United States Copyright Office
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January 6, 2014

William H. Eilberg, Esq.
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Reno, NV 89509

RE: BOTTLE DESIGN
Correspondence ID: 1-G8W9NV

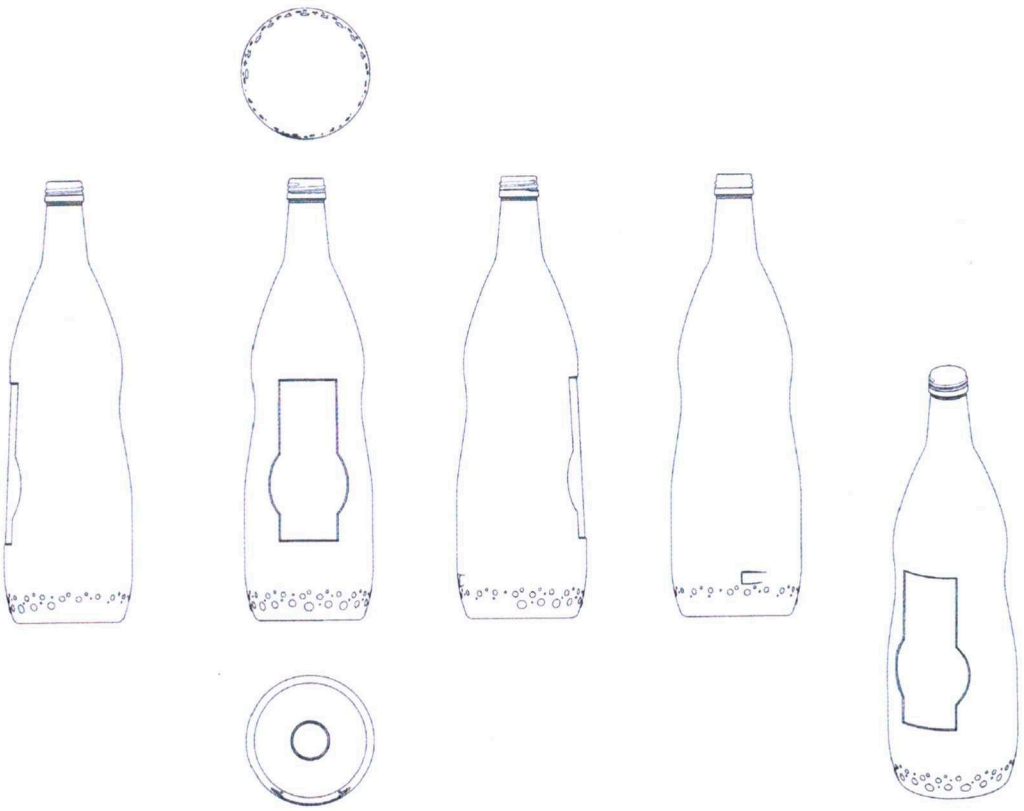
Dear Mr. Eilberg:

The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the work entitled *Bottle Design* (the "Work"). You submitted this request on behalf of your client, Etablissements Geyer Freres. The Board has examined the application, the deposit copy, and all of the correspondence in this case. After careful consideration of the arguments in your second request for reconsideration, the Board affirms the Registration Program's denial of this copyright claim. The Board's reasoning is set forth below. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

I. DESCRIPTION OF THE WORK

The deposit copy for *Bottle Design* contains five hand-drawn configurations of the Work that appear to depict the bottle as viewed from five different angles. The second drawing also depicts what appear to be top down images of the open top of the bottle, and the enclosed base or underside of the bottle. The overall shape of the bottle is vaguely hourglass, with a narrower top neck that is threaded at the top (a common "twist-off" top for beverages). The bottom of the bottle contains a series of scattered circles or dimples that you represent "symbolize small water drops." *Letter from William H. Eilberg, Esq. to Copyright RAC Division*, at 5 (May 2, 2013) (*First Reconsideration*). One side of the bottle contain a slightly recessed area for the placement of a label. This recessed area consists of a

rectangle with two, protruding semi-circles on opposite sides at the bottom, resembling in overall shape an old-styled key hole on a door. The images below are reproductions of the Work from the deposit material.



II. ADMINISTRATIVE RECORD

On February 8, 2013, the United States Copyright Office (the "Office") issued a letter notifying you that it had refused registration of the above identified Work. *Letter from Registration Specialist Paula Gillaspie to William Eilberg* (February 8, 2013). In its letter, the Office identified the Work as being a useful article within the meaning of 17 U.S.C. § 101, and concluded that it did not contain any separable authorship that warranted copyright protection. *Id.*

In a letter dated May 2, 2013, you requested that the Office reconsider its initial refusal to register the Work. *First Reconsideration* (May 2, 2013). Upon reviewing the Work in light of the points raised in your letter, the Office affirmed the initial refusal on the

same grounds. *Letter from Attorney Advisor, Stephanie Mason, to William H. Eilberg, Attorney at Law* (August 21, 2013). You subsequently sought a second reconsideration of the registration refusal. *Letter from William H. Eilberg, Esq. To Copyright RAC Division* (November 14, 2013) (*Second Reconsideration*).

In support of your second request for reconsideration, you acknowledge that the Work is a useful article but argue that the design of the Work is sufficiently separable from its utilitarian function as a bottle to warrant copyright protection. You submit that the separability analysis applied by the court in *Pivot Point International, Inc. v. Charlene Products, Inc.*, 373 F.3d 913 (7th Cir. 2004) should be controlling [1], and argue that the design of the Work is not dictated by its function and could have been expressed in a number of different ways. *Second Reconsideration* at 7 ("The ability to produce an alternative design, while preserving the function of the bottle, is critical in determining whether a design is 'capable of existing independently' of the utilitarian aspects of the article"). You also argue that the burden should be on the Copyright Office to show that the design of the Work was subject to, or limited by, its functional considerations. *Id.* at 8 (citing Declaration of Jean-Pierre Barjon, author of the design, who states that many features of the Work were developed without regard to functionality).

III. DECISION

A. *The Legal Framework*

1. *Separability*

Copyright protection does not generally extend to useful articles, *i.e.*, "article[s] 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 authorship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as [the designs'] form but not their mechanical or utilitarian aspects are concerned." *Id.* at § 101.

To be clear, a design incorporated into a useful article is only eligible for copyright protection to the extent that the design includes "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, utilitarian aspects of the article." *Id.*; *see also Esquire, Inc. v. Ringer,* 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied,* 440 U.S. 908 (1979) (holding copyright protection is not available for

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[1] You also cite *Stanislawski v. Jordan*, 337 F. Supp. 2d 1103 (E.D. Wisc. 2004) and *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010) which are supportive of the analysis of *Pivot Point*.

the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be"). The Board employs two tests to assess separability: (1) a test for "physical separability"; and, (2) a test for "conceptual separability." *Id.; see also Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q. 2d 1714 (D.D.C. 1995) (finding that the Copyright Office's tests for physical and conceptual separability are "a reasonable construction of the copyright statute" consistent with the words of the statute, present law, and the legislature's declared intent in enacting the statute).

To satisfy the test for "physical separability," a work's pictorial, graphic, or sculptural features must be able to be physically separated from the work's utilitarian aspects, by ordinary means, without impairing the work's utility. *See, e.g., Mazer v. Stein*, 347 U.S. 201 (1954) (holding a sculptured lamp base depicting a Balinese dancer did not loose its ability to exist independently as a work of art when it was incorporated into a useful article); *and see, Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (upholding the copyright in a sculpture of an antique telephone that was used as a casing to house a pencil sharpener because the sculpture was physically separable from the article without impairing the utility of the pencil sharpener). To satisfy the test for "conceptual separability," a work's pictorial, graphic, or sculptural features must be able to be imagined separately and independently from the work's utilitarian aspects without destroying the work's basic shape. *See, e.g.,* H.R. Rep. No. 94-1476 (1976), (indicating a carving on the back of a chair or a floral relief design on silver flatware are examples of conceptually separable design features). A work containing design features that fail to qualify as either physically or conceptually separable from the work's intrinsic utilitarian functions are ineligible for registration under the Copyright Act.

If a useful article does possess elements that are conceptually separable from the work, the Office examines these elements to determine if one or more of the elements possesses sufficient creativity to warrant copyright protection. If one or more of the elements is copyrightable, a registration can be made but it is important to understand the registration does *not* cover the entire useful article; rather, it only applies to the copyrightable elements. This is precisely the teaching of the *Mazer v. Stein* case. The sculpture of the Balinese dancer, as a separable element, was protectable, but the overall lamp design was not.

Several legal scholars have envisioned different approaches for analyzing and applying the legal requirement of separability for useful articles. Professor Robert Denicola's test for conceptual separability, articulated in his article *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn.L.Rev. 707 (1983), is favored by the United States Court of Appeals for the Seventh Circuit and is described in the *Pivot Point* decision that you have cited. It is *not* the test or analysis applied by the Office, as described above. You have not cited any legal authority confirming that the *Pivot Point* approach is controlling in the examination process of the Work, nor have you

cited any authority asserting that the Office's separability analysis is contrary to the statute or otherwise in error.

2. *Originality*

All copyrightable works must qualify as "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). As used with respect to copyright, the term "original" consists of two components: independent creation and sufficient creativity. *See Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). First, the work must have been independently created by the author, *i.e.*, not copied from another work. *Id.* Second, the work must possess sufficient creativity. *Id.* While only a modicum of creativity is necessary to establish the requisite level, the Supreme Court has ruled that some works (such as the telephone directory at issue in *Feist*) fail to meet this threshold. *Id.* The Court observed that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity." *Id.* at 363. It further found that there can be no copyright in a work in which "the creative spark is utterly lacking or so trivial as to be nonexistent." *Id.* at 359.

The Office's regulations implement the long-standing requirements of originality and creativity set forth in the law and, subsequently, the *Feist* decision. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring"); *see also* 37 C.F.R. § 202.10(a) (stating "[i]n order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form").

Of course, some combinations of common or standard shapes or designs that comprise a conceptually separable element may contain sufficient creativity, with respect to how they are juxtaposed or arranged, to support a copyright. Nevertheless, not every combination or arrangement will be sufficient to meet this grade. *See Feist,* 499 U.S. at 358 (finding the Copyright Act "implies that some ways [of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not"). Ultimately, the determination of copyrightability in the combination of standard design elements rests on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D.D.C. 1989).

Finally, Copyright Office Registration Specialists (and the Board, as well) do not make aesthetic judgments in evaluating the copyrightability of particular works. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's uniqueness, its visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *see*

also Bleistein v. Donaldson, 188 U.S. 239 (1903). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not automatically mean that the work, as a whole, constitutes a copyrightable "work of art."

B. *Analysis of the Work*

After carefully examining the Work and applying the legal standards discussed above, the Board finds that it is a useful article that does not possess design elements that are *both* separable from the Work's utilitarian functions and sufficiently creative to support a claim to copyright. Accordingly, we affirm the Registration Program's decision to deny registration.

A "useful article" is defined by statute 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 (2007). As discussed above, the law requires that, to be eligible for registration, design features incorporated into useful articles must be either physically or conceptually separable from the utilitarian aspects of the work. *See Esquire,* 591 F.2d at 800. Here, it is undisputed that the Work (a bottle) is a useful article. It is also undisputed that there are no elements of the bottle design that are physically separable from the Work; therefore, registration can only be based upon those elements that are conceptually separable from the useful article itself. The overall shape of the Work is not conceptually separable from Work as a bottle, for to do so would destroy the configuration of the useful article in violation of the legal analysis applied by the Office. There are, however, two elements of the Work that do appear to be conceptually separable: the raised dimples or bumps at the base of the work, and the rectangular indentation on the face of the bottle for the placement of a label. The Board finds that neither of these elements, individually or in combination, possess the requisite amount of creative authorship to warrant copyright registration.

As noted, 37 C.F.R. § 202.1(a), identifies certain elements that are not copyrightable. These elements include, among others, "familiar symbols or designs" such as circles, common rounded shapes, and any minor variation thereof. *Id.* Here, the raised dimples or bumps at the bottom of the bottle are simple geometric designs (ovals) that are not subject to protection. Likewise, the label indentation is nothing more than a rectangle with opposing semicircle protrusions at the base that create the basic shape of an old-style key hole for a door. These elements, considered individually and in combination, fail to meet the threshold for copyrightable authorship. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883. Accordingly, we conclude that both the individual elements that comprise the Work's separable design feature, as well as their selection and arrangement, lack the requisite "creative spark" necessary for registration. *Feist,* 499 U.S at 359; *Satava*, 323 F.3d at 811.

IV. CONCLUSION

For the reasons stated above, the Copyright Office Review Board affirms the refusal to register the Work entitled *Bottle Design*. This decision constitutes final agency action in this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____
William J. Roberts, Jr.
Copyright Office Review Board