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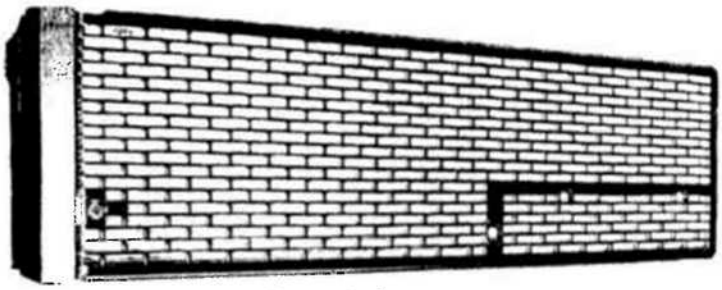
Re: BRICK WALL PATTERN
Copyright Office Control No. 61-403-1731(M)

Dear Mr. Shiells:

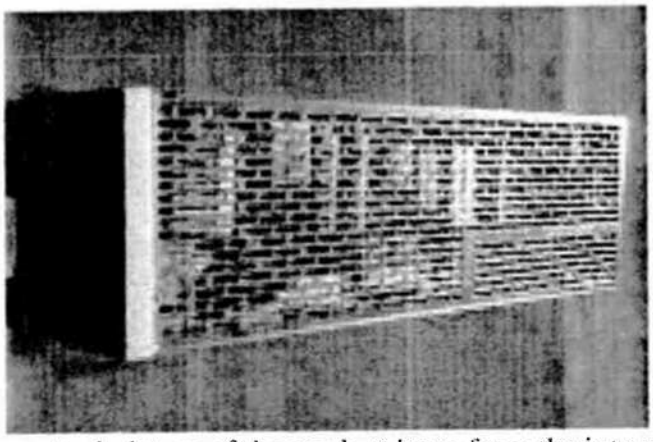
I write on behalf of the Copyright Office Review Board ("Board") in response to your Second Request for Reconsideration in which you request the Copyright Office to reconsider its refusal to register a graphic design entitled "Brick Wall Pattern." We apologize for the long delay in resolving this case and providing you with the determination of the Board. Nevertheless, after carefully examining the application from your client, Valere Power, Inc., the deposit, and the arguments that you presented on the Applicant's behalf, the Board affirms the denial of registration of this work.

I. DESCRIPTION OF WORK

The work is the three-dimensional brick wall pattern on the face of a vent. The design is comprised of a series of rectangular, uniform sized empty spaces, placed in a manner to resemble a brick wall. The spaces exist in order to allow gas or liquid to pass through the vent. The vent also includes a smaller, similar rectangular piece in the bottom right corner which displays the same brick design within the borders of the door-like opening. Several attachment devices are apparent in the design including a Phillips head screw. Below is a copy of the drawing submitted to the Office as the deposit in support of the application and a reproduction of the work from a website that offers (or had offered) this work for sale for the purposes illustrated in the photograph.



Deposit image



An actual picture of the work at issue from the internet.[1]

II. ADMINISTRATIVE RECORD

A. Initial Application and the Office's Refusal to Register

On April 18, 2005, the Office received from your firm a Form VA application on behalf of your client Valere Power, Inc. to register a graphic design. In a letter dated October 14, 2005, Visual Arts Section Examiner, Sandra Ware, refused registration of this work because she concluded it lacks the authorship necessary to support a copyright claim. Letter from Ware to Morgan (Oct. 4, 2005), at 1.

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[1] *See* http://www.google.com/imgres?hl=en&sa=X&tbo=d&biw=1024&bih=587&tbm=isch&tbnid=qOnZ9J4LM6jdvM:&imgrefurl=http://www.telexpressinc.com/pcat_lvl3_0.aspx%3Findex%3D00066697&docid=JXwEGyi1_Vj1iM&itg=1&imgurl=http://www.telexpressinc.com/pic_get.aspx%253Fproduct_number%253DV1500AVC&w=1600&h=1200&ei=9X_DULPwF5On0AGVoYCgBw&zoom=1&iact=hc&vpx=608&vpy=259&dur=4984&hovh=194&hovw=259&tx=133&ty=126&sig=115170233716792455875&page=2&tbnh=164&tbnw=190&start=13&ndsp=20&ved=1t:429,r:16,s:0,i:135 (last visited December 10, 2012).

B. First Request for Reconsideration

In a letter dated January 12, 2006, you requested reconsideration of the Office's refusal to register the Brick Wall Pattern. Letter from Shiells to Copyright R&P Division (Jan. 12, 2006), at 1. You noted that the requisite amount of creativity to support a copyright claim is "extremely low," and argued that the subject work meets this threshold. *Id.* You cited *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) and *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001) to support your claim that the work contained at least a minimum degree of creativity sufficient to be an original work of authorship.

Your first request for reconsideration also claimed that the work is separable from a vent, both conceptually and physically. You identified six specific tests for case law and scholars that have been advanced to determine separability: 1) the artistic features are "primary" and utilitarian features "subsidiary;" 2) the useful article "would still be marketable to some significant segment of the community simply because of its aesthetic qualities;" 3) the article "stimulate[s] in the mind of the beholder a concept that is separate from the concept evolved by its utilitarian function;" 4) the artistic design was not significantly influenced by functional considerations; 5) the artistic features "can stand alone as a work of art traditionally conceived, and . . . the useful article in which it is embodied would be equally useful without it;" and 6) the artistic features are not utilitarian. Letter from Shiells to Copyright R&P Division (Jan. 12, 2006), at 2-3. You then claimed that "[T]he present work meets multiple ones of these examples of separability" and "thus registrable under the Copyright Statute." *Id.* at 3-4.

C. Examining Division's Response to First Request for Reconsideration

In response to your first request for reconsideration, Attorney-Advisor Virginia Giroux-Rollow of the Examining Division reexamined the application and determined that the Office is "still unable to register a copyright claim in this work because it is a useful article that does not contain any authorship that is both separable and copyrightable." Letter from Giroux-Rollow to Shiells (Jun. 16, 2006), at 1. Ms. Giroux-Rollow cited the definition of "useful article" in section 101 of the copyright law, which provides that a useful article is an article having function that is not merely to portray the appearance of the article or to convey information. An article that is part of a useful article is considered a useful article. *Id.*

In reaching her determination, Attorney-Advisor Giroux-Rollow noted that your correspondence did not dispute the fact that the work is a useful article, functional in nature. She further noted that "your argument in favor of registration is that this work contains non-functional elements based on the designer's aesthetic judgment rather than utilitarian concerns and as such contains physically or conceptually separable authorship that is copyrightable," and respectfully disagreed with that assessment. *Id.* at 2.

She then explained that the physical separability test derives from the principle that a copyrightable work of art that is later incorporated into a useful article retains its copyright protection. She stated that examples include a sculptural lamp base of a Balinese dancer or a pencil sharpener shaped like an antique car. However, she clarified that the test is not met by the mere fact that the housing or other component of a useful article is detachable from the working parts of an article. Finally, she concluded that none of the components or elements in the work met the test of physical separability. *Id.* at 2.

She also explained that the Copyright Office's test for conceptual separability generally follows the separability principle set forth in *Esquire v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), citing *Compendium of Copyright Office Practices II*, Ch. 5, § 505.03 (1984) (hereinafter *"Compendium II"*). *Id. Compendium II* provides that conceptual separability occurs when 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 a free-standing sculpture, as another example, independent of the shape of the article, without destroying the basic shape of the article. Examples include a carving on the back of a chair, or pictorial matter engraved on a glass vase. *Id.* She furthered explained that where the non-functional elements are an integral part of the overall shape, styling, or contour of the useful article, registration is not possible, citing to *Esquire*, 591 F.2d at 804, (stating 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.").

Ms. Giroux-Rollow next considered, assuming that the pattern design was conceptually separable, whether the "brick pattern" was original and possessed more than a *de minimis* quantum of creativity, citing *Feist*, 499 U.S. 340 . She elaborated that originality, as interpreted by the courts, meant that the authorship must constitute more than a trivial variation of public domain elements, citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). *Id.* at 3. Applying these standards for originality, she concluded that the pattern "on the surface of the vent," although suggestive of a brick wall, was a common configuration and failed to reflect a sufficient amount of original and creative authorship to support a copyright registration. *Id.* In further support of this conclusion, she noted that "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." *See id.* at 4 (quoting *Nimmer on Copyright*, § 2.01(B)).

D. Second Request for Reconsideration

In a letter dated September 15, 2006, you requested the Office reconsider for a second time its refusal to register the copyright claim in the Brick Wall Pattern. In this letter, you argue that the Copyright Office has erroneously determined that the pattern has been rejected as a "work of art" based upon a judgment of taste as to the degree of artistic merit. Letter from

Shiells to Copyright R&P Division (Sept. 15, 2006), at 1. You also maintain that the "brick pattern on the surface of the vent" is conceptually separable based upon Ms. Giroux-Rollow's statements in her letter rejecting the work at the first reconsideration stage. You further argue that the work meets the test of physical separability discussed in Goldstein's and Nimmer's treatises on copyright. *See* Goldstein, 1 *Copyright* § 2.5.3, at 2:67 (stating that "the design of a useful article is physically separable from the article without impairing the article's utility and if, once separated, it can stand alone as a work of art traditionally conceived") and *Nimmer on Copyright*, § 2.08[B][3] (2004) (concluding that "separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.").

Starting from the assumption that the "brick design pattern" is separable, your letter acknowledges that the work must not only be original, but also possess more than a *de minimis* quantum of creativity in order to support a copyright registration. In contrast to the work at issue in *Feist*, you note that the present work is not a mere list of factual information, but is a work of visual art that "considered separately from its possible use as a vent, embodies creative and provocative expression of incongruity [that] goes beyond the '*de minimis*' contribution" required under the *Feist* standard.

III. DECISION

When considering a second request for reconsideration, the Board carefully reviews the work that has been submitted for registration, the application to register the work, the deposit, 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 Brick Wall Pattern lacks any separable sculptural authorship. The Board notes that Ms. Giroux-Rollow, in the Second Refusal Letter, conceded that the work may contain conceptually separable authorship that is not copyrightable. The Board cannot agree with Ms. Grioux-Rollow that the brick wall design of the vent is conceptually separable. Assuming, *arguendo*, that the brick wall 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.

1. Useful Articles and Separability

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. H.R. REP. NO. 94-1476, at 55 (1976). 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 registration. In other words, the separability analysis must be conducted prior to and independent of the creativity analysis.

a. Useful Articles

Copyright protection does not extend to a useful article, defined 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. However, works of artistic craftsmanship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* § 101. The design of the useful article will be protected "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.*

The Board agrees with Attorney-Advisor Giroux-Rollow that your client's work is a useful article. Its intrinsic purpose is to serve as a vented cover. Moreover, throughout your correspondence with the Office you did not contest the Office's determination that your client's work is a useful article. Starting from this initial determination, the next question is whether there is separable authorship.

b. The Legal Framework

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:

> [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the 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. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element and would not cover the over-all configuration of the utilitarian article as such.

H.R. REP. NO. 94-1476, at 55.

Physical separability means that the subject pictorial, graphic, or sculptural features must be able to be separated from the useful article by ordinary means. 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, a statuette that also serves as a lamp base can be ordinarily separated from the functional portion of the lamp by unscrewing the bulb and shade. Thus, the statuette can qualify as physically separable. *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.

In contrast, conceptual separability means that the subject features 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, *i.e.*, the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of useful article. The 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." *Compendium II, supra*, § 505.03. For example, while a carving on the back of a chair cannot readily be physically separated from the

chair, it can easily be conceptually separated because one could imagine the carving existing as a drawing. The chair, meanwhile, would still remain a useful article having retained its basic shape, even absent the carving. The carving would therefore qualify as conceptually separable.

However, just because a feature is not necessary to or dictated by the utilitarian concerns of an article does not mean that the feature is automatically conceptually separable. If removing such features would destroy the useful article's basic shape, namely because the features are an integral part of the overall shape or contour of the useful article, then the features would not qualify as conceptually separable.

c. Cases Applying the Separability Test

Your requests for reconsideration cited a number of precedents and tests concerning the concept of conceptual separability which you maintain support registration of the work. Variations in the theory on conceptual separability among the several scholars/jurists who have written about this issue are widely recognized. Nevertheless, for the reasons stated in this section, the Board finds your arguments unpersuasive.

In your First Request for Reconsideration, you cite *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) as one example of a test for separability. *Kieselstein* involved two belt buckles, the Winchester and Vaquero, registered by the Copyright Office, and which incorporated ornamental features consisting of geometric shapes with "several surface levels" and wavy lines. *Id.* at 990. These identifiable ornamental features were found to be conceptually separable from the utilitarian function of the belt buckles. We further note that the Winchester and Vaquero belt buckles reflected sculpted, contoured lines which could not fairly be said to be co-extensive with the entire shape of the buckles; and, the court could visualize the sculpted lines as separate from the usefulness of the belt buckle, without violating congressional intent that useful articles remain without copyright protection. The same cannot be said for your client's work. The three-dimensional aspects of the Brick Wall Design are an integral part of and coextensive with the vent and, therefore, unlike the belt buckles at issue in *Kieselstein*.

Next, you cite *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985), a case in which the court invalidated registrations by the Copyright Office on four styles of mannequins on the grounds that the works failed to meet the separability test. In reaching this conclusion, the court categorized the works as utilitarian, and did not find any separable features that were not essential to the function. Similarly, as you acknowledge, the "utilitarian aspect of a vent is to permit the free flow of air or water," but you fail to identify any elements in the design that do not serve this purpose. Rather, you contrast the open grill work on the vent to a brick wall where the purpose of the bricks is "to make a brick wall impervious to the passage of air" in a misplaced reliance upon a different standard offered by Judge Newman in the dissent. His test would acknowledge conceptual separability in the case where the article "stimulate[s] in the

mind of the beholder a concept that is separate from the concept evoked by its utilitarian function." *Id.* at 422. Such, however, is not the test. Moreover, the Board believes the work at issue is as utilitarian as the mannequins found uncopyrightable in *Barnhart.*

In your legal analysis in support of your first request for reconsideration, you also raise the separability test that was applied in *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) and *Pivot Point Int'l v. Charlene Prods., Inc.*, 170 F. Supp. 2d 828 (N.D. Ill. 2001). The *Brandir* and *Pivot Point* cases rely on what is widely known as the Denicola test for conceptual separability because it was first advocated by Professor Denicola.[1] Unfortunately, the Denicola test offers no objective standard that can be applied with consistency by the Office in its statutorily-required examination of claims to registration. The Denicola separability test essentially relies on the exercise of subjective judgment and such judgment would likely lead to arbitrary decision-making. Because of the possible problems which the Denicola test may engender, premised as it is, at least partly, on subjective perception and on the personal intention of the creator of the work in question, and because such a test might result in registration of works in conflict with the expressed Congressional intent to deny copyright protection to the design of useful articles which happen to be aesthetically pleasing, the Copyright Office has not adopted this particular alternative separability test.

You also relied on *Pivot Point v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004), in which the Seventh Circuit upheld copyright in a mannequin head. The Board has no quarrel with the result reached in that case since the face was sufficiently detailed to be an independently recognizable human visage. Moreover, the court found the head to have been made as a "product of a creative process unfettered by functional concerns." *Id.* at 932. The work at issue here, however, is distinguishable from the protected mannequin head in that the copyright claim is in the general pattern of the vent openings and there is no basis to consider the overall pattern of the openings to have any independently recognizable sculptural authorship apart from creating spaces in the overall shape of the vent to allow for sufficient air flow.

Apart from the cases discussed above, you articulate two other separability tests offered

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[1] The Second Circuit in *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987), adopted Professor Denicola's test for determining conceptual separability. That test considers whether or not a given feature or aspect of a useful article "reflects a merger of aesthetic and functional considerations;" if so, the artistic features of the useful article cannot be said to be conceptually separable; if not, conceptual separability may exist. *Id.* at 1145. Professor Denicola's test encompasses a consideration of the design process involved in the useful article in question as well as the artistic choices of the creator of the article and whether the artistic aspects of the article were significantly influenced by the functionality requirements. 67 Minn. L. Rev. 707 (1983). Professor Denicola argued that "The statutory directive requires a distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear." *Id.* at 742. He advocates that copyrightability "ultimately should depend on the extent to which the work reflects artistic expression *uninhibited by any functional considerations.*" *(emphasis added) Id.*

by scholars. First is the "likelihood-of-marketability" test which would recognize "conceptual separability [] where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities." Melville B. Nimmer & David Nimmer, *1 Nimmer on Copyright* § 2.08[B][3], at 2-101 (2004). This test, however, has had limited application. In *Galiano v. Harrah's Operating Co.*, 416 F.3d 411(5th Cir. 2005), the court chose to apply the Nimmer test for determining the presence of separability rather than the Brandir/Dinecola test. In doing so, the court further chose to limit this particular separability test to the category of garment designs only and preferred this narrow standard "in the interest of having a determinate rule." *Id.* at 421-422. Thus, although commenting that *Pivot Point* represents the "most thorough and persuasive analysis" of the separability issue "in any circuit," *Id.* at 418, the Fifth Circuit panel applied the Nimmer test and found the plaintiff's works as not having been shown to be "marketable independently of their utilitarian function as casino uniforms." *Id.* at 422.

As an initial manner, the "likelihood-of-marketability" is not applicable to your client's work under the limitations articulated by the Fifth Circuit since the work is not a garment design. We also take this opportunity to discuss particular decision and its separability test to explain why the Copyright Office would not consider the marketability or the predictable commercial success of a useful article with respect to its aesthetic aspects as relevant to its analysis. The House Report to the 1976 Act states unequivocally that "[A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill." H.R. REP. NO. 1476 at 55. *Compendium II*, § 503.01, restates this noting that the registrability of a work does not depend on artistic merit or aesthetic value. Section 505.05 further states that in applying the Office's test for separability, *above at 6-7*, the fact that the shape of the article could be designed differently and the amount of work which went into the making of the design are not relevant factors: "Thus, the mere fact that a famous designer produces a uniquely shaped food processor does not render the design of the food processor copyrightable." The Office does not consider a test which premises the requisite separability on the marketability or the sales potential– factors which may fluctuate and differ from predictive judgment to predictive judgment – of a useful article as a work of art to be a test consistent with explicit congressional intent concerning the statutory meaning of separability.

Finally, you identify one last test for physical separability; namely, whether the work "can stand alone as a work of art traditionally conceived, and . . . the useful article in which it is embodied would be equally useful without it" Goldstein, 1 Copyright § 2.5.3, at 2:67. You argue that "a vent would be just as useful without the shiny metallic-appearance and without a brickless, "brickwall" appearance." Letter from Shiells to Copyright R&P Division (Sept. 15, 2006), at 3. While the Board does not disagree with your observation, it is nonetheless not relevant. The question is whether the work, *i.e.*, the brick wall three-dimensional design of the vent, contains separable elements that are not part of the useful article and not consideration of other possible designs of a vent. The Board is only concerned with the actual work submitted for

registration.

Thus, we return to the Office's separability tests. The test applied by the Office must be one consistent with the expressed intention of Congress as it was set forth in the substantial legislative history that accompanied the 1976 major revision of the copyright law. Section 505 of *Compendium II, supra* at 6-7, is a direct successor to the Copyright Office regulation that was affirmed in *Esquire*. *Esquire* enunciated the rule that is the basis for the Office's analysis of whether a pictorial, graphic, or sculptural work may be considered separable from the utilitarian object in which it is incorporated. Relying on explicit statements in legislative history, the *Esquire* court found that the Office's regulation was an authoritative construction of the copyright law. *Id.* at 802-803. *Esquire* and later cases held that, despite an aesthetically pleasing, novel or unique shape, the overall design or configuration of a utilitarian object may not be copyrighted if it is not "capable of existing as a work of art independent of the utilitarian article into which [it is] incorporated." *Id.* at 803-804. In *Esquire*, the court held that the Copyright Office properly refused registration for a useful article, in that case a light fixture, notwithstanding how aesthetically pleasing the useful article's shape or configuration may have been. *Id.* at 800. As noted above, the legislative history states that:

> 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.R. Rep. No. 94-1476, at 55.

Thus, 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* 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." *Esquire*, 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

[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

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 Indus, Inc. v. Int'l 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).

Based on the foregoing considerations, the Board has determined that there are no physically or conceptually separable elements.

2. Original Work of Authorship

As noted above, the refusal to register the 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 three-dimensionalimensional brick wall design of the vent could be physically or conceptually separated, it would not be sufficiently creative to support a copyright claim.

a. The Legal Threshold

The separability of a design feature from a utilitarian object does not mean that the feature will necessarily merit copyright protection. All copyrightable works, be they sculptures, engravings or otherwise, must also qualify as "original works of authorship." 17 U.S.C. § 102(a).

The term "original" consists of two components: independent creation and sufficient creativity. *Feist*, 499 U.S. at 345. First, the work must have been independently created by the author, *i.e.*, not copied from another work. For the purposes of this reconsideration request, the Copyright Office accepts at face value the assertion on the subject application for registration that your client Valere Power designed the vent. Second, the work must possess sufficient creativity. In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist,* where the Supreme Court held that only a modicum of creativity is necessary.

As you properly note in your second request for reconsideration, a work must be both original and "possess more than a *de minimis* quantum of creativity." Letter from Shiells to Board of (Sept. 15,2006), at 2. The Court in *Feist* also ruled that some works (such as the work at issue in that case) fail to meet the standard. The Court observed and you included the reference in your letter above 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*,

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the old regulations." 591 F.2d at 803. Section 505 of *Compendium II* (quoted above) is a direct successor to the regulation which was affirmed by the D.C. Circuit.

In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist,* where the Supreme Court held that only a modicum of creativity is necessary.

As you properly note in your second request for reconsideration, a work must be both original and "possess more than a *de minimis* quantum of creativity." Letter from Shiells to Board of (Sept. 15,2006), at 2. The Court in *Feist* also ruled that some works (such as the work at issue in that case) fail to meet the standard. The Court observed and you included the reference in your letter above 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*, 499 U.S. at 363, and that there can be no copyright in a work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359; *see also*, 37 C.F.R. § 202.10(a) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."). Yet, while the level of creativity is relatively modest, there does "remain[] a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." *Nimmer on Copyright* § 2.01(b).

The *Compendium II* has long recognized this principle stating that "[w]orks that lack even a certain minimum amount of original authorship are not copyrightable." *Compendium II*, § 202.02(a). With respect to pictorial, graphic, and sculptural works, the class within which the designs fall, *see* 17 U.S.C. § 102(a)(5), the *Compendium II* states that "[a] certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Compendium II*, § 503.02(a). The *Compendium II* recognizes that it is the presence of creative expression that determines the copyrightability of a work, and that:

> [R]egistration cannot be based upon the simplicity of standard ornamentation . . . Similarly, it is not possible to copyright common geometric figures or shapes . . . a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.

Id. See also 37 C.F.R. § 202.1(a) ("familiar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained.").

The case law and at least one copyright treatise confirm these principles. *See Forstmann,* 89 F. Supp. 964 (label with words "Forstmann 100% Virgin Wool" interwoven with standard *fleur-de-lis* could not support a copyright claim due to lack of authorship); *Bailie v. Fisher*, 258 F.2d 425 (D.C. Cir. 1958) (cardboard star with two folding flaps allowing star to stand for retail display not copyrightable work of art); *Magic Mktg., Inc. v. Mailing Servs. of Pittsburgh*, 634 F. Supp. 769 (W.D. Pa. 1986) (envelopes with black lines and words "gift check" or "priority message" did not contain minimal degree of creativity necessary for copyright protection);

Tompkins Graphics, Inc. v. Zipatone, Inc., 222 U.S.P.Q. 49 (E.D. Pa. 1983) (collection of various geometric shapes not copyrightable). *See also Nimmer on Copyright* § 2.01(B). ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.").

Of course, some combinations of common or standard design elements may contain sufficient creativity with respect to how they are combined or arranged to support a copyright. *See Feist*, 499 U.S. at 358 (the Copyright Act "implies that some 'ways' [of compiling or arranging uncopyrightable material] will trigger copyright, but that others will not."). However, merely combining or arrangement itself may be too simplistic. For example, the Eighth Circuit upheld the Register's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in cursive script below the arrow. *John Muller & Co. v. N.Y. Arrows Soccer Team*, 802 F.2d 989 (8th Cir. 1986). *See also Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) ("It is true, of course, that a *combination* of unprotectible elements may qualify for copyright protection. (citations omitted). But it is not true that any combination of unprotectible elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectible elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an *original* work of authorship.") (emphasis added).

b. The Brick Wall Pattern Does Not Embody Sufficient Creativity

In this work, the work consists of a standard brick wall pattern embodied in a vent. A simple review of architectural history notes the widespread use of bricks in a brick wall pattern as early as the Roman era in which alternating bricks were used to create structures. The lack of bricks in order to allow gas or liquid to pass through does not change the standard pattern in any way. A brick wall pattern, even with the absence of the bricks themselves, simply is unable to embody a sufficient level of creativity to sustain a copyright registration within the meaning of *Feist*. Here, it is a three-dimensional representation of a common geometric shape, and is therefore not subject to copyright protection. Similarly, the use of shiny metal in place of clay or other masonry as the material used to create the work is not copyrightable in itself, nor is its use in conjunction with the standard brick wall pattern sufficient to overcome the requirement that the work demonstrate a sufficient level of creativity. A simplistic "combination and arrangement" of non-protectable elements cannot rise to the requisite level of creativity. *See Compendium II, supra*, § 503.02(b). "[T]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations." In this case, there is only one standard form or shape, arranged in a garden variety pattern depicting a series of stacked rectangles.

Your reference to *Suntrust* is also misplaced. The discussion on incongruity between elements in the defendant's work and the original work concerned the question of whether the defendant's work was a parody of the original work as part of a fair use analysis under 17 U.S.C, § 107; a question which is not at issue here. *Suntrust,* 268 F.3d 1257. This analysis is unrelated to your erroneous contention that the incongruity between "the imperviousness of a normal brick wall" and "the porous appearance of the present work" satisfies the requirement for at least a minimum degree of creativity. Symbolic meanings or interpretations by themselves are not copyrightable. "The requisite minimal amount of original sculptural authorship necessary for registration in Class VA does not depend upon the aesthetic merit, commercial appeal, or symbolic value of a work . . . In every case, it is the creative expression of the author which must be able to stand alone as an independent work apart from the general idea which informs it." *See Compendium II, supra,* § 503.02(b).

IV. **CONCLUSION**

For the reasons stated herein, the Copyright Office Review Board affirms the refusal to register the work entitled "Brick Wall Pattern." This decision constitutes final agency action on this matter.

Sincerely,

Tanya M. Sandros
Copyright Office General Counsel
for the Review Board
United States Copyright Office