



United States Copyright Office

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August 24, 2016

Robert M. Wasnofski, Jr.
Dorsey & Whitney LLP
51 West 52nd St.
New York, New York 10019-6119

Re: Second Request for Reconsideration for Refusal to Register L322 Delta Wing and L322 Turbine; Correspondence ID: 1-MCGG6X

Dear Mr. Wasnofski:

The Review Board of the United States Copyright Office (the “Board”) has considered Jaguar Land Rover Limited’s (“Jaguar Land Rover’s”) second request for reconsideration of the Registration Program’s refusals to register sculpture copyright claims in the works titled “L322 Delta Wing” and “L322 Turbine” (the “Works”). After reviewing the applications, the deposit copies, and the relevant correspondence, along with the arguments set forth in the second request for reconsideration, the Board affirms the Registration Program’s denials of registration.

I. DESCRIPTION OF THE WORKS

L322 Delta Wing is the outer “cosmetic face” of a wheel, that is, a wheel cover visible when the wheel is mounted on a car. L322 Delta Wing’s design consists of the following elements: a “hub” where the Work can be connected to a vehicle via five bolts, five “V” shaped spokes that connect from the Work’s outer rim to center, each of which contains a smaller “V” shaped rectangle flanked by two yet smaller “V” shaped rectangles, and an outer rim. A “Land Rover” logo is placed at the center of the wheel cover.

L322 Turbine is another outer “cosmetic face” of a wheel. Its design consists of the following elements: a “hub” where the Work can be connected to a vehicle via five bolts, a starburst-like feature that surrounds and connects to the “hub,” and fifteen spokes that extend inward from the Work’s outer rim toward the “hub,” alternating between two spokes that meet a

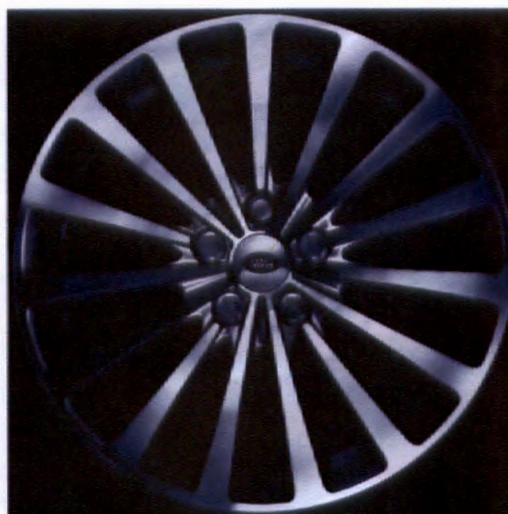
“Land Rover” logo placed at the center of the wheel cover, followed by one spoke that extends only so far as one of the bolts.

Reproductions of the Works are set forth below:

L322 Delta Wing



L322 Turbine



ADMINISTRATIVE RECORD

On March 26, 2013, Jaguar Land Rover filed applications to register the two Works at issue in this second request for consideration. Specifically, Jaguar Land Rover asserted claims to copyright in “Sculpture.”

In a letter dated April 10, 2014, a Copyright Office registration specialist refused to register the Works, finding that “they are ‘useful articles’ which does [*sic*] not contain any separable features that are copyrightable.” *See* Letter from Larisa Pastuchiv, Registration Specialist, to Robert Wasnofski, Jr., Dorsey & Whitney LLP (Apr. 10, 2014) (emphasis in original).

In a letter dated July 10, 2014, Jaguar Land Rover requested that the Office reconsider its initial refusal to register the Works. *See* Letter from Robert M. Wasnofski, Jr., Dorsey & Whitney LLP, to U.S. Copyright Office (July 10, 2014) (“First Request”). After reviewing the Works in light of the points raised in the First Request, the Office reevaluated the claims and in a letter dated November 6, 2014, again concluded that the Works “are useful articles that do not contain any authorship that is both separable and copyrightable.” Letter from Stephanie Mason, Attorney-Advisor, to Robert Wasnofski, Jr., Dorsey & Whitney (Nov. 6, 2014).

In a letter dated February 6, 2015, Jaguar Land Rover requested that, pursuant to 37 C.F.R. § 202.5(c), the Office again reconsider its refusal to register the Works. Letter from Robert M. Wasnofski, Jr., Dorsey & Whitney LLP, to U.S. Copyright Office (Feb. 6, 2015)

(“Second Request”). In its Second Request, Jaguar Land Rover did not dispute the Office’s prior determination that the Work is a useful article. Jaguar Land Rover did, however, assert that the Works included design features that are separable from the Work’s utilitarian function. Jaguar Land Rover also disagreed with the Office’s conclusion that those design features lack a sufficient amount of separable original authorship to qualify for copyright protection. *Id.* at 4. Specifically, Jaguar Land Rover argued that the “sculptural designs of the ‘cosmetic faces’ certainly meet [the] threshold [of creative authorship necessary to warrant copyright protection] as they depict a high level of creativity with many alternating contours.” *Id.*

II. DISCUSSION

A. *The Legal Framework: 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); 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.; 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.

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 do not contain the requisite separable authorship necessary to sustain a claim to copyright.

First of all, it is undisputed that wheel covers are useful articles. *See, e.g., Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (wheel cover determined to be a useful article). Thus, for there to be any consideration of the Works' design features, the features must be either physically or conceptually separable from the Works' utilitarian functions as vehicle wheel covers. *See id.* at 923; *Esquire, Inc.*, 591 F.2d at 800.

Jaguar Land Rover argues that the Works include “cosmetic faces” that are “conceptually separate from the wheels themselves” and contain separable “ornamental design features” that are merely “superimposed over the basic shape” of wheel covers. Second Request at 2. The Board disagrees. Based on the deposits Jaguar Land Rover submitted with its copyright applications, we are unable to distinguish the “ornamental design” that is allegedly “superimposed over the basic shape” of the wheel covers from the wheel covers themselves. Indeed, the deposits seem to demonstrate the opposite—designs that are so intertwined with the basic functioning of standard wheel covers that it is impossible to imagine a way to physically or conceptually separate these elements from the wheel covers without destroying their basic shape or purpose. *See* COMPENDIUM (THIRD) § 924.2(B). As in *Norris Industries*, “the pattern

resulting from the placement of spokes is an inseparable component of the wheel cover.” *Norris Indus., Inc.*, 696 F.2d at 923. To imagine the Works’ “ornamental design” features separately from the Works overall leaves little more than outer rims and interior bolt hubs. As a result, the wheel covers and their “cosmetic faces” cannot be pictured side by side “as fully realized, separate works—one an artistic work and the other a useful article.” COMPENDIUM (THIRD) § 924.2(B).

III. 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