COPYRIGHT
OFFICE

May 22, 1997

Dear Mr. Bello:

This is in response to your letter of July 18, 1996, requesting a second review or reconsideration of the Copyright Office refusal to register claims to copyright in five useful articles - dishes and garlic containers. Upon a careful examination of the works, and analysis of the arguments you have advanced in support of registrations, we regret that we have no alternative but to affirm the decision of the Examining Division rendered on first appeal.

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Administrative Record

On June 13, 1994, the claimant, Boston Warehouse Trading Corporation submitted five applications Form VA to register claims to copyright in "3-dimensional sculptures" titled: SALSA SALSA SERVER, SALSA TORTILLA WARMER, SALSA CHIP and DIP, JUMBO GARLIC CELLAR, and ORIGINAL GARLIC BAKER.

In a letter dated September 15, 1994, Examiner James L. Shapleigh examined the scope of copyrightability in a useful article and suggested only one registration for the "SALSAS" since they contain the same copyrightable authorship and were first published on the same date. The other two works - "the GARLICS" - were not considered to exhibit enough original and separable sculptural or design authorship and hence were rejected.

In a letter dated January 12, 1995, the applicant, through, you, its attorney, appealed the dispositions of its claims asserting: (1) the three "SALSAS" are entitled to separate copyright registrations as each sculpture has "its own creative design that is separate and distinct from the utilitarian aspects [of the works] (your letter of 1/12/95 at 1)."

With respect to the "Garlics", you maintained that rejection should be reconsidered because "each sculpture sought to be registered is an original artistic creation." Id. at 1.

In a letter dated March 22, 1996, Attorney Advisor, Dave Levy of the Visual Arts Section of the Examining Division underscored the issue of copyrightability of a useful article. Further, he stated that when the copyrightable authorship of multiple works is identical and the works are published on the same date, the Copyright Office can register only one of the works chosen by the applicant for registration. As for the "Garlics," registration was refused for both works as they were stated to lack "any separable artistic design."

In your above mentioned letter of July 18, 1996, you, as the applicant's attorney, disagree with the Attorney Advisor's conclusions and maintain: (1) that each Salsa represents "variation in copyrightable content that is separate and distinct from the other" and therefore warrants separate registration. But if applicant must choose one, you advised us that the applicant prefers a registration for the SALSA TORTILLA WARMER.

With respect to the "Garlics" you have apparently conceded to our rejection of GARLIC BAKER, but request a reconsideration of the rejection for the JUMBO GARLIC CELLAR, because its features - "[t]he particular shape of the handles, the placement of the holes and the design of the cover...- represent separable artistic designs that are copyrightable." We respectfully disagree for the following reasons.

The Copyright law protects pictorial, graphic, and sculptural works. 17 U.S.C. 102(a)(5). Such works include works of artistic craftsmanship insofar as their form, but not their mechanical or utilitarian aspects are concerned. Moreover, the design of a "useful article" is considered a pictorial, graphic or sculptural work "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." 17 U.S.C. 101 (1994). The legislative history confirms that this separability may be physical or conceptual. See H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976).

The Copyright Office implementation of the copyright statute, including the legislative history, is reflected in Compendium II of the Copyright Office Practices which states that the required conceptual separability is met when "artistic or sculptural features can be visualized as free-standing sculpture independent of the shape of the useful article, i.e., the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article." Sec. 505.03 (1984).

The holding in Esquire, Inc. v. Ringer, 591 F. 2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), although decided under the 1909 law, most clearly enunciated the rule which supports the Office's refusal to register the "GARLICS." Esquire held that the Copyright Office regulation properly prohibited copyright registration for the overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape or configuration may be. Id. at 800. In fact, Section 505.03 of Compendium II of Copyright Office Practices is a direct successor to the Copyright Office regulation which was affirmed in Esquire as an authoritative construction of the statute as explicitly stated in the legislative history. Id. at 802-03. The underlying rationale was followed in Custom Chrome, Inc. v. Ringer, 35 U.S.P.Q. 2d 1714, 1718 (D.D.C. 1995), where the court held that the Office's "conceptual separability test" as it is enunciated in Compendium II is consistent with the holding in Esquire, later cases decided under the present law, and the legislative history.

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The Office follows the holding enunciated in Esquire and later cases such as Carol Barnhart, Inc. v. Economy Cover Corp., 733 F. 2d 411 (2d Cir. 1985), that, despite an original and creative shape, the overall design or configuration of a utilitarian article may not be copyrighted if it is incapable of existing as a work of art physically or conceptually separable from and independent of the utilitarian object in which it is incorporated and where the overall design is inextricably intertwined with the functional purpose or use.

The Appeals Board concludes that the principles espoused in Esquire and later cases also apply to the garlic container in question. There is no clearly separable work of sculpture on which to base a copyright registration. Granted that when viewed as a whole, the elements - the handles, cover and the placement of the holes - portray a pleasant appearance of the containers. That appearance, however, cannot be identified separately from the intrinsic functional aspect of the food container. Neither the overall shape of the container nor the shape of any surface variations of the parts contain such authorship. There is no artwork that can be identified separately from the intrinsic functional purpose of the garlic container, i.e., to store and to use the garlic in the containers. Whatever artistic features there are, they are, again, inextricably intertwined and merged with the utilitarian features and with the overall shape and configuration of the container.

As we have previously stated, the SALSAS dishes do contain separable copyrightable authorship warranting, however, only a single copyright registration. Hence, and in accordance with your preference, we have registered the work titled, the SALSA TORTILLA WARMER.

For the reasons stated in this letter, we affirm the refusal to register the submitted claims in the garlic container and are closing the file in this case. This decision of the Board of Appeals constitutes final agency action in this matter.

Sincerely,

Nanette Petruzzelli

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