



**Copyright Review Board**

United States Copyright Office · 101 Independence Avenue SE · Washington, DC 20559-6000

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**Re: Second Request for Reconsideration for Refusal to Register Sculpture of Locker (Correspondence ID: 1-3XNOMTF; SR # 1-8073830571)**

Dear Mr. Walton:

The Review Board of the United States Copyright Office (“Board”) has considered Longhorn Locker Company’s (“Longhorn’s”) second request for reconsideration of the Registration Program’s refusal to register a three-dimensional art claim in the work titled “Sculpture of Locker” (“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 locker for professional sports teams with the following decorative features: (1) a decorative football-shaped cut-out centered along a thin horizontal opening molded into the locker’s seatback; (2) metal horizontal trim pieces on the locker’s shelving and footlocker; (3) back-lit colored name plate on the top of the locker that displays “Drew Brees 9”; (4) metallic insert on the locker’s footlocker with the round grill pattern; and (5) decorative contours and carvings on the locker’s side panels. The applicant expressly disclaims the New Orleans Saints’ logo and individual fleur de lis insignia.

The Work is as follows:



## II. ADMINISTRATIVE RECORD

On September 16, 2019, Longhorn filed an application to register a copyright claim in the Work.<sup>1</sup> In a September 17, 2019, letter, a Copyright Office registration specialist refused to register the claim, finding that the Work “is a useful article, and determined that it does not contain any non-useful design element that could be copyrighted and registered.” Initial Letter Refusing Registration from U.S. Copyright Office to James E. Walton (Sept. 17, 2019).

Longhorn subsequently requested that the Office reconsider its initial refusal to register the Work. Letter from James E. Walton to U.S. Copyright Office (Oct. 8, 2019) (“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 was a useful article whose separable features consisted of “common and familiar shapes that do not contain the requisite amount of creativity.” Refusal of First Request for Reconsideration from U.S. Copyright Office to James E. Walton, at 5 (Feb. 20, 2020).

In response, Longhorn 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 James E. Walton to U.S. Copyright Office (Sept. 16, 2020) (“Second Request”). In that letter, Longhorn asserts that the “work comprises unique and highly-creative decorations and ornamentations on a sports locker.” *Id.* at 4. Further, Longhorn contends that the Work is sufficiently creative because it is a “creative interpretation of a stylized football field with a sleek and contemporary feel.” *Id.* Finally, Longhorn provides an extensive analysis noting that the Work was granted a design

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<sup>1</sup> The Office notes that Longhorn separately obtained a registration for photographs depicting the Work and used that registration in the pending infringement case *Longhorn Locker Co. v. Hollman, Inc.*, No. 3:19-CV-02872-K (N.D. Tex. 2019). The court in that case submitted a request to the Office pursuant to section 411(b) of the Copyright Act after the defendants challenged the validity of the registration. The Office’s response is available at <https://www.copyright.gov/rulings-filings/411/longhorn-locker-company-v-hollman-inc-response.pdf>.

patent<sup>2</sup> and that its design patent is separate and distinct from others issued by the U.S. Patent and Trademark Office. *Id.* at 7–29.

### III. DISCUSSION

#### A. *The Legal Framework*

##### 1) *Useful Articles and Separability*

Copyright does not protect useful articles as such, which are defined in the Copyright Act 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. Importantly, however, artistic features applied on or incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works under sections 101 and 102(a)(5) of the Copyright Act. This protection is limited to the “‘pictorial, graphic, or sculptural features’ [that] ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’” *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (quoting 17 U.S.C. § 101).

To assess whether an artistic feature incorporated into the design of a useful article is protected by copyright, the Office examines whether the feature “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” *Id.* at 1007; *see also* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924 (3d ed. 2021) (“COMPENDIUM (THIRD)”). This analysis focuses on “the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction [because the] statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature.” *Star Athletica*, 137 S. Ct. at 1013. Put another way, while useful articles as such are not copyrightable, if an artistic feature “would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article.” *Star Athletica*, 137 S. Ct. at 1011; 17 U.S.C. § 113(a) (“[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.”); *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”).

##### 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

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<sup>2</sup> U.S. Patent No. D826,602.

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. *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 that “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 stereotypical elements in a glass sculpture of a jellyfish including clear glass, an oblong shroud, bright colors, vertical orientation, and the 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.” U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1 (3d ed. 2021) (“COMPENDIUM (THIRD)”); *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, the Board reiterates that the issuance of a design patent for a work has no relevancy to the determination of separability or copyrightability. While the Board acknowledges that both copyright and patent laws contain a requirement of originality, these areas of law and the policies they serve are aimed at protection of different aspects of intellectual property. Specifically, patent law contemplates that design patents can be issued to protect ornamental characteristics of useful articles, which is expressly contrary to copyright law.<sup>3</sup> Instead, “utility” or “usefulness” actually militates against copyrightability, leading to instances where a design patent might be granted for a work that is not copyrightable. *See, e.g., Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337, 1346 (Fed. Cir. 2020) (finding that the design of a crayon-shaped chalk holder could not be separated from its useful function); *Johnson v. Levi Strauss*, 2009 U.S. Dist. LEXIS 80630 (S.D. Ohio Aug. 5, 2009) (invalidating copyright registration for a useful article despite the issuance of a design patent).

### ***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 original authorship necessary to sustain a claim to copyright.

As Longhorn acknowledges, the Work—a locker—is a useful article. *See* Second Request at 4 (“Longhorn is not seeking protection for the locker itself nor the locker’s mechanical or utilitarian aspects.”). The Copyright Act does not protect useful articles, but does protect a feature incorporated into the design of a useful article if that feature “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article, and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” *Star Athletica*, 137 S. Ct. at 1004–05.

Here, Longhorn asserts that the locker contains the following separable features: (1) the overall shape of the folding seatbacks and individual pieces of the seatback as well as a decorative football-shaped cut-out centered along a thin horizontal opening molded into the locker’s seatback; (2) metal horizontal trim pieces on the locker’s shelving and footlocker; (3)

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<sup>3</sup> Compare 17 U.S.C. § 101 (defining “[p]ictorial, graphic, and sculptural works” to specifically exclude “mechanical or utilitarian aspects”), with U.S. Patent and Trademark Office, *A Guide To Filing A Design Patent Application*, at 2, [http://www.uspto.gov/web/offices/com/iip/pdf/brochure\\_05.pdf](http://www.uspto.gov/web/offices/com/iip/pdf/brochure_05.pdf) (“In general terms, a utility patent protects the way an article is used and works (35 U.S.C. § 101), while a ‘design patent’ protects the way an article looks (35 U.S.C. § 171). Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance. While utility and design patents afford legally separate protection, the utility and ornamentality of an article are not easily separable. Articles of manufacture may possess both functional and ornamental characteristics.”).

back-lit colored name plate on the top of the locker that displays “Drew Brees 9”; (4) metallic insert on the locker’s footlocker with the round grill pattern; and (5) decorative contours and carvings on the locker’s side panels. Second Request at 5–6. None of these, however, individually or as a whole, warrant copyright protection.

First, many of the features are not separable at all. The decorative contours and carvings on the locker’s side panels and the overall shape of the seatback are not separable. They cannot be imagined separately from the locker because “copyright law does not protect the overall form, shape, or configuration of the useful article itself, no matter how pleasing or attractive it may be.” COMPENDIUM (THIRD) § 924.3(F). Similarly, the individual pieces of the seatback cannot be imagined separately because the seatback sections are themselves considered a useful article whose overall shape cannot be considered. 17 U.S.C. § 101 (“An article that is normally a part of a useful article is considered a useful article.”).

Second, for those features that are separable, they are not sufficiently creative to support a claim to copyright, individually or as a whole. Specifically, the Board agrees that the football-shaped cut-out in the seatback, horizontal trim pieces, name plate, and metallic insert are separable because they can be perceived as two- or three-dimensional works of art separately from the useful article. These features, however, simply consist of uncopyrightable rectangles (one with a parallel circular hole pattern), three long lines, and a football shape. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of familiar symbols or designs); *id.* § 202.10(a) (stating that “to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form”); COMPENDIUM (THIRD) § 906.1 (providing two rows of parallel white dots on a purple background as an example of insufficient arrangement of geometric shapes).

The question, therefore, is whether these unprotectable separable elements, as a whole, are sufficiently creative to entitle the Work to copyright protection. Here, the separable features are stacked vertically and in parallel to one another. Their placement with respect to the locker is obvious. The trim is placed at the edge of the shelves and seat cushion, the football shape is placed at the juncture of seatback pieces, and the nameplate is placed in a position of high visibility. While a sufficiently creative arrangement of otherwise unprotectable shapes may provide a basis for copyrightability, a mirror image arrangement of evenly spaced shapes amounts to a garden variety pattern that falls short of the Copyright Act’s requirements for protection. *See Satava*, 323 F.3d at 811 (“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”); *Coach*, 386 F. Supp. 2d at 496 (upholding the Copyright Office’s refusal to register 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”); COMPENDIUM (THIRD) § 906.1 (providing example of a solid color rectangle with evenly spaced symmetrical circles as a combination of common shapes that lacks sufficient creative expression).

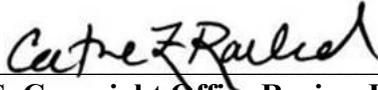
Lockhorn, however, asserts that these garden variety choices are sufficiently creative because they constitute a “creative interpretation of a stylized football field with a sleek and contemporary feel.” Second Request at 4. Lockhorn further states “the choice to adorn the

locker with stylized yard lines made of metallic trim pieces adds a feeling of movement to Longhorn's work." *Id.* These assertions, however, are irrelevant because they merely point to the subjective interpretation of the Work, which is not a factor that the Board considers when evaluating a work for copyright protection. COMPENDIUM (THIRD) § 310.3.

Finally, Lockhorn relies heavily on the design patent covering the Work and its comparison to other design patents for unrelated lockers and cabinets. Much of this analysis is focused on the overall shape of the locker and seatbacks, which is irrelevant because, as previously discussed, the overall form of a useful article is not separable in copyright law. Moreover, the presence of a design patent has no impact on copyrightability generally. 37 C.F.R. § 202.10(a) ("The grant of protection under the law for a utility or design patent will not affect the registrability of a claim in an original work of pictorial, graphic, or sculptural authorship."). And, to the extent that Lockhorn is attempting to rely on competing design patents to establish that it had a variety of choices when designing the Work, Second Request 7–11, the Board notes that the availability of other creative choices in creating a work is also not a factor in evaluating the copyrightability of a work. COMPENDIUM (THIRD) § 310.8 ("The creative process often requires many choices involving the size, coloring, orientation, proportion, configuration, perspective, or other constituent elements of the work. . . . It is not the variety of choices available to the author that must be evaluated, but the actual work that the author created.").

#### 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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**U.S. Copyright Office Review Board**

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