United States Copyright Office
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September 5, 2013

McCormick, Paulding & Huber LLP
Attn: Michael Cartona
185 Asylum Street
Hartford, Connecticut 06103-3410

Re: Stepped Spa and Enclosure
Correspondence ID: 1-DJ512N

Dear Mr. Cartona:

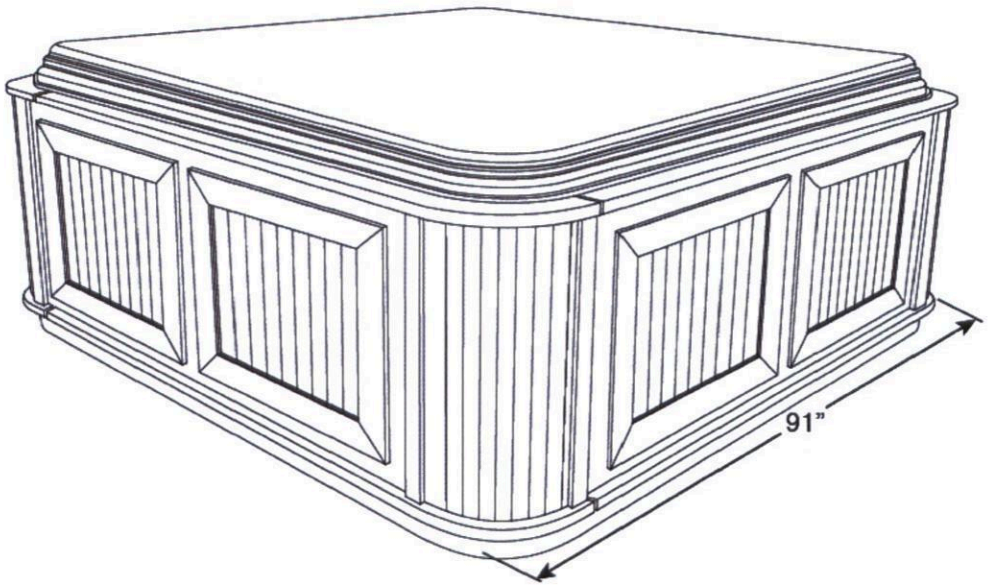
The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the work entitled: *Stepped Spa and Enclosure*. You submitted this request on behalf of your client, Strong Industries, Inc., on June 14, 2013.

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

Stepped Spa and Enclosure (the "Work") consists of paneling designed to act as a spa cabinet enclosure and a "shell" designed to act as a cover for the spa. The paneling includes the following design elements: (1) four rectangular-shaped frames that overlay the enclosure's wood-grained slats; (2) symmetrical rails located at the top and bottom of the enclosure; (3) four vertical strips located at the end of each portion of the enclosure; and, (4) a rounded, "fluted" ornamentation located on the enclosure's corners. The "shell" includes a "stepped" design around its outer edge. The "stepped" design includes at least five steps.

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



II. ADMINISTRATIVE RECORD

On September 4, 2012, the United States Copyright Office (the "Office") issued a letter notifying Strong Industries, Inc. (the "Applicant") that it had denied its application for registration of the above mentioned Work. *Letter from Registration Specialist, Guy Messier, to J. Grogan* (September 4, 2012). In its letter, the Office stated that it could not register the Work because it is a useful article that lacks any separable authorship on which to support a copyright claim. *Id.*

In a letter dated December 3, 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 Michael Cartona to Copyright RAC Division* (December 3, 2012) ("First Request"). Upon reviewing the Work in light of the points raised in your letter, the Office concluded that the Work "is a useful article that does not contain any authorship that is both separable and copyrightable" and again refused registration. *Letter from Attorney-Advisor, Stephanie Mason, to Michael Cartona* (March 15, 2013).

Finally, in a letter dated June 14, 2013, 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 Michael Cartona to Copyright R&P Division* (June 14, 2013) ("Second Request"). In your letter, you agree with the Office's prior determination that the Work is a useful article that includes design features that are separable from its utilitarian function, but disagree with the Office's conclusion that those design features lack a sufficient amount of original

authorship to qualify for copyright protection. *Id.*. Specifically, you claim the design features the Office identifies as separable, both individually and in their selection and arrangement, include at least the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). *Second Request* at 2-3. You also argue that the Office was incorrect in determining that the "stepped" design incorporated into the edge of the "shell" portion of the Work is not separable from the Work's utilitarian function. *Id.* at 3. You claim the "stepped" design is both conceptually separable and sufficiently creative to warrant registration. *Id.*

In addition to *Feist*, your argument references several cases in support of the general principle that ornamental designs incorporated into furniture are eligible for registration under the Copyright Act if they are both separable and possess a requisite amount of creative authorship. *Second Request* at 4-5.

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 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. New York 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 *Stepped Spa and Enclosure* 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 a work's utilitarian aspects. *See Esquire,* 591 F.2d at 800. Here, it is undisputed that the Work (a combination of paneling designed to act as a spa cabinet enclosure and a "shell" for covering a spa) is a useful article. It is also undisputed that the Work includes certain design features that are separable from its function as a spa cabinet enclosure and cover (the rectangular-shaped frames, symmetrical top and bottom rails, vertical strips, and fluted corner ornamentations). However, the Board finds that none of these features possess 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, we find that the Work's only separable features include: (1) standard, rectangular-shaped frames; (2) ordinary, symmetrical top and bottom rails; (3) vertical strips; and, (4) basic, fluted corner ornamentations. Consistent with the above regulations, none of these simple, common features are sufficiently creative, in and of themselves, to be eligible for copyright protection. *See Id.* (prohibiting the registration of basic symbols or designs); *see also Feist*, 499 U.S at 359. Thus, we conclude that the Work's separable design elements, considered individually, do not possess the requisite amount of creative authorship to warrant copyright registration.

Likewise, the Board finds that the Applicant's selection and arrangement of the Work's separable design features fails to meet the grade for registration. *Id.*; *see also Atari Games,* 888 F.2d at 883 (accepting that combinations of geometric shapes may be eligible for copyright protection; but, concluding that in order to be accepted for registration, such combinations must contain more than mere *de minimis* creative authorship). Viewed as a whole, the Applicant's Work consists of a standard spa cover sitting atop wood-grained paneling garnished with four basic rectangles (two per panel), two standard top and bottom rails, four plain vertical strips (located at the end of each panel), and simple fluted corner ornamentation incorporated into it. We find that the level of creative authorship involved in this obvious configuration of common, unprotectable elements is, at best, *de minimis*, and far too trivial make the work eligible for copyright registration. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883.

The Board is not persuaded by your assertion that the "stepped" design the Applicant has incorporated into the "shell" portion of the Work includes separable authorship that is

sufficiently creative to warrant registration. Again, it is undisputed that this portion of the Work serves a utilitarian purpose (a "shell" for covering a spa). It is also evident from the deposit materials that the stepped design incorporated into the shell's edge is not physically separable from the shell. *Contra*, *Mazer v. Stein*, 347 U.S. 201 (1954). Therefore, for there to be any consideration of the stepped design, the feature must be conceptually separable – *i.e.* able to be imagined separately and independently from the Works' utilitarian aspects without destroying the Work's basic purpose. Here, the stepped design makes up the portion of the shell's edge that attaches to the spa. The Board cannot imagine a way to separate this shape and form-related element from the shell without destroying its basic function as a spa cover. In other words, if the stepped portion of the shell is removed, the shell would no longer fit, as a cover, over the top of the spa. Thus, because the stepped design is either subsumed within the overall shape, contour, and configuration of the Work itself; or, incapable of being imagined separately from the Work without destroying its function as a spa cover, we conclude the feature is not eligible for protection under the Copyright Act. *See Esquire,* 591 F.2d 796.

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: *Stepped Spa and Enclosure*. 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