United States Copyright Office
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July 24, 2013

Bond, Schoeneck & King, PLLC
Attn: Fred Price
One Lincoln Center
Syracuse, NY 13202-1355

Re: Embrace Spoon Artwork
Correspondence ID: 1-2JHDQX

Dear Mr. Price:

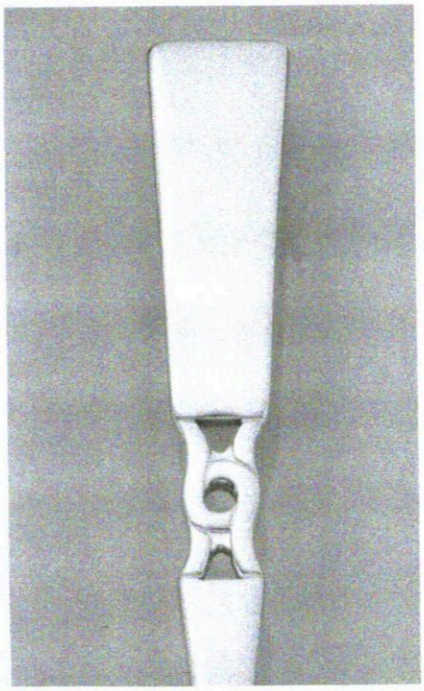
The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the work entitled: *Embrace Spoon Artwork*. You submitted this request on behalf of your client, Oneida Ltd., on October 14, 2009. I apologize for the lengthy 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

Embrace Spoon Artwork (the "Work") consists of a design feature incorporated into the handle of a spoon. The design feature includes a shape that resembles a "b" interlocking with as shape that resembles a "q." These two shapes interlock so that their circular portions overlap. Attached at opposite ends of the interlocking shapes are two rectangular shapes with curved edges.

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



II. ADMINISTRATIVE RECORD

On May 28, 2009, the United States Copyright Office (the "Office") issued a letter notifying Oneida Ltd. (the "Applicant") that it had refused registration of the above mentioned Work. *Letter from Copyright Office Registration Specialist to Catherine Suttmeier* (May 28, 2009). In its letter, the Office indicated that it could not register the Work because it "lacks the authorship necessary to support a copyright." *Id.*

In a letter dated April 23, 2009, the Applicant requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from George S. Blasiak to Copyright RAC Division* (April 23, 2009) ("First Request"). The letter set forth the reasons the Applicant believed the Office improperly refused registration. *Id.* Upon reviewing the Work in light of the points raised in the letter, the Office concluded that the Work "does not contain any authorship that is both separable and copyrightable" and again refused registration. *Letter from Attorney-Advisor Virginia Giroux-Rollow to Marjana Muldoon* (June 18, 2009).

Finally, in a letter dated October 14, 2009, 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 Fred Price to Copyright R&P Division* (October 14, 2009) ("Second Request"). In arguing that the Office improperly refused registration, you claim the Work's design feature

is neither an integral part of the Work's overall shape, contour, and structure, nor related to the Work's utilitarian function as a spoon. *Second Request* at 3. Specifically, you claim that it is possible to envision the design the Applicant has incorporated into the Work (described above) separate from the Work's utilitarian elements (a plain spoon with a head and handle).

Your argument references the following cases: *Pivot Point International, Inc. v. Charlene Products., Inc.*, 372 F.3d 913 (7th Cir. 2004) and *Stanislawski v. Jordan*, 337 F. Supp. 2d 1103 (E.D. Wis. 2004). Both cases support the principle that copyright protection can be secured when conceptual separability exists between the material sought to be copyrighted and the utilitarian article in which the material is incorporated. You also reference the Copyright Office's Circular 40, which lists "a carving on the back of a chair or a floral relief design on silver flatware" as examples of instances where copyright may be extended to artistic expression that is separable from a useful article. U.S. Copyright Office, Circular 40 (2012), http://www.copyright.gov/circs/circ40.pdf.

III. DECISION

A. *The Legal Framework*

(1) Separability

Copyright protection does not generally extend to useful articles, *i.e.*, "article[s] having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. However, works of artistic authorship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as [the designs'] form but not their mechanical or utilitarian aspects are concerned." *Id.* at § 101.

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

To satisfy the test for "physical separability," a work's pictorial, graphic, or sculptural features must be able to be physically separated from the work's utilitarian aspects, by ordinary means, without impairing the work's utility. *See, e.g., Mazer v. Stein*, 347 U.S. 201 (1954) (holding a sculptured lamp base depicting a Balinese dancer was physically separable from the article's utilitarian function); *and see, Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733, 1966 U.S. Dist. LEXIS 10265, 151 U.S.P.Q. (BNA) 286 (S.D.N.Y. 1966) (which held that a pencil sharpener shaped like a telephone was physically separable from the article's utilitarian function). 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) (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 Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). 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.* 499 U.S. at 359.

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

Of course, some combinations of common or standard design elements may contain sufficient creativity, with respect to how they are juxtaposed or arranged, to support a copyright. Nevertheless, not every combination or arrangement will be sufficient to meet this grade. *See Feist,* 499 U.S. at 358 (finding the Copyright Act "implies that some ways

[of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not"). Ultimately, the determination of copyrightability in the combination of standard design elements rests on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D. D.C. 1989).

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

> [i]t is true, of course, that a combination of unprotectable elements may qualify for copyright protection. But it is not true that any combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.

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

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

B. *Analysis of the Work*

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work does not contain any requisite separable authorship on which to base a claim to copyright. We further find that even if the Work's design features are to be considered separately from the Work's utilitarian function, they lack a sufficient

amount of copyrightable authorship to satisfy the requirement of originality. Accordingly, we affirm the denial of registration.

The Applicant is seeking protection of the design feature (a combination of geometric shapes) embodied within the Work (a spoon). There is no doubt that the spoon is a useful article, with its utility resting in its ability to be used as a utensil for gripping and scooping. Your own letter points this fact out. *Second Request* at 3. As discussed above, the law requires that, to be eligible for registration, the designs of useful articles must be either physically or conceptually separable from the utilitarian aspects of the work. *See Esquire,* 591 F.2d at 800. You have conceded the fact that the design embodied in the spoon is not physically separable from the spoon itself. *See Second Request* at 2. Therefore, for there to be any consideration of the design feature, the feature must be conceptually separable *i.e.* able to be imagined separately and independently from the Work's utilitarian aspects *without destroying the Work's basic shape.*

Imagining the design feature separate from the Work itself does, in the Board's view, destroy the Work's intended purpose as a utensil for gripping and scooping. If the design feature is separated from the spoon, one is left with three pieces of metal: (1) the small, quadrilateral piece of metal that was previously attached to the top of the design feature; (2) the design feature itself; and, (3) what remains of the lower portion of the spoon's handle with a spoon "head" attached to it. We conclude that, whether the Work be a sugar spoon, a serving spoon, or any size spoon in between, subtracting the design feature and upper metal piece from the spoon's handle destroys a user's ability to grip the Work (in the way one would normally grip a spoon) and scoop with it. *See* Amazon, Oneida Embrace Sugar Spoon, http://www.amazon.com/Oneida-T287SSGA-Embrace-Sugar-Spoon/dp/B0015YT70E (last accessed on July 18, 2013); *and see* Sears, Oneida Embrace Pierced Serving Spoon, http://www.sears.com/oneida-embrace-pierced-serving-spoon/p-SPM6839352308?prdNo=9 (last accessed on July 18, 2013). We further note that the Work differs from the "floral relief design on silver flatware" example given in the Office Circular that you reference, in that a standard relief design can be separated from flatware without dividing or shortening the flatware's handle pieces. U.S. Copyright Office, Circular 40 (2012), http://www.copyright.gov/circs/circ40.pdf. Accordingly, a separability analysis cannot be conducted for the Works' design feature.

Assuming *arguendo* that one could conceive of a way in which to imagine the design feature separately from the Work without destroying the ability to use the Work as one would normally use a spoon, the Board finds that this feature contains a mere *de minimus* combination of common, geometric shapes and is unregisterable.

The Board accepts the principle that combinations of geometric shapes may be eligible for copyright protection. However, in order to be accepted for registration, such combinations must contain some distinguishable variation in the selection, coordination, or arrangement of their elements that is not so obvious or minor that the "creative spark is

utterly lacking or so trivial as to be nonexistent." *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883. Here, the Work consists of the simple combination of what can be characterized as interlocking "b" and "q" shapes with two small curved-edged rectangles. This basic arrangement of common shapes lacks the requisite "creative spark" for copyrightability and is therefore unregisterable. *See Feist*, 499 U.S. at 359; *see also 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").

In sum, the Board finds that the Work's design feature is not separable from the Work itself; but, even if the design feature were separable, the Applicant's selection and arrangement of the elements in the design feature lack a sufficient level of creativity to make the Work registerable under the Copyright Act.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the work entitled: *Embrace Spoon Artwork*. 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