United States Copyright Office
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June 21, 2013

William H. Oldach III
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1909 K Street NW, Suite 900
Washington, DC 20006-1152

Re: Open-Top Infant Swing Versions II, III
Reg. No. VAu001017011; VAu001017019

Dear Mr. Oldach,

I write on behalf of the Copyright Office Review Board (the "Board") in response to your letter dated December 14, 2011, in which you requested the U.S. Copyright Office (the "Office") to reconsider its refusal to register the "3-Dimensional sculptures" entitled "Open-Top Infant Swing II" and Open-Top Infant Swing III" (collectively, the "Works").

The Board has carefully examined the application, the deposit and all correspondence concerning this application. For the reasons set forth below, and subject to the limitations set forth herein, the Board will register the Works.

ADMINISTRATIVE RECORD

A. Initial Application and Office's Refusal to Register

On July 24, 2009, the Office received an application from you on behalf of your client, Louis M. Kohus, to register claims for "3-Dimensional sculptures" and "2-Dimensional artwork, technical drawings" entitled "Open-Top Infant Swing II" (or "Version II") and Open-Top Infant Swing III" (or "Version III").

In a letter dated August 26, 2009, William Briganti, Assistant Chief of the then Visual Arts and Recordation Division, refused registration of the 3-dimensional claims to the Works because he determined that they were useful articles that "[did] not contain any separable authorship needed to sustain a claim to copyright." Letter from William Briganti to William H. Oldach III (Aug. 26, 2009). Mr. Briganti discussed the Office's physical and conceptual separability tests for useful articles. *Id.* at 1-2. He then concluded, "[b]ecause all of the sculptural elements of the works you deposited are either related to the utilitarian aspects or function, or are subsumed within the overall shape, contour, or configuration of the articles, there is no physically or conceptually 'separable' sculptural authorship as such. Consequently, we cannot register these claims." *Id.* at 2. Mr. Briganti also stated that the Office could register claims limited to "2-Dimensional artwork" and "Technical drawings." *Id.* at 1.

B. First Request for Reconsideration

In a letter dated November 25, 2009, you requested reconsideration of Mr. Briganti's initial refusal of registration. Letter from William H. Oldach III to Copyright RAC Division 1 (Nov. 25,

2009). You argued that the Works should be registered because the designs, "including their three-dimensional aspects," were not useful articles, and "serve no utilitarian purpose." *Id.* at 1. In making this argument you pointed toward "goods similar to those designed by Mr. Kohus" that are sold as toys, "including miniaturized formats, such as doll-sized toys," which you asserted are undeniably non-useful. *Id.* You then stated that courts have held that models and toys, including miniatures, are not useful articles. *Id.*

You distinguished between various versions of the Open-Top Infant Swing design in your applications to the Copyright Office, only claiming 3-dimensional authorship in material that had 3-dimensional aspects. *Id.* at 2. You further clarified that Mr. Kohus felt that the 3-dimensional character of the Works was a key aspect of his creative expression and he therefore did not wish to limit claims in the Works to 2-dimensional artwork or technical drawings. *Id.* Next, you discussed the statutory definition of "useful article" and the fact that when an article does not have "such a utilitarian function," the separability analysis is inapt. *Id.*

After repeating your assertion that the Works are not useful articles, you claimed that "[w]ith respect to Version II, no three-dimensional article, let alone any useful article, was in existence at the time the version was created." *Id.* You then asserted that Open-Top Infant Swing III is a "non-functional model handcrafted from basswood and painted to look like plastic and metal." *Id.* Having posited that the Works do not have "intrinsic utilitarian function," you stated that the Office incorrectly assumed the works are useful. *Id.* at 2-3.

You then cited to *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970 (6th Cir. 1983), for the proposition that, in certain contexts, toys do not have an intrinsic function other than the portrayal of the real item. You also pointed to *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, 780 F.2d 189 (2d Cir. 1985), as support for the notion that miniaturized versions of useful articles may be copyrightable. You then asserted that the Works at hand are non-functional and merely representative. *Id.* at 3. You also alleged that "miniature embodiments of open-top swings such as those created by Mr. Kohus are widely available for purchase." *Id.* You attached exhibits of such miniature designs and asserted that they could not be useful and that, accordingly, Mr. Kohus' design is entitled to registration. You further asserted that the swing is a toy and that the application should cover miniature embodiments of Mr. Kohus' sculpture. *Id.*

C. Examining Division's Response

In response to your request, Attorney-Advisor Virginia Giroux-Rollow examined Open-Top Infant Swing II and Open-Top Infant Swing III. Letter from Virginia Giroux-Rollow to William H. Oldach III (Mar. 10, 2010). She concluded that the Works are toys and not useful articles. *Id.* Specifically, she noted that "since the 'separability doctrine' applies only to useful articles, we have decided to allow and approve a claim in '3-d sculpture' because we believe that these works contain a sufficient, although minimal, amount of original and creative sculptural authorship to support a copyright registration." *Id.* She also noted that the application for each work included registerable claims in "2-d artwork, photographs, and technical drawings." *Id.*

D. Proposed Partial Cancellation

On May 14, 2010, then Associate Register for Registration, Nanette Petruzzelli addressed an email to you proposing to cancel the registrations for 3-dimensional sculpture for Open-Top Infant Swing II and Open-Top Infant Swing III. Email from Nanette Petruzzelli to William H. Oldach III (May 14, 2010). Ms. Petruzzelli explained that during the standard review of requests for copies of deposits for use in litigation according to 37 C.F.R. § 201.2(d)(2)(ii) it came to the attention of the Office that the Works might have been "erroneously" registered. *Id.* Thus, "[s]enior staff [] re-examined the deposit materials and correspondence related" to the applications. *Id.* At the conclusion of this re-examination, the staff determined that the Works were not "toys or the type of toys that fall outside the useful article category." *Id.*

Ms. Petruzzelli also noted that the First Request for Reconsideration appears to argue that the Works are miniature swings, while the deposits "indicate full-size articles, sufficient in their expanse and structure to accommodate use for infants." *Id.* Ms. Petruzzelli found that the sculptural elements were "related to the utilitarian aspects or function of the infant swings." Ms. Petruzzelli also stated that there appeared to be no 3-dimensional sculpture in existence at the time Open-Top Infant Swing II was registered and "[i]f this is the case, it serves as an additional ground for cancellation of the claim for 3-Dimensional sculpture." *Id.*

Ms. Petruzzelli further stated that if the Office decided to cancel the registrations with respect to the claims of authorship for the 3-dimensional sculpture and model, the Office would allow registration of the claims of authorship for the 2-dimensional artwork, technical drawing, and photograph and issue new registration certificates, which would carry the original effective date of registration of July 24, 2009. Ms. Petruzzelli added that since it appears as if the Office registered identical claims of authorship for the 2-dimensional artwork, technical drawing, and photograph for two identical works entitled Open-Top Infant Swing II (registration number VAu001006445) and Open-Top Infant Swing III (registration number VAu001006444), which were assigned an effective date of registration of December 2, 2009, upon any cancellation of the claims for the 3-dimensional sculpture and model for the instant Works, the later-filed registrations would be cancelled as duplicate claims. *Id.*

Ms. Petruzzelli concluded by pointing to 37 C.F.R. § 201.7, which discusses the circumstances under which the Office will cancel a registration and the procedure it follows to do so. *Id.* Specifically, Ms. Petruzzelli noted that "(1) Where the Copyright Office becomes aware after registration that a work is not copyrightable, either because the authorship is *de minimis* or the work does not contain authorship subject to copyright, the registration will be cancelled. The copyright claimant will be notified by correspondence of the proposed cancellation and the reasons therefore, and be given 30 days, from the date the Copyright Office letter is mailed, to show cause in writing why the cancellation should not be made. If the claimant fails to respond within the 30 day period, or if the Office after considering the response, determines that the registration was made in error and not in accordance with title 17 U.S.C., Chapters 1 through 8, the registration will be cancelled." *Id.* (citing 37 C.F.R. § 201.7(c)(1)).

E. Response to Proposed Partial Cancellation

In a letter dated June 11, 2010, you requested that the Office not cancel the registrations in 3-dimensional artwork for Open-Top Infant Swing II and Open-Top Infant Swing III. Letter from William H. Oldach III to Copyright RRP 1 (June 11, 2010). You asserted that "it is apparent that the Copyright Office has not given proper consideration to the fact that the original 3-dimensional embodiments of Mr. Kohus's Version II and Version III works were non-functional models, and thus by definition were not useful articles." *Id.* at 1. You also stated that a model of Version II was in existence at the time of registration, though Mr. Kohus did not have it in his possession. *Id.* at 2. Mr. Kohus stated the same in a declaration attached to your letter. Second Declaration of Louis M. Kohus ¶ 3, you argued that because the Works were "first made as non-functional models," the Office did not have to reach the question of whether the swings also satisfied the supposed "toy 'exception.'" Letter from William H. Oldach III to Copyright RRP at 2.

You next repeated your assertion that the Works were first embodied in three dimensions as non-functional models. You then pointed to case law in an effort to demonstrate that other products (consisting of toys that resemble the Works but which are different and distinct from the Works), which are allegedly based on the Works, fit within a supposed "'toy' exception to the useful article doctrine." *Id.* at 2-3. You cited to *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, 780 F.2d 189 (2d Cir. 1985), and *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970 (6th Cir. 1983), for the proposition that "courts have long held that in certain contexts, 3-Dimensional toys are copyrightable despite their intrinsic utilitarian function of amusing or entertaining children, even when there is a mechanical or functional element to the toy." *Id.* at 3. You then discussed *Lanard Toys Ltd. v. Novelty, Inc.*, 511 F. Supp. 2d 1020 (C.D. Cal. 2007), *aff'd*, No. 08-55795, 2010 WL 1452527 (9th Cir. Apr. 13, 2010), a case involving works registered by the Office where the judge denied both summary judgment and then judgment as a matter of law on the question of whether toy launchers were uncopyrightable "useful articles" even though the judge had stated that the toys in question appeared to have inseparable useful functions. *Id.* at 3. You noted that the Ninth Circuit affirmed the district court's denial of defendant's motion for judgment as a matter of law, refusing to overturn the jury's verdict that the toys were not useful, but copyrightable. *Id.* You also referenced *Silverlit Toys Manufactory Ltd. v. Absolute Toy Marketing, Inc.*, No. C 06-7966 CW, 2007 WL 521239 (N.D. Cal. Feb. 15, 2007), and *Spinmaster Ltd. v. Overbreak LLC.*, 404 F. Supp. 2d 1097 (N.D. Ill. 2005), as two other examples where courts found flying toys were copyrightable. *Id.* at 3-4. You asserted that these cases demonstrate that the Office "has issued registrations for functional toys, and courts have upheld these registrations, despite not finding that there exists any 'conceptually separable' elements to these toys." *Id.* at 4. You then claimed that there is "no rationale" in these cases that would justify treating the applied for Works differently from the flying toys in *Lanard* and related cases. *Id.* You then asserted that the Office properly agreed with this conclusion in its March 10, 2010 letter. *Id.*

Next, you stated that the Office had not explained why the Works are not considered to be toys, or, if they are toys, what types of toys are considered to fall outside the useful article category. You argued that it would be an abuse of discretion to arbitrarily or capriciously reverse the Office's earlier decision to register in light of the case law presented, without providing a reasoned basis for why the Works should be subjected to a treatment different from other similar works for which registration was granted and upheld. *Id.* Moreover, you wrote that if the Office is doubtful as to whether a work is copyrightable or not, it should register the work and let the appropriate court

decide. *Id.* (citing *Compendium of Copyright Office Practices II* § 108.07 (1984) (hereinafter "*Compendium II*")). You then asserted that the Office should not cancel the registrations because the ongoing litigation will allow "for full evidentiary presentations before a United States District Judge and jury, and ... provides a much more suitable forum to resolve such issues ...." *Id.*

You next clarified that the references to miniature versions of Mr. Kohus's Works in the First Request for Reconsideration were never meant to limit Mr. Kohus's claim in the full-sized 3-dimensional works. *Id.* at 5. You indicated that the First Request for Reconsideration stated that the Works "include miniature versions." *Id.* You asserted that such statements made clear that Mr. Kohus did not limit the claim to miniature embodiments; rather, Mr. Kohus was claiming the full-size sculptures. You then acknowledged that the dimensions on the deposit drawings made clear that they were of sufficient size to accommodate an infant, while at the same time you maintained that the Works are non-functional. You added that the doll swing submissions that accompanied the First Request for Reconsideration were not intended as a limitation, but were provided as examples to show that "whether or not swings made in the form of Mr. Kohus's original sculpture were considered toys, 3-dimensional protection was appropriate since it would give additional and more certain remedies to Mr. Kohus against an infringer who might copy Mr. Kohus's original, non-functional sculpture in another unquestionably non-functional manner such as for a doll swing." *Id.*

You then acknowledged the submission of duplicate applications for 2-dimensional artwork, which were submitted during the pendency of the First Request for Reconsideration. You consented to the cancellation of these registrations provided the 3-dimensional claim is upheld. You made no argument as to why the duplicate registrations should not be cancelled if the 3-dimensional claim is not upheld. *Id.* Finally, you concluded with a summary of your arguments for why the registrations should be maintained. *Id.* at 5-6.

F. Cancellation

On September 14, 2011, the Office confirmed cancellation of the Works. The Office accepted your revised statement that Open-Top Infant Swing II was completed and in existence at the time of submission, including 3-dimensional design aspects. With regard to the 2-dimensional design aspects, and technical drawing design aspects, the Office agreed that these design aspects are copyrightable. However, the Office found that the 3-dimensional design aspects, as they are given with their specific dimensions, can fairly be considered useful and therefore are not copyrightable. In making this determination, the Office analyzed whether the Works at issue, as submitted for registration, possess sufficient copyrightable authorship. Letter from Nanette Petruzzelli to William H. Oldach III (Sept. 14, 2011).

The Office explained that to the extent that you argued that the Works at issue fit into a supposed "toy" exception to the useful article doctrine, such an argument proceeds from an erroneous understanding of the law. The Office explained that no "toy" exception to the useful article doctrine exists. All toys are *not* de facto copyrightable. Instead, the Office noted that toys must fall within the subject matter of copyright as set forth in 17 U.S.C. §§ 101, 102. Toys that fall into the category of pictorial, graphic or sculptural works are *generally* considered eligible for copyright protection. However, for toys, as well as all items that are alleged to fall within the category of pictorial, graphic or sculptural works, a finding of copyright protection involves an inquiry as to whether the work is a useful article; and, if so, whether there are features that are

separable from the utilitarian aspects of the article; and further, whether such separable features themselves contain sufficient original authorship. *Id.* at 5-6 (citing 17 U.S.C. §§ 101, 102). The Office noted that the case law you cited does not support a "toy" exception to the useful article doctrine. *Id.* at 6 (citing *Spinmaster Ltd. v. Overbreak LLC*, 404 F. Supp. 2d 1097, 1103 (N.D. Ill. 2005) ("With respect to toys, *only* those toys which qualify as pictorial, graphic or sculptural works are subject to copyright protection.") (emphasis added); *Lanard Toys Ltd. v. Novelty, Inc.*, 511 F. Supp. 2d 1020, 1035 (C.D. Cal. 2007), *aff'd*, No. 08-55795, 2010 WL 1452527 (9th Cir. Apr. 13, 2010) ("*Only* those toys which qualify as pictorial , graphical or sculptural works are subject to copyright protection.") (emphasis added)).

The Office recognized that certain toys are copyrightable and that the Office has registered toys as varied as model aircraft, dolls, and puppets. For example, the Office noted that in *Gay Toys, Inc v. Buddy L. Corp.*, the Court determined that the only function of the model airplanes at issue was to portray the real item, and they were thus entitled to copyright protection. *Id.* at 6 (citing 703 F.2d at 974). The Office also observed that when faced with toys that both resembled "real items" and fictional ones, the Central District of California ruled that the model toys were copyrightable and the fictional ones presented a genuine issue of material fact as to whether they were useful. *Id.* (citing *Lanard Toys*, 511 F. Supp. 2d at 1036-37).

The Office found that the Works at issue, like the toy motorcycle considered by the court in *Kikker 5150*, not only portrays a real item but also serves a useful function. *Id.* (citing *Kikker 5150 v. Kikker 5150 USA, LLC*, No. C 03-05515 SI, 2004 U.S. Dist. LEXIS 16859 at *21 (N.D. Cal. Aug. 13, 2004)). In finding that the works serve utilitarian functions, the Office noted the dimensions on the deposit drawings, which establish that the Works at issue could accommodate a human infant. *Id.* at 7. The Office specifically observed that the material from which the Works are made, basswood, is a common material used for adult-sized furniture. *Id.* Therefore, it determined the Works to be useful articles in and of themselves, namely furniture. *See Compendium II* § 505.01. The Office made this determination regardless of the assertion that the Works could not swing. *Id.*

The Office found that all of the sculptural elements of the deposited full-scale works were related to their utilitarian function. Furthermore, it noted that no argument was made that any sculptural feature could be identified separately from, or was capable of existing independently of, the utilitarian aspects of the article. The Office noted that any article "that is normally a part of a useful article is considered a 'useful article.'" *Id.*

The Office did not disagree that the Works might generally and fairly be called "toys." *Id.* However, even if deemed toys, the Office determined that they were uncopyrightable toys because their functionality – that is, their ability to accommodate a human infant – could also serve as a basis for categorizing them as useful objects. *Id.*

The Office noted that it did not hold any doubt as to whether the Works are useful articles. Therefore, it refused to follow your call to register the Works under the "Rule of Doubt" as provided in *Compendium II* § 108.07. *Id.*

The Office therefore cancelled the registrations for Open-Top Infant Swing II (registration number VAu001017011) and Open-Top Infant Swing III (registration number VAu001017019) with respect to the claims of authorship for a 3-dimensional sculpture and model. The Office

acknowledged the authorship in the 2-dimensional artwork, technical drawing, and photograph, and issued new registration certificates indicating an original effective date of registration of July 24, 2009. Additionally, the registrations for the 2-dimensional artwork, technical drawing, and photograph for two identical works entitled Open-Top Infant Swing II (registration number VAu001006445) and Open-Top Infant Swing III (registration number VAu001006444), were cancelled as duplicate claims. *Id.* at 8.

G. Second Request for Reconsideration

In a letter dated December 14, 2011, you requested a second reconsideration of the refusal to register the 3-dimensional claim in the Works, asserting that the Office's determination that the Works are useful was incorrect. Letter from William H. Oldach III to U.S. Copyright Office 1-2 (Dec. 14, 2011). Included with the Second Request for Reconsideration was a declaration of Louis M. Kohus in which he stated that "[i]t would have been unsafe and irresponsible to allow any infant to use or otherwise interact with these 3-D Models because their construction was not intended for such use." Declaration of Louis M. Kohus 1 (Dec. 14, 2011). Citing to Mr. Kohus' declaration, you stated that "the 3-D Models were not suitable for the purpose of holding and supporting an infant child" because, *inter alia*, the "parts were assembled and held together primarily with glue." Letter from William H. Oldach III to U.S. Copyright Office at 2 (citing Declaration of Louis M. Kohus at 1).

You challenged the Office's observation that basswood is a common material for adult-sized furniture, asserting that such an observation is neither sufficient proof that basswood is appropriate for infant furniture in general, nor sufficient proof that the mere use of basswood as the medium for creation of the model in this specific case made it functional or fit for use or occupancy by an infant. You added that the lack of utility is especially true since the deposits were not created for any purpose other than to portray the appearance of the swings. *Id.*

H. Request for Physical Objects to Supplement the Deposit Material

In a letter dated December 21, 2012, Attorney-Advisor Stephen Ruwe wrote to you requesting that the actual physical objects that comprise Open-Top Infant Swing Version II and Version III, as opposed to the identifying material (consisting of photographs and technical drawings) submitted with the applications for registration, be provided for the Board's review. Letter from Stephen Ruwe to William H. Oldach III (Dec. 12, 2012).

In a letter dated January 9, 2013, you explained that Mr. Kohus was unable to provide the actual physical objects that comprise Open-Top Infant Swing Versions II and III because he no longer has possession of the models depicted in these registrations. Letter from William H. Oldach III to Stephen Ruwe (Jan. 9, 2013).

DETERMINATION

The design of a "useful article" is considered a pictorial, graphic, or sculptural work that is eligible for copyright protection "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." 17 U.S.C. § 101. The Office's prior consideration of the Works found that they are utilitarian in that they function as furniture, and therefore are not eligible for copyright protection. Despite these prior determinations, the Board finds that it is unable to determine whether the Works are functional.

On the one hand, the deposit material indicates that the Works are of a size and dimension to support an infant and therefore function as a chair. On the other, the claimant's assertions that the Works are non-functional models suggest a contrary conclusion. In an effort to resolve this issue, the Board requested submission of the actual objects. In light of the claimant's inability to provide the actual objects at issue in this review, the Board does not have the evidence before it that might permit it to determine the question in claimant's favor. Therefore the Board directs that the Works shall be registered, pursuant to the "Rule of Doubt" as stated in *Compendium II* § 108.07. The fact that the registrations are made pursuant to the rule of doubt will be noted as an annotation on the registration certificates.

The Board also takes this opportunity to clarify the scope of the claim being registered. 17 U.S.C. § 113(b) states:

> This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.

This provision disallows using copyright in a depiction of a useful article to prohibit unauthorized copying of the utilitarian object depicted, in order to prevent the possibility of indirect control over the useful article itself. *See* Patry on Copyright § 11:12 (Mar. 2013); *see also Gusler v. Fischer*, 580 F. Supp. 2d 309, 315 (S.D.N.Y. 2008) ("[A] copyright in a technical drawing of a useful article... does not preclude Defendants' manufacturing and marketing of the article itself."); *Eliya, Inc. v. Kohl's Dep't Stores*, No. 06 Civ 195 (GEL), 2006 U.S. Dist. LEXIS 66637, at *28 (S.D.N.Y. Sept. 13, 2006) ("[O]wnership of a copyright in a pictorial representation of a useful article does not vest the owner of the picture with a derivative copyright in the useful article itself.").

As asserted in your December 21, 2011 Second Request for Reconsideration, the Works are not for any other purpose than to portray the appearance of infant swings. In other words, the Works portray useful articles as such (*i.e.* the Works portray useful articles as useful articles). Pursuant to section 113(b), registration of the Works as models does not afford rights with respect to the making, distribution, or display of the useful infant swings *portrayed* in the Works. Rather, the registration extends to the Works only insofar as they are copyrightable models, and subject to the Rule of Doubt. *See* Register's Report on the General Revision of the U.S. Copyright Law (1961) at 14 ("[W]here the *work of art* actually portrays the useful article as such – as in a drawing, scale model, advertising sketch, or photograph of the article – existing court decisions indicate that copyright in the *work of art* does not protect against manufacture of the useful article portrayed."). The limitation on the scope of the claim, pursuant to 17 U.S.C. § 113(b), will be noted as an annotation on the registration certificates.

CONCLUSION

For the reasons stated herein, and subject to the above-stated limitations and annotations, the Copyright Office Review Board will register the two 3-dimensional sculptures entitled Open-Top Infant Swing II (Version II) and Open-Top Infant Swing III (Version III).

This decision constitutes final agency action in this matter.

Sincerely,

Steve Ruwe
Attorney-Advisor
for the Review Board
United States Copyright Office

cc: Corey Field (Counsel for Graco Children's Products Inc. c/o Newell Rubbermaid)
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