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April 9, 2008

Mr. Jeffrey H. Brown
Michael Best & Friedrich
Two Prudential Plaza
180 North Stetson Avenue
Suite 2000
Chicago, IL 60601-6710

RE: FANCIFUL ORNAMENTAL BOTTLE DESIGNS 1-9
Control No. 61-309-9525 (S)

Dear Mr. Brown:

The Copyright Office Review Board has considered your second request to review the Examining Division's refusal to register the individual claims in the FANCIFUL ORNAMENTAL BOTTLE DESIGNS 1-9, submitted on behalf of MSRF, Inc. We apologize for the delay in getting this response to you. After reviewing all materials submitted in support of the claims and carefully considering your arguments, the Review Board has determined that all nine of the Bottle Designs cannot be registered because they are useful articles that contain no separable and copyrightable authorship.

I. ADMINISTRATIVE RECORD

A. Initial submission

On January 8, 2004, you submitted for registration claims to copyright in nine works entitled FANCIFUL ORNAMENTAL BOTTLE DESIGNS, numbered 1-9, on behalf of MSRF, Inc. The photographic deposits in these works depict transparent glass bottles apparently containing individual slices or other pieces of fruits, vegetables, and herbs. The applications for registration have the boxes checked at space 2 to indicate that "3-Dimensional sculpture" describes the nature of authorship in these works.

On March 9, 2004, Visual Arts Examiner Joy Burns refused registration for all nine Bottle Designs on the grounds that they are useful articles that do not contain authorship which is both separable and copyrightable. Ms. Burns noted that while pictorial, graphic, and sculptural works are registrable, designs of useful articles can be considered as pictorial, graphic, or sculptural works only if, and to the extent that, they incorporate such features that can be separately identified from and have an independent existence from the useful articles, either physically or conceptually. Letter from Burns to Brown of 3/9/2004, at 1.

Ms. Burns then set forth *Compendium of Copyright Office Practices II* [*Compendium II*] requirements for conceptually separable authorship, and clarified that separability is not met by analogizing the general shape of a useful article to a work of modern sculpture. In such cases, the alleged artistic features and the useful article cannot be perceived as having separate, independent existences. She further noted that where features are an integral part of the overall shape or contour of the useful article, no registration is possible. Finally, Ms. Burns examined the copyrightability of the features which may be identifiable as separable, and found them not copyrightable inasmuch as they did not contain the

requisite amount of creative authorship within the meaning of the copyright law and settled case law. *See Feist Publications, Inc. v. Rural Telephone Service Company,* 499 U.S. 340 (1991). Letter from Burns of 3/9/2004, at 2.

B. First request for reconsideration and Office response

On July 6, 2004, you requested reconsideration of Examiner Burns' decision. You acknowledge that the sufficiency of the creative content was to be measured by the standards enunciated in *Feist*, but asserted that the Bottle Designs are original works of authorship under that standard. You pointed out that the level of creativity necessary is "very slight" and "modest." You cited additional authorities and noted that the threshold of creativity is so minimal that simple shapes are registrable when "selected or combined in a distinctive manner indicating some ingenuity," citing *Atari Games Corp. v. Oman,* 888 F.2d 878, 883 (D. C. Cir. 1989)*, Concord Fabrics v. Marcus Brothers Textile Corp.,* 409 F.2d 1315 (2d Cir. 1969), and *In Design v. Lynch Knitting Mills,* 863 F.2d 45 (2d Cir. 1988), *inter alia.* Letter from Brown to Chief, Receiving and Processing Division, of 7/6/2004, at 1-2.

You suggested that Ms. Burns' decision may have rested on an undue focus on dissecting the components of the work, and point out some components that should be considered, not in isolation, but, rather, in their combination with other elements. By way of example, you indicate that the arrangement of letters to spell B-A-T-H and V-I-N-E-G-A-R, combined with the putative original shapes of designs #1 and #5, respectively, create copyrightable 3-dimensional sculptures. You enumerate the other designs and assert that the "original, artistic bulges, twists, and artful cuts" of those bottles also create copyrightable sculptural works. You also assert that the overall "look and feel" of the works add up to copyrightable as a whole. Finally, you assert that the creativity in the designs at issue exceed those in the designs found copyrightable by the courts in such cases as *Concord Fabrics* and *In Design*. Letter from Brown of 7/6/2004, at 2-3.

On September 16, 2004, Attorney Virginia Giroux responded on behalf of the Examining Division that, after review in light of the points raised, the works at issue here still could not be registered on the basis of lack of sufficient authorship that is both separable and copyrightable. Ms. Giroux again explained Congress' prohibition on copyright of designs of useful articles unless the designs contain independently separable pictorial, graphic, or sculptural authorship and are capable of existing independently of the utilitarian aspects of the article without losing their basic shape." Letter from Giroux to Brown of 9/16/2004, at 1.

Ms. Giroux noted that the Copyright Office's test for conceptual separability is enunciated in *Esquire v. Ringer,* 591 F.2d 796 (D.C.Cir. 1978) as expressed in *Compendium II of Copyright Office Practices*, Ch. 500, § 505.03 (1984). She noted that this test generally finds conceptually separable features where sculptural features are recognizable as a work which can be visualized on paper as a free-standing sculpture, juxtaposed next to the useful article, without destroying the shape of the article itself. Letter from Giroux of 9/16/2004, at 2.

Ms. Giroux noted further that the letters that spell "Bath" and "Vinegar" were not copyrightable, citing Copyright Office regulations at 37 C.F.R. § 202.1, and that as the bottles' bulges and curves were all part of the overall configuration of the bottles themselves, they were not copyrightable. Letter from Giroux of 9/16/2004, at 3. Disagreeing with your assertion that a work's "look and feel" is copyrightable, she maintained that where a work produces a certain effect or impression, that effect or impression does not mean that a work is copyrightable but that all works must be examined in terms of their creative content. *Id.* at 3-5. Distinguishing the case law you cited, Ms. Giroux observed that the creative content in the arrangements of geometric shapes contained in the works at issue in the cases which you cited was more substantial than that contained in the Bottle Designs at issue here.

Finally, Ms. Giroux drew attention to the legislative history that clarified Congress' intent to exclude from coverage the shape of an industrial product, even if aesthetically satisfying and valuable, in the absence of separately identifiable and independently existing artistic features that are distinct from the overall configuration of that industrial product. On that basis, Ms. Giroux again refused registration for the nine Bottle Designs. *Id.*

C. Second request for reconsideration

On January 13, 2005, you appealed to the Review Board in a second request for reconsideration. Your request acknowledges that the copyright law excludes useful articles from coverage. However, you assert that the conceptual separability of the sculptural aspects of these bottles has been given short shrift. Letter from Brown to Copyright Office Review Board of 1/13/2005, at 1. You point out that you are not attempting to register utilitarian aspects of the Bottle Designs but that you want to register elements that "can clearly be identified as reflecting the designer's artistic judgment exercised independently of functional influences," asserting that that is the "hallmark of conceptual separability." Letter from Brown of 1/13/2005, at 1-2. You assert that the bottles are "works of artistic craftsmanship and [that they] are perceived as such in the marketplace, being displayed in special stores rather than in the food section of grocery stores. *Id.* at 2.

You assert that *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980), should be applicable to these bottle designs; *Kieselstein-Cord* is a case in which the court found that, where the utilitarian function is subsidiary to the primary ornamental aspect of the work, the ornamental aspect is conceptually separable and the work is capable of copyright protection. Letter from Brown of 1/13/2004, at 2.

II. DESCRIPTION OF WORKS[1]

Design #1 consists of a rectangular bottle with taped lid. The block capital letters "B" and "A" are symmetrically lined up above "T" and "H" and are placed inside an indented rim around the bottle. Design #2 is a triangular-shaped bottle tapering at the top with two, urn-like handles positioned under the bottle top; the bottle top appears to be wrapped in cord. The upper portion of Design #3 is a truncated cone shape separated by a circular mid-section whose bottom portion is a similarly truncated inverted cone, indented on the side. The top and neck of this bottle design are wrapped in cord and tied near the top. Bottle Design #4 appears to be a somewhat flattened pear shape (*e.g.*, similar to a "Coca-Cola" bottle shape) with a taped closure at the top. Design #5 is a taller version of Design #1, but the neck is wrapped in cord, and the cord is knotted at the top. The word"Vinegar" embossed on the glass surface of the bottle is split into its letters in three horizontal rows: "V" "I" "N", is symmetrically situated above "E"G", which is lined up above "A"and "R." Design #6 appears to consist of triangular glass sides which have a truncated triangular bottom topped by a small globe shape. The short-necked top is wrapped in cord and knotted. Design #7 is a long necked bottle with a circular bottom-half that leans at a 45-degree angle on a slightly flared flat base (for support). The neck is wrapped in cord. Design #8 is a bottle in the shape of a lower case letter "b". The top portion of the "b" is wrapped in cord and knotted vertically at the beginning of the b's curvature. This bottle is slightly flared and flat at the bottom for support. Design #9 is a long-necked narrow bottle, with cord wrapped around the neck, and with unevenly spaced square indentations along both sides of the glass, in the manner of ladder rungs.

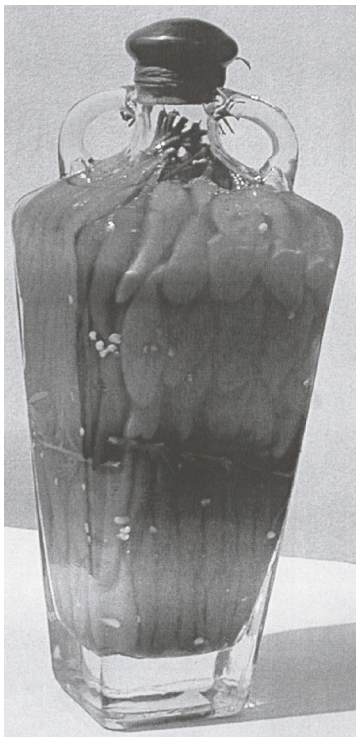
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[1] The description of the bottle designs is confined to the bottles themselves and does not describe their contents, much of which cannot be distinguished from the photographic deposits submitted. The assumption that the subject of the claims is the bottles themselves is derived from the indistinct contents of the photographs, the titles of the works, and your descriptions and discussions of them (*e.g.*, "The mere fact that the Applicant's works may be used to store fruits, vinegars, or salts should not render the artwork non-registrable." Letter from Brown of 1/13/2005, at 2).

The photographic deposits for the nine bottle designs which you have submitted are reproduced here.



FANCIFUL ORNAMENTAL BOTTLE DESIGN #1



FANCIFUL ORNAMENTAL BOTTLE DESIGN #2



FANCIFUL ORNAMENTAL



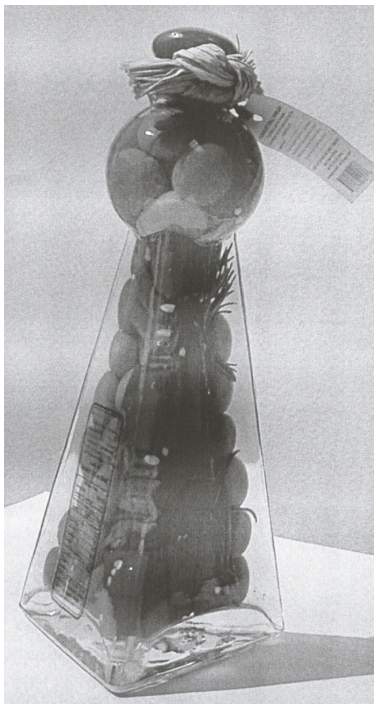
FANCIFUL ORNAMENTAL

BOTTLE DESIGN #3



FANCIFUL ORNAMENTAL BOTTLE DESIGN #5

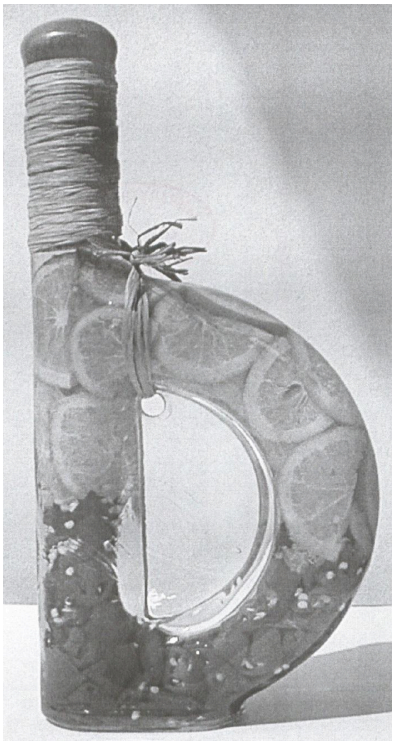
BOTTLE DESIGN #4



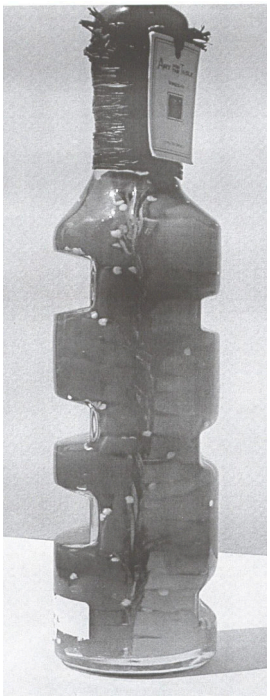
FANCIFUL ORNAMENTAL BOTTLE DESIGN #6



FANCIFUL ORNAMENTAL BOTTLE DESIGN #7



FANCIFUL ORNAMENTAL BOTTLE DESIGN #8



FANCIFUL ORNAMENTAL BOTTLE DESIGN #9

III. DISCUSSION

The following discussion responds to the arguments you have raised and explains the Office's reasons for refusing to register the Bottle Designs at issue here.

You do not dispute that these works are useful articles or that either conceptual or physical separability is needed in order for these Bottle Designs to be considered sculptural works. Letter from Brown of 1/13/2005, at 1: "[A]pplicant seeks to register the aesthetic, ornamental features that are conceptually separable from the utilitarian features of the Bottle Designs. Applicant has not sought to register any mechanical or utilitarian aspect of the Bottle Designs." Your discussions have focused on conceptual separability; physical separability is not present in these works; *i.e.,* you have not asserted that the sculptural features of the bottles can be physically separated from the bottles themselves. Your second request for reconsideration addressed conceptual separability in distinction to your first request for reconsideration which focused on your position that the nine bottle designs at issue here are sculptural works which evidence the necessary minimal degree of creativity under *Feist* to support copyright and, thus, a registration claim. *Feist*, 499 U.S. at 345 (1991).

We first address, *below*, the separability issue for the nine bottle designs, followed by our discussion of the creativity issue for these bottles when the bottles are considered in their non-functional aspects as sculptural works.

A. Useful articles and separability

You argue that your client, MSRF, Inc., is seeking to register the "aesthetic, ornamental features that are conceptually separable from the utilitarian features of the Bottle Designs" and is not seeking to register "any mechanical or utilitarian aspect of the Bottle Designs." Letter from Brown of 1/13/2005, at 1-2. You further indicate that the design elements for which your client seeks registration "can clearly be identified as reflecting the designer's artistic judgment exercised independently of functional influences." *Id.,* at 2. You call this explanation the "hallmark of conceptual separability." *Id*. In support of this

position, you cite *Kieselstein-Cord,* 632 F.2d 989 (2d Cir. 1980). We take this opportunity to set out the Copyright Office's position with respect to useful articles and separable authorship.

As a general proposition, copyright protection does not extend to a useful article, defined 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. However, works of artistic craftsmanship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* § 101. As you correctly note in your second request for reconsideration, the design of the useful article will be protected "only 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." *Id*; Letter from Brown of 1/13/2005, at 1. In stating that this separability can be physical or conceptual, Congress has explained 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 . . . 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).

Physical separability means that the subject pictorial, graphic or sculptural features must be able to be separated from the useful article by ordinary means. *Compendium II,* Ch. 500, § 505.03 - 505.04 (1984). Conceptual separability means that the subject features are "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, *i.e.*, the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works – one an artistic work and the other a useful article." *Compendium II*, Ch. 500, § 505.03. For example, while a carving on the back of a chair cannot readily be physically separated from the chair, it can easily be conceptually separated because one could imagine the carving existing as a drawing. The chair, meanwhile, would still remain a useful article having retained its basic shape, even absent the carving. The carving would therefore qualify as conceptually separable.

1. Case law

As explained in *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be." In that case, the Office had refused to register an outdoor lighting fixture which arguably contained non-functional, purely aesthetic features. The court upheld the Office's refusal, noting that "Congress has repeatedly rejected proposed

legislation that would make copyright protection available for consumer or industrial products." *Id.*[2] Similarly in *Norris Industries, Inc. v. International Telephone & Telegraph Corp.*, 696 F.2d 918, 924 (11th Cir. 1983), *cert. denied,* 464 U.S. 818 (1983), the court held that a wire-spoked wheel cover was not entitled to copyright protection because it was a useful article used to protect lugnuts, brakes, wheels and axles from damage and corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself. You argue, however, that conceptual separability exists whenever the utilitarian function of a useful article is " 'subsidiary' to the primary ornamental aspect of the work." Letter from Brown of 1/13/2005, at 2, citing *Kieselstein-Cord*, at 993.

As we have just stated, the Copyright Office follows the articulation of conceptual separability set forth in *Esquire* and as it is explained in *Compendium II,* Ch. 500, § 505.03. The Office's test was confirmed in an action against the Copyright Office in *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995). *Custom Chrome* was an action brought under the Administrative Procedure Act [APA], 5 U.S.C. §§ 701-706, based on an assertion that the Copyright Office's action refusing registration for twenty-three motorcycle parts was arbitrary and not in accord with the law. At *1. The District Court for the District of Columbia held that the Office's determination, under the Office's separability test found in *Compendium II*, that the motorcycle parts did not contain separable features was reasonable and consistent with the copyright statute and with "declared legislative intent." At *12. Because *Custom Chrome* was an APA action, the Court did not determine which of the several separability tests available from legal scholars and from case law is the correct one. The Court simply stated that "... so long as the Copyright Office has offered a reasonable construction of the copyright statute, its judgment must be affirmed even if this Court were to accept Custom Chrome's assertions that the duality test would support its copyright claims." At *15. We point to *Custom Chrome* to emphasize that *Compendium II's* separability test, centering on the general shape of the useful article, is consistent with "later cases decided under the present law and the legislative history," *Custom Chrome* at *16, in denying protection to the shape of an industrial product even though it may be aesthetically pleasing.

Further, *Compendium II* states that the shape or configuration of supposedly artistic features cannot be considered to provide the requisite separability merely because the features are nonfunctional. *Id*. at Ch. 500, § 505.03. While an author's artistic judgment may, indeed, influence design elements, those elements must themselves also meet the requirements of separability and originality. Your argument that the works in question here are perceived as works of artistic craftsmanship in the marketplace and are routinely displayed as art does not carry the day; as we have explained, unusual or aesthetically pleasing objects are eligible for copyright protection only to the extent that they exhibit features which meet the Office's separability tests, those tests founded on statutory provisions and on the legislative history of the 1976 Copyright Act [1976 Act].

2. Separable features are not present under any of the separability tests

As we have discussed, *above*, the Copyright Office is guided by *Esquire* with respect to the shape of useful articles. Relying on explicit statements in legislative history, the *Esquire* court held that, despite an aesthetically pleasing, novel or unique shape, the overall design or configuration of a utilitarian object may not be copyrighted unless it is "capable of existing as a work of art independent of the utilitarian article into which [it is] incorporated." *Id.* at 803-04. You have admitted that the nine works in question here are, indeed, useful articles but you have also taken the position that the articles, glass bottles, exhibit "ornamental features that are conceptually separable from the utilitarian features of the Bottle Designs." Letter from Brown of 1/13/2005, at 1. In further arguing for the separable features, you state that the "design elements of the works for which registration is sought can clearly be identified as reflecting the

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[2] Although *Esquire* was decided under the 1909 version of the Copyright Act, its reasoning is, nevertheless, applicable to cases arising under the 1976 Act. "[T]he 1976 Act and its legislative history can be taken as an expression of congressional understanding of the scope of protection for utilitarian articles under the old regulations." 591 F.2d at 803.

designer's artistic judgment exercised independently of functional influences." *Id*., at 2. In arguing for separability, you have implied that separability would be found under the test proffered by Professor Denicola. We apply below the Office's *Compendium II* test, the Denicola test, and the principle found in *Kieselstein-Cord*, as we analyze the possibly separable features of these nine glass bottles.

a. *Compendium II*

Under this test, we seek elements in the useful articles, *i.e.*, in the glass bottles, that can be "clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, *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,* Ch. 500, § 505.03 The only elements associated with the bottles in question that could possibly be eligible for copyright registration would be those that adorn or embellish these functional articles. Of these, we can identify only two minimal elements: the capital letters B-A-T-H on design # 1; the capital letters V-I-N-E-G-A-R on design # 5; any printed label on the side[s] of a bottle listing the contents of the bottle as on design # 6.[3] Although these features may fairly be said to be conceptually separable from the bottle– in the *Compendium's* principle, they can be imagined as separate features without mentally destroying the overall bottles' shape and configuration– such features do not represent individually copyrightable elements. *See below* for our analysis of copyrightability. The bottle designs in the shapes of rectangles, modified triangles, two cone-like shapes divided in the middle of the bottle by a circular shape, a modified pear-shape, bottles consisting of a flat-bottomed circle with an elongated neck, bottles in the shape of the small-letter "b," and a saw-toothed or ladder-step-shaped bottle, all do not reflect conceptually separable features because the shapes of the bottles are just that – the overall configuration of the useful articles. And, in the terms of the legislative history of the copyright law as well as of *Compendium II*, the bottle shapes represent the "shape[s] of an industrial product [which] may be aesthetically satisfying and valuable," H.R. Rep. No. 94-1476, at 55, but which shape Congress did not intend to protect under the current copyright law. Even aesthetically pleasing shapes and configurations are not the subject of copyright: "independence from the 'utilitarian aspect of the article' does not depend upon the nature of the design..." *Id*.

Again, separable elements incorporated into a useful article can warrant copyright protection in and of themselves provided they embody a sufficient amount of creativity. With respect to these nine glass bottles, the supposedly "artistic shapes, viewed in their entirety," the "original, artistic bulges, twists, and ornamental cuts,' [Letter from Brown of 7/6/2004, at 2], are clearly parts of the bottles which, by definition, cannot be separable, and any *symbolism* they might possess would not bear upon their copyrightability. *Compendium II*, Ch. 500, § 503.02(a) ("Copyrightability depends upon the presence of creative expression in a work, and not upon . . . symbolic value."). The Office can consider only those sculptural elements actually expressed in the three-dimensional design, not the symbolic value they may have to certain viewers. Any separability analysis of the work in question here as that analysis is made under *Compendium II* necessarily arrives at the point where registration must be refused. Under the conceptual separability test, there are no segments or portions of the glass bottles in question which can be separated out from the overall shape or configuration of the individual bottle and simultaneously stand beside the useful article as independent works of art without conceptually destroying the basic shape of the useful article.

b. Denicola test

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[3] Any printed label or cord or straw-like ribbon tied around, or adhering to, the various bottles may be said to be physically separable from the bottles themselves. However, such physically separable elements, although associated with the bottles, represent only *de minimis* listings of content of the bottles or pre-existing cords or ribbon which are not themselves the original authorship of your client, MSRF, Inc. Such pre-existing elements might be considered part of the overall bottle design but, given the nine glass bottle contours' lack of separable portions or identifiable features, such few, uncopyrightable pre-existing factors do not raise the level of authorship in these bottle designs.

We have noted that your January 13, 2005, second request for reconsideration refers to the nine bottle designs' "reflecting the designer's artistic judgment exercised independently of functional influences." Letter from Brown of 1/13/2005, at 2. Although you have not explicitly stated so, this is, in terms of copyright, a reference to Professor Denicola's separability test for useful articles. Having found these nine bottle designs wanting in separable features under *Compendium II's* test, we now turn to the alternative separability tests to which you have alluded to argue for separability. One such test is Professor Denicola's test as adopted by the *Brandir* court. *Brandir International, Inc. v. Cascade Pacific Lumber Co.,* 834 F.2d 1142 (2d Cir. 1987).

Judging a creator's intent, given the factual circumstances of creation, and determining whether design elements in a particular work reflect "the designer's artistic judgment exercised independently of functional influences," *Brandir*, 834 F.2d at 1145, is not the type of judgment the Office normally undertakes in its examining process. Such judgments would necessarily rely on interpreting the specific actions surrounding the creation of a work; these actions occur outside the registration process. Any investigation and questioning of the method and circumstances of creation lie beyond the administrative capability of the Office. *See, e.g.*, *Compendium II*, Ch. 100, § 108.05. Thus, the Office uses as its tests for separability those adopted in *Esquire* and found in *Compendium II*, *above*, in carrying out its mandate at 17 U.S.C. § 410(a) to examine works submitted for registration under the copyright law. However, judicial acceptance of separability tests other than those found in *Compendium II* leads us to analyze the nine glass bottle works in question here under certain of those alternative tests to which you have alluded in order to determine as objectively as possible whether the nine glass bottle designs do, indeed, lack any separable features which might be subject to copyright registration.

You have cited in your first request for reconsideration [Letter from Brown of 7/6/2004, at 2] a number of features of the nine glass bottles at issue here which represent "distinctive, original sculptural depiction," "capable of being identified apart from the utilitarian aspects" of the bottles. *Id.* These "distinctive" features are: bulges, twists, cuts, and their overall arrangement. *Id.*, at 3. Such features are part and parcel of the shape of the bottles; in other words, the twists, the angles at which the glass bottles are set, the indentations along the side of the bottle, the shaping of the bottle into identifiable letters of the alphabet– all these features are descriptions of the overall shape and configuration of the bottles and, as such, cannot be separated out from the bottles which, in their essence, are useful. Under the principle of the Denicola test, the listed aspects of the bottles are integral to the glass bottles themselves– subsumed within the glass bottles– and thus part of something that has utilitarian purpose: the bottles are containers for the storing or holding of things. The nine designs of the bottle designs are part of an object that essentially serves a purpose.

Under the Denicola test, "copyrightability ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations." Robert C. Denicola, "Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles," 67 *Minn. L. Rev.* 741 (1983). Under this guideline, the nine glass bottle designs are, in their entireties, objects for storing, holding, or conserving other objects and any aesthetic characteristics of the bottles do not negate the usefulness and facility for storage. Thus, the nine bottle designs fail the Denicola test because, in Professor Denicola's words, the bottle designs are not comparable to the statuettes used in the lamps in the Mazer case: ".... the Mazer statuettes remain copyrightable despite their use as lamp bases, because their form is not responsive to utilitarian demands." *Id*. at 742-743, citing *Mazer v. Stein*, 347 U.S. 201 (1945). Although the bottle designs may be novel and aesthetically pleasing, they are nevertheless created in a way that allows them to function as holders or storage containers, meeting the utilitarian and functional demand of such storage – no matter the material or objects within the containers. Thus, the form of the containers does not "reflect purely aesthetic visions" [*id*. at 743] because the containers possess the necessary elements [container and top] to constitute a useful container. In *Brandir's* words, "if 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." 834 F.2d at 1145. Such is the case with the nine glass bottle designs.

c. *Kieselstein* principle

You have also cited *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989 (2d Cir. 1980) for your position that the nine glass bottle designs at issue here "are art and are considered as art by those who acquire them. The Copyright Act provides for protection as such." Letter from Brown of 1/13/2005, at 2. The belt buckles at issue in *Kieselstein* do not provide your client a foundation for registration. *Kieselstein* involved two sculptured belt buckles which the court described as being "on a razor's edge of copyright law." *Id.* at 990. The Copyright Office had registered the two belt buckles on the basis that their sculptural features constituted separable artistic authorship. While the court did analogize the belt buckles to jewelry, as you have cited [Letter from Brown of 1/13/2005, at 2], the court also explicitly applied the separability test for useful articles. In upholding the Copyright Office's registration of the two belt buckles, the court concluded: "[w]e see in appellant's belt buckles conceptually separable sculptural elements..." *Id*. at 993. The belt buckles contained conceptually separable ornamentation that was not part of the general contours of the buckle itself.[4] While the nine glass bottle designs at issue here may be aesthetically pleasing, they are still functional, and all of the purported design elements to which you cite are inextricable parts/aspects of the overall shape and contour of the bottles themselves. We do not, moreover, consider *Kieselstein* precedent for the Board's categorizing the bottles at issue here as "art for the table" to a degree that negates the bottles' usefulness. The Copyright Office does not deny that the nine bottles may be subjectively viewed by some as decorative art, especially when the bottles are filled with "vinegar, fruits, vegetables, or salts" and are sold, as filled, "in specialty stores and in gift or housewares departments with other decorative items and works of artistic craftsmanship." Letter from Brown of 1/13/2005, at 2. The Office cannot, however, ignore the fact that the nine glass bottles at issue here are subject to the law's separability consideration. As such, any registration for the bottle designs must be premised on the copyrightability of separable features within the bottle designs and the Office finds no features which are both separable and copyrightable. We analyze the separable features, *below*, for copyrightability.

B. The standard for creativity

Separable elements incorporated into a useful article can warrant copyright protection in and of themselves provided that they embody a sufficient amount of creativity. *Compendium II,* Ch. 500, § 503.02(a) ("Copyrightability depends upon the presence of creative expression in a work, and not upon . . . symbolic value.")

An artistic feature which may be separable from a utilitarian object does not necessarily mean that it will merit copyright protection, either in itself or in combination with the useful article as an arrangement. All copyrightable works, be they sculptures, engravings or otherwise, must qualify as "original works of authorship." 17 U.S.C. § 102(a). The term "original" consists of two components: independent creation and sufficient creativity. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991). First, the work must have been independently created by the author, *i.e.*, not copied from another work. The Office accepts at face value the assertion on the application for registration that your client, MSRF, Inc., independently created these glass bottle designs. Therefore, the first component of the term "original" is not at issue here. Second, the work must possess sufficient creativity. In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist*, where the Supreme Court held that only a modicum of creativity is necessary.

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[4] Please note that although the Office determined that the belt buckles embodied sufficient creativity in order to sustain registrations, the court expressly declined to address the issue of originality in its opinion. *Kieselstein-Cord*, 632 F.2d at 991.

The Court stated that the requisite level of creativity is "extremely low"; "even a slight amount will suffice." *Feist*, 499 U.S. at 345. However, the Court also ruled that some works (such as the work at issue in that case) fail to meet the standard. 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 a work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359; *see also* 37 C.F.R. § 202.10(a) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."); 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 2.01(B) (2002) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.")

Even prior to *Feist*, the Copyright Office recognized the modest, but existent, requisite level of creativity necessary to sustain a copyright claim. *Compendium II* states, "Works that lack even a certain minimum amount of original authorship are not copyrightable." *Compendium II*, Ch. 200, § 202.02(a). With respect to pictorial, graphic and sculptural works, *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Id.* Ch. 500, § 503.02(a). In implementing this threshold, this Office, as well as courts, has consistently found that standard designs and geometric shapes are not sufficiently creative in thmselves to support a copyright claim. *Id.* ("[R]egistration cannot be based upon the simplicity of standard ornamentation . . . .").[5]

Of course, some combinations of common or standard design elements contain sufficient creativity with respect to how they are combined or arranged to support a copyright. *See Feist*, 499 U.S. at 358 (the Copyright Act "implies that some 'ways' [of compiling or arranging uncopyrightable material] will trigger copyright, but that others will not;" determination of copyright rests on creativity of coordination or arrangement). However, merely combining non-protectible elements does not automatically establish creativity where the combination or arrangement itself is simplistic or trivial. For example, the Eighth Circuit upheld the Register's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in cursive script below the arrow. *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986). *See also Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) ("It is true, of course, that a *combination* of unprotectible elements may qualify for copyright protection. But it is not true that *any* combination of unprotectible elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectible elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.") (emphasis in original) (citations omitted)

After again examining the nine bottle designs at issue here and in light of the above-described legal framework, the Board has determined that the bottles themselves are intrinsically useful articles that contain only a very few separable features. These separable features, however, are not copyrightable in themselves. As we have enumerated these features, *above,* they include printed labels listing contents of the bottles; an individual word on a bottle where the letters of the word are inscribed on the surface of the glass bottle; foil-type material wrapped around the top or opening of the bottle; cord or straw-like material wrapped around the opening of the bottle.

We note your argument that the bottle designs at issue here should be considered in their entirety, *i.e.*, the "overall arrangement, size, and shape of each of the bottles." Letter from Brown of 7/6/2004, at 3. As we have explained, the bottles themselves as far as their size, shape, contours, and

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[5] *See also, id.* Ch. 200, § 202.02(j) ("Familiar symbols or designs . . . or coloring, are not copyrightable."); *id.* Ch. 500, § 503.03(b) ("No registration is possible where the work consists solely of elements which are incapable of supporting a copyright claim."); 37 C.F.R. § 202.1(a) ("[F]amiliar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained.").

lines are useful articles and, as such, are not the subject of copyright. The few modifications to the bottles which may be said to be separable– a few letters inscribed into the glass of a bottle, a label attached to a bottle, foil-type material or cord-type material or string wrapped around the upper portion of a bottle– these simple elements are not numerous enough nor do they in themselves represent sufficient copyrightable authorship to result in a work capable of sustaining copyright registration.[6] As we cited *Satava, above*, we again state that works based on public domain elements may be copyrightable if there is some distinguishable aspect in their selection, arrangement or modification that reflects choice and authorial discretion and that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Feist,* at 359. These nine bottle designs, each depicted with one or two public domain elements [NB: MSRF is not the author of the vinegar or the other elements within the bottles] and sometimes containing a label, a cap covering, or cord, or sometimes reflecting one word etched into the bottle's surface [see the Office's regulations at 37 C.F.R. § 202.1(a), material not subject to copyright: words and short phrases such as names, titles, and slogans; mere variations of typographic ornamentation, lettering, or coloring; mere listing of ingredients or contents], are insufficient for registration as they are considered, each in its totality as an arrangement of very few elements. The Office will register a design incorporated into a useful article when the design itself embodies sufficient creativity, but not all ornamentation of a useful article is sufficiently creative to warrant copyright protection– either in itself or as part of a larger arrangement of elements connected or related to a useful article.

Moreover, the fact that a particular design element is not necessary to the functionality of a useful article does not make it automatically copyrightable. That design element must also be independently separable from the functional component without destroying either the element or the component itself, and must on its own accord embody a sufficient amount of creativity.

For the reasons stated above, the Copyright Office Review Board affirms the refusal to register the nine ornamental bottle designs. This decision constitutes final agency action in this matter.

Sincerely,

/s/

Nanette Petruzzelli
Associate Register,
Registration and Recordation Program
for the Review Board
United States Copyright Office

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[6] As we have stated above, we are assuming that the contents of the bottles are not the authorship of the claimant here. And, if we were to consider the contents of the bottles as part of the overall authorship, the contents are merely one or two common kitchen and cooking liquids and foodstuffs which have been placed in each bottle. The choice of so few elements placed within a glass container does not rise to the level of copyrightable discretion in the attempt to create a protectible sculptural work. The Board is prevented from registering by the utility of the containers which are pictured in the deposit copies as filled with very few common food elements.