



November 30, 2016

Tia Loya
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Re: Second Request for Reconsideration for Refusal to Register 3 Bangs For Your Butt, Large 11061011; 11" Polyphemus Plug 11336011; and 11" Dark Vader 11045011; Correspondence ID: 1-18105Y2; Original Correspondence ID: 1-124X0OU

Dear Mr. Stewart:

The Review Board of the United States Copyright Office ("Board") has considered TSX Toys, Inc.'s ("TSX Toys") second request for reconsideration of the Registration Program's refusal to register sculpture claims in the works titled "3 Bangs for Your Butt; Large 11061011," "11" Polyphemus Plug 11336011," and "11" Dark Vader 11045011" (collectively, "Works"). After reviewing the applications, deposit copies, 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 WORKS

The Works are three-dimensional sculptural works, specifically dildo and butt plug sex toys.

3 Bangs For Your Butt; Large 11061011 ("3 Bangs For Your Butt") is a pale flesh-toned sex toy with a maximum length of 11 inches and a maximum circumference of 11.5 inches. The body is made of three stylistic penis head nodules that are arranged one on top of another from the top of the work to the bottom. The nodules become slightly larger in descending order. There is a small amount of spacing between each nodule, and there is a longer space between the third nodule and the base of the Work. There is a small platform base at the bottom of the Work.

11" Polyphemus Plug 11336011 ("Polyphemus Plug") is a pale flesh-toned sex toy with a maximum length of 13 inches and a maximum circumference of 10 inches. The work is larger at the base, narrows at the top, and curves to the side. The top is a semi-sphere, meant to look like

a cyclops eye. Moving down from the semi-sphere tip, the work is broken up into five segments that are each separated by a raised ridge.

11" Dark Vader 11045011 ("Dark Vader") is a pale flesh-toned sex toy with a maximum length of 12 inches and a maximum circumference of 12.5 inches. Its title suggests the work is meant to resemble the Star Wars character Darth Vader. The back view of the work is smooth with a stylistic penis head nodule. The nodule wraps partially around the work and has a raised tip that extends to the top of the work. The front view of Dark Vader has an imprint of three ovals that are separated by ridges. The smallest oval is in the center of the work's front, and the two remaining ovals surround the smaller one and extend to the sides of the work. There is an imprinted triangle that extends from the base of the work through the smallest oval. This design is on the lower three-quarters of the work. The Dark Vader's top is stylized with ridges, in a manner suggestive of a helmet.

Photographic reproductions of the Works are set forth in Appendix A.

II. ADMINISTRATIVE RECORD

On October 21 and 22, 2014, TSX Toys filed three applications to register copyright claims in the Works. In an April 15, 2015 letter, a Copyright Office registration specialist refused to register the claims, finding that the Works were useful articles that did not contain any separable authorship needed to sustain a claim to copyright. Letter from Guy Messier, Registration Specialist, to Tia Loya, TSX Toys, Inc. (Apr. 15, 2015).

In a letter dated April 23, 2015, TSX Toys requested that the Office reconsider its initial refusal to register the Works. Letter from Tia Loya, TSX Toys, Inc., to U.S. Copyright Office (Apr. 23, 2015) ("First Request"). After reviewing the Works in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Works were useful articles. Because all of the Works' features "are part of the overall shape, contour, and configuration of the works," there were neither physical nor conceptual separable elements. Having found no separability, the Office did not evaluate whether the Works possessed the amount of creativity needed to warrant copyright registration. Letter from Stephanie Mason, Attorney-Advisor, to Tia Loya, TSX Toys, Inc. (Sept. 9, 2015).

In a letter dated November 19, 2015, TSX Toys requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Works. Letter from Tia Loya, TSX Toys, Inc., to U.S. Copyright Office (Nov. 19, 2015) ("Second Request"). In that letter, TSX Toys asserted that "each and every one of these items is capable of existing as a work of art independent of the utilitarian article in which it is incorporated." *Id.* at 2. TSX Toys further argued that while the Works may not be "innovative or surprising . . . they are certainly NOT typical, garden-variety or devoid of creativity. Thus they have met the measure of creativity" required to warrant copyright registration. *Id.* at 3. TSX Toys additionally emphasized that the Office should not "write off the artistic elements of sex toys . . . just because they are sex toys." *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. 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 works’] 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 artistic “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 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); *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. *See* COMPENDIUM (THIRD) § 924.2(A). 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 freestanding 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 [able to be] imagined separately and independently from the useful article without destroying the basic shape of that article. 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 fully realized, separate works—one an artistic work and the other a useful article.

COMPENDIUM (THIRD) § 924.2(B); *cf.* H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 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 copyright protection does not extend to any aspect of a useful article that cannot be separated from its utilitarian elements. 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 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).

Finally, while the Office may register a work that consists merely 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.

B. Analysis of the Works

After carefully examining the Works and applying the legal standards discussed above, the Board finds that the Works do not contain requisite separable creative authorship necessary to sustain a claim to copyright. We would like to emphasize that when evaluating a claim to copyright, the Board uses objective criteria to determine whether a work satisfies the requirements. The sexual nature of the Works is irrelevant to the Board’s analysis of their copyrightability.

To begin with, the Works—dildos and butt plugs—are plainly useful articles, a point that TSX Toys implicitly concedes with its references to the Polyphemus Plug’s “useful purpose,” Second Request at 2, and to the Works’ functions as dildos and butt plugs, *id.* *See also ConWest Resources, Inc. v. Playtime Novelties, Inc.*, No. C 06-5304 SBA, 2006 U.S. Dist. LEXIS 85461, at *5 (N.D. Cal. Nov. 17, 2006) (noting the likelihood that the adult novelty items at issue, specifically sculptures of male genitalia, were “utilitarian objects not entitled to copyright protection”).

Thus, for there to be any consideration of the copyrightability of the Works' design features, these features must be either physically or conceptually separable from the Works' utilitarian function as sex toys. TSX Toys urges the Board to consider that it is "easy to conceive that all of the sculptural elements of the item could literally be cut away and the item would still serve as a perfectly functional dildo or butt plug." Second Request at 2. As discussed above, this is not the Office's test for either physical or conceptual separability.

To be physically separable, the 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. An example is a sufficiently creative decorative hood ornament on an automobile. *See* COMPENDIUM (THIRD) § 924.2(A). Unlike the example of a hood ornament, which can easily be removed without destroying the utilitarian aspects of the hood, physical removal of the Works' aesthetic features would destroy the Works entirely. For instance, removal of the three stylistic penis head nodules from 3 Bangs For Your Butt would solely leave the work's base, which would no longer function as a sex toy.

The Board finds that the design features of neither 3 Bangs For Your Butt nor Polyphemus Plug are conceptually separable, while Dark Vader does include conceptually separable elements. Regarding 3 Bangs For Your Butt and Polyphemus Plug, the stylistic penis head nodules, contours, and ridges cannot be visualized separately and independently from the Works' use as sex toys. The sculptural features of the design of a useful article are conceptually separable only if they are not "required" or are "*wholly unnecessary* to performance of the utilitarian function." *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985). It is difficult for the Board to conceive that the bumps, ridges, and curves in the Works are wholly unnecessary to the performance of the sex toy. Because 3 Bangs For Your Butt and Polyphemus Plug are plainly intended for sexual gratification, and do not include features incidental to this purpose, the Board finds that their nodules, contours, and ridges are "required" for their utilitarian function, and thus not conceptually separable. *Id*; *see also ConWest Resources, Inc.* No. C 06-5304 SBA, 2006 U.S. Dist. LEXIS 85461, at *5 (finding that designs of adult novelty items based on male genitalia "appear to be inextricably intertwined with their utilitarian purpose").

The Board does find, however, that some stylistic elements in Dark Vader are conceptually separable. Like 3 Bangs For Your Butt and Polyphemus Plug, none of the folds or ridges making up the shape of Dark Vader, including those forming the tip of the work, are separable, as they constitute the basic shape of the article. However, viewing Dark Vader from the front, the oval and triangle imprints on the lower three-quarters of the work are able to be visualized separately and independently from the sex toy without destroying the basic shape of the work. Unlike 3 Bangs For Your Butt and Polyphemus Plug, all of whose sculptural elements are integral to the overall shape and contour of the sex toys, the oval and triangle imprints on the front of Dark Vader can be viewed as a work of authorship that is independent from the overall shape of the useful article. *See* COMPENDIUM (THIRD) § 924.2(B).

Of course, for a separable element of a work to be eligible for copyright protection, it must "possess more than a *de minimis* quantum of creativity." *Feist*, 499 U.S. at 363. The imprint on Dark Vader does not meet this low threshold. The Copyright Act does not protect

common geometric shapes, such as the curved lines, ovals, and triangle that are represented in the Work. *See* 37 C.F.R. § 202.1(a); COMPENDIUM (THIRD) § 906.1. The Board recognizes that although the individual components of a given work may not be copyrightable, these components may be protectable if selected or combined “in a distinctive manner indicating some ingenuity.” *Atari Games Corp.*, 888 F.2d at 883. Here, though, the Board finds that the selection, combination, and arrangement of Dark Vader’s oval and triangle imprints, noted above, is not sufficient to render the work original. These few and unprotectable elements are combined in an entirely standard and commonplace manner—ovals enveloping each other in descending size is an obvious configuration. The placement of a triangle in the middle of the basic configuration does not raise the amount of creative expression to a level warranting copyright registration. *See Feist*, 499 U.S. at 359.

Overall, the Board finds that the Works are not copyrightable. 3 Bangs For Your Butt and Polyphemus Plug are utilitarian works with no physical or conceptual separability. While Dark Vader, also a utilitarian work, has some minor conceptually separable elements, the level of creative authorship involved in this configuration of elements is, at best, *de minimis*, and too trivial to enable copyright registration. *See* COMPENDIUM (THIRD) § 313.4(B).

IV. CONCLUSION

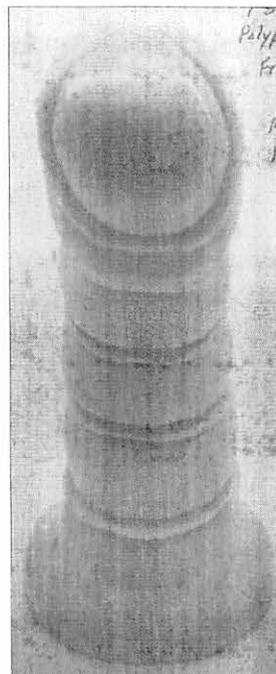
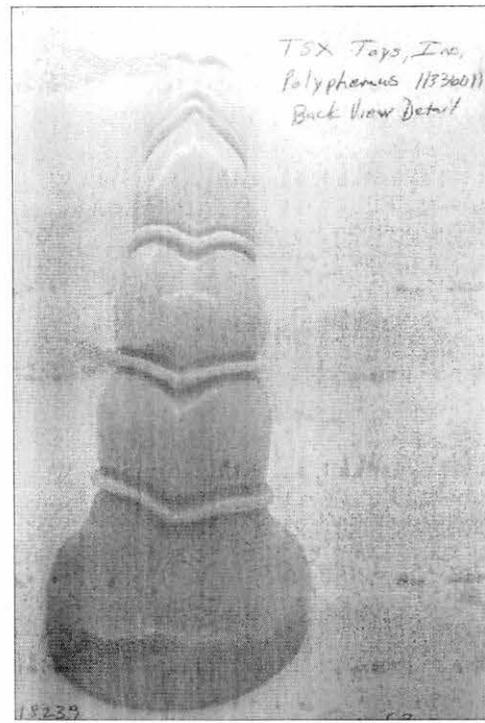
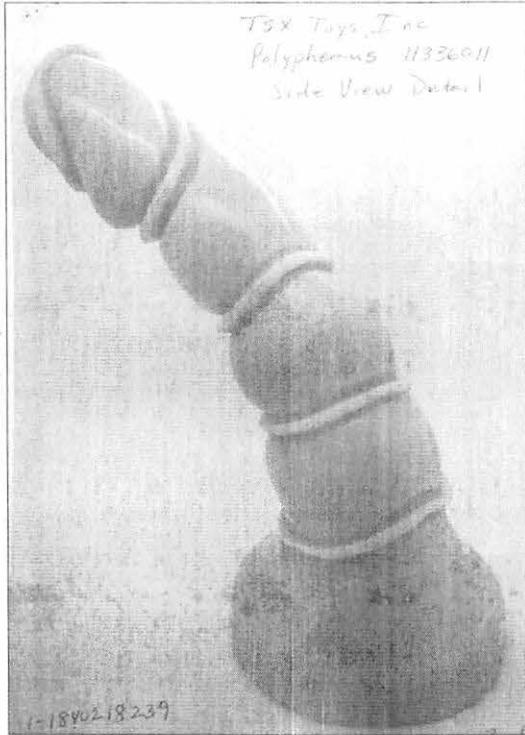
For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claim in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.

APPENDIX A

3 Bangs For Your Butt; Large 11061011



11" Polyphemus Plug 11336011



11" Dark Vader 11045011

