United States Copyright Office
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July 30, 2012

Via First Class Mail and Fax

Stuart E. Benson, Esq.
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2000 M Street, N.W., 7th Floor
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Re: Second Request for Reconsideration of Refusal to Register
Ice Crystal Design
SR Number 1-539916887

Dear Mr. Benson:

I am writing on behalf of the U.S. Copyright Office Review Board ("Board") in response to your letter in which you requested that the Copyright Office ("Office") reconsider its refusal to register your client's copyright claim in the sculpted chair back design for the work entitled Ice Crystal Design, a.k.a. Alchemia chair ("Work"). The Board has carefully reviewed the registration application, deposit, and related correspondence and affirms the denial of the application to register the claim to copyright in the Work because the Work is a useful article that lacks separable authorship.

I. DESCRIPTION OF THE WORK

The Work is a chair with four legs, a seat, and a chair back consisting of two alternating rows of cut-out triangles. Each row consists of seven triangles that alternate between those with the base at the bottom and a point at the top, and those with the base at the top and the point at the bottom. The top row begins and ends with triangles positioned with their bases at the bottom and points at the top. The bottom row begins and ends with triangles with their bases at the top and their points at the bottom. The design is depicted as follows:



II. ADMINISTRATIVE RECORD

A. The Registration Application and the Office's Refusal to Register

The application to register the copyright claim in the Work was submitted with a request for Special Handling on December 21, 2010. The registration application states that the Work was completed in 2006 and published on May 31, 2007, in Italy. Archirivolto snc is named as the made-for-hire author and Calligaris S.p.A is named as the owner. The copyright claim is described as "sculpted chair back." The application is supported by a document that states the Work is a useful article and the applicant recognizes that useful articles are not copyrightable but that "a feature of a chair, such as the carving on the back of the chair, is eligible for copyright protection if it is original and conceptually separable from the chair itself and has artistic value in itself." Statement from Stuart E. Benson to the Copyright Office dated 12/21/2010 ("Application Statement") at 1. The registration application was accompanied by several Xerox copies of photographs of the entire Work depicted at different angles.

On December 29, 2010, Visual Arts Division Copyright Registration Specialist ("Specialist") Wilbur King informed you that the Office refused to register your client's copyright claim in the Work because "all of the elements of the work you deposited are either related to the utilitarian aspects or function, or are subsumed within the overall shape, contour, or configuration of the article" and as result "there is no physically or conceptually 'separable' authorship." First Refusal of Copyright Registration Letter from Wilbur King to Stuart E. Benson dated 12/29/2010 ("First Refusal Letter") at 2 (emphasis omitted). The Specialist explained that in order for a useful article to be considered a pictorial, graphic, or sculptural work, the design must incorporate "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." First Refusal Letter at 1 (citing 17 U.S.C. § 101, the definition of "pictorial, graphic and sculptural works"). The Specialist referred you to the legislative history of the Copyright Act of 1976 which confirms that separability may be physical or conceptual. First Refusal Letter at 1 (citing *House Report on the 1976 Copyright Act*, H. Rep. No. 94-1476, 94th Cong. 2d Sess. (1976)).

The Specialist then explained that physical separability "means that the pictorial, graphic, or sculptural features can be physically separated by ordinary means from the utilitarian item." First Refusal Letter at 1 (citing *Compendium II, Copyright Office Practices* ("*Compendium II*"), § 505.04). He further explained that "conceptual separability means that the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper...or as a free-standing sculpture...independent of the shape of the article, *i.e.*, the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article..." First Refusal Letter at 1-2 (citing *Compendium II, Copyright Office Practices*, ("*Compendium II*"), § 505.03 (emphasis omitted)).

B. First Request for Reconsideration

In a letter dated March 28, 2011, you urged the Office to reconsider its refusal to register your client's copyright claim in the Work because, in your opinion, the design is conceptually separable. First Request for Reconsideration Letter from Stuart E. Benson to the Copyright Office dated 3/28/2011 ("First Request Letter") at 1. You argued that artistic features can be conceptually separable from the useful articles that they adorn and cited *Universal Furniture Int'l v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010) in support. First Request Letter at 1. You stated that the Office did not specify how your client's Work was functional and seemed to ignore the fact that an "article can be part of a useful article but still be conceptually separate," and cited *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d. Cir. 1980) in support. First Request Letter at 2. You explained that, like the bear paw slippers in *Animal Fair, Inc. v. Amfesco Industries, Inc.*, 620 F.Supp. 175 (D.Minn. 1985), your client's Work "can be visualized on paper" to reveal an ice crystal pattern that "by itself is not recognizable as the back of a chair." First Request Letter at 2. You attached a "copy of the ice crystal design without the rest of the chair" and an article on the subject of ice crystal formations to support your argument that your client's Work is conceptually separable, and stated that "[t]he question in such cases is not whether the element is an integral part of the useful article. The question is whether the element can be imagined separately from the overall shape or contour of the useful article." First Request Letter at 2.

You conceded that the back of the chair "has a shape and contour appropriate for its function" but denied that the shape and function of the chair back dictate the design itself and added that during the design process the sides of the back of the chair were extended "beyond what is strictly necessary for the function of the chair back" in order to maintain the integrity of the design. First Request Letter at 2. You urged the Office not to have a bias against the Work because it is nonrepresentational, and stated that the Work should not be considered any less than a design that includes "flowers or the image of an animal." First Request Letter at 3 (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-252 (1903); and *Esquire v. Ringer*, 414 F.Supp. 939, 941 (D.D.C. 1976) *rev'd*, 591 F.2d 796 (D.C. Cir. 1978) *cert, den.*, 440 U.S. 908 (1979)). You concluded that the Office should reconsider its refusal to register the claim to copyright in the Work because the Work is "distinctive" and "ornamental, artistic, and conceptually separate from the chair itself." First Request Letter at 3.

C. The Office's Response to the Applicant's First Request for Reconsideration

On August 31, 2011, Registration Program Attorney-Advisor Virginia Giroux-Rollow ("Ms. Giroux-Rollow") responded to your First Request Letter. She upheld the Office's refusal to register your client's copyright claim in the Work because "the chair is a useful article that does not contain any authorship that is both separable and copyrightable." Second Refusal of Copyright Registration Letter from V. Giroux-Rollow to Stuart E.

Benson dated 8/31/2011 ("Second Refusal Letter") at 1. She concluded that the Work is conceptually separable from the chair but that "the elements composing the design, if taken as a whole, do not constitute a copyrightable 'work of art.'" Second Refusal Letter at 2. She then defined "useful article," discussed the Office's examination process for works of art and useful articles, analyzed the copyrightability of your client's Work under the standards for conceptual separability and creative authorship, and distinguished your client's claim from the facts in the cases cited in your First Request Letter.

Ms. Giroux-Rollow explained that a useful article is "an article having an intrinsic function that is not merely to portray the appearance of an article or to convey information. An article that is part of a useful article is considered a useful article" and the "design of a useful article shall be considered a pictorial, graphic, or sculptural work only if and to the extent that such a design incorporates pictorial, graphic, or sculptural features that can be identified as separately (sic) from and capable of existing independently of the utilitarian aspects of the article." Second Refusal Letter at 1. She further explained that when the Office examines a useful article to see if any elements contained on the article are copyrightable, it "examines such a work to determine if it contains physically or conceptually separable elements that can be regarded as a 'work of art' apart from the article in order to support a copyright registration." Second Refusal Letter at 1 (emphases omitted). She did not agree with your argument that your client's Work "contains conceptually separable authorship that is copyrightable." Second Refusal Letter at 1.

Citing *Esquire v. Ringer*, 591 F.2d 796 (D.C.Cir. 1978), she stated the test for conceptual separability in *Compendium II*, § 505.05[3]:

> Conceptual separability means that the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as free-standing sculpture, as another example, independent of the shape of the useful article, *i.e.*, the artistic feature can be imagined separately and independently from the useful article without destroying the basic shape of the useful article.

She explained, however, that the test for conceptual separability cannot be met by "analogizing the general shape of an article to works o[f] modern sculpture, since in this case, the alleged 'artistic or decorative' features and the useful article cannot be perceived as having separate existences." Second Refusal Letter at 2 (citing *Esquire v. Ringer*, 591 F.2d 796 (D.C.Cir. 1978) (upholding Copyright Office's refusal to register copyright claim in an outdoor lighting fixture on the grounds that copyright protection is not possible when based on the overall shape or configuration of a useful article regardless of aesthetic appeal); and *Norris Industries, Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983) (holding wire-spoked wheel cover an uncopyrightable useful article that did not contain any

sculptural design apart from the wheel cover itself)). And although she concluded that your client's Work was conceptually separable, she did not believe that "the elements composing the design, if taken as a whole, constitute a copyrightable 'work of art.'" Second Refusal Letter at 2.

To support her argument that the design itself did not contain enough creative authorship to support a copyright claim, Ms. Giroux-Rollow recited the standard for copyrightability, *i.e.*, "a work must not only be original with and independently created by the author, but it must also 'possess more than a *de minimis* quantum of creativity.'" Second Refusal Letter at 2 (citing *Feist Publications v, Rural Telephone Service Corp.*, 499 U.S. 340, 363 (1991)). She further explained that "[o]riginality...means that the authorship must constitute more than a trivial variation or arrangement of public domain, pre-existing, or noncopyrightable elements." Second Refusal Letter at 2, citing *Alfred Bell v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). She described your client's Work as a "design on a seat back, a repetitive pattern...which is supposed to represent the structure of an ice crystal" and which "consists of two rows of alternating triangles counterposed from side to side and inverted top to bottom with the sides crossing in a series of hexagon shapes." Second Refusal Letter at 2. She explained that the individual elements of the design – triangles and hexagons – are uncopyrightable because they are common and familiar shapes, 37 C.F.R. § 202.1, and that, taken as a whole, the resulting design is a "simple combination and arrangement of a series of triangles and hexagons" which is "*de minimis* and would not support a copyright registration as a stand alone copyrightable 'work of art.'" Second Refusal Letter at 2 (citing *Compendium II, Copyright Office Practices*, § 503.02(a) – (b)). She concluded that the Work did not meet the standard for creativity required to support a copyright claim. Second Refusal Letter at 3.

Ms. Giroux-Rollow then distinguished your client's case from the cases cited in your First Request Letter. She explained that in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980), the Office registered the plaintiff's claims in the belt buckles for which registration had been sought "because they contained conceptually separable elements that were, as a whole, copyrightable," and the "court likened the belt buckles to jewelry pieces which reflected separable copyrightable applied art," something not present in your client's Work. Second Refusal Letter at 3. She stated that the bear claw design on the slippers at the heart of *Animal Fair, Inc. v. Amfesco Industries, Inc.*, 620 F.Supp. 125 (D.C. Minn. 1983) was found by the Office and the court to be conceptually separable from the slippers on which they were applied, but also copyrightable, unlike the design in your client's Work. Second Refusal Letter at 3. She also explained that in the case of *Universal Furniture, Inc. v. Collezione Europa, USA, Inc.*, 618 F.3d 417 (4th Cir. 2010), the works in question were "elements consisting of 3-D shells, acanthus leaves, finials, columns, rosettes, and other carvings" that were "conceptually separable, wholly unnecessary to the furniture's utilitarian function and were, as a whole, *capable of existing independently as a copyrightable 'work of art,'*" unlike the chair back design that is your client's Work. Second Refusal Letter at 3 (emphasis added).

Regarding your client's Work, she stated that "the design of the chair falls within the narrow category of works 'where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.'" Second Refusal Letter at 3 (quoting *Nimmer on Copyright*, § 2.01(b)). She further stated that "in the case of a useful article, unless the product contains separable authorship that is also copyrightable, there is no basis for a copyright registration," and concluded that regarding your client's Work, "[t]he design on the seat back of this chair does not contain any authorship that is both separable and copyrightable." Second Refusal Letter at 3-4.

Ms. Giroux-Rollow then cited legislative history on the 1976 Copyright Act that emphasizes "the need for separable authorship to stand on its own," and, finally, maintained that your client's Work is not copyrightable because "all of the elements or features embodied in this chair are either related to the utilitarian aspects or function of the chair itself, or, if separable, do not contain any copyrightable authorship, or are subsumed within the overall shape, contour, and configuration of the chair itself," and that the Office did not find separable authorship that is also copyrightable in the Work. Second Refusal Letter at 4 (citing H. Rep. No. 94-1476, at 55 (1976)).

D. Second Request for Reconsideration

In a letter dated November 29, 2011, you requested for the second time that the Office reconsider its refusal to register your client's claim to copyright in the Work. You argued that the claim should be registered because the design is a "stylized re-creation of a phenomenon of nature, an ice crystal, as the basis for the design of a modern chair back" that "is more than sufficient to meet the requirement for creativity." Second Request for Reconsideration Letter from Stuart E. Benson to the Copyright Office dated 11/29/2011 ("Second Request Letter") at 1. You noted that in its First Refusal Letter, the Office found the Work to be neither physically nor conceptually separable, but that in its Second Refusal Letter, the Office concluded that the Work is conceptually separable but lacking more than a *de minimis* level of creativity. Second Request Letter at 1-2. You sought verification that the Office did not refuse to register the claim in the Work "merely because the design is composed of familiar shapes" and stated that your client's Work "is the result of a sufficient amount of creativity to meet the standard recognized by the Supreme Court [in *Feist*]." Second Request Letter at 2.

You asked the Office to review the photocopy of the design that was included in your First Request Letter and to read a statement made by the designer himself – both evidentiary items that, in your opinion, demonstrate that the Work contains the minimal level of creativity required to support a copyright claim. Second Request Letter at 2-3. You argued that the Work does meet the minimal standard for creative authorship required for copyright protection based on the fact that a major competitor of your client's has copied the Work wholesale, and that "[e]vidence of creativity can be found in the copying of the work by others." Second Request Letter at 3 (citing *Nimmer on Copyright*, § 2-13). You also stated that the Office "should not impose its own view of what constitutes valuable artistic

content." Second Request Letter at 3 (citing *Nimmer on Copyright*, § 2-13; and *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-252 (1903); and *Esquire v. Ringer*, 414 F.Supp. 939 (D.D.C. 1976)). Finally, you urged the Office not to discriminate against abstract design and stated that the "Alchemia chair is no less so [copyrightable] merely because it is not representational art or is less ornate." Second Request Letter at 3.

III. DECISION

When considering a second request for reconsideration, the Review Board carefully reviews the work that has been submitted for registration, the application to register the work, and all of the correspondence between the applicant and the Copyright Office, including the arguments set forth in the applicant's first and second requests for reconsideration. The refusal to register is subject to *de novo* review, which means that the Board will take a fresh look at whether the work is copyrightable and whether the applicant complied with all of the formal and legal requirements for registration.

The Board upholds the refusal to register a copyright claim in the Work because the chair lacks any separable sculptural authorship. The Board notes that Ms. Giroux-Rollow, in the Second Refusal Letter, concluded that the Work contains separable authorship that is not copyrightable. The Board cannot agree with Ms. Grioux-Rollow that the design on the back of the chair is conceptually separable. Assuming, *arguendo*, that the chair back design is conceptually separable, the Board still upholds the refusal to register a copyright claim in the Work because the design on its own lacks the minimal level of creativity required to support a copyright claim.

A. The "Sculpted Chair Back" Is Not Copyrightable

The question that the Board must address is whether your client's Work is copyrightable. In making that determination the Board must answer a threshold question: Is the Work a useful article?

If a work is a useful article, the Board must determine whether it contains any elements that are separable from its utilitarian function. If the work does not contain any elements that can be separated from its utilitarian function, the Board must uphold the refusal to register, because Congress has made it clear that the Copyright Act does not cover any aspect of a useful article that is not separable. If the Board determines that the work contains one or more elements that can be separated from its utilitarian function, it will examine those elements to determine if they contain a sufficient amount of creative expression to warrant a registration. In other words, the separability analysis must be conducted prior to and independent of the creativity analysis.

1. Useful Articles

The Copyright Act defines a useful article as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101 (definition of a useful article). The statute also explains that "[a]n article that is normally part of a useful article is considered a 'useful article.'" *Id.*

The Board agrees with Specialist King and Attorney-Advisor Giroux-Rollow that your client's Work is a useful article. Its intrinsic purpose is to provide a person with physical support while they are in a seated position. Throughout your correspondence with the Office you did not contest the Office's determination that your client's Work is a useful article. In fact, in your statement supporting the original copyright registration application you conceded, "The application is for registration of the sculpted design of the back of the Alchemia chair. We recognize that useful articles such as chairs are not eligible for copyright."[1] Application Statement at 1.

2. The Legal Framework for Evaluating Separability

Because your client's Work is a useful article, the Board must determine whether the Work contains any elements that are separable from their utilitarian function. If the Work does not contain any separable elements, it cannot be copyrightable.

a. The Copyright Act of 1976

Copyright law sets forth the guiding principles regarding the extent of copyright protection for a useful article. It explains that "pictorial, graphic, and sculptural works" may be eligible for copyright protection, and that this category includes "two-dimensional and three-dimensional works of fine, graphic, and applied art" as well as "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." 17 U.S.C. §§ 101 (definition of pictorial, graphic, and sculptural work), 102(a) (subject matter of copyright). The statute also explains that "the design of a useful article...shall be considered a pictorial, graphic, or sculptural work, only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* § 101 (definition of pictorial, graphic and sculptural work).

The legislative history of the Copyright Act of 1976 confirms that the utilitarian aspects of a useful article are not copyrightable. Only elements that are physically or conceptually separable from the utilitarian purpose or the overall shape of a useful article may be copyrighted. As the House Report to the 1976 Act explains:

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[1] You went on to state, "However, a feature of a chair, such as a carving on its back rest, is eligible for copyright if it is original and conceptually separable from the chair itself, and has artistic value in itself." *See* Statement from Stuart E. Benson to the Copyright Office dated 12/21/2010 at 1.

> Although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer copyright protection under this bill. Unless the shape of any automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design – that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable.

H. Rep. No. 94-1476, 94th Cong., 2d Sess. 55 (1976).

b. The Compendium II, Copyright Office Practices

The purpose of the separability test is to ensure that the utilitarian aspects of a useful article are not registered, because they are not copyrightable subject matter. The Copyright Office's policies and procedures for applying this test are set forth in the *Compendium II, Copyright Office Practices*, § 505.02 (1984) ("Compendium"), which states that:

> Registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article. Determination of separability may be made on either a conceptual or physical basis.

"Physical separability" means that the pictorial, graphic, or sculptural features can be physically separated from the useful article by ordinary means while leaving the utilitarian aspects of the useful article completely intact. As *Compendium II*, § 505.04 explains, "the physical separability test derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection." For example, when a decorative statuette is used as the base for a lamp, the statuette would be considered physically separable if it could be separated from the functional portions of the lamp by removing the shade and lightbulb. *See Mazer v, Stein*, 347 U.S. 201 (1954). "However, since the overall shape of a useful article is not copyrightable, the test of physical separability is not met by the mere fact that the housing of a useful article is detachable from the working parts of the article." *Compendium II*, § 505.04.

Conceptual separability means that elements of the useful article are "clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as a free-standing sculpture, as another example, independent of the shape of the useful article." *Compendium II*, § 505.03. In other words, "the artistic features can be imagined separately and independently from the useful article without destroying the basic shape" of that article, such that "[t]he artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works – one an artistic work and the other a useful article." *Id.* Although the carving on the back of a chair cannot be physically separated from the chair, it would be considered conceptually separable because one could imagine the carving existing as a drawing on a piece of paper. Even if the carving was theoretically removed the shape of the chair would remain unchanged and the chair would still be capable of serving a useful purpose. The fact that an element is not necessary to or dictated by the utilitarian aspects of a useful article does not necessarily mean that the element is conceptually separable. If the element is an integral part of the overall shape or contour of the useful article, that element would not be considered conceptually separable, because removing the element would destroy the basic shape of the useful article.

c. Cases Applying the Separability Test

Courts have recognized that the Copyright Office's regulation concerning useful articles and the separability requirement is an authoritative construction of the copyright law. For example, in *Esquire v. Ringer* the Office refused to register an outdoor lighting fixture which allegedly contained non-functional, purely aesthetic design features. The court upheld the refusal to register, finding that the overall shape or configuration of a utilitarian article is not copyrightable, no matter how aesthetically pleasing that shape may be, unless it is "capable of existing as a work of art independent of the utilitarian article into which [it is] incorporated." 591 F.2d at 803-804. The court noted that the Office's decision was supported by the legislative history of the Copyright Act, which "indicate[s] unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright.[2] *Id.* at 804. Since then, a number of other courts have relied on the Office for "expertise in the interpretation of the law and its application to the facts presented by the copyright application," because the Office has "been concerned with the distinction between copyrightable and noncopyrightable works of art since the Copyright Act of 1870." *Norris Industries, Inc. v. International Telephone and Telegraph Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (holding wire-spoked hubcap uncopyrightable because it was a useful article used to protect lugnuts, brakes, wheels, and axles from damage and dust.

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[2] Although *Esquire* was decided under the 1909 version of the Copyright Act, the court said that it was appropriate to consider the legislative history of the current statute, because "the 1976 Act and its legislative history can be taken as an expression of congressional understanding of the scope of protection for utilitarian articles under the old regulations." 591 F.2d at 803. Section 505 of the Compendium (quoted above) is a direct successor to the regulation which was affirmed by the D.C. Circuit.

In your First Request Letter, you relied on *Kieselstein-Cord v. Accessories by Pearl, Inc., supra.* The two belt buckles at issue in that case were described as "solid sculptured designs...with rounded corners, a sculpted surface." 632 F.2d at 990. The defendant in the case claimed that buckles were useful articles not subject to copyright protection, and that "copyrightability cannot adhere in the 'conceptual' separation of an artistic element." *Id.* at 991-993 (quoting H. Rep. No. 94-1476, 94th Cong., 2d Sess. 55 (1976)). The primarily ornamental aspects of the buckles were found by the court to be conceptually separable and copyrightable. *Id.*

In another case cited in your First Request Letter, *Animal Fair, Inc. v. Amfesco Industries, Inc., supra,* the defendant attacked the validity of the plaintiff's copyright alleging that *inter alia*, the work was a useful article not subject to copyright protection. The court agreed that the work was a useful article but found that it was conceptually separable because "one could draw a line drawing of the whole shape and design which would be recognizable as a fanciful artistic rendition of a bear's paw, regardless of what type of functional or utilitarian object it was used to adorn." 620 F.Supp. at 187. The court also found that the separable authorship was copyrightable because of "the impractical width and shape of the BEARFOOT™ sole, the artwork on the sole, the particular combination of colors, the profile of the slipper, the stuffed aspect of the slipper, and the toes are all sculptural features which comprise the artistic design and which are wholly unrelated to function." *Animal Fair* at 187-188.

In *Universal Furniture Int'l v. Collezione Europe USA, supra,* the defendant attacked the validity of plaintiff's copyrights for, *inter alia*, lack of copyrightability (not sufficiently original and not conceptually separable). 618 F.3d at 428. Prior to filing suit, the plaintiff registered a copyright claim in the work. The authorship on the registration application was described as "decorative sculptural designs on furniture; adaptation of preexisting decorative designs; compilation of decorative designs on suites of furniture..." *Id.* at 425. The court found the works (decorative elements applied to the surface of furniture consisting of 3-D shells, acanthus leaves, finials, columns, rosettes, and other carvings) both conceptually separable and copyrightable because the works were "superfluous, nonfunctioning adornments for which the shape of the furniture...serves as a vehicle" and "not 'inextricably intertwined' with the function of the furniture" but capable of existing independently." *Id.* at 434-435.

B. Application of the Separability Test to the Applicant's Work

1. Physical Separability

As discussed above, the separable elements of a useful article may be eligible for copyright protection if they are capable of existing independently of the useful article without destroying the basic shape or utilitarian function of that article. You conceded that the Work is not physically separable from the useful article. First Request Letter at 1. The Board agrees. The chair back design that forms the basis for your client's claim in the Work

is not physically separable from the useful article, *i.e.*, the chair, because the design forms the back of the chair itself; the design is fused to the utilitarian object and cannot be detached from the chair by ordinary means. Under the test for physical separability, the Work is required to maintain the basic functionality of a chair (*i.e.*, provide support for people in a seated position). As such, the Work cannot be detached from the chair without destroying the basic shape of the chair.

2. Conceptual Separability

As noted above, though Ms. Giroux-Rollow, in the Second Refusal Letter, concluded that the Work is conceptually separable, both the Registration Specialist in his First Refusal Letter, and the Board do not agree.

In your First Request Letter you stated "[t]he applicant submitted that the ice crystal design carved out of the chair back is an original artwork and is conceptually separate from the chair back." First Request Letter at 1. You stated that the "question in such cases [physical and conceptual separability from a useful article] is not whether the element is an integral part of the useful article. The question is whether the element can be imagined separately from the overall shape or contour of the useful article." First Request Letter at 2. As stated earlier, the test for conceptual separability is whether the design, while physically incapable of separation from the useful article by ordinary means, is clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper or as a free-standing sculpture independent of the shape of the useful article. To be conceptually separable from a useful article, a design has to be capable of being imagined separately and independently from the useful article *without destroying the basic shape of the useful article.*

The useful article in this case is a chair with four legs, a seat, and a chair back. The Work is the chair back design composed of alternating rows of cut-out triangles which form the back of the chair. The Work cannot be conceived as a separate work from the chair without destroying the basic shape of the chair itself because the work and the chair back are intricately intertwined. If one were to draw the Work on paper without the remaining parts of the chair (similar to the photocopy of the Work included with your First Request Letter), the basic shape of the chair would be destroyed because it would no longer have a chair back against which to rest.[3] The Work and the chair cannot exist side-by-side and be perceived as fully realized, separate works. Therefore, the Work is not conceptually separable from the useful article.

[3] Even if the outer edges of the triangles at the top and sides of the chair back were not removed, the gap between those edges and the seat would render them useless as a chair back. But since the edges are part of the allegedly separable "ice crystal" design, in fact absolutely nothing would be left of the chair back if the allegedly separable authorship were removed.

C. Copyrightability of the Chair Back Design

The refusal to register that Work is primarily based on the fact that it is a useful article that does not satisfy the separability test. However, the Board notes that even if the rows of alternating triangles that make up the Work could be physically or conceptually separated, they would not be sufficiently creative to support a copyright claim.

In your Second Request Letter you asked the Office to reconsider the refusal to register the copyright claim on the basis that the design does contain enough creative authorship to support a copyright. Second Request Letter at 2. You argued that "the Alchemia chair back is the result of a sufficient amount of creativity to meet the standard recognized by the Supreme Court. The design is not, as suggested by the Office, merely a series of triangles and hexagons. It is an abstract design inspired by the structural shape of an ice crystal, with its repeating geometric shapes. As such, it is original and creative." Second Request Letter at 2.

Designs can fall under copyright protection if they are original. The Supreme Court made clear in *Feist* that the concept of originality in the context of copyright law requires that a work both be independently created by the author and possess a minimal degree of creativity. *Feist*, 499 U.S. at 345.

The Board does not dispute that the Work was independently created by the author in this case. However, the Board does not find that the Work possesses the minimal degree of creativity to support a copyright claim because the Work is a *de minimis* combination of uncopyrightable elements. As already described above, the Work is a chair with four legs, a seat, and a chair back consisting of two alternating rows of cut-out triangles. Each row consists of seven triangles that alternate between those with the base at the bottom and a point at the top, and those with the base at the top and the point at the bottom. The top row begins and ends with triangles positioned with their bases at the bottom and points at the top. The bottom row begins and ends with triangles with their bases at the top and their points at the bottom.[4]

Copyright Office regulations contain an illustrative list of works that are not eligible for copyright protection, including standard designs, figures, and geometric shapes. *See Compendium* § 503.02(a) ("[I]t is not possible to copyright common geometric figures or shapes . . . ."); *id.* § 202.02(j) ("Familiar symbols or designs . . . are not copyrightable."). Because these elements are the building blocks for creative expression, they are uncopyrightable and in the public domain. Triangles, individually, are familiar symbols that are not copyrightable.

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[4] The observation that the design is "a series of" "hexagons" is unduly generous, since the "hexagons" are simply the inevitable result of the regular alignment of the fourteen triangles.

The Supreme Court made it clear in *Feist*, that, "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity." *Feist* at 364. Where a design is composed of noncopyrightable elements in a way that displays more than a "*de minimis* quantum of creativity," the Board agrees that, "[w]hile common shapes are not copyrightable in and of themselves, they are copyrightable if they are arranged in a way that is original and creative." Second Request Letter at 2. But your client has not arranged the two rows of triangles in such a way. Your client's Work as a whole is a simple combination of two rows of alternating triangles resulting in a work that, much like the phone books in *Feist* that were comprised of basic factual information listed in alphabetical order, displays less than the minimal creative authorship required to support a copyright claim. *Feist* at 364. Copyright does not extend protection to an arrangement of triangles "that are selected, coordinated, and arranged in a way that utterly lacks originality." *Id.* at 365. Therefore, the Board does not find that the Work, if conceptually separable, would contain a sufficient amount of creativity to support a copyright claim.

D. Other Factors Cited in the First and Second Request for Reconsideration Letters Are Irrelevant to this Decision

In your First and Second Request Letters, you cite *Bleistein v. Donaldson Lithographing Co.*, *supra*, 188 U.S. at 251-252, and the district court decision in *Esquire, Inc. v. Ringer*, *supra, rev'd*, to support your argument that just because the Work is comprised of nonrepresentational art, "such a design, if original, would be copyrightable," and that the Office "should not impose" its "own view of styles of art in the decision-making process." First and Second Request Letters at 3.

As you reminded us in your Second Request Letter, the Court in *Bleistein* warned:

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value,-it would be bold to say that they have not an aesthetic and educational value,-and the taste of any public is not to be treated with contempt. It is an

> ultimate fact for the moment, whatever may be our hopes for a change.

Bleistein at 251-252. The Board agrees and did not use its own views on art to determine whether your client's Work is copyrightable. As explained in detail above, the Board applied the tests for separability and copyrightability to determine whether the copyright claim in the Work was properly refused registration.

Incredibly, you rely on *Esquire v. Ringer*, 414 F.Supp. 939 (D.D.C. 1958) to support your argument that the Office should not impose its own views on art when determining the copyrightability of a Work. That case, however, was reversed by the U.S. Court of Appeals for the District of Columbia Circuit - that in an opinion that you do not cite - because the work in that case did not contain elements that were physically or conceptually separable from the useful article. *See Esquire, Inc. v. Ringer*, 591 F.2d 796, 806 (D.C. Cir. 1978). The D.C. Circuit also rejected the lower court's conclusions that the Register's refusal of the registration for the lamp design was inconsistent with *Mazer* and that the Register somehow discriminated against abstract modern art. *Id.* at 804. Regarding the conclusion that the Register discriminated against abstract modern art, the court agreed with the district court "that the Copyright Act does not enshrine a particular conception of what constitutes art," but concluded that "the present case does not offend the nondiscrimination principle recognized in *Bleistein*." *Id.* at 806 (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. at 251).

In your Second Request Letter you assert that "[e]vidence of creativity can be found in the copying of the work by others," and cite *Nimmer on Copyright*, § 2-13 ("As was said in the leading case of *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, originality for copyright purposes amounts to 'little more than a prohibition of actual copying.'") to support that assertion. Second Request Letter at 3. What the court in *Alfred Bell* and Professor Nimmer in *Nimmer on Copyright* were referring to when explaining the prohibition of actual copying was the principle that originality in copyright means that a work is original to the author. The court in *Alfred Bell* stated that "'[o]riginal in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.' No large measure of novelty is necessary." *Alfred Bell.* at 102. The court further stated that "[t]he copyright of the book, if not pirated from other works, would be valid without regard to the novelty, or want of novelty, of its subject-matter. The novelty of the art or thing described or explained has nothing to do with the validity of the copyright...That is the province of letters-patent, not of copyright." *Alfred Bell & Co. Ltd.* at 102 (citing *Baker v. Selden*, 101 U.S. 99, 102-103, 25 L.Ed. 841). Contrary to your assertion, *Alfred Bell* and *Nimmer on Copyright*, § 2-13 do not stand for the notion that evidence of wholesale copying of a work proves that a work is copyrightable. There is no principle in copyright law that stands for the proposition that copying by competitors is probative of the copyrightability of a work. Cases are legion in which claims of infringement have been asserted involving works that the courts have concluded are not copyrightable. *See, e.g., Feist, supra; Esquire, supra; Norris Industries, supra.*

You also mentioned in your Second Request Letter that your client attached a "depiction of the ice crystal structure adapted for the Alchemia chair back" as evidence that the Office did not address. Second Request Letter at 2. Your client also submitted a statement in support of the Second Request Letter. Second Request Letter at 2-3. Your client states that he drew inspiration from hexagons and triangles in ice crystal formations, and developed a "unique pattern" for the chair "derived directly from nature." Statement at 1-2. He continued:

> The choice of a hexagonal shape for the ALCHEMIA chair's backrest therefore derived from my personal elaboration on the hexagonal form of the crystal lattice in ice. In fact, inspiration and transposition followed immediately one after the other, and I am delighted with the backrest's beauty and the harmonious sensations that it conveyed to me when I created it and continues to do so.

Statement at 2. But what inspires an author to create a work is irrelevant to the question of copyrightability. What is relevant in cases involving artistic authorship is the objective appearance of the work. And a garden-variety array of triangles does not meet the copyright law; creativity requirement, no matter how creative the inspiration for that arrangement.

IV. CONCLUSION

For the foregoing reasons, the Copyright Office Review Board concludes that Ice Crystal Design cannot be registered for copyright protection. This decision constitutes the final agency action on this matter.

Sincerely,

/s/

David O. Carson
General Counsel
for the Review Board
United States Copyright Office