



United States Copyright Office

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August 24, 2016

Maxim H. Waldbaum
Eaton & Van Winkle LLP
3 Park Avenue
New York, NY 10016

**Re: Second Request for Reconsideration for Refusal to Register Bellocq Tea Caddy;
Correspondence ID: 1-17NGB92**

Dear Mr. Waldbaum:

The Review Board of the United States Copyright Office ("Board") has considered Bellocq Tea Atelier's ("Bellocq's") second request for reconsideration of the Registration Program's refusal to register a sculpture claim in the work titled "Tea Caddy". After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board affirms the Registration Program's denial of registration.

I. DESCRIPTION OF THE WORK

The Work is a metal canister with a knob lid. The knob lid can be removed to reveal a fitted insert with a smaller knob handle at its center. While the Work includes a solid-colored sleeve label that features a printed description of the tea contained in the canister and applicant's brand name, the copyright claim is limited to sculpture and thus excludes the sleeve label. The Work is depicted below.



II. ADMINISTRATIVE RECORD

On December 8, 2014, Bellocq filed an application to register a copyright claim in the Work. In a December 15, 2014, letter, a Copyright Office registration specialist refused to register the claim,

finding that it “is a ‘useful article’ which does not contain any separable sculptural features that are copyrightable.” Letter from Kathryn Sukites, Registration Specialist, to Robert Katz (Dec. 8, 2014) (emphasis omitted).

In a letter dated March 16, 2015, Bellocq requested that the Office reconsider its initial refusal to register the Work. Letter from Maxim H. Waldman, Partner, Eaton & Van Winkle LLP, to U.S. Copyright Office (Mar. 16, 2015) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office again concluded that the Work is uncopyrightable “[b]ecause all of the elements or features . . . are either related to the utilitarian aspects or functions of the container, or are part of the overall shape, contour, and configuration of the [W]ork [and thus] there is no authorship that is separable.” Letter from Stephanie Mason, Attorney-Advisor, to Maxim H. Waldman (Aug. 14, 2015).

In a letter dated November 13, 2015, Bellocq 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 Maxim H. Waldman, to U.S. Copyright Office (Nov. 13, 2015) (“Second Request”). In that letter, Bellocq asserted, *inter alia*, that the “Office assumes, without any proof, that the article is hollow and capable [of] functioning as a container,” and that the Office’s standard would “render innumerable sculptural works that happen to resemble a useful article unregistrable.” Second Request at 1-2. Bellocq also contended that the Work included numerous features that were “neither dictated by, nor inseparable from, the alleged utilitarian function of this sculptural work,” and that met the low standard for originality required for copyright registration. *Id.* at 2-4. Bellocq further argued that the Work employed expressive design choices that were not dictated by functional considerations. *Id.* at 5.

III. DISCUSSION

A. *The Legal Framework - 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 are concerned.” *Id.* at 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 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*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995) (finding that the Office’s tests for physical and conceptual separability are “a reasonable construction 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 utilitarian elements. If the Office determines that the work contains one or more features that can be separated from its functional elements, the Office will examine those features to determine if they contain a sufficient amount of original authorship to warrant registration.

B. Analysis of the Work

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work is a useful article that does not contain the requisite separable authorship necessary to sustain a claim to copyright.

It cannot be disputed that the Work—comprised of a canister, a lid, and an insert with a knob—is a useful article meant to hold tea. While Bellocq argues that the “Office assumes, without any proof, that the article is hollow and capable [of] functioning as a container,” any other conclusion would be contradicted by the application materials and Bellocq’s own marketing efforts. Second Request at 2. The title of the Work is “Tea Caddy.” According to its website, Bellocq is a tea company located in Brooklyn, New York that packages some of its teas in the Work. *See* Bellocq Tea Atelier, About, <http://www.bellocq.com/pages/about> (last visited Aug. 5, 2016); Bellocq Tea Atelier, FAQs, What kind of packaging does your tea come in? <http://www.bellocq.com/pages/faq> (last visited Aug. 5, 2016) (“Each tea’s individual web page covers the various types of packaging available . . . Traveler Caddies, and Connoisseur Caddies are available.”). Since the Work is a useful article, for there to be any consideration of the Work’s design features, these features must be either physically or conceptually separable from the Work’s utilitarian functions.

The Work is clearly not physically separable. Bellocq encourages the Office to apply a standard for conceptual separability that is less “draconian” in order to accommodate the registration of “works that happen to resemble a useful article.” Second Request at 2. The Board declines Bellocq’s suggestion. The Office’s test for conceptual separability is well-established, and multiple circuits have accorded deference to the Office with respect to the manner in which it distinguishes between the ornamental and utilitarian aspects of useful articles for purposes of registration. *See, e.g., Inhale*, 755 F.3d at 1042 (in rejecting copyrightability of hookah vessel, explaining that “[b]ecause the Copyright Office’s reasoning is persuasive, we adopt it for this case”); *Custom Chrome*, 35 U.S.P.Q.2d 1714 (finding that Office’s tests for physical and conceptual separability are “a reasonable construction of the copyright statute[.]”). Indeed, while Bellocq suggests that *Esquire v. Ringer* “rejected the idea of conceptual separability” and determined “that the Register of Copyrights had abused its discretion by denying registration to the overall shape of certain outdoor lighting fixtures,” the *Esquire* court in fact affirmed the Register’s decision to deny registration, finding the Office’s regulations to be reasonable. *Compare* Second Request at 2 *with Esquire*, 591 F. 2d at 801.

Accordingly, the Board examines the Work in light of its longstanding test set forth in the *Compendium*. *See* COMPENDIUM (THIRD) § 924.2(B). Here, the canister, lid, and insert with knob cannot be visualized separate and independent from the Work’s use as a tea canister. The sculptural elements of the Work that Bellocq identifies as “artistic”—*i.e.*, an “unusually” shaped dome top, an artistically designed and “unusually” shaped sloping silver shoulder portion, or overall “sculptural shape”—are part and parcel of the useful article itself. Second Request at 2. Where the aspects of a useful article comprise the useful article itself, there can be no protection for the “overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape or configuration might be.” *Esquire*, 591 F.2d at 800; *see also* COMPENDIUM (THIRD) § 924.2(B).

The Board considers the remaining case law Bellocq relies upon to be inapposite. While it is true that, in the context of evaluating copyright claims for jewelry designs, some courts have considered whether such design choices were “dictated by function alone,” the Office does not consider jewelry pieces to be useful articles. *See* COMPENDIUM (THIRD) § 908 (outlining standards for copyright protection in jewelry); *compare* Second Request at 5-6 (citing various cases related to the copyrights in jewelry design). Similarly, while the Sixth Circuit recently held that 2-dimensional designs applied to a garment were conceptually separable from the garment’s useful elements and thus copyrightable subject matter, here, for the reasons explained above, the Work lacks such conceptually separable design elements. *See* Second Request at 2 (citing *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 492 (6th Cir. 2015)).

Finally, to the extent to which Bellocq points to its sleeve label in seeking copyright registration for the Work as a sculpture, the label elements are 2-dimensional, not sculptural, and at any rate were not claimed on Bellocq’s registration application. *See* Second Request at 2. If Bellocq is interested in obtaining a copyright registration for its label elements, it may file a new application for protection as 2-D artwork. From its review of the current deposit, along with Bellocq’s description of those elements as “brightly colored” and “a classic framework design for a label,” however, the Board notes that these elements may lack sufficient originality to merit copyright protection. *See* Second Request at 2; COMPENDIUM (THIRD) § 906.3 (explaining that “mere coloration” is not eligible for copyright protection); *id.* § 913 (explaining that the spatial placement or format of label elements is typically insufficient to enable 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