



Copyright Review Board
United States Copyright Office · 101 Independence Avenue SE · Washington, DC 20559-6000

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Re: Second Request for Reconsideration for Refusal to Register Filter Funnel (SR 1-7786584619) and Plier Pro (SR 1-7648505741) (Correspondence ID: 1-3X5PEX1)

Dear Mr. Walters:

The Review Board of the United States Copyright Office (“Board”) has considered Ernst Manufacturing’s (“Ernst’s”) second request for reconsideration of the Registration Program’s refusal to register sculptural claims in the works titled “Filter Funnel” and “Plier Pro” (“Works”). After reviewing the applications, deposit copies, 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 Works are three-dimensional sculptural works submitted for registration in two separate applications. Filter Funnel is an orange funnel with a broad, U-shaped body that narrows into a spout. Plier Pro is a black and red device used for sorting, separating, and storing tools. The Works are as follows:

Filter Funnel



Plier Pro



II. ADMINISTRATIVE RECORD

On June 13, 2019, Ernst filed applications to register copyright claims in the Works. In a June 14, 2019 letter, a Copyright Office registration specialist refused to register the claim, finding that “they are useful articles [that] do not contain any non-useful design element that could be copyrighted and registered.” Initial Letter Refusing Registration from U.S. Copyright Office to James Walters (June 14, 2019).

In a letter dated September 12, 2019, Ernst requested that the Office reconsider its initial refusal to register the Works. Letter from James H. Walters to U.S. Copyright Office (Sept. 12, 2019) (“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 are “useful article[s] that does not contain any separable features.” Refusal of First Request for Reconsideration from U.S. Copyright Office to James Walters (Feb. 11, 2020) (“Refusal of First Request”).

In a letter dated May 11, 2020, Ernst 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 James H. Walters to U.S. Copyright Office (May 11, 2020) (“Second Request”). In that letter, Ernst addressed each Work separately, but asserted the same argument for both Works, specifically that “the curvature, the spacing of elements, the lengths, [and] the angles” are all separable design features. Second Request at 2. Ernst further suggests that the Works are sculptural works “standing on their own” because “if painted on a canvas” or “encased in clear plastic” they would qualify for protection. *Id.*

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separability*

Copyright does not protect useful articles as such, which are defined in the Copyright Act 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. Importantly, however, artistic features applied on or incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works under sections 101 and 102(a)(5) of the Copyright Act. This protection is limited to the “‘pictorial, graphic, or sculptural features’ [that] ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’” *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (quoting 17 U.S.C. § 101).

To assess whether an artistic feature incorporated into the design of a useful article is protected by copyright, the Office examines whether the feature “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” *Id.* at 1007; *see also* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES

§ 924 (3d ed. 2021) (“COMPENDIUM (THIRD)”). This analysis focuses on “the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction [because the] statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature.” *Star Athletica*, 137 S. Ct. at 1013. Put another way, while useful articles as such are not copyrightable, if an artistic feature “would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article.” *Star Athletica*, 137 S. Ct. at 1011; 17 U.S.C. § 113(a) (“[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.”); *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”).

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. *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 careful examination and application of 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.

Here, both Works—a funnel and sorting device—are useful articles. The question is thus whether there is any separable original authorship. In *Star Athletica*, the Supreme Court held that such an analysis requires consideration of whether there are features that “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” *Star Athletica*, 137 S. Ct. at 1007.

Under the first prong, the Board finds that both Works lack separable features entitled to copyright protection. The features Ernst claims are separable are themselves articles that are “normally part of a useful article,” *Star Athletica*, 137 S. Ct. at 1010, or are dictated by functional design considerations not protected by copyright. *See* 17 U.S.C. § 101 (providing copyright protection for “the design of a useful article . . . only if, and only to the extent that,

such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article”); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 35 (1st Cir. 2001) (noting copyright protection does not extend to “an essentially functional design choice” of a useful article); *Bassett v. Jensen*, 459 F.Supp. 3d 293, 304-05 (D. Mass. 2020) (finding slipcovers and pillows not copyrightable because “their shapes were chosen for the functional purpose of covering items of furniture . . . not designed by Bassett”). Ernst suggests that “the curvature, the spacing of elements, the lengths, [and] the angles” are all “aesthetic features that can be imaginatively separated from the useful articles.” Second Request at 2. These features, however, are not merely artistic features of the Works. Rather, the curvatures, spacing, lengths, and angles of the Works are useful features, dictated and constrained by the functional purpose of the articles. The Filter Funnel’s shapes, curvatures, lengths, and angles allow it to fit in place around a motorcycle filter and guide fluid into a single point for draining and refilling liquid.¹ The Plier Pro’s spacing, shapes, angles, and lengths serve as the functional dividers that are normally part of divider or storage systems. Because of the elements’ clear utilitarian functions, the Board concludes that they lack “the capacity to exist apart from the utilitarian aspects” of the Works “on [their] own.” *Star Athletica*, 137 S. Ct. at 1010.

Ernst contends that “the shapes of the applicant’s articles” are separable and “if . . . painted on a canvas, [the Works] would surely qualify for protection” or if “encased in clear plastic, they would be sculptural works.” Second Request at 2. Under Ernst’s analysis, every three-dimensional design would be perceived as separable and thus copyrightable if original. This position misapplies *Star Athletica* and is counter to Congress’ intent to provide copyright protection “for original works of art, but not for industrial design.” *Star Athletica*, 137 S. Ct. at 1007. Features of a useful article are not separable where imaginatively removing those features merely “replicates” the useful article. *See id.* at 1012 (noting that the image on the cover of a guitar is protected even if it resembles the shape of the guitar because the imaginatively removed image “does not ‘replicate’ the guitar as a useful article”); *Lanard Toys, Ltd. v. Toys “R” US-Delaware, Inc.*, 2019 U.S. Dist. LEXIS 46911, *73 (M.D. Fla. 2019) (finding a chalk pencil not copyrightable because “the pencil design does not merely encase or disguise the chalk holder, it is the chalk holder. When one imagines the pencil design as a separate work of sculptural art, one is merely picturing a replica of the chalk holder.”), *aff’d sub nom. Lanard Toys, Ltd. v. Dolgencorp LLC*, 958 F.3d 1337 (Fed. Cir. 2020). Here, imagining the “shapes” of the Works in another medium merely replicates the Works themselves. Moreover, the fact that a painting of a useful article may qualify for protection has no bearing on whether the Work itself is copyrightable. *Star Athletica*, 137 S. Ct. at 1010 (“Although the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.”).

Second, even if the features could exist as separable pictorial, graphic, or sculptural designs, they lack sufficient creativity for protection. For a work to be eligible for copyright protection, it must “possess more than a *de minimis* quantum of creativity.” *Feist*, 499 U.S. at 363. The curvatures, spacing, lengths, and angles of the Works are not sufficiently creative to

¹ 960 *Greg’s Oil Filter Funnel*, ERNST MANUFACTURING, <https://www.ernstmfg.com/Gregs-Oil-Filter-Funnel.aspx> (last visited Mar. 22, 2021) (“This superior U-shaped design fits the Harley like no other funnel can. This multipurpose funnel is also great for refilling fluids! Fits perfect in tight places for refilling your oil, transmission, and primary fluids.”).

meet this low threshold. U.S. copyright law does not protect common geometric shapes, such as straight or curved lines, squares, rectangles, and cubes. *See* 37 C.F.R. 202.1(a) (prohibiting registration of “familiar symbols or designs”); COMPENDIUM (THIRD) § 906.1 (common geometric shapes such as “straight or curved lines . . . cones, squares, [and] trapezoids” are not protected by the Copyright Act). While copyright can protect the combination of unprotectable elements like simple shapes, that is the case only if the elements “are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.” *Satava*, 323 F.3d at 811. These Works lack such creative expression; instead, they consist of simple, predictable combinations of a few elements. The Filter Funnel has straight and curved lines, many of which are symmetrical while others are consistent with the shape of a funnel. The Plier Pro has a predictable pattern of identical, evenly spaced and symmetrical panels. Both Works merely bring together a few standard forms or shapes with minor special variations and are thus insufficiently creative. *See* COMPENDIUM (THIRD) § 313.4(j); *see also Past Pluto Prods. Corp. v. Dana*, 627 F. Supp. 1435, 1441 (S.D.N.Y. 1986) (reviewing a novelty crown design with spikes that were “uniform in shape and size” and declining to find “artistic originality in a design feature composed of elemental symmetry and prompted most probably by the promise of convenience in manufacture”).

Lastly, Ernst claims that the Office misapplied *Star Athletica* “by focusing on what remains after the imagined extraction.” Second Request at 7. Ernst is correct that the “separability inquiry focuses on the extracted feature and not on any aspects of the useful article remaining after imaginary extraction.” *Star Athletica*, 137 S. Ct. at 1006. But while the imagined remainder does not need to be a “fully functioning useful article,” some aspect of the useful article must remain after extraction. *See id.* If nothing remains after the features are imaginatively removed, those removed features are the useful article itself, and a useful article is not copyrightable. COMPENDIUM (THIRD) § 924.39(F); *see Progressive Lighting, Inc. v. Lowe's Home Ctrs., Inc.*, 549 F. App'x 913, 921 (11th Cir. 2013) (“an entire useful article cannot receive copyright protection, no matter how many superfluous, aesthetic individual components it has”). That is the case here.

IV. CONCLUSION

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



U.S. Copyright Office Review Board

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