



United States Copyright Office

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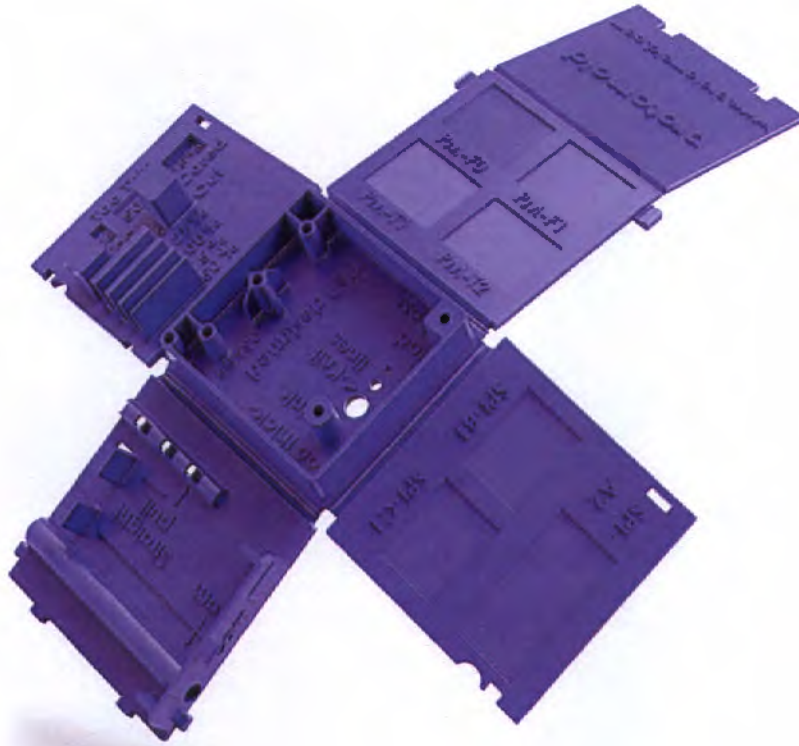
Jeffrey D. Shewchuk
Shewchuk IP Services LLC
3356 Sherman Ct., Suite 102
Eagan, Minnesota 55121

**Re: Second Request for Reconsideration for Refusal to Register Design Cube;
Correspondence ID: 1-1C6C0WF**

Dear Mr. Shewchuk:

The Review Board of the United States Copyright Office ("Board") has considered Proto Labs, Inc.'s ("Proto") second request for reconsideration of the Registration Program's refusal to register a sculpture claim in the work titled "Design Cube" ("Work"). The Work consists of a three-dimensional foldable box which is nearly, but not entirely, a cube, which includes some thirty different sized and differently shaped design elements on its exterior surface. The Board understands that the Work is not an injection mold, but that its design elements are used by Proto to represent features on parts that can be created using an injection molding process. *See* Letter from Jeffrey D. Shewchuk, to U.S. Copyright Office, at 3-5 (Jan. 25, 2016) ("Second Request"). The Work is depicted below.





After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board finds that the Work exhibits copyrightable authorship and thus may be registered.

First, based on the additional information submitted with the second request for consideration, the Board reverses the Office's prior determination that the Work "is a useful article because it is an injection mold used to create parts." Letter from Stephanie Mason, Attorney-Advisor, to Jeffrey Shewchuk at 1 (Nov. 27, 2015). While the Work appears to be the product of an injection mold, which, as a work tool, is a useful article such that its utilitarian aspects are not entitled to copyright protection, *see* 17 U.S.C. § 101; the Board understands from the explanation in the Second Request that the Work itself cannot be used as an injection mold and, as a result, the Board does not consider the Work a useful article. To the extent that the Work can be used to convey information regarding how clients may choose to design parts created by Proto's injection molding process, the Work may be analogized to how-to books or catalogs of services, both of which may be copyrightable if they contain sufficient creative expression. *See* U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 914; 920; 920.4 (3d ed. 2014) ("COMPENDIUM (THIRD)") ("In no case will a registration for two-dimensional artwork, three-dimensional sculpture, or technical drawing cover an uncopyrightable item that results from the deposit copy[ies] or the pattern pieces that may be used to make that item."). The Board notes, however, that the Work appears to include mechanical or utilitarian elements which are not

subject to copyright protection. With regard to sculptural works, the copyright law protects “three-dimensional works of fine, graphic, and applied art . . . diagrams, models, and technical drawings . . . insofar as [the works] form but not their mechanical or utilitarian aspects are concerned.” 17 U.S.C. § 101. Accordingly, any copyrightable interest in the Work will exclude its mechanical aspects, *i.e.*, the living hinges and tab attachment system which allow the Work to be folded into a cube-like shape.

Next, the Board considers the Office’s initial denial of registration on the grounds that the Work does not qualify as an “original work[] of authorship” fixed in any tangible medium of expression. *See* Letter from Guy Messier, Registration Specialist, to Jeffrey Shewchuk at 1 (May 19, 2015); 17 U.S.C. § 102 (a). In this context, the term “original” consists of two components: independent creation and sufficient creativity. *See Feist Publ’ns, Inc. 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 sufficient creativity. *Id.* Only a modicum of creativity is necessary, but the Supreme Court has ruled that some works (such as the alphabetized 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 virtually nonexistent.” *Id.* at 359.

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, but not every combination or arrangement will be sufficient to meet this test. *See Feist*, 499 U.S. at 358. A determination of copyrightability in the 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 (D.C. Cir. 1989). For example, the Office may register a work that consists merely of geometric shapes where the “author’s use of those shapes results in a work that, as a whole, is sufficiently creative.” COMPENDIUM (THIRD) § 906.1; *see also Atari Games Corp.*, 888 F.2d at 883 (“[S]imple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court.”). Thus, the Office would register, for example, a wrapping paper design that consists of circles, triangles, and stars arranged in an unusual pattern with each element portrayed in a different color, but would not register a picture consisting merely of a purple background and evenly-spaced white circles. COMPENDIUM (THIRD) § 906.1 (“The [Copyright Office] will register this claim because it . . . goes beyond the mere display of a few geometric shapes in a preordained or obvious arrangement.”).

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work satisfies the requirement of creative authorship necessary to sustain a claim to copyright. While the Board finds that the basic box shape of

the Work, to the extent it varies from a standard cube, is too trivial to enable copyright registration, it agrees that the design elements on the Work's surface render the Work sufficiently original to be copyrightable. Specifically, the Work is a sculpture that displays a selection and arrangement of more than thirty varying shapes in a manner that "goes beyond the mere display of a few geometric shapes in a preordained or obvious arrangement." COMPENDIUM (THIRD) § 906.1. Therefore, the Work "indicates [at least] some ingenuity," which is sufficient creative authorship to qualify for copyright protection. *See Atari Games Corp.*, 888 F.2d at 883.

For the reasons stated herein, the Review Board of the United States Copyright Office reverses the refusal to register the copyright claim in the Work to the extent the claim is now narrowed as described above. The Board now refers this matter to the Registration Policy and Practice division for registration of the Work, provided that all other application requirements are satisfied.

No response to this letter is needed.

BY:



Regan A. Smith
Copyright Office Review Board