United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

May 25, 2006

Daniel J. Warren, Esq.
Sutherland Asbill & Brennan LLP
999 Peachtree Street, N.E.
Atlanta, GA 30309-3996

Re: Aegean Art Frames
Copyright Office Control Number 61-314-1086(L)
Aegean Frame Nos. 392370, 392371, 392372, 392373, 392374, 392375, 592372, 592373
Copyright Office Control Number 61-315-5648(L)
Aegean Frame No. 592370
Copyright Office Control Number 61-321-7166(L)
Aegean Frame Nos. 392376, 592371, 592374, 592375, 592376

Dear Mr. Warren:

I write on behalf of the Copyright Office Review Board [hereinafter Board] in response to your letter dated June 16, 2005, in which you requested the U.S. Copyright Office [hereinafter Office] to reconsider for a second time its refusal to register the fourteen Aegean art frames identified above. The Board has carefully examined the applications, the deposits and all correspondence concerning these applications, and must affirm denial of registration for these frames due to their lack of sufficiently creative, separable authorship.

I. DESCRIPTION OF WORKS

The subject Aegean frames, of which there are larger and smaller versions, are comprised of linear moldings mitered at the corners. The molding has a slight concave slope towards the center of the frame. The surface of each frame is contoured with linear ridges and depressions that parallel the edge of the molding, and features one of a variety of mottled colors. Appendix A displays images of these frames.

II. ADMINISTRATIVE RECORD

A. Initial Applications and Office's Refusal to Register

On May 7, 2004, the Office received fourteen Form VA applications[1] from Margaret Craig, a representative of Larson-Juhl US LLC, a wholly-owned subsidiary of the claimant Albecca, Inc., to register individual art frames. In letters dated July 28, 2004, August 20, 2004, and December 14, 2004, respectively, Visual Arts Section Examiners Sandra D. Ware, Kathryn Sukites and Helen Livanios refused registration of these works because they determined that each work lacked the separable authorship necessary to support a copyright claim. Letter from Ware to Craig of 07/28/04, at 1; Letter from Sukites to Craig of 08/20/04, at 1; Letter from Livanios to Craig of 12/14/04, at 1.

B. First Request for Reconsideration regarding Frames Assigned to Control Numbers 61-314-1086(L) and 61-315-5648(L)

In a letter dated October 29, 2004, you requested reconsideration of the Office's refusal to register the nine Aegean frames assigned to Copyright Office Control Numbers 61-314-1086(L) and 61-315-5648(L), as well as other frames not subject to your second request for reconsideration. Letter from Warren to Chief, Receiving & Processing Division of 10/29/04, at 2. You explained that high-end, popular, artistic frames which result from the selection of sculptural, texture and coloring aspects are often imitated in lower-end reproductions, and noted that your client's "artisans and designers take tremendous pride in the craftsmanship, quality, and unique appearance of each frame and line of frames" and these frames "are frequently copied by competitors because of their popularity." *Id.* You described the Aegean line of frames as "inspired by the natural colors of the Aegean Sea and surrounding landscape." *Id.* at 3. You noted its "weathered or sea-related coloring" as well as its unique sculptural cross-section which for the 592 Series "has a series of softly rolling curves that dip and rise from the outside of the frame towards the inside" and for the 392 series features "somewhat more pronounced curves with a large outer curve and a series of smaller inner curves." *Id.* at 3-4.

You argued that conceptual separability exists in each of these works because "the artistic design of the frames is clearly independent of any functional influences." *Id.* at 4. You further argued that physical separability exists as well, because each of the frames "can be cut such that a perfectly flat, unadorned, rectangular frame may be removed from the upper and side surfaces."

---

[1] The Office contemporaneously received numerous other Form VA applications for other frames in the Aegean line, some of which were also the subject of your first request for reconsideration. However, because you have not included them in your second request for reconsideration dated June 16, 2005, the Board does not address them herein.

Id. The removed surface, you argue, would qualify as an artistic work much in the same manner as the carvings on the back of a chair.

Finally, you requested registration of these works under the "rule of doubt," and attached as support a demand letter evidencing that your client has defended its intellectual property from knock-offs. *Id.* at 5.

C. Examining Division's Response to First Request for Reconsideration regarding Frames Assigned to Control Numbers 61-314-1086(L) and 61-315-5648(L)

In response to your request and in light of the points raised in your letter of October 29, 2004, Attorney Advisor Virginia Giroux of the Examining Division reexamined the applications and determined that each of these nine frames, as well as each of the other frames which were also the subject of that request, was a useful article that did not contain any authorship that was both separable and copyrightable. Letter from Giroux to Warren of 02/17/05, at 2. She noted that you did not dispute the fact that these frames are useful articles, but rejected your arguments that these frames contain physically and conceptually separable design elements, mainly because the overall shape of a useful article is not copyrightable. *Id.* at 3-4. She also explained that the process or technique which gives these frames their weathered look or sea-related appearance cannot be the subject of copyright protection. *Id.* at 2. Finally, she rejected your request to register these works under the "rule of doubt," finding that these frames clearly fall within the category of non-copyrightable works. *Id.* at 4.

D. First Request for Reconsideration regarding Frames Assigned to Control Number 61-321-7166(L)

In a letter dated February 24, 2005, and entitled "Supplement to First Appeal," you requested the Office to reconsider its refusal to register the five Aegean Frames assigned to Copyright Office Control Number 61-321-7166(L). Letter from Warren to Chief, Receiving & Processing Division of 02/24/05, at 2. You stated that, with respect to these additional five Aegean frames, you adopted the arguments made in your appeal dated October 29, 2004, relating to the nine other Aegean frames assigned to the other two control numbers. *Id.*

E. Examining Division's Response to First Request for Reconsideration regarding Frames Assigned to Control Number 61-321-7166(L)

Attorney Advisor Giroux reexamined these five additional applications and works, and again determined that each of these five Aegean Frames was also a useful article that did not contain any authorship that was both separable and copyrightable. Letter from Giroux to Warren of 03/04/05, at 1. She provided the same analysis and conclusions she set forth in her prior response letter of February 17, 2005. *Id.* at 1-3.

F. Second Request for Reconsideration

In a letter dated June 16, 2005, you request the Office to reconsider for a second time its refusal to register the copyright claims in all fourteen Aegean frames assigned to the three above-referenced Copyright Office Control Numbers. Letter from Warren to Board of 06/16/05, at 1. You state that you adopt the legal arguments recited in the second request for reconsideration you submitted regarding your client's Canaletto, Ferrosa and Deco lines of frames. *Id.* at 2. Specifically, you argue that physical separability exists because the Aegean frames can be cut so that their surfaces may be removed from the functional frame. *Id.* You also repeat the description of the Aegean frames that you provided in your first two requests for reconsideration. *Id.*

III. DECISION

A. The Legal Framework

1. Useful Articles and Separability

As a general proposition, copyright protection presumptively does not extend to a useful article, defined 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. However, works of artistic craftsmanship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* § 101. The design of the useful article will be protected "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." *Id.* This separability can be physical or conceptual. Congress has explained that:

> [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an . . . 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. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element and would not cover the over-all configuration of the utilitarian article as such.

H.R. Rep. No. 94-1476, at 55.

Physical separability means that the subject pictorial, graphic or sculptural features must be able to be separated from the useful article by ordinary means. *Compendium of Copyright Office Practices II,* § 505.03 - 505.04 (1984) [hereinafter *Compendium II*].

Conceptual separability means that the subject features are "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 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." *Compendium II*, § 505.03. For example, while a carving on the back of a chair cannot readily be physically separated from the chair, it can easily be conceptually separated because one could imagine the carving existing as a drawing. The chair, meanwhile, would still remain a useful article having retained its basic shape, even absent the carving. The carving would therefore qualify as conceptually separable.

Additionally, as explained in *Esquire v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 404 U.S. 908 (1979) copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be." In that case, the Office had refused to register an outdoor lighting fixture which arguably contained non-functional, purely aesthetic features. The court upheld the Office's refusal, noting that "Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products." *Id.* Similarly in *Norris Industries, Inc. v. International Telephone & Telegraph Corp.*, 696 F.2d 918, 924 (11th Cir. 1983), *cert. denied,* 464 U.S. 818 (1983), the court held that a wire-spoked wheel cover was not entitled to copyright protection because it was a useful article used to protect lugnuts, brakes, wheels and axles from damage and corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself.

2. Original Works of Authorship

Just because an artistic feature may be separable from a utilitarian object, though, does not mean that it will necessarily merit copyright protection. All copyrightable works, be they sculptures, engravings or otherwise, must also qualify as "original works of authorship." 17 U.S.C. § 102(a).

The term "original" consists of two components: independent creation and sufficient creativity. *Feist Publications, Inc. v. Rural Telephone Service 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. The Office accepts at face value the assertion on the subject applications for registration that your client Albecca, Inc. acquired any copyrights in and to these works by virtue of assignments from its wholly-owned subsidiaries who originally created the works. Therefore, the first component of the term "original" is not at issue in the analysis set forth herein. Second, the work must possess sufficient creativity. In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist*, where the Supreme Court held that only a modicum of creativity is necessary.

The requisite level of creativity is "extremely low"; "even a slight amount will suffice." *Feist*, 499 U.S. at 345. However, the Court also ruled that some works (such as the work at issue in that case) fail to meet the standard. 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, and 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; *see also* 37 CFR § 202.10(a) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."); 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.01(B) (2002) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.").

Even prior to *Feist*, the Office recognized the modest, but existent, requisite level of creativity necessary to sustain a copyright claim. *Compendium II* states, "Works that lack even a certain minimum amount of original authorship are not copyrightable." *Compendium II*, § 202.02(a). With respect to pictorial, graphic and sculptural works, *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Id.* § 503.02(a).

In implementing this threshold, the Office and courts have consistently found that standard designs, figures and geometric shapes are not sufficiently creative to support a copyright

claim. *Id.* § 503.02(a) ("[R]egistration cannot be based upon the simplicity of standard ornamentation . . . . ").[2]

Of course, some combinations of common or standard design elements contain sufficient creativity with respect to how they are combined or arranged to support a copyright. *See Feist*, 499 U.S. at 358 (the Copyright Act "implies that some 'ways' [of compiling or arranging uncopyrightable material] will trigger copyright, but that others will not"; determination of copyright rests on creativity of coordination or arrangement). However, merely combining non-protectible elements does not automatically establish creativity where the combination or arrangement itself is simplistic. For example, the Eighth Circuit upheld the Register's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in cursive script below the arrow. *John Muller & Co. v. New York Arrows Soccer Team*, 802 F.2d 989 (8th Cir. 1986). *See also Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) ("It is true, of course, that a *combination* of unprotectible elements may qualify for copyright protection. [citations omitted.] But it is not true that *any* combination of unprotectible elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectible 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.") (emphasis in original)

After again examining the fourteen Aegean frames and in light of the above-described legal framework, the Board has determined that all of the subject works are intrinsically useful articles that do not contain any separable authorship that is copyrightable.

B. Analysis of Works

1. The Art Frames are Useful Articles

As self-evident from the "Nature of this Work" designation on the applications for registration, the "art frames" at issue are useful articles. They hold the art in place away from a wall and permit hanging without compromising the art itself. While the Office recognizes that some art frames may incorporate artistic features, the intrinsic purpose of a frame is useful. An industrial product qualifies as a "useful article" as long as it has "an intrinsic utilitarian function." You have not objected to the designation of art frames as useful articles, and in fact recognized them as such in your first request for reconsideration regarding your client's Canaletto, Ferrosa and Deco lines of frames. Letter from Warren to Chief, Receiving & Processing Division of

---

[2] *See also, id.* § 202.02(j) ("Familiar symbols or designs . . . or coloring, are not copyrightable."); *id.* § 503.03(b) ("No registration is possible where the work consists solely of elements which are incapable of supporting a copyright claim."); 37 CFR § 202.1(a) ("[F]amiliar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained.").

01/30/04, at 4. Based on the foregoing, the Board finds that these art frames fit squarely within the definition of useful articles.

2. None of the Frames Contain Separable Design Elements

Separable elements incorporated into a useful article can warrant copyright protection in and of themselves provided that they embody a sufficient amount of creativity. Physical separability is a moot point in this instance because the solid, wood frames have no design elements that could be separated by ordinary means. You argue that physical separability exists, though, because each of the frames "can be cut such that a perfectly flat, unadorned, rectangular frame may be removed from the upper and side surfaces." Letter from Warren to Chief, Receiving & Processing Division of 10/29/04, at 4. However, the required use of a mechanical device to divide an otherwise solid medium is not within the scope of separation by ordinary means. As we did in our May 15, 2006 letter, we point out that each frame at issue here is an integrated, solid medium; cutting the base away from the upper structure is not within *Compendium II's* intended scope of physical separation by "ordinary means." *Compendium II*, 505.03-505.04. Such physical division would destroy the overall objects of the frames as they exist in the exact form in which they have been submitted for registration: the frames for which you seek registration are not plain, wooden rectangles. Your statement that the frames "can be cut such that a perfectly flat, unadorned, rectangular frame may be removed from the upper and side surfaces" [Letter from Warren of 10/29/04, at 4] does not aid your argument for registration–such cutting would essentially destroy the specifically adorned frames for which registration is sought.

Nor do any of the Aegean frames contain any design elements which are conceptually separable from the utilitarian aspects of the frames themselves. The concave slopes of the moldings are part of the very contours of the frames themselves, as are the linear ridges and depressions. You argue that conceptual separability exists in each of these works because "the artistic design of the frames is clearly independent of any functional influences." *Id.* However, the fact that a feature is not necessary to or dictated by the utilitarian concerns of an article does not mean that the feature is automatically conceptually separable. If removing such features would destroy the useful article's basic shape, namely because the features are an integral part of the overall shape or contour of the useful article, then the features would not qualify as conceptually separable. The slope, ridges and depressions are just such features and, thus, not conceptually separable.

Arguably, the only design element that is conceptually separable is the coloring, but mottled brown, mottled green, mottled grey or any other mottled color is incapable of embodying sufficient creativity to warrant copyright protection in and of itself, regardless whether, as you argue, the coloring is "inspired by the natural colors of the Aegean Sea and surrounding landscape." *Id.* at 3. Whether or not copyright protection is available for a work depends on the

amount of creativity embodied in a work's elements, not the author's inspiration or motivation in developing those elements. Even if the other design elements were deemed to be conceptually separable and viewed in combination with the coloring, the result is a simple, angled frame with some surface texture paralleling the edge of the frame and some basic color. While the amount of creativity necessary to sustain a copyright registration is minimal, these few elements simply do not meet that threshold.

Other Considerations

Several other arguments that you make, while perhaps important on personal or commercial levels, have no bearing on the determination of whether or not copyright registration is available for these works. For example, you state that your client's "artisans and designers take tremendous pride in the craftsmanship, quality, and unique appearance of each frame and line of frames" and these frames "are frequently copied by competitors because of their popularity." *Id.* at 2. However, as discussed above, the commercial success or quality of a work are not material, and should not be for policy purposes, to a copyrightability analysis. *See Compendium II*, § 503.02(b) ("The requisite minimal amount of original sculptural authorship necessary for registration in Class VA does not depend upon the aesthetic merit, commercial appeal, or symbolic value of a work.").

You also argue that the applicant is entitled to registration of these works under the "rule of doubt," and attach as support a demand letter evidencing that your client has defended its intellectual property from knock-offs. Letter from Warren to Chief, Receiving & Processing Division of 10/29/04, at 5. You will note that this principle applies only when the Office determines that there is "reasonable doubt" as to whether a court would determine that the works contain copyrightable subject matter. *Compendium II*, § 108.07. Based on the analysis above, the Office does not believe that any reasonable doubt exists with respect to these fourteen frames. These works embody so little copyrightable authorship that it is not reasonable that they would satisfy the threshold necessary to sustain a copyright registration. Moreover, whether your client has asserted copyright claims against alleged infringers has no bearing on whether a court would concur with such assertion.

Finally, you state that, for purposes of this second request for reconsideration, you adopt the arguments that you made in the other second request for reconsideration that you submitted regarding your client's other lines of art frames. Letter from Warren to Board of 06/16/05, at 2. The Board has already addressed these points in its response letter dated May 15, 2006, and repetition is unnecessary.

IV. CONCLUSION

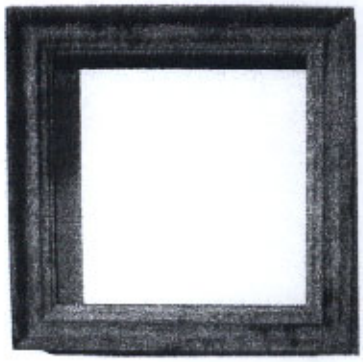
For the reasons stated herein, the Copyright Office Review Board affirms the refusal to register the fourteen Aegean frames identified above. This decision constitutes final agency action on this matter.

Sincerely,

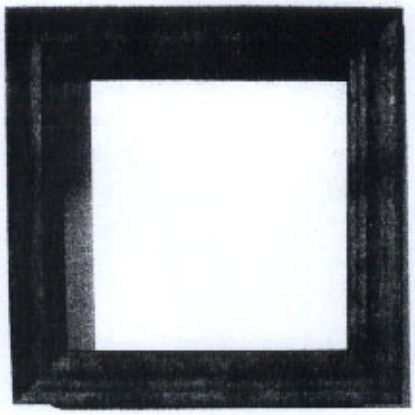
Nancie Petruzzelli
Special Legal Advisor for Reengineering
for the Review Board
United States Copyright Office

Appendix A

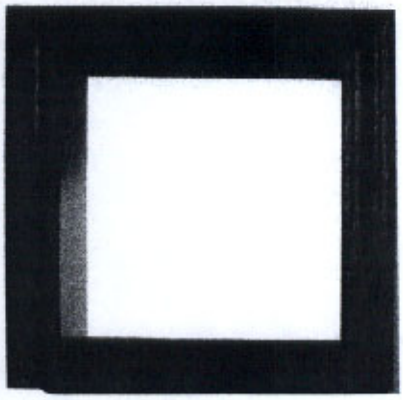
Aegean Frames



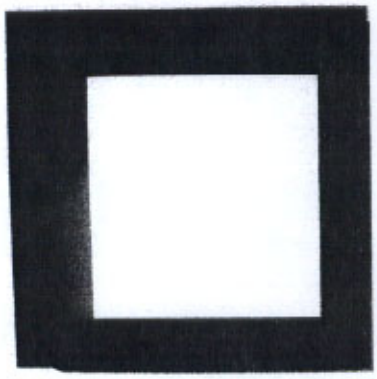
Item #: 392370
Finish: White Sand



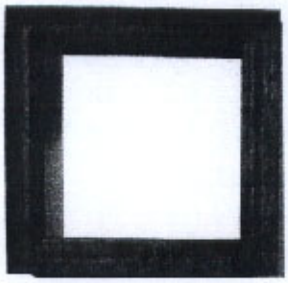
Item #: 392371
Finish: Rock Grey



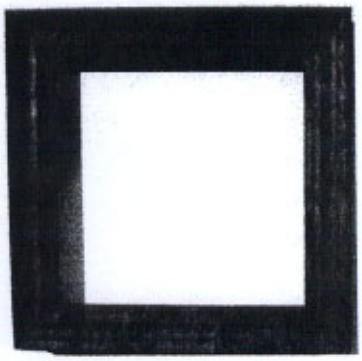
Item #: 392372
Finish: Black Coral



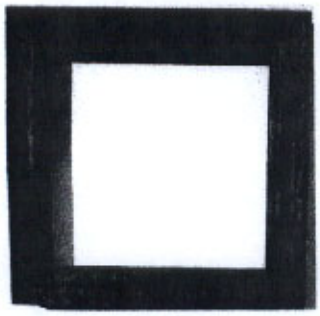
Item #: 392373
Finish: Sun Yellow



Item #: 392374
Finish: Moss Green



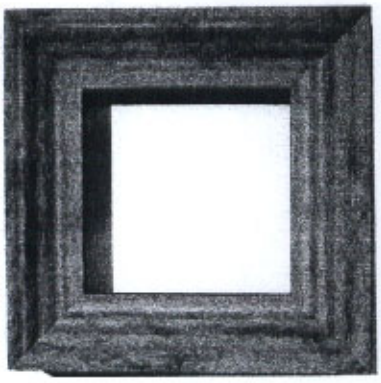
Item #: 392375
Finish: Aqua Blue



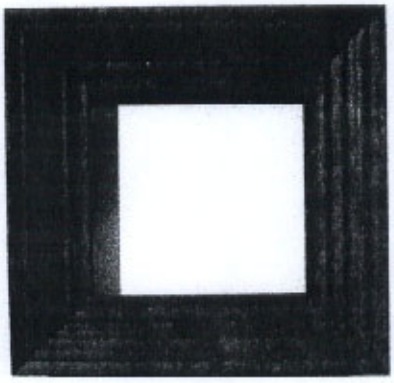
Item #: 392376
Finish: Sky Blue

Appendix A Continuation

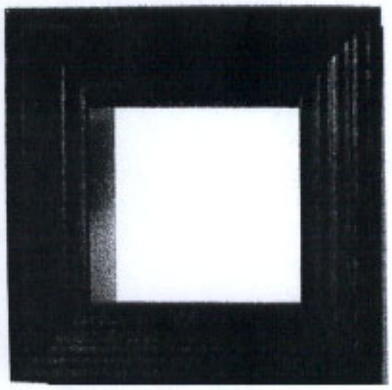
Aegean Frames



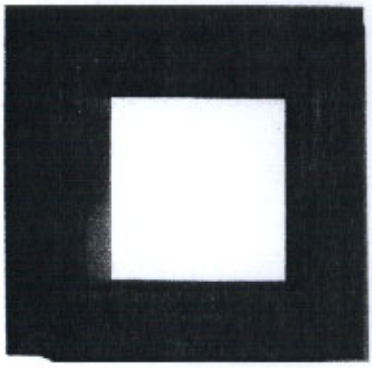
Item #: 592370
Finish: White Sand



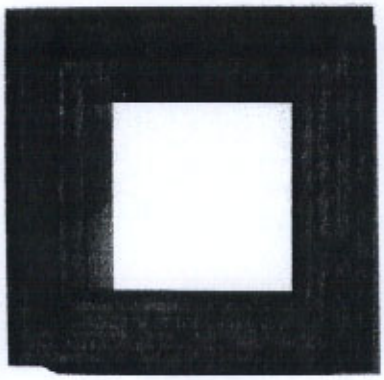
Item #: 592371
Finish: Rock Grey



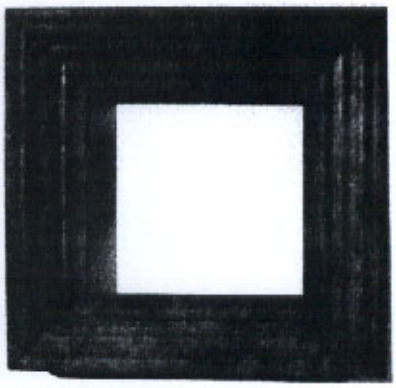
Item #: 592372
Finish: Black Coral



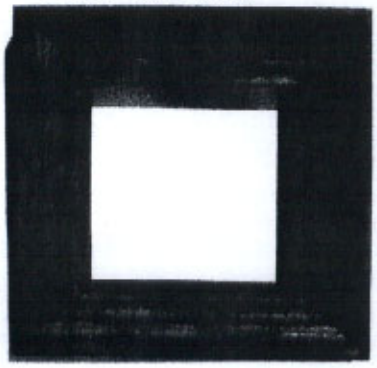
Item #: 592373
Finish: Sun Yellow



Item #: 592374
Finish: Moss Green



Item #: 592375
Finish: Aqua Blue



Item #: 592376
Finish: Sky Blue