



United States Copyright Office

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October 13, 2016

Michael J. Frodsham, Esq.
Workman Nydegger
60 East South Temple, Suite 1000
Salt Lake City, Utah 84111

**Re: Second Request for Reconsideration for Refusal to Register Ribbon Sculpture Design B;
Correspondence ID: 1-ZNEA8H**

Dear Mr. Frodsham:

The Review Board of the United States Copyright Office ("Board") has considered 3form, LLC's ("3form's") second request for reconsideration of the Registration Program's refusal to register a three-dimensional artwork claim in the work titled "Ribbon Sculpture Design B" ("Work"). 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 Work is a lighting fixture that consists of a light bulb suspended by an electrical cable and two support wires and surrounded by a shade. The shade is constructed of red strips of resin that are woven and twisted to form a hollow shell and that surround the light bulb. The Work is depicted below.



II. ADMINISTRATIVE RECORD

On April 9, 2014, 3form filed an application to register a copyright claim in the Work. In a September 2, 2014 letter, a Copyright Office registration specialist refused to register the claim, finding that it “lacks the authorship necessary to support a copyright claim.” Letter from Adrienne Brown, Registration Specialist, to Michael Frodsham, Workman Nydegger, at 1 (Sept. 2, 2014).

In a letter dated October 3, 2014, 3form requested that the Office reconsider its initial refusal to register the Work. Letter from Michael J. Frodsham, Workman Nydegger, to U.S. Copyright Office (Oct. 3, 2014) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and 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 Michael Frodsham, Workman Nydegger, at 1 (Feb. 19, 2015).

In a letter dated May 14, 2015, 3form 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 Michael J. Frodsham, Workman Nydegger, to U.S. Copyright Office (May 14, 2015) (“Second Request”). In that letter, 3form stated that “there is simply no *per se* prohibition on receiving copyright protection for certain features of ‘useful articles’ even if the useful article happens to be a light fixture.” *Id.* at 7. 3form further argued that “the design is physically separable from any such light fixture as evidenced by the other ribbon-like sculptures . . . in 3form, LLC’s line that have already been registered,” and that the Work “is also conceptually separable from any light fixture on which it can be incorporated because the concept of a flourishing blossom formed by the ribbons is similarly separable from the concept of a light fixture.” *Id.* at 9. Finally, 3form argued that the Work “is an original selection, coordination, and arrangement of billowing shapes, undulating patterns, colors, and textures aesthetically chosen by 3form LLC and evidencing the requisite sculptural expression and creative authorship to merit copyright protection.” *Id.* at 11.

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separability*

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).

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.

As depicted in the deposit materials, the Work includes a light bulb and a cable supplying electrical current to that light bulb, and, as such, is a lamp, which is a useful article. While it is possible for the design features of light fixtures to receive copyright protection, those features must be either physically or conceptually separable from the Work's utilitarian functions. Thus, while "there is simply no *per se* prohibition on receiving copyright protection for certain features of 'useful articles' even if the useful article happens to be a light fixture," Second Request at 7, the protectable elements must be separable to be eligible for copyright protection, COMPENDIUM (THIRD) § 924.2(A).

Here, if the ribbon design were to be physically separated from the Work, nothing would remain except for a light bulb suspended by an electrical cable. As such, the Work would still illuminate the room, but would lose the light-softening properties of lamps equipped with lampshades. Thus, because the design could not be physically removed without altering the useful aspects of the article—the lamp—the design is not physically separable. *Id.* 3form's reliance on *Spectrum Creations, Inc. v. Catalina Lighting, Inc.*, No. Civ.A.SA-00-CA-875-F, 2001 WL 1910566 (W.D. Tex. Aug. 1, 2001) does not persuade the Board that the design is physically separable. In that case, the court was faced with determining whether a stained glass design that had been used on lamp could be protectable. It is not entirely clear whether the court was addressing specifically physical separability, and the stained glass design at issue in that case had been used "on more than 35 items, including, *but not limited to*, lighting fixtures and lamps." *Id.* at *7 (emphasis added). The court did not use the Office's physical separability test, and, here, 3form does not identify using the ribbon design on items other than lamps, thus all of the examples are of useful articles. The Office thus finds that the Work is not physically separable.

As to conceptual separability, a pictorial, graphic, or sculptural feature of a work satisfies this test "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). 3form claims that the Work meets this test because "the concept of a flourishing blossom formed by the ribbons is . . . separable from the concept of a light fixture." Second Request at 9. This argument misunderstands the conceptual separability test. The relevant question is whether the Work's utilitarian and artistic aspects can exist "side by side" with one another. The ribbons are conceptually inseparable components of the Work because the ribbons and the light bulb and electrical cable cannot exist side by side and be perceived as fully realized, separate works: with the ribbons removed from the Work, it would no longer be a useful article capable of illuminating a room with lampshade-softened light. 3form's reliance on *Sunset Lamp Corp. v. Alsy Corp.* to support its argument is unpersuasive. *Sunset Lamp* concerned the copyrightability of a banana leaf design on a lamp, and the court in that case held that because "it takes no great feat of ratiocination to separate the concept of the banana leaves from the concept of the lamps[,] . . . the design is copyrightable in this respect." *Sunset Lamp Corp. v. Alsy Corp.*, 698 F. Supp. 1146, 1151 (S.D.N.Y. 1988). The *Sunset Lamp* court, however, relied on a Second Circuit decision that employed an approach to conceptual separability different from that adopted by the Copyright Office. See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) ("The primary ornamental aspect of the [belt] buckles is conceptually separable from their subsidiary utilitarian function."). On issues including separability, where the provisions of the Copyright Act are ambiguous, courts have deferred to Office interpretations. See, e.g., *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (9th Cir. 2014) ("Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function.' . . . We think § 101 is sufficiently ambiguous to justify deference to administrative interpretations.") (citations omitted). Therefore, the Office finds that the Work is not conceptually separable.

The Office agrees with 3form that the Work would manifest sufficient creative authorship were it not a useful article. Because the creative features are neither physically nor conceptually separable from the Work's utilitarian function as a lamp, however, the Review Board must affirm the Office's previous refusal to register a copyright claim in the Work.

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.

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Copyright Office Review Board