



United States Copyright Office

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July 19, 2016

Richard D. Harris
Greenberg Traurig, LLP
777 West Wacker Drive, Suite 3100
Chicago, IL 60601

**Re: Second Request for Reconsideration for Refusal to Register Zig Zag Chandelier;
Correspondence ID: I-126JVZH**

Dear Mr. Harris:

The Review Board of the United States Copyright Office (“Board”) has considered Halo Trademarks Limited’s (“Halo’s”) second request for reconsideration of the Registration Program’s refusal to register a three-dimensional sculpture claim¹ in a work titled Zig Zag Chandelier (“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 WORKS

The Work is a crystal chandelier comprised of a metal shade consisting of diamond cutouts in the center rows and half-triangle cutouts on the top and bottom rows. A crystal ball is suspended in the center of each diamond cutout. The inside of the light fixture contains a metal rod with six spokes attached to the top of the light fixture, and light bulbs attached to metal disks running down the center of the metal rod. Photographic reproductions of the Work are included below.



¹ Though the claim on the original application was in “photograph(s), 2-D artwork,” Halo asked the Office to amend the registration application so that the claim read “3-Dimensional Sculpture” instead. Email from Richard Harris, Greenberg Traurig, LLP, to Ivan Proctor, Registration Specialist (Sept. 17, 2014).



II. ADMINISTRATIVE RECORD

On July 23, 2014, Halo filed an application to register a copyright claim in the Work. In an October 29, 2014, letter, a Copyright Office registration specialist refused to register the claim, finding that “the work is a ‘useful article’ which does not contain any separable features that are copyrightable.” Letter from Ivan Proctor, Registration Specialist, to Richard D. Harris, Greenberg Traurig, LLP (Oct. 29, 2014).

In a letter dated January 28, 2015, Halo requested that the Office reconsider its initial refusal to register the Work. Letter from Richard D. Harris, Greenberg Traurig, LLP, to U.S. Copyright Office (Jan. 28, 2015) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and concluded that the Work “is a useful article that does not contain any separable features.” Letter from Stephanie Mason, Attorney-Advisor, to Richard D. Harris, Greenberg Traurig, LLP (Apr. 16, 2015).

In a letter dated April 16, 2015, Halo requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. Richard D. Harris, Greenberg Traurig, LLP, to U.S. Copyright Office (July 10, 2015) (“Second Request”). In that letter, Halo asserted, *inter alia*, that the Office’s test for conceptual separability is “unnecessarily rigid” and should have a way to distinguish between the unprotectable “utilitarian aspects of an article” compared to “the article itself.” Second Request at 2-3, 10. Halo asserted that if a useful article is “aesthetically pleasing in appearance [it is] “subject to copyright protection with respect to its form.” Second Request at 15 (citing *Nimmer* § 2.08[B][3]).

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 under 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 “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 U.S. COPYRIGHT OFFICE, 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); see also *Mazer v. Stein*, 347 U.S. 201 (1954) (sculpture of Balinese dancer eligible for copyright protection even though intended for use as lamp base); *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (pencil sharpener casing 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 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.*; see also H.R. REP. NO. 94-1476, at 55 (1976), reprinted in U.S.C.C.A.N. 1976 at 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 functional 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). Thus, the fact that a work required effort to create, or has commercial or aesthetic appeal, does not necessarily mean that the work 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 not contain the requisite separable authorship necessary to sustain a claim to copyright.

It is undisputed that the Work, a crystal chandelier, is a useful article. As explained above, 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. While Halo does not argue the decorative aspects of the Work are physically separable, it does assert that the Work contains "original, conceptually separable, creatively authored, ornamental features which meet the qualifications for copyright protection." Second Request at 1-2. Halo's Second Request makes two main arguments: first, that the Copyright Office applies an incorrect test for conceptual separability, and second, that the Work should be registered even under the Office's test. Second Request at 2. The Board considers each of these arguments in turn.

As explained above, the Copyright Office applies an established test for conceptual separability to determine whether a work contains pictorial, graphic, or sculptural features that can be visualized as a work of authorship that is separate and independent from the utilitarian aspects of the article and the overall shape of the article. *See* COMPENDIUM (THIRD) § 924.2(B). Halo seeks to have the Office instead apply a test that is more "flexible" in order to accommodate the registration of useful articles that have "aesthetically pleasing" forms. Second Request at 4, 6 (citing *Nimmer* § 2.08[B][3]). More specifically, Halo suggests that the test adopted by the Seventh Circuit, which analyzes "whether the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences," is preferable to the Office's test. *See id.* at 19-20 (citing *Pivot Point v. Charlene Products*, 372 F.3d 913, 931 (7th Cir. 2004)).

The Board declines Halo's request for the Board to apply an alternative test for conceptual separability to this Work. The Supreme Court has indicated that judicial deference to the Copyright Office's interpretation and application of the Copyright Act is appropriate, *see Mazer*, 347 U.S. at 213, and multiple circuits have accorded deference to the Office with respect to the manner in which it distinguishes between the ornamental and utilitarian aspects of useful articles for purposes of registration. *See, e.g., Inhale*, 755 F.3d at 1042 (in rejecting copyrightability of hookah vessel, explaining that "[b]ecause the Copyright Office's reasoning is persuasive, we adopt it for this case"); *Custom Chrome*, 35 U.S.P.Q.2d 1714 (finding that Office's tests for physical and conceptual separability are "a reasonable construction of the copyright statute[]"); *Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (affording deference to decision to deny registration for wheel covers in light of the Office's "expertise in the interpretation of the law and its

application to the facts presented by the copyright application”); *Esquire*, 591 F. 2d at 801 (agreeing with Office’s decision to refuse copyright registration for the overall shape of outdoor lighting fixtures and finding that “[c]onsiderable weight is to be given to an agency’s interpretation of its regulations”).² While the Board is aware that some circuits apply alternate tests, nothing in Halo’s Second Request persuades the Board that it would be appropriate to afford Halo special treatment by applying an alternate test when evaluating the Work.

Accordingly, the Board examines the Work in light of the test set forth in the *Compendium*. See COMPENDIUM (THIRD) § 924.2(B). Halo asserts that “neither the outer metallic frame, nor the series of glass spheres serves any utilitarian function—nor do those features enhance the chandelier’s functionality as a chandelier.” Second Request at 23. The Board disagrees. Without the metallic frame and the crystal balls, the Work would cease being a chandelier; instead, it would just be a metal rod with light bulbs and metal spokes attached to it. In other words, one cannot “imagine[] [the metallic frame and the crystal balls of the Work] separately and independently from the [useful article, *i.e.*, chandelier] without destroying the basic shape of th[e] [chandelier].” COMPENDIUM (THIRD) § 924.2(B). Where the aspects of a useful article comprise the useful article itself, copyright protection is not available, “no matter how aesthetically pleasing that shape or configuration might be.” *Esquire*, 591 F. 2d at 800.

Finally, even if the metallic frame and crystal balls were conceptually separable, the Board finds that they would lack sufficient originality to merit copyright protection. A black metal frame comprised of rows of uniform diamond cutouts, combined with crystal balls arranged in ordinary rows, is a predictable pattern of common geometric shapes such that the resulting design does not “trigger copyright.” See *Feist*, 499 U.S. at 358; see also COMPENDIUM (THIRD) § 906.1 (“Generally, the U.S. Copyright Office will not register a work that merely consists of common geometric shapes unless the author’s use of those shapes results in a work that, as a whole, is sufficiently creative.”).

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.

BY: 

Regan Smith
Copyright Office Review Board

² Halo argues that *Esquire*, which issued in 1978, is not relevant because the work at-issue was not evaluated under the 1976 Copyright Act. The Board, however, finds that the holding of *Esquire* remains relevant, not least because the Court noted explicitly that the Copyright Office’s test for conceptual separability “finds further support” under the 1976 Act. *Esquire*, 591 F. 2d at 803-04.