COPYRIGHT
OFFICE

December 31, 1996

Re: Fairway Collection I
Copyright Office Control NO: 60-409-9761 (L)

Dear Ms. Gallenson:

LIBRARY
OF
CONGRESS

This concerns your letter dated July 19, 1996, requesting an Appeal Board determination regarding the registration of a collection of furniture designs entitled FAIRWAY COLLECTION I. The Appeals Board has met on your request and has decided to affirm the Examining Division's refusal to register.

Administrative Record

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On November 29, 1994, the Copyright Office received an application, fee and identifying reproduction for your client's published collection of furniture designs. The application stated that the nature of the authorship in the furniture pieces was three dimensional sculpture. The collection contained designs for eight items of furniture: two tables, two lamps, a barstool, a chair, a hat rack, and a magazine rack. In a letter dated March 9, 1995, copyright examiner James Shapleigh of the Visual Arts Section refused registration on the grounds that the furniture designs were useful articles lacking "separable" copyrightable authorship.

In a letter dated May 25, 1995, you appealed the refusal to register largely on the basis of the Supreme Court's decision in Mazer v. Stein, 347 U.S. 201 (1954), and the wording of the copyright statute. You argued that if the utilitarian aspects of the furniture design were removed, the sculpture would remain. You stated that "[w]ith respect to applicant's table and floor lamps, if the light bulb and shade are removed, the sculpture remains. With respect to the applicant's coffee and end tables, if the table top is removed, the sculpture again still remains..." (Letter from Gallenson to Shapleigh, 5/25/95, at 6).

In a letter dated March 22, 1996, David Levy, Attorney Advisor for the Visual Arts Section, again refused registration. Mr. Levy noted that the works in question employ useful articles, golf clubs, as structural support for other useful articles, i.e., the furniture itself and that if you removed, for example, the table top, the utilitarian golf clubs would remain. He also noted that some of the elements of the furniture pieces were in the public domain. (Letter from Levy to Gallenson, 3/22/96, at 2). Mr. Levy reaffirmed the

original basis of refusal that the collection was one of useful articles which lacked pictorial, graphic, or sculptural features that are conceptually or physically separable from the useful articles.

In a letter dated July 19, 1996, you directed a second appeal to the Appeals Board. In that letter you again asserted that Mazer and current copyright law support registration. You characterized the Office's position as leading to the conclusion that "no three dimensional sculpture is copyrightable if its component parts have utilitarian aspects." (Letter from Gallenson to Copyright Office Board of Appeals, 7/19/96, at 1). Additionally, you argued that the sculptural work of the golf club elements remains if certain parts of the furniture are removed. Finally, you criticized Mr. Levy's analysis of the case as engaging in impermissible dissection of the artist's work.

Separable Authorship

The Board has carefully reviewed your client's claim in relation to the applicable copyright law and case law. It does not, however, agree that Mazer, involving a lamp which incorporated a pre-existing copyrightable sculpture of Balinese dancing figures, supports registration in this case. In Mazer the court of appeals noted that, "[t]he principle issue ....was whether objects that are concededly 'works of art' can be copyrighted if incorporated into mass-produced utilitarian articles." The works involved in the instant case do not contain any separately recognizable works of sculpture apart from the furniture configuration itself. As your appeal letter appears to concede, these designs are for production of useful articles. The Fairway Collection consists of industrial designs for furniture, and the designer uses recognizable, useful articles in creating these designs.

When the Office considers whether registration may be made for a useful article, it must follow the dictates of the existing copyright law. Congress has not chosen to give copyright protection to useful articles. As the court of appeals noted in Esquire v. Ringer, "Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products." 591 F.2d 796, 800 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979). Congress declined to create such protection in 1976; it also failed to pass the design legislation that was introduced in the 101st and 102d Congresses.

The definition of useful article in section 101 of the copyright law identifies a useful article as "an article 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 (1994). The statute further provides that registration is possible only if and to the extent that the works contain pictorial, graphic, or sculptural features that are separable from the useful article. Id.

The legislative history confirms that this separability may by physical or conceptual. See H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976).

The Office's implementation of the copyright statute, including its legislative history, is reflected in Compendium II of the Copyright Office Practices which states that the required conceptual separability is met when "artistic or sculptural features...can be visualized as free-standing sculpture independent of the shape of the useful article, i.e, the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article." U.S. Copyright Office, Compendium of Copyright Office Practices II, §505.03 (1984).

In order to determine whether these furniture pieces contain separate and copyrightable authorship apart from the utility aspects of the articles themselves, it is necessary for the Office to analyze the useful articles of the furniture pieces and, thus, to engage in some "dissection" to the degree necessary in order to identify the overall shape of the article and its component parts and, then, to determine the presence of any physically or conceptually separable authorship elements [parts] which in themselves are copyrightable. We further point out that section 410[a] of the current copyright statute authorizes the Copyright Office to determine whether any given work submitted for registration constitutes copyrightable subject matter.

Esquire, Inc. v. Ringer, 591 F.2d. 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), although decided under the 1909 law, most clearly enunciates the rule underlying the Office's principal reason for refusal. Esquire held that the Copyright Office regulation properly prohibited copyright registration for the overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape or configuration may be. Id. at 800. In fact, Section 505.03 of Compendium of Copyright Office Practices II is a direct successor to the Copyright Office regulation which was affirmed in Esquire as an authoritative construction of the statute as explicitly stated in legislative history. Id. at 802-03.

Moreover, the court did not accept Esquire's offer of a test for protectibility "that the overall design or configuration of a utilitarian article should be copyrightable as a work of art if its shape is original and creative and it exhibits a sufficient quantity of intellectual labor "to distinguish it from everyday industrial designs." Id. at 805. The Appeals Board concludes that the principles expressed in Esquire are applicable to the furniture collection involved in this case. Each of the works involved is a furniture piece which incorporates golf clubs or portions of golf clubs into the furniture piece. The golf clubs form integral and essential parts of the pieces of furniture, such as table legs, chair backs or slats and feet of magazine racks. Under the Esquire standard, as that is articulated in Compendium II, the golf club portions of the furniture articles cannot be physically or conceptually separated from the rest of the piece of furniture without destroying the overall shape and outline design of the useful article.

See also Custom Chrome, Inc. v. Ringer, 35 U.S.P.Q. 2d 1714, 1718 (D.D.C. 1995), where the court stated that the Office's "conceptual separability test" as it is enunciated in Compendium II is consistent with the holding in Esquire, later cases decided under the present law, and the legislative history. We agree with Mazer where the Court stated that useful lamps having a base that was a pre-existing, recognizable sculptural work represented the principle of incorporation of a work of art into industrial design. These particular furniture designs, however, do not contain a physically or, under the Esquire test, a conceptually separable sculptural work consisting of golf clubs. The Board finds no clearly identifiable work of sculpture embodied within the furniture pieces on which to base a copyright registration.

Additionally, although we agree that the backboard for the hat rack may be considered conceptually separable from the hooks on which hats can be placed, the sculptural shape of the backboard is a minor variation of a simple, oval shape and, thus, not copyrightable. On de minimis 2-dimensional art design authorship and the administrative authority of the Office to determine such, see generally Jon Woods v. Curran, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988); SCOA Industries, Inc. v. Famolare, Inc., 192 USPQ 216 (S.D.N.Y. 1976); John Muller & Co. v. New York Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986).

Materials Used to Create a Copyrightable Work

Your appeal letter of July 19, 1996, additionally discusses the Office's position as leading to a conclusion that useful articles may not be used to create a copyrightable sculpture. You argue that this means "a sculpture formed of paper clips is not copyrightable because paper clips are used for holding pieces of paper together... a sculpture formed of coins is not copyrightable because coins are used as a medium of currency; and steel itself is not copyrightable because steel is used in making forks, paper clips, door jambs and coins." (Letter from Gallenson to Copyright Office Board of Appeals, 7/19/96, at 1-2) This analogy and the examples cited in your letter are not an accurate reflection of the Office's position. Although useful articles and materials such as stone, metal or paper are per se uncopyrightable, see 17 U.S.C. § 101 (1994), the Copyright Office does not take the position that because the particular materials used to create a sculptural work may have a useful purpose, the resulting work cannot be subject to copyright protection. We do not assert that golf clubs can never be used to create a copyrightable sculptural work: the use of useful articles to create a work of sculpture may result in copyrightable authorship. That is not, however, the case here. Your client's designs are useful articles of furniture with no physically or conceptually separable copyrightable authorship under the standard articulated in Esquire and in Compendium II, both of which implement the 1976 law and its legislative history.

The Office does not dispute the uniqueness or novelty of the collection which incorporates golf clubs or recognizable parts of golf clubs into furniture designs. Although a work may be unique and/or commercially valuable, it is not necessarily copyrightable unless it meets the requirements of statute and settled case law.

Conclusion

For the reasons stated in this letter we affirm the refusal to register the submitted claim and are closing the file in this case. This decision constitutes the final agency action on this matter.

Sincerely,

Nanette Petruzzelli

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for the Appeals Board
U.S. Copyright Office

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