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Via First Class Mail and Fax

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RE: VERSAILLES
ATHENA
HEART SHAPE 5151
CRYSTAL FUEL BOTTLE
"HUMERY" -open work shade
Control Number: 61-313-2110(K)

Dear Mr. Caughman:

On behalf of the Copyright Office Review Board (formerly known as the Board of Appeals), I am responding to your July 11, 2005 letter requesting a second reconsideration of the Office's refusal to register five claims to copyright in catalytic diffusers, which you describe as "a product which absorbs and destroys odors and smoke while ast the same time enhancing the air with fragrances through a unique catalytic phenomenon." (Letter from Caughman to the Board of Appeals of 7/11.05 at 2). The copyright claims were submitted on behalf of your client Produits Berger, S.A. The Copyright Office Review Board affirms the Examining Division's refusal to register.

I. REPRESENTATIONS OF THE WORKS

The works involved in this reconsideration are as follows:

1. VERSAILLES



2. ATHENA



3. HEART SHAPE 5151



Heart Shape 5151
4.5x3.5x3.5

4. CRYSTAL FUEL BOTTLE



5. "HUMERY" -open work shade



II. ADMINISTRATIVE RECORD

A. Initial submission

The Copyright Office received applications to register the five works relating to catalytic diffusers on May 20, 2004. In a letter dated August 9, 2004, the original Examiner refused to register four of the designs, [ATHENA, HEART SHAPE 5151, CRYSTAL FUEL BOTTLE, and "HUMERY" -open work shade], on the ground that the items were useful articles which did not contain any separable features that were copyrightable. After reviewing the applications, including the deposits, the Examiner concluded that the separable elements of the four works were not copyrightable because they represent an insufficient amount of original authorship. Likewise, with respect to the fifth claim entitled VERSAILLES, the Examiner explained that it could not be registered as a "3-dimensional sculpture" because it was a useful article lacking separable sculptural

features. However, the Examiner found that the flower design could be registered as a "2-dimensional artwork", and she requested a new application modifying the nature of the copyright claim.

B. First Request for Reconsideration

In a letter dated December 10, 2004, you requested reconsideration of the Office's refusal to register the five designs.[1] You stated that your client is the worldwide leader in the design, manufacture, and sale of catalytic diffusers, a product which absorbs and destroys odors and smoke while at the same time enhancing the air with fragrances, through a unique catalytic phenomenon. (Letter from Caughman to the Examining Division of 12/10/04 at 2). The diffusers consisted of a bottle which held a scented fuel, a wick, and an open work shade, which is intended to keep people from burning their hands on the open flame. *Id.* at 2.

You stated that all the works exhibited the creativity of the human mind which has created something from nothing. *Id.* at 3. You argued that the Examiner had treated your client's works as useful articles containing some separable features, but the separable features were not copyrightable. You contended that the standards of "conceptual separability" developed in the case law lead to the conclusion that the works were copyrightable. *Id.* at 5.

You began your analysis with Mazer v Stein, 347 U.S. 201(1954), which held that a lamp base consisting of a statuette of dancing figures was copyrightable. *Id.* at 5-6. You next discussed Kieselstein-Cord v. Accessories by Pearl, 632 F.2d 989 (2d Cir. 1980), which held that an ornamental belt buckle contained separable sculptural elements. *Id.* at 6-7. You distinguished the mannequins found not copyrightable in Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411 (2nd Cir. 1985), from your client's works on the ground that the mannequins were required to resemble the human form, while the diffuser products could take any shape. *Id.* at 7-8. You argued that finding a bicycle rack to be uncopyrightable because it was dictated by functional considerations, Brandier International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987), actually supported the registration of your client's works since the shapes of those works were not dictated by function. *Id.* at 8-11. You asserted that passages cited in the Compendium II, Copyright Office Practices regarding useful articles were printed 20 years ago, and did not take into account recent precedents. *Id.* at 12.

You further asserted that the five works contained the necessary element of creativity. You cited Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991), as authority for the proposition that the quantum of originality and creativity required to support copyright is extremely low. That case further provided that the requirement of originality mean only that the work was independently created by the author and that it possessed at least a minimal degree of creativity. *Id.* at 13-14. While the Supreme Court held that the arrangement of names in a telephone book in alphabetical order did not possess the "minimal creative spark" for copyright protection, you argued that your client's works were distinguishable from the white pages telephone directory in Feist on the grounds that they were "created purely from the mind of a person and "can take any shape conceived

[1] For reasons not explained in your first request for reconsideration, you did not seek to register a copyright claim in the 2-dimensional floral design on the work entitled VERSAILLES. Instead, you asserted that it, and the other four copyright claims, should be registered on the basis of three-dimensional sculptural authorship.

in the mind of the designer." *Id.* at 19. You also asserted that Bleistein v. Donaldson, 188 U.S. 239 (1903), cautioned the courts and the Copyright Office that it should not get into the business of determining what art is. *Id.* at 15.

After reviewing your first request for reconsideration, Examining Division Attorney Adviser Virginia Giroux responded in a letter dated March 14, 2005. She upheld the refusal to register all five works on the basis of 3-dimensional sculptural authorship.[2] (Letter from Giroux to Caughman of 3/14/05 at 1.) Ms. Giroux stated that your letter did not dispute that the works had a functional use, and that the works had to be examined in accordance with the standards applicable to useful articles. She stated that 17 U.S.C. § 101 not only defines a useful article as an article having an intrinsic function but also provides that the design of a useful article "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 "without destroying its basic shape." *Id.* at 1-2.

In examining a work in the useful article category, Ms. Giroux explained that a useful article must determine whether the work has any pictorial, graphic, or sculptural authorship that is either physically or conceptually separable from the utilitarian aspects of the article. She stated further that the Copyright Office examines such a work to determine if it contains physically or conceptually separable elements that can be regarded as a "work of art" apart from that shape of the article. *Id.* at 2.

Ms. Giroux stated that the Copyright Office follows the test for conceptual separability which is set out in Compendium II, Copyright Office Practices, rather than the test articulated in Brandier International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2nd Cir. 1987). She clarified that the Compendium states that conceptual separability occurs when the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized independent of the shape of the article. She cited as examples a carving on the back of a chair, or pictorial matter on a glass vase. *Id.* at 2.

Ms. Giroux explained that the "test for conceptual separability, however, is not met by merely analogizing the general shape of a useful article to works of modern sculpture since, in this case, the alleged 'artistic or decorative features' and the useful article cannot be perceived as having separate, independent existences." Further, she explained that although certain features could have been designed differently, if the features are an integral part of the overall shape or contour of the useful article, no registration is possible. She cited Esquire v. Ringer, 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), for the proposition that copyright could not be secured for a useful article based on the overall shape or configuration of the article, no matter how aesthetically pleasing that shape or configuration might be. *Id.* at 2-3.

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[2] Ms. Giroux did state that the floral design on the surface of VERSAILLES, and, if original, the photograph on the surface of CRYSTAL FUEL BOTTLE could be registered as two dimensional works of art. In your request for reconsideration, you had neither sought nor argued for registration on the basis of two dimensional pictorial authorship.

Turning to the works at issue, Mr. Giroux stated that four of the works were bottles which held scented fuel. The fifth work, entitled HUMERY-OPEN WORK SHADE, was a device inserted into the top of a bottle to keep people from burning their hands on the flame coming out of the bottle when in use. She viewed the curves, twists, the raised and indented portions, as well as the various cuts of the bottles as part of the overall shape, contour, or configuration of the useful article itself, which could not be perceived as conceptually separable without destroying the basic shape of the article itself. *Id.* at 3.

Finally, she concluded that neither Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991); Mazer v. Stein, 347 U.S. 201 (1954); Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980); nor Carol Barnhardt, Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985) supported registration of the five works in issue. While Feist confirmed that the requisite level of creativity is very low, applying the standard to useful articles first required a finding that the work contains separable authorship. She stated that the Mazer case involved a copyrighted statuette of a Balinese dancer which had been used as a lamp base, while the sculptural elements embodied in the works at issue were not copyrightable prior to being incorporated into the useful article. In Kieselstein-Cord, the belt buckles at issue were held by the court to contain separately identifiable sculptural shapes constituting separable authorship. Ms. Giroux did not find any comparable authorship in the five works at issue. She further asserted that the court in Carol Barnhardt confirmed that aesthetic or artistic features that cannot be identified separately from the useful article itself is not copyrightable, a test with which the Copyright Office agrees. *Id.* at 4. Ms. Giroux closed with a recitation to the legislative history concerning the standards applicable to copyright protection for useful articles. *Id.* at 4-5.

C. Second Request for Reconsideration

In a letter dated July 11, 2005, you mad a second request for reconsideration of the Office's refusal to register the five designs.[3] You repeat the statement made in your first request for reconsideration regarding the nature of your client's catalytic diffuser products. (Letter from Caughman to the Board of Appeals of 7/11/05 at 2). You argue that the designs at issue are "conceptually separable" and therefore copyrightable, because the designs are not controlled by utilitarian requirements, but rather by aesthetic choices and human creativity. *Id.* at 3. You contend further that the designs meet the requisite level of creativity established by Supreme Court precedents, and that because the designs have been copied by third parties, a presumption is created regarding the requisite creativity. *Id.* at 3-4.

You began your analysis with Mazer v Stein, 347 U.S. 201(1954), which held that a lamp base consisting of a statuette of dancing figures was copyrightable. *Id.* at 6-7. You characterize the case as establishing whether a work of art, which is applied to a specific industrial use, can still retain copyright protection under U.S. law. The court answered in the affirmative. *Id* at 7. You next discuss Kieselstein-Cord v. Accessories by Pearl, 632 F.2d 989 (2d Cir. 1980) holding that an ornamental belt buckle contained separable sculptural elements. *Id.* at 7-8. You quote several

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[3] In your second request for reconsideration, you did not address Ms. Giroux's offer to consider registration of 2-dimensional pictorial authorship for two of the works. Instead, you asserted that all five works should be registered on the basis of 3-dimensional sculptural authorship.

sentences from the opinion finding conceptually separable elements, and stating that the buckles in issue could be considered jewelry.

You argue that while the court in Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985), found the mannequins involved in the case to be uncopyrightable, the test the court articulated supports the copyrightability of your client's different products. In Carol Barnhart , you assert, the mannequins were found not copyrightable because they were required to resemble the human form, while your client' s work could take any shape. *Id.* at 8-10.

You cite Brandier International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987), as supporting registration of your client's works. In Brandier, the Second Circuit found that a bicycle rack was uncopyrightable because it was dictated by functional considerations. In making this finding, the Court applied a test proposed by Professor Denicola. You assert that since your client's work are not dictated primarily by functional characteristics, they meet the test applied by the Second Circuit in Brandier. *Id.* at 10-13.

You further cite to the recent case of Pivot Point International, Inc. v. Charlene Products, Inc. , (7th Cir. 2004), upholding a copyright claim in a mannequin head used to teach students hairstyling and makeup application. You assert that the court drew from Second Circuit opinions in finding conceptual separability when the artistic aspects of an article can be conceptualized as existing independently of a utilitarian function, and independence is determined by whether the design elements can be identified as reflecting the designers' artistic judgment exercised independently of functional influences. You claim your client's products meet that test. *Id.* at13-15. You state that the cases of Superior Form Builders, Inc. v. Dan Chase Texidermy Supply Co., Inc. , 74 F.3d 488 (4th Cir. 1996); Rachel v. Banana Republic, Inc. , 831 F.2d 1503 (9th Cir. 1987); and Oddzon Products, Inc. v. Oman, Register of Copyrights, 924 F.2d 346 (D.C. Cir. 1991) also support registration of the designs in issue. *Id.* at 15-16.

You also assert that your client's works contain the necessary element of creativity as established by Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991). You state that Feist held that the quantum of originality and creativity required to support copyright is extremely low, and that the requirement of originality means only that the work was independently created by the author and that it possesses at least a minimal degree of creativity. *Id.* at 18-19. While the Supreme Court held that the arrangement of names in a telephone book in alphabetical order did not possess the "minimal creative spark" for copyright protection, you argue that your client's works are distinguishable on the grounds that the work could take any shape. *Id.* at 19. You also assert that Bleistein v. Donaldson, 188 U.S. 239 (1903), cautioned the courts and the Copyright Office that they should not get into the business of determining what art is. *Id.* at 20.

III. DECISION

A. Copyrightability of Useful Articles

While your request for a second reconsideration argues that your client's works are primarily works of art, you acknowledge that they also have a functional purpose of catalyzing scented fuel. (Letter from Caughman to the Board of Appeals of 7/11/05 at 2). Moreover, the primary thrust of your argument that the five designs should be registered is that they meet the test of conceptual

separability as articulated in some court opinions. Since it appears clear that the standards applying to useful articles are controlling in this instance, the Review Board will begin with a discussion of the extent of copyright protection provided for useful articles.

1. The statute

The copyright law sets forth the guiding principle regarding the extent of copyright protection for a useful article. The statute defines this protection in the following terms: "the design of a useful article... 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." 17. U.S.C. § 101 (2004). The legislative history accompanying the 1976 Copyright Act clarified Congress's intent with respect to copyright protection for useful articles: "... to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design." H.R. Rep. No. 1476, at 55 (1976). The House Report further explains Congress's intention that "although the shape of an industrial product may be aesthetically satisfying and valuable, [Congress's] intention is not to offer it copyright protection..." *Id.* Specifically addressing the issue of the "shape" of an industrial product, the House Report goes on to state that:

> 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.

Id.

2. Copyright Office Compendium

Compendium II, Compendium of Copyright Office Practices ("Compendium II"), the Copyright Office's manual of practices with respect to examination of claims to copyright registration, addresses registration of the 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 the statutorily-required "pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the articles." In the case of conceptual separability, Compendium II, Ch. 500, § 505.03 1984), states:

> 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.

In the case of physical separability, Compendium II, Ch. 500, §505.04 (1984), states:

> 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.... 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 Office's position and its Compendium articulation of that position is consistent with the statutory grounds for protectibility of pictorial, graphic and sculptural works which are incorporated within useful articles. The statute's definitional guideline for determining whether protectible features exist apart from the **utilitarian aspects** of the useful article does not explicitly delineate the meaning, *i.e.*, the scope and range, of utilitarian aspects which must be taken into account in performing such separability judgment. Although "utilitarian aspects" might appear, on first consideration, to be language which is plain on its face, Congress saw fit to include the explanatory discussion of the subject within the legislative history of the 1976 Copyright Act which has been cited above.

The House Report also specifically refers to Copyright Office regulations, promulgated in the 1940's, on this subject of separability as the regulations applicableo useful articles and industrial design. The House Report [at 54] notes that the 1976 statutory language is "drawn from" those Office regulations and that part of the language is "an adaptation" of subsequent Office regulatory language which implemented Mazer v. Stein, 347 U.S. 201 (1954) [works of art incorporated into useful articles, such as mass-produced articles of commerce, may retain their copyright protection]. Courts, under both the 1909 and the 1976 Acts, have considered the appropriate extent of protection for works of art incorporated into useful articles and have consistently recognized the expertise of the Copyright Office in its administration of the registration activity, including confirming Office registration decisions concerning works of art incorporated into useful articles. *See* Norris Industries, Inc. v. International Telephone and Telegraph Corp., 696 F.2d 918 (11th Cir. 1983), *cert. denied*, 464 U.S. 818 (1983); Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978) *cert. denied*, 340 U.S. 908 (1979); Vacheron and Constantin - Le Coultre Watches, Inc. v. Benrus Watch Company, Inc. 260 F.2d 637 (2d Cir. 1958); SCOA Industries, Inc. v. Famolare, Inc., 192 U.S.P.Q. 216 (S.D.N.Y. 1976).

Concerning the Office's Compendium tests for separability, the relevant Compendium sections essentially confirm the case law which supports the long history of the Office's

interpretation. In Esquire v. Ringer, referring to the useful article passage from the 1976 House Report, *supra,* the United States Court of Appeals for the District of Columbia Circuit stated that the passage "indicate[s] unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright." Esquire, Inc. v. Ringer, 591 F.2d 796, 804 (D.C. Cir. 1978). Although Esquire was decided under the 1909 Act, the Court made clear that its references to the provisions of the 1976 Act were appropriate because "the new Act was designed in part to codify and clarify many of the [Copyright Office] regulations promulgated under the 1909 Act, including those governing 'works of art.'" *Id.* at 803. The Office's position with respect to the interpretation of the separability issue was also confirmed by the 11th Circuit in Norris Industries, Inc. v. International Telephone and Telegraph Corporation in which the Court noted Congress' intention concerning the statutory language on separability and additionally noted that other federal circuit courts have relied upon the Office for "expertise in the interpretation of the law and its application to the facts presented by the copyright application," based upon the Office's having "been concerned with the distinction between copyrightable and noncopyrightable works of art since the Copyright Act of 1870..." Norris, 696 F.2d at 922. And, although it was a case brought under the Administrative Procedure Act [5 U.S.C. 701 - 706], Custom Chrome, Inc. v. Ringer, 35 U.S.P.Q.2d 1714 (D.C.D.C. 1995), nevertheless confirmed that the Office's refusal – premised on the Compendium tests – to register motorcycle parts was not arbitrary, capricious, an abuse of discretion and otherwise not in accordance with law.

3. Application of the conceptual separability test to the works in issue

While you contend that the five designs meet the conceptual separability test, nowhere in your letters seeking reconsideration do you identify the separable three-dimensional elements in each of the designs. Instead, you seem to believe that the general shape of each of the designs is deserving of copyright protection because each was designed with aesthetics in mind, and each is not dictated by function. Congress could have made these principles the test for copyright protection of useful articles, but expressly chose not to. As the House Report clearly states: "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." *Id.* You have identified no such three-dimensional separable elements.

In determining the five designs cannot be registered as three-dimensional sculptures, the Review Board has looked at each design carefully. Each design can be described as follows:

VERSAILLES

The work VERSAILLES is a plain, smooth oval-shaped bottle similar to standard perfume bottle. The pictorial floral design is obviously separable but you have elected not to seek registration on the basis of a two dimensional pictorial representation. The Review Board sees no three-dimensional sculptural element on which registration can be considered, and your letters for reconsideration identify no such element.

ATHENA

The work ATHENA is a six sided bottle with a large oval design on each of the six sides. The overall shape is somewhat similar to a vase, and the oval design appears subsumed in basic shape of the bottle. No separable three-dimensional elements have been identified by you in your reqeusts for reconsideration, and the Review Board concludes there are no such features on which copyright registration can be based.

HEART SHAPE 5151

The work HEART SHAPE 5151 is another plain, smooth bottle, shaped more or less like an apple, and resembling perfume bottles. Again, the Review Board sees no three-dimensional sculptural element on which registration can be considered, and your letters for reconsideration identify no such element.

CRYSTAL FUEL BOTTLE

The work CRYSTAL FUEL BOTTLE is a long, oblong bottle with a diamond ornamentation at both the top and bottom of the bottle. The generally rectangular shape of the bottle is rather commonplace. The pictorial label is obviously separable, but you have elected not to seek registration on the basis of a two dimensional pictorial representation. The Review Board believes the diamond ornamentation is arguably separable, but *de minimis*. Copyright Office regulations provide that there is no protection for familiar symbols, designs or shapes such as standard geometric shapes. 37 C.F.R. 202.1. The diamond ornamentation is a familiar geometric design which falls within this exclusion. Since the general shape of the bottle cannot be registered because it is the shape of a useful article, and the diamond ornamentation is *de minimis,* the Review Board concludes there is no basis on which copyright registration can be based.

"HUMERY" -open work shade

The design is circular in shape and includes a top. The sides consist of six large rectangular holes arranged around the circumference, and 12 smaller rectangular holes arranged around the circumference at the top and bottom of the large rectangles. These rectangular holes have the utilitarian purpose of allowing air to reach the flame of the diffuser. The circular top has six trapezoidal holes arranged between the center and the edges, and a large hole in the shape of a circle at the center of the top. These holes serve the utilitarian purpose of allowing the flame and the scent to exit at the top of the diffuser, and to circular air to the flame. The Review Board concludes that the geometric holes created in the open shade are central to the utilitarian function of diffusing scent through the burning of fuel. Since these elements are utilitarian in nature, they can not be considered in determining the registrability of the open shade. Since there are no other elements in this work which is arguably separable, the Review Board concludes that the design can not be registered.

As previously cited in this decision regarding the legislative history, Congress intended the separability test to establish as clearly as possible the boundaries of copyright protection for useful articles. If the separability test could be met by merely citing to aesthetic intentions of a designer, or by asserting that a given shape was not absolutely dictated by function, then the boundary created by

the separability test would largely disappear. Most industrial designs would suddenly become copyrightable, and the intention of Congress would be frustrated.

4. Precedents on conceptual separability

Your second request for reconsideration cites a number of precedents concerning the concept of conceptual separability which you assert support registration of the five designs. The theory on conceptual separability differs among the several scholars/jurists who have written about it. For the reasons stated in this section, the Review Board finds your argument unpersuasive.

You cite Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980) as supporting registration of your client's five designs. (Letter from Caughman to Board of Appeals of 7/11/05 at 7-8). We disagree with your comparison with Kieselstein and with your conclusion concerning the supposedly separable overall shape of the five designs involved in this instance. Kieselstein involved two belt buckles, registered by the Copyright Office, and which incorporated ornamental features consisting of geometric shapes with "several surface levels" and wavy lines. 632 F.2d at 990. These identifiable ornamental features were found to be conceptually separable from the utilitarian function of the belt buckles. We further note that the Winchester and Vaquero belt buckles reflected sculpted, contoured lines which could not fairly be said to be co-extensive with the entire shape of the buckles; and, the court could visualize the sculpted lines as separate from the usefulness of the belt buckle, without violating congressional intent that useful articles remain without copyright protection. We do not see a parallel to the Kieselstein works in the works at issue here.

In Carol Barnhart, Inc. v. Economy Cover Corp, 773 F.2d 411 (2d Cir 1985), the court invalidated registrations by the Copyright Office on four styles of mannequins on the grounds that the works failed to meet the separability test. In reaching this conclusion, the Court categorized the works as utilitarian, and did not find any separable features that were not essential to the function. You contend that this case supports registration of your client's diffuser products because while there were utilitarian considerations in the shape of the mannequins, there were no such considerations with respect to the diffuser products. (Letter from Caughman to Board of Appeals of 7/11/05 at 9). The Review Board disagrees with your characterization of the diffuser products having no utilitarian considerations. Four of the products are bottles, and are immediately recognized as bottles because of their general shape. While there is a range of various shapes for bottles, as there is for mannequins, they must ultimately conform to certain parameters in order to perform the functions which are intended. The fifth design, the open shape, must surround the bottle and contain holes in order to permit air to reach an open flame but prevent one's fingers from touching the flame. The Review Board believes these products are as utilitarian as the mannequins found uncopyrightable in Barnhart.

You rely heavily on Brandir International, Inc. v. Cascade Pacific Lumber Co., 834 F. 2d 1142 (2d Cir. 1987), a case in which the design in issue, a bicycle rack, was found not copyrightable. The Brandir Court did adopt 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). Because of the possible problems which the Denicola test might engender, premised as it is, at least partly, on subjective perception and on the personal intention of the creator of the work in question, and because such a test might result in 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, the Copyright Office has not adopted this particular alternative separability test. In any event, we note that even accepting the Second Circuit's articulation of the Denicola test, the shapes of the bottles in question could not be considered conceptually separable because it cannot be said that the "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional considerations." 834 F.2d at 1145 (emphasis added). The shape of HUMERY - OPEN WORK SHADE and of the bottles seem clearly to have been influenced by their functions.

Additionally, as explained in Esquire, 591 F.2d at 800, copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be." In that case, the Office had refused to register an outdoor lighting fixture which arguably contained non-functional, purely aesthetic features. The court upheld the Office's refusal, noting that "Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products." *Id.*[4]

You further cite to Pivot Point v. Charlene Products, Inc., 372 F.3d 913 (7th Cir. 2004), in which the Seventh Circuit upheld copyright in a mannequin head. The Review Board has no quarrel with the result reached in that case since the face was sufficiently detailed to be an independently recognizable human visage. Moreover, the court found the head to have been made as a "product of a creative process unfettered by functional concerns." Pivot Point at 932. Your client's works are distinguishable from the protected mannequin head in that the copyright claims are in the general shapes of four bottles and an open shade and there is no basis to consider them to have any independently recognizable sculptural authorship apart from the overall shape of the objects.

You have cited Pivot Point for its discussion of Esquire to argue that Esquire is not useful in speaking of conceptual separability. Letter from Caughman of 7/11/05 at 13-14. We have discussed Esquire, to emphasize that court's references to the history of protection for useful articles and to the legislative history behind the 1976 Act's intention that the overall configuration of a utilitarian article is not the subject of copyright. You point to Pivot Point's statement concerning Esquire that "the court [*i.e.*, the D.C. Circuit] acknowledged that the 1976 Act was 'not applicable to the case before' it, *id.* at 803," and you concluded that it did not believe that the D.C. Circuit would have considered its decision in Esquire to have disposed of the issue of conceptual separability. We point out, however, that the Esquire court, in making this statement, also concluded that the "new Act was designed in part to codify and clarify many of the regulations promulgated under the 1909 Act, including those governing works of art." 591 F.2d at 803. And, Esquire noted that the legislative

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[4] Although *Esquire* was decided under the 1909 version of the Copyright Act, its reasoning is still applicable to cases arising under the 1976 Act. "[T]he 1976 Act and its legislative history can be taken as an expression of congressional understanding of the scope of protection for utilitarian articles under the old regulations." 591 F.2d 803. Since pre-1976 case law in part formed the basis for the 1976 Act, the reasoning of these earlier cases remains relevant to cases arising under the later Act.

history passages cited "indicate unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright." *Id.* at 804. In your request for reconsideration, you have not identified specific features in the works at issue here as separable, either physically or conceptually; and, you have merely argued that the shapes of the diffuser bodies are not dictated by function and that such articles could assume any shape, thus making the particular shapes chosen by the creator of these works to be non-functional. However, you state that parts of the catalytic diffusers "can assume any shape to accomplish their functional tasks." Letter from Caughman of 7/11/05 at 13. The Board has examined the composition of all the works at issue here and does not consider the works to have overcome the fiat expressed by Esquire that no protection is available for the overall design or shape of a useful article, even though it may be created with aesthetic appeal in mind: the works are useful articles and their overall configuration, or parts of their configuration, cannot serve as the basis for registration.

Finally, the Office has not taken the position that Esquire decided, with finality, the issue of conceptual separability. Esquire, a mandamus action, stated only that the overall shape and configuration of a useful article could not be the basis of copyright protection, thus applying the general principle of denying protection to industrial design that Congress found fit to embody within the 1976 Act. We point out, though, that, in its examining function, addressing separability requires the Office to reference to the fact that separability may exhibit itself either physically or conceptually. Comp. II, sec. 5. The reference to physical or conceptual separability was made by the court in Oddzon Products, Inc. v. Oman, 924 F.2d 346 (D.C. Cir. 1991). You cited Oddzon for the proposition that the District of Columbia Circuit court had not, prior to Oddzon, decided the standard for conceptual separability and also for your argument that "the Oddzon court clearly viewed the position of the Copyright Office to be based on the Brandier [sic] decision, and it found no error in such position." Letter from Caughman of 7/11/05 at 16, citing Oddzon, 924 F.2d at 350: "[W]e are satisfied, however, that the Copyright Office was not arbitrary in adhering to a line similar to the one taken by our sister circuit."

We take this opportunity to point out that Oddzon was a case brought under the Administrative Procedure Act, 5 U.S.C. 701-706, and that the court decided only that the Office's refusal to register the work known as KOOSH ball was not an abuse of its administrative discretion in registering claims to copyright. 942 F.2d at 350. The court's reference in its discussion of the analysis of KOOSH ball's composition, for purposes of determining whether the work was subject to copyright, to the Office's refusal reasoning being "similar" to reasoning found in the Brandir decision, cannot be interpreted to mean that the court accepted the Copyright Office's refusal decision because that decision was, in your words, "based on the Brandir decision." The court itself explained that the Office's decision to refuse registration was based on its argument that KOOSH ball "is a useful article and its feel is inseparable from its utilitarian function." 924 F.2d at 349. Notwithstanding the court's arguably implied comparison of the Office's administrative decision to the separability test adopted by the Second Circuit in Brandir, the Office has never utilized any separability test for registration purposes other than those put forward in Compendium II – even if it appears to others that the Office's reasoning for refusing to register a particular work is similar to reasoning found in particular judicial decisions. The Office's separability tests are not found

articulated in Professor Denicola's proffered test nor in the tests proposed by any other commentators.[5]

Your reliance on Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., 851 F. Supp. 222 (E.D. Va 1994), *aff'd*, 74 F.3d 488 (4th Cir. 1996); and Rachel v. Banana Republic, Inc., 831 F2d 1503 (9th Cir. 1987); are also misplaced. In Superior Form, the court upheld the copyrightability of animal mannequins used by taxidermists to mount animal skins. The court found that these specific mannequins, with their positioning of body parts and anatomical detail, were copyrightable sculpture rather than useful articles. Likewise, the synthetic animal heads in Rachel were never regarded as useful articles, so separability was never considered by the court.

4. Aesthetic considerations

Because your requests for reconsideration rest heavily on your assertions that your client's five designs should be registered on the basis of the aesthetic considerations which went into the design of the shape of the five works, we will comment briefly as to Copyright Office policy in this area. (Letter from Caughman to Board of Appeals of 7/11/05 at 3).

The "registrability of a work . . . is not affected by the style of the work or the form utilized by the artist." Compendium II, section 503.01. The question before the Board is not the artistic style adopted by your client in designing the five designs at issue here, but whether the works contain separately identifiable artistic expression. In Mazer v. Stein, 347 U.S. 201 (1954), the Supreme Court held that the "use in industry of an article eligible for copyright" does not prevent the copyright registration of that article. *Id.* at 218. The Mazer principle does not, however, negate the need under Title 17 to identify separable artistic elements within the design of useful articles in order to consider such artistic elements for registration.

The Office applies the same standard of authorship to all types of works without judging the aesthetic merit of the works. Although you contend that your client's products are considered works of art by the public, the Office's analysis of any work is premised upon statutory and regulatory requirements and not on a subjective interpretation of the artistic value of the work. *See, e.g.*, Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903) (courts should not undertake to

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[5] In any event, as noted above in the discussion of Brandir, proper application of the Denicola test would reach the same result. In the case of each of the works here, it cannot be said that the design elements can be identified as reflecting the designer's aesthetic judgment exercised independently of functional considerations. As noted above, the shapes of VERSAILLES, ATHENA, HEART SHAPE 5151, and CRYSTAL FUEL BOTTLE are constrained by those bottles' function of holding scented fuel, and the shape of HUMERY is constrained by the utilitarian purpose of allowing air to reach the flame of the diffuser. Under the Denicola test, "copyrightability ultimately should depend on the extent to which the work reflects artistic expression *uninhibited* by functional considerations." Robert C. Denicola, "Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles," 67 *Minn. L. Rev.* 707, 741 (1983) (emphasis added). Additionally, in the words of the *Brandir* court, "if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements." *Brandir*, 834 F.2d at 1145. While the shape of a work may be novel and aesthetically pleasing, it is nevertheless not copyrightable if it was fashioned even in part in order to allow the device to perform its intended function. Thus, the five works in question here fail the Denicola test because their forms do not, in Professor Denicola's words, "reflect purely aesthetic visions." 67 *Minn. L. Rev.* at 743.

judge the artistic worth of a work of authorship.) *Accord*, H.R. Rep. No. 1476, at 51 (1976) (the standard for copyright protection "does not include requirements of novelty, ingenuity, or esthetic merit.") The Copyright Office does not look for, nor does it reject, any particular "style" of art in its examination; rather, it looks for the presence of separable, copyrightable authorship in useful articles which have been submitted for registration.

5. *De Minimis* authorship

While four of the designs lack elements which could reasonably be characterized as separable, the work CRYSTAL FUEL BOTTLE contains a diamond ornamentation which arguably meets the separability test. However, even if that feature could be regarded as separable, it would be *de minimis* and unable to support a copyright claim.

Copyright Office registration practices have always recognized that some works of authorship have a *de minimis* amount of authorship and, thus, are not copyrightable. *See* Compendium II, 202.02(a). With respect to pictorial, graphic and sculptural works, which are Class VA [visual arts] works, section 503.02(a) of Compendium II states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." Further, there is no protection for familiar symbols, designs or shapes such as standard geometric shapes. 37 C.F.R. 202.1. Compendium II also reflects the principle that creative expression is the basis for determining whether a work is copyrightable, not an assessment of aesthetic merit. Section 503.02(a) of Compendium II states that:

> Copyrightability depends upon the presence of creative expression in a work, and not upon aesthetic merit, commercial appeal, or symbolic value. Thus, registration cannot be based upon the simplicity of standard ornamentation such as chevron stripes, the attractiveness of a conventional fleur-de-lys design, or the religious significance of a plain, ordinary cross. Similarly, it is not possible to copyright common geometric figures or shapes such as the hexagon or the ellipse, a standard symbol such as an arrow or a five-pointed star. Likewise, mere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work. . . The same is true of a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.

The policy reflected in these provisions represents a fundamental principle of copyright law: common ordinary shapes and designs, and minor variations of those, may not be copyrighted because that could limit their availability to the general populace. Basic, common and ordinary shapes, designs and symbols are in the public domain for use by all since they form the building blocks for creative works.

Case law clearly supports the standards applied by the Copyright Office. In John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986), the work was a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below. In Jon Woods Fashions v. Curran, 8 U.S.P.Q.2d 187 0 (S.D.N.Y. 1988), the design consisted of two inch stripes

with small grid squares superimposed upon the stripes. In both of these cases, the number of elements and simple arrangement is roughly equivalent to what is found in the four features you urge are separable and deserving of copyright. Other cases involving similar features found not copyrightable include Magic Market, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F.Supp. 769 (W.D.Pa. 1986)(envelopes printed with solid black stripes and a few words such as "priority message" or "gift check"), and Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F.Supp 964 (E.D.N.Y. 1950)(reproduction of standard fleur-de-lis).

Applying these principles in Homer Laughlin China v. Oman, 22 U.S.P.Q.2d 1074 (D. D.C. 1991), the court affirmed the Copyright Office's refusal to register a commercially successful chinaware design where the Office had concluded that the work was not copyrightable because "familiar shapes and symbols are not copyright nor are simple variations or combinations of basic geometric designs capable of supporting a copyright registration." 22 U.S.P.Q.2d at 1075 (brackets omitted). As the court observed, "[w]hether a particular work reflects a sufficient quantum of creativity to satisfy the copyright laws is not susceptible to bright line rules or broad principles." The court continued that "in determining creativity, such a decision necessarily requires the exercise of informed discretion, and the Register, in part due to having to make such determinations on a daily basis, is generally recognized to possess considerable expertise over such matters." *Id.*

In the work CRYSTAL FUEL BOTTLE, a repetitive diamond pattern design is etched into the glass at both the top and bottom of the bottle. This diamond pattern is both familiar and commonplace. The Review Board concludes that under Copyright Office practices and related court decisions this ornamentation is *de minimis*, and therefore cannot serve as a basis for copyright registration.

IV. CONCLUSION

For the reasons stated above, the Copyright Office Review Board concludes that the five designs relating to diffuser products cannot be registered for copyright protection. This decision constitutes final agency action.

Sincerely,

/s/

David O. Carson
General Counsel
for the Review Board
United States Copyright Office