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September 24, 2001

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Dear Mr. Patch:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated October 27, 2000 on behalf of Hermes International, in which you requested that the Copyright Office reconsider its refusal to register a handbag entitled "TRIM." The Copyright Office Board of Appeals affirms the Examining Division's refusal to register.

ADMINISTRATIVE RECORD

On March 30, 1999, the Copyright Office received a Form GATT application to register Applicant Hermes International's handbag design, entitled "TRIM," as a VA class work. On page two of your second appeal letter, dated October 27, 2000, you characterized TRIM as "a fashion accessory which is capable of serving the purpose of holding personal items."

In a letter dated January 21, 2000 from Visual Arts Section Examiner, John M. Martin, the Examining Division refused to register "Trim" because the work is a purse which is a useful article. Useful articles are not entitled to registration under copyright law. Also, Mr. Martin stated that there are no separately identifiable aspects of the work that satisfy the minimum standard of creativity.

In a letter dated May 22, 2000, you requested that the Copyright Office reconsider its refusal to register "TRIM." Relying on Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980), you argued that the aesthetic elements of applicant's work are conceptually separable from its utilitarian elements. You analogized Applicant's bag design to the buckles at issue in Kieselstein-Cord, stating that its utilitarian feature is simply the ability to hold contents, similar to a fine vase. You also pointed out that the TRIM design, selling for over one thousand dollars, is similar to the belt buckles in being valued beyond its functional worth. Attached to your letter was a statement from a managing director at Hermes stating that the bag is being sold for between $2,600 and $7,350. You distinguished Applicant's work from the mannequins at issue in Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985), stating that while the mannequins' forms were dictated by the need to accurately portray a human body, Applicant's useful article need only be a sack for its utilitarian purposes so that the "remainder of the design thereof being entirely a matter of aesthetic consideration" that

has been added to the otherwise utilitarian article. Quoting Nimmer on Copyright, you distinguished TRIM from the light fixtures at issue in Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C.Cir. 1978), by arguing that unlike the light fixtures, but like the Kieselstein-Cord belt buckles, TRIM's aesthetic appeal is so great that purchasers buy it for artistic reasons. You have also stated, "There is no doubt that an Hermes TRIM bag, even if incapable of holding items, would still be phenomenally attractive to the public, simply because of its beauty as art ... ." [Your 5/22/00 letter at 9, 10.]

Having argued that there are conceptually separable elements of TRIM, you then discussed the copyrightable aspects of those conceptually separable elements. The specific design features that you identified as being conceptually separable and copyrightable include the shape and placement of the trim elements, the configuration of the buckle and the overall shape of the bag. You stated that the level of creativity required for copyright protection is very low and that the work should be evaluated as a whole and not by considering its elements separately. You analogized TRIM to a vase design that is a useful object but which incorporates aesthetically pleasing and original elements into an overall creative design.

In a letter dated June 30, 2000 from Attorney Advisor Virginia Giroux, the Examining Division again refused to register Applicant's works on the basis that the handbag is a useful article that does not contain any separable authorship that is copyrightable. After reviewing the legal requirements for determining whether there are conceptually separable elements and analyzing TRIM in light of the cases you cited, Ms. Giroux stated that the work does not have any design elements that are separable from its utilitarian aspects.

In another letter, dated October 27, 2000, you submitted a second request for reconsideration. In addition to the arguments made in your first request for reconsideration, you also stated that the same analysis should be applied to TRIM as was applied to a watch by the court in Severin Montres, Ltd. v. Yidah Watch Co., 997 F.Supp 1262 (C.D.Cal. 1997) which led that court to conclude that the watch had conceptually severable elements. Consistent with that court's analysis, you stated that, like a watch, a handbag may be designed and constructed in an infinite variety of ways. You have stated that:

> Such a bag must presumably include a container portion capable of holding some number of personal items and, optionally, some type of strap to allow hand holding and/or slinging over a shoulder. The TRIM design, however, includes detailed metal sculpture on the front clasp element, contrasting colors of the trim features with respect to the center section, as viewed from both the front and back, further contrasting thread on the trim sections, and a shape, texture, and dimensions of the bag which combine to produce a singular overall work. Aside from the

> existence of an enclosed volume and the presence of a handle, there is nothing in the present work that can be fairly said to be influenced by function. ...the TRIM design bag is not first a utilitarian bag which happens to contains [sic] sufficient conceptually separable originality to warrant protection, but rather first a high-fashion, aesthetically pleasing and original work, worn by its owner, that also happens to serve a useful purpose of carrying personal items.

[Your 10/27/00 letter at 5, 6.]

You cited cases in support of the proposition that useful articles may be copyrightable on the basis of conceptually separable elements. One of the cases you cited is Great American Fun Corp. v. Hosung New York Trading, Inc. 960 F.Supp. 815 (S.D.N.Y. 1997) for the proposition that copyright protection extends only to those aspects of a useful object that are not essential to its functioning as a useful object. You also cited Hart v. Dan Chase Taxidermy Supply Co., Inc., 86 F.3d 320 (2d Cir. 1996) and Superior Form Builders, Inc. v. Chase Taxidermy Supply Co., 74 F.3d 488 (4th Cir. 1996), in support of your belief that, similar to those decisions regarding the fish mannequins at issue there, TRIM is designed primarily to convey its appearance and that its useful function is incidental to that primary purpose which is conceptually separable. A final case you cited in support of the principle that the artistic features of a useful article may be copyrightable separate from its utilitarian features is Gemini Industries Inc. v. Labtec Enterprises Inc., 31 USPQ2d 1776 (W.D. Wa. 1993) in which the court found that a blister card package had separable elements that were copyrightable which were pictorial and graphic.

In closing you stated that all these arguments support a determination that TRIM should be properly characterized as jewelry, the same as the belt buckles in Kieselstein-Cord v. Accessories by Pearl, Inc.

DECISION

After reviewing the application and arguments you presented, the Copyright Office Appeals Board affirms the Examining Division's refusal to register Applicant's work, TRIM, because the work is a useful article, a handbag, that does have some portions of decorative trim which, although conceptually separable, are, nevertheless, *de minimis* authorship and, thus, not copyrightable.

Copyright Protection for Useful Articles

The Board has determined that Applicant's work, TRIM, is a useful article as defined by copyright law. A useful article is defined as "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 (definition of "useful article"). TRIM is a handbag. Handbags traditionally serve the purpose of being containers, usually for small personal items, such as keys, money and personal identification. Typically, people carry handbags by a handle or strap while moving around. TRIM has the traditional appearance of a handbag because of its general design, shape and size. It appears to be capable of holding items and has a handle so that it can be carried. Since TRIM has the traditional design of a handbag and can function as a handbag, the Board has concluded that it is a useful object.

You argued that the primary purpose of TRIM is its aesthetic value, not its functional purpose as a handbag, so it should be regarded as jewelry like the belt buckles in Kieselstein-Cord. However, traditionally, handbags are not considered jewelry, although they can be fashion accessories similar to scarves, shoes, hats and belts. Jewelry typically has no purpose but to adorn the body; it is either hung around the neck, leg or arm; worn on the ears and fingers or fastened to clothing. In Kieselstein-Cord, the court found evidence that the belt buckle designs at issue there were regarded as jewelry in a way that is not traditional for belt buckles, even to the extent of being worn "around the neck or elsewhere on the body other than the waist." Kieselstein-Cord, at 991.

In further support of your point, you analogized the TRIM design to the fish mannequins at issue in Hart v. Dan Chase Taxidermy Supply Co., Inc. and Superior Form Builders, Inc. v. Chase Taxidermy Supply Co. In those cases, the courts considered whether fish mannequin designs used in taxidermy had any artistic elements that distinguished them from the human torso mannequins at issue in Carol Barnhart Inc. v. Economy Cover Corp. In Carol Barnhart, the court found that the human torso mannequins were useful articles and that there were no separable aspects from their functional purpose. The court in Superior Form Builders distinguished the fish mannequins from the human torso mannequins in Carol Barnhart on the basis that they were designed primarily to portray themselves and therefore were not useful articles. "The usefulness of the forms is their portrayal of the appearance of animals." Superior Form Builders, at 494. You urged the Board to use the same analysis to distinguish TRIM from the human torso mannequins and find that it is not a useful article.

In support of your argument that the TRIM design should not be considered a useful article, you also stated that, unlike the human torso mannequins at issue in Carol Barnhart, Applicant's design is "entirely a matter of aesthetic consideration." You have stated, "That it ... is capable of carrying personal items, make no difference." [Your 10/27/00 letter at 9.]

The Board disagrees with your argument because the design for TRIM has a utilitarian purpose, regardless of how aesthetically pleasing it may be. The purpose is that of a container to transport personal items. Unlike the fish mannequins that are designed for the sole purpose of portraying themselves, the TRIM design has a useful function of serving as a carrying case or container, in addition to its aesthetic appeal.

By your own admission, TRIM is a useful article. In your 10/27/00 letter, you state in various ways that TRIM is a useful article, including these statements: 1) it "is capable of serving the purpose of holding personal items," 2) "such a bag must presumably include a container portion capable of holding some number of personal items" and 3) it "also happens to serve a useful purpose of carrying personal items."

The Board has found no relevant case law to contradict its finding that TRIM is a useful article. For the purpose of analyzing your application for registration, the functional nature of a handbag requires that TRIM be treated as a useful article under copyright law, regardless of its aesthetic merit.

Citing Great American Fun Corp. v. Hosung New York Trading Inc., you stated that the fact that a work is a useful article does not necessarily disqualify it from copyright protection, but registration is possible if there is authorship that is either physically or conceptually separable from its utilitarian aspects. The Board agrees that a useful article may be entitled to copyright protection if it contains pictorial, graphic or sculptural features that "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." (Emphasis added.) 17 U.S.C. §101 (definition of "pictorial, graphic, and sculptural works").

Separability

The legislative history of the Copyright Act of 1976 provides some guidance on the separability analysis. Specifically, the House Report accompanying the Act states that:

> [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 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. 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. (Emphasis added.)

H.R. Rep. No. 94-1476, at 55 (1976).

The separability analysis used by the Office, which is based on the statutory definitions and legislative history discussed *infra*, is set forth in §505 of the Compendium of Copyright Office Practices, Compendium II (1984). Section 505.01 states that:

> Registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article. Determination of separability may be made on either a conceptual or physical basis.

You have not argued, however, that the handbag design has any physically separable aspects. Rather, you argue that TRIM has conceptually separable elements that are copyrightable.

Conceptual Separability. Conceptual separability exists when pictorial, graphic or sculptural features are "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. Section 505.03 of Compendium II also provides a useful example:

> Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration.[1]

You have identified aspects of the TRIM design that you argue are conceptually separable elements, which include the trim and buckle elements. [Your 5/22/00 letter at 11.] Although the Board does not agree that the buckle is conceptually separable, it does concede that the trim around the edges and sides of the handbag are conceptually separable. The buckle has a utilitarian purpose of keeping the handbag closed so that things do not fall out. As you pointed out, it is not necessary for a handbag to have a clasp. Nevertheless, if one is attached, it is a functional aspect of the useful object. "An

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[1] On page six of your first appeal letter, dated May 22, 2000, you analogized TRIM to a vase, stating that, "In the present TRIM design, the utilitarian feature is simply the ability to hold contents, no less than the similar utilitarian feature attributable to a fine vase, which may be no less a work of art." You made a similar statement on page 12 of that letter. The Copyright Office would regard a vase as a useful article since it serves the purpose of being a container. A vase would be subject to the same separability analysis as is applied to a handbag or any other useful article.

article that is normally part of a useful article is a 'useful article.' " 17 U.S.C. §101 (definition of "useful article"). Commenting on conceptually separable elements, the court in Norris Industries v. Intern. Tel. & Tel. Corp., 696 F.2d 918 (11th Cir. 1983), observed, "These items are ornamental, superfluous designs contained within useful objects." *Id.* at 923-24. The only elements of TRIM that are superfluous to its functional aspects is the dark trim around the edges and sides.

You also argued that the overall shape of the handbag was copyrightable. Citing Nimmer on Copyright, you argued that the Kieselstein-Cord and Esquire decisions are based on the view that conceptual separability exists when the aesthetic value of a useful article has transcended its functional purpose. In other words, buyers would purchase TRIM even if it could not function as a container. As evidence of this, you provided a statement regarding the extremely high prices that buyers are currently paying for TRIM. You argue that they would not pay such high prices merely for the purpose of having TRIM function as a handbag. However, the interpretation you offer is irrelevant to the Office's conceptual separability analysis as is discussed below and which has been judicially confirmed when it has been challenged in litigation. Also, whether people would buy TRIM even if it did not fulfill the function of a handbag is a theoretical question that is not before the Board. The information which we have before us indicates that the applicant's work does function as a handbag, as was discussed *infra*.

The "overall design ...of a utilitarian object, even if it is determined by aesthetic as well as functional considerations is not eligible for copyright." Esquire, Inc. v. Ringer, at 804. In that quote from Esquire, the court was interpreting this language from the legislative history: "The test of separability . . . does not depend upon the nature of the design -- 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." (emphasis added.) H.R. Rep. No. 94-1476, at 55 (1976). Section 505.03 of Compendium II states how the Office incorporates this principle into its treatement of the overall shape of a useful article in its review for conceptual separability:[2]

The test of conceptual separability, however, is not met by

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[2] One of the principle cases on conceptual separability is Esquire, Inc v. Ringer, 591 F.2d 796 (D.C.Cir. 1978) cert. denied, 440 U.S. 908 (1979). Esquire held that a Copyright Office regulation that preceded the current §505.03 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. Section 505.03 of Compendium II is a direct successor to the Copyright Office regulation that 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 USPQ2d 1714, 1718 (D.C. 1995), where the court stated that the conceptual separability test as it is currently enunciated in Compendium II "is consistent with the holding in *Esquire*, later cases decided under the present law, and the legislative history."

> 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. Thus, the fact that a lighting fixture might resemble abstract sculpture would not transform the lighting fixture into a copyrightable work. (Emphasis added.)

The overall shape of a useful object is not copyrightable because it cannot be perceived of independently of the useful article.

Aside from the fact that your argument is inconsistent with the standard of review discussed above, the Office also cannot accept your interpretation concerning aesthetic qualities and marketability of the handbag in question. Copyright law and settled case law does not give the Copyright Office authority to investigate or to consider in its determinations of registrability such matters. The Office cannot determine what motivates buyers to pay unusually high prices for useful objects or what makes a useful object highly sought after whether expensive or not. As a legal and practical matter, consideration of price and aesthetic appeal would greatly undermine the basis for refusing to register useful articles and threaten to render meaningless the rule that a useful object is not copyrightable unless there are separable elements. Unlike a court of law, the Copyright Office cannot evaluate separability on the basis of elements that are beyond the information required by the application for registration or that are beyond matters of general knowledge. Compendium II, §108.05. Therefore, the Office does not accept your interpretation of conceptual separability.

In further support of your arguments, you also cited Severin Montres, Ltd. v. Yidah Watch Co. in which the court found that a watch design was conceptually separable because the component parts of its functional aspects were capable of being designed in numerous ways.[3]
The fact that the aspects of the useful object that are part of its utilitarian nature could have been designed differently is not relevant with respect to the test of conceptual

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[3] The Office canceled the registration for the watch at issue in Severin Montres, Ltd. primarily because the separably identifiable matter was not copyrightable. The only separable aspect of that watch design was a single letter of the alphabet, the letter "G." Lettering and typographic ornamentation are not copyrightable. 37 C.F.R. §202.1(a) and (e).

separability that is used by the Copyright Office– a test frequently upheld by the courts and one not permitting protection for artistic aspects of a work that have the same shape as its functional aspects. "The mere fact that certain features ... could have been designed differently is irrelevant to the statutory definition of pictorial, graphic, and sculptural works." Compendium II, §505.03.

Finally, you cited Gemini Industries Inc. v. Labtec Enterprises Inc. in support of finding TRIM copyrightable as a container. However, the Board finds the container at issue in that case distinguishable from the TRIM design because that work included separable pictorial and graphic elements which is not true of the TRIM design. TRIM does not have any pictorial or graphic
elements that are separable from its utilitarian function. Pictorial and graphic elements typically consist of two dimensional drawings or designs which designs may incorporate text elements. The TRIM design does not have any such identifiable drawings or text elements within a design.

Originality

Although the Board agrees that the contrasting trim along the edges and sides of the handbag are conceptually separable, registration must still be denied because the level of creativity in those elements is *de minimis*.

The requisite level of creativity required for copyright is very low. The Supreme Court has stated 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" Feist at 363. 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. A work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. *Id.* at 362-363. An example would be alphabetical listings in the white pages of telephone books which the Supreme Court characterized as "garden variety...devoid of even the slightest trace of creativity." *Id.* at 362.

Even prior to Feist, Copyright Office registration practices following settled precedent recognized that some works of authorship contain only a *de minimis* amount of authorship and, thus, are not copyrightable. See Compendium of Copyright Office Practices, Compendium II, §202.02(a), (1984). With respect to pictorial, graphic and sculptural works, the class to which the separable trim design on this handbag belongs, Compendium II states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." Compendium II, §503.02(a), (1984). Compendium II recognizes that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability. *Id.* Section 503.02(a) of Compendium II states that:

> [R]egistration cannot be based upon the simplicity of standard ornamentation such as chevron stripes, the attractiveness of a conventional

fleur-de-lys design, or the religious significance of a plain, ordinary cross. Similarly, it is not possible to copyright common geometric figures or shapes such as the hexagon or the ellipse, a standard symbol such as an arrow or a five-pointed star. Likewise, mere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work. ... The same is true of a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations."

The trim around the sides and edges of the handbag in question have only a *de minimis* amount of creativity. The Board finds substantial support for its conclusion in case law. In John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986), the court upheld a refusal to register a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below, noting that the design lacked the minimal creativity necessary to support a copyright and that a "work of art" or a "pictorial, graphic or sculptural work ... must embody some creative authorship in its delineation of form." *See also*, Magic Marketing v. Mailing Services of Pittsburgh, 634 F.Supp. 769 (W.D. Pa. 1986) (envelopes with black lines and words "gift check" or "priority message" did not contain minimal degree of creativity necessary for copyright protection); Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F.Supp. 964 (E.D.N.Y. 1950) (label with words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lys held not copyrightable); Homer Laughlin China Co. v. Oman, 22 USPQ2d 1074 (D.D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection); Jon Woods Fashions v. Curran, 8 USPQ2d 1870 (S.D.N.Y. 1988) (upholding refusal to register fabric design consisting of striped cloth with small grid squares superimposed on the stripes where Register concluded design did not meet minimal level of creative authorship necessary for copyright). The trim on the handbag in question can be described in terms of a minor variation on simple rectangular shapes. It can also be described as slightly modified, softly rounded rectangular shapes which **follow the outline shape of the handbag itself and,** thus lack the necessary creativity to sustain a registration.

The Board finds that this trim, following the outline of the handbag, consists of uncopyrightable variation on elongated, rounded, rectangular shapes-- too simple to result in an overall work that rises to the level of copyrightable authorship. Like the alphabetical arrangement in Feist, the elongated rectangular shapes following the edges of the handbag fall within the category of simple, minimal authorship which Feist referred to as "entirely typical"or "garden variety" authorship. While a "simple arrangement" may contain enough authorship to meet the creativity standard, as Feist holds, some selections and arrangements fall short of the mark. The Board is unable to recognize in the decorative trim of the handbag any contribution that is "more than merely trivial."

For the reasons stated in this letter, the Copyright Office Board of Appeals affirms the refusal to register the claim. This decision constitutes final agency action on this matter.

Sincerely,

N. Petruzzelli

Nanette Petruzzelli
Chief, Examining Division
for the Board of Appeals
United States Copyright Office