



United States Copyright Office
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July 13, 2016

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**Re: Second Request for Reconsideration for Refusal to Register Camarena
2009A; Correspondence ID 1-TC8OPQ**

Dear Ms. Gray:

The Review Board of the United States Copyright Office (“Board”) has considered E&J Gallo Winery’s (“Gallo’s”) second request for reconsideration of the Registration Program’s refusals to register the work titled “Camarena” (“Work”). After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board affirms the denial of registration.

I. DESCRIPTION OF THE WORK

The Work consists of a three-dimensional bottle with slightly raised embossed designs on the front and back, as well as four labels applied to the surface of the bottle—one around the neck, one on the lower left, one on the middle front center, and one across the bottom of the back of the bottle. While the back label provides product information and a bar code, the other three labels each contain some amount of graphic and artistic authorship in the form of flourishes and a crest. The surface of the bottle itself contains the aforementioned embossing, which depicts scrollwork, a rising sun motif, stylized agave plants, and a family crest.

Reproductions of the Work are set forth below:



II. ADMINISTRATIVE RECORD

On September 18, 2013, Gallo filed an application to register a copyright claim in “2D artwork, sculpture, Compilation of bottle and artwork” as embodied in the Work. A Copyright Office registration specialist refused to register the claim in the “compilation of bottle and artwork.” Letter from Larisa Pastuchiv, Registration Specialist, to Naomi Jane Gray, Harvey Siskind LLP (Dec. 13, 2013). In addition, the registration specialist refused registration for the remainder of the claim because “[Gallo] . . . declined the offer to delete [the compilation of bottle and artwork] statement from [its]” claim. *Id.*¹

In a letter dated February 25, 2014, Gallo requested that the Office reconsider its refusal to register the Work. Letter from Naomi Jane Gray, Harvey Siskind LLP, to

¹ Prior to refusing registration, the Copyright Office registration specialist asked for clarification on the “sculpture” element of the claim because it was “not clear from the photographic image whether the design [on the bottle] is a sculpted relief carved into the glass, or 2-D art effect made to look like 3-D.” Email from Larisa Pastuchiv to Naomi Jane Gray (Sept. 19, 2013). In response, Gallo explained that the “artwork includes both two- and three-dimensional elements” and that “[t]he scrollwork, sunrays and related elements are sculpted into the glass . . . the designs are slightly raised on the surface of the glass.” Letter from Naomi Jane Gray, to Larisa Pastuchiv, at 1 (Oct. 4, 2013). Gallo added that the compilation element of the claim was based on the coordination and arrangement of “numerous elements,” including “the shape of its bottle; the artwork sculpted into the glass . . . and two-dimensional artwork, including leaf motifs and a family crest.” *Id.* at 3. The registration specialist responded, stating that “if [Gallo] decline[s] to delete this phrase from the authorship statement, [the Office] will refuse the claim outright even though there may be copyrightable elements included.” Email from Larisa Pastuchiv to Naomi Jane Gray (Oct. 17, 2013).

U.S. Copyright Office (Feb. 25, 2014) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office reevaluated the claims and again concluded that “with the exception of the claim in 2-D artwork, we are still unable to register a sculptural copyright claim in this bottle because it is a useful article that does not contain any sculptural authorship that is both separable and copyrightable.” Letter from Stephanie Mason, Attorney-Advisor, to Naomi Jane Gray, Harvey Siskind LLP, at 1-3 (Sept. 25, 2014). The Office found that the only sculptural element was the bottle²—a useful article with no physically or conceptually separable authorship, leaving it not subject to copyright protection. *Id.* at 2-3. As for the compilation claim, the Office determined that the Work “fail[ed] to meet even the low threshold for copyright authorship.” *Id.* at 3-4. The Letter reiterated the concern that Gallo sought to include the uncopyrightable “bottle shape as one element of [the] compilation.” *Id.* at 3. But the Office added that “[a]s stated in our original correspondence, the 2-D artwork contained on this work, specifically the flourishes and crest on the print label and the more expansive crest embossed on the bottle itself contain sufficient creative and original authorship to support a claim in registration,” and offered Gallo another chance to amend its application to register a claim in those elements only. *Id.* at 1-2.

Once again, Gallo declined the offer to amend its application. Instead, in a letter dated December 17, 2014, Gallo requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. Letter from Naomi Jane Gray, to U.S. Copyright Office (Dec. 17, 2014) (“Second Request”). Gallo emphasized that it “does not seek to register the shape of its bottle as a useful article,” but rather “to register the selection, coordination, and arrangement of a variety of elements in and on the bottle as a compilation,” and urged the Office to “grant Gallo’s application as it was initially submitted.” *Id.* at 1,7.

III. DECISION

A. The Legal Framework

1) *Useful Articles and Separability*

The copyright law does not protect useful articles, which are defined as “article[s] 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. Works of artistic craftsmanship that have been incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). The protection for such works is limited, however, in that it extends only “insofar as [the works’] form but not their mechanical or utilitarian aspects

² The Office noted that it was treating the embossed design on the bottle as two-dimensional artwork. Letter from Stephanie Mason to Naomi Jane Gray, 1 (Sept. 25, 2014).

are concerned.” *Id.* §101. In other words, a design incorporated into a useful article is only eligible for copyright protection to the extent that the design includes artistic “features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” *Id.*; *see also Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978) (holding that copyright protection is not available for the “overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape . . . may be”).

The Office employs two tests to assess separability: (1) a test for physical separability; and (2) a test for conceptual separability. *See* U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2 (3d ed. 2014) (“COMPENDIUM (THIRD)”); *see also Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (9th Cir. 2014) (finding that the Office’s interpretation of conceptual separability is entitled to deference); *Custom Chrome, Inc. v. Ringer*, 1995 WL 405690 (D.D.C. June 30, 1995) (finding that the Office’s tests for physical and conceptual separability are “reasonable construction[s] of the copyright statute[] consistent with the words of the statute,” existing law, and the legislature’s declared intent in enacting the statute).

To satisfy the test for physical separability, a useful article must contain pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means. *See* COMPENDIUM (THIRD) § 924.2(A); *see also Mazer v. Stein*, 347 U.S. 201 (1954) (sculpture of Balinese dancer eligible for copyright protection even though intended for use as lamp base); *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (pencil sharpener casing shaped like a telephone was physically separable from the article’s utilitarian function).

To satisfy the test for conceptual separability, a useful article must contain pictorial, graphic, or sculptural features that can be visualized—either on paper or as a freestanding sculpture—as a work of authorship that is separate and independent from the utilitarian aspects of the article and the overall shape of the article. In other words,

. . . the feature must be [able to be] imagined separately and independently from the useful article without destroying the basic shape of that article. A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature 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 (THIRD) § 924.2(B). If the feature is an integral part of the overall shape or contour of the useful article, that feature cannot be considered conceptually separable because removing it would destroy the basic shape of the article. *See id.*; *cf. H.R. REP. NO. 94-1476*, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668 (citing a carving

on the back of a chair or a floral relief design on silver flatware as examples of conceptually separable design features).

If the useful article does not contain any features that can be physically or conceptually separated from its utilitarian function, the Office will refuse to register the claim because Congress has made it clear that copyright protection does not extend to any aspect of a useful article that cannot be separated from its functional elements. If the Office determines that the work contains one or more features that can be separated from its utilitarian elements, the Office will examine those features to determine if they contain a sufficient amount of original authorship to warrant registration.

2) *Originality*

A work may be registered if it qualifies as an "original work[] of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). In this context, the term "original" consists of two components: independent creation and sufficient creativity. *See Feist Publ'ns, Inc. v. Rural Tel. Serv. 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. *Id.* Second, the work must possess sufficient creativity. *Id.* Only a modicum of creativity is necessary, but the Supreme Court has ruled that some works (such as the alphabetized telephone directory at issue in *Feist*) fail to meet even this low threshold. *Id.* 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. It further found 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.

The Office's regulations implement the longstanding requirement of originality set forth in the Copyright Act and described in the *Feist* decision. *See, e.g.*, 37 C.F.R. § 202.1(a) (prohibiting registration of "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring"); *id.* § 202.10(a) (stating "to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form"). Some combinations of common or standard design elements may contain sufficient creativity with respect to how they are juxtaposed or arranged to support a copyright. Nevertheless, not every combination or arrangement will be sufficient to meet this test. *See Feist*, 499 U.S. at 358 (finding the Copyright Act "implies that some 'ways' [of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not"). A determination of copyrightability in the combination of standard design elements depends on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection. For example, the United States District Court for the Southern District of New York upheld the Copyright Office's refusal to register simple designs consisting of two linked letter "C" shapes "facing each other in a mirrored relationship" and two unlinked letter "C" shapes "in a mirrored relationship and positioned perpendicular to the linked elements." *Coach Inc. v. Peters*, 386 F. Supp. 2d 495, 496 (S.D.N.Y. 2005). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, and the stereotypical jellyfish form did not merit copyright protection. *See Satava v. Lowry*, 323 F. 3d 805, 811 (9th Cir. 2003). The language in *Satava* is particularly instructive:

It is true, of course, that a combination of unprotectable elements may qualify for copyright protection. But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable 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.

Id. (internal citations omitted).

Finally, Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. *See* COMPENDIUM (THIRD) § 310.2. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See, e.g., Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

B. Analysis of the Work

After carefully examining the Work and applying the legal standards discussed above, the Board finds that, apart from the separable two-dimensional artwork that Gallo has declined to register by itself, the Work is a useful article. Thus, the Board affirms the refusal to register the Work as a compilation comprised of "bottle and artwork."

It is undisputed that the bottle itself is a useful article. Further, the Work, "can[not] be separated from [the bottle's] utilitarian function." COMPENDIUM (THIRD) § 924.2. That is, the Work, as defined by Gallo, cannot be physically or conceptually separated from the shape of the bottle without eliminating the bottle's ability to hold liquid. *Id.* A question, then, is whether the bottle contains other pictorial, graphic, or

sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the bottle.

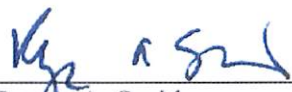
The Board finds that the bottle does contain conceptually separable pictorial and graphic features, namely, the embossing on the bottle consisting of scrollwork, a rising sun motif and stylized agave plants. Like a carving on the back of a chair, this embossing can be “visualized . . . as a work of authorship that is independent from the overall shape” of the bottle so that “imagin[ing] [it] separately and independently” from the bottle would not destroy the shape of the bottle. COMPENDIUM (THIRD) § 924.2[B]; see also H.R. REP. NO. 94-1476 (1976), reprinted in U.S.C.C.A.N. 1976 at 5668. But while the Copyright Office indicated it would consider registering the embossed design on the bottle, as well as two-dimensional artwork on the labels to the extent they contain copyrightable authorship, Gallo repeatedly declined to amend its application to limit its claim to these elements.

Further, the Board must reject Gallo’s claim that the Work is copyrightable as a compilation. As explained above, the bottle itself is not subject to copyright protection; thus, copyright registration cannot extend to the utilitarian features of a bottle, including its shape. See 17 U.S.C. § 101; COMPENDIUM (THIRD) § 924.1. Nor, setting aside the bottle, do the two-dimensional elements on the bottle qualify as a protectable compilation. Viewed as a whole, the selection, combination, and arrangement of the labels and embossing on the bottle are not sufficient to render such a work original. The arrangement of labels on the bottle is a “[m]ere spatial placement or format of . . . label elements” insufficient to constitute copyrightable authorship. COMPENDIUM (THIRD) § 913.1. And while the embossing itself may demonstrate creative authorship, its placement on a bottle does not. The level of creative authorship involved in the configuration of these elements is, at best, *de minimis*, and too trivial to merit copyright registration.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claim in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.

BY:



Regan A. Smith
Copyright Office Review Board