United States Copyright Office
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November 30, 2015

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RE: Second Request for Reconsideration for Refusal to Register TRUNKI PRODUCT, Correspondence ID: 1-TP09JF

Dear Ms. Wiser:

The Review Board of the United States Copyright Office (the "Board") has examined Magmatic Limited's ("Magmatic's") second request for reconsideration of the Registration Program's refusal to register the work titled "Trunki Product" (the "Work"). After reviewing the application, the deposit copy, a physical specimen of the work, the relevant correspondence in this case, and the arguments set forth in the second request for reconsideration, the Board affirms the denial of registration.

I. DESCRIPTION OF THE WORK

The Work is "a ride-on suitcase" that is designed for children and is intended to evoke "the overall shape and look of an animal or character." Letter from Jennette Wiser, Epstein Drangel LLP, to Copyright Office 1 (Dec. 29, 2014) ("Second Request"). The Work is in the general three-dimensional rectangular shape of a two-wheeled suitcase, with several aspects designed in an effort to create the impression of various human facial and bodily features. Specifically, there are two cylindrical protrusions at the top of the Work, intended to represent eyes, along with a lock in the front serving as a nose, and a raised contoured strip below the nose that leads to a "bubble" shape at the bottom of the work intended to evoke a mouth. Additionally, on the back of the Work is another lock, this one representing a tail, and a gentle, divided protrusion intended as buttocks. Finally, the two wheels are said to represent feet, and a concavity along the top serves as a saddle. Second Request, at 3 n. 1.

The images below are photographic reproductions of the Work:





II. ADMINISTRATIVE RECORD

On May 15, 2014, Magmatic filed an application to register the Work. Specifically, Magmatic asserted a claim to copyright in "Sculpture/3D artwork," but expressly disclaimed any of the "color" that appears in this Work.

In a letter dated May 28, 2014, a Copyright Office registration specialist refused to register the Work, finding that it is a "useful article" that does not contain "any separable features that are copyrightable." *See* Letter from Sandra Ware, Copyright Office, to Jason Drangel, Epstein Drangel LLP (May 28, 2014). The letter stated that the Work is utilitarian in nature and does not possess sufficient separable creative authorship within the meaning of the copyright statute and settled case law to support a claim to copyright. *Id.*

In a letter dated June 16, 2014, Magmatic requested that the Office reconsider its initial refusal to register the Work. *See* Letter from Sarah I. Cohen, Epstein Drangel LLP, to U.S. Copyright Office (June 16, 2014) ("First Request"). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and in a letter dated October 3, 2014, again concluded that the Work is a useful article that does not contain any authorship that is both separable and copyrightable. Letter from Stephanie Mason, Copyright Office, to Sarah I. Cohen, Epstein Drangel LLP (Oct. 3, 2014) ("First Refusal").

In a letter dated December 29, 2014, Magmatic requested that, pursuant to 37 C.F.R. § 202.5(c), the Office again reconsider its refusal to register the Work. Letter from Jennette Wiser, Epstein Drangel LLP, to Copyright Office (Dec. 29, 2014) ("Second Request"). In its Second Request, Magmatic conceded that the Work is a useful article, and that its design is not physically separable from its utilitarian aspects. *Id.* at 2. Instead, Magmatic asserted that the Work includes design features that are conceptually separable from the utilitarian aspects of the Work, and that these design features contain a sufficient amount of original authorship to qualify for copyright protection. *Id.* Magmatic also provided the Office with a physical sample of the Work to illustrate "all of the distinct characteristics and expressions of the design." *Id.* at 1.

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separability*

The copyright law does not protect useful articles. However, the purely ornamental or decorative pictorial, graphic, or sculptural features of a useful article may be protectable if those features can be identified separately from – and are capable of existing independently of – the utilitarian aspects of that article.

The statute defines a useful article 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. It also states that "[a]n article that is normally part of a useful article is considered a 'useful article.'" *Id.* For example, the bezel on a wristwatch or the handle on a casket would be considered useful articles, because they are inherently useful and because they are typically used as part of a larger useful article. COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.1 (3d ed. 2014).

Sections 101 and 102(a) of the Copyright Act provide the guiding principles for determining whether the decorative or ornamental features of a useful article may be registered. Section 102(a)(5) states that the copyright law protects "pictorial, graphic, and sculptural works," which are defined by Section 101 to include two-dimensional and three-dimensional works of artistic craftsmanship, but only "insofar as their form but not their mechanical or utilitarian aspects are concerned." The statute also states that "the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work, only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101 (definition of "pictorial, graphic and sculptural works"); *see also Esquire, Inc. v. Ringer,* 591 F.2d 796, 800 (D.C. Cir. 1978) (agreeing with the Register of Copyrights that 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 Office uses two tests to determine if the design of a useful article is separable from its utilitarian elements, namely, a test for physical separability and a test for conceptual separability. COMPENDIUM (THIRD) § 924.2; *see also Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 739 F.3d 446, 449 (9th Cir. 2014) (finding that the Office's interpretation of conceptual separability is entitled to deference); *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q. 2d 1714, 1717 (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 useful article must contain pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact. *See* COMPENDIUM (THIRD) § 924.2(A); *see also Mazer v. Stein*, 347 U.S. 201 (1954) (finding a sculptured lamp base depicting a Balinese dancer was physically separable from the article's utilitarian function); *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (1966) (finding a pencil sharpener shaped like a telephone was physically separable from the article's utilitarian function).

To satisfy the test for conceptual separability, a useful article must contain pictorial, graphic, or sculptural features that can be visualized – either on paper or as a free-standing sculpture – as a work of authorship that is separate and independent from the utilitarian aspects of the article and the overall shape of the article. In other words, the feature must be

capable of being imagined separately and independently from the useful article without destroying the basic shape of that article. A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature and the useful article could both exist side by side and be perceived as separate, fully realized works – one an artistic work and the other a useful article. If the feature is an integral part of the overall shape or contour of the useful article, that feature cannot be considered conceptually separable because removing it would destroy the basic shape of the article. *See* COMPENDIUM (THIRD) § 924.2(B); *see also* H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668-69 (citing a carving on the back of a chair or a floral relief design on silver flatware as examples of conceptually separable design features).

If the useful article does not contain any features that can be physically or conceptually separated from its utilitarian function, the Office will refuse to register the claim, because Congress has made it clear that the Copyright Act does not cover any aspect of a useful article that cannot be separated from its functional elements. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668-69. If the Office determines that the work contains one or more features that can be separated from its functional elements, the Office will examine those features to determine if they contain a sufficient amount of original authorship to warrant registration.

2) *Originality*

A work may be registered if it qualifies as an "original work[] of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). In this context, the term "original" consists of two components: independent creation and creativity. *See Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (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 a sufficient amount of creative expression. *Id.* Only a modicum of creativity is necessary for copyright protection, but the Supreme Court has ruled that some works (such as the telephone directory at issue in *Feist*) fail to meet even this low 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 longstanding requirements of originality and creativity that are set forth in the statute and the *Feist* decision. *See, e.g.*, 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"); 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").

Some combinations of common or standard design elements may contain a sufficient amount of creativity to support a copyright claim. However, 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"). A determination of copyrightability based on a combination of standard design elements depends 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, 883-884 (D.C. Cir. 1989). A mere simplistic arrangement of non-protectable elements does not satisfy this requirement. For example, the Ninth Circuit held that a glass sculpture of a jellyfish consisting of 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 language in *Satava* is particularly instructive:

> It 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) 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); *Bleistein v. Donaldson*, 188 U.S. 239 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not necessarily mean that the work, as a whole, constitutes a copyrightable work of art.

B. *Analysis of the Work*

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work is a useful article that does not contain the requisite original separable authorship needed to sustain a copyright claim. Although the Work contains some three-dimensional elements that are conceptually separable from the utilitarian aspects of the design, these elements do not contain a sufficient amount of creative artistic authorship to warrant registration.

It is undisputed that the Work is a suitcase, and as such, it is a useful article. Likewise, it is undisputed that the Work does not contain any design features that can be physically separated from the article. Second Request, at 2. Instead, Magmatic contends that the Work is conceptually separable, because "each and every design feature included in the Trunki Product, i.e., eyes, nose, mouth, tail, feet, buttocks, stylized feet/wheels, and saddle, are separate artistic decisions [that] are . . . incorporated into a suitcase, but could clearly stand alone as a sculptural work or be visualized on paper." *Id.* at 4.

For obvious reasons, the Board finds that the oval locks that comprise the "nose" and "tail" of the Work and the wheels that comprise the "feet" are mechanical components that have an intrinsic utilitarian function. The locks keep the suitcase shut, while the wheels support the suitcase and make it easier to transport from one place to another. Similarly, the "mouth" and "buttocks" protruding from the base of the suitcase prevent it from tipping over. As for the "raised contoured strip" that purportedly evokes the filtrum (*i.e.*, the depression on the upper lip between a person's nose and mouth), it is apparent from the physical sample of the Work that this strip is a clasping mechanism that tightly joins the two sides of the suitcase together.

These features cannot be conceptually removed from the Work without destroying its basic function as a suitcase. If the nose, tail, and contoured strip were removed there would be no way to shut the suitcase. Removing the wheels, mouth, and buttocks would make it difficult to keep the suitcase standing upright. Each feature is an inseparable and integral part of the structure and function of the suitcase. They are subsumed within the overall shape and configuration of this useful article, and removing any of them would prevent the Work from being used for its intended purpose. As a result, none of these features can exist side by side with the suitcase "and be perceived as fully realized, separate works — one an artistic work and the other a useful article." COMPENDIUM (THIRD) § 924.2(B).

Magmatic also contends that the "overall design" of the Work can be separated from its function, but it is well settled that copyright does not protect the "overall shape or configuration" of a useful article "no matter how aesthetically pleasing that shape or configuration might be." *Esquire,* 591 F.2d at 800. Copyright only protects those aspects of a useful article that are separable from the article's utilitarian function and possess sufficient independent, creative authorship to satisfy the originality requirement set forth in *Feist*. *See Feist* at 499 U.S. at 345; *see also Esquire,* 591 F.2d at 800. Accordingly, we find that the Work's locks, contoured strips, "bubble" shaped protrusions, wheels, and "overall design" are all inseparable from its function as a suitcase and thus ineligible for copyright registration.

The Board does not question that the Work contains additional design elements that are separable from the Work's utilitarian function (the two cylindrical shapes that protrude from the front of the Work). However, the Board finds that these features do not possess the requisite amount of creative authorship to warrant copyright registration.

It is true that public domain elements, such as three-dimensional cylindrical shapes, may be combined with other elements to satisfy the requirement for copyrightable authorship as a compilation through their selection, coordination, or arrangement. *See* COMPENDIUM (THIRD) § 312.2. Thus, although the individual components of a given work may not be copyrightable, the Copyright Office follows the principle that works should be judged in their entirety and not judged in terms of the protectablity of individual elements within the work. *See Atari Games Corp. v. Oman*, 979 F.2d 242, 244-245 (D.C. Cir. 1992). Works based on public domain elements may be copyrightable if there is some distinguishable element in their selection, arrangement, or modification that reflects sufficient choice and authorial discretion and that is not so obvious or so minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Feist* at 359. But, this does not mean that all combinations and arrangements of commonplace, simple, or unprotected elements will rise to the level of copyrightable authorship. In *Satava*, for example, the Ninth Circuit explained that such a compilation is only protectable if the "elements are numerous enough and their selection and arrangement original enough." *Satava*, 323 F.3d at 811.

Here, the only separable features of the Work are two three-dimensional cylindrical shapes. Such ordinary shapes do not possess the requisite level of independent creativity to warrant copyright protection. Furthermore, the selection and arrangement of these two shapes when conceptually separated from the overall suitcase design is not sufficient to render the discrete shapes or the Work, as a whole, original. *See Feist*, 499 U.S. at 358 (noting that "not every selection, coordination, or arrangement will pass muster"). We find that the level of creative authorship involved in this configuration of unprotectable elements is, at best, *de minimis*, and too trivial to enable copyright registration.

III. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claims in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

Maria A. Pallante
Register of Copyrights

BY: _____
Chris Weston
Member of the Review Board