**United States Copyright Office**
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August 14, 2013

Bryan Cave LLP
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Charlotte, NC 28202

**Re: Bayside Stool**
**Bergamo Stool and Chair**
**Riggler Stool**
**Trevilian Stool**
**Martino Bed**
**Correspondence ID: 1-BDMAOE; 1-BDON0**

Dear Mr. Sidbury:

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 works entitled: *Bayside Stool, Bergamo Stool and Chair, Riggler Stool, Trevilian Stool,* and *Martino Bed* (the "Works"). You submitted this request on behalf of your client, Hillsdale Furniture, LLC, on July 18, 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 applications, the deposit copies, and all of the correspondence in these cases. After careful consideration of the arguments in your second request for reconsideration, the Board affirms the Registration Program's denial of registration of these copyright claims. 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

The Works consists of the following five furniture designs:

### *(1) Bayside Stool*

The *Bayside Stool* is a four-legged wooden stool with wooden arm rests and a wooden backrest. The stool's backrest includes a design that consists of two elongated "circle eight" figures.

The figures overlap at the bottom, forming a small oval. The below image is a photographic reproduction of the Work from the deposit materials:



***(2) Bergamo Stool and Chair***

The *Bergamo Stool* is a four-legged wooden stool with a wooden backrest. The stool's backrest includes a metal design feature that consists of standard, symmetrical curlicue scroll work. The below image is a photographic reproduction of the Work from the deposit materials:



The *Bergamo Chair* is a four-legged wooden chair with a wooden backrest. The stool's backrest includes a metal design feature that consists of standard, symmetrical curlicue scroll work. The below image is a photographic reproduction of the Work from the deposit materials:



***(3)Riggler Stool***

The *Riggler Stool* is a four-legged wooden stool with a metal backrest. The stool's backrest includes a metal design feature that consists of two overlapping ovals placed inside of one larger oval. The below image is a photographic reproduction of the Work from the deposit materials:



***(4) Trevilian Stool***

The Trevilian Stool is a four-legged metal stool with a metal backrest. The stool's backrest includes a metal design feature that consists of standard, symmetrical curlicue scroll work (the same design as that in the *Bergamo Stool and Chair*). The below image is a photographic reproduction of the Work from the deposit materials:



***(5) Martino Bed***

The *Martino Bed* is a four-post bed frame. The bed's head and foot frames include a metal design feature that consists of curlicue scroll work with a diamond at its center.



## II. ADMINISTRATIVE RECORD

On November 18, 2011, the United States Copyright Office (the "Office") issued five letters notifying Hillsdale Furniture, LLC (the "Applicant") that it had refused registration of the above mentioned Works. *Letters from Registration Specialists, Robin Jones,and Shawn Thompson to Helen Johnson* (November 18, 2011). In its letters, the Office indicated that it could not register the Works because they are useful articles that do not contain any separable features that are copyrightable. *Id.*

In five letters dated January 4, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusals to register the Works. *Letters from Benjamin Sidbury to Copyright RAC Division* (January 4, 2012) ("First Requests"). Your letters set forth your reasons as to why the Office improperly refused registration. *Id.* Upon reviewing the Works in light of the points raised in your letters, the Office again concluded that the Works are useful articles that do not contain any authorship that is both separable and copyrightable and refused registration. *Letter from Attorney-Advisor, Stephanie Mason, to Benjamin Sidbury* (May 15, 2012).

Finally, in a letter dated July 18, 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 Benjamin Sidbury to Copyright R&P Division* (July 18, 2012) ("Second Request"). In your letter, you agree with the Office's prior determination that the Works include design features that are separable from their functional aspects, but disagree with the Office's conclusion that the Works lack a sufficient amount of original authorship to qualify for copyright protection. *Id.* at 1-3. Specifically, you claim the Works' design features include at least 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 2-3.

In addition to *Feist*, your argument references several cases in support of the general principle that ornamental designs incorporated into furniture are eligible for registration under the Copyright Act if they are both separable and possess a requisite amount of creative authorship. *Second Request* at 3 (referencing *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010); *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365 (Fed. Cir. 2006); *Fabrica Inc. v. El Dorado Corp.*, 697 F.2d 890 (9th Cir. 1983); and *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503 (9th Cir. 1987)).

## III. DECISION

### A. *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.R Rep. No. 194-476 (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 inoriginal).

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 Works and applying the legal standards discussed above, the Board finds that none of the Works possess design elements that are *both* separable from the Works' utilitarian functions and possess a sufficient amount of creative authorship to satisfy the requirement of originality. Accordingly, we affirm the denial of registration for all six Works.

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). As discussed above, the law requires that, to be eligible for registration, design features incorporated into useful articles must be either physically or conceptually separable from the utilitarian aspects of the work. *See Esquire,* 591 F.2d at 800. Here, it is undisputed that the Works (a collection of stools, a chair, and a bed frame) are useful articles. It is also undisputed that each Work possesses a design feature that is separable from its function as a stool, chair, or bed frame.

Below, we list each Work, identify the design elements we have determined are separable from the Work's utilitarian function, and explain why we have concluded that the separable design features are not sufficiently creative to warrant registration.

***(1) Bayside Stool***

The *Bayside Stool* is a four-legged wooden stool with wooden arm rests and a wooden backrest. We agree with you that the design feature the Applicant has incorporated into the stool's backrest is separable from the Work's utilitarian function as a stool. We find, however, that this feature lacks the requisite creative "spark" for copyrightability.

The Work's design feature consists of two elongated "figure eight" shapes that overlap at the bottom to form a small oval. These two elements, considered individually, are no more than simple variations of the common "figure eight" shape. Thus, consistent with section 202.1(a), they are prohibited from registration. 37 C.F.R. § 202.1(a) (prohibiting registration of familiar symbols or designs). Likewise, the Applicant's selection and arrangement of these basic elements fail to meet the grade for registration. *Id.; see also Atari Games,* 888 F.2d at 883 (accepting that combinations of geometric shapes may be eligible for copyright protection; but, concluding that in order to be accepted for registration, such combinations must contain more than mere *de minimis* creative authorship). Viewed as a whole, the Applicant's Work consists of a simple overlapping of "figure eight" shapes. The level of creative authorship involved in this basic configuration is, at best, *de minimis*, and fails to meet the threshold for copyright registration. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883.

***(2) Bergamo Stool and Chair***

The *Bergamo Stool* is a four-legged wooden stool with a wooden backrest. The *Bergamo Chair* is a four-legged wooden chair with a wooden backrest. We agree with you that the metal design feature the Applicant has incorporated into the Works' backrests is separable from the Works' utilitarian functions. We find, however, that this feature lacks the requisite creative "spark" for copyrightability.

The Works' design feature consists of several intersecting, curved lines forming a standard, symmetrical curlicue scroll. The intersecting lines, considered individually, are simple shapes, prohibited from registration under section 202.1(a). Likewise, the Applicant's selection and arrangement of these basic elements fail to meet the grade for registration. *Id.; see also Atari Games,* 888 F.2d at 883. Viewed as a whole, the Applicant's Work consists of a standard, symmetric curlicue design. The level of creative authorship involved in this ordinary design is, at best, *de minimis*, and fails to meet the threshold for copyright registration. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883.

***(3) Riggler Stool***

The *Riggler Stool* is a four-legged wooden stool with a metal backrest. We agree with you that the design feature the Applicant has incorporated into the stool's backrest is separable from the Work's utilitarian function as a stool. We find, however, that this feature lacks the requisite creative "spark" for copyrightability.

The Work's design feature consists of two overlapping ovals placed inside a larger oval. Section 202.1(a) prohibits registration of the basic oval shape. The Applicant's selection and arrangement of these oval shapes also fails to meet the grade for registration. *Id.; see also Atari Games,* 888 F.2d at 883. Viewed as a whole, the Applicant's Work consists of a simple arrangement of three ovals. The level of creative authorship involved in this basic configuration is, at best, *de minimis*, and fails to meet the threshold for copyright registration. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883.

***(4) Trevilian Stool***

The *Trevilian Stool* is a four-legged metal stool with a metal backrest. The stool's backrest includes the same design feature as that incorporated into the *Bergamo Stool and Chair*. We agree with you that the design feature the Applicant has incorporated into the stool's backrest is separable from the Work's utilitarian function as a stool. However, for the reasons explained under the *Bergamo Stool and Chair* section (*section (3), supra*), we find the *Trevilian Stool* fails to meet the threshold for copyright registration.

***(5) Martino Bed***

The *Martino Bed* is a four-post bed frame. We agree with you that the design feature the Applicant has incorporated into the bed's head and foot frames are separable from the Work's utilitarian function as a bed frame. We find, however, that this feature lacks the requisite creative "spark" for copyrightability.

The Work's design feature consists of a scroll work curlicue design with a diamond at its center. The elements that comprise this feature, a standard diamond shape and ordinary curlicue scroll work, considered individually, are unprotectable variations of a common shape and design. 37 C.F.R. § 202.1(a). Thus, consistent with section 202.1(a), they are prohibited from registration. *Id.* Likewise, the Applicant's selection and arrangement of these basic elements fail to meet the grade for registration. *Id.; see also Atari Games,* 888 F.2d at 883. Viewed as a whole, the Applicant's Work consists of a simple, diamond-like shape bordered at each end by an ordinary curlicue design.

The level of creative authorship involved in this basic configuration is, at best, *de minimis*, and fails to meet the threshold for copyright registration. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883.

In sum, the Board finds that none of the Works include design elements that are both separable from the Works themselves and possess the requisite amount of copyrightable authorship, either individually or in their selection and arrangement, to warrant 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: *Bayside Stool, Bergamo Stool and Chair, Riggler Stool, Trevilian Stool,* and *Martino Bed.* This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

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Copyright Office Review Board