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THE COPYRIGHTABILITY OF USEFUL ARTICLES: THE SECOND CIRCUIT'S RESISTANCE TO CONCEPTUAL SEPARABILITY*

INTRODUCTION

The copyrightability of utilitarian articles has been the source of legislative and judicial consternation¹ since their statutory inclusion.² Primary statutory authority is found today in the Copyright Act of 1976,³ which defines a utilitarian or "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. An article that is normally a part of a useful article is considered a 'useful article.'"⁴

Congress's intent in passing the Copyright Act of 1976 was to draw the line between works of applied art, which are protectable, and industrial designs, which are not subject to copyright protection.⁵ In its application, however, "there is no line,

* The author of this Comment was awarded First Place in the Touro College, Jacob D. Fuchsberg Law Center, 1989 Nathan Burkan Memorial Competition, which is sponsored annually by the American Society of Composers, Authors and Publishers.

1. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 709 (1983).

2. Act of July 8, 1870, ch. 230, 16 Stat. 198, 212 (repealed 1916). Copyright protection was enlarged to include "painting, drawing, chromo, statue, statuary, and [elements] of models or designs intended to be perfected as works of the fine arts." *Id.*

3. See Pub. L. No. 94-553, 90 Stat. 2541 (codified at 17 U.S.C. §§ 101-914 (1988)).

4. 17 U.S.C. § 101 (1976); see *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 417 (2d Cir. 1985).

5. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1142-43 (2d Cir. 1987); see H.R. REP. NO. 1476, 94th Cong., 2d Sess. 54 (1976), *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5667 [hereinafter H.R. REP. NO. 1476].

but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns."⁶

This Comment examines the copyrightability of useful items. Part I presents an overview of how the various copyright statutes, from the earliest⁷ to the 1949 enactment,⁸ apply to useful articles. Part II begins with a discussion of the landmark case of *Mazer v. Stein*,⁹ where the United States Supreme Court held that the copyright statute¹⁰ may protect an article otherwise copyrightable despite its subsequent use in an industry.¹¹ Part II also examines subsequent copyright developments, culminating with an extended treatment of those sections of the Copyright Act of 1976 that extend copyright protection to the ornamental design elements of utilitarian articles, which, in large part, codifies *Mazer v. Stein*.¹² Part III focuses on an examination of the issue by the various circuits, with particular emphasis on the Second Circuit's interpretations and concludes that the Second Circuit's current test for granting copyright protection to the design elements of utilitarian articles contravenes congressional intent. Finally, this Comment advocates an alternative test which more closely effectuates Congress's intent in enacting the 1976 Act.

I. STATUTORY PROGRESSION AND EARLY SUPREME COURT RULINGS

Copyright protection per se did not exist at common law.¹³ Rather, it is a statutory creation¹⁴ first seen in the United

6. Denicola, *supra* note 1, at 741.

7. Statute of Anne, 8 Anne, ch. 19 (1710) (covering only books).

8. 37 C.F.R. § 202.8(a) (1949) (repealed 1978).

9. 347 U.S. 201 (1954).

10. *Mazer* was decided under the 1909 Copyright Act, 35 Stat. § 1075. The holding, however, is equally applicable under the current statute, 17 U.S.C. §§ 101-914 (1988).

11. *Mazer*, 347 U.S. at 218.

12. H.R. REP. NO. 1476, *supra* note 5, at 54-55.

13. *Mazer*, 347 U.S. at 214. Under common law, a person could have an unlimited property interest in a work yet unpublished. *Id.* at 214-15 (citing Lord Brougham and Lord St. Leonards in *Jeffreys v. Boosey*, iv H.L.C. 815, 968, 979, 10 E.R. 681, 741, 745 (1854)).

14. *Id.*

States in the Constitution,¹⁵ which provides authorization for federal copyright legislation.¹⁶ The first American copyright law was enacted by the First Congress in 1790.¹⁷ The statute limited copyright protection to charts, books, and maps.¹⁸

Each succeeding statute brought a more expansive treatment of copyright. Prints were included in 1802,¹⁹ musical compositions in 1831,²⁰ and photographs in 1865.²¹ The 1870 Act brought protection to three-dimensional objects, but was limited to the "fine arts."²²

In 1884, the United States Supreme Court, in *Burrow-Giles Lithographic Co. v. Sarony*,²³ held that the words "authors" and "writers" in the Constitution included photographers, designers, engravers, and lithographers and were not limited to literary writers in the traditional sense.²⁴ Subsequently, "writings" were held to include traditional works of "fine arts."²⁵

In *Bleistein v. Donaldson Lithographing Co.*,²⁶ the Supreme Court, in 1903, held that chromolithographs used in circus advertisements were "pictorial illustrations" protectable under the copyright laws.²⁷ Justice Holmes, taking an expansive view

15. U.S. CONST. art. I, § 8, cl. 8. This clause grants to Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." *Id.* However, the earliest statute is held to be the Statute of Anne, *supra* note 7.

16. Denicola, *supra* note 1, at 709.

17. See Act of May 31, 1790, ch. 15, 1 Stat. 124; *Mazer v. Stein*, 347 U.S. 201, 208 (1954).

18. *Mazer*, 347 U.S. at 208.

19. Act of Apr. 29, 1802, ch. 36, 2 Stat. 171 (repealed 1813).

20. Act of Feb. 3, 1831, ch. 16, 4 Stat. 436 (repealed 1870).

21. Act of Mar. 3, 1865, ch. 126, 13 Stat. 540 (repealed 1870).

22. Act of July 8, 1870, ch. 230, 16 Stat. 148, 212 (repealed 1916). "Fine arts" as defined is limited to paintings, drawings, and sculpture. *Id.* See also *supra* note 2 (copyright protection enlarged).

23. 111 U.S. 53 (1884).

24. *Id.* at 60; see Bussert, *Copyright Law: A Review of the "Separability Test" and a Proposal for New Design Protection*, 10 RUTGERS COMP. & TECH. L.J. 59 (1984).

25. Bussert, *supra* note 24, at 70 (examples of fine arts include paintings, sculptures, and drawings). Additionally, the Copyright Acts of 1870, 1874, and 1882 all contained the "works of fine art" language. *Id.* at 70 n.50.

26. 188 U.S. 239 (1903).

27. *Id.* at 251.

of copyright law, construed the term "works of fine art" to mean merely a "work" and, thus, not a barrier to the copyrightability of useful articles.²⁸ The intended use of an object in the commercial realm would not prevent it from receiving copyright protection.²⁹ It was in *Bleistein* that Justice Holmes issued his oft-quoted warning to future courts:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke.³⁰

The Copyright Act of 1909,³¹ forerunner to the present statute, encompassed "[w]orks of art, models or designs for works of art."³² The words "fine arts" were conspicuous in their absence, thus felling a major obstacle to the copyrightability of the design of utilitarian objects.³³ Only one year later, the distinction reappeared with a provision by the Copyright Office which excluded works of the industrial arts, utilitarian in function and character.³⁴ In 1917, this provision was modified to

28. Bussert, *supra* note 24, at 71.

29. *Bleistein*, 188 U.S. at 251.

30. *Id.* Justice Holmes continued:

It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value—it would be bold to say that they have not an aesthetic and educational value—and the taste of any public is not to be treated with contempt.

Id. at 251-52.

31. Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075.

32. *Id.* § 5(g).

33. Denicola, *supra* note 1, at 710.

34. COPYRIGHT OFFICE, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT, BULL. NO. 15, § 12(g) (1910), *reprinted in* Mazer v. Stein, 347 U.S. 201, 212 n.23 (1954). This provision, which again restricted copyright protection to the so-called "fine arts," was formulated by the Copyright Office. Works of industrial art were not granted copyright protection even if they were artistically made or ornamented. *Id.*

The Copyright Office, under the auspices of the Register of Copyrights, is responsible, under 17 U.S.C. § 701, "for all administrative functions and duties under the Copyright Act." Denicola, *supra* note 1, at 710 n.19.

permit registration of artistic drawings even if they later were utilized for articles of manufacture.³⁵ This amendment hardly was revolutionary, serving merely to reassert the holding in *Bleistein*.³⁶ The only remaining obstacle to the copyrightability of useful articles was a reference to “works of artistic craftsmanship,”³⁷ which remained even after the enactment in 1949 of section 202.8(a).³⁸ The focus then turned to judicial interpretation.

II. SUBSEQUENT DEVELOPMENTS

A. *Mazer v. Stein*

In 1954, with the seminal case of *Mazer v. Stein*,³⁹ the United States Supreme Court held that copyright protection was available for statuettes of male and female dancing figures, which, while copyrighted as “works of art,” were used subsequently as bases for table lamps.⁴⁰ While endorsing section 202.8(a), the Court found “nothing in the copyright statute to support the argument that the intended use or [actual] use in industry of an article eligible for copyright bars or invalidates its registration.”⁴¹

Although *Mazer* opened the door to the copyrightability of the design of utilitarian articles, the Supreme Court was careful to phrase the issue narrowly. The query, the Court said, must be answered “not as to a manufacturer’s right to register a lamp base but as to an artist’s right to copyright a work of

35. 37 C.F.R. § 201.4(7) (1917).

36. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903); see also Note, *Copyright Law—Copyright Protection For Industrial Designs Under the 1976 Copyright Act*, 25 WAYNE L. REV. 923, 925 (1979).

37. Denicola, *supra* note 1, at 711.

38. 37 C.F.R. § 202.8(a) (1949) (repealed 1978). This section provided that works of art “include[d] works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned.” *Id.*

39. 347 U.S. 201 (1954).

40. *Id.* at 218. The issue in *Mazer* was whether “statuettes [could] be protected in the United States by copyright when the copyright applicant intended primarily to use the statuettes in the form of lamp bases to be made and sold in quantity and [then] carried those intentions into effect.” *Id.* at 204-05.

41. *Id.* at 218.

art intended to be reproduced for lamp bases.”⁴² The Court noted the deletion of the “fine arts” clause of the 1870 Act,⁴³ finding that Congress clearly intended the copyright statute to encompass more than the traditional fine arts.⁴⁴

The Supreme Court’s holding in *Mazer* rested on two grounds. First, the Court, finding the statutory authority to protect the statuettes in the Copyright Act of 1909,⁴⁵ determined that they could not be denied copyright protection because of “a narrow or rigid concept of art.”⁴⁶ Second, the Court recognized that copyrightability for the aesthetic elements of a useful article did not turn on the distinction between beauty and utility.⁴⁷ Rather, under the 1909 Act, the aesthetic elements were eligible for copyright protection.⁴⁸ Clear-cut distinctions between purely aesthetic articles and useful works no longer were feasible.⁴⁹

B. *Post-Mazer Regulations*

While *Mazer* limited copyright protection to the expression of an idea, the idea itself not being protectable,⁵⁰ *Mazer* provided little guidance to the lower courts as to when the design

42. *Id.* at 205.

43. *Id.* at 211; *see also id.* at 209 n.14.

44. *Id.* at 213.

The term “works of art” deliberately is intended as a broader specification than “works of the fine arts” in the present statute with the idea that there is subject-matter (for instance, of applied design, not yet within the province of design patents) which may properly be entitled to protection under the copyright law.

Arguments Before the Comm. on Patents of the Senate and House, Conjointly, on S. 6630 and H.R. 19853, To Amend and Consolidate the Acts Respecting Copyright, 59th Cong. 1st Sess. 11, reprinted in *Mazer*, 347 U.S. at 213 n.28.

45. *Mazer*, 347 U.S. at 213-14.

46. *Id.* at 214; *see also* Reichman, *Design Protection In Domestic and Foreign Copyright Law: From The Berne Revision of 1948 To The Copyright Act Of 1976*, 1983 DUKE L.J. 1143, 1152.

47. *Mazer v. Stein*, 347 U.S. 201, 218 (1954).

48. *Id.* The Court phrased the distinction as being between “art,” which is protectable under the copyright laws, and “design,” which is subject to patent laws. *Id.* *See* Reichman, *supra* note 46.

49. *Mazer*, 347 U.S. at 211.

50. *Id.* at 217 (citing *F.W. Woolworth Co. v. Contemporary Arts, Inc.*, 193 F.2d 162 (1st Cir. 1951)).

of a commercial product was copyrightable. In conformity with *Mazer*, section 202.10(b)⁵¹ was enacted by the Copyright Office. Under this section, the ability to register a work of art was not jeopardized by the author's intention for its subsequent use.⁵²

In an effort to limit the holding in *Mazer*, as well as to clarify section 202.10(b), the Copyright Office instituted section 202.10(c), which provided:

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 that it is also a useful article will not preclude its registration.⁵³

This section provided the basis for the "separability"⁵⁴ standard, which has become the cornerstone in determining the copyrightability of a "useful article." Copyrightability hinged on whether the useful article possessed artistic or aesthetic features that were physically or conceptually separable from its utilitarian aspects.⁵⁵

Under the new regulation, arguably, any two-dimensional graphic work was separable from its utilitarian aspects,⁵⁶ and copyright protection was granted accordingly.⁵⁷ However, pro-

51. 37 C.F.R. § 202.10(b) (1956) (current version at 37 C.F.R. § 202.10(a) (1981)).

52. *Id.* The complete section provided:

In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile material or textile product. The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been issued.

Id.

53. 37 C.F.R. § 202.10(c) (1959) (revoked Jan. 1, 1978, 43 Fed. Reg. 966 (1978)) (emphasis added).

54. *See infra* note 81 and accompanying text.

55. 37 C.F.R. § 202.10(c) (1953).

56. Denicola, *supra* note 1, at 716.

57. *See, e.g.,* Syracuse China Corp. v. Stanley Roberts, Inc., 180 F. Supp. 527 (S.D.N.Y. 1960) (graphic design on dinnerware granted copyright registration).

tection generally was denied when the graphic design became integrated with its utilitarian features.⁵⁸

Three-dimensional utilitarian objects presented a more basic problem. While certain objects could be removed from their utilitarian function and, yet, exist independently, such as the dancing figures in *Mazer*, other items that could not exist independently still received copyright protection.⁵⁹ For example, the District Court for the Southern District of New York held that a small ornamental box used primarily as a jewelry box was copyrightable despite its utilitarian use.⁶⁰ The same court, in *Ted Arnold Ltd. v. Silvercraft Co.*,⁶¹ relying in part on *Mazer*, held that a simulation of an antique telephone, used as a casing for a pencil sharpener, could be considered apart from its function as a pencil sharpener⁶² and, therefore, was copyrightable.⁶³ The court emphasized that it was the simulation of the telephone casing that was the copyrightable article⁶⁴ but noted that, even if that feature encompassed the entire product, the court would not limit its sole intrinsic function to its utility.⁶⁵

While in the years following *Mazer* the courts expanded protection for "works of art" incident to useful items, the Copyright Office continued to assert its disapproval of providing copyright protection to industrial designs.⁶⁶ The Copyright Office concluded that providing copyright protection for indus-

58. Denicola, *supra* note 1, at 716; see, e.g., *Vacheron & Constantin-Le Coultre Watches Co. v. Benrus Watch Co.*, 155 F. Supp. 932 (S.D.N.Y. 1957) (appearance of watch face not copyrightable), *aff'd on other grounds*, 260 F.2d 637 (2d Cir. 1958).

59. See, e.g., *Royalty Designs, Inc. v. Thrifticheck Serv. Corp.*, 204 F. Supp. 702 (S.D.N.Y. 1962). Here, the court extended protection to coin banks in the shape of dogs, finding that the protectable feature was the bank itself. *Id.*

60. *Dan Kasoff, Inc. v. Gresco Jewelry Co.*, 204 F. Supp. 694, 695 (S.D.N.Y.), *aff'd*, 308 F.2d 806 (2d Cir. 1962).

61. 259 F. Supp. 733 (S.D.N.Y. 1966).

62. *Id.* at 734-35.

63. *Id.*

64. *Id.*

65. *Id.* at 736. The court reasoned that customers were not paying fifteen dollars because it was a pencil sharpener (a bit pricey even in today's economy) but because it was a "decorative conversation piece." *Id.*

66. Denicola, *supra* note 1, at 717 (citing HOUSE COMM. ON THE JUDICIARY, 87th Cong., 1st Sess., COPYRIGHT LAW REVISION, REPORT OF THE REGISTER OF COPY-

trial design would have anticompetitive consequences in light of the duration of copyright and the potential liability of distributors.⁶⁷

During what Professor Denicola has termed the "Revision Effort,"⁶⁸ those favoring protection for industrial design turned their attention from copyright to a series of companion bills that offered *sui generis* protection to the aesthetic elements of utilitarian objects.⁶⁹ The most noteworthy of these was Title II of the Copyright Act of 1976, introduced in Congress in 1975.⁷⁰ Title II's purpose was to provide limited protection for original, commercial design without unduly burdening the small retailer. Title II survived scrutiny in the Senate, but not in the House of Representatives, which feared that Title II

RIGHTS ON GENERAL REVISION OF THE U.S. COPYRIGHT LAW 13 (Comm. Print 1961)).

67. *Id.* at 718.

68. *Id.* See *supra* note 1 and *infra* note 90 and accompanying text.

69. *Id.*

70. Alan Latman, Counsel for the National Committee for Design Legislation, summarized its provisions:

(1) An original design can be protected if it is the original creation of its author, an original design being one that has not been copied; it may not meet any test of obviousness or inventiveness as required by the patent law, but it cannot be staple or commonplace nor dictated by function; (2) The original designer is protected only against unauthorized copying of the protected design; (3) Duration is for 5 years with an optional second 5 year term; (4) Protection begins upon public exhibition, sale or offering of an actual article embodying the design—"making public" of the design; (5) Registration within 6 months after the design is made known. An administrator is to be designated by the President. There is no requirement of a search or comparison with earlier designs, but a proper party may petition the Administrator for cancellation of registration of a design not subject to protection; (6) Notice or marking: requirements as to form and position are flexible and protection is not forever forfeited if notice is omitted, although omission may limit the design owner's remedies against infringers; (7) Infringement: recovery from anyone who, without authority purposely makes or imports articles embodying a copy of the protected design, and copyright proprietors cannot recover from sellers, assemblers, processors or innocent parties generally; (8) Remedies; injunction; damages which can be increased to \$1.00 per copy or \$5000, whichever is greater; possible forfeiture or destruction of all infringing articles, plates, molds, etc.; recovery of costs and possible attorneys fees; (9) Interrelation with Design Patent and Copyright: The new design protection does not affect availability of design patents, but protection would terminate as soon as the design patent is issued.

Bussert, *supra* note 24, at 81-82 n.118.

would remove such designs from the marketplace without providing any real advantages to justify the creation of a monopoly.⁷¹ Title II was deleted by Congress on the basis that it was outside the purview of copyright protection.⁷²

C. *The 1976 Copyright Act*

The 1976 Copyright Act⁷³ codifies the current standards for copyrightability of utilitarian articles. Whereas the old act was limited to "works of art: models or designs for works of art,"⁷⁴ section 101 of the 1976 Act includes "[p]ictorial, graphic and sculptural works," defined as:

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,⁷⁵ shall be considered a pictorial, graphic, or sculptural work only if, and 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.⁷⁶

This represents a codification of the separability test intended by section 202.10(c).⁷⁷ The word "sole,"⁷⁸ which had presented problems of interpretation in section 202.10(c), was eliminated by Congress from the new act.⁷⁹

Congress's intent to include two-dimensional graphic works and three-dimensional carvings of statues used in utilitarian items is clear.⁸⁰ Equally clear is its intent to exclude industrial design:

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

71. H.R. REP. NO. 1476, *supra* note 5, at 50.

72. *Id.*

73. 17 U.S.C. §§ 101-914 (1988); *see supra* notes 3-6 and accompanying text.

74. 17 U.S.C. § 102(a)(5) (1976).

75. *See supra* note 4 and accompanying text (footnote added).

76. 17 U.S.C. § 101 (1976).

77. Bussert, *supra* note 24, at 82-83; *see supra* note 53 and accompanying text.

78. *See* 37 C.F.R. § 202.10(c) (1959) (revoked Jan. 1, 1978); *see also supra* note 53 and accompanying text.

79. Bussert, *supra* note 24, at 83.

80. H.R. REP. NO. 1476, *supra* note 5, at 55.

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.⁸¹

Courts have vacillated in their interpretations of what is physically or conceptually separable. The statute's language provides little assistance in determining its scope. Central to the confusion is whether copyright protection is available for utilitarian articles that contain an element that is merely conceptually, rather than physically, separable from the utilitarian aspects of that article.⁸²

III. RESTRICTIVE VERSUS EXPANSIVE VIEWS OF SEPARABILITY

A. *An Initial Interpretation*

*Esquire, Inc. v. Ringer*⁸³ was the first case to construe the issue of separability. *Esquire* was a mandamus action to com-

81. *Id.* (emphasis added). The passage continues:

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.

Id. Accord 1 M. NIMMER, NIMMER ON COPYRIGHT (2d ed. 1978) [hereinafter 1 M. NIMMER]. But see Gerber, Book Review, 26 UCLA L. REV. 925 (1979) (reviewing M. NIMMER, NIMMER ON COPYRIGHT: A TREATISE ON THE LAW OF LITERACY, MUSICAL AND ARTISTIC PROPERTY AND THE PROTECTION OF IDEAS (1978)).

While Congress is specific in its intent to limit copyright protection to elements that are separable from the functional aspects of a particular article, it is equally clear that separability could be found in either a physical or a conceptual attribute of that article. This language takes on importance in cases that place undue emphasis on physical separability alone.

82. See Gerber, *supra* note 81, at 939 ("the conceptual separability thereof directly conflicts with the pertinent statutory language"). But see 1 M. NIMMER, *supra* note 81, § 2.08[B] at 2-96 ("the House Report suggested that separability may occur either 'physically or conceptually'") (referring to H.R. REP. NO. 1476, *supra* note 5, at 55).

83. 414 F. Supp. 939 (D.D.C. 1976), *rev'd*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). *Esquire* was decided under the 1909 Act because the

pel the Register of Copyrights to grant copyright registration for the artistic design of an outdoor lighting fixture.⁸⁴ The district court, relying on *Mazer*, held that the fixture's "sole intrinsic" use was not purely utilitarian.⁸⁵ The court found that the outdoor lights in question served both a decorative as well as a functional use and, in fact, only a decorative use during daylight hours.⁸⁶

The Court of Appeals for the District of Columbia reversed the lower court.⁸⁷ It concurred with the Register's view that copyrightability of the overall shape was barred by section 202.10(c) despite the aesthetically pleasing shape of the lighting fixtures.⁸⁸ Although decided under the 1909 Act,⁸⁹ the court of appeals relied on the 1976 Act on the basis that the "Revision Act"⁹⁰ was intended "to codify and clarify" the Regulation.⁹¹ In relying on the 1976 Act, the court was able to sidestep the "sole function being utility" language of section 202.10(c)⁹² and proclaim that the "physically and conceptually" separable language was to be given *de minimus* weight in light of the House's refusal to include the overall shape of a utilitarian object for copyright protection.⁹³

1976 "Act does not provide copyright protection for any work that goes into the public domain before January 1, 1978." *Esquire Inc. v. Ringer*, 591 F.2d 796, 799 n.8 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

84. *Esquire*, 414 F. Supp. at 940.

85. *Id.* at 941.

86. *Id.*

87. *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

88. 1 M. NIMMER *supra* note 81, § 2-08[B] at 2-91 to 2-92 (citing *Esquire*, 591 F.2d at 800).

89. *See supra* notes 31-32 and accompanying text. The case arose prior to January 1, 1978; therefore, the 1909 Act governed. *Esquire*, 591 F.2d at 799 n.8.

90. The Copyright Act of 1976 has been termed the Revision Act because it resulted from what is known as the "Revision Effort." Denicola, *supra* note 1, at 718-27. *See also* notes 68-72 and accompanying text.

91. *Esquire*, 591 F.2d at 803.

92. Bussert, *supra* note 24, at 84.

93. *Esquire*, 591 F.2d at 804. The court of appeals distinguished this case from *Mazer*, stating "[t]he statuettes [in *Mazer*] were undeniably capable of existing as a work of art independent of the utilitarian article into which they were incorporated." *Id.*

B. *The Second Circuit Looks at Separability*

*Kieselstein-Cord v. Accessories by Pearl, Inc.*⁹⁴ marked the Second Circuit's initial pronouncement of conceptual separability. Using precious metals, the plaintiff had designed two decorative belt buckles, which were used principally as jewelry. The designs were registered by the Copyright Office. The defendant manufactured identical buckles but used ordinary metals. The district court, relying in part on *Esquire*, determined that the plaintiff's belt buckles were not copyrightable because they did not meet the separability standard required under both the 1909 and 1976 statutes.⁹⁵

The Second Circuit Court of Appeals, taking an expansive view of separability, held that the buckles were copyrightable.⁹⁶ Judge Oakes termed the decision as being "on a razor's edge of copyright law,"⁹⁷ reasoning that, because the appellant's belt buckles embraced elements that were conceptually, albeit not physically, "separable from their *subsidiary* utilitarian function,"⁹⁸ they were copyrightable. The case is significant because of its approval of the "conceptually separable" language found in the legislative history.⁹⁹ The court, relying on Judge Harold Levanthal's concurrence in *Esquire*, determined that legislative policy coincided with the Copyright Office's intent to differentiate between aesthetic elements that are conceptually separable from an article's utilitarian function

94. 632 F.2d 989 (2d Cir. 1980).

95. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 489 F. Supp. 732, 737 (S.D.N.Y.), *rev'd*, 632 F.2d 989 (2d Cir. 1980). The court was correct in applying both Acts.

The court applied the 1909 Act to the "Winchester" buckle because publication and registration occurred prior to 1978. Likewise, the 1976 Act was applied to the "Vaquero" buckle because it was created after January 1, 1978, the effective date of the Act. However, if the infringement of the "Winchester" buckle occurred after January 1, 1978, the 1976 Act would have been applicable in most respects despite its earlier publication and registration. If, under the 1909 Act, the buckle was regarded as unprotectable prior to 1978, then copyright protection would not be available under the 1976 Act. 1 M. NIMMER, *supra* 81, § 2.08[B] at 2-92 n.106.2.

96. *Kieselstein-Cord*, 632 F.2d at 990.

97. *Id.*

98. *Id.* at 993 (emphasis added).

99. *Id.* The legislative history clearly refers to physical or conceptual separability. *Id.* See also H.R. REP. NO. 1476, *supra* note 5, at 55.

and those elements that are inextricably linked to the article's utilitarian aspects.¹⁰⁰

The Second Circuit utilized what has been termed a "market perspective."¹⁰¹ The court found the belt buckles had conceptually separable sculptural elements because they were worn as decoration for parts of the body not limited to the waist.¹⁰² Under this theory, copyright protection might become available whenever the aesthetic aspects of an item are of primary importance to the buyer.¹⁰³

Problems arise in determining what constitutes an item's primary appeal. One commentator asked: "Does the 'ornamental aspect' of an expensive sofa, for example, become 'primary,' and its utilitarian function 'subsidiary,' if its owner permits no one to sit on it?"¹⁰⁴ Another commentator suggested that conceptual separability exists where there is any substantial likelihood that an article would be marketable to a significant portion of the community solely because of its aesthetic value.¹⁰⁵

The dissenting judge in *Kieselstein-Cord* found the belt buckles' design neither physically *nor conceptually* separable, determining that the designer had integrated form with function, thus precluding copyright.¹⁰⁶ Judge Weinstein admitted that denying copyright protection on this basis while granting it to those who imposed "trite gimmickry to a useful object for purposes of enhancement"¹⁰⁷ was regrettable. However, believing that the buckles' form was wholly integrated in their utilitarian function, Judge Weinstein noted that it was not for the judiciary to contravene congressional intent.¹⁰⁸

100. *Id.* (citing *Esquire, Inc. v. Ringer*, 591 F.2d 796, 807 (D.C. Cir. 1978) (Levanthal, J., concurring), *cert. denied*, 440 U.S. 908 (1979)).

101. Denicola, *supra* note 1, at 733.

102. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980).

103. Denicola, *supra* note 1, at 733-34; *see infra* note 115 and accompanying text.

104. *Id.* at 734.

105. 1 M. NIMMER, *supra* note 81, § 2.08[B] at 2-98 to 2-99.

106. *Kieselstein-Cord*, 632 F.2d at 994 (Weinstein, J., dissenting) (emphasis added).

107. *Id.*

108. *Id.*

The point of departure between the majority and the dissent stems from a difference in opinion as to whether the design of the buckles could be considered separately from their use, not whether conceptual separability alone is sufficient to render an object copyrightable.¹⁰⁹ In fact, the dissent specifically cited the “physically or conceptually” language of the Committee on the Judiciary.¹¹⁰

C. Other Circuits' Views of Separability

In the time since *Esquire* and *Kieselstein-Cord*, courts have wrestled with the separability standard.¹¹¹ In *Norris Industries, Inc. v. International Telephone & Telegraph Corp.*,¹¹² the Eleventh Circuit upheld the Register's denial of copyright registration for automobile wire-spoked wheel covers. While acknowledging that case law and legislative history allow separability to be of either a physical or a conceptual nature,¹¹³ the court of appeals affirmed the district court on the basis that the

109. The dissent made reference to *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), which denied copyright to the lighting fixture on the basis that its overall shape was integrated with its functional aspects. *Kieselstein-Cord*, 632 F.2d at 996. *Esquire* is distinguishable from *Kieselstein-Cord* for that reason.

110. *Id.* at 997 (citing 1976 U.S. CODE CONG. & ADMIN. NEWS, (94 Stat.) 5667-68).

111. Bussert, *supra* note 24, at 87. Bussert noted that *Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95, 98 (D. Del. 1982), embraced *Kieselstein-Cord* as “well reasoned and persuasive” whereas *Gay Toys, Inc. v. Buddy L. Corp.*, 552 F. Supp. 622, 626 (E.D. Mich. 1981), *rev'd*, 703 F.2d 970 (6th Cir. 1983), relied on *Esquire* and the dissent in *Kieselstein-Cord* as “express[ing] more accurately the intent of Congress in adopting the act.” Bussert, *supra* note 24, at 87 n.143. The dissent in *Kieselstein-Cord* did not say, however, that conceptual separability was not sufficient. See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 994-99 (2d Cir. 1980) (Weinstein, J., dissenting).

112. 696 F.2d 918 (11th Cir.), *cert. denied*, 464 U.S. 818 (1983).

113. *Id.* at 923. The court relied, in part, on 1 M. NIMMER, *supra* note 81, § 2.08[B] at 2-94 to 2-96.1 (1982). Nimmer was counsel to Norris and argued “that the utility of a wire wheel design should not be equated with the utility of a wheel cover upon which the design is placed any more than the utility of a mural should be equated with the utility of a wall which bears the mural.” 1 M. NIMMER, *supra*, note 81, § 2.08[B] at 2-95 to 2-96 n.110.3.

wheel covers were useful articles that contained no such physical or conceptual elements.¹¹⁴

Taking a narrow view of separability, the court of appeals employed a "primarily useful/ornamental test,"¹¹⁵ determining that both the Register and the district court were correct, both in finding the wheel covers primarily useful because they protected the wheels from corrosion and in dismissing the plaintiff's contention that the covers were inefficient for that purpose.¹¹⁶ The court's argument fails because the wheel covers did not protect the wheels and brakes from dirt or corrosion and would not be sold for that purpose. Rather, their value would be as an ornament.¹¹⁷

In withholding copyright protection on the basis that the wheel covers could not be classified as art traditionally considered copyrightable,¹¹⁸ the court made the erroneous judgment that an automobile and, by necessity, anything associated with it, must be viewed as utilitarian. The Eleventh Circuit appears to have missed the point of Justice Holmes's "non-discrimination principle" in *Bleistein*.¹¹⁹

One commentator made the argument that the wheel covers were both physically¹²⁰ and conceptually separable from the hub.¹²¹ Had the Eleventh Circuit chosen to follow *Kieselstein-Cord*, the wire wheel covers would have been copyrightable.¹²²

114. *Norris Industries*, 696 F.2d at 924. The court could have found that copyright protection was not available since the plaintiff asked for protection for the wheel cover as a whole. Granting copyright protection to the entire wheel cover would have contravened the express intent of Congress. See *supra* note 5; Bussert, *supra* note 24, at 90.

115. Bussert, *supra* note 24, at 89. Whether an item is considered useful or ornamental is determined by its primary function. *Id.* Under this test, the statuettes in *Mazer* would be deemed useful if they were used primarily as lamps. However, they would be considered ornamental if they were purchased primarily as decoration and not for their use as lamps. This test's limitations are apparent from this example.

116. *Id.*

117. *Id.* at 89-90.

118. *Norris Industries v. International Tel. & Tel.*, 696 F.2d 918, 924 (11th Cir.), *cert. denied*, 464 U.S. 818 (1983).

119. See *supra* note 30 and accompanying text.

120. Bussert, *supra* note 24, at 90. The wire-spoked wheel pattern was removable from the hub. *Id.*

121. *Id.*

122. *Id.* at 91.

However, the Eleventh Circuit maintained that the *Kieselstein-Cord* court granted copyright protection to the belt buckles solely because jewelry fell into the category of objects traditionally protected by copyright.¹²³ By denying copyright protection to the wire wheel covers, the Eleventh Circuit's limited view of conceptual separability contravened legislative intent.¹²⁴

Another case that considered copyright protection for the design of useful articles is *Fabrica, Inc. v. El Dorado Corp.*¹²⁵ There, the Ninth Circuit denied copyright protection for display folders used for advertising purposes in the commercial carpet business. The plaintiff argued that its display folder was a pictorial, graphic, and sculptural work under 17 U.S.C. § 101, thereby falling within the ambit of copyright protection under the 1976 Act.¹²⁶ The court of appeals, citing the "any intrinsic utilitarian function" language of the 1976 Act, disagreed, holding that the folders lacked any artistic feature that could be identified separately from their utilitarian aspects.¹²⁷

Other courts have taken a less restrictive approach toward conceptual separability. In *Trans-World Manufacturing Corp. v. Al Nyman & Sons, Inc.*,¹²⁸ the court precluded summary judgment on the issue of whether sculptural elements existed that were conceptually separable from the utilitarian aspects of eyeglass display cases.¹²⁹ The court, citing Justice Holmes's warning in *Bleistein*, concluded that the evidence presented a genuine issue of material fact.¹³⁰

The court in *Poe v. Missing Persons*¹³¹ reached the same result. The Ninth Circuit, which had denied copyright protection for the carpet display folders in *Fabrica*, held that a genu-

123. *Id.* at 90.

124. *Id.* at 91.

125. 697 F.2d 890 (9th Cir. 1983).

126. *Id.* at 892.

127. *Id.* at 893. The court concluded that the folders served no other purpose than their usefulness in marketing and that even under the more lenient test the items would be considered "solely" utilitarian. *Id.*

128. 95 F.R.D. 95 (D. Del. 1982).

129. *Id.* at 99.

130. *Id.*

131. 745 F.2d 1238 (9th Cir. 1984).

ine issue of material fact existed as to whether the article, which the plaintiff described "as an artwork in the medium of soft sculpture,"¹³² was a utilitarian article of clothing or a work of art.¹³³ The Ninth Circuit reversed the district court's grant of the defendant's motion for summary judgment and remanded.¹³⁴ In remanding for trial limited to this issue, the court of appeals set forth relevant factors to be considered by the trier of fact: 1) expert testimony as to whether the functional aspects could be identified separately from the artistic aspects; 2) the designer's intent; 3) testimony concerning custom and usage within the art world and the clothing trade; and 4) the article's marketability as a work of art.¹³⁵

Thus, controversy still loomed over whether conceptual separability without physical separability was sufficient to justify copyright protection. If so, how was conceptual separability to be determined?

D. The Second Circuit Constricts Its View

In 1985, in *Carol Barnhart Inc. v. Economy Cover Corp.*,¹³⁶ the Second Circuit, which had taken an expansive view of conceptual separability in *Kieselstein-Cord*, held that mannequins of human torsos with hollowed backs were not copyrightable.¹³⁷ The figures, which the plaintiff had marketed for use in displaying clothing, were lifelike in form and anatomically correct. Nevertheless, the court determined that their design was utilitarian in nature and, therefore, devoid of features that were physically or conceptually separable.¹³⁸

The majority distinguished its holding from that of *Kieselstein-Cord* on the ground that the belt buckles' utilitarian function did not necessitate their ornamented surfaces, whereas, in *Carol Barnhart*, the mannequins' aesthetic features

132. *Id.* The controversy stemmed from whether the Aquatint was artwork or merely a swimsuit. *Id.*

133. *Id.* at 1243.

134. *Id.*

135. *Id.*

136. 773 F.2d 411 (2d Cir. 1985).

137. *Id.* at 418.

138. *Id.*

were inextricably intertwined with their utilitarian function of displaying clothing.¹³⁹ In refusing to extend copyright protection to the torsos, the court emphasized that Congress has repeatedly denied copyright protection to works of industrial design where aesthetic or artistic features could not be physically or conceptually separated from the utilitarian item.¹⁴⁰ The court determined that such was the case here.

Judge Newman dissented in *Carol Barnhart*, providing a theoretical gold mine for future decisionmaking and commentary on the subject.¹⁴¹ Judge Newman hinged his argument on the idea of conceptual separability, which, he stressed, was different from physical separability.¹⁴² The logical extension of that concept, according to Judge Newman, was that a design feature can be conceptually separable from its utilitarian function "even if it cannot be separated physically."¹⁴³ Judge Newman outlined several tests for conceptual separability¹⁴⁴ before

139. *Id.* at 419. *But cf.* *Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F. Supp. 175, 186-88 (D. Minn. 1985) (conceptual separability found in the design of slippers shaped like a bear's foot) (cited in W. PATRY, LATMAN'S THE COPYRIGHT LAW 42 n.113 (1985)).

140. *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985). "Such works are not copyrightable regardless of the fact that they may be 'aesthetically satisfying and valuable.'" *Id.* (citing H.R. REP. NO. 1476, *supra* note 5, at 55).

141. W. PATRY, *supra* note 139, at 43 (footnote omitted).

142. *Carol Barnhart*, 773 F.2d at 421 (Newman, J., dissenting).

143. *Id.*

144. The tests for conceptual separability have been summarized by W. PATRY, *supra* note 139, at 43-44 as follows:

1. *Primary use as a utilitarian article.*

Under this approach, "an article used primarily to serve its utilitarian function might be regarded as lacking 'conceptual separable' design elements even though those design elements rendered it usable secondarily as an artistic work."

Judge Newman noted that "[t]here is danger in this approach in that it could deny copyright protection to designs of works of art displayed by a minority because they are also used by a majority as useful articles."

2. *Primary aesthetic effect of the work.*

Under this approach, copyrightability would be found "whenever the decorative or aesthetically pleasing aspect of the article can be said to be 'primary' and the utilitarian function can be said to be 'secondary.'"

Judge Newman noted that "[t]he difficulty with this approach is that it offers little guidance to the trier of fact, or the judge endeavoring to deter-

settling on what has become known as the "temporal displacement" test.¹⁴⁵ Under this test, the design features of a utilitarian article must trigger, in the mind of the ordinary reasonable observer, a concept separate from that evoked by its utilitarian function.¹⁴⁶

The test's "requisite separateness" standard is satisfied when the article evokes in the beholder's mind two concepts that are not by necessity entertained simultaneously.¹⁴⁷ Under this approach, temporal displacement may occur, although the utilitarian function is observable, if that function can be replaced in the beholder's mind when he perceives a separate conceptual nonutilitarian function.¹⁴⁸

Applying this test to the torso forms, Judge Newman determined that the forms were not merely mannequins that happened to be aesthetically pleasing but, rather, were capable of being perceived by the beholder as works of art, a concept sep-

mine whether a triable issue of fact exists, as to what is being measured by the classifications 'primary' and 'secondary.'"

3. *Marketability of the work.*

Under this approach, conceptual separability would exist "where there is any substantial likelihood that even if the article had no utilitarian use it would be marketable to some significant segment of the community simply because of its aesthetic qualities." [This is the approach suggested by Professor Nimmer. *See supra* note 105 and accompanying text.].

Judge Newman noted that this approach "risks allowing a copyright only to forms within the domain of popular art. . . . However, various sculpted forms would be recognized as works of art by many, even though those willing to purchase them for display in their homes might be few in number and not a 'significant segment of the community.'"

4. *Aesthetic appeal of the work.*

Under this approach, conceptual separability would exist "whenever the design of a form has sufficient aesthetic appeal to be appreciated for its artistic qualities."

Judge Newman noted that this approach "has plainly been rejected by Congress."

Id.

145. W. PATRY, *supra* note 139, at 43-45; *see* *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987). Judge Winter essentially adopted this approach. *Id.* at 1151 (Winter, J., concurring in part and dissenting in part).

146. *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting).

147. *Id.*

148. *Id.* at 422-23. The observer need not fail to recognize the object as the object but rather that its functional use can be displaced by another concept. *Id.*

arate from and additional to their concept as functional articles.¹⁴⁹ However, since the majority viewed the torsos merely as mannequins, Judge Newman's approach did not quell the controversy.¹⁵⁰

In 1987, the Second Circuit was confronted again with the issue of whether to render copyright protection to the aesthetic elements of a utilitarian article. In *Brandir International, Inc. v. Cascade Pacific Lumber Co.*,¹⁵¹ the court of appeals denied copyright protection to the design of a bicycle rack made out of metal tubing, conceived as a sculpture¹⁵² but modified in the manufacturing process.¹⁵³

Plaintiff, the manufacturer of the bicycle rack, appealed from the district court's grant of summary judgment on the issue of copyright.¹⁵⁴ Judge Oakes, who authored the opinion in *Kieselstein-Cord*, gave extensive treatment to the legislative intent and history of the Copyright Act of 1976,¹⁵⁵ acknowledging that, although *Carol Barnhart* distinguished *Kieselstein-Cord*, it did not overrule it.¹⁵⁶ Judge Oakes affirmed the Second Circuit's acceptance of conceptual separability.¹⁵⁷ Determining how to apply it was another matter.

After noting that Judge Newman's "temporal displacement" test was rejected by the majority in *Carol Barnhart* as "a standard so ethereal as to amount to a 'nontest,'" ¹⁵⁸ the *Brandir* court adopted the test enunciated by Professor Denicola.¹⁵⁹ "[I]f 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.

149. *Id.* at 424.

150. *Carol Barnhart*, 773 F.2d at 418; see *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987). In fact, Judge Newman's test created further controversy. See *infra* notes 158, 167, and accompanying text.

151. 834 F.2d 1142 (2d Cir. 1987).

152. *Id.* at 1146.

153. *Id.* at 1147.

154. *Id.* at 1143.

155. *Id.* at 1143-44.

156. *Id.* at 1144.

157. *Id.*

158. *Id.* (quoting *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 419 n.5 (2d Cir. 1985)).

159. See Denicola, *supra* note 1.

Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists."¹⁶⁰ Professor Denicola stated that "[c]opyrightability . . . should turn on the relationship between the proffered work and the process of industrial design . . . [and] ultimately depend on the extent to which the work reflects artistic expression uninhibited by functional considerations."¹⁶¹

The court adopted Denicola's test for several reasons. First, the court determined that the test was consistent with prior Second Circuit case law.¹⁶² Second, the court hoped it would "alleviate the de facto discrimination against nonrepresentational art."¹⁶³ Third, the court believed that the test would be relatively easy to administer.¹⁶⁴ However, in adopting this test, the court offered copyright protection based solely upon whether the article was altered in the industrial design process.¹⁶⁵

In *Brandir*, the Second Circuit ruled that copyright protection was precluded because, although the original wire sculpture may have been copyrightable as a "work of art," its adaptation for commercial use was dictated by utilitarian concerns.¹⁶⁶ In the court's view, these concerns rendered the aesthetic elements of the rack inextricably intertwined and, hence, conceptually inseparable under Professor Denicola's test.¹⁶⁷

160. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

161. *Id.* (quoting Denicola, *supra* note 1, at 741).

162. *Id.* The court cited *Kieselstein-Cord* as one such decision where copyright protection was granted to belt buckles because their aesthetic features were not dictated by utilitarian concerns. Conversely, in *Carol Barnhart*, the designer incorporated the aesthetic features to further the torso's usefulness. *Id.*

163. *Id.*

164. *Id.* The court said the article "will continue to give 'mute testimony' of its origins," and "[i]n addition, the parties will be required to present evidence to the design process." *Id.*

165. 1 M. NIMMER, *supra* note 81, § 2.08[B] at 2-102.

166. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987).

167. *Id.* The court, again rejecting Judge Newman's test, found it insufficient that the rack was capable of evoking a concept separate from that of a bicycle rack

The court's ruling is erroneous.¹⁶⁸ Although the design of the sculpture was altered in the manufacturing process, the design changes were not dictated by utilitarian concerns.¹⁶⁹ This is apparent from the variety of bicycle rack designs available in the market.¹⁷⁰ Additionally, although various other types of metal tubing were available,¹⁷¹ the plaintiff chose the type it did because that particular kind maintained the effect of the sculpture.¹⁷² These constitute elements of the bicycle rack's design that exist independent of functional constraints. Therefore, under Professor Denicola's test, conceptual separability exists.

The court ignored "the possibility that the shape or configuration of an article can be conceptually separable from its utilitarian aspects."¹⁷³ In so doing, the court misconstrued Denicola's test. As a result, the court discriminated against nonrepresentational art, a result it hoped to avoid.¹⁷⁴

This ruling serves not only to discourage the fusion of form and function, which is so much a part of state-of-the-art design, but it also mistook Congress's intent in passing the 1976 Act. Section 101 of the Act demands more than the mere aesthetic appearance of an article to preclude copyrightability.¹⁷⁵ "Often, the shape of utilitarian articles is the precise feature that distinguishes them as 'art.'"¹⁷⁶

in the mind of the ordinary observer. *Id.* The court, however, seems to have focused solely upon physical separability.

168. See *infra* notes 203-05 and accompanying text.

169. Brief for Appellant at 10-11, *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) (No. 86-6260).

170. *Id.* Brief at 10. The brief discussed several other designs that were available at the time the plaintiff was altering the design of the sculpture. *Id.* Brief at 14.

171. *Id.* Brief at 10.

172. *Id.* Brief at 12.

173. *Id.* Brief at 9. The plaintiff maintained that the bicycle rack was "perceived as a functioning bicycle rack only when a bicycle is juxtaposed against it or secured to it." *Id.* Brief at 15. In fact, the plaintiff illustrated its point by describing an incident where the building manager, at whose building the rack was due to be installed, questioned whether the building owner "would accept [it] as a bicycle rack since it did not look like one." *Id.* See also *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1152 (2d Cir. 1987) (Winter, J., concurring in part and dissenting in part).

174. See *supra* note 163 and accompanying text.

175. *Poe v. Missing Persons*, 745 F.2d 1238, 1242 (9th Cir. 1984).

176. Note, *supra* note 36, at 929.

In *Brandir*, Judge Winter dissented from the majority's opinion on the copyright claim. First, the majority's adaptation of Professor Denicola's test destroyed the notion of conceptual separability.¹⁷⁷ Instead, Judge Winter called for the approach taken in *Kieselstein-Cord*, where copyright protection was granted to the aesthetic elements of a utilitarian item although those elements also performed utilitarian functions.¹⁷⁸ This is the test employed in Judge Newman's dissent in *Carol Barnhart*.¹⁷⁹ The test for conceptual separability should not be determined by whether form and function are inextricably intertwined, but, rather, by whether the reasonable beholder could view the article aside from its utilitarian purpose.¹⁸⁰

Second, and more importantly, Judge Winter stressed that the majority overemphasized the design process as an indicator of copyrightability.¹⁸¹ If the manufacturer of the rack simply had used one of the sculptures without modifying it slightly, then, under the majority's approach, copyright protection would have been available. The simple modification precluded protection: "Copyright protection, which is intended to generate incentives for designers by according property rights in their creations, should not turn on purely fortuitous events. . . . [T]he Copyright Act expressly states that the legal test is how the final article is perceived, *not* how it was developed through various stages."¹⁸²

Based upon the reasoning in *Mazer*, which the Copyright Act of 1976 sought to codify,¹⁸³ commercial use of the bicycle

177. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1151 (2d Cir. 1987) (Winter, J., concurring in part and dissenting in part).

178. *Id.*

179. *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting). To be conceptually separable, the article must evoke a separate concept from that evoked by its utilitarian function. *Id.*

180. *See id.* Judge Winter believed that an observer easily could view the rack as an ornamental sculpture. *Brandir*, 834 F.2d at 1151-52 (Winter, J., concurring in part and dissenting in part).

181. *Brandir*, 834 F.2d at 1152.

182. *Id.* (emphasis added). *Accord* 1 M. NIMMER, *supra* note 81 at § 2-102. Nimmer advanced the argument that commercially manufacturing any utilitarian article inevitably will result in modification of the artist's original design. *Id.*

183. *Brandir*, 834 F.2d at 1147; *see Mazer v. Stein*, 347 U.S. 201, 218 (1953).

rack would not preclude copyrightability.¹⁸⁴ The Act extends copyright protection to designs of "applied art"¹⁸⁵ that are, or are intended to be, incorporated into utilitarian articles. Under the statute, mass protection or commercial exploitation is not a barrier to copyright protection.¹⁸⁶

Like the belt buckles in *Kieselstein-Cord*, the bicycle rack could perform its function without necessarily being of a certain aesthetic design. The majority in *Brandir* seems to have focused on physical separability while ignoring conceptual separability, which by definition is a different concept.¹⁸⁷ Neither conceptual separability nor copyrightability should be impinged because the design of the bicycle rack allows it to function as a bicycle rack. In holding that modification of the sculpture for commercial use rendered the rack uncopyrightable, the court of appeals minimized the Supreme Court's intent and substituted its own.

E. Distinguishing *Brandir*

In 1988, the United States District Court for the Southern District of California had occasion to decide a copyright infringement action brought against a competitor by the manufacturer of masquerade costumes. The court, in *National Theme Productions v. Jerry B. Beck, Inc.*,¹⁸⁸ held for the plaintiff and enjoined the competitor-defendant from manufacturing, promoting, displaying, distributing, or selling the plaintiff's costumes or those substantially similar, on the ground that the plaintiff's costumes were copyrightable.¹⁸⁹

The plaintiff, in *National Theme*, manufactured various masquerade costumes depicting animals,¹⁹⁰ which were worn primarily for ornamentation and not as a substitute for cloth-

184. *Mazer*, 347 U.S. at 218.

185. "Applied art" includes original sculptural works. H.R. REP. NO. 1476, *supra* note 5, at 54.

186. *Id.* at 54.

187. See *supra* notes 142-43 and accompanying text.

188. 696 F. Supp. 1348 (S.D. Cal. 1988).

189. *Id.* at 1356.

190. *Id.* at 1349-51. The costumes were depictions of such things as a rabbit in a top hat, a tigress, and a dragon. *Id.*

ing.¹⁹¹ The court granted copyright protection to the costumes as applied art¹⁹² because of "the minimal functional considerations that went into the design of the costumes."¹⁹³

While acknowledging that costumes, generally, have an inherently useful purpose,¹⁹⁴ which renders them unprotectable "as costumes,"¹⁹⁵ the court determined that, in this case, "[t]he costumes' artistic features simply do not advance their utilitarian purpose as clothing or accessories."¹⁹⁶ Relying on *Mazer* and the 1976 Act,¹⁹⁷ the court was careful to state that copyright protection was extended to the "expressions of ideas, rather than the ideas themselves."¹⁹⁸ Therefore, it is interesting to note that the court extended copyright protection to the costumes only "to the extent that they have features which can be identified separately and are capable of existing independently as a work of art."¹⁹⁹

The case is significant because the court embraced the conceptual separability standard of *Kieselstein-Cord*²⁰⁰ while endorsing the Second Circuit's adoption of Professor Denicola's test.²⁰¹ However, the court rightfully noted that the Second Circuit improperly applied the Denicola test insofar as that court relied on the chronology of events in the development of the bicycle rack,²⁰² rather than considering "the extent to which the work reflects artistic expressions uninhibited by

191. *Id.* at 1353. The costumes were cumbersome and awkward to wear. *See id.* at 1349-53.

192. *Id.* at 1354.

193. *Id.*

194. *See id.* at 1352.

195. *Id.*

196. *Id.* at 1354.

197. *Id.* (citing 17 U.S.C. § 102(b) and *Mazer v. Stein*, 347 U.S. 201, 217 (1954)).

198. *National Theme Prods. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1354 (S.D. Cal. 1988).

199. *Id.* at 1352 (citing *Fabrica, Inc. v. El Dorado Corp.*, 697 F.2d 890, 893 (9th Cir. 1983)).

200. *National Theme*, 696 F. Supp. at 1352. "The features only need be conceptually separable from the utilitarian functions of the garments to be entitled to protection under copyright law." *Id.* (citing *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980)).

201. *Id.* at 1353.

202. *Id.*

functional considerations.”²⁰³ The California court proclaimed that “sequentially and chronologically dependent results go beyond Denicola’s intent, and will cause decisions to turn upon ‘largely fortuitous circumstances’ occurring during the creative process.”²⁰⁴

Applying that court’s interpretation of Professor Denicola’s test, the bicycle rack’s design in *Brandir* would be entitled to copyright protection. Professor Denicola’s test does not require a complete fissure between applied art and utilitarian concerns, merely that the artistic form is not unduly influenced by functional considerations.²⁰⁵ The bicycle rack in *Brandir* was adapted only marginally from the original artistic sculpture. Further, *Brandir* had the option of choosing from many equally utilitarian designs from which to manufacture the bicycle rack. The fact that the original design was modified when the bicycle rack was manufactured commercially is not dispositive of copyrightability under Professor Denicola’s test. The bicycle rack’s design was no more dictated by function than the telephone-shaped pencil sharpener in *Ted Arnold Ltd.*²⁰⁶ or the dancing figures in *Mazer v. Stein*.²⁰⁷

Recently, the District Court for the Eastern District of New York ruled on a case factually similar to *National Theme*. In *Whimsicality, Inc. v. Rubie’s Costume Co.*,²⁰⁸ the court denied the plaintiff’s application for a preliminary injunction and granted defendant’s cross-motion to dismiss the copyright claim²⁰⁹ on the basis that the plaintiff’s Halloween costumes

203. *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) (quoting Denicola, *supra* note 1, at 741).

204. *National Theme Prods. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1353 (S.D. Cal. 1988) (quoting *Brandir*, 834 F.2d at 1151 (Winter, J., concurring in part and dissenting in part)).

205. *Id.* *Accord Brandir*, 834 F.2d at 1145-47. See *supra* notes 168-74 and accompanying text.

206. *National Theme*, 696 F. Supp. at 1354.

207. 347 U.S. 201 (1954).

208. 721 F. Supp. 1566, *aff’d in part; vacated and remanded in part*, 891 F.2d 452 (2d Cir. 1989).

209. *Id.* at 1577.

did not possess substantial physical or conceptual characteristics separate from their utilitarian function.²¹⁰

Although the plaintiff's items were copyrighted as "soft sculptures,"²¹¹ the court determined that they really were costumes, and, therefore, not copyrightable.²¹² The court accepted the separability test adopted by the *Brandir* court²¹³ but rejected the *National Theme* court's analysis²¹⁴ as "flawed because [that] court failed to assess the artistic elements in light of the costumes' purpose as masquerade clothing."²¹⁵ Further, the court found that since the overall shapes of the plaintiff's costumes could not be identified physically or conceptually as separate from their utilitarian function, the costumes were not entitled to copyright protection.²¹⁶

Support for extending copyright protection to the design of *Brandir*'s bicycle rack is found in the court's affirmation of the separability test first enunciated by Professor Denicola and subsequently adopted by the Second Circuit.²¹⁷ The district court, in *Whimsicality*, stated that conceptual separability can be found in a "sculptural work which can be visualized . . . as

210. *Id.* at 1574-75. The court determined, in dicta, that some of the features of the plaintiff's costumes may be copyrightable. However, since those features were not at issue, the court declined to rule with respect to them. *Id.* at 1576.

211. *Id.* at 1568. The court determined that the plaintiff classified the articles as "soft sculptures" only for the purpose of obtaining copyright protection. The plaintiff routinely described the articles as costumes for every other purpose. *Id.* at 1568-70.

212. *Id.* at 1570. The court observed that the defendant's applications for copyright, including one for the "allegedly infringing costumes," had been rejected on this basis by the Copyright Office. *Id.* Unlike the district court, which stated that the plaintiff's misrepresentation did not rise to the level of fraud which would preclude the infringement claims, *id.*, the court of appeals held that the plaintiff "obtained its copyright registrations by misrepresentation . . . [and] therefore decline[d] to reach the issue of copyrightability since proper registration is a prerequisite to an action for infringement." *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 453 (2d Cir. 1989).

213. *Whimsicality*, 721 F. Supp. at 1572 (citing *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987)).

214. *Id.* at 1575. See *supra* notes 188-89, 200-204, and accompanying text.

215. *Whimsicality, Inc. v. Rubie's Costume Co.*, 721 F. Supp. 1566, 1575, *aff'd in part; vacated and remanded in part*, 891 F.2d 452 (2d Cir. 1989).

216. *Id.* at 1575-76.

217. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

a free-standing sculpture"²¹⁸ despite the fact that these factors are physically inseparable from the useful article.²¹⁹

In apparent contradiction to its holding in *Brandir*, the Second Circuit stated on appeal that "[u]nlike a useful article, a sculpture . . . is inherently copyrightable."²²⁰ The bicycle rack, conceived as a sculpture and modified only slightly in the manufacturing process,²²¹ falls squarely into this category.²²² "[A]ny reasonable observer would easily view the . . . [r]ack as an ornamental sculpture."²²³

CONCLUSION

Copyright protection was developed to prevent the copying by another of an author's work and only is available to the nonfunctional aspects of a useful article. Competition, therefore, is not restricted greatly when the design elements of utilitarian articles are copyrighted since the functional elements remain in the public domain.²²⁴ Case law consistently has adopted a lenient view towards the copyrightability of conventional art while depriving modern abstract utilitarian sculpture of copyright protection.²²⁵ The question remains: "Why is copyright less justified and the inhibition on competition more pernicious because the aesthetic form . . . depicts not a Balinese dancer but only an abstract shape?"²²⁶

218. *Whimsicality*, 721 F. Supp. at 1571.

219. *Id.* See *supra* note 173.

220. *Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 456 (2d Cir. 1989). In *Brandir*, the Second Circuit denied copyright protection to the bicycle rack's design because the court found that the bicycle rack was adapted for manufacturing purposes. *Brandir*, 834 F.2d at 1147. But see notes 168-87 and accompanying text.

221. See *supra* notes 152-53 and accompanying text.

222. *Brandir*, 834 F.2d at 1151-52 (Winter, J., concurring in part and dissenting in part) (footnote omitted).

223. *Id.*

224. Note, *supra* note 36, at 930.

225. *Id.* at 929. Compare *Mazer v. Stein*, 347 U.S. 201 (1954) (copyright protection extended to statuettes of male and female dancing figures), with *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) (where copyright protection was denied to a free-form bicycle rack).

226. I M. NIMMER, *supra* note 81, § 2.08[B] at 2-104.

The Constitution authorizes copyright legislation to advance science and art.²²⁷ However, the Framers could not have foreseen the extent to which industrial art would become infused in product development. Industrial design often hinges on the merger of form and function.²²⁸ If the design of a utilitarian article is dictated by its function, copyright protection is denied. However, there rarely is so direct a relationship.²²⁹

The Copyright Act of 1976 extends copyright protection to the design elements of a utilitarian article that can be identified as physically or conceptually separate from that article's utilitarian purpose.²³⁰ Unfortunately, the Second Circuit has "diminishe[d] the statutory concept of 'conceptual separability' to the vanishing point"²³¹ by its misapplication of Professor Denicola's test.

Under Professor Denicola's test, copyright protection is available to the design elements of a useful article if "the work reflects artistic expression uninhibited by functional considerations."²³² In light of the facts presented by the plaintiff in *Brandir*,²³³ the bicycle rack's design should have been granted copyright protection. The Second Circuit's misinterpretation of the Denicola test is evidence of that test's inherent ambiguity.

None of the standards employed by the courts can be deemed satisfactory. However, the test set forth in *Kieselstein-Cord*,²³⁴ and later espoused in Judge Newman's dissent to *Carol Barnhart*,²³⁵ comes the closest to effectuating Congress's intent in enacting the 1976 Copyright Act. Under that test, copyright protection is extended to "the aesthetic elements of

227. U.S. CONST. art. I, § 8, cl. 8.

228. Denicola, *supra* note 1, at 739.

229. *Id.* at 741.

230. 17 U.S.C. §§ 101-914 (1988). See *supra* note 81 and accompanying text.

231. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1151 (2d Cir. 1987) (Winter, J., concurring in part and dissenting in part).

232. *Id.* at 1145 (quoting Denicola, *supra* note 1, at 741).

233. See *supra* notes 151-53 and accompanying text.

234. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 994 (2d Cir. 1980).

235. *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 419-26 (2d Cir. 1985) (Newman, J., dissenting). See also *supra* notes 141-50 and accompanying text.

useful articles *even if* those elements simultaneously perform utilitarian functions.”²³⁶ Conceptual separability is found when the design features of a utilitarian article trigger in the mind of the ordinary reasonable observer a concept separate from that evoked by its utilitarian function.²³⁷

Although not a panacea, the test’s utility rests in its adherence to congressional intent that copyrightability is to be determined by “how the final article is perceived, not how it was developed through various stages.”²³⁸ This standard facilitates the fusion of form and function while denying copyright protection to a utilitarian article if its design is dictated by its function.

While physical or conceptual separability is a practical yardstick for implementing congressional intent in enacting the 1976 Copyright Act,²³⁹ the judiciary must take care not to impose its own prejudices about what constitutes aesthetically separable elements. “It [is] a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [art]”²⁴⁰

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236. *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1151 (2d Cir. 1987) (Winter, J., concurring in part and dissenting in part) (emphasis added) (citing *Carol Barnhart*, 773 F.2d at 423 (Newman, J., dissenting)).

237. *Carol Barnhart*, 773 F.2d at 422.

238. *Brandir*, 834 F.2d at 1152 (Winter, J., concurring in part and dissenting in part).

239. 17 U.S.C. §§ 101-914 (1988).

240. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

