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

April 1, 2014

Stones and Roses International Co. Ltd.
Attn: Phillipe Narbonne
164/53 Moo 10 Theparak Road
Bangpla Bangplee Samutprakam, 10540
Thailand

Re: Surface Pattern C
Surface Pattern TT
Surface Pattern SA
Surface Pattern D
Surface Pattern SQ
Correspondence ID: 1-G8YOEO

Dear Mr. Narbonne:

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 refusals to register 2-D artwork copyright claims in the above five works. You submitted this request on behalf of Stone and Roses International Co. Ltd, on October 23, 2013.

The Board has examined the application, the deposit copies, and all of the correspondence in the 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 WORKS

The above five works are tiles containing specific surface patterns and textures. Surface Pattern C consists of four angled bands with a symmetrical wave pattern on each band. Surface Pattern TT consists of a lattice type grid of raised lines that form squares. Surface Pattern SA similarly consists of a lattice type grid of raised lines forming squares, but with the lines being less prominent than the lines of Surface Pattern TT. Surface Pattern D is smaller in scale than Surface Patterns TT and SA, but also consists of a lattice type grid of raised lines that form squares. Finally, Surface Pattern SQ consists of a grid of squares formed by incised, rather than raised, lines.

The below images are photographic reproductions of the works from the deposit materials:



Pattern C



Pattern TT



Pattern SA



Pattern D



Texture SQ

II. ADMINISTRATIVE RECORD

In March of 2013, the United States Copyright Office (the "Office") issued a letter notifying Stones and Roses International Co. Ltd. (the "Applicant") that it had denied its applications for registration of the five above works. *Letter from Kathryn Sukites, Registration Specialist, to Phillipe Narbonne*. In its letter, the Office stated that it could not register the works because they are useful articles that do not contain any separable original authorship necessary to sustain claims to copyright. *Id.*

In a letter dated April 23, 2013, you requested that, pursuant to 37 C.F.R. 202.5(b), the Office reconsider its initial refusal to register the works. *Letter from Phillipe Narbonne to Copyright RAC Division* (April 23, 2013)("First Request"). Upon reviewing the works in light of the points raised in your letter, the Office concluded that the works are useful articles that do not contain any authorship that is both separable and copyrightable, and again refused registration.

The Office responded in a letter dated August 21, 2013, which re-evaluated the claim and again found that the works are useful articles that do not contain any authorship that is both separable and copyrightable. *Letter from Stephanie Mason, Attorney-Advisor, to Phillippe Narbonne* (August 21, 2013).

In a letter dated October 23, 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 five above works. *Letter from Phillippe Nardone to Copyright RAC Division* (October 23, 2013)("Second Request"). In your letter, you agree with the Office's prior determination that the above five works are useful articles that include design features that are separable from their utilitarian functions, but disagree with the Office's conclusion that those design features lack a sufficient amount of original authorship to qualify for

copyright protection. *Id.* First, you claim that you created the textures of the above five works independently, and that there were no such textures applied on stone tiles before you created them. You also claim that the above five works are not merely basic geometrical shapes and lines made irregular, but "are the expression of an idea and of a concept of the true self of the material." *Id.*

III. DECISION

A. *The Legal Framework*

1) *Separabilty*

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 craftsmanship, 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 conducts 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) (holding 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), 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 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.* 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.C. Cir. 1989).

To be clear, the mere simplistic arrangement of non-protectable 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 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 Works*

After carefully examining the five works at issue and applying the legal standards discussed above, the Board finds that the works are useful articles that do not contain the requisite separable authorship necessary to sustain claims to copyright. Although the patterns on the face of each of the above five works are conceptually separable, the patterns do not contain sufficient original and creative artistic authorship to support copyright registration.

The above five works are useful articles because they are "article[s] having an intrinsic utilitarian function that is not merely to portray the appearance of the article[s] or to convey information." 17 U.S.C. § 101. As discussed above, the design features of a useful article may become eligible for copyright registration when they contain original authorship that is either physically or conceptually separable from the utilitarian aspects of the article. *See id.* Here, it is undisputed that the works (stone wall and floor tiles) are useful articles. It is also undisputed that the works contain design elements that are separable from the tiles utilitarian function (the symmetrical wave pattern and lattice type grids forming squares). However, the Board finds that none of these features possess the requisite amount of creative authorship to warrant copyright registration.

As noted, certain design elements are not copyrightable. 37 C.F.R. 202.1(a). In particular, "familiar symbols or designs" do not contain the sufficient level of originality to warrant copyright protection. *See id.* Here, the only separable features of Surface Patterns TT, SA, D, and SQ are squares, horizontal lines, vertical lines, and variations thereof. These common design features are not sufficiently creative, in and of themselves, to be eligible for copyright protection. *See id.* (prohibiting registration of basic symbols or designs). With respect to Surface Pattern C, you assert that the angled bands and wave pattern "relates to the stone geology as a sedimentary rock . . . commonly displayed in canyons or cliffs where a section of a stone deposit is exposed." *Second Request* at 2. The texture and appearance of a naturally occurring stone deposit does not display the requisite level of independent creation and sufficient creativity to warrant copyright protection.

Furthermore, the selection, combination, and arrangement of the works' features is not sufficient to render each work, as a whole, original. *See Feist*, 499 U.S. at 358. Instead, these designs are simple and common configurations of geometric shapes and patterns that are in the public domain. We find that the level of creative authorship involved in these configurations of common shapes and unprotectable elements is, at best, *de minimis*, and far too trivial to enable copyright registration. *See Feist*, 499 U.S. at 359.

Finally, your assertions that the Applicant's selection and arrangement of the above five works' separable design features are unique for stone tiles and express the idea and concept of the

materials used do not add to your claims of sufficient creativity. *Second Request* at 1-2. As discussed above, the Board does not assess the espoused intentions of the author, the design's uniqueness, its visual effect or appearance, or its symbolism in determining whether a work contains the 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 facts that the Applicant's works are unique for stone tiles and are intended to give off a certain symbolism or feel would not qualify the above five works as copyrightable.

In sum, we find that, in each of the above five works, the Applicant's selection and arrangement of the elements that comprise each work lacks a sufficient level of creativity to make it eligible for registration 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 copyright claims in the above five works. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: 

Stephen Ruwe
Member of the Review Board