United States Copyright Office
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July 24, 2013

Stinson, Morrison & Hecker
Attn: Penny R. Slicer
1201 Walnut Street, Suite 2900
Kansas City, MO 64106

Re: ROUND STAR HAMMER HEAD
ROUND DIMPLE HAMMER HEAD
ROUND CHECKERED HAMMER HEAD
Correspondence ID: 1-7FUB7W; 1-703DWH

Dear Ms. Slicer:

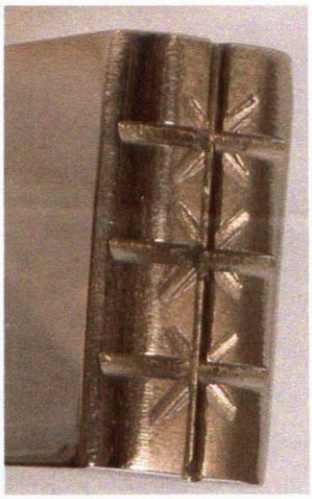
The Review Board of the United States Copyright Office (the "Board") is in receipt of your second requests for reconsideration of the Registration Program's refusals to register the three works entitled: *Rectangular Star Hammer Head*, *Round Dimple Hammer Head*, and *Round Checkered Hammer Head* (the "Works"). You submitted these requests on behalf of your client, Euro Tool, Inc. (the "Applicant"), on May 3, 2011. Administratively, your previous registration requests for *Rectangular Star Hammer Head* and *Round Dimple Hammer Head* were handled separately from those for *Round Checkered Hammer Head*. However, because the issues associated with the three Works are similar, for the purpose of second reconsideration, we will address all three claims in this one letter. 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 these cases. After careful consideration of the arguments in your second requests for reconsideration, the Board affirms the Registration Program's denial of registration of these three 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.

I. DESCRIPTION OF THE WORKS

The *Rectangular Star Hammer Head* design consists of a long vertical groove, three smaller, horizontal grooves, and three "X" shaped grooves carved into the rectangular face of a hammer. The Applicant has arranged the horizontal grooves so that they intersect with the vertical groove in three places. The three "X" shaped grooves each cross a different horizontal groove at the point where it intersects the vertical groove.

The below image is a photographic reproduction of the *Rectangular Star Hammer Head* from the deposit materials:



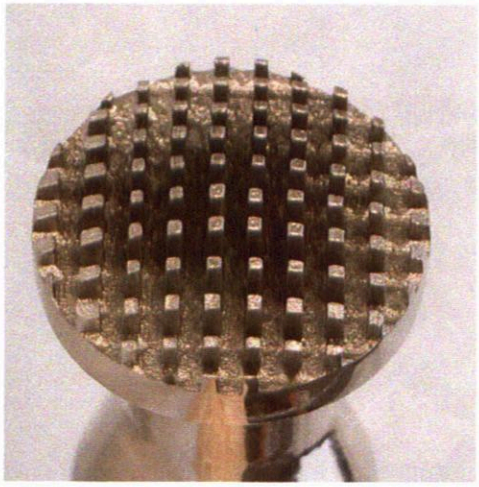
The *Round Dimple Hammer Head* design consists of the uncomplicated combination of forty, apparently identical, circle-shaped "dimples." The Applicant has arranged these "dimples" in circular patterns that cover the round face of a hammer.

The below image is a photographic reproduction of the *Round Dimple Hammer Head* from the deposit materials:



The *Round Checkered Hammer Head* design consists of the simple combination of a series of vertical and horizontal grooves. The Applicant has arranged these grooves so that they create an ordinary checkered pattern on the round face of a hammer.

The below image is a photographic reproduction of the *Round Checkered Hammer Head* from the deposit materials:



II. ADMINISTRATIVE RECORD

On July 17, 2010, the Copyright Office (the "Office") issued a letter notifying you that it had refused registration of the works *Rectangular Star Hammer Head* and *Round Dimple Hammer Head*. *Letter from Chief, Visual Arts Division, John H. Ashley to Penny Slicer* (July 17, 2010). On August 3, 2010, the Copyright Office issued a letter notifying you that it had also refused registration of the work *Round Checkered Hammer Head*. *Letter from Chief, Visual Arts Division, John H. Ashley to Penny Slicer* (August 3, 2010). In both letters, the Office indicated that it could not register the Works because they are "useful article[s]" which do not contain any separable authorship needed to sustain a copyright claim. *Id.*

In letters dated October 14, 2010, and November 1, 2010, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusals to register the Works. *Letter from Penny Slicer to Copyright RAC Division* (October 14, 2010); *Letter from Penny Slicer to Copyright RAC Division* (November 1, 2010). Your letters set forth the reasons you believed the Office improperly refused registration. *Id.* Upon reviewing the Works in light of the points raised in your letters, the Office agreed with you that the Works' design elements could be considered conceptually separable from their utilitarian function as hammer heads. *Letter from Attorney-Advisor Virginia Giroux-Rollow to Penny Slicer* (February 11, 2011) at 1; *Letter from Attorney-Advisor Virginia Giroux-Rollow to Penny Slicer* (March 3, 2011) at 1. Nevertheless, the Office concluded that the Works "do not contain a sufficient amount of original and creative artistic or sculptural authorship that would support a copyright registration" and again refused registration. *Id.*

Finally, in two letters dated May 3, 2011, 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. *Letter*

concerning "Star" and "Dimple" Hammer Heads from Penny Slicer to Copyright R&P Division (May 3, 2011) ("Star & Dimple Letter"); *Letter concerning "Checkered" Hammer Head from Penny Slicer to Copyright R&P Division* (May 3, 2011) ("Checkered Letter"). In arguing that the Office improperly refused registration, you claim that each of the three Works, as a whole, includes at least 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). *Star & Dimple Letter and Checkered Letter.* In support of these arguments, you claim the Applicant carefully selected and combined the individual elements that comprise each Work to give the Works meaning that is not present when their elements are evaluated independently. *Id.*

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 craftsmanship, 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 conducts 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 was physically separable from the article's utilitarian function); *and see, Ted Arnold, Ltd. V. Silvercraft Co.*, 259 F. Supp. 733 (1966) (holding a pencil sharpener shaped like a telephone was physically separable from the article's utilitarian function). 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 non-protectable 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 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 that do not contain the requisite separable authorship necessary to sustain a claim to copyright. We further find that, even if the Works' design elements were to be considered separately from their utilitarian functions, they would lack a sufficient amount of copyrightable authorship to satisfy the requirement of originality. Accordingly, we affirm the denial of registration for all three works.

There is no doubt that all three of the Works are hammers and are useful articles. Indeed, the Applicant's own online catalogue expressly indicates that the Works' utility derives from their usage as "texturing hammers for non-ferrous metals" designed specifically to enable a user to "make attractive patterns to give jewelry and other metal items a special look." *See*, "Texturing Hammer-Round-Dimples & Narrow Pinstripe," http://eurotool.com/products/TEXTURING_HAMMER_ROUND_DIMPLES_NARROW_PINSTRIPE-2801-102.html (accessed July 12, 2013). As discussed above, the law requires that 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. Here, there is no question that the designs on the faces of the hammers, which make the impressions on non-ferrous metals, are not physically separable from the hammers themselves. *Contra*, *Mazer v. Stein*, 347 U.S. 201 (1954). Therefore, for there to be any consideration of the design features present on the faces of the hammers, those features must be conceptually separable *i.e.* able to be imagined separately and

independently from the Works' utilitarian aspects *without destroying the Work's basic shape.* Imagining the design features contained on the faces of the hammers separately from the hammers does, in the Board's view, render the hammer faces smooth and featureless, thereby destroying both their shape and their intended purpose of imparting imprints onto non-ferrous metals. Thus, the Works' design features cannot be separated from the functional aspects the hammers.

However, even if one could envision a way in which to imagine the design features separately from the hammers while still leaving the designs intact on the hammer faces,[1] the Board does not find these features to consist of original authorship. The design elements embodied in all three Works contain mere *de minimus* combinations of common, geometric shapes.

The *Rectangular Star Hammer Head* design consists of a long vertical groove, three smaller, horizontal grooves, and three "X" shaped grooves. The Applicant has arranged the horizontal grooves so that they intersect with the vertical groove in three places. The three "X" shaped grooves each cross a different horizontal groove at the point where it intersects the vertical groove. This obvious overlapping of one long line, three shorter lines, and three "X" shapes does not contain any distinguishable variation in the selection, coordination, or arrangement of common elements that is worthy of copyright protection. *See Feist*, 499 U.S. at 359; *see also* 37 C.F.R. §§ 202.1(a), 202.10(a). Your assertion that the Applicant's arrangement of the four lines and three "X" shapes is "unique" and "aesthetically pleasing" does not add to your claim of sufficient creativity. *Star & Dimple Letter* at 1. The Board does not assess novelty or attractiveness in determining whether works contain the requisite minimal amount of original authorship. *See* 17 U.S.C. § 102(b); *see also Bleistein*, 188 U.S. 239. Accordingly, we conclude that the *Rectangular Star Hammer Head* design is not sufficiently creative to warrant registration.

The *Round Dimple Hammer Head* design consists of the uncomplicated combination of forty, apparently identical, circle-shaped "dimples." The Applicant has arranged these "dimples" in circular patterns that cover the round face of a hammer. This simple arrangement of basic circle shapes is, at best, *de minimis*. *See Feist*, 499 U.S. at 359; *see also* 37 C.F.R. §§ 202.1(a), 202.10(a). Your argument that the Applicant's use of inconsistent spacing between some of the "dimples" satisfies the *Feist* threshold for minimal creativity is unpersuasive. *Id.* Likewise, your assertion that the Applicant's arrangement of the "dimples" resembles "a perfect sunburst" and "a flower with imperfections which only nature typically creates" does not add to your claim of sufficient creativity. *Checkered Letter* at 1. The Board does not assess symbolism or the espoused intentions of authors in determining whether works contain the requisite minimal amount of original authorship. *See* 17 U.S.C. § 102(b); *see also Bleistein*, 188 U.S.

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[1] In order to do this, one has to imagine the flat, two-dimensional configurations of the design separately from the three-dimensional form so that the three-dimensional form remains upon the hammer faces. This, arguably, changes the nature of the authorship claimed in the Works in that it transforms them from three-dimensional sculptural works into two-dimensional graphic works that lack depth and the ability to carry out their intended purposes.

239. Accordingly, we conclude that the *Round Dimple Hammer Head* design is not sufficiently creative to warrant registration.

The *Round Checkered Hammer Head* design consists of a series of intersecting vertical and horizontal grooves. The Applicant has arranged these grooves so that they create an ordinary checkered design on the round face of a hammer. This basic pairing of two intersecting elements, and the resulting checkered pattern, lacks the requisite "creative spark" for copyrightability. S*ee Feist*, 499 U.S. at 359; *see also* 37 C.F.R. §§ 202.1(a), 202.10(a). Your assertion that the Applicant's non-symmetric arrangement of the intersecting grooves creates a "unique and much more aesthetically pleasing design" than a standard checkered pattern does not add to your claim of sufficient creativity. *Checkered Letter* at 1. As noted, the Board does not assess novelty or attractiveness in determining whether works contain the requisite minimal amount of original authorship. *See* 17 U.S.C. § 102(b); *see also Bleistein*, 188 U.S. 239. Accordingly, we conclude that the *Round Checkered Hammer Head* design is not sufficiently creative to warrant registration.

In sum, we find that, in each of the three Works, the Applicant's selection and arrangement of the elements that comprise the work lacks a sufficient level of creativity to make it registerable under the Copyright Act.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusals to register the works entitled *Rectangular Star Hammer Head; Round Dimple Hammer Head*; and *Round Checkered Hammer Head*. 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