



United States Copyright Office

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September 27, 2016

Katherine H. Johnson
McAndrews, Held & Malloy, Ltd.
500 West Madison Street
34th Floor
Chicago IL 60661

Re: Second Request for Reconsideration for Refusal to Register B291 Dresser and B291 Bed, Correspondence ID: 1-FI54R8

Dear Ms. Johnson:

The Review Board of the United States Copyright Office (“Board”) has considered Ashley Furniture Industries, Inc.’s (“Ashley Furniture’s”) second request for reconsideration of the Registration Program’s refusal to register sculptural claims in the works titled “B291 Dresser” and “B291 Bed” (“Works”). After reviewing the applications, deposit copies, and relevant correspondence, along with arguments raised in the second request for reconsideration, the Board affirms the Registration Program’s denial of registration.

I. DESCRIPTION OF THE WORKS

The Works are pieces of furniture: a bed and a dresser. The Works are decorated with a quadrilateral ornamental dentil molding. A gloss and matte vine pattern is applied to the head- and footboards of the bed and two dresser drawers. Reproductions of the Works are set forth below.





II. ADMINISTRATIVE RECORD

On September 9, 2013, Ashley Furniture applied to register copyright claims in “sculptur[al] . . . authorship to the ornamental woodwork on the furniture in the photograph” for B291 Bed and B291 Dresser. The applications did not claim copyright in the two-dimensional leaf and vine pattern applied to the surface of the Works. In a September 23, 2013 letter, a Copyright Office registration specialist refused to register the works, finding “they lack the authorship necessary to support a copyright claim.” Letter from Adrienne Brown, Registration Specialist, to Tanvi Patel (Sept. 23, 2013).

In a letter dated December 20, 2013, Ashley Furniture requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Works. Letter from Katherine Johnson to U.S. Copyright Office (Dec. 20, 2013) (“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 sculptural elements of the Works either “are related to the utilitarian aspects or functions of the bed or dresser, or, if separable, there is no authorship that is both separable and copyrightable.” See Letter from Stephanie Mason, Attorney-Advisor, to Katherine Johnson (Mar. 31, 2014). The Office noted Ashley Furniture’s reference in the First Request to the “leaf and vine design that appears on some of the panels of each of these [W]orks” but stated that, because Ashley Furniture “made no claim in this feature” on its applications, the Office would only address the sculptural elements “for which registration was sought.” *Id.*

In a letter dated June 26, 2014, Ashley Furniture asked the Office to reconsider for a second time its refusal to register a copyright claim in the Works. Letter from Katherine Johnson to U.S. Copyright Office (June 26, 2014) (“Second Request”). Ashley Furniture argued that the Office improperly focused only on the dentil molding and denied consideration of the gloss and matte vine

pattern as part of the original claims as submitted, which it contended was both separable and copyrightable. Second Request at 2. Ashley Furniture further claimed that the selection and arrangement of the selectively placed gloss and matte vine pattern combined with the dentil molding and other constituent elements such as the gloss on the wood, the number and appearance of panels on the head- and footboards, and the panel divider between drawers represented a sufficient amount of creative authorship to warrant registration under the Copyright Act. *Id.* Ashley Furniture cited *Universal Furniture International, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010) for the proposition that furniture designs comprised of otherwise unprotectable elements may meet the originality threshold for copyright protection if the selection and arrangement of those elements satisfies the requisite level of creative authorship. *Id.* at 3. Finally, Ashley Furniture argued that the dentil molding alone is sufficient to support registration under the standard for originality set forth in *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.* 499 U.S. 340 (1991). *Id.* at 5-6.

III. DISCUSSION

A. *The Legal Framework*

1) *The Scope of a Copyright Claim*

When completing a registration application, the onus is on the applicant to clearly state the copyright claim. *See* COMPENDIUM (THIRD) §§ 618.1 (“To register a work of authorship the applicant must file an application that clearly identifies the copyrightable authorship that the applicant intends to register . . . [t]he information provided on the application defines the claim that is being registered.”); 618.4(A) (advising applicants to “identify the authorship that the applicant intends to register” when completing a registration application). Unless the information in the deposit or other application materials contradicts the copyright claim provided on an application, *e.g.*, a claim in authorship that does not appear to be present in the deposit, the Office will register a copyright claim only as it is written on the application by the applicant. *See id.*

In the case of visual art works, two-dimensional works and three-dimensional works are distinctly separate claims to copyright:

In the case of two-dimensional works, original authorship may be expressed in a variety of ways, such as the linear contours of a drawing, the design and brush strokes of a painting, the diverse fragments forming a collage, the pieces of colored stone arranged in a mosaic portrait, among other forms of pictorial or graphic expression. In the case of three-dimensional works . . . carving, cutting, molding, casting, shaping, or otherwise processing material into a three-dimensional work of sculpture.

COMPENDIUM (THIRD) § 905.

When applying to register a visual artwork, applicants have the option to select both two-dimensional artwork and sculpture by “checking one or more of the boxes . . . that accurately describe the authorship” claimed in the work. COMPENDIUM (THIRD) § 618.4(A). An applicant may also use the “Other” field to briefly state any authorship that is not covered by the boxes provided. *Id.*

2) *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.

3) *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. *See* COMPENDIUM (THIRD) § 906.1.

B. Analysis of the Work

After carefully examining the Works and applying the legal standards discussed above, the Board finds that the Works fail to satisfy the requirement of creative authorship necessary to sustain claims to copyright.

First, the Board affirms the Registration Program’s determination that because Ashley Furniture did not claim authorship in the two-dimensional artwork (*i.e.*, the leaf and vine pattern applied to the surface of the Works) on the applications, the copyrightability of the two-dimensional artwork elements cannot be analyzed on appeal. *See* COMPENDIUM (THIRD) §§ 618.1, 618.4(A). The original applications, which specifically claimed in “ornamental woodwork on the furniture,” made no claim of copyright in the two-dimensional applied leaf and vine pattern elements. Accordingly, as the ornamental woodwork elements are the only sculptural elements originally claimed and subsequently denied registration, they are the only elements at issue in this correspondence. Ashley Furniture is welcome to submit new registration applications for the claims in the two-dimensional gloss and matte leaf and vine pattern.

Setting aside these two-dimensional elements, the Board turns to the sculptural elements in the Works. Applying the standards above, the Board finds that some of these elements are conceptually separable, namely, the dentil molding, the dresser’s panel divider, and the vertical panel dividers on the head- and footboards. To the extent that Ashley Furniture claims that the panels of the head- and footboards should be considered, the Board disagrees, finding that the panels can be neither physically nor conceptually separated from the utilitarian aspects of the article and the overall shape of the article. *See* COMPENDIUM (THIRD) § 924.2. The Works nevertheless fail to meet the creativity threshold set forth in *Feist* because the quadrilateral dentil molding and panels dividers are comprised of a common geometric shapes, resulting in Works that lack sufficient creativity. *See Feist* at 359; *see also* COMPENDIUM (THIRD) § 906.1.

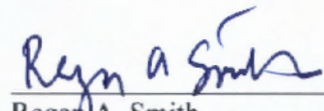
While the Board agrees in theory that a compilation of preexisting design elements could be copyrightable if the selection, coordination, and arrangement of the elements are sufficiently original, here, there is little evidence of inventive combination. *Cf. Universal Furniture*, 618 F.3d at 430-31; *see* Second Request at 3-4 (citing same). For example, *Universal Furniture*, cited by Ashley Furniture, concerned “highly ornate collections of furniture adorned with three-dimensional shells,

acanthus leaves, columns, finials, rosettes, and other carvings. *Id.* at 434. In contrast, the Works here are individual pieces of furniture (not applied-for as a collection) that place a minimal amount of basic, geometric molding in a predictable linear fashion. *See* COMPENDIUM (THIRD) §§ 906.1, 906.5 (addressing common geometric shapes and standard formatting). Accordingly, the Board concludes that the Works lack the requisite amount of creative authorship to warrant copyright registration.

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 A. Smith
Copyright Office Review Board