United States Copyright Office
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February 22, 2013

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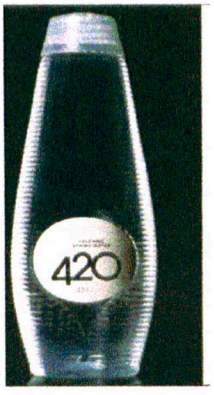
RE: 420 BOTTLE DESIGN
Copyright Office Control Number: 61-502-9393(W)

Dear Mr. Wick:

I am writing to you on behalf of the Copyright Office Review Board (hereinafter "Board") in response to your letter dated June 13, 2008, in which you requested the Copyright Office (hereinafter "Copyright Office" or "Office") to reconsider, for a second time, its refusal to register the work entitled 420 Bottle Design. We apologize for the long delay in resolving this case and providing you with the determination of the Board. Nevertheless, the Board has carefully examined the application, the deposit, and all correspondence concerning this application, and hereby affirms the denial of registration.

I. DESCRIPTION OF WORK

The subject work is a bottle for 42 Below Limited's 420 spring water. The design of the bottle is described as "a lava lamp with a mountainous shape, evoking the impression of the crystal pure spring water which flows from the volcanic springs which are the source of the water; and the circular engravings of the design [which] further evoke the pure, volcanic source of water falling onto the extinct volcano and swirling around into its below-surface springs, from which it eventually is removed, contained and delivered for consumer enjoyment." Letter from Lawrence S. Wick to Chief, Receiving and Processing Division (Nov. 26, 2007), at 3. The bottle also has a smooth circular area where the 420 label is attached. The exact design and shape of the bottle for the 420 spring water is best communicated by the visual representation below.



I. ADMINISTRATIVE RECORD

A. Initial application and Office's refusal to register

On June 26, 2007, the Office received a Form VA application from you on behalf of your client, 42 Below Limited, to register a "3-dimensional sculpture" entitled 420 Bottle Design. In a letter dated September 6, 2007, Visual Arts Section Examiner Joy Burns, refused registration of this work because she determined that it was a useful article that did not contain any separable authorship needed to sustain a claim to copyright. Letter from Joy Fisher Burns to Lawrence S. Wick (Sept. 6, 2007), at 1.

Ms. Burns noted that while pictorial, graphic, and sculptural works are registrable, designs of useful articles can be considered as pictorial, graphic, or sculptural works only if, and to the extent that, they incorporate such features that can be separately identified from and exist independently from the utilitarian aspects of the article, either physically or conceptually. *Id.*

Ms. Burns then explained the requirements for conceptually separable authorship, referencing the *Compendium of Copyright Office Practices*, *Compendium II* (1984) (hereinafter (*Compendium II*'), and clarified that separability is not met by analogizing the general shape of a useful article to a work of modern sculpture. In such cases, the alleged artistic features and the useful article cannot be perceived as having a separate, independent existence. She further noted that where the features are an integral part of the overall shape or contour of the useful article, no registration is possible. Finally, Ms. Burns examined the copyrightability of the work you deposited and determined that all the elements of the work were either related to the utilitarian aspects or function, or were subsumed within the overall shape, contour, or configuration of the article such that there could not be physical or conceptual separability. *Id.* at 2.

B. First request for reconsideration

In a letter dated November 26, 2007, you requested reconsideration of the Office's refusal to register the 420 Bottle Design. Letter from Wick (Nov. 26, 2007), at 1 ("First Request"). You argued that the subject design can be identified as existing independently of the utilitarian aspect of the bottle and that it contains separable, identifiable authorship. *Id.* at 2. You then identified that the conceptually separable, identifiable design of the water bottle is that of "a lava lamp with a mountainous shape" with circular engravings that evoke the "pure, volcanic source of the water falling onto the extinct volcano and swirling around into its below-surface springs." *Id.* at 3. In support of your argument for conceptual separability, you asserted that the public has identified the design as separable from the utilitarian elements because the bottle design has received several awards and the media has written articles describing the bottle as a "distinctive lava-lamp" and "resembling a lava lamp." *Id.* at 4. You also argued that, compared to other copyright registrations for bottle designs, the 420 bottle's identifiable design is conceptually separable in the same way as the engraving of the tree and building on the Belvedere vodka bottle referenced in your letter,

and therefore, meets or exceeds Office registrability standards. *Id.* at 5.

C. Examining Division's response to First Request for Reconsideration

In response to your request and in light of the points raised in your letter of November 26, 2007, Attorney Advisor Virginia Giroux-Rollow of the Examining Division (now part of the Copyright Office's Registration and Recordation Program) reviewed the application, and she, too, determined that 420 Bottle Design was a useful article that did not contain any authorship that is both separable and copyrightable. Letter from Virginia Giroux-Rollow to Lawrence S. Wick (3/17/2008), at 1 ("Giroux-Rollow letter"). First, she noted that the fact that a useful article can also serve as a "work of art" and has won several awards does not take it out of the "useful article" category. *Id.* She also explained that "[a]n article that is part of a useful article is considered a useful article" and is not copyrightable unless it has any pictorial, graphic, or sculptural authorship that is either physically or conceptually separable from the utilitarian aspects of the article. *Id.*, citing 17 U.S.C. § 101.

The Copyright Office's test for conceptual separability, Ms. Giroux-Rollow explained, is enunciated in *Compendium II*, Copyright Office Practices, § 505.03 which follows generally the separability principle set forth in *Esquire v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978). She noted that this test generally finds conceptually separable features where sculptural features are recognizable as a work which can be visualized on paper as a free-standing sculpture, juxtaposed next to the useful article, without destroying the shape of the article itself. Giroux-Rollow letter at 2. She further explained that the test for conceptual separability is not met by analogizing the general shape of a useful article to works of modern sculpture. *Id.*

Ms. Giroux noted that with the exception of where the label would normally attach, there are no other design elements that could be conceptually perceived as separable from the bottle itself without destroying its basic shape. *Id.* at 2-3. She noted that the sculptural elements, which included the lava lamp design and the circular grooves, were all part of the overall shape of the bottle itself, and as such, are not copyrightable. *Id.* She also explained that the fact that a design is aesthetically pleasing or may convey a certain impression such as volcanic springs, are not relevant for determining copyrightability. *Id.* She stated that unless the work contains a sufficient amount of original and creative artistic or sculptural authorship that is both separable and copyrightable, no registration is possible. *Id.*

Ms. Giroux also explained that each work is examined independently and the Office does not compare works under consideration with works that have already been registered or refused registration. Giroux-Rollow letter at 3. Nevertheless, she noted that the nine copyright registrations for designs used on bottles, which you referred to in your letter, presumably contained a sufficient amount of original and creative, artistic authorship on their surfaces that was consistent with the standards set forth in *Feist Publications, Inc. v. Rural Telephone Services Co.*, 499 U.S. 340 (1991). *Id.* In comparison, she noted that 420 Bottle Design does not meet those standards. *Id.*

Before concluding, Ms. Giroux-Rollow returned to the issue of useful articles. She offered an extended quotation from the legislative history of the Copyright Act of 1976, which explains that absent any independent and separable design elements, copyright protection is not to be offered to useful articles, regardless of any aesthetic considerations that went into their creation. *Id.* at 4, citing H.R. REP. NO. 94-1476 at 55 (1976) (the "Report"). She emphasized the Report's statement that even if a 3-dimensional design contains a separable element, "copyright protection would extend only to that element and would not cover the overall configuration of the utilitarian article as such. *Id.*

Finally, Ms. Giroux-Rollow concluded her letter with the determination that because all of the elements embodied in the bottle design are **either related** to the utilitarian aspects or function of the works, **or, if separable**, do not contain a sufficient amount of original and creative authorship, **or are subsumed within** the overall shape, contour, and configuration of the bottle itself, there is no separable authorship. *Id.*

D. Second Request for Reconsideration

In a letter dated June 13, 2008, you requested that the Office reconsider, for a second time, its refusal to register the copyright claim in the work 420 Bottle Design. Letter from Lawrence S. Wick (June 13, 2008), at 1 ("Second Request"). You stated that you are not trying to register a bottle, which you acknowledge is a useful article, but separable, sculptural designs for the bottle. *Id.* at 4, 6. Specifically, you stated that "what applicant seeks to register are the original, fanciful designs or artwork which are imprinted on, or molded or sculpted into [] the bottle." *Id.* at 5. The design elements of the bottle that you claim are conceptually separable are that of a lava lamp with a mountainous shape and the circular engravings on the bottle. *Id.* at 6. In support of your contention, you cited *Pivot Point Int'l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913 (7th Cir. 2004), for the proposition that "conceptual separateness exists when the artistic aspects of a useful article can be conceptualized, intellectually or mentally, as existing independently of the utilitarian function."

You also reiterated your arguments that recognition by the press that the 420 bottle design resembles a lava lamp and that the work has been awarded international design awards is probative of conceptual separability and copyrightability. *Id.* at 7. In addition to avoid any ambiguity concerning the basis of the claim, you have offered to amend the title to "420 Design" and the description to "Design applied to water bottle." *Id.* at 8. As evidence of conceptual separability and originality you have submitted accompanying exhibits that include marketing material for the water bottle, news articles discussing the water bottle, an affidavit from a company executive, awards for the bottle's design, and examples of other copyright registrations for designs used on bottles. *Id.* at Exhibits A-K.

Moreover, you argued that the Office must base its registration decision on the evidence submitted in the record (i.e., the nine examples of copyright registrations you have referenced in your letter and attached in Exhibit H). *Id.* at 8-9. You then declared that the evidence in the record, together with the Declaration of Mr. Sinclair, supports registration

under the *Feist* standard, stating that "considerable time, effort, and money has been spent by the applicant in design development and production of the finished design shown in the application." *Id.* at 9. Finally, you questioned the Office's decision making process for copyright registration claiming, *inter alia*, that the Office may not base its decisions on its expertise, that it must compare previously registered works, and that it should apply the "Rule of Doubt" to your application. *Id.* at 9-12.

III. DECISION

After reviewing the application and arguments in favor of registering Applicant's work, the Board upholds the Examining Division's decision to refuse registration of 420 Bottle Design. The Board determines that the work, 420 Bottle Design, is a useful article and has no artistic elements separable from the utilitarian function of the bottle.

A. Useful Articles and Separability

A useful article is defined as "an article 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. However, works of artistic craftsmanship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic, or sculptural works pursuant to section 102(a)(5) of the Copyright Act. This protection is limited, though, in that it extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* You do not dispute that the water bottle is a useful article. Second Request at 6. As a useful article, the work is subject to the separability analysis that copyright law requires. Changing the title in the registration to "420 Design" and amending the description to "Design applied to water bottle" does not change the application of the separability analysis. The purpose of the separability analysis is to ensure that utilitarian aspects of useful articles are not registered since they are not subject to copyright protection.

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 or features 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 . . . 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 aesthetic (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).

1. Separability Tests

Physical separability means that the subject pictorial, graphic, or sculptural features must be able to be separated from the useful article by ordinary means. *Compendium II,* §§ 505.03, 505.04. Conceptual separability means that the subject features are "clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as a free-standing sculpture, as 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. *Compendium II,* § 505.03. For example, while a carving on the back of a chair cannot readily be physically separated from the chair, it can easily be conceptually separated because one could imagine the carving existing as a drawing. The chair, meanwhile, would still remain a useful article having retained its basic shape, even absent the carving. The carving would, therefore, qualify as conceptually separable.

Moreover, as *Compendium II,* § 505.03, further explains:

> The test of conceptual separability, however, is not met by merely analogizing the general shape of a useful article to works of modern sculpture, since the alleged "artistic features" and the useful article cannot be perceived as having separate, independent existences. The shape of the alleged "artistic features" and of the useful article are one and the same, or differ in minor ways; any differences are *de minimis. The mere fact that certain features are nonfunctional or could have been designed differently is irrelevant under the statutory definition of pictorial, graphic, and sculptural works.* (emphasis added)

Section 505 of *Compendium II*, as quoted above, is a direct successor to the Copyright Office regulation that was affirmed in *Esquire,* 591 F.2d 796. The Office relies on the authority of *Esquire* for the analysis it follows to determine whether pictorial, graphic, or sculptural works are separable from the utilitarian objects in which they are incorporated. As explained in *Esquire,* copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be." *Id.* at 800. In *Esquire*, the Office 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."[1] *Id.* Similarly in *Norris Industries, Inc. v. International Telephone & Telegraph Corp.*, 696 F.2d 918, 924 (11th Cir. 1983), the court held that a wire-spoked wheel cover was not entitled to copyright protection because it was a useful article used to protect lug nuts, brakes, wheels, and axles from damage and corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself.

2. *Custom Chrome*

The validity of the Office's use of the *Compendium II* test was confirmed in an action against the Copyright Office in *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995). In *Custom Chrome*, the court held that the Office's determination, under the Office's separability test found in *Compendium II*, that the motorcycle parts did not contain separable features, was reasonable and consistent with the copyright statute and with "declared legislative intent." *Id.* at 1717. The court did not determine which of the several separability tests available from legal scholars and from case law is the correct one to apply. However, the court declared that "so long as the Copyright Office has offered a reasonable construction of the copyright statute, its judgment must be affirmed even if this court were to accept Custom Chrome's assertions that [another] test would support its copyright claims." *Id.* at 1718. As we have stated above, the Copyright Office follows the articulation of conceptual separability set forth in *Esquire* and as explained in *Compendium II,* § 505.03 to determine whether an element of a useful article is registrable.

We point to *Custom Chrome* to emphasize that *Compendium II's* separability test, centering on the general shape of the useful article, is consistent with "the holding in *Esquire*, later cases decided under the present law, and the legislative history" in denying protection to the shape of an industrial product even though it may be aesthetically pleasing. *Id.*

The Board also notes that *Custom Chrome* was an action brought under the Administrative Procedure Act ("APA") based on an assertion that the Copyright Office's action refusing registration for twenty-three motorcycle parts was arbitrary, capricious, an abuse of discretion, and otherwise not in accordance with the law. 35 U.S.P.Q.2d at 1714. The District Court for the District of Columbia determined that under the APA, abuse of discretion is the appropriate standard for reviewing the Copyright Office's decision to refuse copyright registration. *Id.* at 1717; *see* 5 U.S.C. § 706(2)(A). Under this standard of review, the Office's decision is entitled to "great weight" because the Office possesses "considerable expertise in this area." *Id.*; *see also Darden v. Peters*, 488 F.3d 277, 283 (4th Cir. 2007) (applying abuse of discretion standard because the "Register's denial of a copyright registration application is, by the statute's plain terms, an action taken by the Register under

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[1] Although *Esquire* was decided under the 1909 version of the Copyright Act, its reasoning is, nevertheless, 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 at 803.

the Copyright Act "); *Norris*, 696 F.2d at 922 ("The expertise relied on is not technical expertise in the use of the article . . . but expertise in the interpretation of the law and its application to the facts presented by the copyright application.").

Nevertheless, you have argued that it is impermissible for the Office to base its registration decisions on agency expertise, rather than on admissible evidence which has been placed in the record. Second Request at 9, citing *Brand v. Miller*, 487 F.3d 862 (Fed. Cir. 2007). The Board disagrees. Unlike the cases where the determinations of the Copyright Office not to register a work have been reviewed under the "abuse of discretion" standard, 5 U.S.C. § 706(2)(A), in *Brand*, the court determined that the appropriate standard of review was substantial evidence. *Id.* at 868. The court found that the substantial evidence standard of review applies in cases subject to sections 556 and 557 of the APA and cases that are "reviewed on the record of an agency hearing provided by statute." *Id.* Clearly, *Brand* does not apply to Copyright Office registration decisions for several reasons. First, *Brand* was a case regarding a *patent* registration decision of the Board of Patent Appeal and Interferences ("BPAI") and is thus distinguishable from a copyright registration decision of the Copyright Office. Second, the statute governing decisions of the BPAI, 35 U.S.C. § 144 (2000), requires that these decisions be taken "on the record before the Patent and Trademark Office." The Copyright Act, which governs the registrability of a work, does not specify that the Office's registration decisions be "reviewed on the record of an agency hearing." Administrative Procedure Act, 5 U.S.C. § 706(2)(E) (2000). Additionally, decisions by the Office to register a copyright are not cases subject to sections 556 and 557 of the APA, which govern formal hearings by an agency. Simply put, the Office does not operate like a court when making registration decisions.

B. 420 Bottle Design Fails the *Compendium II* Test for Separability

As we have discussed above, the Copyright Office is guided by *Esquire* with respect to the shape of useful articles. Relying on explicit statements in legislative history, the *Esquire* court held that, despite an aesthetically pleasing, novel, or unique shape, the overall design or configuration of a utilitarian object may not be copyrighted unless it is "capable of existing as a work of art independent of the utilitarian article into which [it is] incorporated." 591 F.2d at 803-04. The artistic elements can exist independently of a useful article if they are physically or conceptually separable from the utilitarian aspects of the article. Your second request for reconsideration addressed conceptual separability; you acknowledged that the design is not physically separable from the bottle. Second Request at 6. You have also admitted that the bottle itself is a useful article, but have taken the position that "the design used on [the bottle] is a separably identifiable conceptual design." *Id.* We apply the Office's *Compendium II* test as we analyze the possible conceptually separable features of the 420 bottle.

The *Compendium II* test allows conceptual separability to be a basis for registration, and does not involve judgments of "artistic merit." The registrability of a work does not depend upon artistic merit or aesthetic value. *Compendium II*, §503.01. Under the *Compendium II* test, the Office examines the elements in a useful article that are clearly

recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper—the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. *Id.* at § 505.03.

You have argued that the conceptually separable identifiable elements are a lava lamp design with a mountainous shape and circular engravings. Second Request at 6. These elements cannot be conceptually separated from the bottle itself. The lava lamp design with a mountainous shape and the circular engravings cannot be imagined separately and independently of the bottle without destroying the bottle's basic shape. While the bottle may be novel and aesthetically pleasing, the bottle is created to serve a purpose as a storage container for water. Thus, these elements are part of the overall configuration of a useful article; the design defines the physical shape of the 420 bottle. As discussed above, Congress did not intend to protect the shape of an industrial product although it "may be aesthetically satisfying and valuable." H.R. REP. NO. 94-1476, at 55. See also, *Inhale, Inc. v. Starbuzz Tobacco, Inc.,* 2012 WL 2321573 (C.D. Cal. 2012) (finding that the shape of a hookah water container not to be copyrightable because the container's shape, even if it had been designed differently, is not separable from its utilitarian elements) and *Ets-Hokin v. Skyy Spirits, Inc.,* 225 F.3d 1068 (9th Cir. 2000) (finding blue Skyy Vodka bottle "although attractive, has no special design or other features that could exist independently as a work of art.").

In your second request for consideration you point to other examples in which the Office has granted copyright registration: designs on master molds (*S-K Potteries and Mold Co. v. Sipes*, 192 U.S.P.Q. 537 (N.D. Ind. 1976); a dog-shaped design for plastic molded toy coin banks (*Royalty Designs, Inc. v. Thriftcheck Service Corp.*, 204 F. Supp. 702 (S.D.N.Y. 1962); and nine copyright registrations for artistic works used on bottles. Second Request at 10-11. The Office does not compare works under consideration with works that have already been registered or refused registration. *Compendium II,* § 108.03. Each article is examined independently and on its own merit. Therefore, whether the Office has registered other designs used on bottles is not relevant because the Office uses the *Compendium II* test to determine whether artistic features of a useful article are copyrightable. In fact, in *Esquire*, the court noted the subjectivity of the Office's test for analyzing useful articles and stated that "given the large volume of copyright applications that must be processed there may be some results that are difficult to square with the denial of registration [of the lighting fixture at issue]," referring to the very registrations that are subject of the cases you cited here as examples of registrable works.

Furthermore, your argument that the works in question here are perceived as works of artistic craftsmanship in the marketplace, Second Request at 6-7, does not persuade us otherwise.[2] As we have explained, unusual or aesthetically pleasing objects are eligible for

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[2] We also note that you have offered evidence in your second appeal that the process of designing the 420 Bottle Design took into consideration the "need to make it easier for consumers to differentiate their product in the marketplace." Letter from Wick (June 13, 2008), Declaration of John Sinclair, Executive Director of 42 Below Limited and its wholly owned subsidiary 420 Spring Water Limited, at Exhibit K, ¶ 11-14. Because the Office's determination of registrability does not evaluate circumstances outside the

copyright protection only to the extent that they exhibit features which meet the Office's separability tests and are based upon the plain language and legislative history of the Copyright Act. *See Compendium II,* § 503.01 ("the registrability of a work does not depend upon artistic merit or aesthetic value.").

You have also argued that in *Norris,* the work at issue, the wheel cover, did not receive a copyright registration because Norris "did not offer any evidence whatever [sic] to contradict the examiner's decision." Second Request at 10. The issue in *Norris* was not whether Norris provided enough evidence, but whether the wheel covers were useful within the meaning of the copyright law, and if there was any separable artwork that was copyrightable. 696 F.2d at 919. The court held that a wire-spoked wheel cover was not entitled to copyright protection because it was a useful article used to protect lugnuts, brakes, wheels, and axles from damage and corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself. *Id.* at 924. The 420 Bottle Design, like the wheel cover in *Norris*, does not contain any artistic features that are separable from the bottle itself.

Based on the above analysis, the Board finds that the 420 Bottle Design is not copyrightable because the artistic elements you have identified—the lava lamp design with a mountainous shape and with circular engravings—are the very elements that define the shape of the bottle and, therefore, not conceptually separable from the utilitarian aspects of the useful article.

C. 420 Bottle Design also Fails the Denicola/*Brandir*/*Pivot Point* Test for Separability

Judging a creator's intent, given the factual circumstances of creation, and determining whether design elements in a particular work reflect "the designer's artistic judgment exercised independently of functional influences," is not the type of judgment the Office normally undertakes in its examining process. Such judgments would necessarily rely on interpreting the specific actions surrounding the creation of a work; these actions occur outside the registration process. Any investigation and questioning of the method and circumstances of creation lie beyond the administrative capability of the Office. *See, e.g.*, *Compendium II*, §108.05. Thus, the Office uses as its tests for separability those adopted in *Esquire* and found in *Compendium II*, in carrying out its mandate of section 410(a) of the Copyright Act to examine works submitted for registration under the copyright law. However, judicial acceptance of separability tests other than those found in *Compendium II* prompts us to analyze the work in question here under the alternative test you have raised in order to determine as objectively as possible whether the work at issue here, 420 Bottle Design, possesses any separable features which might be subject to copyright registration.

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registration process and its application of the statute, any statement explaining the process by which a work is created has no bearing on the analysis of a work under the *Compendium II* test for separability.

In your second appeal of the Office's decision to refuse registration for 420 Bottle Design, you cited *Pivot Point*, 372 F.3d at 931 (affirming *Brandir Int'l. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987)) and argued that "[t]he copyrightability of the [420 Bottle Design] is based on the designers' efforts and success in portraying the purity and lava-welling nature of the water." Second Request at 6. While an author's artistic judgment may influence design elements, those elements must themselves also meet the requirements of separability and originality. Having analyzed 420 Bottle Design under the provisions of *Compendium II's* tests for separability, and finding that the work does not have conceptually separable features, we now turn to the alternative separability test articulated in *Brandir/Pivot Point.* The test under *Brandir/Pivot Point* requires copyright protection in a useful article to depend on "whether the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." *Brandir*, 834 F.2d at 1145.

You have raised the Seventh Circuit's decision in the influential *Pivot Point* case, which you have also cited as support for the separability of the enumerated features of 420 Bottle Design—a lava lamp with a mountainous shape and circular engravings. *Pivot Point* adopted the test articulated in *Brandir*, which in turn was derived from an influential law review article written by Professor Robert C. Denicola.[3] *See* Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983). Under the Denicola test, "copyrightability ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations." *Id.* at 741. In the words of the *Pivot Point* court, "If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists." *Pivot Point*, 372 F.3d at 931. Conversely, when the design of a useful article is "as much the result of utilitarian pressures as aesthetic choices, the useful and aesthetic elements are not conceptually separable." *Id.* (quoting *Brandir*, 834 F.2d at 1147); *see also Brandir*, 834 F.2d at 1145 ("[I]f 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.").

You have asserted that the artistic features of the work are conceptually separable from the utilitarian features of the article and are thus subject to copyright protection. Second Request at 6. However, what you identify as the separable elements, *i.e.*, the lava lamp shape of the bottle with the circular engravings, are the functional contours of the bottle. Such features are part of the overall shape and configuration of the bottle and, as such, cannot be separated from the bottle as a useful article. Under the Denicola test, the listed aspects of the bottle are integral to the bottle itself—subsumed within the bottle—and thus part of something that has utilitarian purpose. The elements of the bottle are functional, in that it allows an individual to use the article—to grasp it, to hold it, to drink water from it,

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[3] We note that the bicycle rack that was the work in question in *Brandir* ultimately failed the Denicola test: "[W]hile the rack may have been derived in part from one or more 'works of art,' it is in its final form essentially a product of industrial design." 834 F.2d at 1147.

which are functions fulfilled by 420 bottle's design itself.[4] Therefore, the aesthetic elements of the bottle are part of an object that essentially serves a purpose.

Viewed in this light, the work 420 Bottle Design is, in its entirety, a useful article; all of its features, including its shape, are part of a single unit. The aesthetic elements of the bottle do not negate its usefulness and facility to function as such. Although the article's design may be aesthetically pleasing, and though it could have been designed differently, it is nevertheless created in a way that allows the bottle to contain spring water and the user to drink from it. Thus, 420 Bottle Design fails the Denicola test because its form does not, in Professor Denicola's words, "reflect purely aesthetic visions." Denicola, *supra*, at 743. At best, the artistic aspects of the 420 Bottle Design "reflect a merger of aesthetic and functional considerations," and thus "cannot be said to be conceptually separable from the utilitarian elements." *Brandir,* 834 F.2d at 1145.

D. Standard for Creativity

In your second request for reconsideration, you argued that the 420 Bottle Design contains the requisite level of creativity sufficient for copyright registration because "[c]onsiderable time, effort and money has been spent by the applicant in design development and production of the finished design." Second Request at 9. While we need not reach this issue given our disposition on the separability question, the Board finds that 420 Bottle Design does not meet the standard for creativity. To merit copyright registration, an artistic feature that is separable must also be an "original work of authorship," and this requires that the work contain a modicum of creativity. 17 U.S.C. § 102(a) (2000); *see, e.g.*, *Feist*, 499 U.S. at 362. Whether the author spent time, effort, and money does not evidence creativity. In fact, the Supreme Court in *Feist* specifically rejected the "sweat of the brow doctrine," finding that the copyright laws only protect "original works of authorship" and not the fruits of research. 499 U.S. at 354-55.[5]

Additionally, the Copyright Office, as well as the courts, have consistently found that standard designs and geometric shapes are not sufficiently creative in themselves to support a copyright claim. *Compendium II*, § 503.02; *see Feist*, 499 U.S. at 358 ("[T]he statute envisions that there will be some fact-based works in which the selection, coordination, and arrangement are not sufficiently original to trigger copyright protection."). The lava lamp is

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[4] *See* Letter from Wick (June 13, 2008), at Exhibit D, Georgina Bond, *420 Way to Go When it Comes to Water*, http://www.nzherald.co.nz/topic/story.cfm?c_id=362&objectid=10127696 (last visited Oct. 16, 2008) (depicting a photo of a man holding the 420 water bottle and drinking the water from it). We also note that you provided evidence that Linkplas, one of the designers of the 420 bottle, tweaked the bottle design "to get to commercial manufacture." *Id.* at Exhibit G.

[5] Copyright laws in other countries, such as New Zealand, also require that a work be original to qualify for a copyright. Copyright Act, 1994, No. 143, s. 14(1) (N.Z.). We note that while New Zealand copyright law finds originality based on the labor, skill, and capital of a maker that was devoted to the production of the work, U.S. copyright law examines the originality of the work itself and not the process by which the work was created. *See Henkel KGaA v. Holdfast NZ Ltd.,* [2007] 1 N.Z.L.R. 336.

a standard design and the circular engravings consist of common and familiar geometric shapes, or minor variations thereof, existing in the public domain. Furthermore, merely combining uncopyrightable elements does not automatically establish creativity where the combination or arrangement itself is simplistic or trivial. *See Compendium II*, § 503.02(b) ("[T]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations."); *see also Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951) ("All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"). The 420 Bottle Design consists of a standard lava lamp design with linear variations in the form of geometric circular engravings. Such a simplistic combination of two uncopyrightable elements does not exhibit the level of creativity necessary for copyright registration.

E. Rule of Doubt

Finally, in your second request for reconsideration, you argued that the "Rule of Doubt" requires the Office to "register the applicant's claim to copyright even if there is reasonable doubt that the material deposited for registration constitutes copyrightable subject matter." Second Request at 12. We disagree with your position. Under the Rule of Doubt, the Copyright Office will register a claim even though there may be reasonable doubt about the ultimate action an appropriate court would take under the same circumstances with respect to whether: (1) the material deposited for registration constitutes copyrightable subject matter; or (2) the other legal and formal requirements of the statute have been met. *Compendium II*, § 108.07. There is no reason to believe that the work is copyrightable or that there are any outstanding questions of law that need to be resolved. On this point we note that the *Compendium II* test we have used in our analysis has been sanctioned by the courts. Careful analysis of the law, as applied to the facts here, leads us to the conclusion that the bottle is a useful article that does not contain any separable artistic elements that are copyrightable.

For the reasons stated above, the Copyright Office Review Board affirms the refusal to register the work 420 Bottle Design. This decision constitutes final agency action in this matter.

Sincerely,

Tanya M. Sandros

Tanya M. Sandros
Deputy General Counsel
for the Review Board
United States Copyright Office

cc: Sue Irwin Ironside, Partner