United States Copyright Office
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April 25, 2016

Dorsey & Whitney LLP
Attn: Robert Wasnofski, Jr.
51 West 52nd Street
New York, NY 10019-6119

Re: Second Request for Reconsideration for Refusal to Register Stormer Style 2, Style 4 L320, Discovery 13MY, and L538 Vipers Nest, Correspondence ID: 1-KN5WUW

Dear Mr. Wasnofski:

The Review Board of the United States Copyright Office (the "Board") has examined Jaguar Land Rover Limited's ("Jaguar Land Rover's") second request for reconsideration of the Registration Program's refusals to register copyright claims in the works titled "Stormer Style 2," "Style 4 L320," "Discovery 13MY," and "L538 Vipers Nest" (the "Works"). After reviewing the application, the deposit copy, and the relevant correspondence in the cases, 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 WORKS

Stormer Style 2 is a three-dimensional wheel cover (or hubcap or "rim") design that consists of the following elements: a "hub" where the Work can be connected to a vehicle using five bolts, and nine spokes that connect the Work's outer rim to the "hub." Each spoke has a rectangle-shaped groove carved into it.

Style 4 L320 is a three-dimensional wheel cover (or hubcap or "rim") design that consists of the following elements: a "hub" where the Work can be connected to a vehicle using five bolts; five "V" shaped spokes that connect the Work's outer rim to the "hub;" and five straight, thin spokes that also connect the Work's outer rim to the "hub." The five straight, thin spokes are located in the center of the "V" shaped spokes.

Discovery 13MY is a three-dimensional wheel cover (or hubcap or "rim") design that consists of the following elements: a "hub" where the Work can be connected to a vehicle using five bolts, and seven wedge-shaped spokes that connect the Work's outer rim to the "hub." Each spoke has a "J"-shaped groove carved into it.

L538 Vipers Nest is a three-dimensional wheel cover (or hubcap or "rim") design that consists of the following elements: a "hub" where the Work can be connected to a vehicle using five bolts, and five "U"-shaped spokes that connect from the Work's outer rim to the "hub."

Photographic reproductions of the Works are included as Appendix A.

II. ADMINISTRATIVE RECORD

On March 7, 2013, Jaguar Land Rover filed four applications to register copyright claims in three-dimensional works titled "Stormer Style 2," "Style 4 L320," "Discovery 13MY," and "L538 Vipers Nest." In each application Jaguar Land Rover asserted a claim to copyright in "sculpture."

In a letter dated August 13, 2013, a Copyright Office registration specialist refused to register the Works, finding them to be "'useful articles' which do not contain any separable authorship needed to sustain a claim to copyright." *See* Letter from Rebecca Barker, Registration Specialist, to Robert Wasnofski, Jr., Dorsey & Whitney LLP (Aug. 13, 2013). The letter stated that the Works do not possess sufficient separable creative authorship within the meaning of the copyright statute and settled case law to support claims to copyright. *Id.*

In a letter dated November 13, 2013, Jaguar Land Rover requested that the Office reconsider its initial refusal to register the Works. *See* Letter from Robert Wasnofski, Jr., Dorsey & Whitney LLP, to U.S. Copyright Office (Nov. 13, 2013) ("First Request"). After reviewing the Works in light of the points raised in the First Request, the Office reevaluated the claims and in a letter dated February 26, 2014, again concluded that the Works "are useful articles that do not contain any authorship that is both separable and copyrightable." *See* Letter from Stephanie Mason, Attorney-Advisor, to Robert Wasnofski, Jr., Dorsey & Whitney LLP (Feb. 26, 2014).

In a letter dated May 27, 2014, Jaguar Land Rover requested that, pursuant to 37 C.F.R. § 202.5(c), the Office again reconsider its refusal to register the Works. *See* Letter from Robert Wasnofski, Jr., Dorsey & Whitney LLP, to U.S. Copyright Office (May 27, 2014) ("Second Request"). In its Second Request, Jaguar Land Rover did not dispute the Office's prior determination that the Works are useful articles. Jaguar Land Rover did, however, assert that the Works include design features that are separable from the Works' utilitarian functions. Jaguar Land Rover 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 "cosmetic face" that appears on the outermost portion of the four wheel covers at issue (not the wheel covers themselves) possesses a sufficient amount of creative authorship to warrant registration under the Copyright Act. *Id.* at 3. Finally, Jaguar Land Rover asserts that each Work's overall "ornamental design" would be eligible for registration if embodied in "a free standing sculptural work of wall art or simply on paper." *Id.*

III. DECISION

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. However, 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 designs'] 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, 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. COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2 (3d ed. 2014) ("COMPENDIUM (THIRD)"); *see also Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 739 F.3d 446, 449 (9th Cir. 2014) (finding that the Office's interpretation of conceptual separability is entitled to deference, while noting that "[c]ourts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function"); *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 while leaving the utilitarian aspects of the article completely intact. *See* COMPENDIUM (THIRD) § 924.2(A); *see also Mazer v. Stein*, 347 U.S. 201 (1954) (finding a sculptured lamp base depicting a Balinese dancer was physically separable from the article's utilitarian function); *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (1966) (finding a pencil sharpener 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 capable of being imagined separately and independently from the work's utilitarian aspects without destroying the work's basic shape. 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 separate, fully realized works – one an artistic work and the other a useful article. 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* COMPENDIUM (THIRD) § 924.2(B); *see also* H.R. REP. NO. 94-1476 (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 the Copyright Act does not cover any aspect of a useful article that cannot be separated from its functional elements. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668-69. 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 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 nonexistent." *Id.* at 359.

The Office's regulations implement the longstanding requirements of originality and creativity in the law, as affirmed by the *Feist* decision. *See* 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"); 37 C.F.R. § 202.10(a) (stating "[i]n order 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. However, 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 Ninth Circuit rejected a claim of copyright in a piece of jewelry where the manner in which the parties selected and arranged the work's component parts was more inevitable than creative and original. *See Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). Likewise, the Ninth Circuit held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors,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) (emphasis in original).

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. They are not influenced by 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 its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *Bleistein v. Donaldson*, 188 U.S. 239 (1903). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not necessarily mean that the work, as a whole, constitutes a copyrightable work of art.

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 the claims to copyright.

Here, it is undisputed that the Works (wheel covers or hubcaps or "rims") are useful articles. Thus, for there to be any consideration of the Works' design features, the features must be either physically or conceptually separable from the Works' utilitarian function as vehicle wheel covers. *See Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 2011); *see also Esquire*, 591 F.2d at 800.

Jaguar Land Rover argues that each of the Works includes a "cosmetic face" that is "conceptually separate from the wheel itself" and contains separable "ornamental design features" that are merely "superimposed over the basic shape" of a wheel cover. Second Request at 1. The Board disagrees. Based on the deposits Jaguar Land Rover submitted with its copyright applications, we are unable to distinguish the "ornamental design" that is allegedly "superimposed over the basic shape" of the wheel covers from the wheel covers themselves. Indeed, the deposits seem to demonstrate the opposite—designs that are 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 such elements from the wheel covers without destroying their basic function. *Cf Mazer v. Stein*, 347 U.S. 201 (1954). In other words, imagining the Works' "ornamental design" features separately from the Works overall leaves the examiner with little more than outer rims and interior bolt hubs. As a result, the "cosmetic face" of each wheel cover and wheel cover itself cannot 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). Thus, in the Board's view, any attempt at separability destroys the Works' intended purpose as functional wheel covers.

Additionally, the suggestion that a work contains design features that could be characterized as conceptually similar to various forms of free-standing sculpture does not negate its intrinsic utilitarian function. *See Esquire*, 591 F.2d at 800; *see also Norris Indus.*, 696 F.2d at 923-24. Merely analogizing the general shape of a useful article to a work of modern sculpture or an abstract sculpture does not satisfy the conceptual separability test, because it does not provide an objective basis for visualizing the artistic features and the useful article as separate and independent works. COMPENDIUM (THIRD) § 924.2(B). Thus, despite Jaguar Land Rover's claim that each Works' "ornamental design" would be eligible for registration had it been embodied in "a free standing sculptural work of wall art or simply on paper," the fact remains that the design features, as they appear in the deposits included with Jaguar Land Rover's registration applications, are embodied within useful articles.

III. CONCLUSION

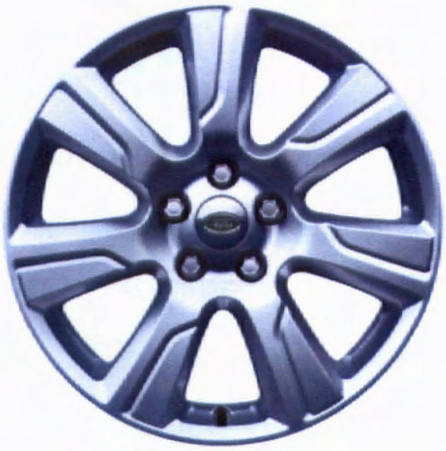
For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claim in the Works. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.

BY: _____
Chris Weston
Copyright Office Review Board Member

APPENDIX A

Stormer Style 2

Discovery 13MY



Style 4 L320

L538 Vipers Nest