United States Copyright Office
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February 22, 2013

John C. McElwaine
Nelson Mullins Riley & Scarborough LLP
151 Meeting Street, Suite 600
Charleston, SC 29401

Charles G. Zug
Nelson Mullins Riley & Scarborough LLP
1320 Main Street, 17th Floor
Columbia, SC 29201

RE: Contemporary Design
Good Luck Design
Control No. 61-414-6360(N)

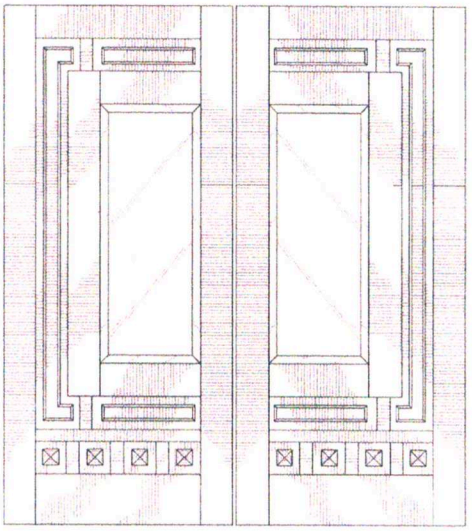
Dear Messrs. McElwaine and Zug:

I am writing on behalf of the Copyright Office Review Board (the "Board") in response to your letter dated August 29, 2008, requesting reconsideration of the Copyright Office's refusal to register two works on behalf of your client, JELD-WEN, Inc. We apologize for the long delay in resolving this case and providing you with the determination of the Board. The Board has carefully examined the applications, the deposits, and all correspondence in this case and affirms the denial of registration for the both the Good Luck Design and the Contemporary Design.

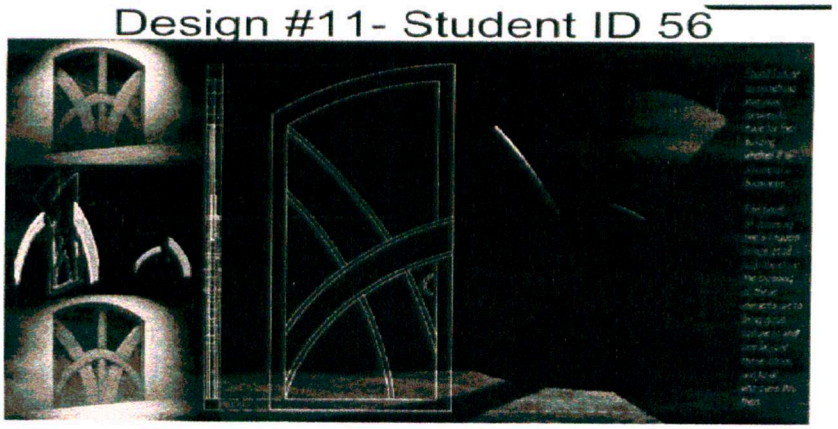
I. DESCRIPTION OF THE WORKS

"Contemporary Design" is a door design claimed on its registration form as a 3-dimensional sculptural work. The design is of a set of double doors made of dark wood, with a large vertically oriented rectangular glass panel on each door. Above and below each glass panel is a horizontally oriented rectangular panel surrounding a smaller, embossed rectangle. Between each glass panel and the outer edge of each door are bracket-shaped moldings within which are smaller embossed brackets. Toward the bottom of each door are a series of four squares, each containing a "pyramid-shaped protrusion . . . [rising] from the

front surface of the doors" Letter from John C. McElwaine and Charles G. Zug to the U.S. Copyright Office (Oct. 19, 2007) (hereinafter "Second Request"), at 5.



"Good Luck Design" is a door design claimed on its registration form as a 3-dimensional sculptural work. The design is of a set of double doors which together form an arch at the top. Each door has two linear moldings made of light-colored wood, one longer than the other. The shorter molding arcs from the lower outside corner to the middle inside edge of each door, so when the doors are closed these moldings appear to meet. The longer molding describes a more obtuse arc from the lower inside corner of each door to the upper outside corner. In addition, dark wood moldings border the entire outside edge of each door. The polygon created by each arced molding, the top edge molding, and inner edge molding of each door is made of frosted glass. Six triangular panels of the same dark wood as the border moldings are created by the intersection of the border moldings and the arced, linear moldings.



II. ADMINISTRATIVE RECORD

A. Initial Submissions and Refusal of the Office

On October 25, 2006, the Copyright Office ("Office") received two Form VA applications from your client JELD-WEN, Inc. JELD-WEN sought to register Contemporary Design and Good Luck Design as 3-dimensional sculptures. The applications indicated that the authors of Contemporary Design (Amanda Hardaway) and Good Luck Design (Brandi Berryman) had assigned all of their rights in the works to JELD-WEN. Mr. Mark C. Dukes of your firm was listed as JELD-WEN's agent for all three claims.

On December 5, 2006, Ms. Sandra D. Ware, an examiner for the Visual Arts Section of the Office, sent a letter to Mr. Dukes stating that the works deposited by JELD-WEN are useful articles and that, while they do contain conceptually separate features, those features are insufficiently creative to warrant copyright registration. Letter from Sandra Ware to Mark C. Dukes (Dec. 5, 2006) ("Ware letter"), at 1-2.

B. First Requests for Reconsideration

On April 4, 2007, the Office received two letters from David A. Harlow of your firm requesting that the Office reconsider its refusal to register JELD-WEN's Contemporary Design and Good Luck Design. Letter from David A. Harlow to the U.S. Copyright Office (Apr. 2, 2007). ("First Requests"). Each letter was accompanied by separate affidavits from Shane Meisel, JELD-WEN's Premium Doors Marketing Manager, and Elizabeth Souders, JELD-WEN's Public Relations and Promotions Manager. Also attached to the letters were the rules of JELD-WEN's door design contest (of which the two works here at issue were winners) and the design patent applications for each work.

The two letters from Mr. Harlow are identical in all aspects except for the names of the works. They argue that the works contain separable features that are copyrightable. Mr. Harlow began by citing Bleistein v. Donaldson Lithographing, 188 U.S. 239 (1903) and Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991) for the proposition that the threshold of originality required to obtain a copyright is extremely low. Id. at 2. He further argued that "it is well settled that a work may be protected by copyright law when its otherwise unprotectible elements are arranged in a unique way," citing as examples the protection of the arrangement of puppies in a photograph, Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992), and a greeting card's combination of card size, paper color, ink, border designs, stripes, ellipses, and single-sided format, Roulo v. Russ Berrie & Co., 886 F.2d 931 (7th Cir. 1989). Id. at 2-3.

Mr. Harlow maintained that the "original molding profile[s]" of the JELD-WEN designs "include several unique elements" that qualify the works for copyright registration, "such as, for example, proportion and scale of the elements, size of the framing components,

interaction of the elements to the other components of the door, and relationship of elements, as well as the angles created by the various elements in the design." Id. at 3.

Mr. Harlow concluded his letter by noting that both works have been granted design patents, and claims that the patentability standard of "novelty and nonobviousness" is more stringent than copyright's "lower standard of originality." He then claimed that if the patentability standard is met then, *a fortiori*, the copyrightability standard is met. Id. at 3-4.

The appended affidavits by Mr. Meisel made the same assertions for each work. Mr. Meisel explained that he is "familiar with door designs in general throughout the industry" and stated that the Contemporary and Good Luck Designs are both "different from all prior door designs in the industry" and are "original and creative ornamental door design[s]." Meisel Aff. at 1. Mr. Meisel also asserted that "market appeal," "creativity," and "uniqueness" were among the standards by which the Contemporary and Good Luck door designs were evaluated in a competition judged by "outside experts in design." Id. at 1. Ms. Souders's affidavits echo Mr. Meisel's assertions regarding the designs' originality and creativity and the criteria by which they were judged. Ms. Souders also noted that the Good Luck Design "went on to receive recognition in numerous publications . . . [and] was selected for inclusion in the 2007 Home & Garden Television Dream Home." Souders Aff. at 2.

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

On September 28, 2007, Ms. Virginia Giroux-Rollow, an attorney-advisor for the Copyright Office's examining division, wrote to Mr. Harlow affirming the initial denial of registration for Contemporary Design and Good Luck Design as 3-dimensional sculptures. Letter from Virginia Giroux-Rollow to David A. Harlow (Sept. 28, 2007) ("Giroux-Rollow letter"), at 1. Ms. Giroux-Rollow found that, while both designs are conceptually separable from the useful articles that they ornament, they are insufficiently creative to meet the copyrightability standard. Id. at 2.

Ms. Giroux-Rollow began by contesting Mr. Harlow's assertion that copyright protection should necessarily follow from patent protection. She argued that "the standards for patentability and copyrightability are mutually exclusive and quite different from each other. Also uniqueness may be applicable to patent protection, but not copyright." Id. at 1.

Regarding the question of useful articles, Ms. Giroux-Rollow noted that section 101 of the Copyright Act defines a "useful article" as 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 normally part of a useful article is considered a useful article." Id., citing 17 U.S.C. § 101. She added that the Act further provides that the "design of a useful article shall be considered a pictorial, graphic, or sculptural work only if and 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.

Ms. Giroux-Rollow described the process the Copyright Office follows when faced with a claim for the registration of a useful article. First, are there any elements of authorship that are physically or conceptually separable from the useful article itself? Second, if separable, do these elements meet the minimum requirements of originality and creativity required for registration? Copyright examiners, Ms. Giroux-Rollow noted, "do not make aesthetic judgments; nor are they influenced in any way by the attractiveness of a design, its uniqueness, its visual effect or appearance, the time, effort and expense it took to create, or its commercial success in the marketplace during the examining process." Id. at 2.

Ms. Giroux-Rollow stated that your letter does not dispute the fact that the works JELD-WEN seeks to register as 3-dimensional sculptures – namely, doors – are useful articles. Instead, she noted that your argument in favor of registration is that these works contain non-functional sculptural elements based on the designer's aesthetic judgment rather than utilitarian concerns and, as such, contain conceptually separable authorship that is automatically copyrightable. Id. at 2.

The Copyright Office's test for conceptual separability, Ms. Giroux-Rollow explained, is enunciated in Compendium II, Copyright Office Practices (1984) (hereinafter "Compendium II") § 505.03 which follows generally the separability principle set forth in Esquire v. Ringer, 591 F.2d 796 (D.C. Cir. 1978). The Compendium II states 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 its basic shape. Id.

Ms. Giroux-Rollow further explained that the test for conceptual separability, however, is not met by merely analogizing the general shape of an article to works of modern sculpture since in this case, the alleged "artistic or decorative" features and the useful articles cannot be perceived as existing separately. She stated that the Copyright Office cannot register features that are an integral part of the overall shape or contour of a useful article even when the features are non-functional or could have been designed differently. Id., citing Esquire, 591 F.2d at 800 (upholding the Copyright Office's refusal to register an outdoor lighting fixture on the grounds that copyright protection was not possible based on the "overall shape or configuration of a utilitarian article no matter how aesthetically pleasing that shape or configuration might be."). She commented that the 1976 Copyright Act codified this practice of not registering claims to copyright in the overall shape or form of articles that have a utilitarian function. She stated that the only possible basis for a registration of a useful article is whatever aspect of the useful article that can be viewed as separable and that is also copyrightable as a "work of art."[1] Giroux-Rollow letter at 2. Supporting this view, she argued, is Norris Industries, Inc. v. International Telephone

[1] Ms. Giroux-Rollow's phrase "work of art" is synonymous with the statutory subject of copyright protection "work of authorship," and should not be interpreted as a separate category of works.

& Telephone Corp., 696 F.2d 918 (11th Cir. 1983), which held that a wire-spoked wheel cover was not copyrightable because it was a useful article that did not contain any sculptural design that could be identified apart from the wheel cover itself.

Ms. Giroux-Rollow found that there are elements on the surface of the door designs that are conceptually separable from the utilitarian aspects of the works. However, she did not believe that these elements or features, as a whole, constitute copyrightable sculptural works of art. Giroux-Rollow letter at 2.

Ms. Giroux-Rollow explained that to be regarded as copyrightable, a work must not only be original and independently created by the author, but it must also "possess more than a *de minimis* quantum of creativity." Giroux-Rollow letter at 3 (citing Feist, 499 U.S. 340). In the case of a design, a certain minimum amount of pictorial or sculptural expression in the work must have originated with the author. She commented that originality, as interpreted by the courts, means that the authorship must constitute more than trivial variation or arrangement of public domain, pre-existing, or non-copyrightable elements. Id., citing Alfred Bell v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951).

Ms. Giroux-Rollow then went on to describe each separable design in detail. She stated that the separable elements of Contemporary Design are "a series of identical squares within squares with an 'X' inscribed in each square positioned horizontally along the bottom surface of both the single and double doors. The inner portions of the doors contain rectangle shaped pieces which serve as a border." Id. She stated that the separable elements of Good Luck Design are two thick curved lines that intersect, with one longer than the other. The shorter curved line starts at the lower left of the door and terminates at the right center. The longer curved line starts at the low right and terminates at the upper left. The lines on the double door mirror each other and are symmetric to those on the single door. Id.

Ms. Giroux-Rollow asserted that "curved or diagonal lines, no matter what their thickness, as well as squares, rectangles, and 'X' shapes, or any minor variation thereof, are common and familiar geometric shapes, in the public domain and are, therefore, not copyrightable." Id. at 3, citing 37 C.F.R. § 202.1. She concluded that the artistic or sculptural authorship on the surface of the JELD-WEN designs does not reflect sufficient originality and creativity to support a copyright registration as a copyrightable "work of art." She added that the combination and arrangement of the shapes on the surface of each work did not rise to the level of authorship necessary to support a copyright registration. The resulting designs, she argued, possess only a *de minimis* level of creativity. Id., citing Compendium II §§ 503.02(a) and (b).

In support of the general soundness and applicability of Compendium II registration principles, Ms. Giroux-Rollow cited a number of cases: John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986) (upholding a refusal to register a logo design consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below); Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y.

1950) (finding that a label with the words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lis is not copyrightable); Homer Laughlin China Co. v. Oman, 22 U.S.P.Q.2d 1074 (D.D.C. 1991) (upholding a refusal to register a chinaware "gothic" design pattern composed of simple variations and combinations of geometric designs); and Jon Woods Fashion, Inc. v. Curran, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988) (upholding a refusal to register a fabric design consisting of a striped cloth with small grid squares superimposed on the stripes). Id. at 3.

Ms. Giroux-Rollow noted that even a slight amount of creativity will suffice to obtain copyright protection and that the vast majority of works make the grade easily if they possess some creative spark. Id. at 4. She further noted that the Copyright Office regards Feist as the articulation from the Supreme Court that the requisite level of creativity is very low; even a slight amount of original authorship will suffice. Id. She pointed out, however, that the treatise *Nimmer on Copyright* § 2.01(b) states that "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." Id.

In addition, Ms. Giroux-Rollow stated that the fact that the creation of the JELD-WEN designs required choices to be made among many shapes, sizes, and configurations does not mean that the final works are copyrightable. Id.

Before concluding, Ms. Giroux-Rollow returned to the issue of useful articles. She offered an extended quotation from the legislative history of the Copyright Act of 1976, which explains that copyright protection is not to be offered to useful articles, regardless of any aesthetic considerations that went into their creation. Id., citing H.R. REP. 94-1476 at 55 (1976) (the "Report"). She emphasized the Report's statement that even if a 3-dimensional design contains a separable element, "copyright protection would extend only to that element and would not cover the overall configuration of the utilitarian article as such. Id. at 4-5.

Ms. Giroux-Rollow concluded her letter with the determination that because all of the elements embodied in these works are **either related to** the utilitarian aspects or function of the works, **or, if separable**, do not contain a sufficient amount of original and creative authorship, **or are subsumed within** the overall shape, contour, and configuration of the works themselves, there is no authorship that is **both** separable **and** copyrightable. Id. at 5.

D. Second Request for Reconsideration

On October 19, 2007, you filed a second request for reconsideration on behalf of JELD-WEN. You began by agreeing with the Copyright Office's prior determination that Contemporary Design and Good Luck Design are useful articles, and by noting that the Office has "conceded" that these articles contain separable elements. Letter from John C. McElwaine and Charles G. Zug to the U.S. Copyright Office (Oct. 19, 2007) (hereinafter

"Second Request"), at 1-2. Your argument was that these separable elements are sufficiently original and creative to be copyrightable. Id. at 2.

You attached to your letter additional photographs and drawings of the works at issue, with the stated intent of better enabling the Copyright Office and the public "to determine the nature of copyright protection being sought by Applicant." Id. You also stated that the additional depictions of the Contemporary Design will serve to alleviate any confusion that might have arisen because of Mr. Harlow's claim that the depictions of the work in its copyright registration claim and design patent application were identical, when in fact there were several slight differences between the two. Id. at 2-3.

You began your legal argument by stating that the Compendium II test for separability should guide the Office's determination. You then cited to Brandir International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2nd Cir. 1987) for the proposition that conceptually separability depends upon whether "artistic judgment [was] exercised independently of functional influences." Id. at 3, quoting Brandir, 843 F.2d at 1145.

You stated that the starting point for a separability analysis is to "examine the functional aspects of the two works in question." Since the works are 3-dimensional designs for double doors, you looked to the functional aspects of a door and determined that "in order for a door to function it must consist of (a) a movable structure that is (b) used to close off an opening or entrance." Id. at 4, citing to Webster's II New College Dictionary (Houghton Mifflin Co. 1999). You then claimed that the separable elements contained in the Contemporary and Good Luck Designs are "unrelated to and separate from the doors' function." Id. at 4.

You quoted Ms. Giroux-Rollow's description of the separable elements of the Good Luck Design, and noted that the curved lines she described are actually 3-dimensional and vary in width. Id. You went on to describe a number of additional separable elements. Specifically, you noted 3-dimensional molding elements along all four edges of each door and the three and four-sided shapes created by the intersection of the various molding elements. You also noted that the four-sided shapes consist of frosted glass. Id. You argued that these various elements are separable under the Compendium II test because they can be visualized on paper and can exist separately from the doors without destroying the doors' basic shape. Id. at 5, citing Compendium II § 505.03.

You quoted from Ms. Giroux-Rollow's description of the separable elements of the Contemporary Design and in addition noted (1) that the "X" figures she described are actually pyramid-shaped 3-dimensional protrusions, and (2) that the "rectangle shaped pieces" she described are actually sculptural features containing 3-dimensional molding elements. Id. at 5-6.

You cited to Feist for the requirement that copyrightable works must be both independently created (*i.e.*, original) and sufficiently creative. Id. at 6, citing Feist, 499 U.S. at 345. The originality of the Contemporary and Good Luck Designs has not been disputed, you noted, and so you focused your argument on their creativity. Id.

First, you maintained that the affidavits by JELD-WEN employees submitted with the First Request provide evidence that the works at issue contain more than the "slight amount" of creativity prescribed by Feist, id. at 6-7, citing Feist, 499 U.S. at 345, evidence that you claimed Ms. Giroux-Rollow did not specifically address. You cited to the Meisel affidavit's statement that both designs are "original and creative." Id. at 6. You cited to the Souders affidavit's statement that both designs won a door design contest in which one of the judging factors was "creativity." Id. The Souders affidavit also states, you pointed out, that the Good Luck Design was featured in numerous publications and selected for inclusion in the 2007 Home & Garden Television Dream Home. Id. at 6-7.

Second, you maintained that, contrary to Ms. Giroux-Rollow's letter, the separable shapes and designs in the JELD-WEN designs are not merely common and familiar elements undeserving of copyright protection. You also argued that even if the individual elements do not meet the standard of creativity, the "overall artistic and creative compilation and arrangement" of the elements does. Id. at 7. For this argument you marshaled support from case law finding that the unique combination of common elements such as paper color, ink, border designs, and stripes to form a greeting card is copyrightable (Roulo, 886 F.2d at 939); that the distinctive arrangement of ordinary lines, typefaces, and colors in a magazine cover is copyrightable (Reader's Digest Assoc. v. Conservative Digest, Inc., 821 F.2d 800, 806 (D.C. Cir. 1987)); that a masthead consisting of a logo, two advertising boxes, and a grey line was conceivably copyrightable (Hamdad Trust v. Ajit Newspaper Advertising, Marketing & Communications, Inc., 503 F. Supp. 2d 577, 589 (E.D.N.Y. 2007)); that a menu design consisting in part of uncopyrightable photographs of food was copyrightable (Oriental Art Printing Corp. v. Goldstar Printing Corp., 175 F. Supp. 2d 542, 548 (S.D.N.Y. 2001)); and that the combination and arrangement of color in a color matching system was copyrightable (Pantone, Inc. v. A.I. Friedman, Inc., 294 F. Supp. 545, 547-48 (S.D.N.Y. 1968)). Id. at 7-8.

Regarding the Good Luck Design, you argued that it is the "overall arrangement and selection" of the separable elements that satisfy the creativity requirement. Id. at 8. Regarding the Contemporary Design you located creativity in the "selection, placement, sizing, and proportion" of the separable elements. Id. You also pointed out the "creative design choices" made by both designers and the "angles and scale created by the interaction of the various elements within each design" as further factors militating in favor of copyrightability. You cautioned against evaluating the designs based solely upon their component parts, stating that "it is the selection, placement, sizing, layout, interplay, and other factors which constitute artistic creation." Id. at 9, citing Diamond Direct, LLC v. Star Diamond Group, Inc., 116 F. Supp. 2d 525, 528 (S.D.N.Y. 2000). The Contemporary and

Good Luck Designs, you concluded, are sufficiently "unique and original" in deploying these factors to warrant copyright registration. Id. at 9.

You asserted that the cases cited by Ms. Giroux-Rollow in support of her contention that a *de minimis* level of creativity in selection and arrangement of common elements – such as those found in JELD-WEN's designs – does not meet the Compendium II standard of copyrightability are distinguishable because the designs in those cases were far less original than JELD-WEN's. Id. You noted that, in contrast to the single uncopyrightable word and four simple lines that make up the logo at issue in John Muller & Co, JELD-WEN's designs contain multiple 3-dimensional components and variations in scale and proportion. Id. at 9-10. Similarly, you pointed out that the label at issue in Forstmann Woolen Co. consists only of a 2-dimensional label containing a short phrase and three identical fleurs-de-lis. Id. You stated that the design litigated in Jon Woods Fashions, Inc., consisting as it did of a grid of small squares superimposed over stripes cannot fairly be compared with JELD-WEN's designs, which contain many more elements, arranged in a unique and not grid-like manner. Id. Finally, you distinguished the china pattern in Homer Laughlin China Co. as a simple geometric design. Id. at 11. "There is simply no support . . . as a matter of law," you claimed, for Ms. Giroux-Rollow to base her refusal of registration on a comparison of the creativity evidenced in JELD-WEN's works with that of the New York arrows logo, the Forstmann logo, or the other examples discussed above. Id.

Instead, you provided an alternative set of cases in order to demonstrate that "the unique, aesthetically pleasing and distinct arrangement of the artistic elements" in the JELD-WEN designs contain a sufficient "spark" of creativity to support copyright registration. Id. at 11-12. This spark, you implied, comes from the door designs' selection and combination of simple shapes with some ingenuity. Id. at 12, citing Atari Games v. Oman (Atari I), 888 F.2d 878, 883-4 (D.C. Cir. 1989). To support this assertion you cited to Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc., 490 F.2d 1092, 1094 (2d Cir. 1974) (finding that a fabric design consisting of a strip of crescents with scalloping or ribbons and rows of semicircles is copyrightable); Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279, 282 (5th Cir. 1970) (finding that a filigree pattern of intercepting straight and arced lines is copyrightable); Concord Fabrics, Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315, 1316 (2d Cir. 1969) (finding that a fabric design of a circle within a square within a circle is copyrightable); and In Design v. Lynch Knitting Mills, Inc., 689 F. Supp., 176, 178-79 (S.D.N.Y. 1988) (finding that a rhomboid design on a sweater is copyrightable). Id. at 12.

Third, you asserted that because JELD-WEN's designs have met the patent registration criteria of novelty and nonobviousness they should also meet the "much lower" originality standard for copyright registration. Id. at 13, citing Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951) and Tonka Corp. v. Tsaisun, Inc., 1 U.S.P.Q.2d 1387 (D. Minn. 1986) for the proposition that copyright registration standards are lower than patent registration standards.

III. DECISION

After reviewing the materials presented to us and the arguments in favor of registering JELD-WEN's door designs, the Board upholds the Examining Division's decision to refuse registration of the Contemporary and Good Luck Designs. The Board agrees with you and with the Examining Division that both works constitute useful articles. The Board also finds that both works contain separable features, although this finding does not encompass every design element described in your submissions. Finally, however, the Board has determined that in neither case do the separable elements contain a sufficient amount of original and creative authorship upon which to support copyright registration.

A. Useful articles and Separability

1. Legal Framework

A useful article is defined as 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. An article that is normally a part of a useful article is also considered a "useful article" in itself. Id. Copyright protection can be extended to the design of a useful article "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. (defining a "pictorial, graphic, and sculptural works").

Only elements or features that are physically or conceptually separable from the utilitarian purpose of a useful article may be copyrighted. A separability analysis ensures that the utilitarian aspects of useful articles are not registered. Section 505.02 of Compendium II provides written guidelines for this separability analysis:

> 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.

These guidelines are based on Congress's clarification in the legislative history of the Copyright Act of 1976 that utilitarian aspects of useful articles are not copyrightable:

> [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 an . . . 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 (1976).

Physical separability means that the subject's pictorial, graphic, or sculptural features must be able to be separated from the useful article by ordinary means. Compendium II § 505.04.

> In the case of conceptual separability, Compendium II § 505.03, states: 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 features can be imagined separately and independently from the useful article without destroying the basic shape of the 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. Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration. The test of conceptual separability, however, is not met by merely analogizing the general shape of a useful article to works of modern sculpture, since the alleged "artistic features" and the useful article cannot be perceived as having separate, independent existences. The shape of the alleged "artistic features" and of the useful article are one and the same, or differ in minor ways; any differences are de minimis. The mere fact that certain features are nonfunctional or could have been designed differently is irrelevant under the statutory definition of pictorial, graphic, and sculptural works.

Compendium II § 505.04

As explained in Esquire, 591 F.2d at 800, copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be." In Esquire, the Office had refused to register an outdoor lighting fixture which arguably contained non-functional, purely aesthetic features. The court upheld the Office's refusal, noting that "Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products." Id.2 Similarly in Norris, 696 F.2d at 924, the court held that a wire-spoked wheel cover was not entitled to copyright protection because it was a useful article used to protect lug nuts, brakes, wheels and axles from damage and corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself.

Section 505 of Compendium II, as quoted above, is a direct successor to the Copyright Office regulation that was affirmed in Esquire. The Office relies on the authority of Esquire for the analysis it follows to determine whether pictorial, graphic or sculptural works are separable from the utilitarian objects in which they are incorporated. The Compendium II test is also based on the legislative history of the "useful articles" definition, quoted above. We call your attention in particular to this passage: "[E]ven 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 (1976).

The validity of the Office's use of the Compendium II test was confirmed in an action against the Copyright Office in Custom Chrome, Inc. v. Ringer, 1995 U.S. Dist. LEXIS 9249, 35 U.S.P.Q.2d (BNA) 1714 (D.D.C. June 30, 1995). Custom Chrome was an action brought under the Administrative Procedure Act ("APA"), 5 U.S.C. §§ 701-706, based on an assertion that the Copyright Office's action refusing registration for twenty-three motorcycle parts was arbitrary and not in accord with the law. Custom Chrome, 1995 U.S. Dist. LEXIS 9249 at *1. The District Court for the District of Columbia held that the Office's determination, under the Office's Compendium II separability test, that the motorcycle parts did not contain separable features, was reasonable and consistent with the copyright statute and with "declared legislative intent." Id. at *12.

Because Custom Chrome was an APA action, the court did not determine which of the several separability tests available from legal scholars and from case law was the correct one. The court simply stated that ". . . so long as the Copyright Office has offered a reasonable construction of the copyright statute, its judgment must be affirmed even if this court were to accept Custom Chrome's assertions that the duality test would support its copyright claims." Id., at *15.

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[2] Although Esquire was decided under the 1909 version of the Copyright Act, its reasoning is, nevertheless, applicable to cases arising under the 1976 Act. "[T]he 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.

We point out Custom Chrome to emphasize that Compendium II's separability test, centering on the general shape of the useful article, is consistent with "later cases decided under the present law and the legislative history," id. at *16, in denying protection to the shape of an industrial product even though it may be aesthetically pleasing.

You began the separability discussion in your Second Request by stating that Compendium II "sets forth the analysis that should be applied by the Copyright Office to determine whether certain features of a work are capable of existing independently of the utilitarian aspects of an article." Second Request at 3. In the next sentence you stated that "the finder of fact" must determine conceptual separability by inquiring whether the "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences," the test set forth in Brandir, 834 F.2d at 1145. Although the Board disagrees with your reliance on Brandir, we will, nevertheless, analyze the works at issue here under both the Esquire and Compendium II test and the alternative test proffered by Brandir. Under either test, the JELD-WEN works exhibit separable features.

2. Applying the Compendium II Test

a. The useful articles at issue

The statutory definition of a useful article states that "an article having an intrinsic utilitarian function that is not merely to portray the appearance of an article is considered a "useful article. [And that] [a]n article that is normally a part of a useful article is considered a 'useful article .'" 17 U.S.C. § 101. Based on that definition, the legislative history and evidence in the application, the Board concluded that the works, Contemporary Design and Good Luck Design, are designs of doors, which are useful articles. The Applicant does not dispute this characterization of the work. Because the works are useful articles, the Board next examined the works to determine whether either included any separable elements.

b. Physical separability

You do not claim that the artistic features of the door designs are physically separable from the other aspects of the doors. Indeed, physical separability would appear to be a moot point in this inquiry because the door design elements are not detachable by ordinary means, the hallmark of a physically separable element. Compendium II § 505.03. Although you seek to register the JELD-WEN designs as 3-dimensional sculptural works, the design elements are not physically distinct from the doors themselves. Rather, they are design elements of the doors. Having to divide an otherwise solid door with a specialized device, such as a band saw, would not be within the scope of detachment by ordinary means, because to do so would destroy the work.

c. Conceptual separability

The Board finds that certain artistic elements of the JELD-WEN works are conceptually separable from the overall shape of the doors themselves because they are capable of being "imagined separately and independently from the useful article without destroying the basic shape of the useful article," Compendium II § 505.03, and could "exist side by side" with the useful article "and be perceived as [a] fully realized, separate work." Id. We will discuss the conceptual separability of the artistic elements of the Good Luck Design first, followed by the Contemporary Design.

As is its standard practice, the Board examined the Good Luck Design with an eye towards finding registerable elements. Doing so in this case meant analyzing the separability of only select aspects of the design, as opposed to analyzing the overall work. Were the Compendium II test to be applied to the overall Good Luck Design, the conclusion would be that the artistic elements were not conceptually separable from the useful article. Your letter cites the artistic elements as being the two curved lines as described in Ms. Giroux-Rollow's letter, along with "straight vertical and horizontal three-dimensional molding elements along the left, right, and bottom edges," "a linear molding element that arches upwards from the outer to the inner side of each door," and "2 four-sided polygons in the upper central corners which consist of frosted glass." Second Request at 4. Reading this description against the photographs and drawings attached to the letter, it appears that every element of the Good Luck Design is "artistic." Given this state of affairs, the Board cannot imagine the artistic elements of the design as described having a separate existence as a free-standing sculpture, as this sculpture would in fact be the door itself.

Indeed, protection for such a design, where a useful article is inextricably bound up with its artistic conception, is properly the domain of design patents, which both the Good Luck and the Contemporary Designs received. Design patents "are subject to examination under the novelty and nonobviousness standards," Second Request at 12, but the success of the JELD-WEN works in meeting these standards does not mean that they also meet the copyright standards for useful articles of conceptual (or physical) separability and creative authorship. Patent and copyright, while they share a Constitutional origin, have developed separate and distinct legal regimes, where protection under one does not lead to, nor may even be probative of, protection under the other. In the case of the Good Luck Design, while the entire work is eligible for design patent protection, its status as a useful article precludes copyright protection. However, if we examine only those artistic elements that do not make up the "basic shape" of the door in question, a stronger argument for conceptual separability can be made.

Specifically, if one excludes the "straight vertical and horizontal three-dimensional molding elements along the left, right, and bottom edges," the polygon-shaped frosted glass panes, and the six triangular-shaped wood panels (e.g., those elements that outline the basic shape of the door), one is left with a design that it is quite easy to conceptualize as a fully realized, separate work. The Board thus finds that the artistic elements of the Good Luck

Design – the two curved lines arching from the outer to the inner edge of each door and the linear molding elements that arch upwards from the inner to the outer edge of each door – taken as a single arrangement, are conceptually separable from the useful work itself.

Regarding the Contemporary Design, your Second Request did not make an argument for the conceptual separability of its artistic elements beyond a more detailed description of certain of the molding elements, but neither did it claim "artistic" – and hence separable – status for every element of the work. Like the Good Luck Design, the Contemporary Design was sought to be registered as a 3-dimensional sculpture, meaning that for its artistic elements to be conceptually separable they would have to able to be imagined "separately and independently" as a free-standing sculpture, with the door itself maintaining its integrity as a useful article.

The Board finds that because the artistic elements (moldings of various sizes and shapes) of the Contemporary Design are not integral to the overall shape and design of the door itself; they can be conceptualized as a separate sculpture by themselves, with the basic shape of the door remaining intact. Thus, like the Good Luck Design, elements of the Contemporary Design is conceptually separable into potentially copyrightable artistic elements on one hand and the basic shape of a useful door on the other.

3. Applying the Brandir Test

Having analyzed the JELD-WEN works under the provisions of Compendium II's test for separability and found that both works contain conceptually separable features, we now turn to the Brandir separability test that you briefly cited. Judging a creator's intent, given the factual circumstances of creation, and determining whether design elements in a particular work reflect "the designer's artistic judgment exercised independently of functional influences," Brandir, 834 F.2d at 1145, is not the type of judgment the Office normally undertakes in its examining process. Such judgments would necessarily rely on interpreting the specific actions surrounding the creation of a work; these actions occur outside the registration process. Any investigation and questioning of the method and circumstances of creation lie beyond the administrative capability of the Office. See, e.g., Compendium II § 108.05. Thus, the Office uses as its tests for separability those adopted in Esquire and found in Compendium II in carrying out its statutory mandate (described in 17 U.S.C. § 410) to examine works submitted for registration under the copyright law. However, judicial acceptance of the Brandir test leads us, as we have mentioned, to analyze the JELD-WEN works under that test in order to determine as objectively as possible whether those works indeed, include any separable features which might be subject to copyright registration.

The flip side of Brandir's "artistic judgment" test is that "if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements." Brandir, 834 F2d. at 1145. The work at issue in Brandir, a bicycle rack made of bent tubing, said to be inspired by a

wire sculpture, was found to not have separable artistic elements, and was thus not copyrightable. The court ruled that "while the RIBBON Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices." Id. at 1147. The evidence regarding the creation of the rack at issue showed that "the designer has clearly adapted the original aesthetic elements to accommodate and further a utilitarian purpose." Id.

Applying Brandir to the JELD-WEN works here at issue, the Board first faces the substantial hurdle of having no evidence regarding the gestation of the artistic elements of the door designs, nor evidence of whether these elements were originally designed for doors, whether they were adapted for use with doors, and, if the answer to the last question is yes, what functional considerations, if any, were brought to bear on that adaptation. Given the centrality of such evidence to a Brandir inquiry, the Board finds itself unable to determine whether the JELD-WEN works would in fact meet this standard of conceptual separability. This does not vitiate our determination above that under the Compendium II test, both the Contemporary and the Good Luck Designs contain separable, copyrightable elements.

B. Requirements for originality and creativity

The Board's decision that the JELD-WEN designs are useful articles with separable creative elements does not determine whether they are registerable; the separable elements must also contain a sufficient amount of creative authorship. We find that the separable elements of the Good Luch Design and the Contemporary Design do not display such creativity, and thus these designs ultimately fall short of copyrightability.

1. Legal Standard: Creativity and Originality

The first step in determining the copyrightability of a work is establishing that it was independently created by the author and not copied from another work. The Office accepts that the JELD-WEN works were independently created by Amanda Hardaway and Brandi Berryman, who then assigned their rights to JELD-WEN. Form VA Applications, 2006. Therefore, the first prong of originality is not at issue here.

In determining whether a work has a sufficient amount of creative authorship necessary to sustain a copyright claim the Board adheres to the standard set forth in Feist, 499 U.S. at 345, where the Supreme Court held that only a modicum of creativity is necessary to support copyrightability. However, the Feist court also held that some works – such as a "white pages" telephone directory – fail to meet even this low standard. The court observed that "as 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, 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 362.

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 sculptural works, the Compendium II states that "registration cannot be based upon standard designs which lack originality, such as common architecture moldings." Compendium II § 503.02(b). It is the presence of creative expression that determines the copyrightability of a work, according to the Compendium II, which notes that such expression "must consist of something more than the mere bringing together of two or three standard forms or shapes 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.").

Caselaw confirms these principles, as illustrated by the John Muller & Co., Forstmann Woolen Co., Homer Laughlin China Co., and Jon Woods Fashions cases cited by Ms. Giroux-Rollow. These cases, contrary to your assertions, were not cited for the proposition that the works they discuss are of a comparable or higher level of creativity than the JELD-WEN works. Second Request at 11. They merely illustrate the application of the Compendium II creativity principles to works that consist solely or primarily of the combination of uncopyrightable geometric and design elements.

2. Creativity of the JELD-WEN Works

To begin with, the affidavits offered regarding the originality and creativity of the JELD-WEN works are not relevant in determining their copyrightability. "Creativity" in copyright law is a term of art, and the statement by door industry professionals regarding the creativity of a design are not probative as to its creativity in a legal sense. In addition, the Compendium II states that copyrightable authorship "does not depend upon the aesthetic merit, commercial appeal, or symbolic value of a work." Compendium II § 503.02(b).

It has been a long-standing principle of copyright law that the use of public domain elements and/or commonly known shapes can result in a copyrightable work as long as the overall resulting design or overall pattern, taken in its entirety, constitutes more than a trivial variation of such elements. See, e.g., Alfred Bell & Co., 191 F.2d at 103; Atari Games Corp. v. Oman (Atari II), 979 F.2d at 244-245; Compendium II, § 503.02(a). The Board applies this standard by examining a work to determine whether it contains elements, either alone or taken as a whole, on which a copyright can be based.

Works based on public domain elements may be copyrightable if there is an element in their selection, arrangement, or modification that reflects choice and authorial discretion and that is not so obvious or so minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." Feist, 499 U.S. at 359. This principle underlying the selection and arrangement of public domain elements does not, of course, mean that all combinations of commonplace, simple, or unprotected-in-themselves elements will rise to the level of copyrightable authorship. For example, in Satava v. Lowry, the Ninth Circuit held unprotectible sculptural arrangements in the shape of jellyfish that combined elements not

copyrightable in themselves. 323 F.3d 805 (9th Cir. 2003). The Satava court explained 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." Id. at 811.

The separable elements of the Good Luck Design, consisting of four gently curved wood moldings, display an insufficient quantum of creative authorship under the standards described above. Unlike the jellyfish sculptures at issue in Satava, the final arrangement of separable elements in the Good Luck Design does not mimic nature; however, this arrangement, consisting as it does of merely four arcs, is not an original, design containing the requisite "creative spark" such that it meets the Feist standard. And while, unlike the molding elements on the Contemporary design, the Good Luck Design artistic elements, as arranged, do not appear to be idiomatic to doors or to architecture in general, their basic arrangement and lack of any identifiable creativity places them below the de minimis bar of authorship required for copyright registration.

On examining the Contemporary Design, the Board finds that it consists of square, rectangle, and bracket-shaped moldings, rectangular windows, and pyramid-shaped protrusions, arranged without any particular originality, particularly given the functional constraints imposed by their placement on a double door. In our view, such combinations of public domain elements fail to rise to the level of creativity required to support a copyright registrations. As stated in the Compendium II § 503.02(a), "it is not possible to copyright . . . a simple combination of a few standards symbols such as a circle, a star, and a triangle with minor linear or spatial variations." In addition, the Board finds these artistic elements to be "common architectural moldings," upon which copyrightable authorship cannot be based according to Compendium II § 503.02(b).

Regarding the case law you marshaled in support of the copyrightability of the Contemporary Design, the Board does not find these citations with parenthetical descriptions helpful, in part because that is all they consist of, lacking any analysis of why the reasoning used by the various courts is applicable to the present question. Second Request at 11-12. In addition, most of the works in the cited cases are not the copyrightable elements of useful articles, but self-contained decorative design works, and thus their copyrightability is of limited value in assessing the copyrightability of the works here in question. The work at issue in the remaining case, Atari I, 898 F.2d 878, while not considered a "useful article," is at least closer in nature to that class of works in that its artistic elements are designed to serve another purpose (video game play) and not for their own sake. This work, the Board finds, exhibited a far more original and creative arrangement of unprotectible elements than does the Contemporary Design, with the game screens in question consisting not only of static shapes, but also sound, color, and motion. Id. at 879.

IV. CONCLUSION

For the reasons stated above, the Copyright Office Review Board concludes that neither the Good Luck Design nor the Contemporary Design may be registered for copyright protection. This decision constitutes final agency action.

Sincerely,

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