



United States Copyright Office

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June 30, 2016

Lew Hansen
Sheridan Ross PC
1560 Broadway, Suite 1200
Denver, CO 80202-5141

**Re: Second Request for Reconsideration for Refusal to Register Starburst
Volcano Pattern on Knife Handles and Fish Scale Pattern on Knife Handles;
Correspondence ID: 1-WIXZ81**

Dear Mr. Hansen:

The Review Board of the United States Copyright Office (“Board”) has examined Spyderco Inc.’s (“Spyderco’s”) second request for reconsideration of the Registration Program’s refusal to register a two-dimensional artwork claim in the the works titled “Starburst Volcano Pattern on Knife Handles” and “Fish Scale Pattern on Knife Handles” (separately, “Starburst Volcano Pattern” and “Fish Scale Pattern,” and collectively, “Works”). After reviewing the application, deposit copies, and relevant correspondence in this case, 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 claimed as 2-D artwork. The Starburst Volcano Pattern is a pattern on the black hard-plastic or silicone handle of a simple folding knife, consisting of rows of squares, each accented with circular indents, and radiating out from the center of the handle, approximately along elliptical radii. A Spyderco Endura logo is positioned in the center. The Fish Scale Pattern is also a pattern on the black hard-plastic or silicone handle of a simple folding knife, consisting of rows of overlapping half-circles or arcs. Each subsequent row is offset by half the diameter of the half-circles in the previous row. At approximately halfway down the length of the handle, where a “Clip-it Calypso Jr.” logo is placed, the half-circles switch direction, so that the rows project outward from the logo in both directions.

Photographic reproductions of the Works are set forth below:

Fish Scale Pattern on Knife Handles



Starburst Volcano Pattern on Knife Handles



II. ADMINISTRATIVE RECORD

On April 25, 2013, Spyderco filed applications to register copyright claims in the Works. In an August 4, 2014 letter, a Copyright Office registration specialist refused to register the claim, finding that “they are ‘useful articles’ which do not contain any separable authorship needed to sustain a claim to copyright.” Letter from Wilbur King, Registration Specialist, to Donna Gonzales, Sheridan Ross P.C. (Aug. 4, 2014).

In a letter dated September 8, 2014, Spyderco requested that the Office reconsider its initial refusal to register the Works. Letter from Donna P. Gonzales,

Sheridan Ross P.C., to U.S. Copyright Office (Sept. 8, 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 Donna Gonzales, Sheridan Ross P.C. (Dec. 9, 2014).

In a letter dated March 3, 2015, Spyderco 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 Lew Hansen, Sheridan Ross P.C., to U.S. Copyright Office (Mar. 3, 2015) (“Second Request”). In that letter, Spyderco continued to assert that the “Starburst Volcano Pattern” design “is sufficiently creative to merit copyright protection,” and that the “Fish Scale Pattern” design “exceeds the ‘extremely low’ level of creativity required for copyright protection.” *Id.* at 3-4.

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 “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.

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).

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. COMPENDIUM (THIRD) § 906.1.

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 a claim to copyright.

First, it is undisputed that the Works (patterns on knife handles) are components of useful articles. Thus, for there to be any considerations of the Works’ design features, the features must be either physically or conceptually separable from the Works’ utilitarian functions as knife handles. *See Norris Indus., Inc. v. Int’l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 2011); *see also Esquire, Inc.*, 591 F.2d at 800.

The Works clearly are not physically separable. Spyderco, however, argues that the Works are “conceptually separable from the shape of the useful articles and their utilitarian functions.” Second Request at 1. We agree. Still, for a work to be eligible for copyright protection, it must “possess more than a *de minimis* quantum of creativity.” *Feist*, 499 U.S. 340, 363. The Works do not meet this low threshold.

Spyderco correctly states that “geometric patterns, through original organization and presentation, may be copyrightable.” Second Request at 1. For the reasons set forth above, however, the Copyright Office will not register patterns of simple shapes unless the “author’s use of those shapes results in a work that, as a whole, is sufficiently creative.” COMPENDIUM (THIRD) § 906.1. The key inquiry is whether the shapes are “selected or combined in a distinctive manner indicating some ingenuity.” *Atari Games*, 888 F.2d at 883.

The Starburst Volcano Pattern consists of rows of squares accented with circular indents. Spyderco argues that these “elements are not merely placed in geometrically similar rectilinear rows” but “are arranged to create a series of arcs,” and that this “as a whole is the result of a number of creative choices, not the simple application of a geometric pattern.” Second Request at 2-3. The mere placement of simple shapes in an arc configuration, however, is a common design approach and does not render the

design sufficiently creative to be protectable under copyright. *See Feist*, 499 U.S. at 358 (noting that “not every selection, coordination, or arrangement will pass muster.”)

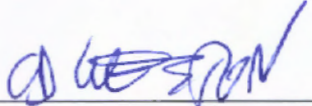
The Fish Scale Pattern consists merely of rows of repeating and overlapping half-circles or arcs, which change direction in the middle of the knife handle. These elements are not selected or combined in a sufficiently distinctive manner to merit protection. Any “‘stacking’ or ‘layering’ effect” is an inevitable consequence of the common repeating arrangement. The direction change creates only a trivial layer of variation.

In sum, the Board finds that the level of creative authorship involved in these Works is, at best, *de minimis*, and too trivial to enable copyright registration.

III. 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 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