



United States Copyright Office

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November 22, 2016

Robert A. Seldon
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**Re: Second Request for Reconsideration for Refusal to Register Desk Accessory;
Correspondence ID: 1-1E0BTFY**

Dear Mr. Seldon:

The Review Board of the United States Copyright Office ("Board") has considered Splash Creative, Inc.'s ("Splash") second request for reconsideration of the Registration Program's refusal to register a sculpture claim in the work titled "Desk Accessory" ("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 sculptural casing for a pencil sharpener. The sculptural casing is made up of three three-dimensional shapes: a hexagonal base, a circular top, and a hollow circular ring placed over the seam where the top and base components meet, such that the Work resembles the upper portion of a standard number 2 pencil. The deposit copy includes an image showing the Work produced in various colors, namely, yellow, pink, and white with a black top. The Work is depicted below.



Front View

Note: front, back, left side and right side views are the same.



Exhibit "E"

II. ADMINISTRATIVE RECORD

On April 24, 2015, Splash filed an application to register a copyright claim in the Work. In a June 4, 2015 letter, a Copyright Office registration specialist refused to register the claim, finding that it “must be refused because it is a ‘useful article’ which does not contain any separable authorship needed to sustain a claim to copyright.” Letter from Annette Coakley, Registration Specialist, to Robert Seldon (June 4, 2015) (“First Refusal”).

In a letter dated October 14, 2015, Splash requested that the Office reconsider its initial refusal to register the Work. Letter from Robert Seldon to U.S. Copyright Office (October 14, 2015) (“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 “does not contain any separable, copyrightable features.” Letter from Stephanie Mason, Attorney-Advisor, to Robert Seldon (January 8, 2016) (“Second Refusal”).

In a letter dated March 23, 2016, Splash 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 Robert Seldon, to U.S. Copyright Office (March 23, 2016) (“Second Request”). In that letter, Splash described the Work as “a sculptural interpretation of a pencil stub which serves as a decorative housing . . . [for a] pencil sharpener.” *Id.* at 1. Splash stated that the Work was “physically separable” from and “exist[ed] independently of the utilitarian aspects of the sharpener mechanism, and [was] therefore entitled to registration.” *Id.* at 3 (citing *Ted Arnold Ltd. V. Silver Craft Co.*, 259 F. Supp. 733, 734 (S.D.N.Y. 1966) (finding the antique-telephone-shaped casing of a pencil sharpener to be physically separable and sufficiently creative to be copyrightable)). In addition, Splash provided an exhibit showing the separate pencil sharpening mechanism inside the sculptural casing in order to illustrate the physical separability of the casing from the pencil sharpener itself. *Id.* at 14 (Exhibit E). Furthermore, with respect to the casing, Splash argued that “there [was] a large degree of creative expression in the Work . . . [such as] the particular dimensions, colors and color variations, and the design for the faux-metal casing (which does not match actual pencils).” *Id.* at 3.

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. See COMPENDIUM (THIRD) § 924.2(B). 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).

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.

To determine whether a work “contains a sufficient amount of original and creative authorship” the Office “will focus on the appearance . . . of the work that has been submitted for registration” and “will not consider possible design alternatives,” such as “the fact that a work could be presented in a different color, in a different size, or with a different orientation.” COMPENDIUM (THIRD) § 310.8. 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 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 contains physically separable sculptural features, but that these features do not exhibit the requisite creative authorship necessary to sustain a claim to copyright.

As noted above, the test for physical separability asks whether pictorial, graphic, or sculptural features in a useful article can be physically separated from the article by ordinary means. See COMPENDIUM (THIRD) § 924.2(A). The Registration Program previously found that the Work was not physically separable because it appeared that the “sharpening apparatus [was] embedded in the body of the pencil.” Second Refusal at 1. This finding was based on images submitted with the application and First Request, which showed the exterior of the Work from many angles, including a “Bottom View” that suggested the sharpening mechanism was embedded into and not detachable from the casing. Based on these exterior views of the Work, the Registration Program concluded that “[u]nlike the telephone sculpture attached to a pencil sharpener in *Ted Arnold Ltd. v. Silver Craft Co.*, 259 F. Supp. 733, 734 (S.D.N.Y. 1966), there is no way to physically divorce the elements of your work from the pencil sharpener itself.” Second Refusal at 2. The Second Request included a new image showing the placement of the pencil sharpening mechanism inside the sculptural casing of the Work, and Splash argued that this image demonstrated the sharpener was readily detachable from the work. Second Request at 14 (Exhibit E). Based on this new information, the Board agrees that the utilitarian aspect of the work, *i.e.*, the pencil sharpening mechanism, appears separable “by ordinary means” from the sculptural features of the Work contained in the pencil stub-shaped casing and therefore meets the test for physical separability. See COMPENDIUM (THIRD) § 924.2(A); *Ted Arnold*, 259 F. Supp. at 734.

The Board finds, however, that the Work’s separable sculptural features, *i.e.*, the pencil stub-shaped casing, are not sufficiently original to qualify for copyright protection. The Work is merely a larger version of the familiar and standard no. 2 pencil—or, as Splash puts it, “the favorite and requisite tool[] of an artist.” Second Request at 9. As explained above, the copyright law does not protect mere variations on familiar designs. See 37 C.F.R. § 202.1(a) (prohibiting registration of “familiar symbols or designs”); COMPENDIUM (THIRD) § 313.4(j) (providing non-exhaustive list of familiar symbols and designs); § 906.2 (mere variations on familiar symbols or designs are not protectable). While works that combine familiar symbols into a larger design may be registered if they are sufficiently creative, here, the entire Work is a slavish representation of a standard pencil. Even apart from the fact that the work is merely a depiction of a pencil, the Work lacks sufficient creativity for the additional reason that it is merely comprised of standard circles and hexagonal

shapes, stacked in a simplistic linear manner that does not “go beyond the display of a few geometric shapes in a preordained or obvious arrangement.” COMPENDIUM (THIRD) § 906.1; *see also Feist*, 499 U.S. at 362. Accordingly, the Board finds that, viewed as a whole, the Work does not exhibit sufficient creativity to qualify for copyright protection.

Splash’s arguments in favor of registration do not persuade the Board otherwise. First, Splash asserts that “there [was] a large degree of creative expression in the Work . . . [such as] the particular dimensions, colors and color variations, and the design for the faux-metal casing (which does not match actual pencils).” Second Request at 3. As explained above, to determine whether a work is copyrightable, “[i]t is not the variety of choices available to the author that must be evaluated, but the actual work that the author created.” COMPENDIUM (THIRD) § 310.8. Therefore, the fact that the Work “could have been wider, shorter, longer, fatter, taller” is irrelevant to the evaluation of the Work’s own features for sufficient creativity to qualify for copyright protection. Second Request at 8. Moreover, to the extent that the Work itself manifests creative decisions related to the Work’s dimension, colors, and design of the faux-metal casing, these features naturally flow from the idea of a pencil sculpture and as such are considered standard and unprotectable. *See Satava*, 323 F.3d at 810-11.

Finally, the Supreme Court’s rule against considering marketability, as articulated in *Bleistein*, makes clear that whether “customers are . . . likely to buy the product . . . as a conversation piece” is also irrelevant to a determination whether the Work possesses sufficient creativity to qualify for copyright protection. Second Request at 3; *see Bleistein*, 188 U.S. at 239.

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.

BY:



Regan A. Smith
Copyright Office Review Board