



United States Copyright Office

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September 24, 2019

Jacob A. Holt
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1400 Wewatta Street
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Denver, CO 80202-5549

Re: Second Request for Reconsideration for Refusal to Register Cosmolite Design 3D, Correspondence ID: 1-3DW2EKU; SR 1-4444510923

Dear Mr. Holt:

The Review Board of the United States Copyright Office (“Board”) has considered Samsonite IP Holdings S.à r.l.’s (“Samsonite’s”) second request for reconsideration of the Registration Program’s refusal to register a sculpture claim in the work titled “Cosmolite Design 3D” (“Work”). After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board affirms the Registration Program’s denial of registration.

I. DESCRIPTION OF THE WORK

The Work is a three-dimensional design applied to the front and back exterior of a suitcase. The design contains alternating raised and shallow tapered lines that spread in a fan-like manner from bottom to the top with scalloped edges. The entire shape forms a raised scallop shell or clamshell-like design. Close-up images of the Work display a textured basket weave design applied evenly to the entire surface of the suitcase. Reproductions of the Work are included as Appendix A.

II. ADMINISTRATIVE RECORD

On February 16, 2017, Samsonite filed an application to register a copyright claim in the Work. In a May 3, 2018 letter, a Copyright Office registration specialist refused to register the claim, finding that the Work is a useful article that does not contain any copyrightable authorship needed to sustain a claim to copyright. Letter from R. Barker, Registration Specialist, to Jacob Holt, Dorsey & Whitney LLP (May 3, 2018).

In July 30, 2018 letter, Samsonite requested that the Office reconsider its initial refusal to register the Work. Letter from Jacob Holt, Dorsey & Whitney LLP, to U.S. Copyright Office (July 30, 2018) (“First Request”). After reviewing the Work in light of the points raised in the

First Request, the Office re-evaluated the claims and again concluded that the Work is a useful article that does not contain any separable, copyrightable features. Letter from Stephanie Mason, Attorney-Advisor, to Jacob Holt, Dorsey & Whitney LLP (Jan. 29, 2019). The Office held that the design, while separable, does not satisfy the originality requirement because it is a common and familiar shape that does not contain a sufficient amount of creativity. *Id.* at 3–4.

In a April 26, 2019 letter, Samsonite 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 Jacob Holt, Dorsey & Whitney LLP, to U.S. Copyright Office (Apr. 26, 2019) (“Second Request”). Samsonite argues that the Work contains more than enough creative authorship to satisfy the very low threshold required for registration. *Id.* Specifically, Samsonite asserts that the Work does not feature common shapes similar to those contemplated by the Copyright Office’s *Compendium*, such as circles, ovals, but rather an imaginative recasting of a more complex shell design. *Id.* at 2. To support its argument, Samsonite favorably compares the Work to the work at issue in *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 207 (3d Cir. 2005) (stating “a sculptural work’s creativity derives from the combination of texture, color, size, and shape” and that “all creative works draw on the common wellspring that is the public domain”). *Id.* at 2–3.

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separability*

Copyright does not protect useful articles as such, which are defined in the Copyright Act 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. Importantly, however, artistic features applied on or incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works under sections 101 and 102(a)(5) of the Copyright Act. This protection is limited to the “‘pictorial, graphic, or sculptural features’ [that] ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’” *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (quoting 17 U.S.C. § 101).

To assess whether an artistic feature incorporated into the design of a useful article is protected by copyright, the Office examines whether the feature “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” *Id.* at 1007; *see also* U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924 (3d ed. 2017) (“COMPENDIUM (THIRD)”). This analysis focuses on “the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction [because the] statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature.” *Star Athletica*, 137 S. Ct. at 1013. Put another way, while useful articles as such are not copyrightable, if an artistic feature “would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article.” *Star Athletica*, 137 S. Ct. at 1011; 17 U.S.C. § 113(a)

(“[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.”); *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”).

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 Publications, Inc. v. Rural Telephone Service 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 longstanding requirement of originality set forth in the Copyright Act and described in the *Feist* decision. *See, e.g.*, 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.* § 202.10(a) (stating “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. Nevertheless, 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 United States District Court for the Southern District of New York upheld the Copyright Office’s refusal to register simple designs consisting of two linked letter “C” shapes “facing each other in a mirrored relationship” and two unlinked letter “C” shapes “in a mirrored relationship and positioned perpendicular to the linked elements.” *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 496 (S.D.N.Y. 2005). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, 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 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).

Similarly, while the Office may register a work that merely consists of geometric shapes, for such a work to be registrable, the “author’s use of those shapes [must] result[] in a work that, as a whole, is sufficiently creative.” COMPENDIUM (THIRD) § 906.1; *see also Atari Games Corp.*, 888 F.2d at 883 (“[S]imple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court.”). Thus, the Office would register, for example, a wrapping paper design that consists of circles, triangles, and stars arranged in an unusual pattern with each element portrayed in a different color, but would not register a picture consisting merely of a purple background and evenly-spaced white circles. COMPENDIUM (THIRD) § 906.1.

Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. *See id.* § 310.2. The attractiveness of a design, the espoused intentions of the author, the design’s visual effect or its symbolism, the time and effort it took to create, or the design’s commercial success in the marketplace are not factors in determining whether a design is copyrightable. *See, e.g., Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

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.

As an initial matter, Samsonite and the Copyright Office agree that the raised scallop shell pattern is a separable element applied to the surface of the Work. Refusal of First Request at 3; *see also* Second Request at 1. The Office, therefore, focuses its analysis on the copyrightability of the separable design. The constituent elements of the Work—lines and color striations—are not copyrightable. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of “familiar symbols or designs...or colors); COMPENDIUM (THIRD) § 906.1 (“the copyright act does not protect common geometric shapes, either in two-dimensional or three-dimensional form...including...straight or curved lines”). The question, then, is whether the combination of the Work’s elements is sufficiently creative.

While some combinations of common or standard design elements may contain sufficient creativity to support a copyright, not every combination will meet this threshold. *See Feist*, 499 U.S. at 358, 363. The combination of elements in the Work here fails to meet the threshold for protection. The Work as a whole merely combines evenly spaced alternating raised and receding

tapered lines. This predictable combination results in a familiar symbol or design—a clamshell—that is not copyrightable. While the design contains a slight variation from the typically round shape of a clamshell, this is due to its confinement to a rectangular surface, which is dictated by the overall shape of the useful article. The rectangular shape of the useful article, however, is not considered in the separable design. *See Star Athletica*, 137 S. Ct. at 1010 (recognizing that a design feature cannot “be a useful article” in and of itself or “[a]n article that is normally part of a useful article”); H.R. Rep. No. 94-1476, at 55, reprinted in 1976 U.S.C.C.A.N. at 5668 (noting that copyright protection does “not cover the over-all configuration of the utilitarian article as such”). When the feature is imagined apart from the useful article as its own sculptural work, the “standalone” design that remains is merely a common, garden-variety clamshell as opposed to a more complex shell design as is asserted by the applicant. *See Star Athletica*, 137 S. Ct. at 1011. Even if the design as a whole is not considered to be a familiar symbol or design, the combination and arrangement of the elements still lacks a sufficient amount of creativity. The lines are arranged in symmetrical and evenly-spaced alternating raised rows with a standard basket weave pattern evenly applied to the entire surface. This is an entirely common sculptural design and does not contain a sufficient amount of creativity to support registration.

Samsonite relies on *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199 (3d Cir. 2005), to support its proposition that the Work contains a sufficient amount of creative authorship. Second Request at 3. While the Review Board agrees that combinations of unprotectable elements may be selected, coordinated, or arranged in a manner that is sufficiently creative for copyright protection, reasonable observation does not support Samsonite’s assertion that the Work here meets this threshold. Furthermore, the Work is distinguishable from the work at issue in *Kay Berry, Inc.*, which contained both literary and graphic elements that were “adapted...to make it visually and rhythmically appealing.” *Kay Berry, Inc.* 421 F. 3d at 207. The Work here contains no textual elements and has not been adapted in a manner that injects a sufficient amount of creativity into the otherwise standard design.

IV. 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.



U.S. Copyright Office Review Board

Karyn A. Temple, Register of Copyrights
and Director, U.S. Copyright Office

Regan A. Smith, General Counsel and
Associate Register of Copyrights

Catherine Zaller Rowland, Associate Register of
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Appendix A





