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September 17, 2012

Via First Class Mail and Fax

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RE: ROUND FLUTED
TULIP -OPEN-WORK SHADE
Control Number: 61-313-6927(K)

Dear Mr. Caughman:

On behalf of the Copyright Office Review Board, I am responding to your June 27, 2005 letter requesting a second reconsideration of the Office's refusal to register two claims to copyright in products relating to catalytic diffusers. We apologize for the lengthy delay in responding to your request. 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.

A. REPRESENTATIONS OF THE WORKS

The works involved in this reconsideration are as follows:

1. ROUND FLUTED



2. TULIP -OPEN-WORK SHADE



Because the arguments made in our second request for reconsideration are identical to the arguments you made by you on behalf of Produits Berger, S.A. in a similar request for reconsideration submitted shortly after the instant request (see our letter dated September 14, 2012 regarding VERSAILLES, ATHENA, HEART SHAPE 5151, CRYSTAL FUEL BOTTLE, AND HUMMERY - OPEN WORK SHADE, Control No. 61-313-2210(K)), our discussion in this letter will be confined to a recitation of the pertinent facts from the

Administrative Record. For the same reasons set forth in our letter relating to VERSAILLES et al., the Board affirms the decision to refuse to register ROUND FLUTED and TULIP-OPEN WORK SHADE.

II. ADMINISTRATIVE RECORD

A. Initial submission

The Copyright Office received two form GATT applications to register two works relating to catalytic diffusers on May 20, 2004. The year date of publication of these works was 1976. In a letter dated August 11, 2004, Senior Examiner Geoffrey Henderson refused to register the two designs on the ground that the items were useful articles which did not contain any separable features that were copyrightable. Mr. Henderson explained that GATT registration for "restored works" could only be made if the works contained copyrightable authorship. (Letter from Henderson to Caughman of 8/11/04, at 1). He stated that the design of a useful article could be considered a copyrightable 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. He stated that the legislative history confirms that separability may be physical or conceptual. *Id.* at 1.

After citing provisions in Compendium II, Copyright Office Practices (1984) ("Compendium II") explaining Copyright Office practices with respect to physical and conceptual separability, Mr. Henderson concluded that while both designs contained features that could be identified as "separable," those features were not copyrightable. *Id.* at 2. He stated that copyright does not extend to ideas, concepts, familiar symbols or designs, citing the copyright statute, and Copyright Office regulations. He concluded that the separable elements were not copyrightable because they represented an insufficient amount of original authorship. *Id.* at 2.

B. First Request for Reconsideration:

In a letter dated December 3, 2004, you requested reconsideration of the Office's refusal to register the two designs. 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 12/3/04 at 2). The diffusers consist of a bottle which holds 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 exhibit 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), holding 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), holding 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 (2d 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 (2nd 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 regarding useful articles were printed 20 years ago, and did not take into account recent precedents. *Id.* at 12.

You further asserted that the two works contained the necessary element of creativity. You cited Feist Publications, Inc. v. Rural Tel.. Serv. Co., 499 U.S. 340 (1991) as evidence that the quantum of originality and creativity required to support copyright is extremely low. That case further provided that the requirement of originality means only that the work was independently created by the author and that it possess at least a minimal degree of creativity. *Id.* at 13-14. While the Supreme Court held that the arrangement of names in a Tel. book in alphabetical order did not possess the "minimal creative spark" required for copyright protection, you argued that your client's works were distinguishable on the grounds that the work could take any shape. *Id.* at 15. You also asserted 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 15.

After reviewing your first request for reconsideration, Examining Division Attorney Adviser Virginia Giroux responded in a letter dated March 2, 2005. She upheld the refusal to register two works because they are useful articles that do not contain any authorship that is both separable and copyrightable. (Letter from Giroux to Caughman of 3/2/05, at 1.) Ms. Giroux stated that your letter did not dispute that the works have a functional use. She claimed that you supported registration on the grounds that the works contain non-functional design elements based on the designer's aesthetic judgment rather than utilitarian concerns. *Id.* at 1. That fact, she concluded, does not place the works outside of the useful article category because the copyright law provides that a useful article need only have "an intrinsic function." 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.

Ms. Giroux explained that in examining a work in the useful article category, one 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 the shape of the article. *Id.* at 1-2.

Ms. Giroux stated that the Copyright Office follows the test for conceptual separability which is set out in Compendium II, rather than the test articulated in Brandier Int'l, 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.

Turning to the works at issue, Mr. Giroux stated that the works consist of a bottle that holds scented fuel and an open-work shade, which was a device placed over the bottle to keep people from burning their hands on the flame coming from the bottle. Ms. Giroux concluded that even if the fluted design on the surface of the bottle, and the circulated and teardrop cutouts on the surface of the open-work shade are considered conceptually separable from the utilitarian aspects, they do not create a copyrightable work of art. *Id.* at 3.

Finally, she concluded that neither Feist Publications v. Rural Tel. Serv. 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), support registration of the two designs. While Feist confirmed that the requisite level of creativity is very low, applying the standard to useful articles first requires 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 two 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 are 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 June 27, 2005, you requested a second reconsideration of the Office's refusal to register the two designs. You repeat the statement made in your first letter of reconsideration regarding the nature of your client's catalytic diffuser products. (Letter from Caughman to the Board of Appeals of 6/27/05 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 begin 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 that a work of art, which is applied to a specific industrial use, can still retain copyright protection under U.S. law. *Id* at 7. You discuss next 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 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 Int'l, 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 works are not dictated primarily by functional characteristics, they meet the test applied by the Second Circuit in Brandier. *Id.* at 10-13.

In addressing the shapes of the two works involved in this case, you state that they are not dictated by function. *Id.* at 12. Indeed, you assert that one of the primary purposes of the works is to serve as objects of art, and many customers collect the products for that reason alone. All that is required for the diffusers to function is a vessel which is able to hold a fluid which is burned through the ceramic burner located on the

top of the vessel. Both the vessel and the open shade, can assume any shape to accomplished their functional tasks. *Id.* at 13.

You further cite to Pivot Point Int'l, 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 meets 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 additionally repeat the arguments based on Feist Publications v. Rural Tel. Service Co. and Bleistein v. Donaldson, noted above at pages 3-4.

III. DECISION

As noted above, your second request for reconsideration is virtually identical to the second request for reconsideration you submitted with respect to VERSAILLES et al., which is the subject of a separate letter from the Review Board. Rather than repeat the Board's reasoning verbatim, the Board adopts that reasoning and by this reference incorporates it herein. The Board will only add the following observations relating specifically to ROUND FLUTED and TULIP.

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

A. ROUND FLUTED

The work ROUND FLUTED is a round bottle with a long neck. The surface of the bottle is ornamented with a fluted design, and tear drops at the top of the neck. The Review Board sees no three-dimensional sculptural element on which registration can be considered, and your letters for reconsideration identify no such element. Even if the tear drop and fluted ornamentation could be characterized as "separable," these two elements are *de minimis*.

In ROUND FLUTED, a repetitive fluted pattern design is etched into the glass, beginning at the bottom of the bottle, and raising to the neck of the bottle. At the neck, a teardrop ornamentation is etched near the opening of the bottle. Both the fluted pattern and teardrop ornamentation is 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.

B. "TULIP" -open- work shade

The design is circular in shape and includes a top. The sides consists of 8 or 9 large teardop holes arranged around the circumference. These holes have the utilitarian purpose of allowing air to reach the flame of the diffuser. The circular top has one circle hole in the center of the top, and six circular holes arranged between the center and the edges. 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 cannot be considered in determining the registerability of the open shade. Since there are no other elements in this work that are arguably separable, the Review Board concludes that the design can not be registered.

IV. CONCLUSION

For the reasons stated above and in our letter affirming the refusal to register VERSAILLES et al., the Copyright Office Review Board concludes that the two designs relating to diffuser products cannot be registered for copyright protection. T his decision constitutes final agency action.

Sincerely,

/s/

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