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September 23, 2002

Robert B.G. Horowitz, Esq.
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1185 Avenue of the Americas
New York, NY 10036

RE: Issey Miyake Fragrance Bottle
Issey Miyake Bath Line Bottle
Control No: 60-713-3582(C)

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Dear Mr. Horowitz:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated August 7, 2000, appealing a refusal to register a fragrance bottle and a bath bottle.[1] I apologize for the delay in responding.

ngton
20559-6000

The Board has examined the claims for the fragrance and bath bottles and considered all correspondence from your firm concerning these claims. After carefully reviewing the claims, the Board affirms the Examining Division's decision to refuse registration.

Administrative Record

On November 2, 1998, the Copyright Office received claims from Beaute Prestige International (BPI) submitted for registration for three works: the Issey Miyake Fragrance Bottle, the Bath Line Bottle and the Fragrance Bottle Box. By letter dated October 8, 1999, Visual Arts Section Examiner Ivan Proctor refused to register the claims on the grounds that they lacked artistic or sculptural authorship necessary to support a claim to copyright.

In a letter date February 4, 2000, you requested reexamination of your client's claims. You submitted a declaration from John Lonczak, the director and manager of an industrial design studio in New York, whom you submit is an expert in industrial design. Mr. Lonczak asserted that "[t]he bottles and box are among the best examples I have ever

[1] The Copyright Office also refused to register the two-dimensional artwork appearing on the box for the fragrance bottle. *See* Letter from Virginia Giroux, Attorney Advisor, to Robert B.G. Horowitz, April 10, 2000. You have not appealed the refusal to register the artwork appearing on the fragrance bottle box.

seen in fragrance bottle and packaging design. In my expert opinion, the bottles manifestly are artistic and not common geometric shapes. Further, the box itself is a work of art." Lonczak 2/4/00 Declaration at para. 19.

With respect to the Fragrance Bottle, Mr. Lonczak concluded that the shape of the bottle is far from a simple geometric design. He stated that it is

> a complex series of forms, colors and components. The translucency and depth of this glass with its inner facets provides a captivating illusion which, at the same time, seems somewhat familiar yet not comprehendible. The bottle appears to have an inner wall of parabolic form in each hemisphere. The parabolic form changes color from a creamy amberish orange at the hemisphere edge (equator) and transforms through orange into a warmish red at the poles. The inner form of the glass has a series of longitudinal and lateral lines around the entire inner circumference thereby giving an illusion of facets which provides yet another layer of visual intrigue. Additionally, the elements comprising this intrigue are in a constant state of flux.

Id. at para. 9.

Mr. Lonczak made similar assertions regarding the Bath Bottle.

> At first look, the bottle is somewhat disk-like, a section of a cylinder with a penetrating disk centered on the rear surface at the axis of the outer disk radius. However, the front surface of the bottle is not flat. Its gentle radius adds a dimension and warmth to the form not available in a pure disk and adds to the richness of the form's depth-like nature. The bottle certainly is not a disk as it does not roll since it has a flattened area at its bottom, which is a result of a shape originating in a non-disk form from its rear view.

Id. at para 15. "The bottle's color has a depth of clarity with some diffusion and magnification quality. The color is a tone found in the fragrance itself and is utilized in a complimentary fashion." *Id.* at para.16. Mr. Lonczak also found the Bottle Box to be highly creative and unique. *Id.* at para. 13-14.

By letter dated April 10, 2000, Attorney Advisor Virginia Giroux denied your request for reconsideration of the refusal to register the claims. Ms. Giroux identified all three items as being "useful articles" within the meaning of that definition contained in

section 101 of the Copyright Act, thereby requiring that the pictorial, graphic or sculptural authorship, if any, must be either physically or conceptually separable from the utilitarian aspects of the articles. Because there are no physically separable aspects of the Fragrance Bottle, the Bath Bottle and the Bottle Box, Ms. Giroux considered the claims for conceptual separability. With respect to the fragrance and bath bottles, which are the subject of this appeal, Ms. Giroux concluded that "[a]lthough aesthetically pleasing, we view the sculptural aspects of each bottle as part of the overall shape, contour and configuration of the bottles themselves, not conceptually separable from the work's [sic] utilitarian function without destroying their basic shape, and as such, not copyrightable." April 10 letter at 3. Ms. Giroux also found the two-dimensional design on the surface of the Bottle Box to be conceptually separable but uncopyrightable. *Id.*

In your August 7, 2000, appeal to the Board, you have expanded your arguments for registration and have included another Declaration from John Lonczak. First, you argue that the Fragrance Bottle and the Bath Bottle are sculptural works that are capable of existing independently as works of art regardless of their utilitarian function. In support of this argument, Mr. Lonczak states that

> [i]n my opinion, this design (Fragrance Bottle) stands as an artistic sculpture by itself. Good art captivates a viewer and this bottle captivates a viewer in the same fashion. Like an Escher print, one is immediately drawn into gazing at the design and exploring its depth. This design is highly intriguing and infinitely changing when viewed....[F]or one to think that this design is not a work of art in and of itself and that the copyrightable subject matter of this design lies only in the shape is a crude minimization and oversimplification of the design. The design is amazingly and tantalizingly complex and its spherical shape is merely but one element of the bottle. The design is not just a sphere.

Lonczak 8/3/00 Decl. at para. 7-8. Mr. Lonczak makes the same assertion for the Bath Bottle. *Id.* at para. 12-14.

Second, you argue that even if the bottles are useful articles within the meaning of section 101 of the Copyright Act, there are many elements which are physically separable that were ignored by Ms. Giroux. For the Fragrance Bottle, they are [as set out in Lonczak 8/3/00 Decl. at para. 5]:

> 1. Orange to red tinting;
>
> 2. A glass sphere composed of two dynamic hemispheres;

3. A sphere having holes at top and bottom to form a sphere truncated at the top and bottom;

4. An inner wall ranging from conical to parabolic form in each hemisphere which changes with the angle of view;

5. The inner wall of the sphere changes color from a creamy amberish orange at its equator through orange into a warmish red at its poles;

6. The inner wall has a series of longitudinal and latitudinal facets around the entire circumference which creates a captivating illusion, which while familiar is not quite comprehendible;

7. The translucency and depth of glass with magnifying inner characteristics;

8. A truncated conical form which sits atop the sphere's top pole which disappears when the sphere is lifted from its seated surface;

9. The translucent red color of the truncated conical form in contrast to the orange tint of the sphere.

For the Bath Bottle, you repeat Mr. Loneczak's claims [as found in his August 3, 2000 Declaration] concerning the following separable elements:

1. A monolithic diskish form, comprised of a softened glossy surface and a tinted orange transparent "C" shape;

2. The "C" shape is augmented by a "D" shaped matte finish of translucent orange which comprises the bottle form's cap;

3. Collectively, both "C" and "D" forms result in a disklike shape as viewed from the front of the bottle;

4. The front surface of the combined form has a slight convex curve which softens the disk's appearance and which forms a lens-like effect. Its gentle radius adds a dimension and warmth to the form not available in a pure disk and adds to the richness of the form's depth-like nature;

5. The liquid within the form adds another visual element to the form;

6. The rear surface of the disk has a disk shape of approximately one-half the diameter of the overall form which is depressed approximately one-fourth the thickness of the bottle;

7. The rear view also differs from the front as the matte-finished "D" shape has a horseshoe magnet-like look;

8. The combination of soft gloss tinted orange lens-like surface, the liquid itself as an integral component and the recessed disk on the rear side create a subtle yet powerful cloudish halo around a glowing spherical central form;

9. Multiple subtle shades of orange (papaya) abound in all elements of bottle form and graphics to further the layered nuances of the bottle;

10. The disk form appears to stand stable and securely on end defying gravity, to reinforce the ethereal quality of the sculptural concept;

11. The appearance of another sphere on the interior of the bottom of the bottle when viewed downwards in perspective from the top.

Id. at para. 10.

You have categorized these listed elements of both works as physically separable features [your August 7, 2000 letter at para. 2] and, given Mr. Lonczak's identification of what you argue are conceptually separable elements,-- the fragrance bottle as a work of art conceptualizing the molten core of the earth and the bath bottle as a work of art conceptualizing a planet or sun rising or setting [Id. at para. 3]--, you submit that the Fragrance Bottle and the Bath Bottle should be registered for the same reasons that certain belt buckles were found to be copyrightable in Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980).

Categorization of Fragrance and Bath Bottles

As discussed above, you have argued that the Fragrance Bottle and the Bath Bottle should not be considered useful articles but rather should be considered free-standing sculptural works of art. It is evident, however, that both these items are useful articles because they are bottles that contain liquid. Section 101 of the Copyright Act defines a "useful article" as one that has "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. 101. The Fragrance and Bath Bottles do have a utilitarian function which is to hold the liquids which are placed in them.

Mr. Lonczak's testimony that the bottles stand as artistic sculptures by themselves and represent "good art" [Lonczak 8/3/00 Decl. at para. 7 - 8] does not change their categorization as useful articles. As the House Report accompanying the current copyright law states:

> [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976).

Copyright Office Separability Tests

The copyright law, 17 U.S.C. 101, contains the following definition:

> *Pictorial, graphic and sculptural works* include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be 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.

Compendium II, the Copyright Office's manual of practices with respect to examination of claims to copyright registration, addresses registration of works of the visual arts [chapter 500] which include the "pictorial, graphic and sculptural works" to which the statute refers. Chapter 500's treatment of separability provides guidelines which explain how the Copyright Office approaches the examination of useful articles in order to determine whether such articles "incorporate pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the articles." ***Compendium II, 505.02*** (1984) states:

> 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.

The requisite separability may be either conceptual or physical. *Id.*

Physical Separability

Compendium II, 505.04, provides the following guidance with respect to physical separability:

> The physical separability test derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection. Examples of works meeting the physical separability test include a sculptured lamp base of a Balinese dancer, or a pencil sharpener shaped like an antique car. However, since the overall shape of a useful article is not copyrightable, the test of physical separability is not met by the mere fact that the housing of a useful article is detachable from the working parts of the article.

The Board has found no basis to conclude that Bath Bottle meets the test for physical separability. Bath Bottle is circular in shape with a flat bottom with a cap, what you describe as a "C shape." At the center is a circular indentation. Bottles can be made in a multitude of shapes and configurations but if that configuration is physically separated, the useful article – i.e. the bottle – ceases to exist. The only possible exceptions here are the circular indentation in the center of the bottle, the liquid inside and the tinting of the plastic. However, even if these elements are physically separable, as you suggest that they are and as we do not agree, the authorship in these elements, nevertheless, would be *de minimis*, preventing registration. The circular indentation is a simple geometric figure that does not warrant protection, *see* 37 C.F.R. 202.1(a) ("familiar symbols or designs" not copyrightable); colors and tints or shades of color per se are not copyrightable, *Id.*; and liquids do not fall within the subject matter of copyright as provided in 17 U.S.C. 102(a).

The Fragrance Bottle possesses many of the same elements which are not physically separable: the round shape of the bottle; the tinted coloring of the plastic. However, inside the plastic of the bottle is a material containing a checkered pattern which, when viewed from different angles through the transparent plastic, creates the image of a cone with the checkered pattern applied to the surface. It is arguable that this checkered material is physically separable from the Fragrance Bottle within the meaning of section ***505.04*** of ***Compendium II***. However, the checkered pattern appearing on this material is far too simple and basic in design to warrant copyright protection as a work of two-dimensional art; nor does the cone shape sustain a registration. Again, *see* 37 C.F.R. 202.1(a).

Conceptual Separability

In the case of conceptual separability, ***Compendium II, 505.03*** further explains:

> Conceptual separability means that the pictorial, graphic and sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as pictorial, graphic or sculptural work which can be visualized on paper, for example, or as free-standing sculpture, an another example, 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. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works– one an artistic work and the other a useful article.

The Board has also analyzed both the Fragrance Bottle and the Bath Bottle to determine whether there are elements that are conceptually separable from the utilitarian features of the bottles which elements would warrant copyright protection. As noted above, conceptual separability exists 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." ***Compendium II, 505.03***.

The "C shape" of the Bath Bottle cannot be imagined separately without destroying the basic shape of the bottle. The indented circular center, which can be imagined separately, is a simple geometric figure that is not copyrightable. 37 C.F.R. §202.1(a). Likewise, the coloring and tinting of the Bottle are not per se copyrightable and, given the unprotectible nature of the coloring, any visual effect produced by the density of the bottle plastic [itself not a subject matter of copyright, *see* 17 U.S.C. 102(a)] and the liquid inside is, by extension, not capable of sustaining a registration.

Following the reasoning set out in the previous paragraph, the Board also does not find any conceptually separable elements in the Fragrance Bottle which would warrant protection. The circular shape of the bottle is, again, a basic geometric shape and that shape cannot be isolated as a separate work of authorship without destroying the overall configuration of the bottle. The checked pattern contained on the material located inside the plastic of the bottle is arguably conceptually separable but in itself fails to rise to the level of a copyrightable design, as explained above. Likewise, the coloring and tinting of the bottle, which change when viewed from different angles due to the density of the plastic, again, are not in themselves copyrightable works of authorship. 37 C.F.R. 202.1(a).

Case Law

You cite a number of cases in your second appeal in which courts have found copyrightable authorship to exist in conceptually separable elements of utilitarian works.

The works at question in those cases may be distinguished from the works now on appeal. In Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980), the Court held that belt buckles accepted by the Metropolitan Museum of Art were copyrightable because of the artistic designs embodied in the buckles which were found to be conceptually separable from the buckles' utilitarian features. The artistic features of those buckles could be envisioned as free-standing and were more than simple geometric shapes. The same cannot be said for the Fragrance or Bath Bottle. Superior Form Builders, Inc. v. Chase Taxidermy Supply Co., 74 F.3d 488 (4th Cir. 1996), involved animal mannequins. There the Court held that the fish mannequins were designed primarily to portray themselves and, therefore, were not useful articles subject to the separability test. "The usefulness of the forms is their portrayal of the appearance of animals." 74 F.3d at 494. The same cannot be said of the Fragrance and Bath Bottles. Both such bottle works possess the "intrinsic utilitarian function" [17 U.S.C. 101] which the statute posits as the hallmark of a "useful article" for purposes of the copyright law, i.e., both works serve as containers to hold liquid. A similar case, Poe v. Missing Persons, 745 F.2d 1238 (9th Cir. 1984), did not address the issue of conceptual separability but rather whether the work in question was in fact a useful article. The Court remanded the case for a factual determination as to whether the works in question were useful articles or works of art. Neither Superior Form Builders nor Poe assists your arguments concerning the protectibility of the Bottles; both Bottles are unequivocally useful articles by statutory definition.[2]

You have also cited Pivot Point Int'l, Inc. v. Charlene Products, Inc., [concerning a sculpted human head mannequin] at its 1993 stage of that protracted litigation. 816 F. Supp. 1286 (N.D. Ill. 1993). The 1993 determination of possible, conceptually separable features of the mannequin head was set aside by the subsequent 2001 determination of non-copyrightability of the mannequin head. The later district court opinion pointed out that the supposedly conceptually separable features are the very features of the head which constitute its utilitarian function and thus cannot be considered separable. 170 F. Supp. 2d 828 (N.D. Ill. 2001). In Oddzon Products, Inc. v. Oman, 924 F.2d 346 (D.C. Cir. 1991) the Court held only that the Office's refusal to register the work in question ["Koosh" ball– a hand ball consisting of numerous elastic filaments radiating from a central core and forming a round, hand ball-like structure] was not an abuse of discretion and explicitly did not get to the issue of whether the ball exhibited conceptual separability or whether it was copyrightable.

In Little Souls, Inc. v. Les Petits, 789 F. Supp. 56 (D. Mass. 1992), the Court held that some aspects [unadorned face structure and arm hole of doll] of the plaintiff's dolls were functional and therefore not protectible in themselves but other aspects of the toy dolls

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[2] We also point out that in determining whether a particular work may be categorized as a "useful article," the Office takes administrative notice of "matters of general knowledge" [***Compendium II, 108.05(b)***]; however, because the Office is not an adjudicating agency with respect to the registration process, it has no procedure for the introduction of "expert evidence" or "testimony from the art world" as you suggest in your August 7, 2000 letter [para. 3].

were held copyrightable. Norris Industries, Inc. v. International Tel. & Tel. Corp., 696 F.2d 918 (11th Cir. 1983) held that the wire-spoked wheel cover in question did not contain any physically or conceptually separable work of work apart from its functional features; and, Ellison Educational Equipment, Inc. v. Accu-cut Systems, Inc., 769 F. Supp. 1090 (D. Neb. 1991) held that 47 geometric cut-out designs related to the plaintiff's paper die punch machine "possess[ed] artistic or aesthetic features which [were neither] physically [n]or conceptually separable from their utilitarian function." Id. at 1102. We conclude that none of the cited cases, including Little Souls which dealt with works falling within the category of toys [not usually categorized as useful articles, *see, e.g.*, Gay Toys, Inc. v. Buddy L., Corp., 703 F.2d 970 (6th Cir. 1983)]– support your contention that the works on appeal here exhibit the necessary separability to sustain registration.

Finally, it should be noted that the Board does not follow the conceptual separability test applied by the Second Circuit in Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987). The Brandir Court adopted Professor Denicola's test for determining conceptual separability. That test considers whether or not a given feature or aspect of a useful article "reflects a merger of aesthetic and functional considerations"; if so, the artistic features of the useful article cannot be said to be conceptually separable; if not, conceptual separability may exist. 834 F. 2d at 1145. Professor Denicola's test encompasses a consideration of the design process involved in the useful article in question as well as the artistic choices of the creator of the article and whether the artistic aspects of the article were significantly influenced by the functionality requirements. 67 Minn. L. Rev. 707 (1983). The Office has not adopted that particular separability test because of the problem that the test is based, at least in part, on subjective perception and application of such a test by the Office in its registration function could result in the registration of works in conflict with the expressed congressional intent to deny copyright protection to the design of useful articles which happen to be aesthetically pleasing.[3] H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976).

In conclusion, the Appeals Board affirms the refusal to register the claims.

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[3] The Denicola test also considers the "designer's intent"-- a factor to which you alluded in your August 7, 2000 letter [para. 3] and which you urged be taken into account in determining whether the constituent features of a work were separable. Because the Office administers the statute in a manner consistent with the legislative history accompanying the 1976 Act, such subjective "designer intent" is not among the considerations taken into account in the Office's determination of whether a given utilitarian object exhibits separable authorship [*see*, ***Compendium II*** separability tests, *supra.*] Nor does the marketability or commercial success of a given work play a part in the Office's determinations: "In connection with its examining and related activities, the Copyright Office does not ordinarily make findings of fact with respect to publication or to any other thing done outside the Copyright Office." ***Compendium II, 108.05***.

Sincerely,

Nanette Petruzzelli

Nanette Petruzzelli
Chief, Examining Division
For the Appeals Board
United States Copyright Office