United States Copyright Office
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September 24, 2013

Greenberg Traurig LLP
Attn: Richard Harris
77 West Wacker Drive, Suite 3100
Chicago, IL 60601

Re: Ornamented Home Theater (Nassau Home Theater)
Correspondence ID: 1-FFHNIJ

Dear Mr. Harris:

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 work entitled: *Ornamented Home Theater*. You submitted this request on behalf of your client, Habersham Plantation Corporation, on August 8, 2013.

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 this copyright claim. 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

Ornamented Home Theater (the "Work") is a large piece of wooden furniture that is designed to house a home theater. The Work is comprised of three sections. The center section includes six shelves of various sizes. The two side sections include cross-shaped shelving, arranged in a pattern so that two full cross shapes appear in the center of the sections. Below the three sections are four rectangular drawers. At the very top of the Work, there is a decorative arch. The arch combines with a semi-circle shape that has been cut from the wood directly below it and forms a circle-shaped opening. The Work's top, bottom, the portion of the Work immediately above its drawers, and the Work's arch design are decorated with "stepped" molding. A decorative, rectangular-shaped design feature appears on the Work's drawers and on the rear wall of each of its three sections.

The below image is a photographic reproduction of the Work from the deposit materials:



II. ADMINISTRATIVE RECORD

On October 15, 2012, the United States Copyright Office (the "Office") issued a letter notifying Habersham Plantation Corporation (the "Applicant") that it had refused registration of the above mentioned Work. *Letter from Registration Specialist, Sandra Ware, to Richard Harris* (October 15, 2012). In its letter, the Office stated that it could not register the Work because it does not contain any separable authorship that is copyrightable. *Id.*

In a letter dated January 15, 2013, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from Richard Harris to Copyright RAC Division* (January 15, 2013) ("First Request"). Upon reviewing the Work in light of the points raised in your letter, the Office again concluded that the Work does not contain any authorship that is both separable and copyrightable and refused registration. *Letter from Attorney-Advisor, Stephanie Mason, to Richard Harris* (May 9, 2013).

Finally, in a letter dated August 8, 2013, you 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 Richard Harris to Copyright R&P Division* (August 8, 2013) ("Second Request"). In your letter, you agree with the Office's prior determination that the Work is a useful article that includes design features that are separable from its utilitarian function; but, disagree with the Office's conclusion that those design features do not possess the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publications*

v. Rural Telephone Service Co., 499 U.S. 340 (1991). *Id. passim.* You argue that the Office improperly examined the Work under a standard that is stricter than the one enumerated in the Copyright Act. Specifically, you claim the Office failed to examine the Work to determine whether its overall selection and arrangement (the combination of its separable elements with its non-separable elements) is sufficiently creative to warrant copyright registration. *Id. passim.*

In addition to *Feist*, your argument references several cases in support of the general principle that works comprised of otherwise unprotectable elements are acceptable for copyright protection if the selection and arrangement of their elements satisfies the requisite level of creative authorship. *Id.*

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*, 499 U.S. at 345. 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 *Ornamented Home Theater* and applying the legal standards discussed above, the Board finds that the Work is a useful article that lacks any authorship that is both separable and sufficiently creative to sustain a copyright claim.

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 works in which they are embodied. *See Esquire,* 591 F.2d at 800. Here, it is undisputed that the Work (furniture for displaying a home theater) is a useful article. Thus, for there to be any consideration of the Work's design features, the features must be either physically or conceptually separable from the Work's utilitarian function as a home theater display or entertainment center.

(1) The Work's Separable Design Features

We find that the following design features are separable from the Work's utilitarian function as furniture for displaying a home theater: (1) the decorative arch that appears at the top of the Work; (2) the semi-circle shape that is cut from the top of the Work's center cabinet; (3) the molding that appears on the Work's top, bottom, immediately above its drawers, and on the arch design; and, (4) the decorative, rectangular-shaped design feature that appears on the Work's drawers and on the rear wall of each of the Work's three sections. All other aspects of the Work are either subsumed within the overall shape, contour, and configuration of the Work itself or are incapable of being imagined separately from the Work without destroying its function as furniture for displaying a home theater. *See Esquire,* 591 F.2d 796.

We further find that none of the above design features that we have identified as separable are sufficiently creative to warrant registration. These basic features (an arch, a semi-circle, common molding, and rectangles) considered individually, are no more than simple variations of familiar shapes and designs. Thus, consistent with 37 C.F.R. § 202.1(a), they lack the requisite "creative spark" for copyrightability and are prohibited from copyright registration. *Feist*, 499 U.S. at 359; 37 C.F.R. § 202.1(a).

Finally, we find that the Applicant's selection, arrangement, and incorporation of these features into the Work fails to meet the creativity threshold set forth in *Feist*. 499 U.S at 359. As explained, the Board accepts the principle that combinations of unprotectable elements may be eligible for copyright registration. However, in order to be accepted, such combinations must contain some distinguishable variation in the selection, coordination, or arrangement of their elements that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Id.*; *see also Atari Games,* 888 F.2d at 883 (finding a work should be viewed in its entirety, with individual noncopyrightable elements judged not separately, but in their overall interrelatedness within the work as a whole). Examined as a whole, the configuration of the features we have identified as separable fails to meet the grade for registration. *Id.; see also Atari Games,* 888 F.2d at 883. Here, the Work's author has arranged the Work's elements in a fashion that is too obvious to warrant copyright registration. For example, there is no copyrightable authorship in the simple decision to add traditional molding to the top and bottom edges of a furniture design. Similarly, one cannot claim original authorship in the decision to trim a group of rectangle-shaped drawers with a decorative rectangle outline. Thus, viewing the Work as a whole, we find that the author's incorporation of the four separable elements identified above into an otherwise unprotectable furniture design is, at best, *de minimis*, and lacks the requisite amount of creative authorship to support registration.

(2) The Work's Non-Separable Design Features

The Board is not persuaded by your argument that the "suspended decorative crosses" and the "suspended shadow-boxes outlines" that form the Work's shelves are separable from the Work's ability to function as furniture for displaying a home theater. To the contrary, we find that the shelve designs are either subsumed within the overall shape, contour, and configuration of the Work itself or incapable of being imagined separately from the Work without destroying

their function as shelving or part of a home theater display cabinet. If an examiner were to either physically remove the shelves from the Work or conceptually imagine the Work without the shelves, the examiner would be left with a wooden shell incapable of storing the items generally associated with a home theater; thus, destroying the Work's intended, utilitarian functionality. Accordingly, we find that the design features the author incorporated into the Work's shelving are neither physically nor conceptually separable from the Work's utilitarian function and are not eligible for copyright registration. *See Esquire,* 591 F.2d 796.

Likewise, the Board is not persuaded by your argument that the Work's scale, size, shape and "the visual cooperation of the overall piece" should qualify the Work for registration. 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. Accordingly, we find elements such as the Work's overall size, shape, scale, and "visual cooperation" are incapable of being imagined separately from the Work without destroying its function; thus, making them ineligible for protection under the Copyright Act.

In sum, the Board finds that the Work does not include design elements that are both separable from the Work's utilitarian function and possess a requisite amount of copyrightable authorship.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the work entitled: *Ornamented Home Theater.* 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