



**United States Copyright Office**

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June 30, 2016

Robert M. Wasnofski, Jr.  
Dorsey & Whitney LLP  
51 West 52nd St.  
New York, New York 10019-6119

**Re: Second Request for Reconsideration for Refusal to Register Senta;  
Correspondence ID: 1-V3XJR0**

Dear Mr. Wasnofski:

The Review Board of the United States Copyright Office (“Board”) has considered Jaguar Land Rover Limited’s (“Jaguar Land Rover”) second request for reconsideration of the Registration Program’s refusals to register a copyright claim in the work titled “Senta” (“Work”). After reviewing the application, the deposit copy, and the relevant correspondence in the case, along with the arguments set forth in the second request for reconsideration, the Board affirms the Registration Program’s denial of registration.

**I. DESCRIPTION OF THE WORK**

Senta is the outer “cosmetic face” of a wheel, that is, a wheel cover visible when the wheel is mounted on a car. Senta’s design as deposited consists of the following elements: ten contoured spokes, forming five rounded “V” shapes that connect from the work’s outer rim to center, fourteen bolts or screws distributed unevenly around the outer rim between the five “V” shapes, and five bolts distributed evenly around the hub. The Work also includes a stylized illustration of a jaguar’s face and the word “JAGUAR” in the center hub.

A photographic reproduction of the Work is set forth below.<sup>1</sup>



## II. ADMINISTRATIVE RECORD

On March 7, 2013, Jaguar Land Rover filed an application to register a claim to copyright in the Work as “sculpture.” In a letter dated April 15, 2014, a Copyright Office registration specialist refused to register the Work, finding that “it is a ‘useful article’ which does not contain any separable features that are copyrightable.” See Letter from Kathryn Sukites, Registration Specialist, to Robert Wasnofski, Jr., Dorsey & Whitney LLP 1 (Apr. 15, 2014) (emphasis in original).

In a letter dated July 10, 2014, Jaguar Land Rover requested that the Office reconsider its initial refusal to register the Work. See Letter from Robert M. Wasnofski, Jr., Dorsey & Whitney LLP, to U.S. Copyright Office (July 10, 2014) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office reevaluated the claims and 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 Robert Wasnofski, Jr., Dorsey & Whitney 1 (Nov. 6, 2014).

In a letter dated February 6, 2015, Jaguar Land Rover requested that, pursuant to 37 C.F.R. § 202.5(c), the Office again reconsider its refusal to register the Works. Letter from Robert M. Wasnofski, Jr., Dorsey & Whitney LLP, to U.S. Copyright Office (Feb. 6, 2015) (“Second Request”). In its Second Request, Jaguar Land Rover did not dispute the Office’s

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<sup>1</sup> The illustration of the Work enclosed with Jaguar Land Rover’s first request for reconsideration, which Jaguar Land Rover describes as the sculptural design for which it is seeking copyright registration, omits the five hub bolts, jaguar illustration, and word “JAGUAR.” Because the copy of a work that accompanies a registration application is the “material deposited” that the Copyright Office must examine to determine copyrightability, 17 U.S.C. § 410(a), the Review Board here analyzes the original deposit rather than the illustration accompanying Jaguar Land Rover’s request for reconsideration.

prior determination that the Work is a useful article. Jaguar Land Rover did, however, assert that the Work includes design features that are separable from the Work's utilitarian function. Jaguar Land Rover also disagreed with the Office's conclusion that those design features lack a sufficient amount of separable original authorship to qualify for copyright protection. *Id.* at 2. Specifically, Jaguar Land Rover argued that the "design elements of the 'cosmetic face' depict a high level of creativity and are copyrightable in light of the 'extremely low' threshold of creative authorship necessary to warrant copyright protection." *Id.*

### III. DISCUSSION

#### A. *The Legal Framework: 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 "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); *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 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 [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* 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 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.

### **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.

First of all, it is undisputed that a wheel cover is a useful article. *See, e.g., Norris Indus., Inc. v. Int'l Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (wheel cover determined to be a useful article). Thus, for there to be any consideration of the Work's design features, the features must be either physically or conceptually separable from the Work's utilitarian function as a vehicle wheel cover. *See id.* at 923; *Esquire, Inc.*, 591 F.2d at 800.

Jaguar Land Rover argues that the Work includes a “cosmetic face” that is “superfluous to and merely embellishes the basic shape of the wheel,” and that the “ornamental sculptural design that embellishes the basic wheel design is therefore conceptually separable” from the wheel itself. Second Request at 2. The Board disagrees.

Based on the deposit Jaguar Land Rover submitted with its copyright application, we are unable to distinguish the “ornamental sculptural design that embellishes the basic wheel design” from the wheel cover itself. Indeed, the deposit seems to demonstrate the opposite—a design that is so intertwined with the basic functioning of a standard vehicle wheel cover that it is impossible to imagine a way to physically or conceptually separate these elements from the wheel cover without destroying its basic shape or purpose. See COMPENDIUM (THIRD) § 924.2(B). As in *Norris Industries*, “the pattern resulting from the placement of spokes is an inseparable component of the wheel cover.” *Norris Indus., Inc.*, 696 F.2d at 923. To imagine the Work’s “ornamental sculptural design” features separately from the Work overall leaves little more than an outer rim and interior hub. As a result, the wheel cover and its “cosmetic face” cannot be pictured side by side “as fully realized, separate works—one an artistic work and the other a useful article.” COMPENDIUM (THIRD) § 924.2(B).

#### 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:



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Chris Weston  
Copyright Office Review Board