United States Copyright Office
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May 4, 2004

Adesh Bhargava, Esq.
Dykema Gossett PLLC
Suite 300 West
1300 I St., N.W.
Washington, D.C. 20005

RE: DIVA
Control No. 60-908-4364(D)

Dear Ms. Bhargava:

I am writing on behalf of the Copyright Office Board of Appeals in response to your memorandum, dated February 21, 2003. You asked the Copyright Office to reconsider its refusal to register a glass carafe, entitled "Diva." The Board of Appeals affirms the Examining Division's refusal to register Diva.

ADMINISTRATIVE RECORD

Initial Submission.

On July 2, 2001, Societe Autonome de Verreries submitted an application to register a glass carafe, called "Carafe." In a letter dated October 26, 2001, William R. Briganti, Senior Examiner, Examining Division, refused to register this work because, as a carafe, it is a useful article that has no separable authorship from its utilitarian purpose that is copyrightable. Mr. Briganti set forth the test for separability that the Copyright Office applies. In conclusion, he stated:

> Because all of the elements of [Diva] are either related to the utilitarian aspects of function, or are subsumed within the overall shape, contour, or configuration of the article, there is no physically or conceptually "separable" authorship as such.

Letter from W. Briganti to W. Bonk of 10/26/01, at 2.

First Request for Reconsideration.

In a memorandum dated January 24, 2002, Mr. William A. Bonk, III, Esq., submitted a first request for reconsideration to the Copyright Office. He requested that the title of the work be changed to "Diva." Mr. Bonk argued that Diva has separable features from its utilitarian purpose that have sufficient creativity to be copyrightable. He stated that only a minimum amount of creativity is required for a work to be copyrightable. He acknowledge that Diva is a useful article that has the capacity to contain fluid and, as an example, it may be employed "for ... containing a fluid such as wine." Memorandum from W. Bonk to Chief, Examining Division of 1/24/02, at 2.

He also argued that Diva "exhibits aesthetic attributes that the author added which are separable from utilitarian aspects thereof." *Id.* He stated that Diva's aesthetic qualities distinguish it from other containers, such as a rusty can. Mr. Bonk said that the test for conceptual separability that the Board should apply to Diva is one based on its marketability. The test should be whether consumers would buy it even if it had no utilitarian purpose. He cited Poe v. Missing Persons, 745 F.2d 1238 (9th Cir. 1984) in support of that standard. As evidence that Diva would be purchased even if it could not function to hold fluids, he pointed out that many consumers do not use carafes to hold fluid but, instead, display them as decorative objects.

Mr. Bonk described Diva's separable authorship as including the stylized rounded shoulder, tapering body, thick base and polished, smooth finish. These features give the carafe "a clean, fluid, sophisticated appearance that conveys serenity and calm." *Id.* at 3. He argued that the overall shape resembles a male figure. The thick base gives the impression of strength and permanence. The finish combined with the overall shape gives the impression of exquisiteness. He compared Diva's appearance to a finely crafted perfume bottle. Mr. Bonk stated that the separable features he identified are not necessary to render Diva useful, but are only ornamental.

In a letter dated October 29, 2002, Virginia Giroux, Attorney Advisor, Examining Division, again refused to register Diva on the same basis that it was denied registration by Mr. Briganti. Ms. Giroux explained that a useful article may be a work of art but under copyright law it is subject to certain requirements as a utilitarian work if it has any intrinsic function. 17 U.S.C. § 101. She again discussed the standard of review that the Copyright Office applies to useful articles. She stated that the test for conceptual separability is not satisfied merely because aspects of a useful article are not dictated by utilitarian concerns. She asserted that the elements identified by Mr. Bonk are not separable from Diva's utilitarian function because they are part of the overall shape or contour of Diva. She rejected Mr. Bonk's suggestion for using a different standard of

review than is required by Copyright Office written procedures which are contained in Compendium II of Copyright Office Practices (1984). Ms. Giroux distinguished the facts of Poe v. Missing Persons from those at issue here. In conclusion, she also explained that the effect or impression that a work conveys is not germane to the question of whether a work is copyrightable.

Second Request for Reconsideration.

On February 21, 2003, you submitted a second request for reconsideration to the Copyright Office. You described the artistic and sculptural aspects of Diva that you argue have sufficient minimum creativity to be entitled to copyright protection.

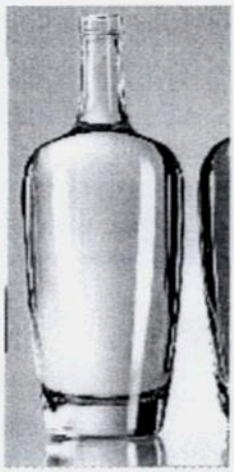
> [DIVA] is a distinctive sculptured carafe including an artistically designed oval section, which is relatively narrow at the base thereof, and which gradually widens toward the strong rounded shoulders thereof. The shape of the oval section changes according to the different levels of the DIVA's overall body and according to the curvature thereof. From the front, the oval section appears fat and curved, whereas from the side, the oval section appears slim and flat.
>
> The oval section of the DIVA is topped with a cone shaped cylindrical collar having a small diameter. The cylindrical collar further tapers downward toward the strong rounded shoulders, which themselves taper downward toward the base of the DIVA.
>
> The base of the DIVA is composed of a distinctively thick glass sole, which provides a heavily sculptured appearance, and further embellishes the curvature within the DIVA. The bottom of the base further possesses a bow or arch shaped section, which provides the base with a sculptured exterior.
>
> These harmonious proportions provide the DIVA with unique sculptured features, as compared to conventional carafe designs. These sculptured features further provide the DIVA with a strong impression at the shoulders, and yet with slimness and elegance due to the unique artistic design thereof.

Memorandum from A. Bhargava to the Copyright Office of 2/21/03, at 2.

After stating that only a minimum level of creativity is required for a work to be copyrightable, you discussed various kinds of useful articles and cases in support of your arguments that Diva is copyrightable, citing Mazer v. Stein, 347 U.S. 201 (1954); Thomas Wilson & Co. v. Irving J. Dorfman Co., 433 F.2d 409 (2d Cir. 1970); Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279 (5th Cir.), *cert denied*, 398 U.S. 928 (1970); Parfums Givenchy, Inc. v. C&C Beauty Sales, Inc., 832 F.Supp. 1378 (C.D. Ca. 1993); Sunset Lamp Corp. v. Alsy Corp., 698 F.Supp. 1146 (S.D. N.Y. 1988) Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co., 260 F.2d 637 (2d Cir. 1958) and Kieselstein-Cord v. Accessories by Pearl, Inc. 632 F.2d 989 (2d Cir. 1980). You enumerated several types of useful articles with artistic aspects that the Office registered in the past. You also interpreted the cases you cited as evidence that useful articles and, therefore, Diva, are copyrightable. You asserted that, based on the standards of modern art and the holdings of Kieselstein-Cord, Thomas Wilson, Tennessee Fabricating, Parfums Givenchy and Sunset Lamp, Diva is registrable as a work of art. You stated that Diva has artistic features that give it a unique sculptured appearance that has sufficient minimum creativity.

Citing Brandir International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d 1987), you identified design elements of Diva that you assert show the author exercised judgment independently of functional influences and argue, therefore, that those elements are conceptually separable. These design elements include the oval section that appears wide from the front and narrow from the sides, the cone shaped cylindrical collar, the rounded shoulders and the thick base. You stated that none of these elements give Diva a utilitarian advantage. Another point you argued is that Diva is ergonomically shaped. You said that its ergonomic shape is not mandated by function which illustrates the point that its shape is not dictated by function. Also, you stated that registering Diva would not violate the policy goal of copyright that individuals should not be given unfair monopoly over basic shapes because Diva is not composed of basic shapes. You urge that it has a distinctive appearance that is composed of numerous shapes and elements that differ from the basic shapes found in ordinary products.

DECISION



After reviewing the application and arguments you presented, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register Diva. To briefly state its analysis, the Board determined that Diva is not copyrightable because it did not find any elements separable from its utilitarian function as a carafe. After analyzing a useful article to determine whether there are any separable aspects, the Board then examines those separable elements to determine whether they have sufficient originality to be copyrightable. Since the Board concluded that Diva does not have any separable elements, it did not consider the issue of originality. The following discussion explains the Board's reasoning.

Based on the statutory definition of a useful article, the Appeals Board initially determined that Diva is a useful article because it is a glass carafe. Typically, carafes are for use at a dining table or in a bedroom to contain liquids for human consumption, such as, water or wine. A useful article is defined as 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 (definition of "useful article"). Also, any article that is "normally a part of a useful article is considered a 'useful article.'" *Id.* Since you acknowledged in your arguments that Diva, as a carafe, is designed to serve the useful function of containing fluids, that issue is not in dispute. Therefore, as a useful article, Diva is subject to the separability analysis that copyright law requires for useful articles.

The purpose of the separability analysis is to ensure that utilitarian aspects of useful articles are not registered since they are not copyrightable. Written guidelines for

the separability analysis are found in § 505 of Compendium II of Copyright Office Practices, Chapter 5 (1984). Section 505.02 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. Determination of separability may be made on either a conceptual or physical basis. (Emphasis added.)

These guidelines are based on the legislative history of the Copyright Act of 1976, quoted below, in which Congress clarified that utilitarian aspects of useful articles are not copyrightable. Only elements that are physically or conceptually separable from the utilitarian purpose of a useful article may be copyrighted.

> [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. 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.)

The Board cannot accept Mr. Bonk's recommendation that it apply a test for separability based on the marketability of a work even if it were unable to perform the utilitarian purpose it was designed to serve. In support of that approach, he relied on Poe v. Missing Persons, 745 F.2d 1238, 1243. In Poe v. Missing Persons, the court reversed

the lower court's grant of summary judgement because there were genuine issues of fact about whether the work at issue, an artist's rendering of a woman's swimsuit, was a useful item of clothing or a work of art. The court, citing Nimmer on Copyright, suggested the approach recommended by Mr. Bonk as one of several methods for ascertaining whether the swimsuit design was functional as a swimsuit. Such an analysis is inconsistent with the requirements of the statute, legal precedents and legislative history of copyright law, as discussed elsewhere in this letter, which are incorporated into Copyright Office rules and procedures. The Copyright Office is required to apply the same separability analysis consistently to all works.

As stated above, after analyzing a useful article to determine whether there is any separable aspect, the Board then examines that separable element to determine whether it has sufficient originality to be copyrightable. However, since the Board concluded that Diva does not have any separable elements, it did not consider the issue of originality. Therefore, the many cases you cited in support of finding that Diva has the minimum level of creativity required to be copyrightable addressed issues that were beyond the Board's purview in its reconsideration of Diva. For that reason, the Board cannot respond to your arguments based on those cases. The Board's separability analysis for Diva is set forth below.

Separability

Physical Separability. As quoted earlier, a useful article is defined as "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. The statute also 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. § 101 (definition of "pictorial, graphic and sculptural works") and § 102(b). Based on these statutory provisions and legislative history, as discussed below, the Copyright Office applies a physical separability test that is contained in § 505 of Compendium II. As quoted above, § 505.02 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.

Section 505 is a direct successor to the Copyright Office regulation that was affirmed in Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), *and reh'g denied*, 441 U.S. 917 (1979). Esquire enunciated the rule that is the basis for the Office's analysis of whether a work is separable from the utilitarian object in which it is incorporated. Relying on explicit statements in legislative

history, the Esquire Court 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 into which [it is] incorporated." *Id.* at 803-804. In Esquire, the Court held that the Copyright Office properly refused registration for a useful article, in that case a light fixture, notwithstanding how aesthetically pleasing the useful article's shape or configuration may have been. *Id.* at 800. As quoted above, the legislative history states that:

> 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.

H.R. Rep. No. 94-1476, at 55 (1976). Only elements that are independent of the utilitarian aspects of a useful article are copyrightable.

Consistent with Esquire, the Appeals Board determined that Diva does not have aspects that are physically separable from its utilitarian function. Diva is analogous to the work that was the subject of Norris Industries, Inc. v. International Telephone & Telegraph Corp., 696 F.2d 918 (11th Cir. 1983), *reh'g denied,* 703 F.2d 582 (11th Cir. 1983), *and cert. denied,* 464 U.S. 818 (1983). That case also involved a useful object, wire-spoke wheel covers that were intended to simulate the appearance of wire wheels. Norris contended that the wheel covers were only ornamental and their purpose was to adorn the wheels of automobiles. However, the court found that the design and function of the wheel covers were inseparable. The court did not find any superfluous sculptured design that served no function and that could be identified apart from the wheel covers.

Similarly, Diva does not have any elements that are superfluous. The artistic aspects that you identified are inseparable from Diva's utilitarian function as a carafe. The oval section, the cone shaped cylindrical collar, the rounded shoulders and the thick base, although they could have been designed differently, are nevertheless functioning parts of Diva in its use as a container. They are also parts of the overall contour and shape of the article and thus, are not physically separable.

Conceptual Separability. Conceptual separability exists when pictorial, graphic or sculptural features are "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. As an

example, § 505.03 also states, "Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration."

The Board determined that Diva does not have any conceptually separable elements, either. Again, the elements you identified cannot be imagined separately and independently from Diva without destroying its overall basic shape. Those elements are essential to the utilitarian function of a carafe. To conceive of them separately from the carafe would alter the overall shape of the utilitarian object.

Nor is it relevant that various aspects of Diva are unique or decorative. To quote the legislative history again, "The test of separability ... does not depend upon the nature of the design -- 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 [utilitarian aspects of the] useful article as such are copyrightable." H.R. Rep. No. 94-1476, at 55 (1976).

The ergonomic considerations you advocated are not relevant to the analysis for separability. Works are not compared, and it is not relevant that there may have been other ways to design a useful article. The Board must review the end result of the work for which registration is sought.

For the reasons stated in this letter, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register Diva. This written opinion constitutes final agency action on this matter.

Sincerely,

/s/

Marilyn J. Kretsinger
Associate General
for the Appeals Board
United States Copyright Office