United States Copyright Office
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April 25, 2016

Pillsbury Winthrop Shaw Pittman LLP
Attn: Peter K. Hahn
501 W. Broadway, Suite 100
San Diego CA 92101-3575

Re: Second Request for Reconsideration for Refusal to Register Ion IQ Headset Sculpture, Correspondence ID: 1-PY753E

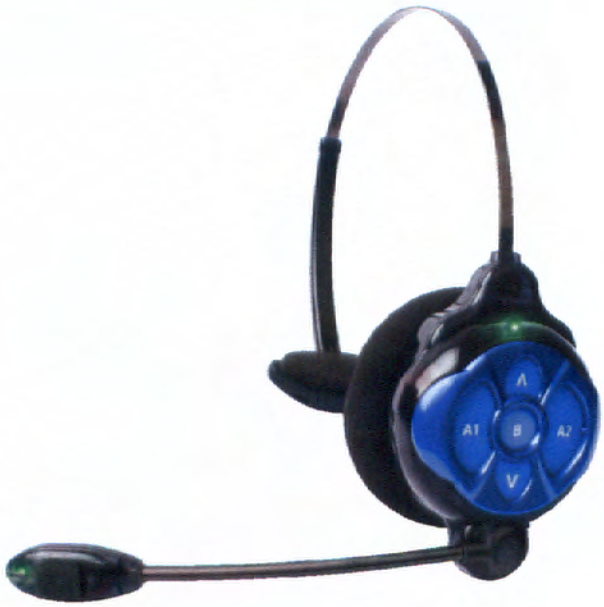
Dear Mr. Hahn:

The Review Board of the United States Copyright Office ("Board") is in receipt of HM Electronics, Inc.'s second request for reconsideration of the Registration Program's refusals to register the work titled "Ion IQ Headset Sculpture" ("Work"). After reviewing the application, the deposit copy, the relevant correspondence, and arguments in the second request for reconsideration, the Board affirms denial of the registration.

I. DESCRIPTION OF THE WORK

The Work consists of a monaural (single speaker) headset comprised of one large, over-ear headphone with several buttons on the side and a protruding microphone; there are green lights on the speaker housing and on the tip of the microphone.

A photographic reproduction of the Work is set forth below.



II. ADMINISTRATIVE RECORD

On December 24, 2013, HM Electronics, Inc. ("HM Electronics") submitted an application to register a claim in "sculpture" for the Work. On December 26, 2013, the United States Copyright Office refused registration, finding that it is a "useful article" that "does not contain any separable features that are copyrightable." Letter from Sandra Ware, Registration Specialist, to Peter Hahn (Dec. 23, 2013).

In a letter dated March 26, 2014, HM Electronics requested that the Office reconsider its initial refusal to register the Work. Letter from Peter Hahn to Copyright RAC Division (Mar. 26, 2014) ("First Request"). After reviewing the Work in light of the points raised in the First Request, the Office reevaluated the claims and, in a letter dated July 7, 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, Attorney-Advisor, to Peter Hahn (July 7, 2014).

In a letter dated October 7, 2014, HM Electronics requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. Letter from Peter Hahn to Copyright R&P Division (Oct. 7, 2014) ("Second Request"). In that letter, HM Electronics claims that elements of the Work are physically as well as conceptually separable, and that the separable design features demonstrate at least the minimum amount of creativity required to support registration under the standard for originality required by copyright law. Second Request at 5. Specifically, HM Electronics points to the characteristics of particular pieces of the headphones to support its arguments that the Work contains separable and copyrightable authorship.

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separabilty*

The copyright law does not protect useful articles, which are defined as "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 that have been incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). The protection for such works is limited, however, in that it extends only "insofar as [the designs'] form but not their mechanical or utilitarian aspects are concerned." *Id.* at 101. In other words, 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, the utilitarian aspects of the article." *Id.*; *see also Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978) (holding 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 employs two tests to assess separability: (1) a test for physical separability; and (2) a test for conceptual separability. *See* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2 (3d ed. 2014) ("COMPENDIUM (THIRD)"); *see also Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (9th Cir. 2014) (finding that the Office's interpretation of conceptual separability is entitled to deference, while noting that "[c]ourts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be

identified separately from and exist independently of the article's utilitarian function") (citation omitted); *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995) (finding that the Office's tests for physical and conceptual separability are "a reasonable construction of the copyright statute[] consistent with the words of the statute, existing 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 (S.D.N.Y. 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 work's utilitarian aspects without destroying the work's basic shape. 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).

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. *See* H.R. REP. NO. 94-1476 (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 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.

The Office's regulations implement the long-standing requirements of originality and creativity in the law, as affirmed by 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"); *id.* at 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 sufficient creativity with respect to how they are juxtaposed or arranged to support a copyright. However, not every combination or arrangement will be sufficient to meet this test. *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 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).

A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection. For example, the Ninth Circuit rejected a claim of copyright in a piece of jewelry where the manner in which the parties selected and arranged the work's component parts was more inevitable than creative and original. *See Herbert Rosenthal Jewelry Corp. v. Kalpakian,* 446 F.2d 738, 742 (9th Cir. 1971). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, 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. *See* COMPENDIUM (THIRD) § 310.2. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's 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 Lithographing Co.*, 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 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 contain the requisite separable original authorship needed to sustain a copyright claim.

It is undisputed that this Work is a set of headphones with an attached microphone and as such is a useful article. Thus, for there to be any consideration of the design features, the features must be either physically or conceptually separable from the Work's utilitarian functions. *See Esquire*, 591 F.2d at 800. In arguing that the sculptural authorship in this work is physically separable from its utilitarian aspect, HM Electronics describes various elements of the headset as resembling other objects, such as "a highly stylized flower bulb and petals," or "an art deco mantel clock." Second Request at 3-4.

HM Electronics' assertion that several of the elements "can be visualized as having a separate, independent existence," even if true, does not automatically mean that the design elements are conceptually separable from the useful article. Second Request at 3-5. As explained above, to be conceptually separable, 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, at 55 (1976), *reprinted in* U.S.C.C.A.N. 5659, 5668. Here, while the various aspects of the work could conceivably be imagined separately as taking the shape of "a highly stylized flower bulb and petals" or an "art deco mantel clock shape," removal of these elements from the Work would destroy the Work's basic shape.

Further, it is well settled that copyright protection does not extend to the "overall shape or configuration" of a utilitarian article "no matter how aesthetically pleasing that shape or configuration might be." *Esquire*, 591 F.2d 800; *see also Inhale, Inc.* 739 F.3d 449 (adopting the Office's reasoning "that whether an item's shape is distinctive does not affect separability"). Accordingly, we find that the Work lacks separable authorship and is not eligible for protection under the Copyright Act.

Even if the Board were to agree that these features are conceptually separable, the Board finds that these elements would nonetheless be insufficient to meet the creativity threshold set forth in *Feist*. 499 U.S. at 359. The earpiece consists of four oval shapes with a circle in the middle, all common geometric shapes. Each geometric shape is inscribed with a letter or a letter/number combination, such as "V" and "A1," etc. As explained in the Office's *Compendium*, common geometric shapes, letters and numbers are not copyrightable. *See* COMPENDIUM (THIRD) §§ 313.3(D), 906.1. The very basic combination of geometric shapes, letters and numbers comprising the Work lacks the requisite amount of creativity to warrant copyright protection. *See Feist*, 497 U.S. at 358 (noting that "not every selection, coordination, or arrangement will pass muster"); *see also* COMPENDIUM (THIRD) § 913.1.

IV. CONCLUSION

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

BY: _____
Regan Smith
Copyright Office Review Board