‘Courts Have Twisted Themselves into Knots’ (and the Twisted Knots Remain to Untangle): US Copyright Protection for Applied Art after Star Athletica

Jane C. Ginsburg
Columbia Law School, jane.ginsburg@law.columbia.edu

Follow this and additional works at: https://scholarship.law.columbia.edu/faculty_scholarship

Part of the Intellectual Property Law Commons

Recommended Citation

This Book Chapter is brought to you for free and open access by the Faculty Publications at Scholarship Archive. It has been accepted for inclusion in Faculty Scholarship by an authorized administrator of Scholarship Archive. For more information, please contact scholarshiparchive@law.columbia.edu.
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.


9.1 Introduction

United States copyright law explicitly enumerates ‘pictorial, graphic or sculptural works’ (henceforth ‘PGS works’) among the subject-matter of copyright.¹ 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’.² 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

---

¹ 17 USC s. 102(a)(5).
² 17 USC s. 101.

* Many thanks to Robert E. Bishop, Columbia Law School class of 2017, and to Nathalie Russell, Columbia Law School class of 2018, for most helpful research assistance, and to Lionel Bently, June Besek, Paul Goldstein, Michael Heller, Rob Kasunic, Philippa Loengard, Paolo Marzano, Bill Patry and Antoon Quaedvlieg for trenchant critiques and valuable suggestions, and to participants in staff seminars at Columbia Law School and at the University of Johannesburg law faculty for probing questions. Portions of this chapter are drawn from an affidavit on US law (‘Certificat de coutume’) filed (in French) in Knoll Int’l v. M Top Mobilier, File No. 20150086, Court of Appeals of Paris, GR No. 15/05833 and from an earlier and more extensive (but pre-Star Athletica) version published at 40 Columbia Journal of Law & the Arts 1 (2016).
patent law.\footnote{For a cross-IP discipline view that encompasses design protection, see Peter Lee and Madhavi Sunder, ‘The Law of Look and Feel’ (2017) 90 S. Cal. L. Rev. 529. For designs that acquire secondary meaning, trade mark 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’ (2016) 37 Adelaide Law Review 403.} 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 seventy years \textit{post mortem auctoris} (or for works made for hire, or anonymous or pseudonymous works, ninety-five years following first publication),\footnote{At the time of passage of the 1976 Act, the terms were fifty years p.m.a., or seventy-five years after first publication.} 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’ doctrine. The latter inquires whether the ‘idea’ is susceptible to multiple forms of expression, or whether instead the 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.\footnote{See Jane C. Ginsburg and Robert A. Gorman, \textit{Copyright: Concepts and Insights} (New York: Foundation Press, 2012), p. 50.}

This chapter will first review the statutory definitions of a PGS work, and then will address the genesis of the troublesome ‘separability’ requirement. Next, the chapter will analyse 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, culminating in the US Supreme Court’s 2017 decision in \textit{Star Athletica v. Varsity Brands}.\footnote{197 L. Ed. 2d 354 (2017).} Finally, this chapter will offer a conclusion and a legislative proposal. I conclude that 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 to extend separability analysis to the useful article’s abstract form as a whole prove unworkable. Accordingly, rather than continuing to struggle with an intractable statutory copyrightability standard, this chapter proposes the enlargement of Title 17’s \textit{sui generis} design protection regime to cover original designs of most useful articles.
9.2 Statutory Standards

The US Copyright Act protects PGS works, including applied art, but distinguishes the designs of ‘useful articles’ from non-utilitarian works; the latter include those whose function is ‘merely to portray the appearance of the article or to convey information’.\(^7\) While the statute denominates the design of a useful article as PGS 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’, non-utilitarian works are PGS works in themselves, and there is no need to undertake an inquiry into the ‘separability’ of aesthetic and useful elements. Such works need not be devoid of purpose, but their potential informational or expressive or even affective utility, such as a religious painting’s stimulation of spiritual contemplation,\(^8\) is not the kind of usefulness that the statute reserves to the patent system (or to the public domain).\(^9\) Similarly, a two- or three-dimensional depiction of a useful article, such as a model aeroplane or a drawing of a bottle, is not itself a useful article. The statute, however, makes clear that a protected representation of a useful article gives the author no rights in the article depicted.\(^10\) 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.

Section 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’.\(^11\)

\(^7\) 17 USC s. 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.

\(^9\) For detailed discussion of that policy choice, see Viva Moffat, ‘The Copyright/Patent Boundary’ (2014) 48 University of Richmond Law Review 611, 638–9 (the intention to confine functional features of useful articles to the patent realm is implicit in the statute and the legislative history); but see Star Athletica, 197 L. Ed. 2d at 371 (rejecting ‘argument that the only protectable features are those that play absolutely no role in an article’s function’).

\(^10\) 17 USC s. 113(b).

\(^11\) Ibid.
Oldenburg’s monumental sculptures of everyday items such as clothespins, baseball bats and trowels 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. 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”), helpfully instructs: Magritte has made a picture of a pipe. It is a pictorial work; it is not an actual, functioning pipe (indeed, that is the point of the painting). Under section 113(b), Magritte’s copyright does not extend to smoking paraphernalia that looks like his representation of a pipe. Section 113(b) thus 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.

The statute also specifies, in section 113(a), 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”. For example, an artist holds the exclusive right to reproduce her drawing onto a t-shirt, a tablecloth, a shower curtain, etc. (thus, Magritte’s heirs enjoy the exclusive right in the USA to reproduce the pipe image on a variety of merchandising properties); a sculptor can authorise or prohibit the incorporation of her work into a paperweight or to ornament andirons.

In the case of three-dimensional works, however, a complication arises, that I have called the ‘birth order problem’. The statute’s definition of a

\[12\] See, e.g., http://oldenburgvanbruggen.com/largescaleprojects/lsp.htm (includes photographs of clothespin, baseball bat, trowel and other large-scale depictions of ordinary objects).


\[14\] Cf. Eliya, Inc. v. Kohl’s Dept Stores, 82 USPQ 2d 1088 (SDNY 2006) (holding without reference to s. 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”).

\[15\] 17 USC s. 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, 94th Cong. 2d Sess. at 105 (1976) (emphasis supplied), which suggests that the rights in the pre-existing PGS work extend to authorising 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, below, the copyright inheres in the PGS work, not in the useful article ‘in or on’ which it is reproduced.
PGS work leads to a distinction between incorporating a pre-existing sculptural work ‘in or on’ a useful article, on the one hand, and altering the form of the work in order to adapt it into a useful article, or designing the work as a useful article from the start, on the other. The copyright in the original standalone sculpture subsists as a PGS work regardless of its reproduction ‘in or on’ a useful article. But the adapted version becomes a useful article, and, as with the work initially designed to be a useful article, these versions’ characterisation as a PGS work in their own right will depend on whether their form, or parts of their 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 pre-exists 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 sub-optimally functional (the first set of crocodile salad tongs may not seize salad as well as the second). The Supreme Court has now ruled that ‘copyright protection extends to pictorial, graphic and sculptural works regardless of whether they were created as free-standing art or as features of useful articles’ – so long as the features can be seen as existing independently of the article’s utility. As we shall see, however, as that proviso portends, the Court has not in fact fully eradicated the birth order distinction.

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:

‘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.

16 197 L. Ed. 2d at 367.
17 17 USC s. 101 (defining pictorial, graphic and sculptural works).
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 features 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 chapter reveals, courts have failed to interpret the meaning of the statutory separability standard in any consistent or coherent manner. Nor, as we shall see, has the Supreme Court succeeded in untangling the ‘knots’ into which the lower ‘courts have twisted themselves’. Before turning to the divergent and often contradictory judicial attempts, we should first detail the genesis of the statutory rule.

9.3 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’.

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.

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”.

By the late 1940s, the Copyright Office recognised the need to update its regulations more specifically to address the availability of protection

---

18 Act of March 4, 1909, 60th Cong., 2d Sess., 35 Stat. 1075, s. 5(g).
19 Rules and Regulations for the Registration of Claims to Copyright, Copyright Office Bulletin No. 15, 8 (1910).
for industrial design. Its revised regulations no longer interpolated ‘fine’ before ‘work of art’, and explicitly provided protection for useful articles ‘including works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspect are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture’. 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’.

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’. (See images in Figures 9.1 and 9.2.)

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. 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 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.’

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’.

Emphasising 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’. The Court noted that the ‘dichotomy of

25 347 US 201 at 211–12.  26 Ibid. at 214.  27 Ibid. at 215.  28 Ibid. at 217.
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’. 29 Hence, a design might be both a work of art for purposes of copyright and, if sufficiently novel, an ornamental design for purposes of

29 Ibid. at 218.
design patents. But, the Court stressed, citing the Copyright Office regulation, ‘artistic articles are protected in “form but not their mechanical or utilitarian aspects”’.  

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).  

30 Ibid.

31 See ibid. 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
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.’\textsuperscript{32}

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.\textsuperscript{33}

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.\textsuperscript{34}

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?’\textsuperscript{35}

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’\textsuperscript{36}

\textsuperscript{32} Perlmutter, ‘Conceptual Separability’, 345. \textsuperscript{33} 37 CFR §202.100(c) (1957). \textsuperscript{34} 37 CFR §202.10(c) (1960). \textsuperscript{35} Perlmutter, ‘Conceptual Separability’, 346. \textsuperscript{36} Perlmutter, ‘Conceptual Separability’, 346–7, citing, among other cases, L. Batlin & Son, Inc. v. Snyder, 536 F 2d 486 (2d Cir. 1976) for failure to meet original authorship,
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.  

While recognising that a work of art could serve to decorate a useful article, the Copyright Office disfavoured copyright protection for industrial design in general, largely out of concern for anti-competitive consequences.  

It preferred a mid-measure between a copyright protection limited to pre-existing 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’. 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’. 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’, and was deemed to be

*Tennessee Fabricating Co. v. Moultrie Mfg Co.*, 421 F 2d 279 (5th Cir. 1970) for 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) for relying on categories of works traditionally considered copyrightable works of fine art.

38 Ibid. 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.’  
39 S. Rep. 94–473, Title II.  
40 Ibid. at §201(b)(1).  
41 Ibid. at §201(b)(2).
ornamental if ‘it is intended to make the article attractive or distinct in appearance’.\footnote{Ibid. at §201(b)(3).} Protection would attach only if the work were original, not commonplace or a minor variation of a pre-existing design, not ‘dictated solely by a utilization function of the article that embodies it’, and not apparel.\footnote{Ibid. at §202.} Protection would last for an initial term of five years, with the possibility of an additional five years upon application.\footnote{Ibid. at §205.} The Act would create a unique marking symbol – ‘(D)’ – to cover such designs.\footnote{Ibid. at §206(a).} ‘Protection . . . [would] be lost if application for registration of the design is not made within six months after the date on which the design was first made public.’\footnote{Ibid. at §209(a).}

The Senate proposal, in short, contained what was effectively a \textit{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’.\footnote{H.R. Conf. Rep. 94–1733 at 82.} 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’.\footnote{H.R. Rep. 94–1476 at 50.} 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?’\footnote{H.R. Conf. Rep. 94–1733 at 82.} In 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’.\footnote{Ibid.} 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’.\footnote{H.R. Conf. Rep. 94–1733 at 82.} 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 \textit{Mazer}’,\footnote{H.R. Rep. 94–1476 at 54.} thus yielding the current § 101 definition with its requirement that the design features of a 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

\begin{footnotesize}
\begin{enumerate}
\item[ootnote{Ibid. at §201(b)(3).}]\textit{Ibid. at §202.}
\item[ootnote{Ibid. at §205.}]\textit{Ibid. at §206(a).}
\item[ootnote{Ibid. at §209(a).}]\textit{H.R. Conf. Rep. 94–1733 at 82.}
\item[ootnote{H.R. Conf. Rep. 94–1733 at 82.}]\textit{H.R. Rep. 94–1476 at 50.}
\item[ootnote{Ibid.}]\textit{H.R. Rep. 94–1476 at 54.}
\end{enumerate}
\end{footnotesize}
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 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.53

Thus, the House Judiciary Committee ‘stressed Congress’s desire to exclude from protection the general class of industrial products, notwithstanding any “aesthetically satisfying” design’.54

53 Ibid. at 55.
54 Perlmutter, ‘Conceptual Separability’, 351.

Star Athletica may make way for broader copyright coverage of applied art; the Court did not allude to this aspect of the legislative history but instead stated ‘Congress has provided for limited copyright protection of certain features of industrial design [even when those features may affect the article’s utility], and approaching the statute with presumptive hostility toward protection for industrial design would undermine Congress’ choice’: 197 L. Ed. 2d at 373.
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).\textsuperscript{55} A test of physical separability seems fairly easy to apply, \textit{Mazer} offering a paradigmatic example: removing the lampshade, light bulb, dowel and electric cord leaves the freestanding statuette.\textsuperscript{56} ‘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 standalone items, one of which will be a protectable PGS work. As we will see in the next section, the Copyright Office adhered to this approach to ‘conceptual’ separability. The Supreme Court, however, while endorsing a ‘mirror image’ of § 113(a) analysis, and thus finding separability if the extracted design feature yields a standalone PGS work, does not concomitantly require that the object remaining after separation be capable of existing independently as a useful article.\textsuperscript{57}

9.4 Administrative Interpretation

The US Copyright Office administers the registration of works of authorship. Registration is not a prerequisite to protection, but no


\textsuperscript{56} The \textit{Star Athletica} court, however, characterised \textit{Mazer} as an example of conceptual separability, and further declared that it was ‘abandon[ing] the distinction between “physical” and “conceptual” separability’. See 197 L. Ed. 2d at 371.

\textsuperscript{57} Ibid.
suit may be brought for infringement of a work of US origin unless the work has been registered before the suit is filed.58 Thus any right holder of a US work of applied art who seeks to enforce 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.59 The Compendium of US 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. H.R. REP. NO. 94–1476, at 55 (1976), reprinted in 1976 USCCAN 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

58 17 USC s. 411(a). Or at least, the plaintiff has filed an application to register. Compare Cosmetic Ideas v. LAC/Interactive Corp., 606 F 3d 612 (9th Cir. 2010); Chicago 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, 1202–4 (10th Cir. 2005); MGB Homes, Inc. v. Ameron Homes, Inc., 903 F 2d 1486, 1489 (11th Cir. 1990); Fourth Estate Public Benefit Corp. v. Wall-Street.com LLC, 856 F 3d 1338 (11th Cir. 2017) (‘registration approach’).

59 If the Register continues to refuse, the applicant may nonetheless file suit; the Register may choose to become a party to the action, 17 USC s. 411(a).
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 pre-existing PGS work ‘in or on’ a useful article; one can imagine the drawing or carving as a freestanding 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’ co-existence of the 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.60

The Compendium continues with examples of ‘conceptually separable’ elements; none involves 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 (1978) (DC 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’].

The Compendium’s examples feature artworks effectively ‘applied to’ useful articles,61 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

60 See, e.g., Humanetics Innovative Solutions Inc., Correspondence ID: 1-JT7IVR, Review Board of the United States Copyright Office (11 September 2014), p. 5, https://ipmall.law.unh.edu/sites/default/files/hosted_resources/CopyrightAppeals/2014/Q1Q10,Q1.52014.pdf (discussed below): (‘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’).

61 Compare Paolo Marzano, ‘An Ill-Designed Protection for a Well-Designed Product: Italy and its Copyright Protection of Industrial Design’ (2014) 240 Revue Internationale du Droit d’Auteur 119 (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). Italy, law of 21 April 1941, n. 633, art. 2, since amended by Legislative Decree 2 February 2001, n. 95, implementing EU Directive 98/71/EC.
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 of that article.

By contrast, the Copyright Office appears to reject more strenuous efforts of conceptualisation 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 to 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 USCCAN 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 USCCAN 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. A pattern emerges from these letters. First, the Review Board ascertains if the design

---

of the useful article presents separable elements. Secondly, 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. 63

The chart 64 in Figure 9.3 illustrates the grounds for denying the remaining 143 appeals. Of these, sixty-three 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 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 in Figures 9.4–9.6), 65 the Review Board ruled:

\[ \text{[Y]ou argue that the Works’ overall visual aesthetic appearances are conceptually separable from the utilitarian functions of a crash test dummy. We find your} \]

appeals.asp. The statements in the text are based on a search of that database for rejections of form VA (visual art) applications from 1995 to 2014.

63 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.

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

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, Q1O, 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, Q1O, and Q1.5, there would be no underlying works remaining. The Works, therefore, fail the Copyright Office’s test for conceptual separability.66

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. As we shall see, the Supreme Court, while disagreeing in some respects with the Copyright Office approach, now also appears to limit

66 Ibid. at p. 5 (citation omitted).
Copyright protection to design features that do not constitute the shape of the useful article as a whole.

9.5 Judicial Interpretation

The case law preceding *Star Athletica* offered a plethora of tests of conceptual separability, some of which could have extended

67 Compare *Brandir Int’l, Inc. v. Cascade Pacific 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, 488 (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’), with *Progressive Lighting, Inc. v. Lowe’s Home Centers, Inc.*, 549 *Federal Appendix* 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’).
copyright protection to the entirety of a useful article’s form. One widely adopted approach considered the extent to which an article’s function affected the designer’s aesthetic choices, an approach that endeavoured to locate copyrightability on a sliding scale from form-follows-function (inseparable) to functionally gratuitous (separable).\(^68\) Another inquired whether the claimed design features enjoyed market value independently of the article’s utilitarian aspects.\(^69\) The Supreme Court has now rejected both of those tests, and proclaimed a single standard, but as we shall see, its application, particularly to three-dimensional forms, proves elusive.

### 9.5.1 Threshold Question: What Is a ‘Useful Article’?

The separability test applies only to ‘features’ of articles ‘having an intrinsic utilitarian function’ (other than to portray or convey information). The statute distinguishes between PGS features comprised within the ‘design of a useful article’ (emphasis supplied) and PGS works applied to a useful article.\(^70\) Courts have unduly complicated their inquiries by searching for separability when they should first have inquired whether the disputed design was in fact a useful article.\(^71\) Indeed, Star Athletica was such a case.\(^72\)

There, the Sixth Circuit ruled that team insignia applied to cheerleader uniforms (pictured in Figure 9.7)\(^73\) 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’,\(^74\) it should

\(^68\) See, e.g., *Universal Furniture*, 618 F 3d 417 (4th Cir. 2010); *Jovani Fashion, Ltd v. Fiesta Fashions*, 500 Federal Appendix 42 (2d Cir. 2012) (prom dresses); *Brandir Int’l*, Inc. v. *Cascade Pacific Lumber Co.*, 834 F 2d 1142, 1145 (2d Cir. 1987); and *Pivot Point Int’l v. Charlene Prods, Inc.*, 372 F 3d 913 (7th Cir. 2004).

\(^69\) See, e.g., *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F 2d 989, 991 (2d Cir. 1980); Melville B. Nimmer and David Nimmer, *Nimmer on Copyright* (New York: M. Bender, 2016), 2A-75, §2A.08[B][4] (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’); *Galiano v. Harrah’s Operating Co., Inc.*, 416 F 3d 411, 419 (5th Cir. 2005). For an extensive review of the case law, see an earlier version of this chapter published at 40 Colum. J. L. & the Arts 1 (2016).

\(^70\) Accord, W. Patry, *Patry on Copyright*, §3:143.50 (distinguishing between the design ‘of’ a useful article, and a design applied ‘to’ a useful article).

\(^71\) See, e.g., *Home Legend v. Mannington Mills*, 784 F 3d 1404 (11th Cir. 2015) (depictions of wood grain drawn on paper laminated to floor boards).

\(^72\) See 197 L. Ed. 2d at 375–6 (Ginsburg, J concurring in the judgment).

\(^73\) 799 F 3d at 473 (image located in opinion, but no additional source information available).

\(^74\) Ibid. at 491.
instead have treated those elements as fabric design, a category long recognised as a pictorial or graphic work. Copyright does not protect the garments into which the design-bearing fabric is cut, but neither does

---

75 See, e.g., *LA Printex Industries 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. 48 (SDNY 1997). By contrast, in *Jovani Fashion, Ltd v. Fiesta Fashions*, 500 Federal Appendix 42 (2d Cir. 2012), the Second Circuit affirmed the
the fashioning of the fabric into an article of clothing cancel out the copyright of the design imprinted thereon.

Rather than addressing the cheerleading garments as a whole (and detailing ten different tests of conceptual separability), the court should have recognised 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.76

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 characterisation 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.77

76 799 F 3d at 491. Toward the end of its opinion, the Sixth Circuit finally recognised ‘we believe that the graphic features of Varsity’s cheerleading-uniform designs are more like fabric design than dress design’, ibid. at 493.

77 The court acknowledged that, ‘If 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 USC § 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]’, ibid. at 487. See also Patry on Copyright, §3:143.50 (Varsity Brands exemplifies designs applied to a useful article).
The Supreme Court, however, asserting that the parties had not raised the issue of whether the designs were ‘useful articles’, proceeded directly to separability, thus depriving lower courts of guidance on a potentially dispositive definitional issue. Nonetheless, the Court’s subsequent statement that a ‘separable’ feature ‘cannot itself be a useful article’ will likely require lower courts to grapple with the meaning of that term.

9.5.2 Separability: The ‘Mirror Image’ Approach

Eschewing distinctions between ‘physical’ and ‘conceptual’ separability, Star Athletica turned to the statutory text, which defines a useful article’s ‘pictorial, graphic, or sculptural features’ as PGS works if [1] they ‘can be identified separately from, and [2] are capable of existing independently of, the utilitarian aspects of the article’. The Court stated:

The first requirement—separate identification—is not onerous. The decisionmaker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.

The independent-existence requirement is ordinarily more difficult to satisfy. The decisionmaker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article. In other words, the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in §101 once it is imagined apart from the useful article. If the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.

Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or ‘[a]n article that is normally a part of a useful article’ (which is itself considered a useful article).

As construed by the Supreme Court, the statutory text best fits the kind of pictorial, graphic or sculptural design elements exemplified by the Mazer statuette lamp base: these clearly can be ‘identified separately from’ and can be imagined as ‘existing independently of’ the useful article’s functional elements; indeed, the lamp bases were also sold as freestanding statuettes.

As we have seen in the Copyright Office’s approach, interpreting the statutory phrase ‘capable of existing independently’ to extend to the imaginary removal of the feature as a predicate to its existing independently from the article meets the dual statutory requirements of separate identifiability and independent existence. As we observed, this conceptual effort in effect imagines the design feature as a pre-existing PGS work reproduced on or in

78 197 L. Ed. 2d at 366. 79 Ibid. at 367. 80 Ibid. at 371. 81 17 USC s. 101 (emphasis supplied). 82 197 L. Ed. 2d at 367 (citations omitted). 83 Above, text after note 61.
the useful article. Interpreting separability as the mirror image of § 113(a) is 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.

The Supreme Court adopted a similar analysis:

The Copyright Act provides ‘the owner of [a] copyright’ with the ‘exclusive right[t] . . . to reproduce the copyrighted work in copies.’ §106(1). The statute clarifies that this right ‘includes the right to reproduce the [copyrighted] work in or on any kind of article, whether useful or otherwise.’ §113(a). Section 101 is, in essence, the mirror image of §113(a). Whereas §113(a) protects a work of authorship first fixed in some tangible medium other than a useful article and subsequently applied to a useful article, §101 protects art first fixed in the medium of a useful article. The two provisions make clear that copyright protection extends to pictorial, graphic, and sculptural works regardless of whether they were created as freestanding art or as features of useful articles. The ultimate separability question, then, is whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article.84

It is not clear how far the Court’s application of the reverse §113(a) approach goes. In the case before it:

Applying this test to the surface decorations on the cheerleading uniforms is straightforward. First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium—for example, on a painter’s canvas—they would qualify as ‘two-dimensional . . . works of . . . art,’ §101. And imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself. Indeed, respondents have applied the designs in this case to other media of expression—different types of clothing—without replicating the uniform. The decorations are therefore separable from the uniforms and eligible for copyright protection.85

By contrast, had the separated features ‘replicated the uniform’, then it appears the features would not have been separable because ‘the [extracted] feature cannot itself be a useful article’. ‘Replication’ does not mean ‘representation’. The Court analogised to a design that covers the full surface of a guitar: if the designs are lifted off, their contours will depict the shape of the guitar, but they will not be a guitar.86 By the same token, the Varsity stripes were ‘surface decorations’: they followed the cut of the uniforms, but did not

84 197 L. Ed. 2d at 367–8. 85 Ibid. 86 Ibid.
shape them (as evidenced by the interchangeability of the team-designating designs on the same basic – unadorned – uniform).

The announced rule that ‘to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article’ appears to preclude PGS status for the full shape of most useful articles. Indeed, ‘features’ suggests aspects or components of the design, not the entirety of the form of the useful article. Furthermore, the Court appears to exclude from PGS status even some portion of the shape of the article less than its entirety because ‘the feature cannot itself be . . . “[a]n article that is normally a part of a useful article” (which is itself considered a useful article)’.

Are there nonetheless circumstances in which the ‘mirror image’ approach to separability would embrace the full form of a three-dimensional useful article (or some substantial portion of it)? For example, were the complete abstraction of the article’s form from its function possible, and the shape could stand on its own as a work of art, perhaps the overall shape might be a ‘feature’.

In fact, the Court’s separability standard may not require that the form be completely unnecessary to the article’s function: the Court rejected a proposed requirement ‘that the statute protects only “solely artistic” features that have no effect whatsoever on a useful article’s utilitarian function’. Thus, it appears that the useful article’s separable form may even ‘make [the article] more useful’. Thus, to return to the crocodile salad tongs posited earlier, the Court might consider both the pre-existing sculpture outfitted with tongs, and the tongs designed in the shape of a crocodile, to be protectable PGS works. Similarly, the Court disapproved the Copyright Office requirement that the conceptual separation of the PGS features from the useful article must result in two intact objects, the extracted PGS work on the one hand, and the remaining utilitarian article on the other:

The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.

It is correct that the statutory text requires only that the PGS feature be capable of existing independently without the useful article; the Copyright

88 197 L. Ed. 2d at 371. 89 Ibid. 90 Ibid. at 370–1.
Office interpolated the reverse proposition that the useful article should be capable of existing independently without the design element. If the conceptual extraction of the PGS features does not require that the remainder still be capable of serving as the useful article that it was pre-extraction, then the Court would appear to be opening the way to widening the universe of protectable shapes of useful articles.

That said, the Court did pose some limit to the extraction approach:

Of course, because the removed feature may not be a useful article—as it would then not qualify as a pictorial, graphic, or sculptural work—there necessarily would be some aspects of the original useful article ‘left behind’ if the feature were conceptually removed. 91

If ‘some aspects of the original useful article’ must be ‘left behind’, then perhaps the extraction approach necessarily stops short of extending to the useful article’s entire form.

The Court also declined to find in Congress’ frequent failure to enact a sui generis industrial design right a congressional ‘intent to entirely exclude industrial design from copyright’. 92 Rather, ‘Congress has provided for limited copyright protection for certain features of industrial design’ 93 that the separability test should accommodate. On the other hand, the Court stressed that ‘our test does not render the shape, cut, and physical dimensions of the cheerleading uniforms eligible for copyright protection’. 94 The Court’s enumeration of what its separability test does not protect suggests a narrow scope of copyright coverage. If the listed features are not copyrightable per se, then the Court has implicitly rejected an approach to separability that inquires whether other designs could achieve the utilitarian aspects of the article. After all, many different shapes, cuts or physical dimensions could permit a cheerleading uniform to attain its characteristic objectives to ‘cover the body, permit free movement, and wick away moisture’. 95 But, unlike the stripes, chevrons and colour blocks at issue in Star Athletica, whose reproduction would not ‘replicate’ the uniforms, ‘shape, cut, and physical dimensions’ do constitute the article itself. That the article may be one example of many different variations of uniforms does not matter; ‘shape, cut, and physical dimensions’ define the particular resulting uniform, and that is all that is needed to produce a copyright-excluded ‘useful article’.

Applying the non-replication rule to three-dimensional design ‘features’ of useful articles should similarly result in a very limited

---

91 Ibid. at 371. 92 Ibid. at 372. 93 Ibid. at 373. 94 Ibid. 95 Varsity Brands, 799 F 3d at 491.
universe of copyright-protectable forms constituting the object as a whole. The claimed shape, after all, will ‘replicate’ the object (or a part of it), and the object will have ‘an intrinsic utilitarian function’. Consider an amoeba-shaped table top. A table is a useful article, and its top ‘is normally part of’ it; accordingly, is its shape not separable? That table tops can come in many shapes would not matter. Which shapes are ‘normally part of a useful article’? The answer may turn on whether the particular shape has ‘an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information’. If the shape has no utilitarian function (as might be the case for carvings that shape the edges of the table96), then separating the shape would not ‘replicate’ a ‘useful article’. But if the shape does have an intrinsic utilitarian function, then its extraction would ‘replicate’ a ‘useful article’. An amoeba shape for a table top might at first blush seem arbitrary and devoid of utility. But amoeba-shaped conference tables in fact exist and serve the utilitarian purpose of dividing the larger group sitting around the whole table into smaller discussion groups.97 As a result, the three-dimensional form of the table top, even if it might be perceived as a sculptural work, would not pass the second step of the Star Athletica Court’s analysis.

The Supreme Court’s new test will in application probably yield the same representational art-favouring results as those obtained under most prior interpretations of the statutory standard: Courts more easily perceive figurative designs as ‘separable’ than abstract forms. A federal district court found the bear paw shape of a slipper separable (see Figure 9.8).98

Similarly, the sheep-shaped seat of a stool (image in Figure 9.999) may readily be identified separately and conceived as existing independently of the rest of the stool.100

96 See, e.g., Universal Furniture v. Collezione Europa, above, note 68.
98 Animal Fair, Inc. v. AMPESCO Indus., 620 F Supp. 175, 188 (D. Minn. 1985), aff’d without opinion, 794 F 2d 678 (8th Cir. 1986) (finding the bear-depictive sculptural features of the slippers separable from and ‘wholly unrelated’ to the footwear function). Figure 9.8 image source: www.myboothang.com/bear-paw-slippers/. The depicted slippers may not have been the ones at issue in Animal Fair; that company ceased operations in 2015; see www.theridgefieldpress.com/44570/animal-fair-to-close-its-doors-after-15-years-in-business/ (1 April 2015).
100 The Star Athletica ruling brings the sheep stool even more comfortably within the zone of separability because the court has clarified that the extraction of the PGS feature need not leave a ‘fully functioning’ useful article behind, 197 L. Ed. 2d at 371. A stool without a seat is not fully functional, but that no longer appears to be an impediment to the ‘separability’ of the design of the seat.
Figure 9.8 Bear paw slippers

Figure 9.9 County Engraving, ‘Children’s wooden step or stool sheep design personalised’
In *Mazer v. Stein*, while the placement of the bulb and shade atop the dancer (see image in Figure 9.2) may have facilitated ruling the ballerina sculpture protectable despite its incorporation in the lamp, one might predict that even were the lighting elements fully integrated into the sculpture – for example, were the illumination to emanate from the ballerina’s tutu – a court would still find the sculpture separable from the useful article of the lamp. By contrast, the abstract form of the lighting fixture in *Esquire v. Ringer* did not elicit a perception of the object as a distinct sculpture.\(^\text{101}\) Moreover, the simpler or sleeker the shape, the less likely courts may be to identify separate PGS features, much less perceive them as capable of existing independently of the article’s utilitarian aspects. Similarly, the more the form follows the article’s function, the less will be ‘left behind’ after the extraction exercise, but the Court has told us that ‘there necessarily would be some aspects of the original useful article “left behind” if the feature were conceptually removed’.\(^\text{102}\)

Ultimately, the Court’s reverse-§113(a) analysis fails to supply the sword that cuts through the tangle of ‘separability’ case law. Even if the overall form of a useful article (or of parts of it) can be ‘identified’ as a sculptural work, its ability to exist independently of the utilitarian aspects of the article will now be assessed under the non-replication rule: if the shape of the object is a useful article, then it is not separable, even if other articles of similar utility might be differently shaped (just as cheerleader uniforms may come in many shapes, cuts or proportions).

How do we know if the shape is a useful article? The statutory definition of a useful article tells us that the object has ‘an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information’. So long as the form is not gratuitous relative to the function, just about any three-dimensional shape of a useful article (or of a part of it) will enable ‘an intrinsic utilitarian function’. Courts’ perception of representational shapes (such as the *Mazer* ballet dancer) as separable suggests a tendency to overlook the role the shape may play in the attainment of the article’s functional objectives. For example, much of the form of the fish pitcher depicted in Figure 9.10\(^\text{103}\) bears a relationship to its function; the open mouth serves as the spout and the curved tail furnishes the handle. Nonetheless, *Star Athletica*’s refusal to require that the claimed PGS elements be “solely artistic” features that have no effect whatsoever on

---

\(^{101}\) 591 F 2d 796 (4th Cir. 1978).  
\(^{102}\) 197 L. Ed. 2d at 371.  
\(^{103}\) Image source: www.etsy.com/listing/84000688/glug-jug-pitcher-ceramic-golden-fish.
accommodates the copyright protection at least of representational shapes, despite the apparent tension of the rejection of a ‘solely artistic’ standard with the definition of a useful article as having ‘an intrinsic utilitarian function’  (emphasis supplied).

9.5.3 Birth Order Redux: Indirect Copyright Protection for Some Industrial Design?

The above analysis leads to a paradox: although the Star Athletica Court sought a test under which copyright protection extends to pictorial, graphic, and sculptural works regardless of whether they were created as freestanding art or as features of useful articles. The ultimate separability question, then, is whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article

birth order continues to matter because under Star Athletica the claimed PGS ‘feature’ may not ‘replicate’ the useful article whose form it constitutes. By contrast, had the design shaped a standalone sculpture, it would be a PGS

Figure 9.10 Fish pitcher

a useful article’s utilitarian function accommodates the copyright protection at least of representational shapes, despite the apparent tension of the rejection of a ‘solely artistic’ standard with the definition of a useful article as having ‘an intrinsic utilitarian function’ (emphasis supplied).

9.5.3 Birth Order Redux: Indirect Copyright Protection for Some Industrial Design?

The above analysis leads to a paradox: although the Star Athletica Court sought a test under which copyright protection extends to pictorial, graphic, and sculptural works regardless of whether they were created as freestanding art or as features of useful articles. The ultimate separability question, then, is whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article

birth order continues to matter because under Star Athletica the claimed PGS ‘feature’ may not ‘replicate’ the useful article whose form it constitutes. By contrast, had the design shaped a standalone sculpture, it would be a PGS

104 197 L. Ed. 2d at 371. 105 197 L. Ed. 2d at 367.
work, and its subsequent incorporation in a useful article would not deprive the underlying sculpture of copyright protection. This outcome 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.

The divergent outcomes seem a product of pure formalism. (Which may be one reason for the Court’s attempt to abolish the ‘birth order’ distinction.) Consider the application of the two-step ‘first-a-sculpture, then-a-useful-article’ approach\(^{106}\) to the item in Figure 9.11.\(^{107}\)

---

106 Cf. *Universal Furniture v. Collezione Europa*, above, note 68, 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).

In the actual litigation, the court ruled that the plaintiff had failed to plead with particularity which elements of the item were conceptually separable and why. After *Star Athletica*, a court might identify the design of the hollowed tree trunk base and arms separately from the seat, but the base and arms’ capacity for existence independently of the chair function could founder on the rule that the design may not replicate a part of a useful article. The base and arms of a chair are indeed a part of the chair: albeit fanciful, they still fulfil the ‘intrinsic utilitarian function’ of providing arm rests and a base for the seat. On the other hand, if the shape of the useful article, or part of it, also represents a figurative form – the ballet dancer lamp base (part of the useful article), or the ballet dancer-shaped lamp with the illuminated tutu (the entire useful article) – then a court might perceive the representational features (even if they constitute the whole of the design) as existing separately from their utilitarian aspects. Applied to the chair base and arms, if a court perceived them as the representation of a tree trunk, it might envision their independent existence notwithstanding their functional role. The reverse-$§113(a)$ analysis could in theory apply equally well to abstract shapes – imagine the chair base and arms no longer depicted a tree trunk, but instead formed an atypical polygon. But the less representational the form, the less likely it may be to pass the first step of the *Star Athletica* test, which requires the court initially to identify separate PGS elements. By the same token, while *Star Athletica* now tells us that the useful article’s form need not be fully independent of its function, the more they are intertwined, the less courts may be likely to identify the formal elements ‘separately from the utilitarian aspects of the article’.

By contrast, if the designer had first created the hollowed tree trunk-like external shell as a sculptural form in its own right, then there would be no doubt that the copyright in the underlying sculpture would remain unaffected by the subsequent addition of the seating element. As a result, the sculptor would have 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 (see Figures 9.12 and Figure 9.13).

Admittedly, 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

---

Figure 9.12 Chair removed from the trunk (Heptagon Creations, Ltd v. Core Group Marketing LLC)

Figure 9.13 Chair reincluded in the trunk (Heptagon Creations, Ltd v. Core Group Marketing LLC)
obtain an exclusive licence from the sculptor, thus giving her enforceable rights against competing designers of useful articles.

As a result, even indirect protection for artistically designed useful articles significantly broadens the de facto application of copyright to works of applied art. Direct protection via a reverse-§113(a) approach seems more troublesome still. The wider that 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 over-inclusiveness. If, to paraphrase Gertrude Stein, ‘a chair is a chair is a chair’, so that the shapes of most useful articles should resist recharacterisation as non-useful PGS works, the universe of forms that effective advocates might conceptually convert to ‘sculptures’ could nonetheless prove ever-expanding. Consider the item in Figure 9.14:109 it does not require great labour of the imagination to conceive of the ‘Tube chair’ as a sculpture.

Or the Sori Yanagi ‘Butterfly stool’ (1954) (Figure 9.15),110 as its name suggests, could be conceptualised as an abstract representation of a butterfly.

Or either of the items in Figures 9.16 and 9.17, displayed in the Helsinki Design Museum,111

Or, the Le Corbusier ‘LC2’ armchair (1928) (Figure 9.18)112 looks more like a chair and less like an abstract form than the earlier 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 non-useful works of art. Sadly, then, for the attempt to forge a path to 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 toward which Star Athletica points presents two daunting risks: either a run down the slippery slope, or, to halt that slide, judicial resort to a gut sense of

Figure 9.14 Joe Colombo, ‘Tube chair’

Figure 9.15 Sori Yanagi, ‘Butterfly stool’
whether or not the disputed object is ‘art’. Star Athletica offers two limiting principles (though the majority opinion also contains language inconsistent with those guidelines): first, the claimed PGS work cannot be the entire form or a functional part of the useful article. Secondly, the requirement that the alleged PGS features be perceived as separate PGS works will tend to confine the reconception of the useful article as a standalone three-dimensional PGS work to representational forms. Without those limiting principles, the §113(a) mirror-image approach in practice is likely often to present intractable problems of line-drawing, and for that reason may well prove unworkable.
Figure 9.17 Flying carpet sofa, by designer Ilkka Suppanen, 1998

Figure 9.18 Le Corbusier ‘LC2’ armchair
9.6 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’.113 Chapter 13 largely tracks the abandoned Title II of the 1976 Copyright Act,114 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.115 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’,116 thus 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 Star Athletica’s interpretation 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.117

114 See above, text at notes 39–50.
115 17 USC ss. 1301, 1305, 1310. There is also a notice requirement; see ibid. ss. 1306, 1307.
116 Ibid. §1302. Designs not subject to protection:

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.

117 Ibid. §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.
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. But the origins of this legislation in special pleading from the Florida and California boat-building industries need not preclude its revision into a genuine design protection statute. Indeed, bills (so far unenacted) to extend intellectual property protection to fashion design have taken Chapter 13 as their starting points. 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 ‘[t]he 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’ 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. Admittedly, Chapter 13 establishes a

Ibid. §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.

118 Ibid. §1301(b)(2).
119 See, e.g., US Copyright Office. Compendium of US Copyright Office Practices, s. 1302 (3d ed. 2014) (‘Vessel design protection is not a form of copyright protection. Congress enacted the VHDPA 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’). Susanna Monseau, ‘The Challenge of Protecting Industrial Design in a Global Economy’ (2012) 20 Texas Intellectual Property Law Journal 495, 535 (‘[The VHDPA] 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’).
121 Ibid. §1301(a)(1).
sui generis design protection regime that borrows from other intellectual property regimes as well as from copyright. For example, distinctiveness is a characteristic of trade marks, 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 nor the Compendium of Copyright Office Practices allude to, much less implement, any requirement that the applicant demonstrate that the design is attractive or distinctive to the purchasing public.

Secondly, 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’. 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 supplied).

Finally, the definition of a ‘useful article’ could reprise the definition in § 101 of the Copyright Act. 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 thing, 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 anti-competitive consequences. Spare parts for automobiles and other devices may well fall into this category. To confront the problem of potential overprotection, Congress would need

---

123 Lanham Act s. 45 (definition of a trade mark).
125 See Copyright Office Compendium, above, ss. 1300–1305.
126 Ibid. §1301(b)(1).
127 ‘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” ’.
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.128 By contrast, Chapter 13 allows for the co-existence of copyright and design protection; the latter for the shape of the vessel hull as a whole, the former for particular design components.129 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 back-up extension of protection for the entire design of a useful article after the ten-year design protection term expires.

9.7 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

128 See 17 USC §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, 144 Cong. Rec. H. 1243, 1247.

129 See Compendium s. 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, 144 Cong. Rec. H. 521–57, Prepared Statement of Marybeth Peters, Register of Copyrights for the United States (‘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’).
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 pre-existing 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. The Supreme Court in Star Athletica now instructs courts to interpret 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. This approach 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 pre-existing artworks applied to useful articles relative to artistic designs created as useful articles.

Because the statutory separate identifiability plus independent existence standard best accommodates individual design features that are representational or superfluous to the article’s function, it arguably privileges design frivolity over sobriety, excrescence over simplicity, often disfavouring 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 endeavours to interpret the statute to encompass a wider range of overall forms of useful articles.  

130 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. But that is the point: in the absence of the kind of specially tailored coverage this chapter 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 even (or especially) after Star Athletica, places most overall designs of useful articles in the public domain.

130 In addition to the reverse-§113(a) approach, several such endeavours are detailed in Varsity Brands, Inc. v. Star Athletica, LLC, 799 F 3d 468, 484–5 (6th Cir. 2015), cert. granted 194 Lawyers’ Edition 2d 829 (2016). See also Goldstein, ‘Goldstein on Copyright’, §2.5.3(c) (‘it seems appropriate to place designs 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.