



**United States Copyright Office**

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**Re: Second Request for Reconsideration for Refusal to Register Aviator Valkyrie Desk and Mars Chair; Correspondence ID: 1-10BW7J1**

Dear Mr. Harris:

The Review Board of the United States Copyright Office (“Board”) has considered Halo Trademarks Limited’s (“Halo’s”) second request for reconsideration of the Registration Program’s refusal to register three-dimensional sculpture claims in the works titled “Aviator Valkyrie Desk” and “Mars Chair” (“Works”). After reviewing the application, deposit copy, and relevant correspondence in the case, 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 Aviator Valkyrie Desk is a large, solid wood desk covered with stainless steel plates, riveted, countersunk together, and overlaid with a distressed, shiny metallic finish. It has two vertical supports: a tapered hollow column, and a bent extension of the top surface, slanting down from that surface at an angle of approximately 120 degrees. The tapered hollow column is inset under the top surface and divided into three storage cubbies.

The Mars Chair is an armchair consisting of a metal frame and a leather seat and seatback. The leather seat and seatback are supported by the metal frame described by Halo as a “metallic wishbone design concept” that is constructed out of two separate concave square forms, open in the middle, that wrap around the sides of the seat and supply a place for the user to rest her arms. The two metal forms do not meet at the back of the chair, exposing the leather upholstery. The leather upholstery is also exposed through the opening in each of the square forms.

The Works are depicted below:

*Aviator Valkyrie Desk*



*Mars Chair*



## II. ADMINISTRATIVE RECORD

On July 9, 2014, Halo filed an application to register copyright claims in the Works. In a July 16, 2014 letter, a Copyright Office registration specialist refused to register the claims, finding that the Works “are ‘useful articles’ which do not contain any separable authorship needed to sustain a claim to copyright.” Letter from Guy Messier, Registration Specialist, to Richard D. Harris, Greenberg Traurig, LLP, at 1 (July 16, 2014).

In a letter dated October 15, 2014, Halo requested that the Office reconsider its initial refusal to register the Works. Letter from Richard D. Harris, Greenberg Traurig, LLP, to U.S. Copyright Office (Oct. 15, 2014) (“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 registration of the Works “must be refused because they are useful articles that do not contain any separable features.” Letter from U.S. Copyright Office to Richard D. Harris, Greenberg Traurig, LLP, at 1 (Mar. 6, 2015). Finding that the Works had no separable features, the Office did “not discuss whether any sculptural elements, either individually or as a whole, possess the requisite amount of creativity to warrant registration.” *Id.* at 4.

In a letter dated June 5, 2015, Halo 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 Richard D. Harris, Greenberg Traurig, LLP, to U.S. Copyright Office (June 5, 2015) (“Second Request”). In that letter, Halo disagreed with the Office’s conclusion that the Works, as a whole, are useful articles that do not contain any separable features. Halo argued that the Copyright Office “inaccurately applied the wording of the Compendium” in evaluating the Works for registration, and further argued that the “Copyright Office’s test for conceptual separability also contradicts the plain language of the copyright statute.” *Id.* at 5-6. Halo further argued that each of the Works contains “original, conceptually separable, creatively authored, ornamental features, which meet the qualifications for copyright protection.” *Id.* at 2. With respect to the Aviator Valkyrie Desk, Halo pointed to the “pattern of stainless steel plates and accompanying rivets,” as well as the “other sculptural ornamentation” including “the graduated, increasing width of each of the desk surface (the wing), the desk stanchion (the wing strut) and the shelving (the tail rudder), as well as the filleted attachment points for the tail rudder.” *Id.* at 21. With respect to the Mars Chair, Halo argued that the metal frame “is literally capable of ‘standing’ and existing independently of the utilitarian aspects of the chair” and are “wholly unnecessary to the furniture’s utilitarian function.” *Id.* at 23 (internal quotations omitted). Presumably to support its claim that the metal frame is sufficiently original to be copyrightable, Halo argued that it is “evocative of an ornamental, metallic wishbone.” *Id.* at 24.

### 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). 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 *id.*; 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).

Similarly, 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.

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. 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 the design’s commercial success in the marketplace are not factors in determining whether a design is copyrightable. *See* 17 U.S.C. § 102(b); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). Thus, 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 Works***

After carefully examining the Works and applying the legal standards discussed above, the Board finds that the Works are useful articles that contain neither the requisite separable authorship nor the sufficient level of creativity necessary to sustain a claim to copyright registration.

First, it is undisputed that the Works (a chair and a table) are useful articles. COMPENDIUM (THIRD) § 924.1; *see also Magnussen Furniture, Inc. v. Collezione Europa*

*USA, Inc.*, No. 96-1917, 1997 WL 337465, at \*2 (4th Cir. June 19, 1997) (observing that “most pieces of furniture are ‘useful articles’ rather than ‘works of art.’”). Thus, for there to be any consideration of the Works’ design features, the features must be either physically or conceptually separable from the utilitarian features as a desk and a chair. *See Norris Indus., Inc. v. Int’l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983); *see also Esquire, Inc.*, 591 F.2d at 800.

The Board does not understand Halo to be claiming that the design features of the Mars Chair clearly are physically separable. Halo, however, argues that the metal frame is conceptually separable because it “is literally capable of ‘standing’ and existing independently of the utilitarian aspects of the chair.” Second Request at 23. Halo misstates the Office’s test for conceptual separability.<sup>1</sup> As stated above, for a feature to be conceptually separable, it must be capable of being “imagined separately and independently from the useful article without destroying the basic shape of that article.” COMPENDIUM (THIRD) § 924.2(B). The metallic frame cannot be imagined separately and independently from the rest of the Mars Chair without destroying the basic shape of the article. First, the metallic frame plays an important structural role, supporting the seat and back of the chair. Without the frame, the seat would rest directly on the floor, and the back would lack horizontal support. Second, the frame performs another function as an armrest. *See Heptagon Creations, Ltd. v. Core Group Marketing LLC*, 507 F. App’x 74, 75-76 (2d Cir. 2013) (stating that with respect to a “Cacoon Chair,” the design of the arms “was also dictated by the function concern that a person sitting in the chair have a surface on which to rest his arms.”). Finally, even were the metallic frame conceptually separable—which it is not—it is merely a simple geometrical form that lacks sufficient originality to warrant copyright protection. Each of the two pieces comprising the frame is a simple four-sided figure with another four-sided figure cut out of the center. As noted above, the “Copyright Act does not protect common geometric shapes.” COMPENDIUM (THIRD) § 906.1.

The design features of the Aviator Valkyrie Desk also are clearly not physically separable, except for the stainless steel plates that could be removed from the wooden core without threatening the physical integrity of the desk. The stainless steel plate pattern, however, does not manifest adequate originality to qualify for copyright protection. The plates do not intersect on a perfect, square grid, but the deviations from a grid pattern are slight enough that the pattern overall does not possess sufficient originality to warrant copyright protection. *See* COMPENDIUM (THIRD) § 906.1 (the Copyright Act does not protect common geometric shapes such as straight or curved lines). It is irrelevant that the stainless steel plate pattern, as Halo describes it, is “evocative of the hull of a classic, World War II airplane.” Second Request at 22. The “symbolic meaning or impression of a work is

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<sup>1</sup> As noted above, the Office’s interpretation of conceptual separability is entitled to deference. *See Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (9th Cir. 2014); *Custom Chrome, Inc. v. Ringer*, No. CIV. A. 93-2634, 1995 WL 405690, at \*5 (D.D.C. June 30, 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). Thus, the Office evaluates the conceptual separability of the creative features of articles under its own test, and not the test proposed by Halo.

irrelevant” to the determination of whether a work is copyrightable. COMPENDIUM (THIRD) § 310.3.

Halo argues that the remaining design features—the stainless steel plate pattern, the increasing width of the desk surface, the desk stanchion, the shelving, and the filleted attachment points for the tail rudder—constitute conceptually separable features. The Office disagrees. It is impossible to imagine the increasing width of the desk surface separately and independently from the desk surface without destroying its basic shape. COMPENDIUM (THIRD) § 924.2B. Were the stanchion and shelves to be removed, the desk surface would lack vertical support, and would be nothing more than a piece of wood lying directly on the ground, useless as a desk. The Office is unable to identify the filleted attachment points for the tail rudder in the deposit.

In sum, the Board finds that (except for the stainless steel plating in the Aviator Valkyrie Desk) the Works contain no separable design features, and with respect to the stainless steel plating, the level of creative authorship is, at best, *de minimis*, and too trivial to enable copyright registration.

#### 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 Works. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.

BY:   
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Copyright Office Review Board