



United States Copyright Office

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Re: Second Request for Reconsideration for Refusal to Register Fiore Sculpture; Correspondence ID: 1-LYOBWD

Dear Mr. Frazer:

The Review Board of the United States Copyright Office ("Board") has considered SIP, LLC's ("SIP's") second request for reconsideration of the Registration Program's refusal to register a sculpture claim in the work titled "Fiore Sculpture" ("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 ceramic container designed for use as a candle warmer. According to SIP's Scentsy catalog, a small dish may be placed on top of the warmer and filled with a specially formulated wax. The warmer houses a low-watt electric light bulb that emits heat when it is turned on. This melts the wax inside the dish, which in turn, emits a pleasant aroma. SCENTSY, SPRING SUMMER 2014 CATALOG 4 (2014), available at [https://scentsy.com/Portals/5/Images/Catalog/PDF/2014 Scentsy-Catalog-Spring-Summer-2014-United-States.pdf](https://scentsy.com/Portals/5/Images/Catalog/PDF/2014%20Scentsy-Catalog-Spring-Summer-2014-United-States.pdf). Near the top of the container are a series of small holes. The container is colored dark beige, with a raised black cross-hatched band around the center and a sculpted black sunflower design in the middle, bordered in burnt orange.

A reproduction of the Work is set forth below:



II. ADMINISTRATIVE RECORD

On August 26, 2013, SIP filed an application to register a copyright claim in the Work. In a September 5, 2013 letter, a Copyright Office registration specialist refused to register the claim, finding that it “lacks the authorship necessary to support a copyright.” Letter from Annette Coakley, Registration Specialist, to Brad Frazer, Hawley Troxell Ennis & Hawley LLP (Sept. 5, 2013).

In a letter dated December 4, 2013, SIP requested that the Office reconsider its initial refusal to register the Work. Letter from Bradlee R. Frazer, Hawley Troxell Ennis & Hawley LLP, to U.S. Copyright Office (Dec. 4, 2013) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office reevaluated the claims and again concluded that the Work “is a useful article that does not contain any authorship that is both separable and copyrightable.” Letter from Stephanie Mason, Attorney-Advisor, to Bradlee R. Frazer, Hawley Troxell Ennis & Hawley LLP (Mar. 31, 2014).

In a letter dated June 27, 2014, SIP 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 Bradlee R. Frazer, Hawley Troxell Ennis & Hawley LLP, to U.S. Copyright Office (Jun. 27, 2014) (“Second Request”). In that letter, SIP argued that the Work is “fundamentally, a work of art” and should not be evaluated as a useful article. *Id.* at 4. Moreover, SIP maintained that the Work “expresses originality in multiple elements . . . creatively selected, ordered, and arranged in a way that easily meets the minimal test of creativity set forth in *Feist*.” *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 “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 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); *see also Mazer v. Stein*, 347 U.S. 201 (1954) (sculpture of Balinese dancer eligible for copyright protection even

though intended for use as lamp base); *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (pencil sharpener casing 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 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*; *see also* 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 utilitarian 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.

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.

An assessment of the Work’s copyrightability must proceed from its status as a useful article. SIP argues that the only utilitarian elements of the Work are its electrical components, and that once those are removed, either physically or conceptually, the resultant artifact is entirely non-utile—“a piece of *home décor*, not a household appliance.” Second Request at 3-4 (emphasis in original). We disagree.

The Work’s candle-warming function cannot be so easily disengaged from its artistic components. Bearing in mind the rule that there can be no copyright protection for the “overall shape or configuration of a utilitarian article,” *Esquire, Inc.*, 591 F.2d at 800, it is clear that many of the elements of the Work that SIP identifies as “act[s] of creative expression”—the size, the “round, undulating shape,” the placement of the light-emitting holes, the shape of the top, and the shape of the base, Second Request at 4—are in fact part and parcel of the useful article itself. Moreover, because these elements make up the very form and shape of the Work, there can be no conceptual separation of them from the underlying useful article. *See* COMPENDIUM (THIRD) § 924.2(B). Because these elements are non-separable, any potential creativity deriving from their selection and arrangement need not be analyzed by the Board.

The design on the outside of the Work is a collection of elements that are conceptually separable, in that this arrangement of shapes can be imagined as existing separately on a piece of paper, without destroying the Work’s shape. *See id.* The individual elements, however—a simple sunflower design, colored banding and cross-hatching—are not copyrightable. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of, *inter alia*, “familiar symbols or designs”). Neither is the arrangement of elements copyrightable, because it is merely a collection of standard design elements evincing *de minimis* creativity. While an arrangement of unprotectable shapes and common design elements can, when viewed as a whole, be registerable, the combination must be arranged “in a distinctive manner indicating some ingenuity.” *Atari Games Corp.*, 888 F.2d at 883. A basic flower design combined with colored banding is a simplistic arrangement that fails to exhibit either distinctiveness or ingenuity, and as such does not meet the creativity requirement for copyright protection.

Overall, we find that the Work is a useful article with some conceptually separable artistic elements. Those elements lack creative authorship, however, and thus the Work is not copyrightable.

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:



Chris Weston
Copyright Office Review Board