United States Copyright Office
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September 18, 2012

Via First Class Mail and Fax

Morris E. Cohen, Esq.
Goldberg Cohen, LLP
1350 Avenue of Americas, 4th Floor
New York, NY 10019

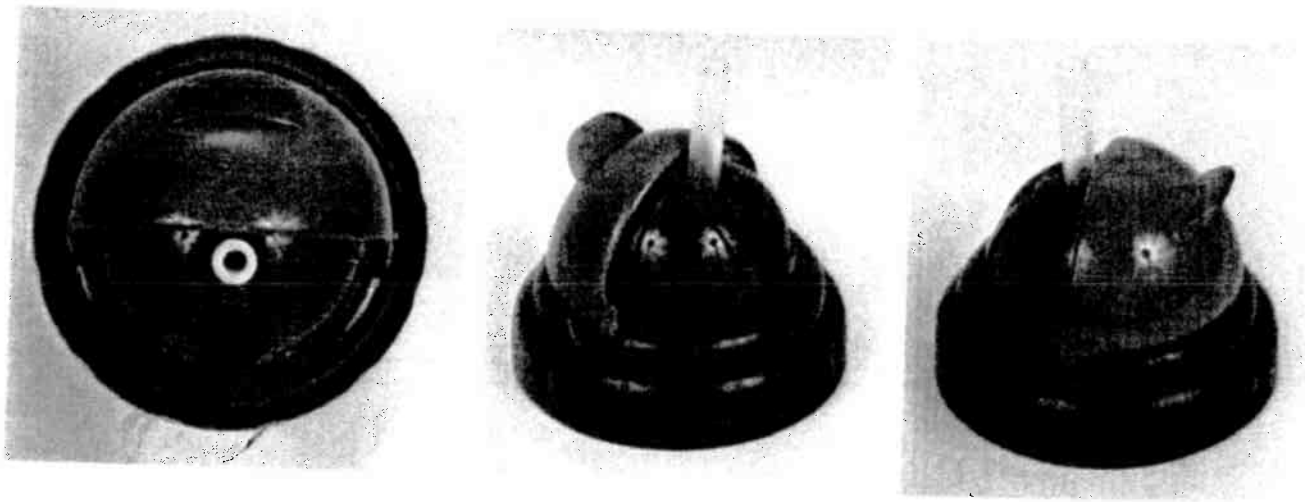
RE: FLIP IT CAP DESIGN FOR DRINKING CUPS
Control Number: 61-317-8257

Dear Mr. Cohen:

On behalf of the Copyright Office Review Board, I am responding to your December 7, 2005 letter requesting a second reconsideration of the Office's refusal to register a cap for a drinking cup. The copyright claim was submitted on behalf of your client Luv n'care, Ltd. The Copyright Office Review Board affirms the Examining Division's refusal to register.

I. DESCRIPTION OF THE WORK

The work, FLIP IT CAP DESIGN FOR DRINKING CUPS, appears as follows:



II. ADMINISTRATIVE RECORD

A. Initial submission

The Copyright Office received an application to register the above work on January 3, 2005. In a letter dated January 5, 2005, the Examiner, Sandra Ware, refused to register the design on the ground that it was a useful article which did not contain any separable features that were copyrightable. Citing 17 U.S.C. § 101, Ms. Ware stated that the design of a useful article is considered a pictorial, graphic, or sculptural work only if the 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. (Letter from Ware to Cohen dated 9/10/05 at 1). She stated that the legislative history confirms that separability may be physical or conceptual, and that the Compendium II, Compendium of Copyright Office Practices § 500 (1984) ("Compendium II"), clarifies that conceptual separability mean that the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. *See* Letter from Ware to Cohen, *supra*, at 1. Ms. Ware concluded that because all of the elements of the work were either related to the utilitarian aspects or function, or were subsumed within the overall shape, there was no physically or conceptually separable authorship. Consequently, registration was not possible. *Id.* at 2.

B. First Request for Reconsideration:

In a letter dated May 4, 2005, you requested reconsideration of the Office's refusal to register the cap for drinking cups. You acknowledged that the cap is a useful article, but nevertheless asserted that it is entitled to registration because it contains both physically and conceptually separable features. (Letter from Cohen to the Examining Division dated 5/4/05 at 1). You argued that while the work contains utilitarian aspects, the requirements could be fulfilled without utilizing the particular aesthetics in your client's design. You claimed that the cap contains a sculptural carving of a recessed and rounded triangular wedge with a margin conceptually separable from the article itself. *Id.* at 1. You asserted that this sculptural feature has no utilitarian function, and that the article can operate fully without it.

You additionally stated that a rounded bar encircles the article between the upper dome and lower rim, providing a three-tiered appearance, which is not necessary to perform the article's function. *Id.* at 1-2. You claimed the bar forming the appearance of the middle tier is a feature both physically and conceptually separable from the article, and could be removed without affecting the article's use.

You further stated that the particular shapes and contouring were designed to meet aesthetic considerations apart from the utilitarian ones. *Id.* at 2. Like the pencil sharpener shaped like an antique car cited in Compendium II, you asserted that your client's cap was designed to look analogous to a football helmet. In closing, you cited to a "rooster top" cup design by a competitor of your client which you believed was copyrightable, and similar to your client's design.

After reviewing your first request for reconsideration, Examining Division Attorney Advisor Virginia Giroux responded in a letter dated August 10, 2005. She upheld the refusal to register the cap for a drinking cup because it was a useful article, functional in nature, that did not contain any authorship that is both separable and copyrightable. (Letter from Giroux to Cohen of 9/10/05 at 1). Ms. Giroux cited the definition of "useful article" in section 101 of the copyright law, which provides that a useful article is an "article having function that is not merely to portray the appearance of the article or to convey information. An article that is part of a useful article is considered a useful article." Moreover, she stated that the statute further provides that the "design of a useful article shall be considered a pictorial, graphic, or sculptural work only if and 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 without destroying its basic shape." *Id.* at 1

Ms. Giroux clarified that in examining a work within the useful article category, the Copyright Office must first determine whether the work has any pictorial, graphic, or sculptural authorship that is either physically or conceptually separable from the utilitarian aspects of the article. *Id.* at 1. In applying this standard, the Copyright Office examines the work to determine if it contains physically or conceptually separable elements that can be regarded as a work of art apart from the shape, styling, or design of the article. She stated that examiners do not make aesthetic judgments, nor are they influenced by the attractiveness of a design, its visual effect or appearance, its uniqueness, its symbolism, the amount of time and effort it took to create, or its commercial success in the marketplace. Instead, she asserted that the question is whether there is a sufficient amount of original and creative separable authorship within the meaning of the copyright law and settled case law. *Id.* at 1.

Ms. Giroux stated that there is no dispute that the work in issue is a useful article. She characterized your argument as being that the works contain non-functional design elements based on the designer's aesthetic judgment rather that utilitarian concerns and as such, are automatically conceptually separable. She stated that the Copyright Office does not agree with such a position. *Id.* at 2.

She asserted that the physical separability test derives from the principle that a copyrightable work of art that is later incorporated into a useful article retains its copyright protection. She stated that examples include a sculptural lamp base of a Balinese dancer or a pencil sharpener shaped like an antique car. However, she clarified that the test is not met by the mere fact that the housing or other component of a useful is detachable from the working parts of an article. *Id.* at 2.

She stated that the Copyright Office's test for conceptual separability was enunciated in Compendium II, § 505.03, which generally follows the separability principle set forth in Esquire v. Ringer, 591 F.2d 796 (D.C. Cir. 1978). The Compendium II provides that conceptual separability occurs when the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for

example, or as a free-standing sculpture, as another example, independent of the shape of the article, without destroying the basic shape of the article. Examples include a carving on the back of a chair, or pictorial matter engraved on a glass vase.

Ms. Giroux stated that she regarded the rounded triangular wedges on the surface of the cap to be separable, but nevertheless not copyrightable. *See* Letter from Giroux to Cohen, *supra*, at 3. Citing Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991), she stated that a work must not only be original, but must possess more than a *de minimis* quantum of creativity. *See* Letter from Giroux to Cohen, *supra*, at 3. She elaborated that originality, as interpreted by the courts, meant that the authorship must constitute more than a trivial variation of public domain elements, citing Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951). *See* Letter from Giroux to Cohen, *supra*, at 3. She concluded that triangles, or any minor variations therefore, are not copyrightable, citing 37 C.F.R. § 202.1. Regarding the other sculptural features referred to in your letter for reconsideration, she concluded those were not separable from the work itself without destroying its basic shape. Therefore, the rounded bars creating a three-tiered appearance, and other mentioned sculptural elements she claimed were all part of the overall shape of the useful article, and therefore was not copyrightable. *See* Letter from Giroux to Cohen, *supra*, at 3.

Ms. Giroux acknowledged that the Supreme Court case of Feist Publications v. Rural Telephone Service Co., Inc., 499 U.S. 340 (1991) established that the requisite level of creativity was very low, and even a slight amount of original authorship will suffice. However, she concluded that the sculptural elements in the instant work are not copyrightable. *See* Letter from Giroux to Cohen, *supra*, at 3.

She stated that the fact that the cap portion may have been designed to somewhat resemble a football helmet did not mean the work is copyrightable. She clarified that all designs involve choices. It is not the possibility of choices that determines copyrightability, but rather whether the particular expression contains copyrightable authorship. The elements embodied in the work in issue, individually and in this particular configuration, do not contain any authorship that is both separable and copyrightable. *Id.* at 3-4. Ms. Giroux closed by citing the House Report on the Copyright Act of 1976, H.R. Rep. No. 94-1476 at 55 (1976), explaining that Congress's intention that "although the shape of an industrial product may be aesthetically satisfying and valuable, [Congress's] intention is not to offer it copyright protection." *See* Letter from Giroux to Cohen, *supra*, at 4.

C. Second Request for Reconsideration

In a letter dated December 7, 2005, you filed a second request for reconsideration for your client's work. You begin your argument that the work is entitled to registration by citing the statutory definition of "pictorial, graphic, and sculptural works" in section 101 of the copyright law. (Letter from Cohen to the Review Board dated 12/7/05 at 1). Distilling from the statutory language, you state that the design of a useful article is considered a pictorial, graphic or sculptural work to the extent the features in question can be identified

separately from and are capable of existing independently from the utilitarian aspects of the article. You conclude that your client's work meets this test. *Id.* at 1.

As you argued in your first request for reconsideration, you state that the designs include a sculptural carving on both sides of the straw depicting a recessed and rounded triangular wedge with a margin. You contend that this carving is conceptually separable from the article. *Id.* at 1. The carvings, you clarify, are not utilitarian, and are used only to enhance the appearance of the article. You dispute Ms. Giroux's characterization of this element as merely variations on a triangle. You assert that the wedges are used to achieve a pleasing artistic impression. *Id.* at 2.

You additionally argue that a number of other design elements are not needed for the article's function. The dome-shaped structure, for instance, differs substantially from the Playtex cap which was included in your first letter of reconsideration. In addition, there is a rounded bar which encircles the article between its upper dome and lower rim, providing a three-tiered appearance. *Id.* at 2. You assert that the bar forming the appearance of a middle tier is both physically and conceptually separable from the article because it can be completely removed without affecting the article's use. *Id.* at 2. You again cite to a Playtex's "rooster top" cup design which you believed is copyrightable, and similar to your client's design. *Id.* at 2-3.

You further state that the particular shapes and contouring were designed to meet aesthetic considerations apart from utilitarian ones. *Id.* at 3. Like the pencil sharpener shaped like an antique car cited in Compendium II, you assert that your client's cap is designed to look analogous to a football helmet. *Id.* at 3.

III. DECISION

A. Copyrightability of Useful Articles

In your second request for reconsideration, you acknowledge that the work in issue is a useful article which must meet the separability test set forth in the copyright law in order to secure copyright protection. Disagreeing with the position taken by the Examining Division of the Copyright Office, you assert that the work meets this test. While there is no dispute that the copyright standards applicable to useful articles apply to this work, as a starting point the Review Board believes it would be useful to review the terms of the statute and the practices of the Copyright Office relating to the extension of copyright protection to useful articles.

1. The statute

The copyright law sets forth the guiding principle regarding the extent of copyright protection for a useful article. The statute defines this protection in the following terms: "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 (2006). The legislative history accompanying the 1976 Copyright Act clarified Congress's intent with respect to copyright protection for useful articles: "... to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design." H.R. Rep. No. 1476, at 55 (1976). The House Report further explains Congress's intention that "although the shape of an industrial product may be aesthetically satisfying and valuable, [Congress's] intention is not to offer it copyright protection..." *Id.* Specifically addressing the issue of the "shape" of an industrial product, the House Report goes on to state that:

> Unless the shape of an automobile, airplane, ladies' dress, food- processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design--that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. Id.

2. Copyright Office Compendium

Compendium II, the Copyright Office's manual of practices with respect to examination of claims to copyright registration, addresses registration of the works of the visual arts [chapter 500] which include the "pictorial, graphic and sculptural works" to which the statute refers. Chapter 500's treatment of separability provides guidelines which explain how the Copyright Office approaches the examination of useful articles in order to determine whether such articles incorporate the statutorily-required "pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the articles." In the case of conceptual separability, Compendium II, § 505.03 (1984), states:

> Conceptual separability means that the pictorial, graphic and sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as pictorial, graphic or sculptural work which can be visualized on paper, for example, or as free-standing sculpture, an another example, independent of the shape of the useful article, i.e., the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works – one an artistic work and the other a useful article.

In the case of physical separability, Compendium II, §505.04 (1984), states:

> The physical separability test derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection.... However, since the overall shape of a useful article is not copyrightable, the test of physical separability is not met by the mere fact that the housing of a useful article is detachable from the working parts of the article.

The Office's position and its Compendium articulation of that position are consistent with the statutory grounds for protectibility of pictorial, graphic and sculptural works which are incorporated within useful articles. The statute's definitional guideline for determining whether protectible features exist apart from the utilitarian aspects of the useful article does not explicitly delineate the meaning, i.e., the scope and range, of utilitarian aspects which must be taken into account in performing such separability judgment. Although "utilitarian aspects" might appear, on first consideration, to be language which is plain on its face, Congress saw fit to include the explanatory discussion of the subject within the legislative history of the 1976 Copyright Act which has been cited above.

The House Report also specifically refers to Copyright Office regulations, promulgated in the 1940's, on the subject of applied design. The House Report [at 54] notes that the 1976 statutory language is "drawn from" those Office regulations and that part of the language is "an adaptation" of subsequent Office regulatory language which implemented Mazer v. Stein, 347 U.S. 201 (1954) [works of art incorporated into useful articles, such as mass-produced articles of commerce, may retain their copyright protection]. H.R. Rep. No. 1476, at 54-55 (1976). Courts, under both the 1909 and the 1976 Acts, have considered the appropriate extent of protection for works of art incorporated into useful articles and have consistently recognized the expertise of the Copyright Office in its administration of the registration activity, including confirming Office registration decisions concerning works of art incorporated into useful articles. *See* Norris Indus., Inc. v. Int'l Telephone and Telegraph Corp., 696 F.2d 918 (11th Cir. 1983), *cert. denied*, 464 U.S. 818 (1983); Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978) *cert. denied*, 340 U.S. 908 (1979); Vacheron and Constantin - Le Coultre Watches, Inc. v. Benrus Watch Co., Inc. 260 F.2d 637 (2d Cir. 1958); SCOA Indus., Inc. v. Famolare, Inc., 192 U.S.P.Q. 216 (S.D.N.Y. 1976).

Concerning the Office's Compendium II tests for separability, the relevant Compendium II sections are confirmed by the case law which supports the long history of the Office's interpretation. In Esquire v. Ringer, referring to the useful article passage from the 1976 House Report, *supra,* the United States Court of Appeals for the District of Columbia Circuit stated that the passage "indicate[s] unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright." Esquire, Inc. v. Ringer, 591 F.2d 796, 804 (D.C. Cir. 1978). Although Esquire was decided under the 1909 Act, the Court made clear that its references to the provisions of the 1976 Act were appropriate because "the new Act was designed in part to codify and clarify many of the [Copyright Office] regulations

promulgated under the 1909 Act, including those governing 'works of art.' " *Id.* at 803. The Office's position with respect to the interpretation of the separability issue was also confirmed by the 11th Circuit in Norris Industries, Inc., in which the Court noted Congress's intention concerning the statutory language on separability and additionally noted that other federal circuit courts have relied upon the Office for "expertise in the interpretation of the law and its application to the facts presented by the copyright application," based upon the Office's having "been concerned with the distinction between copyrightable and noncopyrightable works of art since the Copyright Act of 1870..." Norris, 696 F.2d at 922. And, although it was a case brought under the Administrative Procedure Act, 5 U.S.C. §§ 701 - 706, Custom Chrome, Inc. v. Ringer, 35 U.S.P.Q.2d 1714 (D.C.D.C. 1995), nevertheless confirmed that the Office's refusal– premised on the Compendium II tests– to register motorcycle parts was not arbitrary, capricious, an abuse of discretion and otherwise not in accordance with law.

3. Application of the separability test.

You contend that FLIP IT CAP DESIGN FOR DRINKING CUPS is both physically and conceptually separable. With respect to physical separability, you claim that the bar forming the appearance of a middle tier is both physically and conceptually separable from the article because it can be completely removed without affecting the article's use. This argument misstates the test of physical separability. The test originated from the landmark case of Mazer v. Stein where a statute of a Balinese dancer was converted into a lamp base by the addition of electrical components. In such an instance, the removal of the electrical components reveals a clearly recognizable work of sculpture. The test of physical separability stands for the principle that a copyrightable work of art does not lose copyright protection when it is incorporated into a useful article. In FLIP IT CAP DESIGN FOR DRINKING CUPS, removal of the bar forming the appearance of a middle tier does not convert the article into a recognizable work of sculpture. Instead, it remains a cap for a drinking cup which looks somewhat different. Moreover, the bar forming the middle tier does not constitute a work of sculptural (or any other) authorship in and of itself. If the test of physical separability could be met by merely detaching a component part of a useful article, an activity that in the case of the work before us seems highly questionable in any event, then most useful articles would suddenly become copyrightable. As provided in Compendium II, §505.04, " the test of physical separability is not met by the mere fact that the housing of a useful article is detachable from the working parts of the article

You additionally identify a number of elements you assert meet the test of conceptual separability. These elements include what you describe as a sculptural carving on both sides of the straw depicting a recessed and rounded triangular wedge with a margin; a dome-shaped structure, and a rounded bar which encircles the article between its upper dome and lower rim, providing a three-tiered appearance. These identified elements fail to meet the test of conceptual separability because none of them are recognizable as an independent pictorial, graphic or sculpture work. Instead, they are readily recognizable as parts of the useful article, with no independent artistic existence. Accordingly, these elements fail to meet the test of conceptual separability.

In urging registration of your client's work, you cite to a "rooster top" cup design of a competitor of your client, apparently to demonstrate that the same utilitarian function can be achieved by a design different from the design of FLIP IT CAP DESIGN FOR DRINKING CUPS. But the test for separability does not depend on whether or not there are alternative means to perform the utilitarian function. As Section 505.05 of Compendium II states, "In applying the test of separability, the following are not relevant considerations: 1) the aesthetic value of the design, 2) the *fact that the shape could be designed differently,* or 3) the amount of work which went into the making of the design." (Emphasis added.) To avoid a finding of conceptual separability under the copyright law, a feature need not constitute the only way to perform the utilitarian function of the useful article. Rather, unless the design of the feature was created independently of functional influences, it cannot be separable. *See* Brandir International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987) ("if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements;") Robert C. Denicola, "Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles," 67 *Minn. L. Rev.* 707, 741 (1983) ("copyrightability ultimately should depend on the extent to which the work reflects artistic expression *uninhibited* by functional considerations")(emphasis added).

4. Aesthetic Considerations

You further state that the particular shapes and contouring were designed to meet aesthetic considerations apart from the utilitarian ones. (Letter from Cohen to the Review Board of 12/7/05 at 2). The "registerability of a work . . . is not affected by the style of the work or the form utilized by the artist." Compendium II, section 503.01. As noted above, in determining whether any authorship in a useful article is separable, whether the shape could have been designed differently is irrelevant. *Id.* § 505.05. The question before the Board is not the artistic style adopted by your client in FLIP IT CAP DESIGN FOR DRINKING CUPS, but whether the work contains separately identifiable artistic expression. The Board can detect no such separable authorship.

The Office applies the same standard of authorship to all types of works without judging the aesthetic merit of the works. Although you contend that aesthetic considerations dictate much of the design features used by your client, the Office's analysis of any work is premised upon statutory and regulatory requirements and not on a subjective interpretation of the artistic value of the work. *See, e.g.,* Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903) (courts should not undertake to judge the artistic worth of a work of authorship.), *Accord,* H.R. Rep. No. 1476, at 51, (1976) (the standard for copyright protection "does not include requirements of novelty, ingenuity, or esthetic merit.") The Copyright Office does not look for, nor does it reject, any particular "style" of art in its examination; rather, it looks for the presence of separable, copyrightable authorship in useful articles which have been submitted for registration.

IV. CONCLUSION

For the reasons stated above, the Copyright Office Review Board concludes that FLIP-IT CAP DESIGN FOR DRINKING CUP cannot be registered for copyright protection. This decision constitutes final agency action.

Sincerely,

/s/

David O. Carson
General Counsel
for the Review Board
United State Copyright Office