November 18, 1996

RE: Menehune Water Company, Inc., Diamond Shape Bottle
Control No. 60-407-148 9(W)

Dear Mr. Wray:

This is in response to your letter dated February 28, 1996, addressed to Melissa Dadant, Special Assistant to the Chief of the Examining Division, and forwarded to the Copyright Office's Board of Appeals on behalf of your client, Menehune Water Company, Inc., appealing the Office's refusal to register the "Diamond Shape Bottle," originally submitted for registration on September 15, 1994.

The Copyright Office's Board of Appeals has examined the claim and considered all correspondence from your firm regarding this claim. Because this bottle has an utilitarian function whose shape does not contain sufficient original authorship which stands conceptually apart from its utilitarian form, the Board of Appeals affirms the Examining Division's decision to refuse to register this claim.

Administrative Record

The Office received your application and other materials for registration of a water bottle design on September 15, 1994. In a letter dated January 13, 1995, Examiner John Ashley refused registration, stating that the design did not incorporate separately identifiable pictorial, graphic, or sculptural features that are copyrightable. On January 31, 1995, the Office received a response from Cristina Pinheiro-Palmer, of your law offices, disagreeing with Mr. Ashley's conclusions. Ms. Palmer asserted that the design had no utilitarian purpose and was separately entitled to copyright.

Following a review of this claim, on February 12, 1996, Ms. Dadant responded that the work contains no copyrightable authorship on which to base a registration. She noted that there was no copyrightable authorship, either physical or conceptual, that was separable from the utilitarian aspects of the bottle. She explained that while the shaping of the bottle is not absolutely essential to the utilitarian aspects

of the bottle, neither is it independent of the utilitarian aspects. In your February 28, 1996 reply to Ms.Dadant, you reassert that the Diamond Shape Bottle contains conceptually separable authorship and maintain that its design shows more than a trivial amount of intellectual labor and artistic expression. Because this is a final agency appeal, your reply was forwarded to the Copyright Office Board of Appeals.

Registration Requirement for Useful Articles

You assert that this work is registrable as a pictorial, graphic or sculptural work under section 102(a)(5) of the copyright law. When such a work is embodied in a "useful article," the copyright law requires a certain type of artistic contribution to be registrable under section 102(a)(5). A useful article is "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article'." 17 U.S.C. 101 (1994).

Moreover, the definition of "pictorial, graphic and sculptural works" limits copyrightability of the design of a useful article to "pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." Id. Therefore, the question before the Board is whether this bottle satisfies the statutory definition for this type of work. The Board concludes that it does not.

That all of the decorative elements on this bottle are related to its shape is a critical point. Congress clarified its intent with respect to the shape of useful articles in the legislative history. Specifically, the House Report accompanying the current copyright law states that:

> In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design...[A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that physically or conceptually can be

> identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design -- that is, even if the appearance is determined by aesthetic (as opposed to functional) considerations, only elements, if any, which can be identified separably from the useful article as such are copyrightable.

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976) (emphasis added).

Conceptual Separability of Overall Shape

You assert that the shaping of the bottle is not functional and is independent of the utilitarian aspects, and thus is protected under section 102(a)(5). The Office's implementation of the copyright statute, including its legislative history, is reflected in Compendium II of the Copyright Office Practices which states that the required conceptual separability is met when "artistic or sculptural features...can be visualized as free-standing sculpture 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." U.S. Copyright Office, Compendium of Copyright Office Practices II, §505.03 (1984).

Esquire, Inc. v. Ringer, 591 F.2d. 796 (D.C.Cir. 1978), cert. denied, 440 U.S. 908 (1979), although decided under the 1909 law, most clearly enunciates the rule underlying the Office's principal reason for refusal. Esquire held that the Copyright Office regulation properly prohibited copyright registration for the overall shape or configuration of an utilitarian article, no matter how aesthetically pleasing that shape or configuration may be. Id. at 800. In fact, Section 505.03 of Compendium of Copyright Office Practices II, is a direct successor to the Copyright Office regulation which was affirmed in Esquire as an authoritative construction of the statute as explicitly stated in legislative history. Id. at 802-03. See also Custom Chrome, Inc. v. Ringer, 35 U.S.P.Q. 2d 1714, 1718 (D.D.C. 1995), where the court stated that the Office's "conceptual separability test" as it is enunciated in Compendium II is consistent with the holding in Esquire, later cases decided under the present law, and the legislative history.

In applying the conceptual separability test, Examiner Ashley found that this artistic work "does not have any features that can be identified as 'separable' and that also constitute a copyrightable work of art." (Letter from Ashley to Wray of 1/13/95.)

In Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985), the Second Circuit found life-like half-torso mannequin designs to be inextricably intertwined with their functionality. Like the features of the mannequin forms of Barnhart, the geometric squaring off of the Diamond Shape Bottle's corners, sides and base and the faceting on the bottle do not stand alone as conceptually separable artistic or sculptural authorship. The court in Barnhart explicitly quoted Congress' prohibition of copyright for works of applied art or industrial design "regardless of the fact that they may be 'aesthetically satisfying and valuable.'"[1] Id. at 418.

Two years after Barnhart, in Brandir International Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987), the Court of Appeals for the Second Circuit ruled once more that the design of a useful article -- in this case, a bicycle rack -- was just that -- a useful design of manufacture. Like the Barnhart court, the Brandir court found that the aesthetic design elements were conceptually inseparable from, i.e., inextricably intertwined with, the utilitarian elements. Id. at 1147. As Judge Oakes explained for the Brandir court:

> While the RIBBON Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack .... [I]t would seem in fact that Brandir has achieved with the RIBBON Rack the highest goal of modern industrial design, that is the harmonious fusion of function and aesthetics. Thus, there remains no

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[1] The Barnhart court highlighted that Title II of S.22, the bill that became the Copyright Act of 1976 would have given protection to original ornamental designs of a useful articles, regardless of whether such designs could stand by themselves, separate from the article itself. See H. Rep. No. 1476, 94th Cong., 2d. Sess. 50 (1976). Neither Title II nor any similar legislation has as yet been enacted. See also discussion of Title II in Esquire Inc. v. Ringer, 591 F.2d 796, 800-01, (D.C.Cir. (1978), cert. denied, 440 U.S. 908 (1979).

> artistic element of the RIBBON Rack that can be identified as separate and "capable of existing independently, of, the utilitarian aspects of the article."

Id. at 1147-48.

The Office applies the rule established in Esquire and later cases that, despite an original and creative shape, the overall design or configuration of an utilitarian article may not be copyrighted if it is not capable of existing as a work of art conceptually independent of the utilitarian object in which it is incorporated. 591 F.2d 796 at 805. Applied here, this water bottle is a useful article not exhibiting any copyrightable authorship separate from its overall shape or configuration. This shape, consisting of an elongated bottle-type configuration with common diamond and/or square faceting is the shape of the useful article. Therefore, although the bottle may be aesthetically pleasing, it falls within the prohibition of the statute. See also Compendium II at § 505.03 (1984). The major barrier to registrability, summarily, is that its artistic features are inseparable from its utilitarian shape.

Secondary consideration:
Minimum Amount of Authorship Not Met

Although this bottle's design does not incorporate separately identifiable artistic or sculptural authorship to warrant registration, Ms. Dadant in her February 12, 1996 letter, did consider whether the bottle contained a sufficient quantum of authorship to warrant registration if separability were conceded. She concluded that it did not. She found that "the facets on the top and bottom of the bottle serve the usual purpose of shaping from a wide section to a narrow one in fairly standard cut shapes." (Letter from Dadant to Wray of 2/12/96, at 3.) In making this decision, the Examining Division relied on Compendium II, at § 503.02(b)(1984), noting that for the expression, if it were conceded to be separable, to be capable of supporting copyright, it must consist of something more than the bringing together of two or three standard forms or shapes with minor linear or spatial variations. This theory applies to the faceting of gems, and also to other applications insofar as they reflect the same geometric shapes. (Letter from Dadant to Wray at 2-3).

In support of this secondary basis for refusal, the policy of the Copyright Office prohibits registration of ordinary faceting, i.e., cuttings. "[I]t is the practice of the Examining Division to refuse registration for faceting when it may be viewed as a standard or common geometric shape in three-dimensional form." (Id. at 2).

Towle Manufacturing Co. v. Godinger Silver Art Co. Ltd., 612 F.Supp. 986 (S.D.N.Y. 1985), a case analogous to your client's case, involved a decorative mouth-blown hand-cut crystal baby bottle. In deciding the threshold question of whether the design was entitled to copyright, the Towle court found that the common glassware cutting design failed to meet the modicum of originality necessary for copyrightability. It further held that the design elements had not been utilized in a sufficiently original manner to warrant copyright protection. Id. at 991-92.

We conclude that even if we were to consider the faceting of the water bottle as sufficiently conceptually separate from the overall useful design, that faceting design is nevertheless insufficient to meet the concededly low standard of originality as that standard is enunciated in Feist Publications Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 363-64 (1991).

Non Useful Artistic Works

In support of your appeal, you cite Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980). There the court found conceptually separable sculptural elements applied to the belt buckles and further likened the belt buckles to jewelry pieces reflecting separable and copyrightable applied art. Id. at 993. We do not find such separable elements in a water bottle which is clearly definable as a useful article.

You also cite Runstadler Studios Inc., v. MCM Ltd., 768 F.Supp. 1292 (N.D.Ill. 1991). Although Runstadler held that combinations of standard shapes may possess the requisite creativity necessary, id. at 1295-96, the court based its decision in part on a presumption of validity accorded when it was registered by the Copyright Office. Id. at 1294. Most significantly, that case dealt with a non-useful article -- sculptural and artistic authorship that had no useful function. Even so, Runstadler has been recently distinguished in M & D International Corp v. Chan, 901 F.Supp. 1502 (D. Haw. 1995). That case held that combinations of rainbows and two other symbols

did not result in a sufficiently original arrangement to merit copyright protection. Id. at 1515.

The Board concludes that the common geometric cuttings that form part of the shape of this water bottle do not lift this article from an industrial design to a work of authorship that is registrable under section 102(a)(5) of the copyright law. Further, although the several artistic elements may be pleasing, they are intertwined with the article's overall shape and are not conceptually separable from the bottle's utilitarian function. The Board also affirms the Examining Division's decision that the cutting designs on this bottle, on the sides, on the squared-off corners, and on the bottom, even if we were to consider them conceptually separable -- which we do not --, fall short of the necessary originality to sustain copyright registration.

This letter constitutes final agency action.

Sincerely,

Nanette Petruzzelli
Chief, Examining Division
for the Appeals Board
U.S. Copyright Office

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November 19, 1996