March 17, 2000

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Timothy J. Ziolkowski, Esq.
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111 East Wisconsin Avenue, Suite 2100
Milwaukee, WI 53202

Re: Rack Pack – Billiard Package Design
Control No.: 50-705-5288(W)

Dear Mr. Ziolkowski:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated May 20, 1999, on behalf of your client, Great Lakes Dart Manufacturing, Inc., in which you sought reconsideration of the Copyright Office's refusal to register a work entitled "Rack Pack-Billiard Package Design." The Copyright Office Board of Appeals affirms the Examining Division's refusal to register.

BACKGROUND

On September 29, 1998, the Copyright Office received a Form VA application for Applicant, Great Lakes Dart Manufacturing, Inc. Applicant's work is entitled "Rack Pack – Billiard Package Design," which is described in the application as "packaging design for billiard accessories exclusive of team names, logos and/or trademarks."

In a letter dated October 8, 1998 from Examiner John M. Martin, the Visual Arts Section of the Examining Division refused to register this work. The letter stated that copyright protection is not available for useful articles, but noted that any element that is separable from the useful work and that contains a minimum amount of original artistic material is copyrightable. After determining that the work is a useful article because it functions as a pool ball rack, the Visual Arts Section denied registration because there are no artistic elements that are separable from the useful object. Claimant was advised that the drawings depicting and describing the rack that were submitted for deposit could be registered.

In a subsequent letter dated October 21, 1998, you responded to that denial by clarifying that Applicant sought to register the three-dimensional package design, not the pool rack. You asked the Copyright Office to reconsider its decision based on that clarification. Consequently, in a letter from Mr. Martin dated October 27, 1998, the Examining Division again refused registration on the basis that the work consists of simple geometric shapes or simple variations and combinations of geometric shapes that do not contain the minimum level of original sculptural authorship that is required for copyright protection. The letter also refused registration because copyright protection does not protect package design as such. Also, copyright protection cannot be extended to the idea of using a package shaped like a rack to hold and display a billiard rack and ball set because copyright is not available for ideas or concepts.

In a letter dated December 4, 1998, you submitted your first appeal of the Copyright Office's refusal to register Applicant's work. Relying on Feist Publications, Inc. v. Rural Tel. Service Co., 499 U.S. 340 (1991), you argued that Applicant's package is a three-dimensional sculpture that satisfies the extremely low level of creativity required because the work as a whole is a compilation of protectable elements.

You also argued that packaging is copyrightable and that courts have upheld the copyrightability of packaging that is less creative than Applicant's work. In support of this argument, you cited Tonka Corp. v. Tsaisun Inc., 1 U.S.P.Q.2d 1387 (D. Minn. 1986) as a case in which a court determined that packaging was copyrightable even though it had a utilitarian dimension. You asserted that Applicant's packaging is more complex than the packaging at issue there. You also cited Prince of Peace Enterprises v. Kwok Shing Import-Export, 43 U.S.P.Q.2d 1601 (N.D.Cal. 1997), in which the court decided that the packaging at issue there was copyrightable even though it was in the simple shape of a trapezoid. In addition, you argued that the facts relating to the packaging in Parfums Givenchy, v. C & C Beauty Sales, 832 F.Supp. 1378 (C.D.Cal. 1993) are similar to those in this case. In Parfums Givenchy, the court upheld the copyrightability of a two dimensional box for packaging perfume.

Finally, you argued that Copyright Office examining practices require that a work be registered if there is a reasonable doubt that the claim may not withstand judicial scrutiny. Compendium of Copyright Office Practices, Compendium II, Sec. 108.07 (1984).

In a letter dated March 17, 1999 from Melissa Dadant, Special Assistant to the Chief of the Examining Division, the Office again denied registration. After reviewing the administrative history of the application, the letter stated that there are no features of the package shape that can be separated from the utilitarian aspects of the work. In support of this basis for denial, the letter cited SCOA Industries, Inc. v. Famolare, Inc., 192 U.S.P.Q. 216 (S.D.N.Y. 1976) (finding that there could be no valid copyright in wavy lines on the soles of shoes, which are not works of art and, if they were, lacked the minimum originality needed for copyright) and Vacheron & Constantin-Le Coultre Watches v. Benrus Watch Co., 260 F.2d 637 (2d Cir. 1958) (supporting the

Copyright Office's refusal to register a watch face design with no conceptually separable authorship).

In response to your arguments, the letter challenged the relevance of the cases upon which you relied. In Tonka Corp. v. Tsaisun Inc., the packaging had been designed to resemble a kennel or dog house, which had other uses besides being sales packaging for the stuffed toy dog. Unlike Applicant's packaging, the toy kennel had a separate use from the utilitarian one of serving as packaging. Mr. Martin also pointed out that, in Parfums Givenchy v. C & C Beauty Sales, the court's decision focused on the artistic design or label on the package at issue there, which included two-dimensional artwork. Those facts do not apply here because there is no two dimensional artwork on Applicant's work. Finally, the facts regarding the work at issue in Prince of Peace Enterprises v. Kwoc Shing Import-Export also differ from Applicant's work because copyright protection under the registration at issue there did not extend to the two-dimensional trapezoid shape of the packaging but to the text and artwork on the packaging. Again, there is no text or artwork on Applicant's packaging.

Finally, the Examining Division declined to apply the Rule of Doubt under Sec. 108.07 of Compendium II because it did not believe that Applicant's claim of copyrightability would be sustained in a court of law despite the Office's serious reservations.

In a letter dated May 20, 1999, you submitted a second appeal. After reviewing the administrative record, you stated that Rack Pack should be registered on the basis that it is a three dimensional sculptural work that has a sufficient level of creativity independent of its packaging function to satisfy the Feist standard. You stated that the packaging design is not dictated by the useful article. You said that, "there are an infinite number of ways to 'package' the items that would accomplish the 'utilitarian function' of containing the items for sale in commerce." In support of that statement, you stated that the packaging need not be triangular shaped or transparent. It could have been square or round. You discussed other possible approaches to packaging that would have been equally feasible.

As evidence that the work has design elements unrelated to its functional aspect, you pointed out that the letter of denial itself described a portion of the work as an "expansion" for "another set of balls (or some other oblong item)." March 17 letter, p. 2, Para. 1. You argued that this statement is an acknowledgment by the Copyright Office that there are elements of Rack Pack which are separate from its function because it's not clear that they serve any particular purpose.

You also challenged the refusal to register because you interpreted the Copyright Office's refusal as being based on the proposition that no packaging is eligible for registration. You again drew an analogy between Applicant's work and the work at issue in Tonka Corp. v. Tsaisun Inc. You stated that, like the work in Tonka, Rack Pack is designed to allow a purchaser

to view the items prior to purchase, to make the package easier to carry and to use as a storage place for the items after purchase.

You also challenged the relevance of Vacheron & Constantin-Le Coultre Watches v. Benrus Watch Co., which had been cited in the letter of denial as standing for the proposition that copyright does not extend to the features of a useful article which are not separable from its utilitarian function. You pointed out that the court in that case was reviewing the question of whether a copyright infringement action could be maintained if the work had not been registered. The issue of copyrightability was not before the court.

In support of registration, you stated in conclusion that Rack Pack embodies unique elements arranged in an arbitrary manner which are not dictated by function.

DECISION

After reviewing the application and administrative record, the Copyright Office Board of Appeals reached the conclusion that Rack Pack – Billiard Package Design cannot be registered because there are no features of the packaging design that are separable from its utilitarian function. Copyright protection is not available for useful articles except to the extent that there are such separable features. Therefore, pursuant to 17 U.S.C. §§ 101 and 113, Rack Pack – Billiard Package Design is not copyrightable.

The statutory definition states that a useful article has "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. Sec. 101 (definition of a "useful article"). The statute further provides that registration is possible only if and to the extent that a work contains pictorial, graphic or sculptural features that are separable from the useful article. 17 U.S.C. Sec. 101 (definition of "pictorial, graphic, and sculptural works"). Based on these provisions of law and the legislative history, the Office applies the following separability test which is contained in Sec. 505 of Compendium II. Section 505 states that:

> Registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article.

U.S. Copyright Office, Compendium II, Sec. 505.02 (1984).

Section 505 of Compendium II is a direct successor to the Copyright Office regulation that was affirmed in Esquire v. Ringer, 591 F.2d 796 (D.C.Cir. 1978). Based on explicit statements in the statute's legislative history, the court of appeals found that the Office's regulation was an authoritative construction of the copyright law. Id. at 802-803. Esquire and later cases held that, despite an original and creative shape, the overall design or configuration of a utilitarian object may not be copyrighted if it is not "capable of existing as a work of art independent of the utilitarian article in which [it is] incorporated." Id. at 803-804. The court further held that the Copyright Office properly refused copyright registration for a useful article, in that a case a light fixture, notwithstanding how aesthetically pleasing the useful article's shape or configuration may have been. Id. at 800.

The Appeals Board found that the various shapes that make up the packaging design for Rack Pack are not separable from its utilitarian function. Each of the different shapes in the plastic container functions as packaging for a correspondingly shaped piece of merchandise. Each item is placed in the plastic packaging material for protection while being stored or transported. The package also groups the items together to ensure that the several pieces will be sold together as a unit. That is the usual function of packaging.

It is not relevant whether the Rack Pack's design is esthetically pleasing or unique. The legislative history states:

> The test of separability and independence from the "utilitarian aspects of the article" does not depend upon the nature of the design--that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And even if the three dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.

H.R. Rep. No. 94-1476, at 55 (1976) (emphasis added).

In your letter of appeal, you argued that, generally, packaging is copyrightable and that courts have upheld the copyrightability of packaging that is less creative than Applicant's work. In support of this argument, you cited three cases. However, the facts of those cases can be distinguished from the facts at issue here.

In Tonka Corp. v. Tsaisun Inc., the court found that defendants had engaged in copyright infringement because they had substantially copied plaintiff's work. The court based its holding on the substantial similarity between the products due to specific similarities between the stuffed

dogs and the overall appearance, which included both the packaging and the toy stuffed dogs. The court determined that the similarities between the stuffed dogs were magnified by the comparable packaging and marketing themes. It found that plaintiff's packaging, which had been designed to resemble a kennel or a dog house, was copyrightable because its styling and form made it identifiable as something other than a container. It had been marketed as an important part of the play value of the toy dog. In evaluating both copyrightability and infringement, the court focused primarily on the stuffed animals and secondarily on the packaging, and found both copyrightability and infringement based on the combination of the stuffed animals and the packaging. As the court observed, "the similarities in packaging are not the only similarities between the two products. They merely serve to make the similarities of the actual puppies themselves more pronounced." 1 U.S.P.Q.2d at 1402. In contrast, Applicant's claim extends only to the shape of its packaging, which does not function as anything other than a container for the merchandise. To the extent, if any, that Tonka stands for the proposition that that packaging alone may be copyrightable based on its shape, the Board finds that it is not persuasive authority.

You also relied on Parfums Givenchy v. C & C Beauty Sales In that case, the court stated that copyright protection extended to the "packaging design or label," citing Copyright Office regulations that authorize copyright for "a print or label." Parfums Givenchy v. C & C Beauty Sales, at 1391-1392. However, the court concluded that the issue of conceptual separability did not arise in that case. Id. at 1392. The court did not find that the three dimensional box was copyrightable, but simply concluded that "[t]he Amarige Box Design is a *two-dimensional artistic design,* which is physically separable from the utilitarian aspects of Amarige perfume." Id. (emphasis added). In other words, the court simply applied the rule which it quoted from the legislative history of the 1976 Copyright Act: "A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, *containers,* and the like." Id. (emphasis added). Therefore, the facts of that case are not relevant here, because Applicant's claim is confined to the alleged sculptural authorship found in the shape of the Rack Pack.

Similarly, in another case on which you relied, Prince of Peace Enterprises v. Kwoc Shing Import-Export, the court stated that the plaintiffs' copyright registrations extended to the text and two dimensional artwork on the packaging. 43 U.S.P.Q.2d at 1603. Furthermore, the court noted that the clear cover of the packaging had not been included in the copyright application and was not protectable because it was simply functional. Id. at 1606.

The Copyright Office follows a two step procedure in examining useful articles. After identifying any separable elements of the work, then the Office determines whether those separable elements are copyrightable. Due to the fact that the Board did not find that any aspect of Rack Pack was separable from the useful article, it was unnecessary to apply the *de minimis* standard in Feist to determine whether the work was copyrightable.

For the reasons stated in this letter, the Copyright Office Board of Appeals affirms the refusal to register Applicant's work, Rack Pack – Billiard Package Design. This decision constitutes final agency action on this matter.

Sincerely,

David O. Carson
General Counsel
for the Appeals Board
U.S. Copyright Office

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