



**United States Copyright Office**

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September 23, 2016

Mark H. Plager  
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**Re: Second Request for Reconsideration for Refusal to Register Kiesel Treated Finger Boards for String Instruments; Correspondence ID: 1-VL2YTG**

Dear Mr. Plager:

The Review Board of the United States Copyright Office (“Board”) has considered Jeff Kiesel’s second request for reconsideration of the Registration Program’s refusal to register a copyright claim in the works collectively titled “Kiesel Treated Finger Boards for String Instruments” (“Works”). 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 WORKS**

The Works are several colored fingerboards for stringed instruments. There are 188 different fingerboards with various color schemes of red, orange, yellow, green, blue, purple, pink, black, and white. Some of the fingerboards are a single solid color, some are several shades of the same color, and some incorporate several shades of two colors. The shading on the non-solid colored fingerboards is graduated, being either darker in the middle and lighter at the ends or darker on one end changing to a lighter color on the opposite end. Some of the fingerboards have one color at the center of the fingerboard with a second color framing it.

Reproductions of the Works are set forth in Appendix A.

## **II. ADMINISTRATIVE RECORD**

On October 28, 2014, Mr. Kiesel filed an application to register a copyright claim for “sculpture” in the Works. In a letter dated November 17, 2014, a Copyright Office registration specialist refused to register the Works, finding that they were “a ‘useful article’ which does not contain any separable authorship needed to sustain a claim to copyright.” Letter from Wilbur King, Registration Specialist, to Mark Plager, Plager Schack LLP (Nov 17, 2014).

In a letter dated December 4, 2014, Mr. Kiesel requested that the Office reconsider its initial refusal to register the Works. Letter from Mark Plager, Plager Schack LLP, to U.S. Copyright Office (Dec. 4, 2014) (“First Request”). After reviewing the Works in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Works do not contain any authorship that is both separable and copyrightable. Letter from Stephanie Mason, Attorney-Advisor, to Mark Plager, Plager Schack LLP (Apr. 20, 2015).

In a letter dated June 5, 2015, Mr. Kiesel requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Works. Letter from Mark Plager, Plager Schack LLP, to U.S. Copyright Office (June 5, 2015) (“Second Request”). In that letter, Mr. Kiesel argued that registration is not sought for the colors themselves but instead for the arrangement of the colors. *Id.* at 1. These arrangements, states Mr. Kiesel, are the result of “many different aesthetic choices,” and hence copyrightable. *Id.* at 2.

### III. DISCUSSION

#### A. *The Legal Framework*

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

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. 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 works]’ 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 artistic “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); *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. See COMPENDIUM (THIRD) § 924.2(A).

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 freestanding 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 [able to be] imagined separately and independently from the useful article without destroying the basic shape of that article. 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 fully realized, separate works—one an artistic work and the other a useful article.

COMPENDIUM (THIRD) § 924.2(B). 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 id; cf.* H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668 (citing a carving on the back of a chair or a floral relief design on silver flatware as examples of conceptually separable design features).

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 copyright protection does not extend to any aspect of a useful article that cannot be separated from its utilitarian elements. 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 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).

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. 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 the design’s commercial success in the marketplace are not factors in determining whether a design is copyrightable. See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

#### **B. Analysis of the Works**

After carefully examining the Works and applying the legal standards discussed above, the Board finds that the Works are useful articles that do not contain the requisite separable authorship necessary to sustain claims to copyright.<sup>1</sup>

First, Mr. Kiesel and the Board agree that the fingerboards themselves are useful objects and that the color schemes which accent the fingerboards of the instruments are conceptually separable. See Second Request at 1.

Nevertheless, after a work is deemed to be conceptually separable, the Board must evaluate the separable elements and determine whether they qualify as a copyrightable work of authorship. Here, the separable elements are the Works’ 188 color schemes. Although Mr. Kiesel does not seek to register the specific colors in the work, he does claim that the “intricate color arrangements” are copyrightable. Second Request at 2. While it is true that works may be copyrightable if their selection or arrangement reflects choice and authorial discretion that is not so obvious or so minor that the “creative spark is utterly lacking or trivial as to be nonexistent,” *Feist*, 499 U.S. at 358-9, as a rule, mere variations in coloring alone are not eligible for copyright protection, 37 C.F.R. § 202.1(a). Similarly, the Office will not register a visual art work where the author “merely added relatively few colors to a pre-existing design or simply created multiple colorized versions of the same basic design.” COMPENDIUM (THIRD) § 906.3. The colored fingerboard designs in the deposit

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<sup>1</sup> The Board also affirms the refusal on the basis that Mr. Kiesel incorrectly seeks to register the Works as “sculpture” and not “two-dimensional artwork.” Because the object of registration is the color schemes, and not the instruments that they decorate, the Works fail to meet the three-dimensional requirements of sculptural works, and thus cannot be registered as such. See COMPENDIUM (THIRD) at § 905.

represent either solid colors or gradients of one or two colors, and are a clear example of the non-registrable addition of relatively few colors to a pre-existing design—here, the fingerboard. The Board finds that these color schemes are not sufficiently creative to constitute a copyrightable work of authorship.

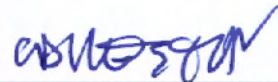
Additionally, the Second Request argues that “there are gazillions of ways to combine colors and color variations” and that Mr. Kiesel chose to register only a limited amount of arrangements out of the unlimited number of color combinations and patterns that he could have chosen from. Second Request at 2. Mr. Kiesel’s stylistic choices and color alternatives have no bearing on the Board’s analysis. It is not the number of options available that determine copyrightability, but the actual work. *See* COMPENDIUM (THIRD) at § 310.8.

Thus, we find that the level of creative authorship involved in the Works’ color arrangements is, at best, *de minimis*, and too trivial to enable copyright registration. *See id.* § 313.4(B).

#### IV. CONCLUSION

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

BY:



Chris Weston  
Copyright Office Review Board

# **APPENDIX A**

