**United States Copyright Office**
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January 8, 2019

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**Re: Second Request for Reconsideration for Refusal to Register Box Design I; Correspondence ID: 1-2WE3Z9Z; SR 1-4915853861**

Dear Mr. Hunt:

The Review Board of the United States Copyright Office ("Board") has considered Diamond Assets, LLC's ("Diamond's") second request for reconsideration of the Registration Program's refusal to register a sculpture claim in the work titled "Box Design I" ("Work"). After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board affirms the Registration Program's denial of registration.

## I. DESCRIPTION OF THE WORK

The Work is a cardboard container . It is comprised of four sides, a bottom piece, and lid piece. It also contains an interior flap from which a circle is cut out. The Work is depicted as follows:

## II. ADMINISTRATIVE RECORD

On May 10, 2017, Diamond filed an application to register a copyright claim in the Work. In a September 5, 2017, letter, a Copyright Office registration specialist refused to register the claim, finding that it "it is a useful article, and . . . it does not contain any non-useful design element that could be copyrighted and registered." Letter from C. Stoner, Registration Specialist, to Jason M. Hunt, at 1 (Sept. 5, 2017).

In a letter dated October 6, 2017, Diamond requested that the Office reconsider its initial refusal to register the Work. Letter from Jason M. Hunt to U.S. Copyright Office (Oct. 6, 2017) ("First Request"). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Work is a useful article "not eligible for copyright protection." Letter from Stephanie Mason, Attorney-Advisor, to Jason M. Hunt, at 3 (Feb. 21, 2018). The Office reasoned that "th[e] circular shape cannot exist apart from the box itself, because it consists of 'negative space' and thus has no physical form. But this shape can be visualized in another medium of expression, such as glass or lucite." *Id.* However, on the basis that familiar symbols and designs and common geometric shapes are not copyrightable, the Office concluded: "Even if the circular shape was imaginatively recast in a transparent medium it would not be considered a pictorial, graphic, or sculptural work within the meaning of § 101 of the Copyright Act." *Id.* Therefore, the Office upheld the refusal to register the Work. *Id.*

In a letter dated May 21, 2018, Diamond 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 Jason M. Hunt, to U.S. Copyright Office (May 21, 2018) ("Second Request"). In that letter, Diamond states that it "claims, not a cutout in the shape of a circle, but the original design of a circular aperture on a rectangular surface or sheet having a solid backdrop is a three-dimensional artistic design applied to a useful article." *Id.* at 2. Next, Diamond argues that "[t]he circular aperture within the original design feature is not 'negative space' as claimed by the Registration Specialist"; rather, Diamond contends, "the design of the circular aperture . . . is the object of interest . . . ." *Id.* at 3. In addition, Diamond asserts that the design contains "the three-dimensional element of a circular aperture of a particular size and specific location on a rectangular surface or sheet having a solid backdrop. No prior work pertaining to similar articles includes these creative, non-trivial features in the original and distinctive combination chosen by the authors." *Id.* at 4.

## III. DISCUSSION

### *A. The Legal Framework*

#### *1) Useful Articles and Separability*

Copyright does not protect useful articles as such, which are defined in the Copyright Act 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. Importantly, however, artistic features applied on or incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works under sections 101 and 102(a)(5) of the Copyright Act. This protection is limited to the "'pictorial, graphic, or sculptural features' [that] 'can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.'" *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (quoting 17 U.S.C. § 101).

To assess whether an artistic feature incorporated into the design of a useful article is protected by copyright, the Office examines whether the feature "(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated." *Id.* at 1007; *see also* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924 (3d ed. 2017) ("COMPENDIUM (THIRD)"). This analysis focuses on "the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction [because the] statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature." *Star Athletica*, 137 S. Ct. at 1013. Put another way, while useful

articles as such are not copyrightable, if an artistic feature "would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article." *Star Athletica*, 137 S. Ct. at 1011; 17 U.S.C. § 113(a) ("[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise."); *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").

***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 longstanding requirement of originality set forth in the Copyright Act and described in 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"); *id*. § 202.10(a) (stating "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. Nevertheless, 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 United States District Court for the Southern District of New York upheld the Copyright Office's refusal to register simple designs consisting of two linked letter "C" shapes "facing each other in a mirrored relationship" and two unlinked letter "C" shapes "in a mirrored relationship and positioned perpendicular to the linked elements." *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 496 (S.D.N.Y. 2005). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, 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).

Similarly, while the Office may register a work that consists merely of geometric shapes, for such a work to be registrable, the "author's use of those shapes [must] result[] 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.

### *B. Analysis of the Work*

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work does not contain the requisite separable authorship necessary to sustain a claim to copyright.

The Board finds that the Work is a useful article, a fact that Diamond does not dispute. *See* Second Request at 2. Instead, Diamond focuses on an element in the interior of the Work, a circle on a solidly colored rectangle, as the basis for registration, arguing that this artistic feature

is both separable and registrable. *See id.* Under *Star Athletica*, the circle within the rectangle is indeed conceptually separable, as it can be perceived apart from the box itself. The design of a circle on a rectangular can be identified as a freestanding three-dimensional work of art. The fact that the circle is a cutout and consists of the absence of material does not prevent it from being so. *See Star Athletica*, 137 S. Ct. at 1032 (reciting "carvings engraved onto furniture" as an example of "copyrightable matter," indicating that designs involving the creation of negative space may be conceptually separable).

The design of the interior of the box, however, must still meet the standard for originality under *Feist*, which it does not. *See Feist*, 499 U.S. at 358–59. The question of independent creation is not at issue. The Office's analysis, therefore, focuses on the question of sufficient creativity. The individual elements—a square and a rectangle—are uncopyrightable as common geometric shapes. 37 C.F.R. § 202.1(a) (stating that "familiar symbols or designs" are not registrable); COMPENDIUM (THIRD) § 906.1 (including circles and rectangles in the list of non-protectable common geometric shapes). The fact that the design is three-dimensional does not alter the Office's analysis. COMPENDIUM (THIRD) § 906.1 ("The Copyright Act does not protect common geometric shapes, either in two-dimensional or three-dimensional form."). Likewise, the combination of the components is not sufficient to make the design original, as it is merely a circle placed on a solidly colored rectangle. The *Compendium* instructs that a solidly colored rectangle decorated with many evenly spaced circles would be denied registration. *Id.* § 906.1. Therefore, even considering the precise proportion, form, and configuration here, one circle placed on a solidly colored rectangle lacks the requisite originality required by *Feist*. Finally, Diamond points out that the box's particular configuration is not common in its industry. Second Request at 5. True as this fact may be, it does not influence the Office's analysis, because novelty is not the same thing as originality. *Feist*, 499 U.S. at 345 (stating that "[o]riginality does not signify novelty"); COMPENDIUM (THIRD) § 310.1. Thus, both the individual elements of the Work and the combination of those elements fail to demonstrate the requisite creativity.

## IV. CONCLUSION

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

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