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**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

PROLINE CONCRETE TOOLS, INC., a  
California corporation,

Plaintiff,

vs.

GORD DENNIS, an individual,  
CADILLAC CONCRETE PRODUCTS,  
LTD., an unknown business form located  
in British Columbia, Canada, CREATIVE  
URETHANE CONCEPTS, INC., a South  
Carolina Corporation, UNIVERSAL  
BUILDING PRODUCTS, INC., an Illinois  
Corporation, LEGACY DECORATIVE  
CONCRETE SYSTEMS , INC., an Illinois  
Corporation, SOLOMON COLORS, INC.,  
an Illinois Corporation, and DOES 1  
through 20, inclusive,

Defendants.

CASE NO. 07cv2310-LAB (AJB)

**ORDER GRANTING MOTION TO  
COMPEL REGISTRATION OF  
COPYRIGHT CLAIMS**

Proline Concrete Tools has filed a motion for the Court to compel registration of its  
copyright claims after the Copyright Office Register refused to register them.

The works Proline seeks to copyright are rock and stone sculptures that are used  
to make decorative concrete stamps. They are called Appian Cobble Stone "A", Appian  
Cobble Stone "B", Castle Stone, Grand Sandstone Groutable, and Random Garden

1 Stone. The process is straightforward: “Plaintiff makes a mold of each sculpture. The  
2 mold serves as a die for the purpose of impressing the three dimensional design of the  
3 sculpture into large expanses of wet concrete.” (Doc. No. 88 at 2). To be clear, Proline  
4 seeks to copyright only the original sculptures, not the decorative stamps that are made  
5 from them.

#### 6 **I. Legal Background**

7 Proline asserts that the Court must review the Register’s rejection of its copyright  
8 claims *de novo*. It relies on *Atari Games Corp. v. Oman*, 888 F.2d 878, 887 (D.C. Cir.  
9 1989). The Court disagrees with Proline’s reliance on *Atari*, however.

10 There are two ways for a party to challenge the Register’s decision to deny a  
11 copyright claim. The first way is to file an infringement action under the Copyright Act  
12 and ask for judicial review of the Register’s decision as part of that action. See 17 U.S.C.  
13 § 411(a); *Darden v. Peters*, 488 F.3d 277, 285 (4th Cir. 2007). The Register must be  
14 served with a copy of the complaint, and the Register can opt to become a party to the  
15 action with respect to the issue of registrability by entering an appearance within 60 days  
16 of service. This is what Proline has done in this case, although the Register has opted  
17 not to join.

18 Alternatively, a party can challenge the Register’s decision under the  
19 Administrative Procedure Act. 17 U.S.C. § 701(e). *Atari* was an Administrative  
20 Procedures Act case, and did not address the standard of review in infringement actions.  
21 *Paul Morelli Design, Inc. v. Tiffany And Co.*, 200 F. Supp. 2d 482, 485 n.3 (E.D. Pa.  
22 2002). Thus, the standard of review in *Atari* isn’t applicable here.

23 The Ninth Circuit has spoken, however, on the standard of review applicable in  
24 infringement action like this one. See *Batjac Productions. v. GoodTimes Home Video*  
25 *Corp.*, 160 F.3d 1223, 1230 (9<sup>th</sup> Cir. 1998). *Batjac* involved the Register’s determination  
26 that once a movie passes into the public domain the underlying screenplay passes into  
27 the public domain, too. *Id.* at 1225-26. The Ninth Circuit recognized that the Register  
28 “has the authority to interpret the copyright laws and its interpretations are entitled to

1 judicial deference if reasonable.” *Id.* at 1223 (citing *Marascalco v. Fantasy, Inc.*, 953 F.2d  
2 469, 483 (9<sup>th</sup> Cir. 1991)). While *Batjac* is not identical to this case (the Register actually  
3 appeared to defend its rejection), the Court will follow its standard of review and ask  
4 whether the Register’s rejection of Proline’s copyright claims was reasonable. See  
5 *Zhang v. Heineken N.V.*, 2010 WL 4457460 at \*6 (C.D. Cal. 2010) (citing *Batjac* and  
6 deferring to Register’s decision if reasonable); *Paul Morelli Design*, 200 F. Supp. 2d, at  
7 485 (same).

## 8 **II. Analysis**

9 Copyright protection is granted to “original works of authorship fixed in any tangible  
10 medium of expression, now known or later developed, from which they can be perceived,  
11 reproduced, or otherwise communicated, either directly or with the aid of machine or  
12 device.” 17 U.S.C. § 102(a). Among the works of authorship that can be protected are  
13 those that are “pictorial, graphic, and sculptural.” 17 U.S.C. § 102(a)(5). The works  
14 Proline wishes to copyright are sculptural.

15 The Register denied Proline’s copyright claims on two different bases. Each basis  
16 is individually sufficient to reject the claims, and the Court will address them individually.

### 17 **A. Slavish Copies**

18 The first basis for denial of registration by the Register was that Proline’s works  
19 are “slavish copies of un-copyrightable objects and, as such, do not contain a sufficient  
20 amount of original authorship to support copyright claims.” (Doc. No. 88-4 at 2.) The  
21 Register opined that the works are slavish copies because they just replicate natural  
22 stones and their features:

23 [T]hese works have been created by molding actual stones  
24 and this process conveys cut marks, defects and other  
25 qualities appearing on natural stone. This process is a slavish  
26 reproduction to duplicate the appearance of natural stone and  
27 slavish reproductions are not subject to copyright because  
28 they lack the minimum amount of original artistic material to  
support copyright registrations. Also, the specific qualities  
appearing on natural stone, such as cut marks, defects and  
the like are merely un-copyrightable effects.

(Doc. No. 88-4 at 2).

1 In response, Proline clarifies that the process by which the sculptures are created  
2 does not involve the molding of actual stones. Contrary to the Register’s analysis, “the  
3 sculptures are not molds of existing stones or rocks. They are created from the artists  
4 interpretation of stones and rocks he has observed.” (Doc. No. 88 at 9).

5 The Court agrees. The sculptures are not slavish copies of natural stones but  
6 rather Proline’s original sculptures. This seems to be a clear misunderstanding on the  
7 part of the Register that confused its analysis and led it to conclude that the sculptures  
8 are slavish copies of natural objects. Its rejection of the copyright claims was therefore  
9 not reasonable, and is not entitled to deference.

#### 10 **B. Useful Articles**

11 The second basis for denial of registration by the Copyright Register was that  
12 Proline’s works are useful articles, which as a general rule cannot be copyrighted. (Doc.  
13 No. 88-4 at 2). A useful article is “an article having an intrinsic utilitarian function that is  
14 not merely to portray the appearance of the article or to convey information. An article  
15 that is normally a part of a useful article is considered a ‘useful article.’” 17 U.S.C. § 101.  
16 Clear examples of useful articles include automobiles, food processors, and television  
17 sets. See *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970, 973 (6<sup>th</sup> Cir.1983).<sup>1</sup>

18 After reviewing Proline’s sculptures and the process by which they are created, the  
19 Court finds they are not useful articles. Indeed, they have no intrinsic utilitarian function  
20 other than to “portray the appearance” of the sculptures. 17 U.S.C. § 102(a)(5). The fact  
21 that they are made to serve some utilitarian purpose doesn’t change that. A painting isn’t  
22 any less copyrightable, for example, just because it is used to cover a hole in the wall.

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24 <sup>1</sup> Useful articles *can* be given copyright protection if they “incorporate[ ] pictorial,  
25 graphic, or sculptural features that can be identified separately from, and are capable of  
26 existing independently of, the utilitarian aspects of the article.” (Doc 88-4 at 2, citing 17  
27 U.S.C. § 101). The Court doesn’t need to reach this issue, of course, if it finds the work at  
28 issue isn’t a useful article to begin with. See *Masquerade Novelty, Inc. v. Unique  
Industries, Inc.*, 912 F.2d 663, 670 (3<sup>rd</sup> Cir. 1990) (“If a sculptural work is not a ‘useful article’  
because its sole ‘utilitarian function... is ... to portray the appearance of the article,’ then it  
remains copyrightable ... and a court need not analyze whether its utilitarian function is  
separable from the work’s sculptural elements.”).

1 The Register's conclusion seems again to result from its confusion over how  
2 Proline creates the sculptures and what exactly it seeks to copyright. ("[A]nother basis for  
3 refusing these registrations is the *concrete stamps* are 'useful articles' which do not  
4 contain any separable authorship needed to sustain a claim to copyright.") (Doc 88-4 at 2  
5 (emphasis added).) Because of this misunderstanding, the Register wrongly concluded  
6 that the sculptures are useful articles. As a result, its rejection of the copyright claims on  
7 Useful Article grounds is not reasonable, and is not entitled to deference.

8 **III. Conclusion**

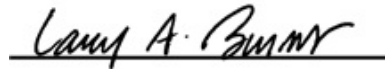
9 For the foregoing reasons, Proline's motion to compel registration of its copyright  
10 claims is **GRANTED**. The sculptures used to create the decorative concrete stamps are  
11 copyrightable.

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13 **IT IS SO ORDERED.**

14 DATED: July 13, 2012

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**HONORABLE LARRY ALAN BURNS**  
United States District Judge

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