United States Copyright Office
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September 5, 2013

Birch, Stewart, Kolasch & Birch LLP
Attention: James M. Slattery
PO Box: 747
Falls Church, VA 22040

Re: Overhead/Wall Lamp TARAXACUM C/W
Floor Lamp TOIO
Suspension Lamp FUCSIA
Correspondence ID: 1-9UL2LI

Dear Mr. Slattery:

The Review Board of the United States Copyright Office (the "Board") is in receipt of your second requests for reconsideration of the Registration Program's refusal to register the Works entitled: *Overhead/Wall Lamp TARAXACUM C/W*; *Floor Lamp TOIO;* and, *Suspension Lamp FUCSIA* (the "Works"). You submitted these requests on behalf of your client, FLOS S.p.A. (the "Applicant"), on November 20, 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.

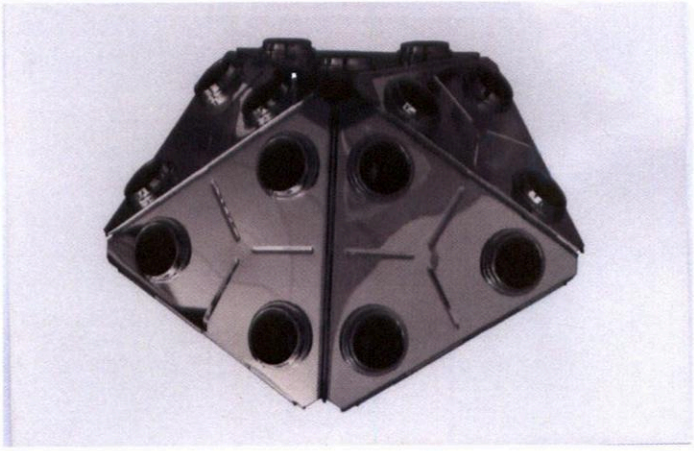
The Board has examined the applications, the deposit copies, and all of the correspondence in this case. After careful consideration of the arguments in your second requests for reconsideration, the Board affirms the Registration Program's denial of these copyright claims. The Board's reasoning is set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

II. DESCRIPTION OF THE WORKS

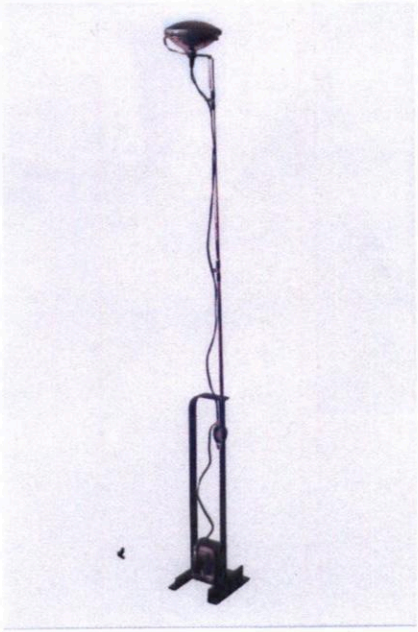
The Works consist of the following three lamp and light fixture designs:

(1) *Overhead/Wall Lamp TARAXACUM C/W* is a wall or ceiling-mounted lighting fixture that consists of a pentagon-shaped metal base with five metal triangular panels extending out of it. The five metal panels are attached to a raised portion of the base by a metal hinge and fold inward so that they meet at the center of the

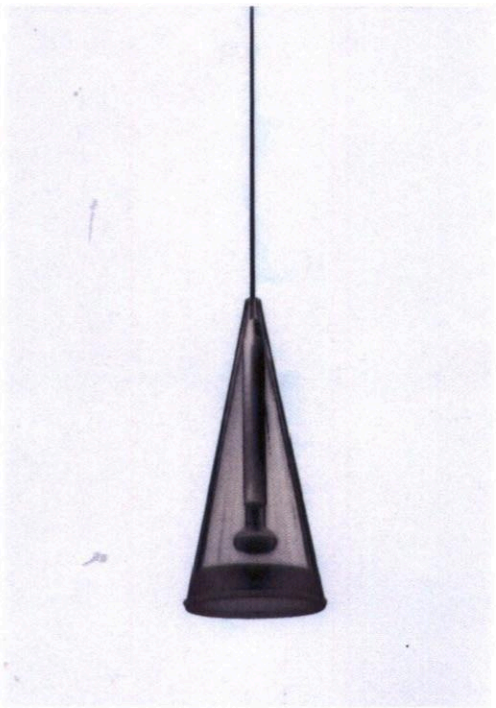
pentagon shape. Each panel includes three circular outlets where light bulbs can be placed, three engraved lines arranged in a starburst design, and a raised, triangular tip. There is a small, pentagon-shaped gap at the point where the tips of the five triangular pieces meet.



(2) *Floor Lamp TOIO* is a floor lamp that consists of a black metal base with black metal pieces arranged in the shape of a round-edged rectangle attached to it. A long, silver metal stem protrudes upward and out of the rectangle shape. At the top of the stem, silver metal pieces are arranged in a circular shape so that they can support a dish-shaped light bulb. Along the stem, there are small metal loops for threading the electrical wire that runs from the light bulb to the Work's base.



(3) *Suspension Lamp FUCSIA* is a ceiling-mounted lighting fixture that consists of a transparent, cone-shaped encasing with a plastic tube and a light bulb hanging inside of it. There is a round, colored strip near the bottom of the cone-shape's wide, open end and an electrical wire extending from its narrow end.



I. ADMINISTRATIVE RECORD

On April 13, 2011, the United States Copyright Office (the "Office") issued two letters notifying you that it had refused registration of the above mentioned Works. *Letters from Registration Specialist, Robin Jones, to James Slattery* (April 13, 2011). 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 that is copyrightable. *Id.*

In one letter dated May 4, 2012, and two letters dated April 24, 2012, you requested, pursuant to 37 C.F.R. § 202.5(b), that the Office reconsider its initial refusals to register the Works. *Letter from James Slattery to Copyright RAC Division* (May, 4, 2012); *Letters from James Slattery to Copyright RAC Division* (April 24, 2012). Upon reviewing the Works in light of the points raised in your letters, the Office again concluded that the Works are useful articles that do not contain any authorship that is both separable and copyrightable and refused registration. *Letter from Attorney-Advisor, Stephanie Mason, to James Slattery* (August 24, 2012).

Finally, in three letters dated November 20, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusals to register the Works. *Letters from James Slattery to Copyright R&P Division* (November 20, 2012). In arguing that the Office improperly refused registration, you claim the following: (1) the Works include elements that are both physically and conceptually separable from their utilitarian aspects; and, (2) that those separable elements include at least the minimum amount of creativity required to support registration. *Id.* at 2-4. In support of your argument, you have supplied the Board with forty-two examples of copyright registrations for lamps that you offer for purposes of comparison to the Applicant's Works. You also include a list of cases in which various courts have found specific lamp designs to be copyrightable. *Id.* at 3-4.

III. DECISION

A. *The 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 (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.*, 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 Works*

After carefully examining the Works and applying the legal standards discussed above, the Board finds that all three Works are useful articles void of elements that possess the requisite separable authorship necessary to sustain a claim to copyright. Accordingly, we affirm the denial of registration for *Overhead/Wall Lamp TARAXACUM C/W*; *Floor Lamp TOIO;* and, *Suspension Lamp FUCSIA*.

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 (a floor lamp and two lighting fixtures) are useful articles. Thus, for there to be any consideration of the Works' design features, the features must be either physically or conceptually separable from the Works' utilitarian functions as lamps and lighting fixtures.

Below, we list each Work and identify why we have concluded that the Work lacks separable authorship that is sufficiently creative to warrant copyright registration.

(1) Overhead/Wall Lamp TARAXACUM C/W

We find that the following design features are separable from the Work's utilitarian function as a wall-mounted lighting fixture: (1) the sets of three ornamental engravings that appear on all five of the Work's triangular sides; and, (2) the raised triangular tips that appear at the pointed end of all five of the Work's triangular sides. 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 a fifteen-bulb lighting fixture. *See Esquire,* 591 F.2d 796.

We further find that none of the design features we have identified as separable are sufficiently creative to warrant registration. These basic features (five groups of three straight-line engravings and five small triangles), considered individually, are no more than simple variations of common shapes and designs that lack the requisite "creative spark" for copyrightability. *See Feist*, 499 U.S. at 359; *see also* 37 C.F.R. § 202.1(a) (prohibiting registration of familiar symbols or designs). Likewise, the Applicant's configuration of these basic features fails to meet the grade for registration. *Id.; see also Atari Games,* 888 F.2d at 883 (accepting that combinations of geometric shapes may be eligible for copyright protection; but, concluding that in order to be accepted for registration, such combinations must contain more than mere *de minimis* creative authorship). Here, the Applicant has arranged the separable engraved lines so that they form a simple "Y" or starburst pattern that repeats on the Work's five sides; and, has combined the separable small triangles so that the negative space between them forms a pentagon shape. These basic configurations of unprotectable shapes are, at best, *de minimis*, and lack the requisite amount of creative authorship to support registration. Thus, we find the Work is ineligible for protection under the Copyright Act.

(2) Floor Lamp TOIO

We find that none of the Work's constituent elements can be separated, physically or conceptually, from the Work without destroying its basic form and function as a standing, exposed-wire floor lamp. *See Esquire,* 591 F.2d at 800.

We are not persuaded by your argument that the Work's overall shape is separable as a "unique" work of "artistic craftsmanship and pictorial design." *Letter from James Slattery to Copyright R&P Division* (November 20, 2012) at 2. Nor are we persuaded by your claim that the Work's elements are separable because "they are not used as a floor lamp during the daytime." *Id.* at 3. Despite these assertions, the fact remains that each of the Work's elements (the base that keeps the Work upright, the rectangle shape that extends from the base and supports the stem, the stem itself, the wire loops, the wire bracket, and the pieces arranged in a circle to support a light bulb) are all either subsumed within the overall shape, contour, and configuration of the Work itself or incapable of being imagined separately from the Work without destroying its function as a standing floor lamp. Accordingly, we find that the Work does not possess any elements that are separable from its utilitarian function and is not eligible for copyright registration. *See Esquire,* 591 F.2d 796.

(3) Suspension Lamp FUCSIA

We find that none of the Work's constituent elements (the cone-shaped encasing, the colored strip on the cone-shaped encasing, the plastic tube, the light bulb, or the electrical wire) can be separated, physically or conceptually, from the Work without destroying its basic form and function as a hanging light. *See Esquire,* 591 F.2d at 800.

We are not persuaded by your arguments that the overall shape of the Work is separable from its use as a lamp and that the Work is eligible for registration as a sculpture of "a trumpet or a tree." *See Letter from James Slattery to Copyright R&P Division* (November 20, 2012) at 2. Nevertheless, even if it were possible to imagine the Work's general shape as an "applied design," separable from its function as a hanging light, the Work would still not possess sufficient creative authorship to warrant registration. As noted, the Work consists of a simple combination of a basic, cone-shaped tube with a colored strip, a plastic tube, a light bulb, and an electrical wire. This ordinary arrangement of common, unprotectable elements is, at best, *de minimus* and lacks the requisite "creative spark" for copyrightability. *See Feist*, 499 U.S. at 359; *see also* 37 C.F.R. § 202.1(a). Accordingly, we find that the Work is not eligible for protection under the Copyright Act.

With regard to your argument that the Office has registered works similar to the ones in contention, the Office does not compare works that have already been registered or refused registration. Each work is examined independently and on its own merits. The Office is not required to make comparisons of copyright deposits to determine whether or not a similar work has already been registered. *See Homer Laughlin China Co. v. Oman*, 22

U.S.P.Q.2d (BNA) 1074, 1076 (D.D.C. 1991) (where the court stated that it was not aware of "any authority which provides that the Register must compare works when determining whether a submission is copyrightable."); *accord, Coach, Inc. v. Peters*, 386 F. Supp.2d 495, 499 (S.D.N.Y. 2005) (indicating the Office "does not compare works that have gone through the registration process"). Again, each work submitted for registration is evaluated on its own merits, with the Office applying the relevant statutory and regulatory guidelines. Thus, the fact that Office examiners might have accepted for registration works that you perceive as similar to the Works at issue does not impact the Board's decision in the matter at hand.

In sum, the Board finds that none of the Works include design elements that are both separable from the Works themselves and possess the requisite amount of copyrightable authorship, either individually or in their selection and arrangement, to warrant registration.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the Works entitled: *Overhead/Wall Lamp TARAXACUM C/W*; *Floor Lamp TOIO;* and, *Suspension Lamp.* 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