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## **“Courts Have Twisted Themselves into Knots”: U.S. Copyright Protection for Applied Art**

Jane C. Ginsburg<sup>\*</sup>

### **Abstract**

In copyright law, the marriage of beauty and utility often proves fraught. Domestic and international lawmakers have struggled to determine whether, and to what extent, copyright should cover works that are both artistic and functional. The U.S. Copyright Act protects a work of applied art “only if, and only to the extent that, its 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.” While the policy goal to separate the aesthetic from the functional is clear, courts’ application of the statutory “separability” standard has become so complex and incoherent that the U.S. Supreme Court has agreed to hear an appeal from a case in which the appellate court, echoing sister Circuits, expressed the lament quoted in the title of this Article. The Article will review the genesis and application of the statutory standard, with illustrations from several of the cases, and will offer two conclusions and a legislative proposal.

First, the controversy before the Court does not concern the “design of a useful article,” and therefore does not require the Court to resolve the meaning of “separability.” The *Varsity Brands* case nonetheless reveals the importance of ascertaining whether the contested design is in fact the design of a “useful article.” A pre-existing pictorial, graphic or sculptural work applied to a useful article is not itself a useful article, and courts need not “twist themselves into knots” endeavoring to parse the meaning of the statutory separability standard. Were the Supreme Court to decline to reach separability on the ground that resolution of the *Varsity Brands* dispute does not in fact require it, some might be disappointed that the Court would fail to tidy the disarray in the lower courts over separability. But the predicate issue—what is the design of a “useful article”—also warrants more attention than lower courts have given it. Thus, were the Court to leave separability to a case that

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in fact poses that issue, the Court would still contribute to clarifying this area of copyright law.

Second, the statutory requirements of separate identifiability and independent existence apply to “features” of the design, not to the entire shape of a useful article; attempts (including those ventured by this Article) to extend separability analysis to the useful article’s form as a whole prove unworkable. Accordingly, rather than continuing to struggle with an intractable statutory copyrightability standard, this Article proposes the enlargement of Title 17’s *sui generis* design protection regime to cover original designs of most useful articles.

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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.<sup>1</sup>

## INTRODUCTION

United States copyright law explicitly enumerates “pictorial, graphic or sculptural works” (henceforth “PGS works”) among the subject matter of copyright.<sup>2</sup> These include “works of artistic craftsmanship,” but copyright covers the design of a useful article “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.”<sup>3</sup> Inseparable design features, whatever their aesthetic appeal, are not protected under copyright law; any coverage available to the designers must come from other regimes, particularly federal utility or design patent law.<sup>4</sup> The “separability” test, as we will see, has resisted coherent application, but one thing is clear: in the 1976 Copyright Act, Congress intended to impose a high threshold to copyrightability of useful articles. Copyright, which “subsists” in a work of authorship upon creation and lasts for 70 years *post mortem auctoris* (or 95 years following first publication),<sup>5</sup> was not the appropriate regime for most industrial designs. Whatever “separability” means, it excludes more designs than would a test that merely inquires whether there exist other designs for the same kind of useful article. The “separability” threshold therefore will in most cases set a higher bar than the idea/expression “merger”

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1. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 478 (6th Cir. 2015), *cert. granted*, 194 L. Ed. 2d 829 (2016) (*quoting* *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (9th Cir. 2014)) (*quoting* *Masquerade Novelty, Inc. v. Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990)).

2. 17 U.S.C. § 102(a)(5).

3. 17 U.S.C. § 101.

4. For a cross-IP discipline view that encompasses design protection, see Peter Lee & Madhavi Sunder, *The Law of Look and Feel*, UC DAVIS LEGAL STUDIES RESEARCH PAPER SERIES (Feb. 2016), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2733780](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2733780). For designs that acquire secondary meaning, trademark law may afford more useful recourse than copyright or design patent law. See, e.g., Dan Hunter and Suzannah Wood, *The Laws of Design in the Age of Mechanical Reproduction*, ADELAIDE L. REV. (forthcoming 2016).

5. At the time of passage of the 1976 Act, the terms were 50 years *post mortem auctoris*, or 75 years after first publication.

doctrine. The latter inquires whether the “idea” is susceptible to multiple forms of expression, or whether instead plaintiff’s work represents the only way, or one of only a few ways, of presenting the idea. By contrast, that the overall shape of a table or chair may be expressed through multiple different designs does not itself suffice to make any one of those designs “separable” in whole or in part.<sup>6</sup>

This Article will first review the statutory definitions of a “pictorial, graphic or sculptural work,” and then will address the genesis of the troublesome “separability” requirement. Next, the Article will analyze the attempts of administrative and judicial authorities to articulate a predictable test that remains faithful to the text and legislative history of the 1976 Copyright Act. This discussion will include images of the works at issue in order to help the reader understand the courts’ analyses and outcomes (though in some instances, viewing the works may leave the reader more perplexed than ever). Finally, this Article will offer two conclusions and a legislative proposal. First, the controversy before the Court does not concern the “design of a useful article,” and therefore does not require the Court to resolve the meaning of “separability.” Second, the statutory requirements of separate identifiability and independent existence apply to “features” of the design, not to the entire shape of a useful article; attempts (including those ventured by this article) to extend separability analysis to the useful article’s form as a whole prove unworkable. Accordingly, rather than continuing to struggle with an intractable statutory copyrightability standard, this article proposes the enlargement of Title 17’s *sui generis* design protection regime to cover original designs of most useful articles.

### STATUTORY REQUIREMENTS

The U.S. Copyright Act distinguishes “useful articles” from works whose function is “merely to portray the appearance of the article or to convey information.”<sup>7</sup> The latter are PGS works (or, in the case of works whose function is to convey information, other kinds of works of authorship, such as literary works) in themselves, and there is no need to undertake an inquiry into the “separability” of aesthetic and useful elements, because the utility at issue, such as a religious painting’s stimulation of spiritual contemplation,<sup>8</sup> is not the kind of usefulness that the statute reserves to the patent system (or to the public domain). Similarly, the depiction of a useful article, such as a model airplane or a drawing of a bottle, is not itself a useful article. The statute, however, makes clear that a protected

6. See JANE C. GINSBURG & ROBERT A. GORMAN, COPYRIGHT LAW: CONCEPTS AND INSIGHTS SERIES 50 (2012).

7. 17 U.S.C. § 101 (defining “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”).

8. See, e.g., *Masquerade Novelty v. Unique Indus.*, 912 F.2d 663, 671 (3d Cir. 1990):

When hung on a wall, a painting may evoke a myriad of human emotions, but we would not say that the painting is not copyrightable because its artistic elements could not be separated from the emotional effect its creator hoped it would have on persons viewing it. The utilitarian nature of an animal nose mask or a painting of the crucifixion of Jesus Christ inheres solely in its appearance, regardless of the fact that the nose mask’s appearance is intended to evoke mirth and the painting’s appearance a feeling of religious reverence.

representation of a useful article gives the author no rights in the article depicted.<sup>9</sup> A blueprint for constructing a car is not a “useful article” because its functions are to portray the appearance of the car, and to convey information about how to build it. The car, once built, however, is a useful article; any copyright would be limited to elements, such as a hood ornament, that are separable from the car’s utilitarian aspects.

The statute also specifies that the author of a PGS work has the exclusive right to reproduce it “in or on any kind of article, whether useful or otherwise.”<sup>10</sup> For example, an artist holds the exclusive right to reproduce her drawing onto a T-shirt, a tablecloth, a shower curtain, etc.; a sculptor can authorize or prohibit the incorporation of his work into a paperweight or to ornament fireplace andirons. In the case of three-dimensional works, however, it becomes necessary to distinguish between incorporating the sculptural work “in or on” a useful article, and altering the form of the work in order to adapt it into a useful article; in the latter instance the copyright in the original sculpture subsists as a PGS work, but the adapted version becomes a useful article, and its characterization as a PGS work in its own right will depend on whether its form, or parts of its form, are “separable” from the article’s function. For example, imagine a sculpture of a crocodile, with moving jaws. The sculptor’s copyright extends to inserting salad tongs into the jaws; in that event, the sculpture is reproduced “on” a useful article, and its legal status as a PGS work remains unchanged. But if the article consists of salad tongs shaped to resemble a crocodile’s toothy maw, then it is a useful article whose status as a PGS work turns on the separability test. In the first crocodile example, the sculpture preexists its encounter with a useful article; in the second, the three-dimensional form is contemporaneously a useful article. This birth order distinction may yield arbitrary outcomes, among them the apparent privileging of shapes that are suboptimally functional (the first set of crocodile salad tongs may not seize salad as well as the second). But, as we shall see, that is the result of a legislative policy choice to exclude functional items from the copyright domain, thus confining them to the realm of patents, or, more often, to the public domain.<sup>11</sup>

If the article at issue has “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information,” then the statute directs that copyright extends only to those elements (if any) of the object’s design that are separable from its function:

9. 17 U.S.C. § 113(b). See *infra* text accompanying notes 129-35.

10. *Id.* at § 113(a). The examples that follow all illustrate reproduction of the PGS work “on” a useful article. It is less clear what it means to reproduce the work “in” a useful article. (Thanks to Paul Goldstein for this observation.) The House Report refers to PGS works “employed as the design of a useful article,” H.R. REP. NO. 94-1476, at 105 (1976) (emphasis added), which suggests that the rights in the preexisting PGS work extend to authorizing or prohibiting the incorporation of the design not only as a discrete decorative element, such as the hood ornament of a car, but also as the entire shape of the useful article, for example a sculpture hollowed out to serve as a vase. As will be discussed further, *infra*, the copyright inheres in the PGS work, not in the useful article “in or on” which it is reproduced.

11. For detailed discussion of that policy choice, see Viva Moffat, *The Copyright/Patent Boundary*, 48 U. RICH. L. REV. 611, 638-39 (2014) (the intention to confine functional features of useful articles to the patent realm is implicit in the statute and the legislative history). But see *infra* text accompanying notes 126-28 (attempt to overcome birth order distinction).

“Pictorial, graphic, and sculptural works” include . . . works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work 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.<sup>12</sup>

For our crocodile-shaped salad tongs to be protectable in whole or in part as a PGS work, it would be necessary to determine which if any design elements are separable from the function of seizing and serving salad. Perhaps a shaft shaped to resemble the reptile’s scaly tail and body would qualify, but the snapping toothsome jaws perform the function of tongs. Do they nonetheless incorporate “separable” features, so that the entire shape of the tongs would qualify for copyright protection? As the chorus of judicial laments quoted at the outset of this Article reveals, courts have failed to interpret the meaning of the statutory separability standard in any consistent or coherent manner. Before turning to the divergent and often contradictory judicial attempts, we should first detail the genesis of the statutory rule.

### GENESIS OF THE SEPARABILITY RULE

The 1909 Copyright Act listed “works of art” within the categories of registrable subject matter, and further included “models or designs for works of art.”<sup>13</sup> Copyright Office regulations promulgated in 1910 clarified that the statute did not cover industrial designs. According to the Office: “*Works of art*.—This term includes all works belonging to the so-called fine arts. (Paintings, drawings, and sculpture). Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.”<sup>14</sup>

While the regulation might seem to preclude protection for useful articles under copyright law, the Copyright Office nonetheless registered “clocks, candlesticks, inkstands, door knockers, ashtrays and saltshakers—a far cry from the standard conception of the ‘fine arts.’”<sup>15</sup>

By the late 1940s, the Copyright Office recognized the need to update its regulations more specifically to address the availability of protection for industrial design. Its revised regulations no longer interpolated “fine” before “work of art,” and explicitly provided protection for useful articles “includ[ing] works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all

12. 17 U.S.C. §101 (defining pictorial, graphic and sculptural works).

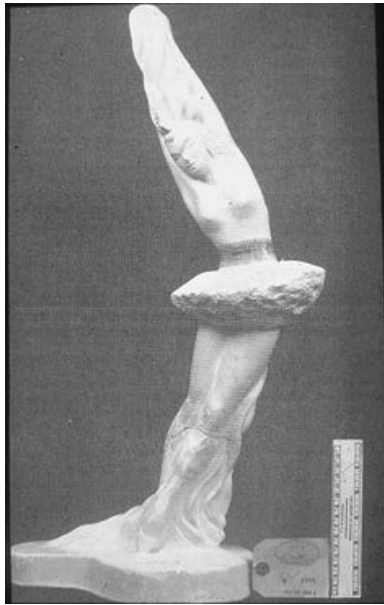
13. Act of March 4, 1909, § 5(g), 35 Stat. 1075, 1077 (1909).

14. Rules and Regulations for the Registration of Claims to Copyright, COPYRIGHT OFFICE BULL. NO. 15, 8 (1910).

15. Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC’Y U.S.A. 339, 342-43 (1990) [hereinafter Perlmutter]. See generally The Meaning of “Writings” in the Copyright Clause of the Constitution, STUDY NO. 3 IN S. COMM. ON THE JUDICIARY, 86th Cong. COPYRIGHT LAW REVISION: STUDIES PREPARED FOR THE SUBCOMM. ON PATENTS, TRADEMARKS, AND COPYRIGHTS PURSUANT TO S. RES. 53, 61 (Comm. Print 1960) for an in depth analysis of the evolution of the definition of “works of art” and the meaning of “writings” under the statutes and case law of the United States.

works belonging to the fine arts, such as paintings, drawings and sculpture.”<sup>16</sup> While this regulation did not explicitly impose a separability requirement, the language implied that the “form” of a work must be distinct from its “mechanical or utilitarian aspects.”<sup>17</sup>

These regulations figured significantly in the Supreme Court’s 1954 decision in *Mazer v. Stein*, which concerned statuettes of dancers. The “statuettes were sold in quantity throughout the country both as lamp bases and as statuettes . . . [but] [t]he sales in lamp form accounted for all but an insignificant portion of . . . sales.”<sup>18</sup> (See images below depicting the statuette in freestanding form, and as incorporated into the lampbase.)<sup>19</sup>



The Court embarked on a review of the relevant statutes, legislative history, and Copyright Office practices, noting the evolution of protection from “works of the fine arts” in 1870 to “all the writings of an author” in 1909, to limiting protection to the “form but not . . . mechanical or utilitarian aspects” of a work of artistic craftsmanship in 1949.<sup>20</sup> As a first step in its analysis, the Court considered whether the statuettes, as sculptures, were copyrightable. Given the gradual expansion of copyright to cover artistic works in general, the Court declined to find the statuettes

16. 37 C.F.R. § 202.8 (1949).

17. *Id.*

18. *Mazer v. Stein*, 347 U.S. 201, 203 (1954).

19. Photograph of *Dancer Statuette* (on left), PINTEREST, <https://perma.cc/G2B6-29LU> (last visited Sept. 24, 2016). Photograph of *Lamp Advertisement* (on right), REBECCA TUSHNET’S 43 (B)LOG, <https://perma.cc/Q683-FC6L> (last visited Sept. 24, 2016).

20. *Mazer*, 347 U.S. at 211-12.

too lacking in artistic merit to warrant protection. The Court noted that “[i]ndividual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art . . . Such expression, whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color, is copyrightable.”<sup>21</sup>

The *Mazer* Court next rejected the proposition that “congressional enactment of the design patent laws should be interpreted as denying protection to artistic articles embodied or reproduced in manufactured articles.”<sup>22</sup> Emphasizing the differences in the nature and scope of copyright law and patent law, the Court ruled that the patent law did not preempt copyright protection for artistic works incorporated in useful articles: “the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art.”<sup>23</sup> The Court noted that the “dichotomy of protection for the aesthetic is not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents.”<sup>24</sup> Hence, a design might be both a work of art for purposes of copyright and, if sufficiently novel, an ornamental design for purposes of design patents. But, the Court stressed, citing the Copyright Office regulation, “artistic articles are protected in ‘form but not their mechanical or utilitarian aspects.’”<sup>25</sup>

Thus, whether the dancer began as a freestanding sculpture subsequently incorporated into a lamp base, or instead was created to serve as a lamp base, the work remained a sculpture, and on that ground was copyrightable as a work of art (assuming sufficient originality).<sup>26</sup> As the author of a leading study on copyright protection of PGS works observed: “*Mazer* . . . established the principle that a work that is otherwise copyrightable does not lose protection when it is incorporated as part of a useful article . . . it did not, however, address the more difficult question of how to determine when elements of a useful article may constitute a copyrightable work of art.”<sup>27</sup>

It is that “more difficult question” that the separability rule, as it emerged from later Copyright Office regulations, was supposed to resolve. Three years after *Mazer*, the Office’s first attempt read:

When the shape of an article is dictated by, or is necessarily responsive to, the requirements of its utilitarian function, its shape, though unique and attractive, cannot qualify it as a work of art. If the sole intrinsic function of an article is its utility, the fact that it is unique and attractively shaped will not qualify it as a work of art. However, where the object is clearly a work of art in itself, the fact it is also a useful article will not preclude its registration.<sup>28</sup>

21. *Id.* at 214.

22. *Id.* at 215.

23. *Id.* at 217.

24. *Id.* at 218.

25. *Id.* (citation omitted).

26. *See id.* at 218-19 (“Nor do we think the subsequent registration of a work of art published as an element in a manufactured article, is a misuse of the copyright. This is not different from the registration of a statuette and its later embodiment in an industrial article.”).

27. *See* Perlmutter, *supra* note 15 at 345.

28. 37 C.F.R. § 202.10(c) (1957).

In 1960, the Copyright Office introduced the separability test, updating the regulation to read:

If the sole intrinsic function of an article is its utility, the fact that that article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.<sup>29</sup>

The amended regulation failed to produce clarity. It provided no guidance on how to determine the “sole intrinsic function” of an item, nor did it explain how separability was to be judged. “Did the artistic features have to be physically separable? In what sense did they have to be ‘identified’ separately? How were these determinations to be made?”<sup>30</sup>

Perhaps as a result of this lack of guidance, few judicial decisions post-*Mazer* contained any meaningful discussion of the separability standard. When courts denied protection, they tended to “rely on a failure to meet the requirement of original authorship rather than” the separability standard, and when they extended protection, courts tended either simply to state their conclusion that the work was copyrightable, or to “carve out distinct categories of works as either protectable or not,” relying on “whether the category would traditionally be considered a work of art.”<sup>31</sup>

In a study produced in anticipation of what would become the 1976 Copyright Act, the Copyright Office revisited the problem of applied art, and proposed a new form of protection for useful articles:

In the years since the *Mazer* decision, full protection under the copyright law has not proved inappropriate for “works of art” used as a design or decoration of useful articles. We do not believe, however, that it would be appropriate to extend the copyright law to industrial designs as such. In this area there is a delicate balance between the need for protection on the part of those who originate and invest in a design, and the possible effect of protection, if overextended, in restraining competition. The term of copyright . . . is too long for ordinary design protection. And there are other fundamentals of the copyright statute—the provisions on notice, deposit, registration, publication, and liability of innocent distributors of infringing articles, for example – that are not suitable for the entire range of industrial designs.<sup>32</sup>

While recognizing that a work of art could serve to decorate a useful article, the Copyright Office disfavored copyright protection for industrial design in general,

29. 37 C.F.R. § 202.10(c) (1960).

30. See Perlmutter, *supra* note 15 at 346.

31. See Perlmutter, *supra* note 15 at 346-47, citing, among other cases, *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976) (failing to meet original authorship), *Tenn. Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279 (5th Cir. 1970) (finding copyrightability without additional explanation), and a pre-*Mazer* decision involving the same plaintiff and similar statuette-lamp bases, *Rosenthal v. Stein*, 205 F.2d 633 (9th Cir. 1953) (relying on categories of works traditionally considered copyrightable works of fine art).

32. STAFF OF H.R. COMM. ON THE JUDICIARY, 87th Cong., REP. OF THE REG. OF COPYRIGHTS ON THE GEN. REV. OF U.S. COPYRIGHT LAW 13 (Comm. Print 1961).

largely out of concern for anticompetitive consequences.<sup>33</sup> It preferred a mid-measure between a copyright protection limited to preexisting works of art incorporated in useful articles (such as the *Mazer* statuette) and full-on copyright protection for the whole domain of industrial design. The Copyright Office, therefore, recommended protection for the artistic design of a useful article, but for a shorter term, and with more restrictive formalities. But only Congress could establish such a *sui generis* regime for applied art.

The Senate proposed such a system. Title II of the copyright reform bill would have given specific protection to “ornamental designs of useful articles.”<sup>34</sup> The Title defined a useful article as “an article which in normal use has an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>35</sup> The design was defined to “consist[] of those aspects or elements of the article, including its two-dimensional or three-dimensional features of shape and surface, which make up the appearance of the article,”<sup>36</sup> and was deemed to be ornamental if “it is intended to make the article attractive or distinct in appearance.”<sup>37</sup> Protection would attach only if the work were original, not commonplace or a minor variation of a preexisting design, not “dictated solely by a utilization function of the article that embodies it,” and not apparel.<sup>38</sup> Protection would last for an initial term of five years, with the possibility of an additional five years upon application.<sup>39</sup> The Act would create a unique marking symbol—“(D)” —to cover such designs.<sup>40</sup> “Protection . . . [would] be lost if application for registration of the design [were] not made within six months after the date on which the design was first made public.”<sup>41</sup> The Senate proposal, in short, contained what was effectively a *sui generis* regime to cover only the artistic design elements of a useful article.

When the Senate proposal reached the House of Representatives, however, the House Judiciary Committee “deleted Title II of the bill entirely.”<sup>42</sup> The Judiciary Committee explained that it chose to remove the section “in part because the new form of design protection provided by Title II could not truly be considered copyright protection and therefore appropriately within the scope of copyright revision.”<sup>43</sup> According to the House Report, the Senate proposal failed to address two key questions: “first, what agency should administer this new design protection system and, second, should typeface designs be given the protections of the title?”<sup>44</sup> In

33. *Id.* at 13 (“We do not believe that it would be appropriate to extend the copyright law to industrial designs as such. In this area there is a delicate balance between the need for protection on the part of those who originate and invest in a design, and the possible effect of protection, if overextended, in restraining competition.”).

34. S. REP. NO. 94-473, Title II (1975).

35. *Id.* at § 201(b)(1).

36. *Id.* at § 201(b)(2).

37. *Id.* at § 201(b)(3).

38. *Id.* at § 202.

39. *Id.* at § 205(a).

40. *Id.* at § 206(a)(1).

41. *Id.* at § 209(a).

42. H.R. REP. NO. 94-1733, at 82 (1976) (Conf. Rep.).

43. H.R. REP. NO. 94-1476, at 50 (1976).

44. *Id.*

addition, the Judiciary Committee gave weight to the Justice Department's objection that "Title II would create a new monopoly which has not been justified by a showing that its benefits will outweigh the disadvantage of removing such designs from free public use."<sup>45</sup> For the Justice Department, the Senate's amendment would have protected subject matter that was in fact in the public domain; creation of a new monopoly right in unpatented industrial design therefore required a heavy burden of justification, unmet in this instance.

After eliminating Title II, the House Judiciary Committee chose to "revise[] the definition of 'pictorial, graphic, and sculptural works' in § 101 to clarify the distinction between works of applied art subject to protection under the bill and industrial designs not subject to copyright protection."<sup>46</sup> The final bill drafted its definitions of pictorial, graphic and sculptural works as well as of useful articles "[i]n accordance with the Supreme Court's decision in *Mazer*,"<sup>47</sup> thus yielding the current § 101 definition with its requirement that the design features of useful article be separately identifiable and capable of existing independently of the article's utilitarian aspects. The final bill's definition of "useful article" tracked the 1960 Copyright Office regulation, with one important change: while the regulation identified an article whose "*sole* intrinsic function . . . is its utility" (emphasis supplied) § 101 defines a "useful article [as] an article having *an* intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. . . ." (emphasis supplied). As a result, even a highly decorative item with a single utilitarian function met the definition of a useful article. Broadening the language in this fashion had the effect of narrowing the kinds of works of applied art, which would be deemed protectable "pictorial, graphic or sculptural works," because more works would be required to meet the separability standard.

The House Judiciary Committee explained its reasoning:

In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although 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 automobile, airplane, ladies' dress, food processor, television set, or any other 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

45. *Id.*

46. H.R. REP. NO. 94-1733, at 82 (1976) (Conf. Rep.).

47. H.R. REP. NO. 94-1476, at 54 (1976).

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 overall configuration of the utilitarian article as such.<sup>48</sup>

Thus, the House Judiciary Committee “stressed Congress’s desire to exclude from protection the general class of industrial products, notwithstanding any ‘aesthetically satisfying’ design.”<sup>49</sup>

At the same time, however, the House Report appeared to introduce some flexibility into the standard by inserting a term not found in the statute. While the statute covers “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 House Report would extend protection to an “element that, physically *or conceptually*, can be identified as separable from the utilitarian aspects of that article” (emphasis supplied).<sup>50</sup> A test of physical separability seems fairly easy to apply, *Mazer* offering a paradigmatic example: removing the lampshade, light bulb, dowel and electric cord leaves the freestanding statuette. “Conceptual” separability, however, has proved far more elusive. Does it mean that one could imagine the design as a separate work of art were it extracted from its utilitarian surroundings, as would be the case for the “carving on the back of a chair or a floral relief design on silver flatware” cited in the House Report, without needing physically to take an axe to the chair to detach the carving? In the cited examples, the design element appears to be engrafted onto the shape of the useful article without necessarily altering the shape itself. It is not too difficult to “conceive of” the design being lifted off the useful article, leaving the article otherwise intact. Indeed, this concept of conceptual separability seems the flip side of the artist’s § 113(a) right to reproduce a PGS work “in or on” a useful article. In the latter instance, a pre-existing protectable design is affixed to a pre-existing useful article; in the former, the imagined separation of the design and the useful article yields two stand alone items, one of which will be a protectable PGS work. As we will see in the next section, the Copyright Office adheres to this approach to “conceptual” separability. We will consider more adventurous applications of “conceptual” separability when we turn to judicial interpretation.

### ADMINISTRATIVE INTERPRETATION

The U.S. Copyright Office administers the registration of works of authorship. Registration is not a prerequisite to protection, but no suit may be brought for infringement of a work of US origin unless the work has been registered before the suit is filed.<sup>51</sup> Thus any rightholder of a U.S. work of applied art who seeks to enforce

48. *Id.* at 55.

49. See Perlmutter, *supra* note 15 at 351.

50. H.R. REP. NO. 94-1476, at 54-55 (1976). For a fuller discussion of the legislative history, as well as of the pre-1976 Act treatment of works of applied art, see, e.g., WILLIAM PATRY, PATRY ON COPYRIGHT, §§ 3:125-3:135 (2016).

51. 17 U.S.C. § 411(a) (2008). Or at least, the plaintiff has filed an application to register. *Compare*

her copyright through an infringement action must convince the Copyright Office examiners that the claimed design elements are separable from the utilitarian aspects in order to obtain the necessary certificate of registration.<sup>52</sup> The Compendium of U.S. Copyright Office Practices (Third Edition 2014) states:

924.2(B) Conceptual Separability

The U.S. Copyright Office applies the conceptual separability test only if it determines that the useful article contains pictorial, graphic, or sculptural features that cannot be physically separated from that article.

Conceptual separability means that a feature of the useful article is clearly recognizable as a pictorial, graphic, or sculptural work, notwithstanding the fact that it cannot be physically separated from the article by ordinary means. This artistic feature must be capable of being visualized—either on paper or as a free-standing sculpture—as a work of authorship that is independent from the overall shape of the useful article. In other words, the feature must 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. For example, the carving on the back of a chair or an engraving on a vase would be considered conceptually separable, because one could imagine the carving or the engraving as a drawing on a piece of paper that is entirely distinct from the overall shape of the chair and the vase. Even if the carving or the engraving was removed the shape of the chair and the vase would remain unchanged, and both the chair and the vase would still be capable of serving a useful purpose.<sup>53</sup> H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668-69.

Under the Copyright Office's approach, in the case of an artistically-designed useful article, it is necessary to conceive of two distinct objects, one useful, the other artistic, "without destroying the basic shape of that article." This exercise of the imagination lends itself to the kinds of decorative elements envisaged in the House Report: one can imagine a drawing or carving on the back of a chair having an existence independent from the chair, without affecting the functioning of the chair as an item of furniture. In effect, this conceptual effort recalls the author's right to reproduce a preexisting PGS work "in or on" a useful article; one can imagine the drawing or carving as a free-standing work subsequently applied to the back of the chair. By contrast, this kind of conceptual exercise does not adapt well to the entire shape of the useful article, because it is difficult to imagine how the entire shape of an object can exist independently of the object itself. The Copyright Office's analysis appears to presume that, in imagining a "side by side" coexistence of the

*Cosmetic Ideas v. IAC/Interactive Corp.*, 606 F.3d 612, 616 (9th Cir. 2010), *and* *Chi. Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624 (7th Cir. 2003) ("application approach"), *with* *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1202-04 (10th Cir. 2005), *and* *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1489 (11th Cir. 1990) ("registration approach").

52. If the Register continues to refuse, the applicant may nonetheless file suit; the Register may choose to become a party to the action, per 17 U.S.C. § 411(a) (2008).

53. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668-69.

useful and the decorative elements, the imagined detachment of the decorative aspect will leave the rest of the object intact and functioning. But if the aesthetic element constitutes the entire form of the object, there is no “rest of” the object to persist independently.<sup>54</sup>

The Compendium continues with examples of “conceptually separable” elements; none involve the total shape of a useful article. Rather, the Compendium casts doubt on the latter’s registrability:

- Artwork printed on a T-shirt, beach towel, or carpet.
- A colorful pattern decorating the surface of a shopping bag.
- A drawing on the surface of wallpaper.
- A floral relief decorating the handle of a spoon.

Merely analogizing the general shape of a useful article to a work of modern sculpture or an abstract sculpture does not satisfy the conceptual separability test, because it does not provide an objective basis for visualizing the artistic features and the useful article as separate and independent works. *See Esquire, Inc. v. Ringer*, 591 F.2d 796, 804 (D.C. Cir. 1978) (agreeing with the Office’s determination that “the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright”).<sup>55</sup>

The Compendium’s examples feature artworks effectively “applied to” useful articles,<sup>56</sup> an approach consistent with what I have called the “flip side” of the § 113(a) right to reproduce a PGS work “in or on” a useful article. Had the “artwork printed on a T-shirt, beach towel, or carpet” pre-existed the useful article to which the “artwork” was affixed, the statute establishes that the “artwork” author’s copyright would extend to its being printed on those articles; reproduction of the article bearing the artwork would infringe the author’s copyright. If the “artwork” was created to be “printed on a T-shirt, beach towel, or carpet” but is nonetheless a separately identifiable PGS work, then it is copyrightable notwithstanding its incorporation in a useful article. The Copyright Office’s treatment of conceptual separability thus eliminates differential outcomes based on the birth order of the design relative to the useful article—so long as the design pertains to a discrete aspect

54. *See, e.g.*, Humanetics Innovative Solutions Inc., Correspondence ID: 1-JT7IVR (Review Board of the United States Copyright Office final agency action Sept. 11, 2014) (“If one were to conceptually separate the features of [the works identified in the application], there would be no underlying works remaining. The Works, therefore, fail the Copyright Office’s test for conceptual separability.”), [https://ipmall.law.unh.edu/sites/default/files/hosted\\_resources/CopyrightAppeals/2014/Q1Q10,Q1.52014.pdf](https://ipmall.law.unh.edu/sites/default/files/hosted_resources/CopyrightAppeals/2014/Q1Q10,Q1.52014.pdf).

55. Compendium of U.S. Copyright Office Practices § 924.2(B) (3d ed. 2014).

56. *Cf.* Paolo Marzano, *An Ill-Designed Protection for a Well-Designed Product: Italy and its Copyright Protection of Industrial Design*, 240 REV. INTE’L. DROIT D’AUTEUR 119 (Apr. 2014) (suggesting—regarding Italian copyright law, which formerly imposed a separability test—that “applied art” should not mean industrial design in general, but rather artworks (e.g., drawings, paintings, sculpture) applied to a useful article). Legge 21 aprile 1941, n.633, G.U. JUL. 16, 1941, n.166 (It.). *since amended by* Decreto legge 2 febbraio 2001, n.95, G.U. APR. 4, 2001, n.79 (It.), *implementing* Council Directive 98/71, 1998 O.J. (L289) 28 (EC).

of that article.

By contrast, the Copyright Office appears to reject more strenuous efforts of conceptualization which might imagine the entire shape of a useful article to be “separable” if the shape in no way affected its function. This approach, however, risks sliding into an idea/expression test, which would deem protectable any design that was not necessary to the functioning of the article. The Compendium rejects that test explicitly with respect to individual features, and necessarily implicitly with respect the overall design of the article:

The fact that a useful article could have been designed differently or the fact that an artistic feature is not necessary to or dictated by the utilitarian aspects of that article is irrelevant to this analysis. 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 useful article. *See generally* H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668-69.

The Copyright Office Compendium also details what considerations do not count in assessing the conceptual separability of a design:

924.2(C) Factors Not Relevant in Evaluating Separability

In assessing whether certain elements are physically or conceptually separable from the utilitarian functions of a useful article, registration specialists do not consider the following: (i) the aesthetic value of the design; (ii) the fact that the article could have been designed differently; or (iii) the amount of effort or expense that went into the making of the design. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668-69.

Specific applications of the Copyright Office rules can be found in the correspondence of the Review Board of the United States Copyright Office with applicants whose works the Office has declined to register.<sup>57</sup> A pattern emerges from these letters. First, the Review Board ascertains if the design of the useful article presents separable elements. Second, the Review Board examines those elements for minimal originality. Between 1995 and 2014 the Review Board resolved 396 appeals, of which 146 concerned useful articles. Three appeals resulted in registration of the design.<sup>58</sup>

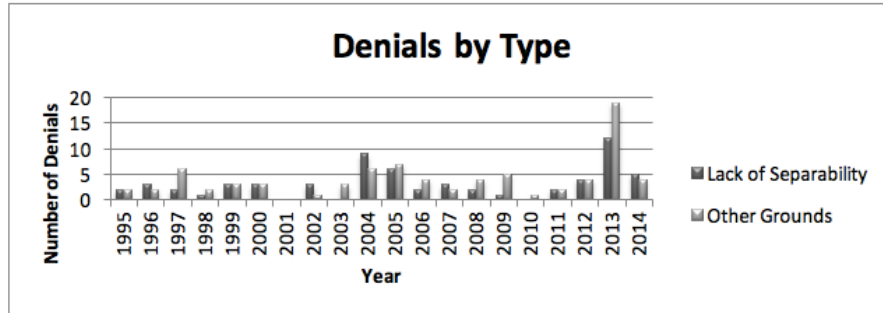
The chart below illustrates the grounds for denying the remaining 143 appeals.<sup>59</sup> Of these sixty-three that were denied registration because the Board found the design features physically or conceptually inseparable from their utilitarian function. Another eighty were rejected on other grounds: seventy-nine because the design

57. The University of New Hampshire School of Law maintains a database of Decision of the Appeals Board—U.S. Copyright Office 1995-2014, <https://ipmall.law.unh.edu/content/us-copyright-office-board-appeals-decisions>. The statements in text are based on a search of that database for rejections of form VA (visual art) applications from 1995-2014.

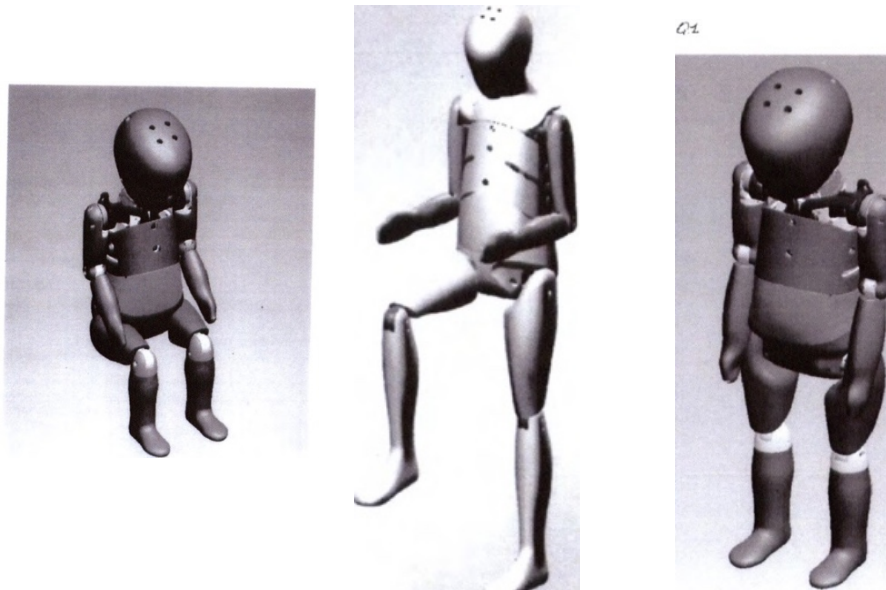
58. In two of those cases, the Board reversed its prior decision and granted copyright on grounds of originality. The other accepted appeal—after a previous finding of a lack of separability—was registered under the Rule of Doubt due to an inability of the Board to determine if the work was a *model* of a useful article or a useful article itself.

59. Thanks to Robert E. Bishop, Columbia Law School class of 2017, for preparing the chart.

features, even if separable, lacked minimal originality, and one for a lack of fixation and authorship.



Where the registrant has sought to claim the entire form of the article as a PGS work, the Review Board has declined to find separability. For example, where the applicant sought to register the overall shape of “crash dummy” human forms designed for testing the impact of automobile crashes on the human body (pictured below),<sup>60</sup> the Review Board ruled:



60. Humanetics Innovative Solutions Inc., Correspondence ID: 1-JT7IVR, p. 2 (Review Board of the United States Copyright Office final agency action Sept. 11, 2014) [https://ipmall.law.unh.edu/sites/default/files/hosted\\_resources/CopyrightAppeals/2014/Q1Q10,Q1.52014.pdf](https://ipmall.law.unh.edu/sites/default/files/hosted_resources/CopyrightAppeals/2014/Q1Q10,Q1.52014.pdf) (image located in appeal, but no additional source information available).

[Y]ou argue that the Works' overall visual aesthetic appearances are conceptually separable from the utilitarian functions of a crash test dummy. We find your arguments to be unpersuasive. Specifically, we find it impossible to imagine a way to conceptually separate the aesthetic design elements from the Works without destroying their shape and configuration as human-based testing devices. In order for *Q1*, *Q10*, and *Q1.5* to be useful as crash test dummies, designed to measure the forces imposed on the human body during an impact, the Works *necessarily* need to be designed in the basic image of a human. It is well settled that copyright protection is not available based on the "overall shape or configuration" of a utilitarian article "no matter how aesthetically pleasing that shape or configuration might be." To argue that the Works' aesthetic appearances are separable from the useful articles underneath is to claim that the Works' overall shapes and forms are distinguishable from their intended function. We do not agree.

. . . The sculptural aspects of the Works cannot be envisioned separately without completely destroying their images or configurations. If one were to conceptually separate the features of *Q1*, *Q10*, and *Q1.5*, there would be no underlying works remaining. The Works, therefore, fail the Copyright Office's test for conceptual separability.<sup>61</sup>

By excluding the "overall shape or configuration" of a useful article, the Copyright Office's application of the separability test effectively assesses only those elements that one may imagine physically detaching from the article. That said, the Office's imagined physical detachment of individual, original, design elements could still encompass elements whose removal would affect the article's appearance, so long as it did not alter the article's utility. While the Copyright Office imagines removal of the design items "without destroying the basic shape of that article,"<sup>62</sup> the term "basic shape" leaves room for maneuver. For example, where a design's shape is superfluous to the article's function, as would be the case were the back of the chair to follow the contours of elaborately shaped woodwork that did not impact the seating experience (that is, the woodwork played no structural or ergonomic role), then even though the overall shape of the chair would look different were its design elements lifted off, its "basic shape"—the unadorned chair back—would remain intact.<sup>63</sup> The superfluous design elements therefore would be "conceptually separable." But perhaps efforts more arduous than those the Copyright Office currently expends to conceptualize the design elements independently from their

61. *Id.* at 5 (citation omitted). Where a useful article does manifest separable design elements, it does not automatically follow that those elements will constitute a protectable PGS work. The Copyright Office's second basis for refusal to register the design of portions of a useful article is lack of originality. If the Copyright Office finds that the form, separated from the remainder of the article, is banal, it will refuse registration for lack of copyrightable authorship, as Ornamented Vanity (Infinity Kitchen Cabinet) Ornamented Coffee Table (Atelier Display Cabinet) Ornamented Cabinet (Guinevere 8' Breakfront Cabinet) Correspondence ID: 1-FJGCF5, p. 3 (Review Board of the United States Copyright Office final agency action Feb. 10, 2014), [https://ipmall.law.unh.edu/sites/default/files/hosted\\_resources/CopyrightAppeals/2014/OrnamentedVanityand2others2014.pdf](https://ipmall.law.unh.edu/sites/default/files/hosted_resources/CopyrightAppeals/2014/OrnamentedVanityand2others2014.pdf) (image located in appeal, but no additional source information available) illustrates. Please refer to the image in the appendix, p. 52.

62. See Compendium, *supra* note 55 at § 924.2(B).

63. See, e.g., *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010), discussed and pictured *infra*.

utility could identify additional protectable elements, whether individually or as a whole. One widely adopted approach considers the extent to which an article's function affects the designer's aesthetic choices, an approach that would endeavor to locate copyrightability on a sliding scale from form-follows-function (inseparable) to functionally gratuitous (separable).<sup>64</sup> As we shall see in the next section, judicial authorities have also offered many more tests for determining conceptual separability. The plethora of standards has, not surprisingly, produced considerable confusion and unpredictability, culminating in the U.S. Supreme Court's decision to grant certiorari in the decision quoted at the outset of this Article.<sup>65</sup>

### JUDICIAL INTERPRETATION

As an initial matter, recall that "conceptual separability" is not a statutory standard; it emerges from the legislative history. Textualists therefore might urge curtailing further elaboration of *conceptual* separability, and henceforth confining the inquiry to "pictorial, graphic, or sculptural *features* that [1] can be *identified separately* from, and [2] are capable of *existing independently* of, the utilitarian aspects of the article."<sup>66</sup> "Features" suggests aspects or components of the design, not the entirety of the form of the useful article. The statutory text best fits physically separable pictorial, graphic or sculptural design elements, as exemplified by the *Mazer* statuette lamp base: these clearly can be "identified separately from" and "exist independently of" the useful article's functional elements; indeed, the lamp bases appear initially to have been freestanding statuettes. But the text does not preclude elements whose physical removal one might imagine, even where actual removal would change the appearance of the useful article, such as chopping the carving off the back of the chair. The Compendium's examples, albeit offered as elaborations on "conceptual separability," meet the dual statutory requirements of separate identifiability and independent existence, at least if one interprets the statutory phrase "*capable* of existing independently" to extend to the imaginary removal of the element as a predicate to its existing independently from the article. In effect, this conceptual effort would imagine the design feature as a preexisting PGS work reproduced on or in the useful article. Interpreting separability as the mirror image of § 113(a) would also be consonant with the statutory text: if notwithstanding its application to or incorporation in a useful article, the design element could have been a freestanding PGS work, then it is both separately identifiable, and *capable* of separate existence.<sup>67</sup>

64. See, e.g., *id.*; *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. Appx. 42 (2d Cir. 2012) (prom dresses); *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987); *Pivot Point Int'l v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004), discussed and pictured *infra*.

65. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 478 (6th Cir. 2015).

66. 17 U.S.C. § 101 (2010) (emphasis added).

67. By contrast, applying the mirror image approach to the entire form of a useful article is more problematic, for, as suggested above, "features" uneasily encompasses the whole rather than particular parts of the useful article. Albeit were the complete abstraction of the article's form from its function possible, because the shape is completely unnecessary to the article's function, and the shape could stand on its own as a work of art, perhaps the overall shape might be a "feature." See PAUL GOLDSTEIN,

In any event, almost every federal court of appeal that has adjudicated the copyrightability of design elements of useful articles has purported to apply a test of conceptual separability, though each court has formulated that test differently.<sup>68</sup> Moreover, in some instances, courts embarked on their tortuous forays into separability tests without adequately analyzing first whether the disputed design was in fact a design of a “useful article.” Separability becomes an issue only if the asserted PGS work is “a design of a useful article.”<sup>69</sup> As we will see, courts might better have treated some cases, including *Varsity Brands*, as involving PGS elements applied to useful articles, rather than as useful articles in themselves.

### THE WHOLE VERSUS THE PARTS: CONSTITUENT ELEMENTS

Because “a useful article, as a whole, does not receive copyright protection, but any constituent design elements that can be physically or conceptually separated from the underlying article can receive copyright protection,”<sup>70</sup> the majority of judicial decisions finding “conceptual separability”<sup>71</sup> focus on the “constituent items” – decorative elements detached from the overall shape of the article. For example, in *Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc.*, a case involving

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GOLDSTEIN ON COPYRIGHT, § 2.5.3(b) (3d ed. 2005) (applying a “stand alone” test to construe “conceptual separability” generally, and citing example of a slipper in the shape of a bear paw).

68. *Compare* *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) (“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. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”), *with* *Varsity Brands v. Star Athletica*, 799 F.3d 468, 487-88 (6th Cir. 2015) (“What are the utilitarian aspects of the useful article? . . . Can the viewer of the design identify pictorial, graphic, or sculptural features separately from the utilitarian aspects of the useful article? . . . Can the pictorial, graphic, or sculptural features of the design of the useful article exist independently of the utilitarian aspects of the useful article?”), *with* *Pivot Point Int’l v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004) (independence of design decisions from utilitarian functions), *with* *Leicester v. Warner Bros.*, 232 F.3d 1212, 1219 (9th Cir. 2000) (conceptual separability requires that the claimed design feature “can stand on its own as a work of art traditionally conceived, and . . . the useful article in which it is embodied would be equally useful without it”) (internal quotation marks omitted), *with* *Progressive Lighting, Inc. v. Lowe’s Home Ctrs., Inc.*, 549 F. App’x. 913, 920 (11th Cir. 2013) (conceptual separability concerns “ornamental, superfluous designs contained within useful objects;” “[c]onceptual separability does not apply to ‘functional components of useful articles, no matter how artistically designed . . . unless they are physically separable from the useful article.’”) (citations omitted).

69. 17 U.S.C. § 101 (2010) (definition of a PGS work).

70. *Progressive Lighting, Inc. v. Lowe’s Home Ctrs., Inc.*, 549 F. App’x. 913, 921 (11th Cir. 2013) (lighting fixture), *quoting* *Baby Buddies, Inc. v. Toys R Us, Inc.*, 611 F.3d 1308, 1316 (11th Cir. 2010) (pacifier holder).

71. The burden of proving separability falls on the plaintiff; many cases have been dismissed at the outset for failure to plead with particularity which elements of the article were conceptually separable and why. *See, e.g.*, *Gusler v. Fischer*, 580 F. Supp.2d 309 (S.D.N.Y. 2008) (“electric vacuum device to extract fluid from the nose of an infant”); *In re Chi. Newspaper Liquidation Corp.*, 490 B.R. 487 (Bankr. D. Del. 2013) (front-backpack); *Spectrum Creations, L.P. v. Carolyn Kinder Int’l, LLC*, 2008 WL 416264 (W.D.Tx. Feb. 13, 2008) (lighting fixture); *Ochre LLC v. Rockwell Architecture Planning and Design, P.C.*, 2012 WL 6082387 (S.D.N.Y. Dec. 3, 2012) (chandelier designs); *Design Furnishings, Inc. v. Zen Path, LLC*, 2010 WL 5418893 (E.D.Cal. Dec. 23, 2010) (furniture designs); and *Heptagon Creations, Ltd. v. Core Grp. Mktg. LLC*, 2011 WL 6600267 (S.D.N.Y. Dec. 22, 2011) (furniture designs).

highly ornate furniture design (pictured below),<sup>72</sup> the Fourth Circuit echoed the Copyright Office's rejection of the overall design of a useful article.<sup>73</sup> Nonetheless, the court held particular decorative aspects of the furniture protectable on the ground that they were "superfluous nonfunctional adornments for which the shape of the furniture (which is not copyrightable) serves as the vehicle."<sup>74</sup> The court found the designs' ornamental profusion of "three-dimensional shells, acanthus leaves, columns, finials, rosettes, and other carvings" "'wholly unnecessary' to the furniture's utilitarian function."<sup>75</sup>



72. Photographs of Dining Room, Table, and Chair, UNIVERSAL EXHIBITS Civil Action No. 1:04CV00977 (M.D.N.C. 2007), <http://168.144.88.155/ce/> (image located on website, but no additional source information available).

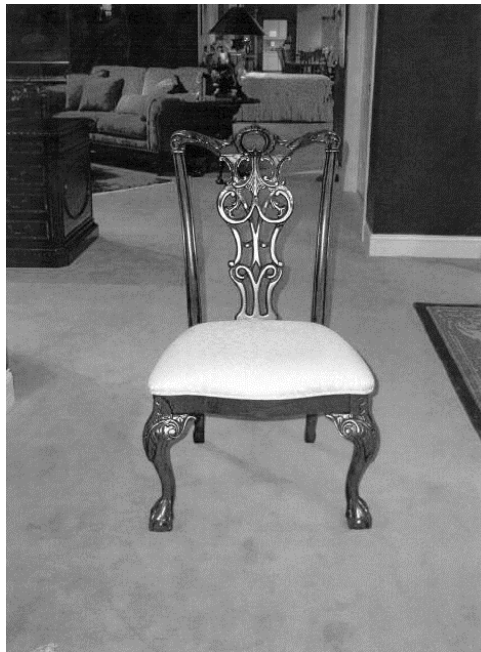
73. *Universal Furniture Int'l, Inc. v. Collezione Europa USA*, 618 F.3d 417, 433 (4th Cir. 2010):

"The industrial design of a unique, aesthetically pleasing chair cannot be separated from the chair's utilitarian function, and therefore, is not subject to copyright protection." . . . [T]he "shape of the furniture cannot be the subject of a copyright, no matter how aesthetically pleasing it may be," but the "decorative elements that are separable from the furniture can be."

74. *Id.* at 434:

The [furniture collection] designs are highly ornate collections of furniture adorned with three-dimensional shells, acanthus leaves, columns, finials, rosettes, and other carvings. Steven Russell [the creator of the collections] described the collections as "an ornamentation explosion," and Universal's expert Thomas Moser similarly described the [collections] as "essentially vehicles for expressing ornament." . . . These decorative compilations are not "industrial designs" of furniture. They are not like a bare human torso mannequin for which adornment is the very utilitarian purpose of the object. Like statuettes on a lamp base, the [collections'] design compilations are superfluous nonfunctional adornments for which the shape of the furniture (which is not copyrightable) serves as the vehicle. The designs can therefore be "identified separately from" the utilitarian aspects of the furniture. 17 U.S.C. § 101. Indeed, the designs are "wholly unnecessary" to the furniture's utilitarian function. A carved scroll of leaves on a nightstand post, for example, does nothing to improve the utilitarian aspect thereof.

75. *Id.*



By contrast, an absence of ornamentation may condemn the design of a useful article, because the artistic creativity (if any) inheres in the overall form of the object, which, no matter how “aesthetically satisfying,” courts generally decline to protect.<sup>76</sup> For example, in *Progressive Lighting, Inc. v. Lowe’s Home Ctrs., Inc.*,<sup>77</sup> the Eleventh Circuit emphasized that conceptual separability applies to “ornamental, superfluous designs contained within useful objects,” and not to the object as a whole, in that case, an unadorned chandelier (of the kind pictured below).<sup>78</sup>



76. H.R. REP. NO. 94-1733, at 82 (1976) (Conf. Rep.).

77. 549 F. App’x. 913, 920 (11th Cir. 2013).

78. See *Lowe’s, Photograph of Chandelier*, <https://perma.cc/T9GD-JRKY> (the image is a “6-Light . . . chandelier[] sold under the ‘Portfolio’ brand” at Lowe’s (last visited Sept. 23, 2016)).

Some courts' separation of protectable decorative detail from the useful article as a whole recalls § 113(a). Indeed, in those decisions, the contested designs might more accurately have been analyzed as preexisting pictorial works affixed onto useful articles. For example, in *Varsity Brands*, the Sixth Circuit ruled that team insignia applied to cheerleader uniforms (pictured below)<sup>79</sup> were separable and protectable from the overall design of the uniforms. While the court found separability because "the arrangement of stripes, chevrons, color blocks, and zigzags are 'wholly unnecessary to the performance of' the garment's ability to cover the body, permit free movement, and wick moisture,"<sup>80</sup> it should instead have treated those elements as fabric design, a category long recognized as a pictorial or graphic work.<sup>81</sup> Copyright does not protect the garments into which the design-bearing fabric is cut, but neither does the fashioning of the fabric into an article of clothing cancel out the copyright of the design imprinted thereon.

79. 799 F.3d at 472-73 (image located in opinion, but no additional source information available).

80. *Id.* at 491.

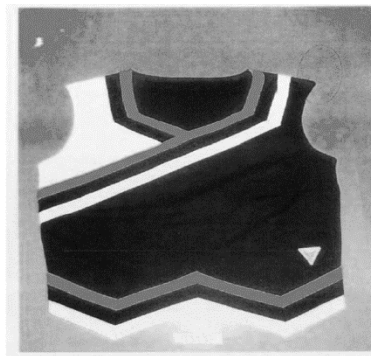
81. See, e.g., *L.A. Printex Indus. v. Aeropostale, Inc.*, 676 F.3d 841 (9th Cir. 2012); *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996 (2d Cir. 1995); *Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484 (S.D.N.Y. 1997). By contrast, in *Jovani Fashion*, *supra* note 64, the Second Circuit affirmed the District Court's dismissal of a complaint alleging that defendant competitor infringed the design of plaintiff's prom dress. According to the District Court, plaintiff "conceded that the individual elements of the dress (such as the pattern of sequins) were not copyrightable in isolation. Jovani acknowledged that there is no discernible pattern of sequins . . . Jovani has conceded that it is not claiming a copyright in the fabric designs of its dress." *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 551 (S.D.N.Y. 2011). The sequin pattern's lack of originality indicates that, unlike *Varsity Brands*, which involved "multiple graphic designs that appear on the cheerleading uniforms and warm-ups they sell," 799 F.3d at 470, *Jovani* could not have been reconceptualized as a fabric design case.



Design 078  
Registration No. VA 1-417-427



Design 0815  
Registration No. VA 1-675-905



Rather than addressing the cheerleading garments as a whole (and detailing ten different tests of conceptual separability), the court should have recognized that the design elements at issue—the fabric designs representing team insignia—were not useful articles in the first place. The facts the court discussed might have alerted it to the difference between the design elements (insignia) and the useful article (the garment). Indeed, the court distinguished between the “graphic design” and the uniform:

The five Varsity designs are examples of how a cheerleading uniform still looks like a cheerleading uniform no matter how different the arrangement of the stripes, chevrons, colorblocks, and zigzags appear on the surface of the uniform. All of Varsity’s graphic designs are interchangeable. Varsity’s customers choose among the designs in the catalog, including the five designs at issue, select one of the designs, and then customize the color scheme. The interchangeability of Varsity’s designs is evidence that customers can identify differences between the graphic features of each design, and thus a graphic design and a blank cheerleading uniform can appear “side by side”—one as a graphic design, and one as a cheerleading uniform.<sup>82</sup>

82. 799 F.3d at 491 (citation omitted). Toward the end of its opinion, the Sixth Circuit finally recognized “we believe that the graphic features of Varsity’s cheerleading-uniform designs are more like fabric design than dress design,” *see id.* at 493.

In highlighting the graphic designs' "interchangeability," the Sixth Circuit effectively applied the statutory standards of separate identifiability and independent existence of the designs relative to the uniforms. But the court would have made shorter work of its analysis had it drawn a different conclusion from its characterization of "the stripes, chevrons, colorblocks, and zigzags" as the "graphic design," and from the customers' selection among the graphic designs: these elements are PGS works "reproduced on" the uniform (the useful article); the graphic designs' status as PGS works did not require assessing the characteristics of the uniforms.<sup>83</sup>

Similarly, in *Home Legend v. Mannington Mills*,<sup>84</sup> the useful article was floorboards made of compacted resin and sawdust, onto which the plaintiff had laminated paper painted to resemble "distressed" woodgrain so that the floorboards would convey the appearance of true wood planks (pictured below).<sup>85</sup> The court held the design separable. One may easily envision lifting off the design (as indeed it had been pasted on), without affecting the flooring, other than aesthetically. That the ersatz wood grain made unsightly pressed sawdust floorboards more aesthetically desirable undoubtedly affected their commercial appeal, but "aesthetic functionality" is not a utilitarian function in the copyright sense. The court should instead have recognized that the "work" allegedly infringed was the depiction of the wood grain, not the floorboards onto which the pictures had been glued. Like *Varsity Brands*, *Home Legend* would have avoided inquiry into conceptual separability had it perceived the case as an instance of reproducing a PGS work on a useful article.



**Distressed Maple Mendocino**



**Glazed Maple**

83. The court acknowledged that "[i]f the design is not the design of a useful article, then there is no need to inquire into whether there are 'pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article.'" 17 U.S.C. § 101. But it then stated that the design at issue was the design of the uniform rather than "the graphic features of each design [uniform]." *Id.* at 487, 491. See also Patry, *supra* note 50, at § 3:143.50 (distinguishing between the design "of" a useful article, and a design applied "to" a useful article, and stating that *Varsity Brands* exemplifies the latter).

84. 784 F.3d 1404 (11th Cir. 2015).

85. Photograph of Flooring, <https://perma.cc/CU7R-WLBS> (last visited Sept. 23, 2016) (image located on website, but no additional source information available). Home Legend sold the Distressed Maple Mendocino, on the left, while Mannington Mills sold the Glazed Maple, on the right.

*Varsity Brands* and *Mannington Mills* reveal the importance of ascertaining whether the contested design is in fact the design of a “useful article.” A PGS work applied to (“reproduced on”) a useful article is not itself a useful article, and courts need not “twist themselves into knots” endeavoring to parse the meaning of the statutory separability standard. If the Supreme Court were to decline to reach separability on the ground that resolution of the *Varsity Brands* dispute does not in fact require it, some might be disappointed that the Court would fail to tidy the disarray in the lower courts over the meaning of “conceptual separability.” But the predicate issue—what is the design of a “useful article”—also warrants more attention than lower courts have given it. Thus, were the Court to leave separability to a case that in fact poses that issue, the Court would still contribute to clarifying this area of copyright law.

### THE WHOLE VERSUS THE PARTS: OVERALL FORM

The cases in which “[c]ourts have struggled mightily to formulate a test to determine whether ‘the pictorial, graphic, or sculptural features’ incorporated into the design of a useful article ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article’” most often address the design of a useful article as a whole.<sup>86</sup> In these instances, the overall form may manifest substantial artistic accomplishment (theoretically, a copyright-irrelevant consideration), prompting judicial inclination to find separability lest an aesthetically meritorious design fall prey to piracy. In often divided decisions, some appellate courts have resisted the temptation, while others have strained to fit the overall form within the separability framework. Hence the Gordian metaphor whose frequent reiteration has made it a trope in design copyright cases.<sup>87</sup>

As the *Varsity Brands* majority evidences, in enumerating nine variants on the separability test and adding one of its own, the case law incessantly restates the separability test, in formulations sometimes adapting the “capable of existing separately” criterion of the statutory definition, and sometimes evaluating the relationship of design choices to utilitarian objectives (and sometimes both).<sup>88</sup> In the “separate existence” camp, one might range the conceptual superimposition of the design elements atop a basic utilitarian framework;<sup>89</sup> the viewer’s response to the object as a work of art rather than as a useful article;<sup>90</sup> and the irrelevance of the design to the article’s functional utility.<sup>91</sup> In the design process camp fall inquiries

86. *Varsity Brands*, 799 F.3d at 484.

87. *Id.* at 478.

88. *Id.* at 484-85.

89. *See, e.g.*, *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980).

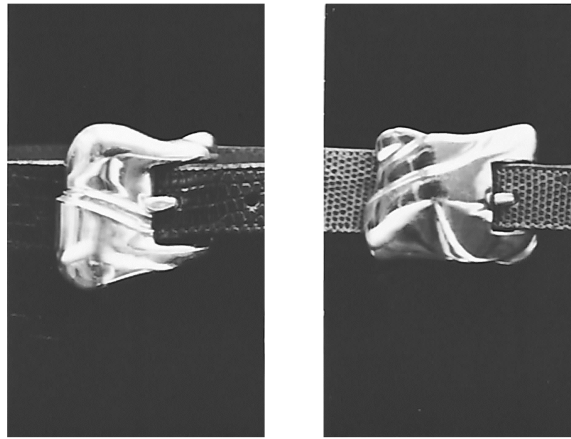
90. *See, e.g., id.*; *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting).

91. *See, e.g., Varsity Brands*, 799 F.3d at 492 (team insignia “wholly unnecessary” to the garments’ function). Evidence that purchasers in fact use the contested item for purely decorative rather than utilitarian purposes may help a court determine, well after the work’s initial publication, that the design elements are separable. But that evidence may not be available at the time of publication, when many applications for registration are made, and the evidence thus will not assist the Copyright Office’s examination. Thanks to Rob Kasunic for this observation.

into the extent to which the designer exercised artistic judgment independently of functional considerations.<sup>92</sup>

### SEPARATE EXISTENCE

The Second Circuit's 1980 decision in *Kieselstein-Cord v. Accessories by Pearl* exemplifies both the "superimposition" and the "viewer response" approaches to conceptual separability. In a dispute concerning artistically-designed belt buckles (pictured below),<sup>93</sup> a majority of the Second Circuit panel succeeded in imagining the removal of the belt buckle covers from the utilitarian housing (even though the buckles apparently were fused into a single piece). The majority considered public perception of the objects as purely ornamental as probative of the distinct conceptualization of the articles' aesthetic features. Because many purchasers of the belt buckles wore them not for the purpose of holding up trousers, but rather "worn around the neck or elsewhere on the body rather than around the waist," the articles were indeed "capable of existing separately" from their utilitarian function.<sup>94</sup>



By contrast, five years later in *Carol Barnhart, Inc. v. Economy Cover Corp.*,<sup>95</sup> a majority of the Second Circuit, arguing essentially by assertion, rejected the

92. See, e.g., *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987); *Pivot Point Int'l v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004).

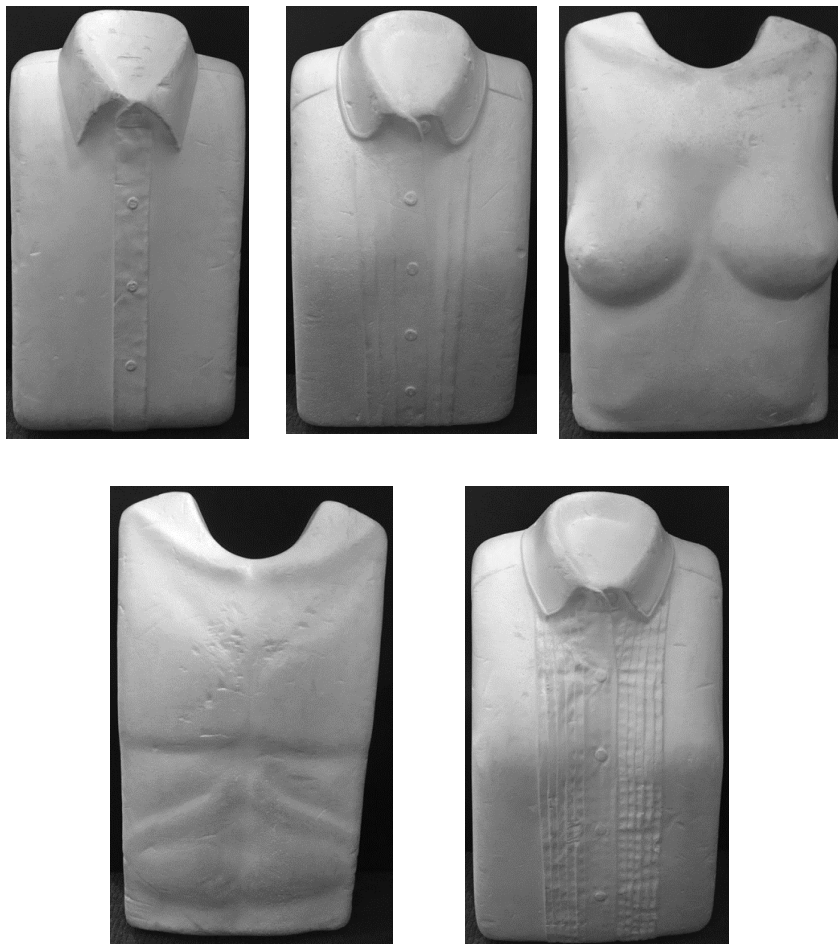
93. *Kieselstein-Cord*, 632 F.2d at 995 (image located in opinion, but no additional source information available).

94. *Kieselstein-Cord*, 632 F.2d at 991 also exemplifies the "market value" variant of the "viewer response" approach: "conceptual separability exists where there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities," 1-2A. *Nimmer on Copyright*, § 2A.08(B) (Matthew Bender, Rev. Ed. 2016); *Galiano v. Harrah's Operating Co., Inc.*, 416 F.3d 411, 419 (5th Cir. 2005). The Second Circuit also noted the belt buckles' inclusion in museum collections; this feature may attest to the (copyright-irrelevant) aesthetic worthiness of the design, but unless the collection assembles works that are not useful articles, e.g., jewelry designs, the disputed design's presence in a museum's collection of applied art is not probative of the separation of form from function.

95. 773 F.2d 411, 419 (2d Cir. 1985).

relevance of public response to plaintiff's polystyrene shirt-display forms (pictured below)<sup>96</sup> as sculptures:

Appellant emphasizes that clay sculpting, often used in traditional sculpture, was used in making the molds for the forms. It also stresses that the forms have been responded to as sculptural forms, and have been used for purposes other than modeling clothes, e.g., as decorating props and signs without any clothing or accessories. While this may indicate that the forms are "aesthetically satisfying and valuable," it is insufficient to show that the forms possess aesthetic or artistic features that are physically or conceptually separable from the forms' use as utilitarian objects to display clothes. On the contrary, to the extent the forms possess aesthetically pleasing features, even when these features are considered in the aggregate, they cannot be conceptualized as existing independently of their utilitarian function.<sup>97</sup>



96. Robert E. Bishop, Photographs of Carol Barnhart Shirt Display Forms (2016).

97. See *Carol Barnhart*, 773 F.2d at 418.

In dissent, Judge Newman endeavored to give meaning to the notion of “conceptual” separability. He contended that “the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function. . . . [T]he requisite ‘separateness’ exists whenever the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously.”<sup>98</sup> This test will in fact exclude most artistically designed useful objects, because perceiving the object as both artistic and useful—Judge Newman gave the example of an artistically-designed chair—does not suffice. The artistic aspects must displace identification of the object as useful. The standard seems to invite philistinism: “I don’t know what it is, so it must be Art.” As a result, Judge Newman’s conceptual displacement approach may serve more to identify when an object’s overall design is *not* separable, than when it is.



**Mara**

Finally, in the category I am calling “separate existence” conceptual separability, would fall designs of useful articles whose overall appearance does not affect their function. We have seen that ornamentally superfluous elements can be conceptually detached from the form as a whole and therefore classed as PGS works. But can functional irrelevance characterize the entire shape of a useful article? A divided Seventh Circuit in *Pivot Point Int’l v. Charlene Prods., Inc.*,<sup>99</sup> concerning mannequin heads used for styling hair and applying makeup in beauty schools (pictured

98. *Id.* at 422.

99. 372 F.3d 913 (7th Cir. 2004).

above),<sup>100</sup> stated, quoting Judge Newman, “[c]onceptual separability exists . . . when the artistic aspects of an article can be ‘conceptualized as existing independently of their utilitarian function.’”<sup>101</sup> Shifting to the design-process approach to conceptual separability (analyzed in the next section), the majority continued, “This independence is necessarily informed by ‘whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.’”<sup>102</sup> We will address design-process analysis subsequently. For present purposes, the court’s determination that the heads’ designer shaped the faces according to his artistic preferences, without regard for the use to which apprentice beauticians would put the heads, could serve not only as evidence that functional concerns did not influence the design, but also for the proposition that the chosen designs did not affect the heads’ utility. For the purpose of learning to apply make-up, any facial features will do.<sup>103</sup>

### DESIGN-PROCESS ANALYSIS

Many decisions addressing the conceptual separability of a useful article’s entire form from its function focus on the role that utilitarian concerns played in the shaping of the article’s appearance. In *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*,<sup>104</sup> a majority of the Second Circuit rejected copyright protection for a stylized bicycle rack (pictured below)<sup>105</sup> on the ground that the object’s functional objectives motivated the designer’s choices. The designer had altered the structure’s shape in order better to accommodate the parking of bicycles; the resulting “fusion” of form and function proved fatal to the copyright claim.

While the RIBBON [bicycle] Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices. Indeed, the visually pleasing proportions and symmetry of the rack represent design changes made in response to functional concerns. Judging from the awards the rack has received, it would seem in fact that Brandir has achieved with the RIBBON Rack the highest goal of modern industrial design, that is, the harmonious fusion of function and aesthetics.<sup>106</sup>

100. Photograph of “Mara,” Pivot Point, 170 F. Supp.2d 828, 840 (N.D.Ill. 2001) (image located in opinion, but no additional source information available).

101. *Pivot Point Int’l v. Charlene Prods., Inc.*, 372 F.3d 913, 931 (7th Cir. 2004).

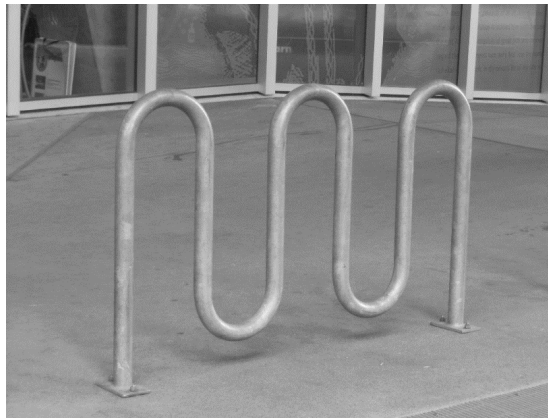
102. *Id.*

103. As the dissent pointed out, 372 F.3d at 934, the majority’s standard seems closer to an idea/expression merger inquiry than to a separability test. *Cf.* Compendium, *supra* note 55 at § 924.2(C), ruling irrelevant “the fact that the article could have been designed differently.”

104. 834 F.2d 1142 (2d Cir. 1987).

105. Jane C. Ginsburg, Photographs of Stylized Bicycle Rack (2016).

106. 834 F.2d at 1147.



Inquiries into the designer's motivation of course encourage revisionist recollection to purge aesthetic choices of any functional influence, as Judge Winter pointed out in dissent.<sup>107</sup> The design-choice approach also raises the question of whether decisions which affect a useful article's shape, but in a manner that, rather than maximizing utility in fact undermines it, would be conceptually separable. For example, a table top in the shape of an amoeba would be visually striking, but probably functionally suboptimal, since its unusual shape would diminish both useful surface area and ease of placement in a room.

Notwithstanding the shortcomings of the design-process approach, it appears to be the preferred mode of analysis of many courts and commentators. Courts and commentators ask if "artistic judgment [was] exercised independently of functional

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107. *Id.* at 1151. *Accord*, Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1350 (1987) ("How are we to verify the impulses that guided a designer's hand? Must we take her testimony in every disputed case?"); *see* Perlmutter, *supra* note 15 at 373 (discussing problems with motivation analysis); Moffat, *supra* note 11 at 638-39 (criticizing design-process analysis as overly fact-specific and manipulable).

influences.”<sup>108</sup> It is not clear, however, at least as to some commentators, how “independent” of functional “influence” the design choices must be. The required liberation appears to range from complete independence to choices that take into account but are not “dictated by” functional constraints.<sup>109</sup> The latter approach welcomes more designs into copyright, and therefore might seem more consonant with the general goal of the copyright system to encourage creativity, but it is in tension with the specific statutory standard and legislative history. The “not dictated by” standard is inconsistent with Congress’ rejection of a new monopoly regime of protection for applied art, even one more limited than copyright. The abandoned Title II of the 1976 Copyright Act would have protected a design whose form was not “dictated solely by a utilization function of the article that embodies it.”<sup>110</sup> If this would have been the test for the lesser form of protection that Congress chose not to enact (in part out of concern for anticompetitive consequences), it seems particularly inappropriate to adopt it for full-on copyright protection.<sup>111</sup> Accordingly, under the statute as enacted, copyright should be denied even if utilitarian imperatives furnished only one of the considerations informing the overall design of the useful article. Separability, conceptual or otherwise, requires the complete separation of aesthetic and utilitarian design choices.<sup>112</sup>

There remains the problem of proving the process. As suggested earlier, to ask the designer “what were you thinking when you chose this shape” invites disingenuousness. A more objective approach would inquire what instructions the designer (if hired to create the useful article) received with respect to the relationship of form and function. The Seventh Circuit in *Pivot Point* assigned considerable relevance to the commissioning party’s having “given carte blanche” to the designer, apart from specifying the non-utilitarian goal that the model heads exhibit a “hungry look.”<sup>113</sup>

More objective still would be to assess whether the overall form achieves

108. See, e.g., *Brandir*, *supra* note 63; *Pivot Point*, *supra* note 63; *Universal Furniture*, *supra* note 62; *Jovani Fashion* *supra* note 64 (prom dresses). See generally Robert Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 740-47 (1983) (proposing to distinguish “applied art from industrial design by examining the extent to which utilitarian considerations influence artistic expression,” *id.* at 743).

109. See *Varsity Brands*, 799 F.3d at 484-85 (quoting Barton R. Keyes, Note, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L.J. 109, 141-42 (2008)).

110. S. REP. NO. 94-473, at 39 (1975).

111. The 1998 Vessel Hull Design Protection Act of 1998, Pub. L. No. 105-304, 112 Stat. 2860, 2905 (1998), which added Chapter 13, “Protection of Original Designs” to Title 17, protects boat hull designs unless the design is “dictated solely by a utilitarian function of the article that embodies it.” 17 U.S.C. § 1302(4) (2006). Like the unenacted Title II, Chapter 13 of the Copyright Act requires notice, registration, and affords protection for ten years from registration. For the moment, however, the only “original designs” Chapter 13 protects are boat hulls.

112. See, e.g., *Aqua Creations United States, Inc. v. Hilton Hotels Corp.*, 2011 U.S. Dist. LEXIS 31982, 98 U.S.P.Q.2D (BNA) 1471, 2011 WL 1239793 (S.D.N.Y. Mar. 28, 2011), *aff’d*, 487 F. App’x. 627 (2d Cir. 2012) (“Aqua must plead facts permitting the Court to find that the design represents purely aesthetic choices, as opposed to ‘a merger of aesthetic and functional considerations.’ *Brandir* [Int’l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142 (2d Cir. 1987)] at 1145.”).

113. *Pivot Point*, 372 F.3d at 931-32.

utilitarian purposes. But that approach foregoes inquiry into how the work was created in order to focus on the form/function relationship in the resulting useful article. The test seeks to determine whether the object's form affects its utilitarian function: would the article function differently were it shaped differently?<sup>114</sup> If the answer to that question is "yes," then the object's form and function are not "capable of existing separately" from each other. Importantly, the capacity for separate existence pertains to the useful article as designed, not to whether a useful article of its kind—for example, a chair—could still serve for seating were it designed differently. The latter inquiry would revert to an idea/expression analysis of whether a multiplicity of forms might fulfill the general function of the useful article. But, as earlier observed, that generous approach is not the statutory standard.

### PROVISIONAL PRECEPTS

To ask whether a useful article's form "affects" its utilitarian function will almost certainly disqualify the overall shape of most useful articles, even though that shape may be aesthetically innovative and pleasing. One might think that result inconsistent with copyright's general goal to promote artistic creativity. But it is important to recall that useful articles do not fit comfortably within copyright's long duration, broad scope, and freedom from formalities. Congress therefore determined to preclude copyright protection for most useful articles, albeit leaving some room for individual design "features." If that room accommodates the overall form of few if any useful articles, that outcome is an intended consequence. As we have seen, attempts to enlarge the category of "conceptually separable" forms to encompass shapes that affect utilitarian function produce inconsistent standards that guide neither lower courts nor the practitioners and purveyors of industrial design.

The following precepts emerge: aesthetic merit is not to be confused with separability; separability is a standard more restrictive than "idea/expression merger"; and conceptual separability, to the extent it applies at all to the overall form of a useful article, requires the complete disenfranchisement of form from function, so that the form is "wholly unnecessary" to the function.<sup>115</sup> If a change in overall form would cause the article to function differently, then the form is not "separable." More radically, one might eschew "conceptual" separability, and return to the statutory requirements that the useful article contain "features" that can be "identified separately" and are "capable of existing independently" from the article's utilitarian

114. See, e.g., *Ochre LLC v. Rockwell Architecture, Planning & Design, P.C.*, 530 F. App'x. 19 (2d Cir. 2013) (lighting fixture design not separable because it "'reflect[s] a merger of aesthetic and functional considerations,' insofar as the aesthetic choices made by Ochre in the design of the chandeliers are necessarily intertwined with the need of the fixture to fulfill its function of lighting the hotel rooms"); *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005) ("[O]ne may not copyright the general shape of a lamp, because its overall shape contributes to its ability to illuminate the reaches of a room.").

115. *Varsity Brands*, 799 F.3d at 488. Some bottle designs may offer one example. The shape of the container may be irrelevant to spray or pump-action bottles if the tube retrieves liquid from the bottom of the container whatever bottle's shape. On the other hand, the overall form may further other utilitarian objectives, such as ease of grasping.

aspects. If the design of a separately identifiable element affects the article's function, it does not exist independently; rather, it is integrated into the article's utilitarian aspects. If the design at issue envelopes the entire form of the article, the task of identifying separate design features becomes more daunting since the statutory term "features" suggests some subset of the article, not its entire form.

Nonetheless, if one assesses the design's capacity for existence independently of the article's utilitarian aspects, there may be circumstances in which one might imagine an intact version of the entire design detached from the article, in effect separating the goods into a useful article on the one hand, and a PGS work "reproduced in or on" the useful article on the other.<sup>116</sup> In other words, § 113(a) may supply the sword that cuts through the tangle of "separability" case law. The following section demonstrates how § 113(a) can provide indirect protection to some overall designs of useful articles when those articles derive from pre-existing PGS works. The discussion then inquires whether a design of a useful article might enjoy direct copyright protection under a separability analysis that imagines that the design of a useful article had initially been the design of a PGS work.

#### CODA AND PARADOX: INDIRECT COPYRIGHT PROTECTION FOR SOME INDUSTRIAL DESIGN?

If the design of an extant PGS work were subsequently adopted as the shape of a useful article, for example, the *Mazer* statuettes or the hypothetical crocodile sculpture, separability analysis should not apply at all, because the scope of protection for a PGS work extends to its reproduction "in or on" a useful article. If the designer of the *Brandir* bicycle rack had not modified his original wire sculpture in order to adapt it into a better functioning parking structure for bicycles, but had instead left it as a work of abstract sculpture, then the wire structure would have remained a sculptural work, and its unauthorized reproduction, whether as a sculpture or enlarged into a bicycle rack, might have violated the sculptor's copyright.<sup>117</sup> In this variation on *Brandir*, changing the form of the sculpture to reproduce it as a bicycle rack would have affected the article's function, but that result does not matter if the separability test does not apply to the underlying wire sculpture in the first place. The copyright lies in the sculpture (assuming it is minimally original), not in the bicycle rack; the sculptor's copyright entitles him to authorize or prohibit bicycle racks based on the sculpture because the rack is a reproduction of the sculpture "in or on" a useful article. Thus, had another designer, seeing the original wire sculpture, perceived the sculpture's potential to serve as a bicycle rack, and then redesigned the sculpture, introducing the changes needed to make the sculpture a better bicycle rack, infringement analysis would inquire if the altered structure were substantially similar to the first designer's PGS work. If the

116. This approach is consistent with the standard adopted in the Copyright Office Compendium, *supra* note 55 at § 924.2(B).

117. This analysis is consistent with the Ninth Circuit's decision in *D.C. Comics v. Towle*, 802 F.3d 1012 (9th Cir. 2015) in which the court, having ruled the "Batmobile" a protectable character, held its copyright infringed by defendant's full-size replicas.

original form remained recognizable notwithstanding the changes introduced (which might not be the case depending on the extent of the modifications), the substantial similarity test should be met, and the underlying sculpture would be infringed.

This observation leads to a paradox: it suggests that producers of artistically-designed useful articles should first create non-useful sculptures, register them as such, and then convert them to useful articles. That the conversion may introduce changes needed to adapt the sculpture into a useful article does not matter because the protected work remains the sculpture, not its utilitarian adaptation. By contrast, as we have seen, if the claimed work were the design of the useful article, the design's responsiveness to functional objectives would disqualify it from copyright protection. Consider the amoeba-shaped tabletop posited earlier. If a designer first sculpts an amoeba-shaped slab, then, under § 113(a) of the Copyright Act, she would have exclusive rights to license its reproduction, *inter alia*, as a tabletop. By contrast, our earlier analysis indicated that if the amoeba shape had been a tabletop *ab initio* it would be both a useful article and inseparable because any differently-shaped table top would function differently (even if perhaps more efficiently).<sup>118</sup>

The divergent outcomes seem a product of pure formalism. Consider the application of the two-step “first-a-sculpture, then-a-useful-article” approach<sup>119</sup> to the following item:<sup>120</sup>



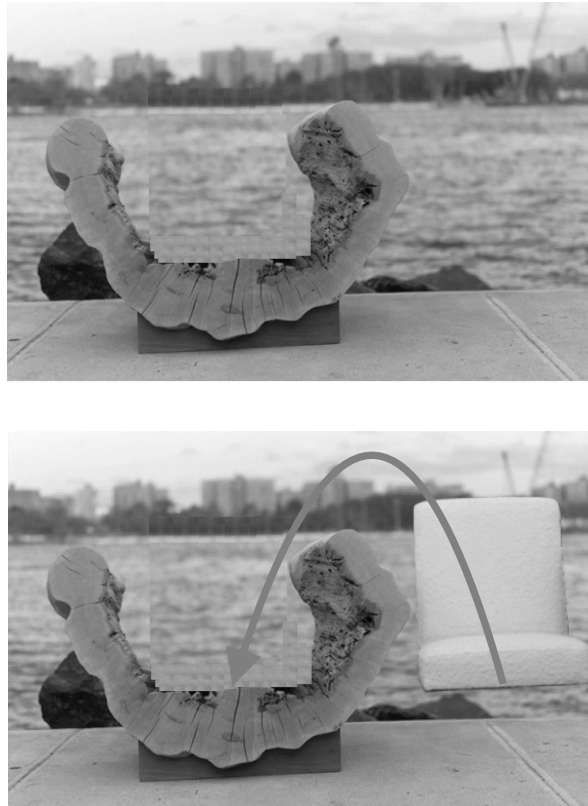
118. Arguably, the tabletop might be considered separable under the “superimposition” test, which imagines a basic tabletop lurking under the amoeba shape, like the functional belt-buckle frame under the decorative covering in *Kieselstein-Cord v. Accessories by Pearl, Inc.* 632 F.2d 989 (2d Cir. 1980), but unlike the belt-buckle covers, the amoeba shape affects the functioning of the table. Moreover, it is less clear in this instance whether the useful article could exist independently of the aesthetic features. The amoeba table-top may be a sculpture in its own right, but a table without its top is not a table. Of course, the table could have some other, differently-shaped, top, but that is not the test for separability. The Copyright Office standard for separability requires that both the aesthetic and the utilitarian features co-exist, separately intact. On the other hand, the statute literally requires only that the pictorial, graphic or sculptural features be capable of existing independently of the article's utilitarian aspects; while independent existence of the useful article's functional features may be implicit (and the Copyright Office has so inferred), the text does not explicitly require it.

119. Cf. *Universal Furniture, supra* note 62 at 434 (reflecting judicial approval of this process in reverse: the designer first designed the useful parts of the furniture, and then in a separate step designed the artistic flourishes).

120. Complaint, *Heptagon Creations, Ltd. v. Core Grp. Mktg. LLC*, 2011 WL 6600267, at \*47 (S.D.N.Y. Dec. 22, 2011) (image located in complaint, but no additional source information available).

In the actual litigation,<sup>121</sup> the court ruled that the plaintiff had failed to plead with particularity which elements of the item were conceptually separable and why. According to the prevailing case law, if the designer had created the outer shell of the item in order to serve as the base and arms of a chair, the overall shape would not be separable, even though the seat could be lifted off and exchanged with some other seat, because the remaining elements still serve functional purposes. The same result would apply under the test that inquires whether the design of the article affects its utilitarian aspects: the seating function of the chair would change were the height of the arms or their distance from the seat altered, therefore the design elements or the outer shell are not “capable of existing independently of” the utilitarian aspects of the chair.

But if the designer had first created the hollowed tree trunk-like external shell as a sculptural form in its own right, then the subsequent addition of the seating element would not deprive the underlying sculpture of copyright protection.



121. *Heptagon Creations, Ltd. v. Core Grp. Mktg. LLC*, 2011 WL 6600267 (S.D.N.Y. Dec. 22, 2011).

As a result, the sculptor would have had a copyright infringement claim against an unlicensed furniture designer who adopted the shell for seating. Moreover, the sculptor's protection would extend to the reproduction of the sculpture with any kind of seating, or, for that matter, as any other kind of useful article, such as the table that might result from turning the shell upside down.

By way of further illustration, consider Constantin Brancusi's iconic sculpture, *Bird in Space* (pictured below, left).<sup>122</sup> The image on the right is the same famous sculpture rotated 90 degrees, reimagined as a bench. Application of the two-step creation process—first, design *Bird in Space* as a sculpture, second, license the form for use as a bench—results in indirect protection of the overall design of the bench. Had the same bench not been based on a pre-existing sculpture, however, it would not enjoy a copyright: the bench is undoubtedly a useful article, and any variation in the overall shape necessarily affects its function for seating.



Now suppose a furniture designer took additional steps to change the bench into a comfortable couch by affixing three cushions.<sup>123</sup>



122. David Heald, Photograph of *Bird in Space* by Constantin Brancusi, GUGGENHEIM, <https://perma.cc/7BPM-E4PP> (last visited Sept. 20, 2016).

123. *Malinda Chair Cushion*, IKEA, <https://perma.cc/5S6G-YBZC> (last visited Sept. 20, 2016).

Whether a bench or a cushioned couch, both useful articles come within the scope of Brancusi's copyright in the sculptural work, as § 113(a) affirms. By contrast, if the form had initially been created to serve as a bench, and even had the original shape of the bench been deemed "separable" under the design process analysis because (hypothetically) no utilitarian considerations informed the original bench design, once the designer modified the shape to adapt it to the utilitarian task of seating, that alteration would, according to prevailing case law, have excluded the overall form from characterization as a PGS work.

One might distinguish these outcomes by pointing out that the two-step approach does not yield copyright protection for the useful article, only for the underlying sculpture on which the useful article is based. In practice, however, this distinction may be without a meaningful difference, because the designer of the useful article could obtain an exclusive license from the sculptor, thus giving her enforceable rights against competing designers of useful articles.

The paradox prompts two responses. First, throw up one's hands: these results do not make sense, but they are the best we can do given the intractable statutory separability standard.<sup>124</sup> Attempts to construct a coherent conceptual separability (or separate identifiability + independent existence) standard regarding the overall shape of a useful article may be doomed to failure. Even the rigorous approach that excludes the form of articles that would function differently were they shaped differently will in some instances buckle under the two-step design process approach.

Second, and alternatively, one might reason backwards from the two-step paradox: embracing the paradox might provide a means to introduce some greater flexibility into the conceptual separability (or separate identifiability + independent existence) test to accommodate not only superfluous flourishes, but also all or most of the shape of some useful articles, without slipping into sliding-scale evaluations of the proportionate influence of aesthetic versus utilitarian considerations in the design process. Recall that some of the separability cases could have been recharacterized as instances of preexisting PGS works (not themselves useful articles) reproduced "in or on" or adapted to useful articles, such as floorboards and cheerleading uniforms.<sup>125</sup> An alternative separability test would ascertain separability by inquiring whether the form could be conceptualized as a preexisting PGS work reproduced "in or on" a useful article.<sup>126</sup> If so, then the design would be

124. For an approach that would eschew the "separability" criterion, see, e.g., GOLDSTEIN, *supra* note 66, at § 2.5.3.1(c), 2:28.1 (suggesting that doctrines of originality and functionality would sufficiently limit universe of protectable applied art).

125. See *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404 (11th Cir. 2015), *cert. denied*, 136 S. Ct. 232 (2015) (floorboards); *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468 (6th Cir. 2015), *cert. granted in part*, 136 S. Ct. 1823 (2016) (cheerleading uniforms).

126. This approach differs somewhat from that proposed in Judge Newman's *Carol Barnhart* dissent: "[T]he article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function. . . . the requisite 'separateness' exists whenever the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously." *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting). Unlike Judge Newman's test, it would not be necessary for the aesthetic character of the form to "displace" the identification of the form as utilitarian. The approach this article considers more closely resembles that advocated by Perlmutter, *supra* note 15 at 376: "If a copyrightable work of art

a protectable PGS work regardless of birth order.

This reverse § 113(a) approach works well for discrete decorative items that one might imagine being applied to a pre-existing useful article such as the sheep stool pictured below.<sup>127</sup>



But it might also cover more. Abstract forms such as the Heptagon outer shells, the amoeba-shaped tabletop, or the hypothetical Brancusi bench, can also be conceived as pre-existing sculptures adapted into a useful article (even if in fact those shapes had been created to serve as a useful article). Reversing the “birth order” to imagine that the pictorial, graphic or sculptural design is a freestanding work whose existence precedes the creation of the useful article thus could bring not only individual design elements within the sphere of separability, but also the overall form of at least some useful articles. We can nonetheless posit that not every shape of a useful article lends itself to this kind of reimagining; most forms will be seen as the useful articles they are; the conceptual reverse-engineering approach applies only to forms that can be seen as depicting an item (non utilitarian or otherwise) that is not the same utilitarian article.<sup>128</sup>

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remains copyrightable when it is later incorporated into a useful article, reversing the sequence of events and starting with its appearance in the useful article should not make the same work uncopyrightable.” See also, Perlmutter, *supra* note 15, at 377-78 (advocating a “duality” over a “displacement” approach to conceptual separability).

127. County Engraving, *Children’s Wooden Step or Stool Sheep Design Personalized*, County Engravings Online (2015), <http://www.countyengraving.co.uk/childrens-wooden-step-or-stool-sheep-design-personalised-109-p.asp>.

128. For example, modernist form-follows-function designs would remain uncopyrightable, notwithstanding their aesthetic appeal, because the perfect integration of form and function defies conceptual reverse engineering into anything other than a pictorial or sculptural representation of a chair, etc. The marriage of form and function would probably also disqualify the furniture design on grounds of functionality under § 102(a). Moreover, the sculpture that emerges from the conceptual reverse engineering may lack the requisite originality. For example, the *Brandir* sine curve shape or the rudimentary form of the *Carol Barnhart* torsos might be considered too banal even under a generous standard of originality.

For reimagined “sculptures” that depict the same kind of useful article, § 113(b) warns that “[t]his title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law . . .”<sup>129</sup> Thus, Claes Oldenburg’s monumental sculptures of everyday items such as clothespins, baseball bats, and trowels,<sup>130</sup> do not give Oldenburg a monopoly in the everyday item. By the same token, the depiction of a useful article such as a chair does not confer on the creator of the two-dimensional drawing or three-dimensional model of the chair the exclusive right to reproduce the chair.<sup>131</sup> In other words, there is no two-step path to chair copyrightability by first drawing a picture of the chair. René Magritte’s painting *The Treachery of Images*, captioned “Ceci n’est pas une pipe” (“This is not a pipe”)<sup>132</sup> helpfully instructs: Magritte has made a picture of a pipe. It is a pictorial work. Magritte’s heirs enjoy the exclusive right in the U.S. to reproduce that image on t-shirts, umbrellas, etc.



129. 17 U.S.C. § 113(b).

130. See e.g., Claes Oldenburg, *Chronology of Large-Scale Projects*, <https://perma.cc/A3E4-ZNB5> (last visited Sept. 20, 2016) (includes photographs of clothespin, baseball bat, trowel, and other large-scale depictions of ordinary objects).

131. See, e.g., *Niemi v. American Axle Mfg.*, 2006 WL 2077590 (E.D.Mich. July 24, 2006) (unauthorized manufacturing of a machine based on copyrighted technical drawing is not infringement).

132. René Magritte, *The Treachery of Images (This is Not a Pipe)*, LACMA, <https://perma.cc/XXW9-QSDD> (last visited Sep. 20, 2016). © 2016 C. Herscovici / Artists Rights Society (ARS), New York.

But Magritte's work is not an actual, functioning pipe (indeed, that is the point of the painting). Under § 113(b), producing smoking paraphernalia that looks like Magritte's representation of a pipe will not infringe Magritte's copyright unless the pipe represented by Magritte included decorative elements distinct from the smoking article function. For example, had he adorned the bowl with some fanciful details, such as shaping its surface to resemble a Belgian waffle,<sup>133</sup> those details might be deemed separable, and protectable, but the potential copyright coverage of the waffle-shaped bowl will not extend to the rest of the pipe; others remain free to base their pipes on Magritte's image, *sans* waffle.



The pipe Magritte in fact drew in *The Treachery of Images* lacks such flourishes; the bowl is unadorned and the curve of the shaft either lacks originality or in an actual shaft would affect the function of delivering tobacco smoke. In the absence of fanciful, separately identifiable non-functional details, § 113(b) reifies Magritte's jest: a picture of a pipe is not an actual pipe; the copyright in a picture of a pipe is not a copyright in an actual pipe.<sup>134</sup>

By contrast, suppose an artist licenses a depiction of a useful article for

133. "This is not a waffle-shaped pipe" by Robert E. Bishop, d'après Magritte. *Presto Waffle Bowl Maker*, KOHL'S, <https://perma.cc/293L-U7B4> (last visited Sept. 20, 2016) (waffle photo).

134. Cf. *Eliya, Inc. v. Kohl's Dep't Stores*, 82 U.S.P.Q.2d 1088 (S.D.N.Y. 2006) (holding without reference to § 113(b), that copyright in a two-dimensional work portraying a three-dimensional useful article—a shoe—does not confer an exclusive right to produce the article portrayed; the court observed that the distinction "brings to mind Magritte's famous painting of a pipe: [Eliya's two-dimensional rendition of the shoe] n'est pas une chaussure, but is merely a depiction of one").

reproduction in or on a different kind of useful article. Suppose, for example, that Magritte had licensed the production of a coatrack with hooks in the shape of his depiction of a pipe.<sup>135</sup>



This kind of licensing is common for wallpaper or fabric designs for apparel or upholstery (think, for example, of aviation-themed children's pajamas or curtains), and falls squarely within § 113(a), and not § 113(b). Section 113(b) ensures that the author of "a work that portrays a useful article as such" has no greater rights in "the useful article so portrayed" than would the producer of that actual useful article. But the useful articles "so portrayed" in the hypothetical fabric design are airplanes, not apparel; therefore, § 113(b) does not deprive the artist who drew the airplane of the exclusive right to license the reproduction of her drawing as any non-aviation kind of useful article, including one in three dimensions, such as a throw pillow or a go-cart. By the same token, since the useful article "so portrayed" in *The Treachery of Images* is a pipe, § 113(b) therefore does not deprive Magritte's heirs of the exclusive right to license Magritte's depiction of a pipe for reproduction in or on a different kind of useful article, such as hooks for a coatrack.

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135. Coat rack design by Nathalie Russell.

Consider the 1970 “Joe chair,”<sup>136</sup> now an iconic piece of children’s furniture:



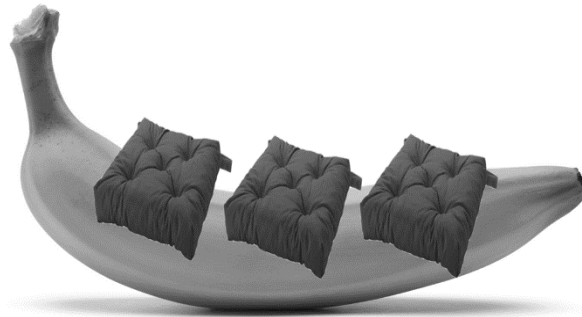
The chair looks like a baseball mitt; the depiction of a baseball mitt is not a depiction of a chair. If the artist drew a baseball mitt, and someone else designed a chair to look like her depiction of a baseball mitt, then § 113(a), rather than 113(b), should apply. In this situation, the sporting equipment function of the mitt has been “deactivated,”<sup>137</sup> and there should be no difference between licensing a non-representational form, such as the *Heptagon* shells, for reproduction “in or on a useful article,” and licensing a form that depicts an object found in the natural world, such as a banana (below, coincidentally similar to the hypothetical Brancusi couch),<sup>138</sup> or a form that depicts any other article, useful or otherwise, for reproduction in or on a different kind of useful article.

137. Joe Chair design by Gionatan De Pas, Donato D’Urbino, Paolo Lomazzi, PINTEREST, <https://www.pinterest.com/pin/569212840375101171/> (last visited Oct. 11, 2016).

137. Thanks to Paolo Marzano for the term and for the concept. See also *Cheffins v. Stewart*, 825 F.3d 588, 601 (9th Cir. 2016) (McKeown, J., concurring) (discussing the difference between applied art and “visual art” (for VARA coverage)):

Tracy Emin’s *My Bed*, displayed at the Tate Britain, incorporates Emin’s real bed as a “monument to the heartache of a relationship breakdown.” The bed arguably retains its original utilitarian function—it remains a bed, and could still be slept in—but it is no longer meant or used for this utilitarian purpose. Rather, *My Bed* is now appreciated and viewed as a work of creative expression and, when viewed as a whole, the utilitarian object has become part of a visual art piece.

138. Banana couch design by Robert E. Bishop. *Malinda Chair Cushion*, IKEA, <https://perma.cc/5S6G-YBZC> (last visited Sept. 20, 2016) (cushion); *How do bananas grow?*, <https://perma.cc/8Y3F-UHGG> (last visited Sept. 20, 2016) (banana).



But § 113(a) will not make the licensed item of furniture copyrightable. It gives the artist rights against furniture designers; it does not give furniture designers rights of their own (unless they acquire them from the artist). For designers to enjoy their own copyrights in the overall form of a useful article, it is necessary to interpret the statutory criteria to apply to a design created for, rather than subsequently applied to, a useful article. Reversing the design's "birth order," the question becomes whether the same design, if created to be a useful article, would lose the protection it would have enjoyed had it begun life as a non utilitarian PGS work.<sup>139</sup> As we have seen, the case law by and large disqualifies designs created *ab initio* to serve as useful articles when the design encompasses the entire form of the article, rather than a detachable flourish. But perhaps thinking of separability as the flip side of § 113(a) can work for the useful article's entire form, at least when the arbitrary quality of the depiction of a completely different article (useful or otherwise) relative to the resulting useful article might meet the statutory criteria of separate identification (banana; baseball mitt) and independent existence, at least if the superfluity of the design to the function<sup>140</sup> betokened its independence.

139. Arguably, any work of art can be converted to non-intellectual kinds of utility; Paul Goldstein posits using the Venus de Milo "as a mannequin for sleeveless blouses," GOLDSTEIN *supra* note 66, at § 2.5.3.1(a), at 2:71. But the statutory definition of a "useful article" as "having an *intrinsic* utilitarian function," 17 U.S.C. § 101 (emphasis added), should preclude the retroactive characterization of the article as "useful" if a third party later puts the article to non artistic use: the third party is conferring an *extrinsic* utilitarian function on the article.

140. See *Progressive Lighting, Inc. v. Lowe's Home Ctrs., Inc.*, 549 F. App'x. 913, 920-21 (11th Cir. 2013); *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 433-34 (4th Cir. 2010).

Or consider a notorious example of artistic employment of a useful article: Marcel Duchamp's 1917 *Fountain* (signed R. Mutt), which is not in fact a depiction of a urinal, but (unlike Magritte's pipe) an actual urinal, removed from its plumbing context and exhibited in a museum.<sup>141</sup>



Duchamp would lack copyright not only in any actual urinals copied from *Fountain*, but it is questionable whether *Fountain* itself would have been copyrightable, since Duchamp simply signed an actual, preexisting urinal. Giving the “found object” a new context<sup>142</sup> through the pseudonymous signature and the museum setting may be original in the artistic sense, but is a non protectable “idea” as a matter of copyright.<sup>143</sup>

Now suppose a furniture designer, appreciating *Fountain*'s curved forms, copies the signed urinal but converts it into a chair.<sup>144</sup>

141. Photo Credit: Alfred Stieglitz, 1917; Image located at [http://www.toutfait.com/unmaking\\_the\\_museum/fountain.html](http://www.toutfait.com/unmaking_the_museum/fountain.html).

142. An unsigned editorial in the second issue of *The Blind Man* published on May 17, 1917, explains in support of *Fountain*: “He took an ordinary article of life, placed it so that its useful significance disappeared under the new title and point of view—created a new thought for that object.” Editorial, *The Richard Mutt Case*, THE BLIND MAN, May, 1917, at 5, <https://perma.cc/EEJ4-JC94>. Duchamp may have written this editorial, and indeed later expressed his agreement with the editorial's views. See DAWN ADES, NEIL COX & DAVID HOPKINS, MARCEL DUCHAMP 127 (1999); see also WILLIAM A. CAMFIELD, MARCEL DUCHAMP FOUNTAIN 37 (1989).

143. See JENNIFER DAVIS, INTELLECTUAL PROPERTY LAW 36 (Nicola Padfield ed., 4th ed. 2012).

144. Urinal chair design by Robert E. Bishop. Marcel Duchamp, *Fountain*, TATE, <https://perma.cc/F56F-5PDY> (last visited Sept. 20, 2016) (urinal); *Henriksdal Chair*, IKEA,



Here, we have no “birth order” indirect copyright protection under § 113(a), since the underlying item was an actual useful object, not a depiction of a useful object. Had *Fountain* instead been a representation of a urinal rather than an actual urinal (which would have defeated the artistic purpose), then Duchamp could under § 113(a) have enjoyed the exclusive right to license the reproduction of his representation in or on other kinds of useful articles. (Though he could not have prevented third parties from creating their own representations of urinals, nor from going back to actual plumbing fixtures in order to convert them to different useful articles such as chairs). But under the reverse § 113(a) approach suggested here, one could imagine the urinal chair as a depiction of a urinal, and therefore as a protectable sculptural work “existing independently” from its function as a chair (and having no function as a urinal).

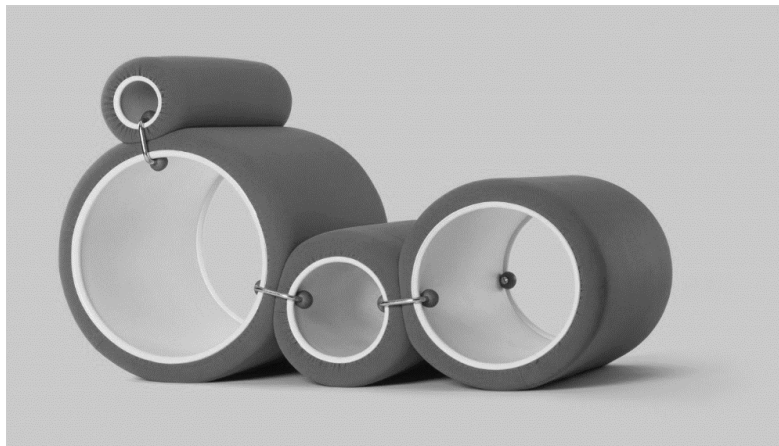
Ultimately, however, the potential copyrightability of these useful article designs may offer designers little solace because the scope of protection for such an article is likely to be extremely thin. The designer cannot monopolize the idea of converting a particular useful (or other) article into an unrelated useful article. Moreover, similarities between the products that are necessary to the expression of the common

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<https://perma.cc/387C-JB42> (last visited Sept. 20, 2016) (chair legs).

idea, including the realization of its functionality, will not be taken into account in assessing substantial similarity of copyrightable expression. Short of exact or near-exact copies, copyright will allow infinite unlicensed variations on banana couches or baseball mitt or urinal chairs. As a result, one may argue that a reverse § 113(a) approach would be unlikely to harm the balance Congress endeavored to strike between copyright and free competition in aesthetically-designed useful articles, but for that reason neither is it likely to provide meaningful remedies to designers.

The last proposition, however, is open to challenge. Protection against exact copies may be all the designer seeks because her competitors are not making their own variations on a theme first essayed by the designer, they are creating “knock offs” of the precise design.<sup>145</sup> The wider a reverse § 113(a) approach sweeps, the greater the risk that the distinction Congress sought to make between PGS works (protectable) and aesthetically-designed useful articles (generally not copyrightable as a whole, albeit potentially copyrightable as to parts) returns to the knot-twisted muddle from which we started. If the reverse § 113(a) approach works well in the context of distinct component part “features” of a useful article, it may ultimately be unconvincing as applied to the entire form of the article because it tends toward overinclusiveness. If, to paraphrase Gertrude Stein, “a chair is a chair is a chair,” so that the shapes of most useful articles should resist recharacterization as nonuseful PGS works, the universe of forms that effective advocates might conceptually convert to “sculptures,” could nonetheless prove ever-expanding. Consider the following item:<sup>146</sup> like the *Brandir* bicycle rack seen out of context, this object is not obviously a useful article, in this case a chair (hence it might pass Judge Newman’s “displacement” version of the separability test). It does not require great labor of the imagination to conceive of the “Tube Chair” as a sculpture.



145. Thanks for this observation to Lionel Bently. For one of many examples, see, e.g., *Comparison Guide: Le Corbusier LC2 Arm Chair and LC3 Chair Reproductions*, MODERN CLASSICS, <https://perma.cc/82ZE-77PU> (last visited Sept. 20, 2016) (inexpensive reproductions of Le Corbusier chairs, with chart comparing copies and originals).

146. Joe Colombo, *Tube Chair*, THE METROPOLITAN MUSEUM OF ART, <https://perma.cc/SP6H-NRN3> (last visited Sept. 20, 2016).

Or the Sori Yanagi “Butterfly Stool”<sup>147</sup> (1954), as its name suggests, could be conceptualized as an abstract representation of a butterfly:



Or, the Le Corbusier “LC2” armchair (1928),<sup>148</sup> which looks more like a chair and less like an abstract form than the earlier two examples, but could nonetheless be imagined as a sculpture of an indented cube:



Other examples likely abound, some more, some less obviously at first blush a piece of furniture or other useful article, but all of them arguably capable of being imagined as nonuseful works of art. Sadly, then, for the attempt to forge a path to

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147. Sori Yanagi, *Butterfly Stool*, VITRA, <https://perma.cc/8RLR-CC92> (last visited Sept. 20, 2016).

148. Le Corbusier, *LC2 Maison La Roche*, CASSINA, <https://perma.cc/8TZH-N6Z2> (last visited Sept. 20, 2016).

copyright coverage of innovative and attractive furniture and other useful article designs, the reverse § 113(a) interpretation of the statutory definition of a PGS work this article has ventured for overall designs of useful articles presents two daunting risks: either a run down the slippery slope, or, to halt that slide, judicial resort to a gut sense of whether or not the disputed object is “art.”

To sum up, what I have called the reverse § 113(a) approach, which inquires whether the claimed “feature” could be imagined as an independent PGS work reproduced in or on a useful article, can help us determine whether a part of the design of a useful article “can be identified separately from and is capable of existing independently of the utilitarian aspects of the article.” The approach might also successfully apply to designs that make up the whole or most of the shape of the useful article, particularly the more the shape, whether figurative or abstract, can be perceived as a form unrelated to the useful article. The unexpected character of the form could make it separately identifiable and its arbitrariness relative to the function<sup>149</sup> could render it capable of existing independently. But the independent existence criterion means that aesthetically pleasing designs in which the form affects the function will remain outside the scope of protection, thus excluding a great deal of modernist and similarly stripped-down design. As a result, this approach to separability will not fully correct the law’s current bias toward protecting the ornate over the austere. Moreover, as we have seen, the approach in practice is likely often to present intractable problems of line-drawing, and for that reason may well prove unworkable.

### CONGRESS SHOULD UNTIE THE KNOT

Attempts to apply the statutory tests of separate identification and capacity for independent existence to the overall designs of useful articles have yielded a plethora of interpretations, but predictable and even-handed treatment of applied art continues to elude courts and creators. It may well be time for Congress to revisit the question. Happily, the solution need not demand extensive Congressional intervention, because a statutory framework already exists in Chapter 13 of the Copyright Act, added in 1998, establishing “Protection of original designs.”<sup>150</sup> Chapter 13 largely tracks the abandoned Title II of the 1976 Copyright Act,<sup>151</sup> covering original designs of useful articles for a ten-year term following registration, if registration occurs within two years of the date on which the design is first made public.<sup>152</sup> The statute excludes coverage for unoriginal or commonplace designs, as well as for those “dictated solely by a utilitarian function of the article that embodies it,”<sup>153</sup> thus

149. An apparently arbitrary design might nonetheless present functional characteristics, for example, if its shape responded to objectives of stress-tolerance or load-bearing. The intertwining of form and function would preclude separate existence for the form.

150. Vessel Hull Design Protection Act, Title V of the Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860, 2905 (1998) (codified as amended at 17 U.S.C. §§ 1301-32).

151. See *supra* note 33.

152. 17 U.S.C. §§ 1301, 1305, 1310. There is also a notice requirement, see *id.* at §§ 1306, 1307.

153. *Id.* at § 1302. Designs not subject to protection

welcoming designs that accommodate the article's function, so long as utilitarian considerations do not exclusively influence design choices. This "not dictated by" standard encompasses a broader range of full article designs than would most interpretations of the statutory separability test for PGS works. The scope of protection prohibits the making or distribution of copies that are "substantially similar in appearance," but, unlike copyright in a PGS work, does not confer a derivative works right.<sup>154</sup>

Chapter 13 thus would offer a ready-made design protection regime, were it not for its definition of a useful article, which currently is limited to vessel hulls.<sup>155</sup> But the origins of this legislation in special pleading from the Florida and California boat-building industries<sup>156</sup> need not preclude its revision into a genuine design protection statute. Indeed, bills (so far unenacted) to extend intellectual property protection to

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Protection under this chapter shall not be available for a design that is —

- (1) not original;
- (2) staple or commonplace, such as a standard geometric figure, a familiar symbol, an emblem, or a motif, or another shape, pattern, or configuration which has become standard, common, prevalent, or ordinary;
- (3) different from a design excluded by paragraph (2) only in insignificant details or in elements which are variants commonly used in the relevant trades;
- (4) dictated solely by a utilitarian function of the article that embodies it; or
- (5) embodied in a useful article that was made public by the designer or owner in the United States or a foreign country more than 2 years before the date of the application for registration under this chapter.

154. *Id.* at § 1308. Exclusive rights

The owner of a design protected under this chapter has the exclusive right to —

- (1) make, have made, or import, for sale or for use in trade, any useful article embodying that design; and
- (2) sell or distribute for sale or for use in trade any useful article embodying that design.

*Id.* at § 1309(e):

(e) *Infringing Article Defined.* — As used in this section, an "infringing article" is any article the design of which has been copied from a design protected under this chapter, without the consent of the owner of the protected design. An infringing article is not an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium. A design shall not be deemed to have been copied from a protected design if it is original and not substantially similar in appearance to a protected design.

155. *Id.* at § 1301(b)(2).

156. *See, e.g.,* U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 1302 (3d ed. 2014) ("Vessel design protection is not a form of copyright protection. Congress enacted the VHDP to provide a new, separate form of special protection for vessel designs in response to the needs of the boat industry, not as an amendment to the copyright law."). *See also* Susanna Monseu, *The Challenge of Protecting Industrial Design in a Global Economy*, 20 TEX. INTELL. PROP. L.J. 495, 535 (2012) ("[The VHDP] came about because the Supreme Court struck down a Florida statute protecting boat hulls on the basis of federal preemption, and once boat designers were prevented from using state unfair competition laws to protect their designs they lobbied Congress for federal protection of boat hull designs.").

fashion design have taken Chapter 13 as their starting points.<sup>157</sup> To bring the design of a broader range of useful articles within statutory coverage, a few modest amendments to Chapter 13 would suffice.

First, the initial declaration that “the designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter upon complying with and subject to this chapter”<sup>158</sup> could remain, albeit preferably without the requirement that the design be “attractive to the purchasing or using public.” The introduction of a merit standard is troublesome, given copyright law’s traditional rejection of inquiries into artistic worthiness.<sup>159</sup> Admittedly, Chapter 13 establishes a *sui generis* design protection regime that borrows from other intellectual property regimes as well as from copyright. For example, distinctiveness is a characteristic of trademarks,<sup>160</sup> and a requirement that the design stand out from its predecessors is not an unreasonable means of limiting the universe of protectable designs. On the other hand, Chapter 13 already captures that restriction in its list of excluded designs, which denies coverage not only to unoriginal or banal designs, but also to a design “different from a design excluded [as banal or commonplace] . . . only in insignificant details or in elements which are variants commonly used in the relevant trades.” In any event, the Copyright Office does not appear to view attractiveness or distinctiveness as conditions of protection; neither registration Form D-VH,<sup>161</sup> nor the Compendium of Copyright Office Practices<sup>162</sup> allude to, much less implement, any requirement that the applicant demonstrate that the design is attractive or distinctive to the purchasing public.

Second, and similarly, the amendment would largely retain the first part of the current definition, which specifies that “a design is ‘original’ if it is the result of the designer’s creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.”<sup>163</sup> To make clear that originality is not limited to providing a distinguishable variation on prior designs, but can also refer to creative designs not based on prior designs, it might be desirable to revise the phrase to read “a design is ‘original’ if it is the result of the designer’s creative endeavor, *including one* that provides a distinguishable variation . . .” (emphasis added).

157. See, e.g., The Innovative Design Protection Act of 2012, 112th Congress, Pub. L. No. 112-259 (2d Sess. 2012), available at <https://www.congress.gov/congressional-report/112th-congress/senate-report/259/1?q=S.3523+>. See generally Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147 (2009). See also Susan Scafidi, *IDPPPA: Introducing the Innovative Design Protection and Piracy Prevention Act, a.k.a. Fashion Copyright*, COUNTERFEIT CHIC (Aug. 6, 2010), <http://www.counterfeitchic.com/2010/08>.

158. 17 U.S.C. § 1301(a)(1).

159. See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903); See generally Robert A. Gorman *Copyright Courts and Aesthetic Judgments: Abuse or Necessity?*, 25 COLUM.-VLA J.L. & ARTS 1 (2002).

160. The Lanham (Trademark) Act § 45 (1946) (definition of a trademark).

161. Form D-VH, THE COPYRIGHT OFFICE, available at <http://www.copyright.gov/forms/formdvhi.pdf>.

162. See *Compendium*, *supra* note 162, § 1300-05.

163. *Id.* at § 1301(b)(1).

Finally, the definition of a “useful article” could reprise the definition in § 101 of the Copyright act.<sup>164</sup> Several limiting factors, some of them already in the statute, could assuage fears that such a broad definition would result in overprotection of utilitarian design. For one, not every design of a useful article will qualify. Threshold criteria in Chapter 13 set the level of creativity and exclude designs dictated by functional objectives. Legitimate concerns may nonetheless arise regarding subject matter that would cross the statutory threshold but whose protection would entail unacceptably anticompetitive consequences. Spare parts for automobiles and other devices may well fall into this category. To confront the problem of potential overprotection, Congress would need to choose between two approaches. It could expand the universe of protectable designs piecemeal from vessel hulls to specifically identified kinds of useful articles, for example, furniture, or apparel, or handbags, leaving all other kinds of designs uncovered. Or it could adopt an encompassing definition of protectable subject matter while excluding specified categories, such as spare parts in general, or the designs of motor vehicles in particular.

Congress would also need to determine whether a claimant may cumulate forms of intellectual property protection. Currently, Chapter 13 requires a claimant to elect between vessel hull protection and design patent.<sup>165</sup> By contrast, Chapter 13 allows for the coexistence of copyright and *sui generis* design protection; the latter for the shape of the vessel hull as a whole, the former for particular design components.<sup>166</sup> Amending Chapter 13 to cover a broader range of useful articles need not alter that result, so long as it remained clear that copyright protection was limited to “features,” i.e., separable parts of the design of the useful article, rather than its entirety. Copyright should not provide a backup extension of protection for the entire design of a useful article after the ten-year design protection term expires.

164. “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. An article that is normally a part of a useful article is considered a ‘useful article.’” 17 U.S.C. § 101.

165. See 17 U.S.C. § 1329 (“Relation to design patent law: The issuance of a design patent under Title 35, United States Code, for an original design for an article of manufacture shall terminate any protection of the original design under this chapter.”).

The H.R. 2696 Vessel Hull Design Protection Act was initially proposed as a form of design patent protection. “The legislation creates a new design patent for vessel hulls. Confusion between copyright patent and trademark protection for hull models over the years has apparently produced a proliferation of unattributed and bad copies of expensive designs, and this legislation articulates clearer standards for the grant of a design patent.” *Vessel Hull Design Protection Act*, 144th Cong Rec H 1243, 1247.

166. See Compendium, *supra* note 55 at § 1302: (“Vessel designs — the overall shape and form of a water craft’s deck or hull — are useful articles and, as such, cannot be protected by copyright law. . . . Purely ornamental two- and three-dimensional decorations on or in the surfaces of the deck or hull might be copyrightable, but the deck and hull themselves are not.”). See also *Hearings Before the Subcommittee on Courts and Intellectual Property on H.R. 2652, H.R. 2696 and H.R. 3163*, 144th Cong Rec H 521-57 (statement of Marybeth Peters) (“We do not believe that the existence or enforcement of protection under the Copyright Act should bear upon the existence or enforcement of protection under design legislation. The standards for obtaining the two forms of protection differ, as do the scope and duration of the protection.”).

### CONCLUSION

The 1976 Copyright Act and its legislative history adopt a restrictive standard that embraces individual design features while largely excluding the overall form of useful articles. Yet, under § 113(a), if the design previously existed as a freestanding original work of art, its application to or incorporation in the overall form of a useful article would not deprive the preexisting PGS work of copyright protection. The resulting useful article will enjoy indirect copyright protection in whole or in part by virtue of the copyright in the underlying PGS work. Interpreting the statutory separability test to mirror the § 113(a) exclusive right of the author of a PGS work to reproduce that work in or on a useful article offers an effective way to discern separability of particular design elements, but proves more problematic in the case of the form of the article as a whole. While limiting the reverse § 113(a) analysis to discrete design “features” better hews to the statute, it nonetheless leaves us with the paradox of the disparate treatment of preexisting artworks applied to useful articles relative to artistic designs created as useful articles.

Because the statutory separate identifiability + independent existence standard best accommodates individual design features that are superfluous to the article’s function, it arguably privileges design frivolity over sobriety, excrescence over simplicity, often disfavoring the cleaner elegance that may appeal to exponents of the modernist, “form follows function” aesthetic (and to at least some judges and law professors). Accordingly, one may be sympathetic to endeavors to interpret the statute to encompass a wider range of overall forms of useful articles.<sup>167</sup> From the designer’s perspective, more capacious standards would be desirable, especially in the absence of a design protection regime such as exists in the European Union.<sup>168</sup> But that is the point: in the absence of the kind of specially-tailored coverage this Article has proposed, Congress has determined that copyright, by and large, is not the appropriate vehicle. Thus, the “separability” line Congress has drawn, albeit often difficult to discern coherently, places most overall designs of useful articles in the public domain.

167. In addition to the reverse § 113(a) approach, several such endeavors are detailed in *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484-85 (6th Cir. 2015), cert. granted *in part*, 136 S. Ct. 1823 (2016). See also GOLDSTEIN, *supra* note 66, § 2.5.3.1(c) (“[I]t seems appropriate to place designs of useful articles that are not essential to the utility of the useful article on the copyrightable side of the line.”). The “not essential to” standard resembles the rejected “not dictated by” standard; both are variants on the idea/expression merger test.

168. Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the Legal Protection of Designs, 1998 O.J. (L 289) 28; see also Graeme Dinwoodie, *Federalized Functionalism: The Future of Design Protection in the European Union*, 24 AIPLA Q.J. 611 (1996) (discussing the considerations underlying the design protection directive in the European Union).

**APPENDIX**



**Figure 1.** Ornamented Cabinet (Guinevere 8' Breakfront Cabinet).