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January 28, 2002

Kathleen M. Olster, Esq.
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Re: Sephora, S.A.
Copyright Control Number: 60-6088369 (C)

Dear Ms. Olster:

The Copyright Office Board of Appeals has reviewed your request for reconsideration of the Office's refusal to register the work SEPHORA BOTTLE submitted by your client, Sephora, S.A. The Board has determined that this work cannot be registered. The item is a useful article that contains no copyrightable authorship that is physically or conceptually separable from the utilitarian function of the item.

**Administrative Record**

On August 15, 1997 , the Copyright Office received an application, deposit and fees for one work by Sephora, S.A; the work was described as a three-dimensional sculpture.

In a letter dated February 6, 1998, Copyright Office Examiner John M. Martin notified your colleague, Mr. Prout, that registration for SEPHORA BOTTLE was denied because it lacks copyrightable authorship that is physically or conceptually separable from the utilitarian function of the item.

**First Appeal**

In a letter received July 28, 1998, addressed to the Visual Arts Section of the Copyright Office, you sought reconsideration of the refusal to register SEPHORA BOTTLE, arguing that it possesses creative designs that are conceptually separable from the utilitarian functions of the work.

**Second Refusal to Register**

On March 17, 1999 Attorney-Advisor Virginia Giroux of the Examining Division responded to your request for reconsideration of the refusal to register SEPHORA BOTTLE.

Ms. Giroux explained the Copyright Office test for determining whether authorship is conceptually separable and, after applying that test, concluded that SEPHORA BOTTLE contains no separable artistic or sculptural authorship that is copyrightable.

**Second Appeal**

You replied in a letter dated November 11, 1999, the substance of which was nearly identical to your letter requesting the First Appeal, requesting reconsideration of the Office's refusal to register SEPHORA BOTTLE. You sought reconsideration of the refusal to register SEPHORA BOTTLE arguing that it contains creative authorship that is conceptually separable from the utilitarian functions of the work.

**DISCUSSION**

The Board of Appeals agrees that a useful article may be registered if it exhibits copyrightable authorship that is separable from the utilitarian aspects of the item. In reviewing SEPHORA BOTTLE, however, the Board has determined that there are no separable aspects of the work that exhibit copyrightable authorship.

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 SEPHORA 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 II, Copyright Office Practices 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, Copyright Office Practices (1984) ("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). You do not argue that there is any physically separable copyrightable authorship in SEPHORA BOTTLE. Therefore, we limit our discussion to conceptual separability, the sole issue raised in your appeal.

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. However, creative that shape might be, it remains the shape of the bottle and therefore is not conceptually separable from the utilitarian object itself.

The work in question is a perfume bottle shaped like a crescent moon with a flat base. The front of the bottle is convex, while the back is concave. Although aesthetically pleasing, the Board views these sculptural features as part of the overall shape and configuration of the bottle itself and not conceptually separable from the bottle's utilitarian function without destroying its basic shape.

As the Compendium II states, conceptual separability occurs when the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be

visualized on paper, for example, or as a free-standing sculpture, as another example, independent of the shape of the useful article, without destroying the basic shape of the useful article. Examples are the carving on the back of a chair or pictorial matter engraved on a glass vase. You do not claim the presence of such features in SEPHORA BOTTLE.

Your letter relies upon the separability test in Brandir Int'l v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987), and later reiterated in Nat'l Theme Productions v. Jerry B. Beck, Inc., 696 F.Supp 1348 (S.D. Cal. 1988). 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.

You have argued that SEPHORA BOTTLE is analogous to the mannequin head at issue in Pivot Point Int'l, Inc. v. Charlene Products, Inc., 816 F.Supp. 1286 (N.D. Ill. 1993). In that case the court did not rule the item was copyrightable, but merely held that the issue should be decided by a jury. Moreover, the court in Pivot Point has subsequently repudiated its 1993 decision and concluded, in granting summary judgment to the defendant, that the mannequin head at issue in that case was not copyrightable. Pivot Point Int'l, Inc. v. Charlene Products, Inc., 170 F. Supp. 2d 828 (N.D. Ill. 2001) (Easterbrook, J.).

You have also relied upon Severin Montres, Ltd. v. Yidah Watch Co., 997 F. Supp. 1262 (C.D. Cal. 1997). In Severin Montres, the court relied on a copyright registration of the subject watch as prima facie evidence of the validity of the copyright in the watch. However, the Copyright Office subsequently canceled the certificate of registration, a decision affirmed by the Appeals Board, on the ground that there was no copyrightable authorship in the watch. Decision

of September 1, 1998, "Watch and Bracelet Design," Control No. 60-608-4721(S).

You have also relied upon Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc., 95 F.R.D. 95 (D.Del. 1982), for the proposition that articles useful for display may be protectible. We do not disagree with that basic proposition. However, the fact that such useful articles *may* be protectible does not mean that all such articles *are* protected by copyright. Copyrightability depends on whether the particular useful article in question contains copyrightable authorship that is physically or conceptually separable from the utilitarian function of the item. To the extent that you may be asserting that the facts of Trans-World support a finding that SEPHORA BOTTLE is copyrightable, we note that Trans-World simply denied a defendant's motion for summary judgment, finding triable issues of fact. The court did not find that the display at issue was copyrightable.

Finally, you have noted that in Esquire v. Ringer, the court noted that the Register has recognized that candlesticks, useful for holding candles, are entitled to copyright protection. See 591 F.2d at 802 n.20. But the court in Esquire simply noted that the Register asserted that candlesticks belong "to a small special category of articles . . . (whose) utilitarian function . . . has now atrophied." That statement has no relevance in the context of perfume bottles, which manifestly are created for the utilitarian function of containing perfume.

For the reasons stated above, the Copyright Office Board of Appeals concludes that SEPHORA BOTTLE cannot be registered for copyright protection. This decision constitutes final agency action.

Sincerely,

David O. Carson

David O. Carson
General Counsel
for the Appeals Board
United States Copyright Office

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