



Utilitarian Shape of Hookah
Not Subject to Copyright Protection,
Even if Distinctive, Ninth Circuit Holds

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Inhale Inc.'s efforts to protect the shape of its hookah under copyright law went up in smoke, as the Ninth Circuit affirmed summary judgment in favor of Starbuzz Tobacco, Inc. *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 739 F.3d 446 (9th Cir. 2014).¹

Inhale, a designer and manufacturer of smoking products, sold the hookah² shown below:



It obtained a U.S. copyright registration for this product.

¹ http://scholar.google.com/scholar_case?case=621471655821174883

²A hookah is a device for smoking tobacco, in which the smoke passes through a water basin, which filters and cools the smoke before it is inhaled by the user. See <http://en.wikipedia.org/wiki/Hookah>.



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Inhale sued Starbuzz for copyright infringement in the U.S. District Court for the Central District of California, alleging that Starbuzz sold a similar hookah. Inhale's claim was based entirely on the shape of Starbuzz's hookah. For purposes of the lawsuit, Inhale disclaimed copyright protection to the skull-and-crossbones graphic.

The district court granted Starbuzz's motion for summary judgment in 2012, holding that Inhale did not own a valid copyright in the shape of its hookah, notwithstanding its registration. Last month the Ninth Circuit Court of Appeals affirmed.

The Copyright Act generally protects "original works of authorship," including sculptural works. But it does not protect "useful articles." Under the Copyright Act, a "useful article" is "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.

Individual design elements of a useful article may be subject to copyright protection, to the extent that they "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. 101. Such protectable elements may be either *physically separable* or *conceptually separable*.

Inhale argued that the shape of its hookah was conceptually separable from its utilitarian features, but the Ninth Circuit disagreed. It explained: "The shape of a container is not independent of the container's utilitarian function—to hold the contents within its shape—because the shape accomplishes the function." 739 F.3d at 449.

The court, citing Copyright Office practice, rejected Inhale's contention that the distinctiveness of the hookah shape affected the separability analysis. The court observed:

Although Inhale's water container, like a piece of modern sculpture, has a distinctive shape, "the shape of the alleged 'artistic features' and of the useful article are one and the same."

739 F.3d at 449 (quoting *Compendium of Copyright Office Practices II*, § 505.03).

The Ninth Circuit also affirmed the district court's award of attorneys' fees to Starbuzz under 17 U.S.C. § 505, and further awarded Starbuzz its attorneys' fees on appeal.

The Ninth Circuit's decision is a blow to producers of creative works that have utilitarian functions, including other sculptural works such as bottles and vases. In view of this decision, it may be harder for such entities to address copying by competitors – at least under copyright law.

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