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August 1, 2000

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Cincinnati, OH 45202-2917

Re: BEAD & SEQUIN CHRISTMAS LIGHT DESIGN
Control Number: 60-616-805(W)

Dear Mr. Summe:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated August 12, 1999, appealing the Office's refusal to register the work "Bead & Sequin Christmas Light Design" on behalf of your client, Galerie Au Chocolat. The Board carefully examined the application, the work, and the correspondence concerning the application. After de novo review, the Board concluded that it must deny registration because the work lacks sufficient original authorship to support a copyright claim.

Administrative Record

On April 23, 1998, the Office received six applications from you on behalf of your client. The works were described on the applications as 2-Dimensional artwork and as Decorative Bead/Sequin Design. One work, "Bead and Sequin Christmas Light Design," is the subject of your appeal.

In a letter dated August 28, 1998, Visual Arts examiner John Ashley explained that the designs could not be registered because they lacked the artistic or sculptural authorship necessary to support copyright claims. He added that familiar shapes and designs and basic geometric shapes cannot be protected by copyright law.

The Office received your first appeal December 22, 1998. You wrote that you disagreed with the examiner's decision to deny registration for "Bead and Sequin Christmas Light Design #89152," and you asked the Office to reconsider its decision. You noted that the two-dimensional design submitted may be used to decorate boxes, as shown in deposit photographs, but may decorate other items as well.

You also claimed that Mr. Ashley did not discuss a specific work among those designs submitted, adding that the examiner did not clearly explain why the designs were rejected. You surmised from the letter's language that the works did not meet the minimum threshold for originality or creativity the Supreme Court recognized in Feist Publications v. Rural Telephone Services, Co., 499 U.S. 340 (1991). You also guessed that the examiner considered one or all of the works submitted to be in the shapes of unregistrable familiar symbols or designs, or minor variations of basic geometric shapes.

You wrote that the design pattern of the work being appealed suggests a Christmas tree light, but claimed that the design is a unique and original arrangement of beads and sequins applied to a box, adding that the design embodies at least a minimal degree of creativity. You cited additional cases to argue that the law requires merely a minimum level of originality for registration.[1]

Melissa Dadant, Special Assistant to the Chief of the Examining Division, responded in a letter dated April 15, 1999. She wrote that the Office had reexamined the deposit, considered your arguments, and concluded that "Bead & Sequin Christmas Light Design" could not be registered.

Ms. Dadant wrote that the standard of copyrightability under the law is whether a work contains a sufficient amount of original expression, that is, more than a trivial variation of public domain elements, either alone or in combination. She noted that the Office did not question the original aspect of your client's design, but looked at whether or not the design embodied copyrightable authorship.

She wrote that the Christmas bulb design resembled a familiar egg shape with an extension at one end. The bulb is filled in with sequins of one color. The screws of the "Christmas bulb" are indicated by three rows of sequins of a second color placed horizontally at one end of the bulb. Tiny beads outline the shape of the entire design, and also the strings of sequins in the screw. Referring to copyright regulations at 37 C.F.R. § 202.1, she noted that the regulations prohibit registration of such a common shape or arrangement; minor variations of standard designs or a basic arrangement of public domain elements may not be registered. She also relied on cases such

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[1] You cited Durham Industries, Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980); L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d. Cir 1976); and Lotus Development Corp. v. Borland International, Inc., 831 F.Supp. 202, 218 (D.Mass. 1993), rev'd on other grounds, 49 F.3d 807 (1st Cir. 1995), aff'd by equally divided Court, 116 S.Ct. 804 (1996).

as John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986); Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958); Forstmann Woolen Co. v. J. W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950); and Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d 1879 (S.D.N.Y. 1988) in support of that proposition.

She wrote that although a work may be unique, "uniqueness" is not an element of copyrightability. Further, she wrote that the Supreme Court in the Feist decision enunciated a standard the Copyright Office follows: at least a spark of creativity must be embodied in a work for registration to be possible. This "spark" could not be discerned in the "Bead and Sequin Christmas Light Design."

On August 13, 1999, the Copyright Office received your second request for reconsideration. You focused on the creativity of your client's work and again described the design, stating that the artwork, separable from the functional boxes it adorns, should be registered (citing Mazer v. Stein, 347 U.S. 201 (1954)). You also noted that the work was a representation of a Christmas light bulb, which should not disqualify it from copyright protection simply because an actual light bulb cannot be protected by copyright law. The work, you argued, is an independently created, original work, which takes nothing from the public domain, and can be registered.

Again you argued that the work met the Feist standard for original authorship. You claimed that the cases Ms. Dadant cited were not relevant because they concerned familiar shapes, and you asserted that the bead design did not express a familiar shape or design. You noted that the court in John Muller expressed that there is no simple way to draw the line between some creative authorship and not enough creative authorship.

You stated that Ms. Dadant argued that because the decorative pattern in the design suggests a Christmas light bulb, it is a Christmas light bulb, which does not contain copyrightable authorship. You disagreed with this position and argued that the Office did not recognize the standard set forth in Feist. You cited several cases to support the argument that originality requires only minimal creativity.[2] In closing, you claimed that the bead design has copyrightable features and should be registered.

Appeals Board Review

The Appeals Board upholds the Examining Division's decision not to register this work because it lack sufficient original authorship separable from the shape of the useful article on which the work appears to support a claim to copyright protection.

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[2] L. Batlin & Son, Inc v. Snyder, 536 F.2d 486 (2d Cir. 1976, en banc); Durham Industries, Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980); Lotus Development Corp. v. Borland International, Inc., 831 F.Supp. 202 (D.Mass. 1993), rev'd on other grounds 49 F.3d 807 (1st Cir. 1995), aff'd by equally divided Court 116 S.Ct. 804 (1996).

Separability

You wrote in your second request for reconsideration that the "Bead and Sequin Christmas Bulb Design" is a two-dimensional artwork design, separable from the box it adorns, adding that under Mazer v. Stein, 347 U.S. 201 (1954) and the current 17 U.S.C. 101, the design may be registered despite the fact that it adorns a useful article. You observed that in deciding the first appeal, the Examining Division agreed that the work was separable from the shape of the box.

The issue of separability in this case arises in a somewhat unusual context. The claim in this case does not relate to the overall shape of a three-dimensional useful article. Rather, it relates to a claim in a two-dimensional design placed on a useful article. However, that design consists, in part, of a significant aspect of the shape of the useful article.

That this appeal involves a useful article appears to be beyond dispute. The design in question appears on the top of a box and occupies the entire surface of the top of the box. The box itself -- a container -- is a useful article, "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.

The copyright statute provides that registration is possible for a useful article only if and to the extent that a work contains pictorial, graphic or sculptural features that are separable from the useful article. 17 U.S.C. Sec. 101 (definition of "pictorial, graphic, and sculptural works"). Based on these provisions of law and the legislative history, the Office applies the following separability test which is contained in § 505 of Compendium II. Section 505 states that:

> Registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article.

Compendium II, § 505.02 (1984).

Section 505 of Compendium II is a direct successor to the Copyright Office regulation that was affirmed in Esquire v. Ringer, 591 F.2d 796 (D.C.Cir. 1978). Based on explicit statements in the statute's legislative history, the court of appeals found that the Office's regulation was an authoritative construction of the copyright law. Id. at 802-803. Esquire and later cases held that, despite an original and creative shape, the overall design or configuration of a utilitarian object may not be copyrighted if it is not "capable of existing as a work of art independent of the utilitarian article in which [it is] incorporated." Id. at 803-804. The court further held that the Copyright Office properly refused copyright registration for a useful article, in that a case a light fixture, notwithstanding how aesthetically pleasing the useful article's shape or configuration may have been. Id. at 800.

Although, as you point out, the claim in this case involves two-dimensional artwork placed on a box, it appears that a significant part of the claim relates to the shape of the two-dimensional design. Because that shape is identical to the shape of the top of the box and is determined by the shape of the box, the Board can find no basis for finding that the shape of the two-dimensional design is separable from the shape of the box. Accordingly, while the Board agrees that the claim involved in this appeal includes design aspects that are separable from the shape of the useful article, those separable aspects do not include the overall shape of the two-dimensional design.

De Minimis Authorship

As you noted in your correspondence, a work must express a modest level of original authorship to be registered. This follows the tenets of statutory copyright law, regulations, and case law including Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991). However, some works fail to meet that standard. The Feist court held that the originality required for copyright protection consists of "independent creation plus a modicum of creativity." 499 U.S. at 346. 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, and that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." Id. at 359.

The Compendium II has long recognized this principle, stating that "[w]orks that lack even a certain minimum amount of original authorship are not copyrightable. Such works are often described as 'de minimis,' in reference to the principle embodied in the Latim maxim 'de minimis non curat lex.'" Compendium II, § 202.02(a). The Compendium elaborates that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." Compendium II, § 503.02(b) (1984). The Compendium recognizes that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability, *id.*, and that "registration cannot be based upon standard designs which lack originality,. . . . Similarly, it is not possible to copyright common geometric figures or shapes in three-dimensional form, such as the cone, cube, or sphere. . . . [T]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations." *Id.* See also Compendium II, § 503.02(a) and section 202.1(a) of the Copyright Office regulations, 37 C.F.R. § 202.1(a) ("familiar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained").

The Board has concluded that the decorative design of the Bead & Sequin Christmas Light Design is not copyrightable because any authorship is *de minimis*. Your letter makes no attempt to describe the authorship in the design by reference to any particular aspects of the design, but simply relies on general statements that the design is a "unique and creative decorative pattern of beads and sequins used to adorn a box in a festive, holiday fashion" and is a "pattern which, in a

preferred embodiment, is incorporated onto or tangibly fixed onto a box."[3] Ms. Dadant's letter specifically described the design:

> This design consists of the recognizable egg-shaped bulb with the screw-in extension on the more rounded end of the bulb. The bulb is filled in with sequins of one color. The screws are indicated by three strings of sequins of a second color that follow the curve of the rounded end of the bulb. Each string of seqins is delineated by a row of tiny beads. Such beads also outline the entire design.

You have offered no reasons why the Board should find anything more than *de minimis* authorship in these few elements found in the design, and the Board cannot find the requisite authorship in the simple selection and arrangement of sequins and beads in the design.

The cases you cite for the proposition that the test of originality is modest, such as Durham Industries, Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980), and Lotus v. Borland International, Inc., 831 F.Supp. 202 (D.Mass. 1993) *rev'd on other grounds*, 49 F.3d 807, *aff'd by equally divided court*, 516 U.S. 233 (1996), do not require a different result. We agree that the requirement of originality is modest, but as the court observed in Feist, there remain works "in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent"; and "[s]uch works are incapable of sustaining a valid copyright." 499 U.S. at 359. The Board finds that the Bead & Sequin Christmas Light Design is such a work.

Case law supports these principles. Works – even works of art – consisting of common shapes or of simple combinations of shapes and/or lines or other basic elements do not reach the requisite level of authorship. See Forstmann Woolen Co. v. J. W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950) (reproduction of standard fleur-de-lis could not support a copyright claim without original authorship); John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986) (logo of four angled lines forming arrow with the word "Arrows" in cursive script held not copyrightable); Magic Market, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F. Supp. 769 (W.D. Pa. 1986) (envelopes printed with solid black stripes and a few words such as `priority message' or `gift check' did not exhibit minimal level of creativity necessary for copyright registration); Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d 1879 (S.D.N.Y. 1988) (upholding Register's decision that fabric design of striped cloth with grid of squares was not

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[3] You also refer to the shape of the pattern, taking issue with the Ms. Dadant's observation that the "basic shape is a common, familiar egg shape, perhaps slightly elongated on the narrow end." Letter of April 15, 1999, p. 2. As noted above, the Board has concluded that the shape of the design is not separable from the shape of the box. Even if that shape were separable, however, the Board finds Ms. Dadant's characterization of the familiar shape embodied in the design to be reasonable. The Board would not necessarily have conducted the identical analysis because whether or not the shape of the design is that of an egg, it clearly is the shape of a familiar Christmas tree light bulb. As such, any authorship found in the shape of the design would be *de minimis* at best.

copyrightable); and Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958) (cardboard star with circular center for photographs, and two folded flaps allowing star to stand for display, not a work of art within the meaning of 17 U.S.C. Sec. 5(g) (1909)). Your attempt to distinguish these cases on the basis that they did not involve an "elongated egg" shape but involved indisputably familiar shapes is not persuasive. Even if the shape of the subject design were separable from the shape of the useful object, it remains a common shape; apart from that shape, the design consists of a simple arrangement of beads and sequins that lacks the "creative spark" required by Feist.

Conclusion

For the reasons stated in this letter, the Copyright Office Board of Appeals affirms the refusal to register the submitted claims and is closing the file in this case. This decision constitutes final agency action on this matter.

Sincerely,

David O. Carson
General Counsel
for the Appeals Board
U.S. Copyright Office