

Torso Forms

Our case involving the four styrene chest forms seems to me a much easier case than *Kieselstein-Cord*. An ordinary observer . . . who views the two unclothed forms . . . would be most unlikely even to entertain, from visual inspection alone, the concept of a mannequin with the utilitarian function of displaying a shirt or blouse. . . . As appellant contends, with pardonable hyperbole, the design of Michelangelo's "David" would not cease to be copyrightable simply because cheap copies of it were used by a retail store to display clothing. . . . [Judge Newman concluded, however, that a triable question of fact existed as to the ordinary observer's perception of the two clothed forms.]

==== *Brandir International, Inc. v. Cascade Pacific Lumber Co.*
 ==== 834 F.2d 1142 (2d Cir. 1987)
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OAKES, J.: [The lawsuit concerned a bicycle rack made of bent metal tubing, developed by Brandir's owner and subsequently copied by Cascade Pacific. The Copyright Office denied registration. The district court agreed with this conclusion, and granted summary judgment to Cascade Pacific; the court of appeals affirmed.]

Perhaps the differences between the majority and the dissent in *Carol Barnhart* might have been resolved had they had before them the Denicola article on *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, [67 Minn. L. Rev. 707 (1983)]. . . . Denicola argues that "the statutory directive requires a distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear." He views the statutory limitation of copyrightability as "an attempt to identify elements whose form and appearance reflect the unconstrained perspective of the artist," such features not being the product of industrial design. . . . To state the Denicola test in the language of conceptual separability, 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.

We believe that Professor Denicola's approach provides the best test for conceptual separability and, accordingly, adopt it here for several reasons. First, the approach is consistent with the holdings of our previous cases. . . . Second, the test's emphasis on the influence of utilitarian concerns in the design process may help, as Denicola notes, to "alleviate the de facto discrimination against nonrepresentational art that has regrettably accompanied much of the current analysis." *Id.* at 745. Finally, and most importantly, we think Denicola's test will not be too difficult to administer in practice. The work itself will continue to give "mute testimony" of its origins. In addition, the parties will be required to present evidence relating to the design process and the nature of the work. . . .

Turning now to the facts of this case, we note first that Brandir contends, and its chief owner [Steven] Levine testified, that the original design of the RIBBON Rack stemmed from wire sculptures that Levine had created, each formed from one continuous undulating piece of wire. . . . He also created a wire sculpture in the shape of a bicycle and states that he did not give any thought to the utilitarian application of any of his sculptures until he accidentally juxtaposed the bicycle sculpture with one of the self-standing wire sculptures. . . . [A friend] informed him that the sculptures would make excellent bicycle racks. . . .

. . . The RIBBON Rack has been featured in *Popular Science*, *Art and Architecture*, and *Design 384* magazines, and it won an Industrial Designers Society of America design award in the spring of 1980. In the spring of 1984 the RIBBON Rack was selected from 200 designs to be included . . . in an exhibition entitled "The Product of Design: An Exploration of the Industrial Design Process," an exhibition that was written up in the New York Times. . . .

. . . [W]e find that the rack is not copyrightable. It seems clear that the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements. . . .

Had Brandir merely adopted one of the existing sculptures as a bicycle rack, neither the application to a utilitarian end nor commercialization of that use would have caused the object to forfeit its copyrighted status. Comparison of the RIBBON Rack with the earlier sculptures, however, reveals that while the rack may have been derived in part from one of[sic] more "works of art," it is in its final form essentially a product of industrial design. In creating the RIBBON Rack, the designer has clearly adapted the original aesthetic elements to accommodate and further a utilitarian purpose. These altered design features of the RIBBON Rack, including the spacesaving, open design achieved by widening the upper loops to permit parking under as well as over the rack's curves, the straightened vertical elements that allow in- and above-ground installation of the rack, the ability to fit all types of bicycles and mopeds, and the heavy-gauged tubular construction of rustproof galvanized steel are all features that combine to make for a safe, secure, and maintenance-free system of parking bicycles and mopeds. Its undulating shape is said in *Progressive Architecture*, January 1982, to permit double the storage of conventional bicycle racks. . . .

It is unnecessary to determine whether to the art world the RIBBON Rack properly would be considered an example of minimalist sculpture [as plaintiff had asserted]. The result under the copyright statute is not changed. Using the test we have adopted, it is not enough that, to paraphrase Judge Newman, the rack may stimulate in the mind of the reasonable observer a concept separate from the bicycle rack concept. While the RIBBON Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices. Indeed, the visually pleasing proportions and symmetry of the rack represent design changes made in response to

functional concerns. Judging from the awards the rack has received, it would seem in fact that Brandir has achieved with the RIBBON Rack the highest goal of modern industrial design, that is, the harmonious fusion of function and aesthetics. Thus there remains no artistic element of the RIBBON Rack that can be identified as separate and “capable of existing independently, of, the utilitarian aspects of the article.” . . .

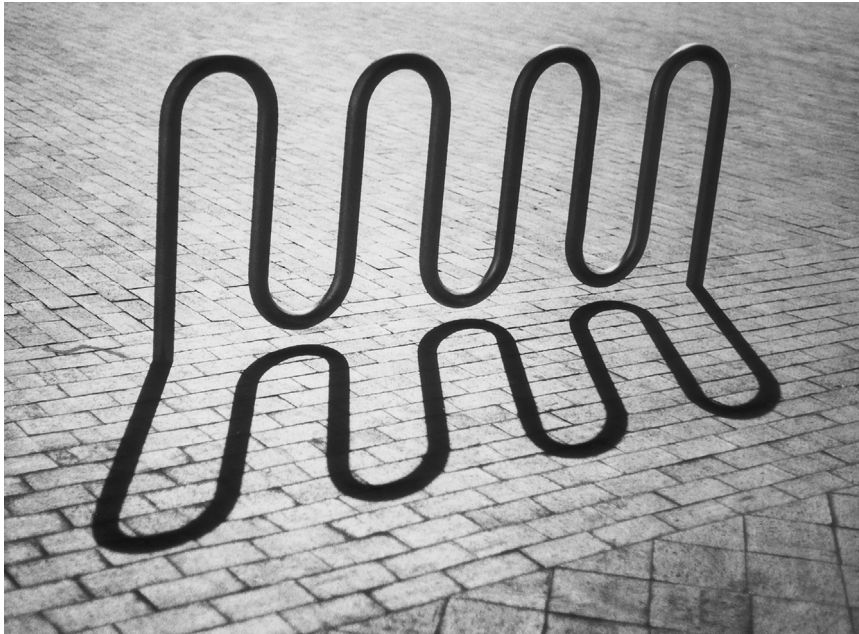


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RIBBON Rack in Shadow



RIBBON is a registered trademark of Brandir International, Inc.

RIBBON Rack in Use as Bike Rack

WINTER, J., dissenting: . . . [M]y colleagues' adaptation of Professor Denicola's test diminishes the statutory concept of "conceptual separability" to the vanishing point. . . .

. . . [T]he relevant question is whether the design of a useful article, however intertwined with the article's utilitarian aspects, causes an ordinary reasonable observer to perceive an aesthetic concept not related to the article's use. The answer to this question is clear in the instant case because any reasonable observer would easily view the Ribbon Rack as an ornamental sculpture. Indeed, there is evidence of actual confusion over whether it is strictly ornamental in the refusal of a building manager to accept delivery until assured by the buyer that the Ribbon Rack was in fact a bicycle rack. Moreover, Brandir has received a request to use the Ribbon Rack as environmental sculpture, and has offered testimony of art experts. . . .

. . . Copyright protection, which is intended to generate incentives for designers by according property rights in their creations, should not turn on purely fortuitous events. For that reason, the Copyright Act expressly states that the legal test is how the final article is perceived, not how it was developed through various stages. . . .

NOTES AND QUESTIONS

1. Are the three cases reconcilable? How would each case be decided under the approach taken in the other cases? Which approach to defining conceptual separability do you think is best, and why? Which is most faithful to the language of the House Report? Which approach adheres best to the nondiscrimination principle articulated by Justice Holmes in *Bleistein*?

2. What standard of review was applied in each of the above cases? Is conceptual separability more appropriately considered a question of fact or a question of law?

3. In *Esquire v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), the D.C. Circuit read the House Report's reference to "conceptually" separable features much more narrowly: "[A]ny possible ambiguity raised by this isolated reference disappears when the excerpt is considered in its entirety. The [surrounding] passages indicate unequivocally 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." *Id.* at 803-04. The *Esquire* court held that the Copyright Office did not abuse its discretion in denying registration to a set of modernistic, rounded designs for lighting fixtures. *Esquire*, however, arose under the 1909 Copyright Act; the court looked to the 1976 Act and its legislative history only as additional evidence to support its conclusion that denial of registration was consistent with Copyright Office regulations and established practice. In a later decision concerning registrability under the 1976 Act, the D.C. Circuit cited the "notable lack of agreement among courts and commentators on the very meaning of 'conceptual separability,'" and deferred judgment on the question. *Oddzon Prods., Inc. v. Oman*, 924 F.2d 346, 349-50 (D.C. Cir. 1991). Do you think the *Esquire* court got it right? See also *Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983) (finding that wheel covers "did not contain a superfluous sculptured design, serving no function, that can be identified apart from the wheel covers themselves").

4. Professor Alfred Yen has argued that it is impossible to undertake a conceptual separability analysis without making judgments about what is art and what is not. He notes that within the field of aesthetic theory, there are several different schools of opinion on this subject:

Aestheticians have . . . spilled a fair amount of ink on the subject, but their efforts have not created a uniformly accepted definition of art. However, three contrasting approaches to defining art are particularly relevant to this Article. First, formalism emphasizes the physical configuration of a work. Second, intentionalism focuses on the behavior of an object's creator. Third, institutionalism prefers a contextual approach that concentrates on how members of a cultural tradition called "the artworld" treat a work.

Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. Cal. L. Rev. 247, 252-53 (1998). He observes that leading copyright decisions reflect this lack of consensus:

Leading cases adopt analytical perspectives that are equivalent to major branches of aesthetic theory. In fact, the very effort to avoid aesthetics has led courts to adopt these varying perspectives because the facts of individual cases often make one analytical perspective seem more or less subjective and aesthetically controversial than others. . . . [C]ourts are essentially swapping one set of aesthetic premises for others in response to the facts of particular cases. Copyright opinions therefore amount to the judicial declaration of preference for one aesthetic perspective over others. Indeed, copyright opinions rendered today *necessarily require* the judicial declaration of such preference.

Id. at 298 (see BB Rule 5.2(d)(iii)). The solution to this problem, he argues, is more, not less, subjectivity in judging. Judges should be more explicit about which aesthetic biases and presumptions they hold:

[J]udges can take steps that will diminish (but not eliminate) the importance of their personal aesthetic biases. A judge must realize that he is not an objective, disinterested observer of the works under consideration. His initial intuitions inevitably come from the peculiar set of circumstances that make up his life. These intuitions may fortuitously be “ordinary” or similar to those held by other people. However, a judge must realize that this fortuity does not make, and cannot make, his intuitions correct in the strongest sense of the word. At best, his intuitions can be correct in a culturally relative way. In short, a judge must know that his intuition which “seems right” probably stands on highly contestable intellectual premises. Reflexive rejection of other possibilities represents the very sort of subjective censorship that Holmes warned against.

A judge who is conscious of this problem can guard against it by being particularly open-minded to alternate aesthetic sensibilities. For example, a dedicated formalist should listen particularly carefully to arguments based in intentionalism or reader-response theory. Traditionally oriented judges should listen carefully to avant-garde arguments. . . . The net result is that courts will wind up embracing a broader set of aesthetic conventions by openly thinking about aesthetics than they would by simply applying doctrine that embodies existing dogma.

Id. at 300-01.

Consider the three Second Circuit cases you have just read. Do they support Professor Yen’s observations? Which aesthetic perspective does each opinion adopt? Do you agree with Professor Yen’s proposal for addressing the problem of unconscious judicial bias? Would some other solution be more desirable?

5. Is a degree of discrimination against nonrepresentational art an appropriate part of the conceptual separability analysis? In another portion of his *Carol Barnhart* dissent, Judge Newman observed: “Any concern that copyright protection may accord a monopoly to advances in functional design . . . is adequately met by confining the scope of copyright protection to the precise expression of the proprietor’s design.” 773 F.2d at 421 n.1 (Newman, J., dissenting). Do you agree?

Section 113 of the Copyright Act places some additional limits on the scope of copyright in a pictorial, graphic, or sculptural work. Examine §113(a)-(c) now. Do any of these provisions address the concern discussed by Judge Newman? Section 113(c) does not allow the copyright owners of designs of useful articles to prevent photographs of those articles from being made and used in advertisements or commentaries about the articles. Why do you think Congress enacted this limitation on the rights of copyright owners for this category of works?

6. Remember that the threshold determination of whether something is a “useful article” is important, because something that is not a “useful article” need not be subjected to a

separability analysis. Do the belt buckles, mannequin forms, and bicycle racks from the cases you have read satisfy the §101 definition of “useful article”? How about masks designed to resemble animals’ noses? *See Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663 (3d Cir. 1990) (no).

Might a collection of blank forms in a personal organizer — e.g., calendar forms, address book forms, and “to do” lists — qualify as a useful article? *See Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 203 (2d Cir. 1989) (holding that no matter how useful a work is, the useful article rule does not affect the copyrightability of an integrated work of text and blank forms, but only that of pictorial, graphic, or sculptural works).

Remember also that other limitations on copyrightability, such as those discussed in Chapter 2, still apply in cases involving useful articles. *See, e.g., Past Pluto Prods. Corp. v. Dana*, 627 F. Supp. 1435 (S.D.N.Y. 1986) (uniform, machine-manufactured “spikes” on Statue of Liberty foam novelty hat lacked sufficient originality to be copyrightable).

7. While courts generally consider clothing a “useful article,” some cases raise interesting questions. Consider whether the clothing in the following hypotheticals is a “useful article”:

- a. clothing for stuffed bears (*See Boyds Collection, Ltd. v. Bearington Collection, Inc.*, 365 F. Supp. 2d 612 (M.D. Pa. 2005) (holding, on motion for summary judgment, that clothes for a doll might be shown not to be a useful article)).
- b. a “jeweled” bikini made of clear plastic and crushed rock (*See Poe v. Missing Persons*, 745 F.2d 1238 (9th Cir. 1984) (reversing a grant of summary judgment and remanding for evidence on the question of usefulness)).
- c. the exterior design of a slipper shaped as a whimsical bear foot (*See Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F. Supp. 175 (D. Minn. 1985) (assuming on a motion for a preliminary injunction that the slipper would be a useful article, and holding its “entire exterior design” protectible because “wholly unrelated to function”), *aff’d mem.*, 794 F.2d 678 (8th Cir. 1986)).

In almost all other cases, courts have found the artistic elements of the clothing’s design to be inextricably interwoven with the clothing’s function of covering parts of the human body. Thus, in the case of most clothing there is nothing that the Copyright Act will protect. *See, e.g., Morris v. Buffalo Chips Bootery, Inc.*, 160 F. Supp. 2d 718 (S.D.N.Y. 2001) (finding leather vests and dresses to be useful articles without separable artistic elements). Note, however, that the pattern or design printed on fabric can qualify as a graphic work.

8. Unlike the U.S., European countries protect clothing designs under both copyright and independent design protection statutes. The most recent EU directive concerning design protection is discussed in the Note on Industrial Design Protection in the EU, *infra* pages 210-11. Article 17 of this directive also expressly provides that such design protection does not foreclose protection under copyright law.

3. New Paradigms?

The murky contours of the “conceptual separability” test create uncertainty for those seeking copyright protection for the designs of useful articles. As you have seen, industries unsure about the availability or scope of copyright protection tend to lobby for more protection; thus, the materials covered in the preceding subsection raise the question whether Congress should accede to such requests by rewriting the definition of “pictorial, graphic, and sculptural works” to give it a broader (or at least clearer) scope. They also raise the question

whether the design of useful articles might more appropriately be protected via a different legal regime, as some other countries have done.

More concretely, the TRIPS Agreement obligates signatory countries to provide a minimum level of protection for industrial designs:

Article 25. Requirements for Protection

1. Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.

2. . . . Members shall be free to meet this obligation through industrial design law or through copyright law.

TRIPS Agreement, art. 25. The U.S. has stated that it already provides adequate protection to satisfy the TRIPS standard. As you read the following materials, consider whether this is so, and whether any of the regimes described are (or would be) good complements to, or substitutes for, copyright protection in this area.

Note on Design Patents

The first of the alternatives for design protection that we discuss is not new. At the time of the *Mazer* decision, design patents had existed in the U.S. for over a century. Under the Patent Act, a design patent is available for “any new, original, and ornamental design for an article of manufacture.” 35 U.S.C. §171. If granted, the design patent lasts for 14 years from the date of issuance. During that period, the patentee may prevent others from making, using, importing, or selling an article embodying the patented design. *Id.* §271.

There are few limitations on the subject matter of design patents. *In re Koebring*, 37 F.2d 421 (C.C.P.A. 1930), is illustrative. There, the Court of Customs and Patent Appeals ordered the Patent Office to grant a patent on the design of a cement mixer truck. The court rejected the Patent Office’s arguments that a machine with moving parts could not qualify as an “article of manufacture” under the Patent Act and could not be “inventively ornamental” as required by the design patent portion of the Act. It reasoned that in enacting design patent protection, Congress “had in mind the elimination of much of the unsightly repulsiveness that characterizes many machines and mechanical devices which have a tendency to depress rather than excite the esthetic sense.” *Id.* at 422. The court concluded that the statutory grant of protection could extend to any man-made article, with or without moving parts, as long as the appearance of that article was “a matter of concern to anybody.” *Id.* at 423. The design, however, cannot be governed solely by function. *See Seiko Epson Corp. v. Nu-Kote Int’l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999).

Until recently, the Copyright Office denied registration for any work that was already the subject of a design patent while the Patent Office and the Court of Customs and Patent Appeals (the predecessor to the U.S. Court of Appeals for the Federal Circuit) permitted design patents to issue on copyrighted designs. The Copyright Office relied on pre-*Mazer* cases such as *Korzybski v. Underwood & Underwood*, 36 F.2d 727 (2d Cir. 1929), which held that “[e]verything disclosed in the patent became a part of the public domain, except the monopoly of the patentee to make, use, and vend the patented device for a limited time.” *Id.* at 728. The Court