United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

September 11, 2013

Kagan Binder, PLLC
Attn: Mara E. DeBoe
221 Main Street North, Suite 200
Stillwater, Minnesota 55082

Re: Cosmetic Container Nozzle
Correspondence ID: 1-DJ4IED

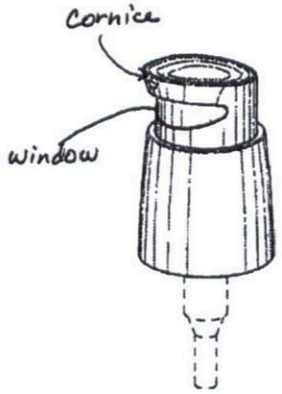
Dear Ms. DeBoe:

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: *Cosmetic Container Nozzle*. You submitted this request on behalf of your client, DB Design GmbH, on December 3, 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

Cosmetic Container Nozzle (the "Work") is a cylindrical spray nozzle. Its design features include an extended top portion that forms a small cornice and an oval-shaped "window" that is located just below the cornice. The nozzle's spray outlet is located near the tip of the cornice. The below image is a photographic reproduction of the Work from the deposit materials:



II. ADMINISTRATIVE RECORD

On March 14, 2012, the United States Copyright Office (the "Office") issued a letter notifying DB Design GmbH (the "Applicant") that it had refused registration of the above mentioned Work. *Letter from Registration Specialist, Adrienne Brown, to Mara DeBoe* (March 14, 2012). In its letter, the Office stated that it could not register the Work because it is a "useful article" which does not contain any separable authorship needed to sustain a claim to copyright. *Id.*

In a letter dated May 9, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from Mara DeBoe to Copyright RAC Division* (May 9, 2012) ("First Request"). Upon reviewing the Work in light of the points raised in your letter, the Office again concluded that the Work was a useful article that lacks separable, copyrightable authorship and refused registration. *Letter from Attorney-Advisor, Stephanie Mason, to Mara DeBoe* (September 4, 2012).

Finally, in a letter dated December 3, 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 Mara DeBoe to Copyright R&P Division* (December 3, 2012) ("Second Request"). In arguing that the Office improperly refused registration, you claim the Work includes elements that are both separable from its utilitarian function as a spray nozzle; and, that those separable elements possess at least the minimum amount of creativity required to support registration. *Id.* at 1-3. Specifically, you assert that the Work's "decorative inset window" and "overhanging cornice" are nonfunctional, decorative features that "can be identified separately from the nozzle and that can be physically removed without affecting the nozzle's functionality." *Id.* at 3. You further allege that these two elements create the "feeling" that "[t]o some . . . may be of overlooking a wide vista, or of a cave hidden below an overhan[g]." *Id.* at 3.

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 (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. 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., Inc. v. NY Arrows Soccer Team, Inc. et. al.*, 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 *Cosmetic Container Nozzle* is a useful article that does not possess design elements that are *both* separable from the Work's utilitarian functions and sufficiently creative to support a claim to copyright. Accordingly, we affirm the Registration Program's decision to deny 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). 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 Work (a spray nozzle design) is a useful article. For the purposes of the Board's analysis, it is also undisputed that two of the Work's design features (an oval-shaped window and an overhanging cornice) are separable from its function as a fluid-dispensing spray nozzle. However, the Board finds that neither of these two features possesses the requisite amount of creative authorship to warrant copyright registration.

As noted, 37 C.F.R. § 202.1(a), identifies certain elements that are not copyrightable. These elements include, among others, "familiar symbols or designs." *Id.* Here, the Work's only separable features include: (1) an ordinary, oval-shaped gap or "window" that is cut out of the nozzle; and, (2) a small extension to the top portion of the nozzle that creates a most basic cornice or overhang. These two features are no more than simple variations of common shapes, symbols, or designs that are in the public domain. Thus, consistent with the above regulations, they are ineligible for protection under the Copyright Act. *See id.* (prohibiting the registration of basic symbols or designs). Moreover, viewed as a whole, the Applicant's Work consists of the simple addition of these two basic, unprotectable design features to an ordinary spray nozzle design. This simple combination of an oval-shaped cut out, a basic cornice, and a standard spray nozzle is, at best, *de minimis*, and fails to meet the threshold for copyrightable authorship. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883. Accordingly, we conclude that the Work's separable design features, both individually and in their selection and arrangement, lack the requisite "creative spark" necessary for registration. *Feist,* 499 U.S at 359; *Satava*, 323 F.3d at 811.

Your assertion that the addition of these two elements to a utilitarian spray nozzle design creates the feeling "of overlooking a wide vista, or of a cave hidden below an overhan[g]" does not add to your claim of sufficient creativity. *Second Request.* at 3. As discussed above, the Board does not assess a design's visual effect or appearance, its symbolism, or the espoused intentions of the author 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*, 188 U.S. 239. Thus, even if accurate, the mere fact that the Work's separable features are symbolic or create a "feeling" upon their viewing would not qualify the Work, as a whole, as copyrightable.

In sum, the Board finds that the Work does not include design elements that are both separable from the Work 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: *Cosmetic Container Nozzle*. 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