



United States Copyright Office

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April 25, 2016

Dorsey & Whitney LLP
Attn: Robert Wasnofski, Jr.
51 West 52nd Street
New York, NY 10019-6119

**Re: Second Request for Reconsideration for Refusal to Register Vortex
Correspondence ID: 1-JT9UJ9**

Dear Mr. Wasnofski:

The Review Board of the United States Copyright Office (the “Board”) has examined Jaguar Land Rover Limited’s (“Jaguar Land Rover’s”) second request for reconsideration of the Registration Program’s refusals to register a copyright claim in the work titled “Vortex” (the “Work”). After reviewing the application, the deposit copy, and the relevant correspondence in the case, along with the arguments set forth in the second request for reconsideration, the Board affirms the Registration Program’s denial of registration.

I. DESCRIPTION OF THE WORK

Vortex is a three-dimensional wheel cover (or hubcap or “rim”) design that consists of the following elements: a “hub” where the Work can be connected to a vehicle using five bolts, a starburst-like feature that surrounds and connects to the “hub,” and seven “V” shaped spokes that connect from the Work’s outer rim to the starburst design that surrounds the “hub.”

A photographic reproduction of the Work is included as Appendix A.

II. ADMINISTRATIVE RECORD

On March 27, 2013, Jaguar Land Rover filed an application to register a three-dimensional work titled “Vortex.” Specifically, Jaguar Land Rover asserted a claim to copyright in “sculpture.”

In a letter dated July 29, 2013, a Copyright Office registration specialist refused to register the Work, finding that it is a “useful article” that does not contain “any separable authorship needed to sustain a claim to copyright.” See Letter from Allan Runge, Registration Specialist, to Robert Wasnofski, Jr., Dorsey & Whitney LLP (July 29, 2013). The letter stated that the Work does not possess sufficient separable creative authorship within the meaning of the copyright statute and settled case law to support a claim to copyright. *Id.*

In a letter dated October 29, 2013, Jaguar Land Rover requested that the Office reconsider its initial refusal to register the Work. See Letter from Robert Wasnofski, Jr., Dorsey & Whitney LLP, to U.S. Copyright Office (Oct. 29, 2013) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office reevaluated the claims and in a letter dated February 5, 2014, again concluded that the Work “is a useful article that does not contain any authorship that is

both separable and copyrightable.” See Letter from Stephanie Mason, Attorney-Advisor, to Robert Wasnofski, Jr., Dorsey & Whitney LLP (Feb. 29, 2014).

In a letter dated May 5, 2014, Jaguar Land Rover requested that, pursuant to 37 C.F.R. § 202.5(c), the Office again reconsider its refusal to register the Work. See Letter from Robert Wasnofski, Jr., Dorsey & Whitney LLP, to U.S. Copyright Office (May 5, 2014) (“Second Request”). In its Second Request, Jaguar Land Rover did not dispute the Office’s prior determination that the Work is a useful article. Jaguar Land Rover did, however, assert that the Work includes design features that are separable from the Work’s utilitarian function. Jaguar Land Rover disagreed with the Office’s conclusion that those design features lack a sufficient amount of separable original authorship to qualify for copyright protection. *Id.* at 2. Specifically, Jaguar Land Rover argued that the “cosmetic face” that appears on the outermost portion of the wheel cover at issue (not the wheel cover itself) possess a sufficient amount of creative authorship to warrant registration under the Copyright Act. *Id.* at 3. Finally, Jaguar Land Rover asserted that the Work’s overall “ornamental design” would be eligible for registration if embodied in “a free standing sculptural work of wall art or simply on paper.” *Id.*

III. DECISION

A. *The Legal Framework*

1) *Separability*

The copyright law does not protect useful articles, which are defined as “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 that have been incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works pursuant to 17 U.S.C.

§ 102(a)(5). The protection for such works is limited, however, in that it extends only “insofar as [the designs’] form but not their mechanical or utilitarian aspects.” *Id.* at § 101. In other words, 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) (holding that 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 Office employs two tests to assess separability: (1) a test for physical separability; and (2) a test for conceptual separability. COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2 (3d ed. 2014) (“COMPENDIUM (THIRD)”); see also *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 739 F.3d 446, 449 (9th Cir. 2014) (finding that the Office’s interpretation of conceptual separability is entitled to deference, while noting that “[c]ourts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article’s utilitarian function”); *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995) (finding that the Office’s tests for physical and conceptual separability are “a reasonable construction of the copyright statute” consistent with the words of the statute, existing law, and the legislature’s declared intent in enacting the statute).

To satisfy the test for physical separability, a useful article must contain pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact. *See* COMPENDIUM (THIRD) § 924.2(A); *see also Mazer v. Stein*, 347 U.S. 201 (1954) (finding a sculptured lamp base depicting a Balinese dancer was physically separable from the article's utilitarian function); *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (1966) (finding a pencil sharpener shaped like a telephone was physically separable from the article's utilitarian function).

To satisfy the test for conceptual separability, a useful article must contain pictorial, graphic, or sculptural features that can be visualized—either on paper or as a free-standing sculpture—as a work of authorship that is separate and independent from the utilitarian aspects of the article and the overall shape of the article. In other words, the feature must be capable of being imagined separately and independently from the work's utilitarian aspects without destroying the work's basic shape. A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature and the useful article could both exist side by side and be perceived as separate, fully realized works—one an artistic work and the other a useful article. If the feature is an integral part of the overall shape or contour of the useful article, that feature cannot be considered conceptually separable because removing it would destroy the basic shape of the article. *See* COMPENDIUM (THIRD) § 924.2(B); *see also* H.R. REP. NO. 94-1476 (1976), *reprinted in* U.S.C.C.A.N. 1976 at 5668 (citing a carving on the back of a chair or a floral relief design on silver flatware as examples of conceptually separable design features).

If the useful article does not contain any features that can be physically or conceptually separated from its utilitarian function, the Office will refuse to register the claim because Congress has made it clear that the Copyright Act does not cover any aspect of a useful article that cannot be separated from its functional elements. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668-69. If the Office determines that the work contains one or more features that can be separated from its functional elements, the Office will examine those features to determine if they contain a sufficient amount of original authorship to warrant registration.

2) *Originality*

A work may be registered if it qualifies as an “original work[] of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a). In this context, 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.* Only a modicum of creativity is necessary, but the Supreme Court has ruled that some works (such as the alphabetized telephone directory at issue in *Feist*) fail to meet even this low 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 longstanding requirements of originality and creativity in the law, as affirmed by 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”); 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”).

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. However, not every combination or arrangement will be sufficient to meet this test. *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”). A determination of copyrightability in the combination of standard design elements depends 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).

A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection. For example, the Ninth Circuit rejected a claim of copyright in a piece of jewelry where the manner in which the parties selected and arranged the work’s component parts was more inevitable than creative and original. *See Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). Likewise, the Ninth Circuit held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, and the stereotypical jellyfish form did not merit copyright protection. *See Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). The language in *Satava* is particularly instructive:

It 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) do not make aesthetic judgments in evaluating the copyrightability of particular works. *See COMPENDIUM (THIRD) § 310.2*. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design’s 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); 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 necessarily 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 is a useful article that does not contain the requisite separable authorship necessary to sustain a claim to copyright.

The Copyright Act defines a useful article 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. 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. Here, it is undisputed that the Work (a wheel cover or hubcap or “rim”) is a useful article. Thus, for there to be any consideration of the Work’s design features, the features must be either physically or conceptually separable from the Work’s utilitarian function as a vehicle wheel cover. *See Norris Indus., Inc. v. Int’l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 2011); *see also Esquire*, 591 F.2d at 800.

Jaguar Land Rover argues that the Work includes a “cosmetic face” that is “conceptually separate from the wheel itself” and contains separable “ornamental design features” that are merely “superimposed over the basic shape” of a wheel cover. Second Request at 1. We disagree. Based on the deposit Jaguar Land Rover submitted with its copyright application, we are unable to distinguish the “ornamental design” that is allegedly “superimposed over the basic shape” of the wheel cover from the wheel cover itself. Indeed, the deposit seems to demonstrate the opposite—a design that is so intertwined with the basic functioning of a standard vehicle wheel cover that it is impossible to imagine a way to physically or conceptually separate these elements from the wheel cover without destroying its basic function. *Cf. Mazer v. Stein*, 347 U.S. 201 (1954). In other words, imagining the Work’s “ornamental design” features separately from the Work overall leaves the examiner with little more than an outer rim and an interior bolt hub. As a result, the “cosmetic face” and the wheel cover itself cannot exist side by side “and be perceived as fully realized, separate works—one an artistic work and the other a useful article.” COMPENDIUM (THIRD) § 924.2(B). Thus, in the Board’s view, any attempt at separability destroys the Work’s intended purpose as a functional wheel cover.

Additionally, the suggestion that a work contains design features that could be characterized as conceptually similar to various forms of free-standing sculpture does not negate its intrinsic utilitarian function. *See Esquire*, 591 F.2d at 800; *see also Norris Indus.*, 696 F.2d at 923-24. Merely analogizing the general shape of a useful article to a work of modern sculpture or an abstract sculpture does not satisfy the conceptual separability test because it does not provide an objective basis for visualizing the artistic features and the useful article as separate and independent works. COMPENDIUM (THIRD) § 924.2(B). Thus, despite Jaguar Land Rover’s claim that the Work’s “ornamental design” would be eligible for registration had it been embodied in “a free standing sculptural work of wall art or simply on paper,” the fact remains that the design feature, as it appears in the deposit included with Jaguar Land Rover’s registration application, is embodied within a useful article.

III. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claim in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.

BY:



Chris Weston

Copyright Office Review Board Member

APPENDIX A

