United States Copyright Office
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August 12, 2013

Dunnegan & Scileppi, LLC
Attn: William Dunnegan
350 Fifth Avenue
New York, NY 10118

Re: 9 Floating Blocks
Correspondence ID: 1-CHLERP

Dear Mr. Dunnegan:

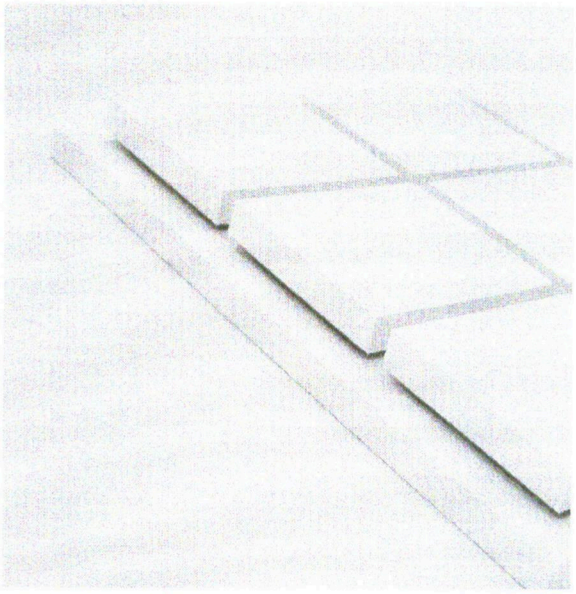
The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the work entitled: *9 Floating Blocks*. You submitted this request on behalf of your client, Nations Photo Lab, Inc. (the "Applicant"), on May 7, 2012. I apologize for the delay in the issuance of this determination. After periods of inaction, staff departures, and budgetary restrictions, the Register of Copyrights has appointed a new Board and we are proceeding with second appeals of registration refusals as expeditiously as possible.

The Board has examined the application, the deposit copies, and all of the correspondence in this case. After careful consideration of the arguments in your second request for reconsideration, the Board affirms the Registration Program's denial of registration of this copyright claim. The Board's reasoning is set forth below. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

I. DESCRIPTION OF THE WORK

9 Floating Blocks (the "Work") consists of nine square blocks arranged in a three-by-three grid and attached to a square backboard. The Applicant has attached the blocks to the backboard in such a way so that there is a small gap between the blocks' edges and the backboard.

The below image is a photographic reproduction of the Work from the deposit materials:



II. ADMINISTRATIVE RECORD

On December 5, 2011, the United States Copyright Office (the "Office") issued a letter notifying the Applicant that it had refused registration of the above mentioned Work. *Letter from Registration Specialist Ivan Proctor to Ella Aiken* (December 5, 2011). In its letter, the Office indicated that it could not register the Work because it lacks the authorship necessary to support a copyright claim. *Id.*

In a letter dated December 9, 2011, the Applicant requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from Ella Aiken to Copyright RAC Division* (December 9, 2011) ("First Request"). The Applicant's letter set forth the reasons it believed the Office improperly refused registration. *Id.* Upon reviewing the Work in light of the points raised in the Applicant's letter, the Office concluded that the Work "does not contain a sufficient amount of original and creative sculptural authorship in either the treatment or arrangement of its elements to support a copyright registration" and again refused registration. *Letter from Copyright Office to Ella Aiken* (April 19, 2012).

Finally, in a letter dated May 7, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. *Letter from William Dunnegan to Copyright R&P Division* (May 27, 2012) ("Second Request"). In your argument, you identify the space between the Work's backboard and the portions of its nine blocks that are raised above the backboard as a "floating feature." You then claim that both the "floating feature," in and of itself, and the incorporation of the "floating

feature" into the Work's overall arrangement possess the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). *Second Request* at 1.

In addition to *Feist*, your argument references several cases supporting the general principle that a work that is comprised solely of a combination of basic or common shapes is not a sufficient basis for refusing copyright registration. *Id.* at 2.

III. DECISION

A. *The Legal Framework*

(1) Separability

Copyright protection does not generally extend to useful articles, *i.e.*, "article[s] 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 authorship, 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 [the designs'] form but not their mechanical or utilitarian aspects are concerned." *Id.* at § 101.

To be clear, a design incorporated into a useful article is only eligible for copyright protection to the extent that the design includes "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, utilitarian aspects of the article." *Id.*; *see also Esquire, Inc. v. Ringer,* 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied,* 440 U.S. 908 (1979) (holding copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be"). The Board employs two tests to assess separability: (1) a test for "physical separability"; and, (2) a test for "conceptual separability." *Id.; see also Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q. 2d 1714 (D. D.C. 1995) (finding that the Copyright Office's tests for physical and conceptual separability are "a reasonable construction of the copyright statute" consistent with the words of the statute, present law, and the legislature's declared intent in enacting the statute).

To satisfy the test for "physical separability," a work's pictorial, graphic, or sculptural features must be able to be physically separated from the work's utilitarian aspects, by ordinary means, without impairing the work's utility. *See, e.g., Mazer v. Stein*, 347 U.S. 201 (1954) (holding a sculptured lamp base depicting a Balinese dancer did not loose its ability to exist independently as a work of art when it was incorporated into a useful article); *and see, Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (upholding the copyright in a sculpture of an antique telephone that was used as a casing to house a pencil sharpener because the sculpture was physically separable from the article

without impairing the utility of the pencil sharpener). To satisfy the test for "conceptual separability," a work's pictorial, graphic, or sculptural features must be able to be imagined separately and independently from the work's utilitarian aspects without destroying the work's basic shape. *See, e.g.,* H.Rep. No. 94-1476 (1976), U.S.Code Cong. & Admin.News 1976, p. 5668 (indicating a carving on the back of a chair or a floral relief design on silver flatware are examples of conceptually separable design features). A work containing design features that fail to qualify as either physically or conceptually separable from the work's intrinsic utilitarian functions are ineligible for registration under the Copyright Act.

(2) Originality

All copyrightable works must qualify as "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). As used with respect to copyright, the term "original" consists of two components: independent creation and sufficient creativity. *See Feist*, 499 U.S. at 345. First, the work must have been independently created by the author, *i.e.*, not copied from another work. *Id.* Second, the work must possess sufficient creativity. *Id.* While only a modicum of creativity is necessary to establish the requisite level, the Supreme Court has ruled that some works (such as the telephone directory at issue in *Feist*) fail to meet this threshold. *Id.* The Court observed 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." *Id.* at 363. It further found that there can be no copyright in a work in which "the creative spark is utterly lacking or so trivial as to be nonexistent." *Id.* at 359.

The Office's regulations implement the long-standing requirements of originality and creativity set forth in the law and, subsequently, the *Feist* decision. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring"); *see also* 37 C.F.R. § 202.10(a) (stating "[i]n order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form").

Of course, some combinations of common or standard design elements may contain sufficient creativity, with respect to how they are juxtaposed or arranged, to support a copyright. Nevertheless, not every combination or arrangement will be sufficient to meet this grade. *See Feist,* 499 U.S. at 358 (finding the Copyright Act "implies that some ways [of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not"). Ultimately, the determination of copyrightability in the combination of standard design elements rests on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D. D.C. 1989).

To be clear, the mere simplistic arrangement of unprotectable elements does not automatically establish the level of creativity necessary to warrant protection. For example, the Eighth Circuit upheld the Copyright Office's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in a cursive script below the arrow. *See John Muller & Co.*, 802 F.2d 989 (8th Cir. 1986). Likewise, the Ninth Circuit held that a glass sculpture of a jellyfish that consisted of elements including clear glass, an oblong shroud, bright colors, proportion, vertical orientation, and the stereotypical jellyfish form did not merit copyright protection. *See Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). The court's language in *Satava* is particularly instructional:

> [i]t is true, of course, that a combination of unprotectable elements may qualify for copyright protection. But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable 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.

Id. (internal citations omitted) (emphasis in original).

Finally, Copyright Office Registration Specialists (and the Board, as well) do not make aesthetic judgments in evaluating the copyrightability of particular works. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's uniqueness, its visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *see also Bleistein v. Donaldson*, 188 U.S. 239 (1903). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not automatically mean that the work, as a whole, constitutes a copyrightable "work of art."

B. *Analysis of the Work*

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work does not contain any separable authorship on which to base a claim to copyright. We further find that, even if the Work's design features can be considered separately from the Work's utilitarian function, they lack a sufficient amount of copyrightable authorship to satisfy the requirement of originality. Accordingly, we affirm the denial of registration.

Regarding separability, the Board determines that the Work is a useful article void of any separable authorship eligible for copyright registration. A "useful article" is defined by statute 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 (2007). The Work fits this definition in that its primary purpose is to serve as a specific arrangement of blank media onto which users can display images. Indeed, the Applicant's own online catalog expressly indicates that the Work's utility derives from its usage as an arrangement of "Floating Gallery Blocks – Photo Blocks" on which users can "create [their] very own three-dimensional piece of art." *See, e.g.,* "Prints & Products: Gallery Blocks" http://www.nationsphotolab.com/gallery_blocks.aspx (last visited July 24, 2013).

As discussed above, the law requires that, to be eligible for registration, the designs of useful articles must be either physically or conceptually separable from the utilitarian aspects of the work. *See Esquire,* 591 F.2d at 800. Here, the Work is comprised of a grid of nine blocks affixed to a larger block. We cannot conceive of a way to physically or conceptually separate any of these elements from the Work without destroying the Work's basic utilitarian purpose as a raised, three-by-three grid for displaying images. Accordingly, we find that the Work does not contain any separable authorship on which to base a claim to copyright.

Regarding originality, even if we were to agree with your assertion that the Work has no purpose other than to act as an "unpainted sculpture," we find that the Work lacks a sufficient amount of creativity to warrant registration. We recognize the principle that combinations of geometric shapes may be eligible for copyright protection. However, in order to be accepted for registration, such combinations must contain some distinguishable variation in the selection, coordination, or arrangement of their elements that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883. Here, the Work consists of the simple combination of nine square-shaped blocks, arranged in a three-by-three grid, and attached to a square-shaped backboard so that their edges are raised from the backboard. This basic configuration of common shapes is, at best, *de minimis*, and lacks the requisite "creative spark" for copyrightability. *See Feist*, 499 U.S. at 359; *see also* 37 C.F.R. §§ 202.1(a), 202.10(a).

Finally, the Board is not persuaded by your assertion that the Applicant's attaching of the blocks to a backboard so that the small gap between the blocks' edges and the backboard "creates the visual impression that the blocks are 'floating' above the base" is, in and of itself, sufficiently creative to warrant registration. *Second Request* at 2. As discussed, the Board does not assess a design's visual effect, appearance, or symbolism in determining whether a work contains the requisite minimal amount of original authorship necessary for registration. *See* 17 U.S.C. § 102(b); *see also Bleistein v. Donaldson*, 188 U.S. 239 (1903). Thus, even if accurate, the mere fact that the Applicant's Work creates the visual appearance of floating blocks, would not qualify the Work, as a whole, as copyrightable.

In sum, we find that the Work is a "useful article" without separable creative elements eligible for copyright registration. We further find that the Work consists of a simple variation of standard shapes that lacks the minimal amount of original artistic authorship necessary to support copyright registration.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the work entitled: *9 Floating Blocks*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____
William J. Roberts, Jr.
Copyright Office Review Board