December 14, 2001

Robert J. Patch, Esq.
Young & Thompson
745 South 23rd Street
Arlington, Va 22202

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COPYRIGHT
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Re: HERBAG
Copyright Office Control Number 60-703-988(Y)

Dear Mr. Patch:

101 Independence
Avenue, S.E.

The Copyright Office Board of Appeals has reviewed your request to reconsider the Examining Division's denial of a claim made on behalf of your client, Hermes International, to register a work denominated as sculpture which is a handbag design, entitled HERBAG. After reviewing all of the materials submitted in support of this claim, the Board affirms the Examining Division's refusal to register this work. It agrees with the Examining Division that the work is a useful article that does not have sufficient separable authorship to support a copyright registration.

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ADMINISTRATIVE RECORD

On April 22, 1999, the Copyright Office received a Form VA application to register your client's handbag design. On the application, you state that the work is a 3-dimensional sculpture.

In a letter dated November 18, 1999, Visual Arts Section Examiner, Geoffrey R. Henderson, refused to register HERBAG. In his letter of rejection, Mr. Henderson noted that the work "is a 'useful article' which does not contain any *separable* authorship needed to sustain a claim to copyright." He went on to explain that useful articles, without physically or conceptually separable authorship, are not subject to protection under copyright law. Mr. Henderson then described the test the Office uses to determine whether a work has separable authorship and concluded that all the elements of HERBAG are subsumed within its overall shape or configuration, and that consequently it did not contain the necessary separable authorship to warrant a registration.

In an appeal submitted on March 17, 2000, you asked the Copyright Office to reconsider its refusal to register HERBAG. Relying on *Kieselstein-Cord v. Accessories*

by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980), you argued that the aesthetic elements of your client's work are conceptually separable from its utilitarian elements. You analogized the Hermes HERBAG 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 pointed out that the HERBAG design, selling for over one thousand dollars,[1] is similar to the belt buckles in being valued beyond its functional worth. You also asserted that HERBAG could be readily distinguished 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, the HERBAG design need only be a "sack for its utilitarian purposes the remainder of the design thereof being entirely a matter of aesthetic consideration, 'added to or super-imposed upon an otherwise utilitarian article.'" First Appeal at 8. Quoting *Nimmer on Copyright*, you attempted to distinguish HERBAG 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, HERBAG's aesthetic appeal is so great that purchasers buy it for artistic reasons. You also stated, "There is no doubt that an Hermes HERBAG bag, even if incapable of holding items, would still be phenomenally attractive to the public, simply because of its beauty as art ...." First Appeal at 9-10.

Having argued that the HERBAG design has conceptually separable elements, you then conclude that these conceptually separable elements easily meet the minimum requirements for copyrightability without identifying any specific design features that fulfill these requirements. Instead you assert that "the full set of features of the present closure design cannot be accurately described as being 'inextricably interwoven' with its utilitarian aspects." First Appeal at 6.

In a letter dated June 16, 2000, Virginia Giroux, Attorney Advisor in the Examining Division, responded to your first appeal and upheld the refusal to register your client's work on the basis that HERBAG 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 HERBAG in light of the cases you cited, Ms. Giroux found that the work does not have any design elements that are separable from its utilitarian aspects.

On October 13, 2000, you submitted a second request for reconsideration. On page two of your second appeal, you characterized HERBAG as "a fashion accessory which is capable of serving the purpose of holding personal items." In addition to the arguments made in your first request for reconsideration, you also stated that the same analysis should be applied to HERBAG as the court applied to a watch in *Severin Montres, Ltd. v. Yidah*

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[1] Your appeal refers to a fax from Hermes DC which indicates that the HERBAG line is being sold for between $1,300 and $1,650.

Watch Co., 997 F.Supp 1262 (C.D.Cal. 1997). In that case, the court concluded that the watch had conceptually severable elements. You urge that a handbag may also be designed and constructed in an infinite variety of ways. In support of this position, you assert:

> 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 HERBAG design, however, includes detailed metal accents on the front clasp element as well as on either end of the top of the bag, a selection of contrasting but coordinating colors, a shape and arrangement of the cover, as well as 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.

Second Appeal at page 5. Quoting *Severin*, you state that your client's "decision to design the [work] in such manner had artistic rather than functional purposes." *Id.* 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, HERBAG 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 pictorial and graphic elements that were copyrightable.

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

DECISION

After the Board completed its review of all of the arguments you presented in both the first and second appeal and all other pertinent materials, it concluded that the Examining Division's refusal to register HERBAG is warranted. It agrees that HERBAG is a useful article and observes that while the handbag design contains a few decorative buttons which are conceptually separable, they reveal only *de minimis* authorship and, thus, are insufficient to support a copyright registration.

Copyright Protection for Useful Articles

The Board has determined that HERBAG 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"). HERBAG 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. HERBAG 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 and a shoulder strap so that it can be carried by hand or worn on the shoulder. Since HERBAG has the traditional design of a handbag and can function as a handbag, the Board concurs with the conclusion reached by the first examiner that this work is a useful object.

You argued that the primary purpose of HERBAG 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 632 F.2d 991.

In further support of your point, you analogized the HERBAG 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*, 74 F. 3d at 494. You urged the Board to use the same analysis to distinguish HERBAG from the human torso mannequins and find that it is not a useful article. Second Appeal at 9-11.

Drawing further support from *Superior Form Builders*, you argue that HERBAG should not be considered a useful article, and that, unlike the human torso mannequins at issue in *Carol Barnhart*, the present work is "unquestionably a permanent artistic object which stands on its own aesthetic merits." Second Appeal at 11. You have stated, the fact "that it is capable of carrying personal items, makes no difference." *Id.* at 9.

The Board disagrees with your conclusion. The design for HERBAG has a utilitarian purpose. Regardless of how aesthetically pleasing it may be, its purpose is to serve as a carrying case or container to transport personal items. Moreover, by your own admission, HERBAG is a useful article. For example, in your second appeal, you state: 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."

Unlike the fish mannequins that are designed for the sole purpose of portraying themselves, the HERBAG design has a useful function in addition to its aesthetic appeal. The Board thus agrees with the initial decision of the Examining Division that in examining your client's copyright claim, pursuant to copyright law, one must treat HERBAG as a useful article 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. Second Appeal at 7-8. 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." 17 U.S.C. §101 (definition of "pictorial, graphic, and sculptural works") (emphasis added).

Separability

The Board then turns to the test the Office applies in determining separability. This test is set out in the Compendium of Copyright Office Practices[2] and is based on the guidance found in the legislative history of the 1976 Copyright Act. The House Report accompanying the Act states:

> [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.

H.R. Rep. No. 94-1476, at 55 (1976) (emphasis added). The separability analysis used by the Office is based on the statutory definitions and legislative history discussed *infra* and is set forth in §505 of *Compendium II:*

> 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.

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[2] Copyright Office, *Compendium II, Compendium of Copyright Office Practices* (1984) (hereinafter *Compendium II*).

Compendium II §505.02. Section 505 then covers the different analyses used on a conceptual or physical basis. Since your argument is that HERBAG possesses conceptually separable elements that are copyrightable, the Board will consider that analysis.

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 also provides a useful example: "Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase,[3] could be considered for registration."

You have identified aspects of the HERBAG design that you argue are conceptually separable elements, which include the detailed metal accents, and the shape and arrangement of the cover. First Appeal at 11. Although the Board does not agree that the front clasp is conceptually separable, it does concede that the metal accents on the sides of the handbag are conceptually separable. The clasp has a utilitarian purpose of keeping the handbag closed so that things do not fall out. Although it is not necessary for a handbag to have a clasp, if one is attached, it is a functional aspect of the useful object. "An article that is normally part of a useful article is a 'useful article.' " 17 U.S.C. §101 (definition of "useful article").

The cover of the handbag also falls into this same category. 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. Because the shape and arrangement of the cover of HERBAG is part of the useful article, and thus a useful article itself, the only elements of HERBAG that are superfluous to its functional aspects are the metal accents on the sides of the handbag, which repeats the clasp design.

You further argue the copyrightability of the overall shape of the handbag, citing *Nimmer on Copyright,* and assert 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 HERBAG even if it could not function as a container. As evidence of this, you provided a statement

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[3] On page 6 of your first appeal, dated March 13, 2000, you analogized HERBAG to a vase, stating that, "In the present HERBAG 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." The Copyright Office would regard a vase as a useful article since it serves as a container. In other words no matter how fine, pleasing or expensive a vase is, it would still be subject to the same separability analysis applied to any other useful article. If the vase had either physically or conceptually separable authorship that warranted copyright, then a registration could be made.

regarding the high prices that buyers are currently paying for HERBAG. You argue that they would not pay such high prices merely for the purpose of having HERBAG function as a handbag. As discussed below, the interpretation you offer is irrelevant to the Office's conceptual separability analysis which has been judicially confirmed when it has been challenged in litigation. Also, whether people would buy HERBAG 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*.

In *Esquire, Inc. v. Ringer*, 591 F.2d 796, 804 (D.C. Cir. 1978) *cert. denied*, 440 U.S. 908 (1979), the court based its ruling as to separability on the language found in the legislative history and concluded that the "overall design . . .of a utilitarian object, even if it is determined by aesthetic as well as functional considerations is not eligible for copyright." The *Esquire* decision and the principle from the legislative history that it reflects[4] are incorporated into the Office's practices[5] regarding the treatment of the overall shape of a useful article in a conceptual separability analysis:

> 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. Thus, the fact that a lighting fixture might resemble abstract

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[4] "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." *H.R. Rep. No. 94-1476, at 55 (1976)*(emphasis added).

[5] *Esquire* remains one of the leading cases in any analysis of conceptual separability. In that case the court held that the regulation that preceded the current §505.03 properly prohibited copyright registration for the overall shape or configuration of an utilitarian article, no matter has aesthetically pleasing that shape or configuration may be. *Id.* at 800. Section 505.03 of *Compendium II* is a direct successor to the 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 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."

> sculpture would not transform the lighting fixture into a copyrightable work.

Compendium II § 505.03 (emphasis added). Thus, as stated in Office practices and legislative history, 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 such matters in its determinations of registrability. 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 agree with 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.[6]

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 separability that is used by the Copyright Office–a test 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 HERBAG copyrightable as a container. However, the Board finds the container

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

at issue in that case distinguishable from the HERBAG design because the work in *Gemini* included separable pictorial and graphic elements. Pictorial and graphic elements typically consist of two dimensional drawings or designs which may incorporate text elements. The HERBAG design does not have any such identifiable drawings or text elements within a design that are separable from its utilitarian function.

Originality

Although the Board agrees that the circle, or button at the sides of the handbag is conceptually separable, registration must still be denied because the level of creativity in a circle 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 Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 343 (1991). 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.* 499 U.S. 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.* 499 U.S. 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 II*, §202.02(a). With respect to pictorial, graphic and sculptural works, the class to which the separable circle design at either side of 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.* *Compendium II* further 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.

Id. § 503.02(a) (emphasis added).

The buttons or circles on the handbag in question have no more than 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 buttons on this handbag depict a simple shape and thus lack the necessary creativity to sustain a registration.

Neither did the Board find that the selection of two contrasting colors for the handbag adds creativity that as a whole rises to the level of copyrightable authorship. Like the alphabetical arrangement in *Feist*, these elements 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 buttons on the handbag any contribution that is "more than merely trivial."

CONCLUSION

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,

Marilyn J. Kretsinger

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for the Board of Appeals
United States Copyright Office