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Washington, D.C.
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September 30, 1998

Re: New Shalimar Bottle
Control No. 60-504-3638(W)

Dear Ms. Douglass:

On behalf of the Copyright Office Appeals Board, I am responding to your June 24, 1997, request for reconsideration of the Office's decision not to register the work "New Shalimar Bottle." The Board has examined the claim and the associated documentation, and upholds the Examining Division's decision to refuse registration because the work is a useful article which does not contain any separable copyrightable authorship

Administrative Record

In a letter dated June 15, 1995, you submitted the fee, deposit and application for registration of "New Shalimar Bottle" on behalf of claimant Guerlain S.A. Examiner Carol Guglielm rejected the application, stating in her letter of February 7, 1996, that the work, a perfume bottle, was functional, contained no separable copyrightable elements, and embodied only common forms or slight variations of common shapes that did not represent enough original authorship to be registered.

On April 16, 1996, you requested reconsideration of the Office's refusal to register the work, claiming that the bottle embodied conceptually separable authorship sufficient to be registered for copyright protection. You cited Superior Form Builder's, Inc. v. Dan Chase Taxidermy Supply Co., Inc., 74 F.3d 488 (4th Cir. 1996) (mannequins used in taxidermy business found copyrightable despite their utilitarian function), and Brandir International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987) (for discussion of test for conceptual separability), to support your contention that conceptually separable authorship existed in the bottle sufficient register the work. You added that although perfume bottles are functional in a technical sense, they are designed and created for display purposes, and thus, "inherently are closer to works of art than most useful articles."

You claimed as copyrightable: 1) the new Shalimar bottle's shape resembling a fan from top to bottom, with an oval base; 2) creation of a ridge effect created by horizontal ridges on the bottle that varied in width; 3) a cloud-like design in the center of the front panel; and 4) the stopper in the form of a half moon with fluted edges resembling pie crust edging. These elements, you wrote, were not designed for function, but "for the purpose of artistic creation...." First appeal letter at 3.

Finally, you contended that the level of authorship in the design far exceeded the "slight" amount of creativity necessary for copyright protection under the standard the Supreme Court articulated in Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340 (1991).

In a letter dated May 20, 1997, Visual Arts Section Attorney-Advisor David Levy replied that after re-examining the bottle, it was determined that the Office still could not register the perfume bottle design. Mr. Levy noted that the separability test cited in Brandir "is one of several tests for determining protectible authorship in useful articles" and cited the Office's practices for determining conceptual separability as found in Compendium II, Copyright Office Practices (1984) ("Compendium II") at section 505.03.

Mr. Levy noted that the elements you described, except for the cloud-like form, represented the over-all form or shape of a utilitarian article, the perfume bottle, and could not be registered. The authorship in the cloud-like form was conceptually separable from the bottle, but contained *de minimis* authorship that was a minor variation of a familiar design, and therefore was not copyrightable according to 37 C.F.R. § 202.1. Mr. Levy explained that neither the purpose for creating a work nor the cost of producing a work were copyrightable elements.

You responded in a second appeal letter, dated June 24, 1997, contending that the Office did not fully weigh the fact that a perfume bottle is not listed as one of the examples given for useful articles in Office practices in Compendium II. You repeated the assertion that perfume bottles, although useful in fact, are more like sculptural works than useful articles because they are "often designed solely with regard to their sculptural appearance, without regard to function." Second appeal letter at 1.

You declared that the design of the bottle was conceptually separable and capable of being drawn on paper without regard to the shape of the bottle. You asserted that examination of the work as a whole would reveal that the bottle's design exceeded the level of creativity required for registration. You noted that the Office had previously registered perfume bottle designs, and you included a copy of a registration in 1985 of another perfume bottle, together with a photocopy of that bottle. Finally, you suggested that unless there was absolutely no basis for registering the new Shalimar bottle, the design should be registered under the rule of doubt.

Useful Article

The Appeals Board has determined that the new Shalimar bottle cannot be registered because there are no separable elements in the bottle that embody sufficient original authorship.

Section 101 of the Copyright Act identifies a useful article 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. Although you accept the characterization of the perfume bottle as being "technically" a useful article, you argue that in fact it is more akin to a "sculptural work per se" and that perfume bottles are not among the examples of useful articles set forth in the Compendium. See Compendium II, § 505.01.

The examples cited in the Compendium are intended to be just that: examples, not an exhaustive list of useful articles. The same section of the Compendium also quotes the definition of "useful article" set forth in 17 U.S.C. § 101. *Id.* A perfume bottle falls squarely within this definition: it is an article with the intrinsic utilitarian function of serving as a container for perfume. Although the appearance of the bottle may be an important factor in its design — and indeed may be the primary factor in the mind of the designer — it is clear that the function of the bottle is "not *merely* to portray the appearance of the article." (Emphasis added.) In contrast, in Superior Form Builder's, Inc. v. Dan Chase Taxidermy Supply Co., Inc., the court concluded that the fish mannequins in question had the function of portraying their own appearance. 74 F.3d at 494. *Accord:* Hart v. Dan Chase Taxidermy Supply Company, Inc., 86 F.3d 320, 323 (2d Cir. 1996).

Separable Authorship

As a useful article, the bottle is eligible for copyright only if there is authorship in the bottle that is separable from its utilitarian aspects. Section 101 of the Copyright Act (in its definition of "pictorial, graphic and sculptural works") provides that "works of artistic craftsmanship" may be protected by copyright "insofar as their form but not their mechanical or utilitarian aspects are concerned," and that the design of a useful article is protectible "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."

The question before the Board is whether the Shalimar bottle satisfies the statutory requirement of separable pictorial, graphic or sculptural authorship. The Board concludes that it does not. Congress clarified its intent with respect to the shape of useful articles in the legislative

history of the Copyright Act of 1976. Specifically, the House Report accompanying the Act states that:

> The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design — that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable.

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

The Compendium states that claims in three-dimensional useful articles will be registered if there are separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article. Compendium II, § 505.02 (1984). The requisite separability may be either conceptual or physical. *Id.* See. H.R. Rep. No.1476, 94th Cong., 2d Sess. 55 (1976).

Physical Separability. The pictorial, graphic, or sculptural features of a work may be said to be physically separable from the shape of the work when a nonutilitarian work that is copyrightable as a pictorial, graphic or sculptural work is later incorporated into a useful article. In such cases, the preexisting copyrightable authorship remains registrable. Compendium II, § 505.04. You do not argue that this is the case with respect to the Shalimar bottle, and there is no reason to conclude that it is the case.

Conceptual Separability. Conceptual separability exists 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." Compendium II, § 505.03 (1984). In its letter rejecting your first appeal, Examining Division relied on this provision in concluding that there are no conceptually separable elements in the bottle. Your second appeal letter admits that the letter from Examining Division ruling on your first appeal "correctly recited the test for conceptual separability," but asserts that Examining Division misapplied that test. Second appeal letter at 1. The Board finds that in refusing registration on your first appeal, Examining Division correctly stated and applied the test for conceptual separability.

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 regarding conceptual separability. Esquire held that the Copyright Office regulation properly prohibited

copyright registration for the overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape or configuration may be. *Id.* at 800. In fact, section 505.03 of Compendium 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 the legislative history of the Copyright Act of 1976. *Id.* at 802-03. See also Custom Chrome, Inc. v. Ringer, 35 U.S.P.Q.2d 1714, 1718 (D.D.C. 1995).

The Office applies the rule established in Esquire that, even when there is an original and creative shape, the overall design or configuration of a utilitarian article is not copyrightable 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, 805. The Board of Appeals concludes that the principles expressed in Esquire are applicable to the design in this case. As the Board understands your claim, it is in nothing more than the shape of the bottle and various parts of the bottle (and, in addition, what appears to be the image of a cloud on the surface of the bottle, an aspect of the design discussed below). However, creative that shape might be, it remains the shape of the bottle and therefore is not conceptually separable from the utilitarian object itself.

You state that Examining Division misapplied the test for conceptual separability because the design of the bottle "is capable of being drawn on paper without regard to the shape of the bottle," referring to the test as set forth section 505.03 of Compendium II, and you recite various aspects of the shape of the bottle. But the fact that one can draw the design of a useful article on a piece of paper does not result in conceptual separability; it is difficult to imagine a situation in which one could not render such a drawing. The key point is that what one could draw in this case would not be "independent of the shape of the useful article." It would, in fact be *the shape* of the useful article.

You also appear to assert, in your first appeal letter, that the test stated in Brandir, 834 F.2d at 1145, would require a different result than the test set forth in Esquire and the Compendium. First appeal letter at 1-2. As the D.C. Circuit has observed, "There is a notable lack of agreement among courts and commentators on the very meaning of 'conceptual separability.'" OddzOn Products v. Oman, 924 F.2d 346, 348 (D.C. Cir. 1991). *See also* Masquerade Novelty, Inc. v. Unique Industries, Inc., 912 F.2d 663, 670 (3rd Cir. 1990) ("Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function"). In this case, however, the Board does not have to choose between its longstanding rules of decision in cases involving conceptual separability and the test enunciated in Brandir. The test as articulated in Brandir is:

> [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. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.

834 F.2d at 1145. In a case such as this, where the design elements for which registration is sought are all part of the shape of the object, it is apparent that such elements can *never* reflect the designer's artistic judgment exercised *independently* of functional influences. The function of the useful object necessarily imposes constraints on the design of the object's shape.[1]

You have asserted that registration is justified because in the past, the Copyright Office has issued a registration for a perfume bottle design. The Office does not, as a matter of examining procedure, compare similar works submitted for registration. The fact that an examiner may have registered a particular work in the past does not require the Board to register any similar works; the judgment of an individual examiner with respect to a particular registration is not stare decisus. The Board will not depart from its practice of refraining from comparing previously registered works with the work in question, but will observe that the perfume bottle registration referenced in your appeal letter involved authorship more likely to be considered separable from the utilitarian aspects of that bottle than is the case with respect to the Shalimar bottle.

De Minimis Authorship

The Board has been able to identify only one aspect of the Shalimar bottle design that may be separable from the bottle's utilitarian aspects: the cloud-like design in the center of the front panel of the bottle.. However, the Board is unable to detect sufficient authorship in this simple cloud design to support a registration.

Under Copyright Office regulations, familiar symbols and designs are not copyrightable. 37 C.F.R. §202.1(a). This principle is supported by numerous judicial decisions. *See* John Muller

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In your first appeal letter, you stated that the Brandir test requires that if a useful article was designed "with emphasis on its artistic qualities, this will qualify for copyright protection because the artistic contribution is conceptually separable." That is not the test as articulated in Brandir, where the court was not concerned merely with the artist's *emphasis*, but was concerned with whether the design was the product of "*purely* aesthetic choices, *independent* of ... function." 834 F.2d at 1145.

& Co. v. New York Arrows Team, Inc., 802 F.2d 989 (8th Cir. 1986)(logo of four angled lines forming an arrow with the word "Arrows" in cursive script held not copyrightable). Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F. Supp. 769 (W.D. Pa. 1986)(envelopes printed with solid black stripes and a few words such as "priority message" or "gift check" did not exhibit minimal level of creativity necessary for copyright registration); Jon Woods Fashions v. Curran, 8 USPQ2d 1870 (S.D.N.Y. 1988)(upholding Register's decision that fabric design of striped cloth with grid of squares was not copyrightable); Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958)(cardboard star with circular center for photographs, and two folded flaps allowing star to stand for display, not a work of art with the meaning of 17 U.S.C. § 5(g)(1909)). The simple and easily recognizable shape of the cloud on the Shalimar bottle is, at most, a minor variation of an equally familiar object which is ineligible for copyright protection.

In Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991), the Supreme Court confirmed that although there is a low standard for determining the copyrightability of a work, some works fail to meet that standard. The Court held that the originality required for copyright protection consists of "independent creation plus a modicum of creativity." *Id.* at 346. 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, and that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. The Court also recognized that some works, such as a "garden-variety white pages directory devoid of even the slightest trace of creativity," are not copyrightable. *Id.* at 362.

The *Feist* ruling simply confirmed longstanding judicial guidelines and Copyright Office practice, including the principles set forth in 37 C.F.R. § 202.1, with respect to the degree of originality and creativity required to support a copyright, The simple, garden-variety cloud design appearing on the Shalimar bottle exhibits, at best, *de minimis* creativity. There can be no doubt that if this cloud design were drawn on a piece of paper and submitted for registration, registration would be denied. The act of placing the design on the surface of a perfume bottle does not contribute any additional authorship that would justify a registration.

Rule of Doubt Registration

Under the copyright law, useful articles must contain separately identifiable artistic authorship on which a copyright claim can be based. The design in the case fails to meet that test. The Board of Appeals does not find it appropriate to register the work under the rule of doubt. That rule applies where:

> there is a reasonable doubt about the ultimate action which might be taken under the same circumstances by an appropriate court 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.

In the instant case, the Office, exercising its authority and discretion to determine copyrightability under 17 U.S.C. § 410(a)(1995), concludes that there is no separable and copyrightable authorship present in this useful article. The work does not present a novel question for registration in either the subject matter or in any other of the formal requirements for registration. Further, although the area of conceptual separability is a difficult one, the Office does not apply the rule of doubt in every such claim to copyright in useful articles in which an applicant disagrees with the Office's assessment of nonseparability.

Conclusion

For the reasons stated above, the Copyright Office must refuse to register the "New Shalimar Bottle." The Appeals Board's decision constitutes final agency action.

Sincerely,



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for the Appeals Board
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