United States Copyright Office
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April 7, 2014

Buchanan Ingersoll & Rooney PC
Attn: Lynn Alstadt
One Oxford Centre
301 Grant Street, 20th Floor
Pittsburg, PA 15219-1410

Re: Swirl Oblong Scalloped Edge Tray
Correspondence ID: 1-GDIQ71

Dear Ms. Alstadt:

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: *Swirl Oblong Scalloped Edge Tray*. You submitted this request on behalf of your client, Novelty Crystal Corporation, on December 4, 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

Swirl Oblong Scalloped Edge Tray (the "Work") is a rectangular-shaped tray. The tray has raised edges. A raised "scalloped" pattern appears on the tray's edges. The "scalloped" pattern consists of several equally-spaced, curved grooves. The curved grooves that appear on the tray's corners differ slightly from the curved grooves that appear elsewhere on the tray. The below images are photographic reproductions of the Work from the deposit materials:





II. ADMINISTRATIVE RECORD

On May 8, 2013, the United States Copyright Office (the "Office") issued a letter notifying Novelty Crystal Corporation (the "Applicant") that it had refused registration of the above mentioned Work. *Letter from Registration Specialist, Guy Messier, to Ralph Fischer* (May 8, 2013). In its letter, the Office stated that it could not register the Work because it "lacks the authorship necessary to support a copyright claim." *Id.*

In a letter dated June 12, 2013, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from Lynn Alstadt to Copyright RAC Division* (June 12, 2013) ("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 Lynn Alstadt* (Sept. 6, 2013) (emphasis original).

Finally, in a letter dated December 4, 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 Lynn Alstadt to Copyright R&P Division* (Dec. 4, 2013) ("Second Request"). In your letter, you agree with the Office's prior determination that the Work is a useful article that includes a design feature that is separable from its utilitarian function, but disagree with the Office's conclusion that the design feature does not possess the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). *Second Request passim.* In support of your argument, you claim the Applicant's selection and arrangement of the elements that make up the Work's separable design feature includes at least the minimum amount of creativity required to satisfy the originality threshold. *Id. passim.* Specifically, you maintain that "[w]hile the design includes sets of spaced apart curved lines, the design also includes a different line pattern at each corner where the lines are not equally spaced and differ in shape." *Id.* at 3.

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 (S.D.N.Y. 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, at 55 (1976), *reprinted in* U.S.C.C.A.N. 5659, 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.C. Cir. 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.*, 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 *Swirl Oblong Scalloped Edge Tray* 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). The Board accepts the general principal that design features incorporated into utilitarian articles are not, *per se*, disqualified from copyright registration. However, as discussed above, the law requires that, to be eligible for registration, such design features must be either physically or conceptually separable from the utilitarian aspects of the industrial product. *See Esquire,* 591 F.2d at 800.

Here, it is undisputed that the Work (a tray) is a useful article. It is also undisputed that the Work includes a design feature (a series of curved grooves that run along the tray's edges) that is conceptually separable from its utilitarian function. Nevertheless, the Board finds that this design feature does not 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, *inter alia*, "familiar symbols or designs." *Id.* Here, the Work's design feature is a pattern of curved grooves that run along its raised edges. The grooves are of equal length and appear at equally-spaced intervals, except where they bunch together at the Work's corners. Consistent with the above regulations, these curved grooves, regardless of their length and spacing, are simple lines that are ineligible for copyright protection. *See id.* (prohibiting the registration of basic symbols or designs). Thus, we conclude the none of individual elements in the Work's design feature qualify for registration under the Copyright Act.

Likewise, the Board finds that the selection and arrangement of the elements that comprise 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 design feature is a pattern of curved grooves arranged so that they create a common "scalloped" pattern on the edge of a tray. We find that the level of creative authorship involved in this obvious configuration of common, unprotectable elements is, at best, *de minimis*, and 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 simple fact that the grooves bunch together and become shorter at the tray's corners is not sufficiently creative to qualify the Work, in its entirety, for protection under the Copyright Act. *See Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q.2d 1074, 1076 (D.D.C. 1991).

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: *Swirl Oblong Scalloped Edge Tray*. 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
Copyright Office Review Board