



United States Copyright Office

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April 25, 2016

Michael R. Friedman
Christopher M. Dolan
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P.O. Box 10395
Chicago IL 60619

Re: Second Request for Reconsideration for Refusal to Register Aviator Sculpture, Correspondence ID: 1-GWO3HI, and Navigator Sculpture, Correspondence ID: 1-PY74MJ

Dear Messrs. Friedman and Dolan:

The Review Board of the United States Copyright Office (“Board”) has examined Skullcandy, Inc.’s (“Skullcandy’s”) second requests for reconsideration of the Registration Program’s refusal to register the works titled “Aviator Sculpture” (“Aviator”) and “Navigator Sculpture” (“Navigator”) (together, the “Works”). After reviewing the applications, the deposited identifying material, the relevant correspondence, and the arguments raised in the second requests for reconsideration, the Board affirms the denial of registration for these copyright claims.

I. DESCRIPTION OF THE WORKS

The Works consist of on-ear headphones, with rounded, transparent outer shells, or housings, covering the outside of the earpieces. To a casual observer, the outer shells could be seen to resemble the lenses of wire-framed sunglasses. The two designs are similar with the exception of the shape of the earpieces and housings, as Aviator’s housing appears egg-shaped, while the Navigator’s resembles “aviator” style glasses.

Photographic reproductions of the Work are set forth below.



Aviator



Navigator

II. ADMINISTRATIVE RECORD

A. Aviator

Skullcandy filed the application to register a copyright claim in Aviator on July 17, 2013. On November 15, 2013, Copyright Office registration specialists issued a letter notifying the claimant that registration had been refused. *See* Letter from Beth Garner and Allan Runge, Registration Specialists, to Tiffany Shimada (Nov. 15, 2013). In its letter, the Office stated that it could not register Aviator because, even if the work may have contained features “separable” from its useful attributes, those features were not copyrightable. *Id.*

In a letter dated February 18, 2014, Skullcandy requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the copyright claim. *See* Letter from Tiffany Shimada and Christopher Dolan to U.S. Copyright Office (Feb. 18, 2014) (“First Request”). Upon reviewing Aviator in light of the points raised in Skullcandy’s 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 Stephanie Mason, Attorney-Advisor, to Tiffany Shimada (June 9, 2014).

In a letter dated September 9, 2014, Skullcandy requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register a copyright claim in Aviator. *See* Letter from Michael Friedman and Christopher Dolan to U.S. Copyright R&P Division (Sept. 9, 2014) (“Second Request”). Skullcandy alleged that the Office improperly refused registration, that the work contains physically as well as conceptually separable elements, and that the separable design features of the work include at least the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publications, Inc. v. Rural Telephone Service Company*, 499 U.S. 340 (1991). *See* Second Request at 3, 5, 7. In support, Skullcandy points to the physical separability of particular pieces of the headphones, news articles highlighting their uniqueness, and design patents it has obtained for the Aviator design. Additionally, Skullcandy highlights several cases describing legally separable and registrable useful articles as analogous to its work. *Id.*

B. Navigator

Skullcandy filed the application to register a copyright claim in Navigator on July 17, 2013. On December 9, 2013¹ Copyright Office registration specialists issued a letter notifying the claimant that registration had been refused. *See* Letter from Beth Garner and Allan Runge, Registration Specialists, to Tiffany Shimada (Dec. 9, 2013). In its letter, the Office stated that it could not register Navigator because, even if the work may have contained “separable” features, those features were not copyrightable. *Id.*

In a letter dated March 10, 2014, Skullcandy requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusals to register the copyright claim. *See* Letter from Tiffany Shimada and Christopher Dolan to U.S. Copyright Office (Mar. 10, 2014) (“First Request”). Upon reviewing the headphones in light of the points raised in Skullcandy’s 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 these registration. Letter from Stephanie Mason, Attorney-Advisor, to Tiffany Shimada (July 7, 2014).

In a letter dated October 17, 2014, Skullcandy requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register a copyright claim in Navigator. *See* Letter from Michael Friedman and Christopher Dolan to U.S. Copyright Office (Oct. 17, 2014) (“Second Request”). Skullcandy argues that the Office improperly refused registration, that the work is physically as well as conceptually separable, and that the separable design features of the work include at least the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publications, Inc. v. Rural Telephone Service Company*, 499 U.S. 340 (1991). *See* Second Request at 3, 5, 7. In support, Skullcandy points to the physical separability of particular pieces of the headphones, news articles highlighting their uniqueness, and design patents it had obtained for the Navigator design. Additionally, Skullcandy highlighted several cases describing legally separable and registrable useful articles as analogous to its work. *Id.*

III. DISCUSSION

A. The Legal Framework

1) Useful Articles and 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 are concerned.” *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, the utilitarian aspects of the article.” *Id.*; *see also Esquire, Inc. v. Ringer*, 591 F.2d

¹ Though both applications were initially received by the Office on the same date, further clarification was requested through correspondence by the examining registration specialist regarding Navigator, resulting in a one-month difference between the initial registration decisions.

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. See COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2 (3d ed. 2014) (“COMPENDIUM (THIRD)”); see also *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (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”) (citation omitted); *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 (S.D.N.Y. 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).

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. See H.R. REP. NO. 94-1476 (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, Inc. 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 virtually nonexistent.” *Id.* at 359.

The Office’s regulations implement the long-standing 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”); *id.* at 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 has 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 Lithographing Co.*, 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.

Finally, the Board reiterates that “the issuance of a design patent for a work has no relevancy to the determination of separability or copyrightability.” Letter from Stephanie Mason to Tiffany Shimada (June 9, 2014); Letter from Stephanie Mason to Tiffany Shimada (July 7, 2014). While the Board acknowledges that both copyright and patent laws contain a requirement of originality, these areas of law and the policies they serve are aimed at protection of different aspects of intellectual property. Specifically, patent law contemplates that design patents can be issued to protect ornamental characteristics of useful articles, which is expressly contrary to copyright law.² Instead, “utility” or “usefulness” actually militates against copyrightability, leading to instances where a design patent might be granted for a work that is not copyrightable. See *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958), *superseded by statute on other grounds as stated in Nova Stylings, Inc. v. Ladd*, 695 F.2d 1179, 1181-82 (9th Cir. 1983) (finding that copyright registration was properly refused for a work determined to be a useful article, despite the fact that a design patent had been issued for the same work); *Johnson v. Levi Strauss*, 2009 U.S. Dist. LEXIS 80630 (S.D. Ohio Aug. 5, 2009) (invalidating copyright registration for a useful article despite the issuance of a design patent).

B. Analysis of the Works

After carefully examining the Works and applying the legal standards discussed above, the Board finds that Aviator and Navigator are useful articles that do not contain the requisite original separable authorship needed to sustain a copyright claim.

Here, it is undisputed that the Works, as headphones designed for playback of sounds, are useful articles. Thus, for there to be any consideration of the design features, the features must be either physically or conceptually separable from the Aviator and Navigator’s utilitarian functions as headphones. See *Esquire*, 591 F.2d at 800. Skullcandy asserts that the housings (or “outer shells”) which may be seen as resembling the lenses of wire-framed sunglasses, may be “physically separated from the work,” and the product will continue “to play music and function as a set of headphones.” Second Requests at 3.³ But Skullcandy’s suggestion that the housings can be viewed as a “free-standing sculpture” does not negate their intrinsic utilitarian function. The photos of the headphones *sans* housings, submitted with Aviator’s Second Request, make clear that once the housings are removed, the headphones’ wiring, speakers, and inner workings are exposed. See Second Request, Ex. 3. These housings therefore appear to be an integral part of the headphones.

The cases Skullcandy cites, *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966), and *Mazer v. Stein*, 347 U.S. 201 (1954), do not help demonstrate that the housings “exist independent of the utilitarian aspects,” as the pencil sharpener disguised as an antique telephone in

² Compare 17 U.S.C. § 101 (defining “[p]ictorial, graphic, and sculptural works” to specifically exclude “mechanical or utilitarian aspects,” with U.S. Patent and Trademark Office, *A Guide To Filing A Design Patent Application*, at 2, http://www.uspto.gov/web/offices/com/iip/pdf/brochure_05.pdf (“In general terms, a utility patent protects the way an article is used and works (35 U.S.C. 101), while a ‘design patent’ protects the way an article looks (35 U.S.C. 171). Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance. While utility and design patents afford legally separate protection, the utility and ornamentality of an article are not easily separable. Articles of manufacture may possess both functional and ornamental characteristics.”).

³ See also Aviator Second Request, Ex. 3 (submitting photos of Aviator with the housing covers removed). Though no photos of Navigator with the housings similarly removed were submitted with Skullcandy’s second request for Navigator, the Board presumes that the housings can be removed from Navigator in the same fashion.

Ted Arnold and the lamp with a base shaped like a Balinese dancer in *Mazer* were both capable of serving their intended utilitarian functions regardless of the presence of these decorative aspects. The Skullcandy housings are more properly compared to the ornamental wire wheel covers in *Norris Industries, Inc. v. International Telephone and Telegraph Corporation*, in which the court found to be uncopyrightable utilitarian articles serving as hubcaps to protect lug nuts. 696 F.2d 918, 924 (11th Cir. 1983). Like the hubcaps in *Norris*, Aviator and Navigator can technically function as headphones without the housings in place. However, the Aviator and Navigator housings are a structural part of the headphones, serving to protect the wiring and speakers inside from damage in the normal course of use, just as the hubcaps in *Norris* protected the internal mechanical aspects of the wheels. As such, these aspects of Aviator and Navigator are uncopyrightable utilitarian articles.

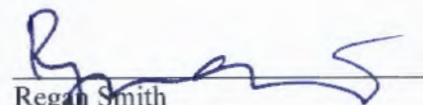
Even assuming the housings here may be characterized as ornamental, or unique in the headphone market based on their shape and resemblance to wire-framed sunglass lenses, it is well settled that copyright protection does not extend to the “overall shape or configuration” of a utilitarian article “no matter how aesthetically pleasing that shape or configuration might be.” *Esquire*, 591 F.2d 800; *see also Inhale, Inc.*, 739 F.3d 449 (adopting the Copyright Office’s reasoning “that whether an item’s shape is distinctive does not affect separability”). Accordingly, the Board finds that the Works lack separable, copyrightable authorship and are not eligible for protection under the Copyright Act.

Finally, the Board finds that, even if the Aviator and Navigator housings existed as freestanding sculptures, they would fail to meet the creativity threshold set forth in *Feist* because they consist solely of rounded, transparent outer shells, which are common geometric shapes, and are void of any copyrightable “pictorial, graphic or sculptural features.” 17 U.S.C. § 101; COMPENDIUM (THIRD) § 906.1. Skullcandy submits several articles and advertisements, which purportedly highlight the “uniqueness of the design[s] in the headphone market,” as support for its argument that these headphone designs are sufficiently original. Second Requests at 8. However, Skullcandy’s assertions that the Works, “designed to evoke a pair of sunglasses [are] unique, innovative, and in line with the policy of *Feist*,” supported by reference to “numerous media articles,” do not help sustain a claim of sufficient creativity. *See* Second Requests at 7; *see also* Aviator Second Request, Ex.1. What a work evokes and the degree to which it is innovative are not factors in determining whether a work contains the requisite minimal amount of original authorship necessary for registration. COMPENDIUM (THIRD) § 310.2; *see also* H.R. REP. NO. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5664. Thus, even if accurate, the fact that Skullcandy’s Works consist of unique, aesthetically appealing objects does not render them copyrightable *per se*. Accordingly, the Board concludes that these Works do not possess the requisite amount of creative authorship to warrant copyright registration.

IV. CONCLUSION

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

BY:


Regan Smith
Copyright Office Review Board