United States Copyright Office
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September 24, 2013

Sandler, Travis & Rosenberg, P.A.
Attn: Matt Nakachi
505 Sansome Street, Suite 1475
San Francisco, CA 94111

Re: ***FN Herstal Design for a . . . Rifle (SCAR-H)***
FN Herstal Design for a . . . Rifle (SCAR-L)
Correspondence ID: 1-DFGJJ9

Dear Mr. Nakachi:

The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the works entitled: *FN Herstal Design for a Special Operations Forces Combat Assault Rifle (SCAR-H)* and *FN Herstal Design for a Special Operations Forces Combat Assault Rifle (SCAR-L)*. You submitted this request on behalf of your client, FN Herstal, on November 19, 2012. I apologize for the delay in the issuance of this determination. After periods of inaction, staff departures, and budgetary restrictions, the Register of Copyrights has appointed a new Board and we are proceeding with second appeals of registration refusals as expeditiously as possible.

The Board has examined the application, the deposit copies, and all of the correspondence in this case. After careful consideration of the arguments in your second request for reconsideration, the Board affirms the Registration Program's denial of registration of these copyright claims. The Board's reasoning is set forth below. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

I. DESCRIPTION OF THE WORK

The Applicant originally filed two applications related to FN Herstal's SCAR rifle design; one seeking registration of the SCAR-L design (a smaller caliber rifle), one seeking registration of the SCAR-H design (a larger caliber rifle). These designs are substantially similar, with the only significantly perceivable differences being the lengths of the barrels, the calibers of bullets they are capable of firing, the size and shape of the magazines where their bullets are stored, and the size of the magazine ports. The deposit materials in both applications include images of the SCAR-L rifle design *and* the SCAR-H rifle design. In your correspondence with the U.S. Copyright Office (the "Office"), you refer to the work at issue as the *FN Herstal Design for a Rifle (SCAR)*, disregarding the different models in the two applications and instead focusing on the core SCAR rifle design. The Office, in its letter

refusing your first request for reconsideration of its decision to reject the two original applications also refers to the core SCAR rifle, rather than the two individual rifle designs. *See Letter from Attorney-Advisor, Stephanie Mason, to Matthew Nakachi* (August 21, 2012). For purposes of this appeal, the Board considers the works at issue to be the two individual rifle designs that you identify in your applications. Namely, *FN Herstal Design for a Special Operations Forces Combat Assault Rifle (SCAR-H)* and *FN Herstal Design for a Special Operations Forces Combat Assault Rifle (SCAR-L)* (hereinafter, the "Works").

The Works consist of assault rifle designs that include (1) a series of "Picatinny rails[1]" that appear on the Works' tops, bottoms and sides; (2) a wedge-shaped stock that extends from the Works' "butt"; and (3) a contoured pistol grip, among other features.

The below image is a photographic reproduction of the SCAR-H rifle design from the deposit materials:



The below image is a photographic reproduction of the SCAR-L rifle design from the deposit materials:



II. ADMINISTRATIVE RECORD

On January 25, 2012 and April 3, 2012, the Office issued letters notifying HN Herstal (the "Applicant") that it had refused registration of the Works. *Letter from Registration Specialist, Allan Rung, to Matthew Nakachi* (January 25, 2012); *Letter from Registration Specialist, Robin Jones, to Matthew Nakachi* (April 3, 2012). In its letters, the Office stated that it could not register the Works because they are useful articles that do not contain any separable authorship on which to sustain a claim to copyright. *Id.*

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[1] A "Picatinny rail" is a common type of rail integration system that is used to attach various accessories (scopes, tactical lights, telescopic sights, bayonets, etc.) to firearms.

In a letter dated March 20, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusals to register the Works. *Letter from Matthew Nakachi to Copyright RAC Division* (March 20, 2012) ("First Request"). Upon reviewing the Works in light of the points raised in your letter, the Office concluded that the Works are useful articles that do not contain any authorship that is both separable and copyrightable and again refused registration. *Letter from Attorney-Advisor, Stephanie Mason, to Matthew Nakachi* (August 21, 2012).

In a letter dated November 19, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Works. *Letter from Matthew Nakachi to Copyright R&P Division* (November 19, 2012) ("Second Request"). In arguing that the Office improperly refused registration, you claim the Works include elements that are both separable from their function as adaptable assault rifles; and, that those separable elements possess at least the minimum amount of creativity required to support registration. *Id.* at *passim*. Specifically, you claim the following aspects of the Works are both separable and copyrightable: (1) the "Picatinny rails" that appear on the Works' top, bottoms and sides; (2) the Works' wedge-shaped stocks; (3) the Works' contoured pistol grips; and, (4) the Works' overall sculptural designs. *Id.* at 5. In support of this claim you state the following:

> "The uninterrupted Picatinny rails that cross the entire top of the rifle and the Picatinny rails that partially cross the bottom and sides of the weapon create a unified look of bold force while allowing for ultimate adaptability of the weapon. Similarly, the wedge-shaped end creates a distinct image and form when pressed up against a shoulder in preparation for or during actual discharge of the weapon. The angled, contoured pistol grip emphasizes that the gun is to be used to advance forcefully upon an enemy."

Id.

You further argue that the "artistic renditions" of the Works that have appeared in popular video games, motion pictures, and television shows prove the Works "*can be* recognized as a graphic work existing on paper"; therefore, qualifying the overall design embodied in the Works as conceptually separable and copyrightable. *Id.* at 6-9. Additionally, you maintain that the fact that an "airsoft" gun manufacturer has used designs similar to that embodied in the Works as a model for its line of "airsoft" rifles proves the Works are "distinguishable on style" and should be registered. *Id.* at 9-10.

Finally, you direct the Board's attention to a "Preliminary Injunction Order" entered by the United States District Court for the District of Nevada that, you argue, confirms the registerability of the Works' "artistic, non-functional" elements. Specifically, you claim the district court's opinion is instructive and should be considered persuasive evidence of the Works' copyrightability. *Id.* at 16-18.

III. DECISION

A. *Legal Framework*

(1) Separability

Copyright protection does not generally extend to useful articles, *i.e.*, "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. However, works of artistic authorship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as [the designs'] form but not their mechanical or utilitarian aspects are concerned." *Id.* at § 101.

To be clear, a design incorporated into a useful article is only eligible for copyright protection to the extent that the design includes "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, utilitarian aspects of the article." *Id.*; *see also Esquire, Inc. v. Ringer,* 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied,* 440 U.S. 908 (1979) (holding 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 Board employs two tests to assess separability: (1) a test for "physical separability"; and, (2) a test for "conceptual separability." *Id.; see also Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q. 2d 1714 (D.D.C. 1995) (finding that the Copyright Office's tests for physical and conceptual separability are "a reasonable construction of the copyright statute" consistent with the words of the statute, present law, and the legislature's declared intent in enacting the statute).

To satisfy the test for "physical separability," a work's pictorial, graphic, or sculptural features must be able to be physically separated from the work's utilitarian aspects, by ordinary means, without impairing the work's utility. *See, e.g., Mazer v. Stein*, 347 U.S. 201 (1954) (holding a sculptured lamp base depicting a Balinese dancer did not loose its ability to exist independently as a work of art when it was incorporated into a useful article); *and see, Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (upholding the copyright in a sculpture of an antique telephone that was used as a casing to house a pencil sharpener because the sculpture was physically separable from the article without impairing the utility of the pencil sharpener). To satisfy the test for "conceptual separability," a work's pictorial, graphic, or sculptural features must be able to be imagined separately and independently from the work's utilitarian aspects without destroying the work's basic shape., *See, e.g.,* H.R. Rep. No. 94-1476 (1976), U.S. Code Cong. & Admin. News 1976, p. 5668 (indicating a carving on the back of a chair or a floral relief design on silver flatware are examples of conceptually separable design features). A work containing design features that fail to qualify as either physically or conceptually separable from the work's intrinsic utilitarian functions are ineligible for registration under the Copyright Act.

(2) Originality

All copyrightable works must qualify as "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). As used with respect to copyright, the term "original" consists of two components: independent creation and sufficient creativity. *See Feist Publications v. Rural Tel. Serv. Co.* 499 U.S. 340, 435 (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.* While only a modicum of creativity is necessary to establish the requisite level, the Supreme Court has ruled that some works (such as the telephone directory at issue in *Feist*) fail to meet this 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 nonexistent." *Id.* at 359.

The Office's regulations implement the long-standing requirements of originality and creativity set forth in the law and, subsequently, the *Feist* decision. *See* 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"); *see also* 37 C.F.R. § 202.10(a) (stating "[i]n order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form").

Of course, 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 grade. *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"). Ultimately, the determination of copyrightability in the combination of standard design elements rests 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.D.C. 1989).

To be clear, the mere simplistic arrangement of unprotectable elements does not automatically establish the level of creativity necessary to warrant protection. For example, the Eighth Circuit upheld the Copyright Office's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in a cursive script below the arrow. *See John Muller & Co., Inc. v. NY Arrows Soccer Team, Inc. et. al.*, 802 F.2d 989 (8th Cir. 1986). Likewise, the Ninth Circuit held that a glass sculpture of a jellyfish that consisted of elements including clear glass, an oblong shroud, bright colors, proportion, 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 court's language in *Satava* is particularly instructional:

> [i]t 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) (emphasis in original).

Finally, Copyright Office Registration Specialists (and the Board, as well) do not make aesthetic judgments in evaluating the copyrightability of particular works. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's uniqueness, its visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *see also Bleistein v. Donaldson*, 188 U.S. 239 (1903). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not automatically mean that the work, as a whole, constitutes a copyrightable "work of art."

B. *Analysis of the Work*

After carefully examining the Works and applying the legal standards discussed above, the Board finds that *FN Herstal Design for a Special Operations Forces Combat Assault Rifle (SCAR-H)* and *FN Herstal Design for a Special Operations Forces Combat Assault Rifle (SCAR-L)* are useful articles that are void of separable authorship.

A "useful article" is defined by statute 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 (2007). As discussed above, the law requires that, to be eligible for registration, design features incorporated into useful articles must be either physically or conceptually separable from the utilitarian aspects of the work. *See Esquire,* 591 F.2d at 800. Here, it is undisputed that the Works (adaptable assault rifles) are useful articles. *See Second Request* at 3. Accordingly, to be eligible for registration, the designs of useful articles must be either physically or conceptually separable from the utilitarian aspects of the work. *See Esquire,* 591 F.2d at 800. In your Second Request, you claim the following aspects of the Works are both separable and copyrightable: (1) the "Picatinny rails" that appear on the Works' top, bottoms and sides; (2) the Works' wedge-shaped stock; (3) the Works' contoured pistol grip; and, (4) the Works' overall sculptural design. *Second Request* at 5. We find that none of these aspects are capable of being physically or conceptually separated from the Works without destroying their basic utility as adaptable assault rifles.

Regarding the Work's "Picatinny rails," the Picatinny standardized rail mounting platform is a common firearm design feature. The rails consist of a series of ridges onto which a user can secure a variety of interchangeable firearm attachments (*i.e.*, scopes, tactical lights, telescopic sights, bayonets, etc.). This element is crucial to the Works' use as *adaptable* assault rifles. Indeed, your own letter highlights the importance of the rails to the Works by

characterizing them as "allowing for ultimate adaptability of the weapon." *Second Request* at 5. In the Board's view, any attempt at separating the rails from the Works would destroy the Works' intended purposes as *adaptable* assault rifles. Accordingly, we find that the Picatinny rails do not qualify as physically or conceptually separable from the Work.

Regarding the Works' wedge-shaped stocks, "stocks" or "butts" are common firearm design features. They generally provide a means for a shooter to steady and support a rifle or firearm while aiming it. They also allow a user to absorb some of the rifle or firearm's post-firing recoil by transmitting some of force of the recoil into the user's body. In the Board's opinion, this element is crucial to the Works' use as adaptable assault rifles. Indeed, your own letter evinces the purpose for this feature by stating "the wedge-shaped end creates a distinct image and form *when pressed up against a shoulder in preparation for or during actual discharge of the weapon.*" *Second Request* at 5 (emphasis added). Accordingly, we find that any attempt at physically or conceptually separating the wedge-shaped stock from the Works would hinder a user's basic ability to fire the Works in their intended fashion; thus, destroying the Works' intended usefulness.

Regarding the Works' contoured pistol grip, we find that this aspect cannot be physically or conceptually separated from the Works without destroying a user's basic ability to use them as adaptable assault rifles. Obviously, a grip is integral to a user's basic ability to aim and fire a firearm. Thus, in the Board's view, any attempt at separating the contoured grip from the Works would destroy the Works' usefulness.

Regarding the Works' overall look and feel, it is well settled that copyright protection is not available based on the "overall shape or configuration" of a utilitarian article "no matter how aesthetically pleasing that shape or configuration might be." *See Esquire,* 591 F.2d at 800. As explained, copyright registration is only available to the aspects of useful articles that are either physically or conceptually separable from an article's utilitarian function *and* that possess sufficient independent, creative authorship to satisfy the originality requirement set forth in *Feist Publications v. Rural Telephone Service Co.* 499 U.S. 340 (1991); *see aslo Esquire,* 591 F.2d at 800. Here, we find that none of the aspects of the Works that you identify as worthy of copyright registration are separable from the Works' function as adaptable assault rifles. Likewise, we find that the Works' overall "look and feel" is void of separable, copyrightable authorship. The fact that "artistic renditions" of the Works have appeared in popular culture does not add to your claim that the Works' "look and feel" is conceptually separable from the Works themselves. Similarly, your allegation that an "airsoft" rifle manufacturer has produced a modified version of the Works' design is of no import. Examples of non-functioning, replica versions of SCAR rifles, which are derived from the original functional rifles, appearing in the popular culture do not help prove how the original design embodied in the Works submitted for registration can be imagined separately without destroying the Works' ability to be used as adaptable assault rifles.

Finally, the Board does not agree with your assertion that we should be persuaded to register the Works by virtue of the United States District Court for the District of Nevada's indication that, for purposes of resolving a preliminary motion for injunctive relief, the

Applicant is likely to succeed in a trademark and trade dress infringement action. The district court's application of the trademark law to a trade dress claim is not binding on the Office in this case, nor is it enlightening or instructive in the application of the copyright law in general. *See Gemveto Jewelry Co. v. Jeff Cooper, Inc.*, 568 F. Supp. 319, 330 (S.D.N.Y. 1983) (providing "the decision to register an article rests in the sound discretion of the Register of Copyrights, and the scope of judicial review is limited to whether the decision was "arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law").

In sum, the Board finds that the Works lack any separable sculptural, pictorial or graphic features that are eligible for copyright protection; and, that any attempt to separate the features the Applicant has identified as separable would destroy the Works' usefulness as adaptable assault rifles.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the works entitled: *FN Herstal Design for a Special Operations Forces Combat Assault Rifle (SCAR-H)* and *FN Herstal Design for a Special Operations Forces Combat Assault Rifle (SCAR-L)*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____
William J. Roberts, Jr.
Copyright Office Review Board