

COPYRIGHT PROTECTION FOR COMMERCIAL DESIGN: THE MOORHEAD BILL

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“The crass are rewarded, the
artist who creates beauty is
not” [1].

Judge Weinstein, dissenting
in *Kieselstein - Cord v.
Accessories by Pearl, Inc.*

1. Introduction

Congress has historically excluded commercial design [2] from the realm of copyright protection [3]. Although the First Congress granted copyright protection to such functional objects as maps and charts [4], and the Supreme Court has indicated that decorative articles that are useful in nature may still enjoy constitutional protection [5], extending copyright to the design of useful objects has been thought to be against the public interest.

Opponents of this repeatedly proposed extension [6] have advanced three principal arguments. First, copyrighting objects would monopolize an entire style or trend [7]. Second, because consumer preference sometimes demands uniformity of shape for certain everyday articles, extending a manufacturer a monopoly on such a shape would preclude others from making the same article [8]. Third, granting copyright to the design of a useful object where the shape is mandated by the function (*e.g.* scissors or paper clips) would tie up the idea of the object and thus undermine the basic premise that copyright “in no case ... extend(s) to any idea, procedure, process, system, method of operation, concept, principle, or discovery” [9]. In short, opponents fear that this extension will render useful articles inaccessible to the general public.

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Designers and manufacturers of original designs, on the other hand, argue that the current protection for commercial design provided under the copyright and patent laws fails to prevent even flagrant instances of design piracy [10]. Proponents of design copyright, moreover, match the arguments against design copyright with a set of equally standard arguments, maintaining that this extension would have, at worst, an economically neutral effect [11].

The most recent proposal to amend the Copyright Act to include protection for commercial design is a bill submitted by Congressman Moorhead of California [12]. This Comment examines the contents of this bill, analyzes the reasons for and against its enactment, and concludes that it should be adopted. In general, the arguments supporting and opposing design copyright tend to be speculative and theoretical. It is, therefore, useful to study a system already in existence that protects commercial design by copyright. Such a system exists in the United Kingdom.

This Comment begins by outlining the current status of design protection under U.S. law and then analyzes the Moorhead bill. Against this background, the British copyright laws are examined and the Moorhead bill is evaluated in light of the advantages and disadvantages of the British model.

2. The current status of copyright and design patent protection in the United States

2.1. *The U.S. design patent laws*

Although commercial design receives no copyright protection, Congress has offered protection for the design of useful objects under the patent statute since 1842 [13]. The current statute states: "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title" [14]. The standard for the design patent, which requires the design be new, original and ornamental, is different from that for patents for inventions [15], which requires inventions to be useful, novel and nonobvious to a person of ordinary skill in the art [16]. Some courts, however, have held design to the stricter standard for inventions, requiring the design to be nonobvious, as well as new, original and ornamental [17]. Indeed, one court required that the design be "beyond the skill of the ordinary designer or draftsman" [18].

Due to these requirements, it is estimated that only one in three design patterns proves valid in litigation [19]. Furthermore, the concept of nonobviousness, when applied to aesthetic aspects of a design, requires that courts make artistic judgments, a judicial function that the Supreme Court has held to be inappropriate [20]. Moreover, although the design patent laws often force

courts to be arbiters of aesthetics, this has not ensured that only superior designs are awarded protection. As one commentator has observed:

[The] fact that a design presents a combination of elements not previously found in a particular article may not be a tribute to the designer's skill, but merely a sign that this combination is inappropriate to the function for which the article is intended. Thus, the standard of "inventiveness" has not only failed to provide a firm basis for commercial reliance, but has also failed to encourage any recognized form of excellence in design [21].

Furthermore, the evaluation process required to assess such criteria as nonobviousness and novelty results in an excessive time lag between filing and issuance. In 1975, this time lag was reported to be about twenty-one months [22]. Since design patent protection begins only upon issuance, it is easily possible for the marketability of a commercial design to expire, and for design piracy to occur before protection can be granted. Judge Learned Hand addressed this problem in *Cheney Bros. v. Doris Silk Corp.* [23], a case in which the Second Circuit held that a silk manufacturer whose designs were being copied could not enjoin unfair competition despite the impracticability of securing design patents or the inability to obtain copyright. Judge Hand stated:

The plaintiff ... is a manufacturer of silks, which puts out each season many new patterns, designed to attract purchasers by their novelty and beauty. Most of these fail in that purpose, so that not much more than a fifth catch the public fancy. Moreover, they have only a short life, for the most part no more than a single season of eight or nine months. It is in practice impossible, and it would be very onerous if it were not, to secure design patents upon all of these. It would also be impossible to know in advance which would sell well, and patent only those So it is easy for any one to copy such as prove successful, and the plaintiff, which is put to much ingenuity and expense in fabricating them, finds itself without protection of any sort for its pains [24].

As Judge Hand points out, design patent fails to provide what the commercial designer needs most – immediate short-term protection with which the designer can launch his or her design into a market of quickly changing styles.

2.2. Copyright as a more viable form of design protection

One essential difference between patent and copyright is that patent, unlike copyright [25], protects ideas by protecting the process or system invented or discovered. Design patent also provides an absolute monopoly to make, use, or sell an ornamental design as applied to an article of manufacture [26]. In contrast, however, copyright does not preclude others from independently creating a work coincidentally identical to the originator's and securing rights thereon [27]; it protects a work only against copying by others [28].

Because the law sanctions a more extensive monopoly in the case of patents,

it is understandably more difficult to obtain a patent. Thus, whereas a difficult standard must be met to obtain patent protection, copyright protection automatically attaches to “original works of authorship, fixed in any tangible medium of expression” at the time the work was created [29]. Moreover, it is logical that the more extensive monopoly of patent should be of shorter duration. Thus, since 1978, copyright protection in newly created works lasts for the duration of the author’s life plus fifty years [30], whereas the duration of a design patent is only fourteen years [31].

Although the shorter duration of the design patent is of adequate length for the short life of most commercial designs, the time lag between filing and issuance, as mentioned earlier, is much too long. Copyright allows for no time lag at all during which the design is without protection; it attaches at the time the work is created [32]. Therefore, for the purposes of the commercial designer, copyright provides protection superior to that of design patent in terms of appropriateness of the standard [33], judicial response [34], and speed with which protection attaches [35].

3. The concept of separability: *Mazer v. Stein* and its progeny

The Supreme Court’s decision in *Mazer v. Stein* [36] marked a turning point in the history of legal protection for commercial design. “Until 1954 it had been widely assumed that the only statutory protection for the designs of utilitarian articles was that available under the design patent law, which dated back to 1842” [37]. In *Mazer*, however, the Court held that a statuette of a Balinese dancer, which was copyrightable as an original work of art, did not cease to be copyrightable by serving as a lamp base [38]. The lamp’s eligibility for a design patent did not preclude simultaneous protection of the statuette via copyright [39]. In upholding the copyrightability of a work of art that had been incorporated into a useful object, the Court in *Mazer* left room for two interpretations [40]. A broad interpretation would suggest that if a useful object is also a work of art, its form is copyrightable. This interpretation would fully extend copyright protection to commercial design. Narrowly read, the decision “preserves copyright protection for objects of art which perform utilitarian functions merely by becoming separable parts of essentially utilitarian objects” [41]. It is this narrow interpretation that has since been accepted. The fact that copyright existed only in the statuette base, which was physically separable from the rest of the lamp, led to the concept of separability, which was codified in the 1976 Act [42] and articulated in *Esquire v. Ringer* [43].

Esquire raised the question whether the overall shape of a lighting fixture was copyrightable. The fixture was a “nontraditional form, devoid of ornamentation or decoration but of pleasing shape and used apparently for outside lighting of parking lots” [44]. The Register of Copyrights denied registra-

tion on the grounds that there was nothing separate or distinguishable from the shape of the intrinsically useful object and that the design as a whole could not be separately identified or “exist independently” as a “work of art” [45]. Citing *Mazer*, the Register contended that “productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamental” [46].

The District Court disagreed, and held that the emphasis of Esquire’s fixtures on “line and shape rather than the realistic or the ornate” should not bar registration [47]. The United States Court of Appeals for the District of Columbia Circuit reversed, however, applying the separability standard for utilitarian objects and citing the House Report pertaining to that section of the 1976 Act governing “pictorial, graphic and sculptural works.” This Report states:

[A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, *physically or conceptually, can be identified as separable from the utilitarian aspects of that article*, the design would not be copyrighted under the bill. The test of separability and independence from “the utilitarian aspects of the article” does not depend upon the nature of the design – that is, *even if the appearance of an article is determined by aesthetic (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 [48].

The Court of Appeals further noted that the possibility that Esquire might claim that the artistic element is “conceptually” separable disappears when the work is considered in its proper context [49]. “Conceptual separability” has been used to refer to two-dimensional, and occasionally three-dimensional, shapes and patterns embellishing useful objects, where the ornamental aspect cannot be physically separated from the article it decorates. Courts have, thus, readily extended copyright to designs on fabric [50] and dinnerware [51]. Under no circumstances, however, according to the court in *Esquire*, did Congress intend that the notion of conceptual separability be applied to “the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations” [52].

Nevertheless, the recent controversial case of *Kieselstein-Cord v. Accessories by Pearl, Inc.* [53] did apply “conceptual separability” in this way. In *Kieselstein*, a divided panel of the Second Circuit upheld copyright in the designs of two belt buckles. The designer of the belt buckles brought suit for alleged copyright infringement and sought to enjoin the defendant from manufacturing two of plaintiff’s designs that plaintiff had registered with the Copyright Office as jewelry [54]. The defendant admitted to copying the designs and

selling the imitations, but claimed that the copyrights were invalid because the buckles were “useful articles” with no “pictorial, graphic, or sculptural features that [could] be identified separately from, and [were] capable of existing independently of, the utilitarian aspects” of the buckles [55]. The Second Circuit, in reversing the District Court’s issuance of summary judgment, found the buckles to be “conceptually separable sculptural elements” and, thus, copyrightable [56].

The court’s application of the notion of conceptual separability erroneously “implies that Congress intended to protect objects like the *Kieselstein-Cord* belt buckles whose artistic elements are inextricably bound with their functional ones” [57]. The court cites as an illustration of conceptual separability Professor Nimmer’s example of Christo’s “Running Fence” [58], thereby equating Congress’ reference to conceptual separability with conceptual art.

Nimmer views the artistic idea of the fence as conceptually separable from the structure of the fence itself, even though the basic structure of the fence was identical to a purely functional object. The woven nylon fabric connecting the posts of Christo’s fence, unusual as it might have appeared, “running for miles through the hills of Sonoma county”, constitutes the actual fence. Similarly, the decorative, but abstract, shape of the belt buckle was visually indistinguishable from the buckle itself.

The House Report’s use of “conceptual separability”, however, would include neither Christo’s fence nor the belt buckle in *Kieselstein-Cord*. The report refers to “some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article” [59]. It appears Congress intended a design to qualify for protection only if it can be separately identified, that is, if the design can be *visually* perceived apart from the utilitarian aspects of the article.

Kieselstein is further complicated by the fact that the court emphasized that purchasers “used [the buckles] as ornamentation for parts of the body other than the waist” [60]; in effect, the court treated the buckles as jewelry. The court, therefore, added to the expanded notion of separability the standard of consumer use of an article. Indeed, Nimmer reads *Kieselstein* to mean “conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some segment of the community simply because of its aesthetic qualities” [61].

The approach of relying on consumer use, however, is problematic [62]. Besides presenting evidentiary problems, there is no justification or precedent in copyright law for using market success as the standard for according protection. More important, the *Kieselstein* decision runs counter to Congress’s intent [63] to exclude the overall shape of utilitarian objects from the realm of copyright protection. The court, it seems, sympathized with the plaintiff and sought to avoid the inevitable results of the separability standard. These unfortunate results are described in Judge Weinstein’s dissenting opinion in

Kieselstein:

The result does deny protection to designers who use modern three-dimensional abstract works artfully incorporated into a functional object as an inseparable aspect of the article while granting it to those who attach their independent representational art, or even their trite gimmickry, to a useful object for purposes of enhancement. Moreover, this result enables the commercial pirates of the marketplace to appropriate for their own profit, without any cost to themselves, the works of talented designers who enrich our lives with their intuition and skill. The crass are rewarded, the artist who creates beauty is not [64].

Ironically, while Judge Weinstein presents the strongest argument in favor of copyright protection for commercial design, he would not extend such protection in *Kieselstein* because “it is not for [the] court to twist the law in order to achieve a result Congress has denied” [65].

Judge Weinstein touches upon one of the most regrettable results of the separability standard – the fact that it promotes bad design. The separability standard conflicts with the examples and teachings of modern industrial designers who merged aesthetic and utilitarian concerns, striving to create a form that was a logical and harmonious extension of the function of the useful article [66]. The basic tenet that form follows function is reflected in the work of the Bauhaus designers and Frank Lloyd Wright. In general, it epitomizes prize-winning industrial design over the past forty years. “The best designs are those in which the appearance springs truly from the structure, and is a logical expression of it” [67]. In *Kieselstein*, “[t]he artist has enhanced the appearance of the buckles by rendering their shape aesthetically pleasing without interfering with function. It is the originator’s success in completely integrating the artistic designs and the functional aspects of the buckles”, writes Judge Weinstein, “that preclude [sic] copyright” [68].

Moreover, even if the separability standard were aesthetically neutral, it would still be difficult to justify a myriad of decisions in which the copyright was upheld. For example, in *Ted Arnold, Ltd. v. Silvercraft Co., Inc.* [69], copyright was upheld in the antique telephone shape of a pencil sharpener. Although the *Esquire* court attempted to distinguish *Ted Arnold* on the grounds that the telephone casing could be removed from the actual sharpener [70], this argument undermines the “overall shape” rationale on which the *Esquire* decision is based. In addition, copyright has traditionally been held to apply to such objects with utilitarian functions as toy banks [71] and stuffed animals that can be used as pajama bags [72]. *Mazer* held that the statuette of a Balinese dancer used as a lamp base was copyrightable, but as one critic argues, if the statuette were converted into a cigarette lighter, pursuant to *Esquire*, it would not be copyrightable because its ornamental aspect cannot be separately identified [73]. “It seems absurd to contend that the statuette is copyrightable in one context but not the other, merely because the utilitarian aspects have been internalized. And if the point is conceded for a Balinese

dancer, what of a more abstract form reflecting twentieth rather than nineteenth century visions" [74]?

4. A feasible alternative: The Moorhead Bill

Among the numerous proposals made in response to this problem is a series of proposed amendments recommending copyright protection for commercial design [75]. Congress came close to enacting "The Design Protection Act of 1975," which was initially Title II [76] of the bill that amended the Copyright Act of 1909 and became the current Copyright Act of 1976. Although the Senate passed Title II [77] and the Copyright Office strongly favored its enactment [78], the design copyright amendment was stricken by the House Judiciary Committee [79]. The Committee thought that "the new form of design protection provided by Title II could not truly be considered copyright protection and, therefore, appropriately within the scope of copyright revision" [80]. The Committee concluded that the issue should be the subject of more extensive hearings in the next Congress [81].

Title II, thus joined a rather long list of proposed amendments recommending copyright protection for commercial design [82] in response to the problem presented by conceptual separability [83], which were proposed but never enacted. The immediacy of this issue, however, has not subsided. As Barbara Ringer, the current Register of Copyright, stated: "the full range of design protection issues ... stands as one of the most significant and pressing items on the Congressional agenda" [84].

Due in part, perhaps, to the longstanding resistance to extending copyright to useful objects, the proposed amendments have generally recommended only modest protection, such as terms of duration much shorter than the "life plus 50 years" term provided under the 1976 Act [85]. Such is the spirit of the Moorhead bill [86], the salient features of which can be summarized as follows:

(1) Copyright protection is provided to the "author or other proprietor of an original ornamental design of a useful article" [87]. "Ornamental" is defined as intending "to make the article attractive or distinct in appearance to the purchasing or using public" [88] and "original" is defined as "the independent creation of an author who did not copy it from another source" [89]. The definition of "useful article" takes its language from the Copyright Act of 1976:

A "useful article" is an article which in normal use has an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article which normally is part of a useful article shall be deemed to be a useful article [90].

(2) Protection is not extended to a design which is "staple or commonplace" or a shape which has become "common, prevalent, or ordinary" [91], or

different from a commonplace design or ordinary shape only in “insignificant details or in elements which are variants commonly used in the relevant trades” [92] or “dictated solely by a utilitarian function” [93].

(3) Protection begins on the date of publication of the registration or the date the design is first made public, whichever occurs first [94], and lasts for ten years [95], after which the proprietor may apply for renewal of the registration [96].

(4) A seller or distributor of an article sold without the consent of the proprietor of the design shall be deemed an infringer only if “he induced or acted in collusion with a manufacturer to make ... such article” or if he refuses to disclose to the proprietor of the design the source of the article, and he orders the article after having received notice of the protection subsisting in the design [97].

(5) “The party alleging rights in a design in any action ... shall have the burden of affirmatively establishing its originality whenever the opposing party introduces an earlier work which is identical to such design, or so similar as to make a prima facie showing that the design was copied from such work” [98].

(6) A registered design shall bear legible notice of the name or an accepted alternative designation of the proprietor [99], the year of the date on which protection commenced [100] and the words “Protected Design”, the abbreviation “Prot’d Des.” or the letter “D” in a circle [101]. The omission of notice shall not cause loss of protection, but shall prevent any recovery “against a person who began an undertaking leading to infringement before receiving written notice of the design protection” [102]. “[N]o injunction shall be had unless the proprietor of the design shall reimburse said person for any reasonable expenditure or contractual obligation in connection with such undertaking incurred before written notice of design protection The burden of providing written notice shall be on the proprietor” [103].

(7) The bill provides for the publication of lists and indices of registered designs and cancellations, and for the maintenance of a file of the drawings of registered designs, which will be available to the public “under such conditions as the Administrator may prescribe” [104].

(8) The proposed legislation shall have no retroactive effect [105]. It will have a pre-emptive effect on works in which copyright exists only with respect to its utilization in useful articles [106]. However, “[u]nless and until the copyright proprietor has obtained ... registration, the ... work shall continue in all respect to be covered” by the current Copyright Act [107].

(9) Remedies for infringement include injunction [108], damages either adequate to compensate for the infringement [109] or, alternatively, “the infringer’s profits resulting from the sale of the copies if [the court] finds that the infringer’s sales are reasonably related to the use of the claimant’s design” [110]. “The court may award reasonable attorney’s fees to the prevailing party” [111], and “may order that all infringing articles, and any plates, molds”, and

other items for making the protected design be forfeited [112].

4.1. Only short-term protection needed

The above provisions will correct the major defect of the design patent system – a long and onerous procedure for obtaining protection for commercial designs of short-term and uncertain commercial value [113]. In light of the relatively short “shelf-life” of commercial design, however, a ten-year initial term might be unnecessarily long.

The Moorhead bill, like prior proposed amendments to the Copyright Act [114], does not propose that commercial designs should be reclassified as “pictorial, graphic, and sculptural works” and that the full copyright term of life of the author plus fifty years should apply. Design copyright is instead perceived as filling the gaps that leave unprotected designs that qualify neither as copyrightable works because of their utilitarian function, nor as inventions [115]. Design copyright would thus alleviate filing and issuance of the design patent by providing immediate protection before the patent protection is secured. Because design copyright would be so much easier to obtain than patent [116], however, one might argue that the initial design copyright term should be no longer than the average commercial life of the design of a useful object. The duration of protection that is actually needed for commercial designers and manufacturers to profit from their designs remains as yet unclear. And whether protection should cover the entire commercial life of the design or merely provide a head start is another question facing Congress with respect to its decision on the duration issue.

The British copyright laws, which currently protect commercial design, are a working example of many of the provisions proposed by the Moorhead bill. The following section examines the British system and notes the problems associated with extending copyright to commercial design as well as the unforeseen difficulties that have actually occurred. The section considers whether the problems of the British system would be perpetuated or corrected in the United States by the enactment of the Moorhead bill.

5. The British system as a model for the Moorhead Bill

5.1. The British copyright laws

The British system provides three kinds of protection for the design of useful objects. Two of these – patent and design registration – are similar to U.S. law. The British patent, like that of the United States, protects the functional concept of an object [117]. The British system of Design Registration is similar to the U.S. Design Patent in that it provides the originator with a complete monopoly, thus preventing others from using the same or similar

designs, whether or not there was copying [118]. Like the U.S. Design Patent, this protection is intended for the artistic features of industrial design, those features which appeal to the eye and are not dictated solely by function [119]. The criterion for obtaining Design Registration is, as under U.S. law, novelty rather than originality [120]. Applications for protection, which lasts a maximum of fifteen years [121], must be made before the article is placed on the market [122].

The British commercial designer, however, unlike his American counterpart, receives full protection under copyright law. The Designs Copyright Act of 1968 [123], amending Section 10 of the Copyright Act of 1956 [124], protects the design of manufactured articles regardless of artistic merit and utilitarian function [125]. The statutory progression of the Copyright Act 1956, resulting in this extensive protection, has been effectively summarized by Louis Stevenson [126] as follows:

(a) Copyright subsists in every published or unpublished original artistic work [127]. "Original" means only that the work originate with the artist or draftsman in the sense that it is his work and not someone else's [128]. "Artistic works" include drawings irrespective of artistic quality [129], and drawings are defined to include any diagram, map, chart, or plan [130]. Copyright also subsists in works of artistic craftsmanship [131] and sculptures, as artistic works [132].

(b) Copyright in an artistic work is infringed, inter alia, by reproducing the work in any material form [133].

(c) Reproduction includes the making of a three-dimensional version of a two-dimensional artistic work [134].

(d) The words "in any material form" have always been given their full literal meaning, so that there is no doubt that manufacturing an article from a blueprint or drawing is reproduction in material form [135].

(e) The copyright in a two-dimensional work, such as a drawing or blueprint, is infringed by making a three dimensional version of the article illustrated, unless that article does not, to a non-expert, look like the drawing [136].

(f) Only a substantial part of a work need be reproduced to constitute infringement [137].

(g) Judicial decisions make it clear that it is not necessary to copy the drawing or blueprint itself to infringe; it is enough to copy a copy, such as an article manufactured from a blueprint [138].

If no drawing or blueprint of the article exists, the originator still has recourse to protection by showing that the article is an "artistic work," the definition of which includes "works of artistic craftsmanship" [139]. Moreover, unlike the U.S. system, British copyright does not bar the design of useful objects *per se* from protection. In the Australian case, *Cuisenaire v. Reed* [140], relevant because Australia has adopted the basic definitions and concepts of British law in its protection of commercial design [141], the court

articulated the following standard:

The true test ... is whether the author in making the article in which copyright is alleged to subsist was applying his skill and taste to its production with the main object of creating an article which, even if it be utilitarian, nevertheless will have a substantial appeal to the aesthetic tastes of those who observe it [142].

The result of this standard is that an otherwise copyrightable work of artistic craftsmanship would not be excluded by virtue of its utilitarian function.

As will be illustrated in the following section, although the inclusiveness of the British system derives in part from its liberal definition of an “artistic work” or a “work of artistic craftsmanship,” it is mainly the result of the notion “that it is not necessary to copy the drawing or blueprint itself to infringe; it is enough to copy a copy, such as an article manufactured from a blueprint” [143]. This, of course, is very different from the current U.S. copyright system which while protecting the blueprints or drawing of a design, permits the finished article appearing on the market [144]. The effect of deeming the copying of an article an infringement, rather than requiring, as under U.S. law, that the drawing itself be copied, is to protect the design of virtually every useful object that is marketed.

5.2. Problems arising under the British system

Despite several problems arising under British copyright laws, some of which are discussed in this section, proposals for reform generally recommend continuing protection for commercial design while narrowing its scope [145]. With respect to its protection of commercial design, the most common criticism of the British system is that it is overinclusive, that it protects purely functional works devoid of any artistic intension, and thereby distorts the underlying principle that copyright protects artistic works whereas patent protects inventions. Indeed, items as prosaic as electric light fixtures [146], bedpans [147], and automobile replacement parts [148], have been protected under the same system as fine arts.

One of the problems of protecting these purely functional objects has been in the field of spare parts. Because spare parts must be exact reproductions of the originals for them to fit into correct positions, copying is very easy to prove [149]. Thus, unless a license is issued by the original manufacturer or implicitly created [150], in most instances any new equipment item designed by a manufacturer will be free from competition by suppliers of spare parts for up to fifteen years [151].

This basic criticism of overinclusiveness raises an issue of policy as well. The accusation that industrial design not new or original enough to merit design registration may still obtain copyright protection rings true, for example, in the case of *P.S. Johnson and Associated Ltd. v. Bucko Enterprise Ltd. and others*

[152]. In *Johnson*, the plaintiff manufacturer sued on the ground that its artistic copyright in blueprints of a lavatory pan connector was infringed by the defendant's production of lavatory pan connectors. The case was brought under the Copyright Act because the design had not been registered under the Designs Registration Act, and, as critics have pointed out, probably could not have been, "since form and function were almost one in the plaintiff's design and its novelty and originality were dubious, to say the least" [153]. The court found that the defendant's connector appeared to be a three-dimensional reproduction of the plaintiff's blueprints and, thus, constituted an infringement, much to the amusement of the press, which noted how "the law in its majesty deemed such drawings to be as much artistic works as drawings of Picasso [154]".

5.3. *The narrower scope of the Moorhead Bill*

Because the Moorhead bill does not propose to protect designs dictated solely by function, the Copyright Office would not be permitted to register objects such as spare parts or lavatory pan connectors. The distinction may be illustrated by comparing the notion of form following function, a basic tenet of modern commercial design [155], with that of form or design dictated solely by function. In the latter instance the designer will usually have only one choice of design to solve the problem at hand. For example, the design for a spare part allows no room for creativity; the designer must meet standard specifications or the design will not be successful. Moreover, the designer does not intend to make the article any more pleasing to the using public via his design.

The Moorhead bill is clearly aimed at the former category. It proposes protection for the "original ornamental design of a useful article" [156], and defines "ornamental" as "intend[ing] to make the article attractive or distinct in appearance to the purchasing or using public" [157]. The bill further guards against including wholly functional designs by excluding from the protection designs that are "staple or commonplace" [158].

The *Johnson* case illustrates another fear of opponents of the proposed design legislation; copyrighting useful articles would do more than protect the creative expression – it would lock up the idea as well [159]. As one commentator points out [160], the lavatory pan connector could not have been made in any shape but the conical one. Therefore, affording copyright protection to the drawing would be tantamount to protecting an idea. In this case, where the object "allegedly" copied, was purely functional, it is difficult to understand how the court inferred copying without actual evidence. As mentioned above, British law does not require the copying of the blueprint or drawing to find an infringement, and the court found it sufficient that the defendant's three-dimensional object was similar enough to the plaintiff's drawing to conclude that it had been copied from the drawing. If the plaintiff's design was dictated

solely by function, however, the same must have been true of the defendant's design and the British Copyright Act does not preclude a designer from independently solving the same problem. The *Johnson* court, however, apparently found that the defendant had not arrived at the same design independently.

Because the Moorhead bill does not protect designs that hold the sole key to the functional nature of the object, there is no danger of monopolizing utilitarian objects. "If copyright is to be accorded only to the non-functional form of a work, this would not inhibit competitors from making available to the public the utilitarian essence of the industrial product. That such a competitor could not copy another's aesthetic form would not affect the competitive product's utility" [161].

The crux of most economic arguments advanced against extending copyright to industrial design is the fear that this extension will render useful articles inaccessible to the general public. The Moorhead bill, it appears, was conceived with these arguments in mind. The Register's brief in *Esquire* [162], for example, lists three economic arguments against design copyright:

First, in the case of some utilitarian objects, like scissors or paper clips, shape is mandated purely by function. If one manufacturer were given the copyright to the design of such an article, it could completely prevent others from producing the same article [163].

The obvious response, of course, is that the Moorhead bill would not protect an object the shape of which is mandated purely by function. Moreover, the designs of items such as scissors and paper clips would most likely be excluded by virtue of being "staple or commonplace".

Second, consumer preference sometimes demands uniformity of shape for certain utilitarian articles, like stoves for instance. People simply expect and desire certain everyday useful articles to look the same particular way. Thus, to give one manufacturer the monopoly on such a shape would also be anticompetitive [*sic*] [164].

The response again, is that everyday objects that are "staple and commonplace" are not subject to protection. And as Nimmer points out [165], the requirement of originality will preclude copyright protection for most standardized shapes.

Finally, the Register contends:

[I]nsofar as geometric shapes are concerned, there are only a limited amount of basic shapes, such as circles, squares, rectangles and ellipses. These shapes are obviously in the public domain and accordingly it would be unfair to grant a monopoly on the use of any particular such shape, no matter how aesthetically well it was integrated into a utilitarian article [166].

Nimmer's response is that "insofar as a shape is in the public domain . . . no copyright may be claimed regardless of whether it is integrated into a utilitarian article" [167]. The bill confirms this, specifically excluding under the rubric of "staple or commonplace", designs "such as a standard geometric figure, familiar symbol, emblem, or motif, or other shape, pattern, or configuration which has become common, prevalent, or ordinary" [168].

6. Conclusion

An alternative is needed to the inadequate protection currently offered to commercial design by the Design Patent Act which has been unable to prevent flagrant instances of design piracy. Although copyright is much better suited to providing immediate and inexpensive protection for designs that are usually shortlived and of uncertain commercial potential, copyright is available only to commercial designs that can be identified separately from the utilitarian aspect of the useful article. The result of this "separability standard" is that the law at present excludes from protection most abstract designs and designs in which aesthetic and utilitarian concerns are merged.

The Moorhead bill would render the copyright law aesthetically neutral toward commercial design. Because the bill does not propose protection for designs dictated solely by function, as does the British Copyright Act, it is able to refute the basic economic arguments commonly advanced against design copyright.

The ten-year duration of the initial term of protection proposed by the bill, however, appears unnecessarily long. What is needed is a period of protection limited to the period in which a designer can be reasonably expected to reap his economic benefit. An appropriate term might be best determined in conjunction with the designers and manufacturers who would be affected should the bill become law.

Finally, in light of the history of proposed legislation for design copyright, the need for congressional action appears pressing indeed. The Moorhead bill, tailored with the fears in mind of longstanding opponents to such amendments, offers the designer modest but adequate protection. It should be enacted.

Notes

[1] 632 F.2d 989 (2d Cir. 1980).

[2] “Commercial design” is herein used interchangeably with the “design of useful objects” and refers to any visual aspect of a useful article (e.g. cars, furniture, appliances) intended to make the article more desirable to the consumer. Fashion design is also generally included under the rubric of commercial design. However, because the proposed legislation for design copyright, which is the focus of this Comment, excludes articles of clothing, copyright protection for fashion design will not be considered herein.

[3] Copyright grants the creator a proprietary right in his artistic expression, be it literary, musical, or visual (see Copyright Act of 1976, 17 U.S.C. § 102(a) (1982) by allowing him or her the exclusive control over the market for the work. The underlying notion is that copyright will serve as an incentive to the creator, and thereby serve its constitutional purpose of promoting “the progress of science and the useful arts.” U.S. Const., Art. I, Sec. 8, Cl.8. A secondary purpose is to reward authors for their contributions to society. *But cf.* Chafee, *Reflections on the Law of Copyright*, 45 Colum. L. Rev., 503, 506–511 (1945) (“The primary purpose of copyright is, of course, to benefit the author.”)

[4] Copyright Act of 1790, 1 Stat. 124 (1790). See also Horowitz, *The Case for the Designer Belt Buckle: The Problem of Copyrighting Utilitarian Objects*, Vol. VI: 3 Art and the Law (1981).

[5] See *infra* text accompanying notes 36–39.

[6] Between 1914 and 1957 nearly 50 design protection bills were introduced, and a number of hearings were held. *Draft, Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, Chap. VII, 4–13 (1975) [hereinafter cited as “Copyright Register’s Report”]; see also *Bibliography on Design Protection Supplement 1976*, 81 (compiled by Copyright Office, listing “Design Copyright Bills Introduced in Congress – 1959–1975”).

[7] See, e.g., Statement of the National Retail Merchants Association on the Subjects of S. 776 Now Before the Sub-Committee of the House Judiciary Committee, January 14, 1964.

[8] This was one of the economic arguments made in the Register’s brief in *Esquire v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978). See *infra* text accompanying notes 44–52.

[9] The pertinent provision states in full:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying music;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works; and
- (7) sound recordings.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102(b). Copyright covers only the expression of the work, not the idea embodied within it. See, e.g., *Baker v. Selden*, 101 U.S. 99 (1879).

[10] Design piracy can be described as follows. A manufacturer who has undertaken the expense of commissioning a designer and producing and marketing a new style, and whose revenue from successful designs must cover his losses from unsuccessful ones, may find that a competitor has copied his prized modes and saturated the market before he, the originator, can dispose of his stock. See Note, *Protection for the Artistic Aspects of Articles of Utility*, 72 Harv. L. Rev. 1520 (1959) [hereinafter cited as "Artistic Aspects"]. See also Dalin, *Design Protection: Walking the Pirate Plank?*, 12 Bull. Cr. Soc. 321, 322 (1964-65). (" '[The design pirate] had no design cost. He doesn't have to pay for stylists [Design pirates] spend no time in the development or promotion of their fabric or design because the success of the pattern and the acceptability of the pattern have already been established by the originator of the pattern. '") (citing Hearings on S. 1884.)

[11] See, e.g., 1 *Nimmer on Copyright* (1980), § 2.08[B], 2-96.3, note 115.1 (responding to the anticompetitive effects which the Register in *Esquire* claimed would occur if copyright were extended to the design of useful objects) [hereinafter cited as "Nimmer"]. See *infra* text accompanying notes 162-167.

[12] H.R. 2985, 98th Cong., 1st Sess. (1983) [hereinafter cited as "Moorhead Bill"]. The bill is currently before the Subcommittee on Courts, Civil Liberties and Administration. As of the date of this comment, no action on the bill has been taken. See *infra* text accompanying notes 85-112 for a discussion of the contents of the bill.

[13] Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543.

[14] 35 U.S.C. § 171 (1982).

[15] See, e.g., *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951) ("[t]he standards for patents and copyrights are basically different"). In 1790, the year after the adoption of the Constitution, the first Congress enacted two statutes, separately dealing with patents and copyrights. The patent statute, enacted April 10, 1790, 1 Stat. 109, provided that patents should be issued only if the Secretary of State, Secretary of War and the Attorney General, or any two of them " 'deem[ed] the invention or discovery sufficiently useful and important' ". *Id.* at 101 (citing Patent Statute). The Supreme Court requires that "to be valid, a patent must disclose a high degree of uniqueness, ingenuity and inventiveness". *Id.* at 100. Copyright, unlike patent, does not protect the author's ideas. See *supra* text accompanying note 8. Nor does it provide the complete monopoly granted by patent. " 'Independent reproduction of a copyrighted ... work is not an infringement,' whereas it is vis-a-vis a patent" 191 F.2d at 103 (citing *Ainstein v. Edward B. Marber Music Corp.* 82 F.2d 275 (2d Cir. 1936)). Thus, " 'original' in reference to a copyrighted work means only that the particular work 'owes its origin' to the author." *Id.* at 102 (citing *Barrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884)).

[16] 35 U.S.C. § 103.

[17] See, e.g., *Brofsky v. General Elec. Corp.*, 396 F.2d 340, 347 (9th Cir. 1968), *cert. denied* 393 U.S. 1031 (1969) (design must be: "(1) new, (2) original, (3) ornamental, (4) nonobvious to a person of ordinary skill in the art, and (5) not primarily for the purpose of serving a functional or utilitarian purpose"); See also, *Application of Rouso*, 222; F.2d 729, (C.C.P.A. 1955).

[18] *Spaulding v. Guardian Light Co.*, 267 F.2d 111, 112 (7th Cir. 1959), *cert. denied* 361 U.S. 883 (1959).

[19] Ringer, *The Case for Design Protection and the O'Mahoney Bill*, 7 Bull. Cr. Soc. n.3(d) at 26.

[20] In upholding copyright in a poster used for advertisement, Justice Holmes stated for the court, "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." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

[21] *Artistic Aspects*, *supra* note 10, at 1523-24.

[22] *Copyright Register's Report*, *supra* note 6, at 187.

[23] 35 F.2d 279 (2nd Cir. 1929), *cert. denied*, 281 U.S. 278 (1930).

[24] *Id.*; see also *Jackson v. Quickslip Co.*, 110 F.2d 731 (creator of a greeting card who attached pair of doll's rubber pants to inside of card did not suffer infringement of copyright when another corporation did likewise because the rubber pants were not within the copyright).

[25] See *supra* note 9.

[26] See 35 U.S.C. § 154.

[27] see e.g. *Arnstein v. Porter*, 154 F. 2d 464 (2d Cir. 1946) *cert. denied*, 330 U.S. 851 (1947).

[28] See 17 U.S.C. § 106(1); see also *Bleistein*, 188 U.S. at 249 ("Others are free to copy the original. They are not free to copy the copy.").

[29] 17 U.S.C. § 102(a).

[30] See 17 U.S.C. § 302(a).

[31] See 35 U.S.C. § 173, as amended August 27, 1982.

[32] 17 U.S.C. § 102(a).

[33] See *supra* text accompanying note 20.

[34] See *supra* note 19.

[35] See *supra* text accompanying note 22.

[36] 347 U.S. 201 (1954).

[37] *Copyright Register's Report*, *supra* note 6, at 4.

[38] 347 U.S. at 217.

[39] *Id.* at 218.

[40] See Horowitz, *supra* note 4, at 3.

[41] *Id.* at 61.

[42] The 1976 Act provides: "[t]he design of a useful article ... shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article". 17 U.S.C. § 101.

[43] 591 F.2d 796, 802–804. *Esquire*, decided before the 1976 Act became effective, nevertheless applied the standard of the new Act. See *infra* text accompanying notes 48–52.

[44] 414 F. Supp. 939, 940 (D.D.C. 1976), *rev'd*, 591 F.2d 796.

[45] 414 F. Supp. at 940.

[46] *Rules and Regulations for the Registration of Claims to Copyright*, Bulletin No. 15 (1910), 8, *quoted in* 414 F.Supp. at 941.

[47] 414 F.Supp. at 941.

[48] H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976), *quoted in* 591 F.2d 796, 803 (emphasis added).

[49] 591 F.2d at 804.

[50] *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

[51] *Syracuse China Corp. v. Stanley Roberts, Inc.*, 180 F. Supp. 527 (S.D.N.Y. 1960). See also H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976).

[52] 591 F.2d at 804.

[53] 632 F.2d 989 (2d Cir.), *rev'd*, 489 F.Supp. 732 (S.D.N.Y. 1980).

[54] Jewelry is subject to copyright protection. See *Boucher v. Du Boyes Inc.*, 253 F.2d 948, 949 (2d Cir.), *cert. denied*, 357 U.S. 936 (1958); *Cynthia Designs, Inc. v. Robert Zentall, Inc.*, 416 F. Supp. 510, 511–12 (S.D.N.Y. 1976); *Trifari, Knussman & Fishel, Inc. v. Cahrel Co.*, 134 F. Supp. 551, 552–53 (S.D.N.Y. 1955). Although the above-cited cases were decided prior to the 1976 Act, they still constitute valid precedents given the congressional adoption at the Copyrights Office's definition. See 632 F.2d at 993–994, n.5.

[55] 632 F.2d at 991–992.

[56] *Id.* at 993.

[57] Horowitz, *supra* note 40, at 62.

[58] As Nimmer stated, *supra* note 11, [Christo's Running Fence] "did not contain sculptural features that were physically separable from the utilitarian aspects of the fence, but the whole point of the work was that the artistic aspects of the work were conceptually separable." Nimmer,

supra note 11 cited in *Kieselstein*, 632 F.2d at 993. (Christo is a well-known conceptual artist. His “Running Fence” was an actual fence, the vertical posts of which were connected with fabric, set up through the hill country of two California counties for purely artistic purposes.)

[59] See *supra* note 48.

[60] 632 F.2d at 993. The *Kieselstein* court stated, “Pieces of applied art, these buckles may be considered jewelry, the form of which is subject to copyright protection.” *Id.*

[61] Nimmer, *supra* note 11, at 2-96, 2-97.

[62] See Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 734 (discussion of various consumer-based models as alternatives to the separability standard).

[63] See *supra* note 48 and accompanying text.

[64] 632 F.2d at 994 (Weinstein, J., dissenting).

[65] *Id.*

[66] For an overview of modern industrial design, see generally K. Baynes, *Industrial Design and the Community* 10–11 (1976); V. Papanek, *Design for the Real World* 22–23 (1971).

[67] W. Cain, *Engineering Product Design* 157 (1979).

[68] 632 F.2d at 994.

[69] 259 F. Supp. 733 (S.D.N.Y. 1966).

[70] 591 F.2d at 802 n.19 (“the registered article – a simulated antique telephone – could be separated physically and exist independently as a work of art apart from the pencil sharpener housed within the telephone casing.”).

[71] See, e.g., *Goldman-Morgen, Inc. v. Dan Brechner & Co., Inc.*, 411 F. Supp. 382 (S.D.N.Y. 1976) (copyright notice on toy bank sufficient to accord the toy protection); *Royalty Designs, Inc. v. Thriftcheck Service Corp.*, 204 F. Supp. 702 (S.D.N.Y. 1962) (same).

[72] See, e.g., *R. Dakin & Co. v. A & L Novelty Co., Inc.*, 444 F. Supp. 1080 (E.D.N.Y. 1978) (stuffed animals with features of pajama bag sufficiently original to receive copyright protection).

[73] Denicola, *supra* note 62 at 738.

[74] *Id.*

[75] See *Bibliography on Design*, *supra* note 6.

[76] During the Hearings on Design Legislation, July 17, 1975, Mr. Alan Latman, who had served as Counsel to the National Committee for Design Legislation, summarized the provisions of Title II as follows:

(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.

Copyright Law Revision Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary, 94th Cong., 1st Sess. (1975), reprinted in *Bibliography on Design*, *supra* note 6, at 92–93.

Mr. Latman testified that he thought Title II should be adopted, stating that “it seeks to afford moderate protection to original, commercially valuable designs which may not be considered ‘inventions’ or works of art; such protection (being) available without undue expense for the smaller manufacturer”. *Id.* at 93.

[77] S.22, 94th Cong., 1st Sess., (1975); see 122 Cong. Rec. S.17, 251 (daily ed. Sept. 30, 1976).

[78] *Copyright Register’s Report*, *supra* note 6, at Ch. VII, 21.

[79] H. Rep. No. 94-1476, 94th Cong. 2d Sess. 50, reprinted in 1976 U.S. Code Cong. & Ad. News 5659, 5663.

[80] *Id.*; see also *Copyright Register’s Report*, *supra* note 6, at ch. VII, 15.

[81] H. Rep. No. 94-1476, *supra* note 79 at 5663.

[82] See *supra* note 6.

[83] See *supra* text accompanying notes 36–74.

[84] Ringer, *The Unfinished Business of Copyright Revision*, 24 U.C.L.A. L. Rev. 951 (1977).

[85] See *supra* note 76.

[86] Moorhead Bill, *supra* note 12.

[87] *Id.* § 901(a).

[88] *Id.* § 901(b)(3). Note that the standard is based on the designer’s intent, rather than the aesthetic or the commercial success of the design. See *supra* note 60.

[89] Moorhead bill § 901(b)(4).

[90] *Id.* § 901(b)(1) (embracing language of Copyright Act of 1976, 17 U.S.C. § 101).

[91] *Id.* § 902(b).

[92] *Id.* § 902(c).

[93] *Id.* § 902(d).

[94] *Id.* § 904. Registration is obtained according to § 912, which states that after applying for registration and payment of the registration fee in accordance with the Act (the normal fee is \$15), “the Administrator shall determine whether or not the application relates to a design which on its face appears to be subject to protection under this chapter, and if so, the Administrator shall register the design. Registration under this subsection shall be announced by publication. The date of registration shall be the date of publication”.

[95] Moorhead Bill, § 905.

[96] *Id.* § 909.

[97] *Id.* § 908(a)(2)(i, ii).

[98] *Id.* § 908(e).

[99] *Id.* § 906(a)(3).

[100] *Id.* § 906(a)(2).

[101] *Id.* § 906(a)(1).

[102] *Id.* § 907.

[103] *Id.*

[104] *Id.* § 914(a), (b).

[105] *Id.* § 934.

[106] *Id.* § 935(e), (f).

[107] *Id.* § 935(e).

[108] *Id.* § 921.

[109] *Id.* § 922(a).

[110] *Id.* § 922(b).

[111] *Id.* § 922(d).

[112] *Id.* § 922(e).

[113] See *supra* note 24.

[114] See *supra* note 76.

- [115] *Id.* (testimony of Latman at Hearings on Design Legislation).
- [116] *See supra* text accompanying notes 13–35.
- [117] *See generally*. The Patents Act, 1949, 12, 13 & 14 Geo. 6 Ch. 87.
- [118] *see* The Registered Designs Act, 1949, 12, 13 & 14 Geo. 6 Ch. 88, § 7.
- [119] Registered Designs Act, 1949, 13 & 14 Geo. 6, Ch. 88, § 1(3).
- [120] *Id.* § 1, 2. *Cf. supra* text accompanying notes 3–5 (description of design patent criteria).
- [121] Registered Designs Act, 1949, 13 & 14 Geo. 6, Ch. 88, § 8.
- [122] *Id.* § 3(1)(5).
- [123] Design Copyright Act, 1968, Ch. 68.
- [124] The Copyright Act, 1956, 4 & 5 Eliz. 2 Ch. 74.

Prior to amendment of the Copyright Act, 1956, by the Design Copyright Act, 1968, industrial designs were excluded from protection under artistic copyright if the designs were, or could have been, registered under the Registered Designs Act 1949. However, designs which could not have been so registered, because for example they were wholly functional, were not excluded from artistic copyright protection The Design Copyright Act 1968 which was a Private Members Bill intended to aid the furniture, toy and costume jewelry industries ... amended the Act in a way which resulted in the extension of artistic copyright to all industrial designs.

Stevenson, *Protection for Industrial Designs under the British Copyright Act 1956*, 8 A.P.L.A. 369, 371 n.13 [hereinafter cited as Stevenson].

- [125] The Copyright Act 1956, § 10, as amended by the Design Copyright Act 1968.
- [126] *See* Stevenson, *supra* note 124, at 371, 372.
- [127] *Id.* at 371 (*citing* Copyright Act, 1956, § 3).
- [128] *Id.* (*citing* *University of London Press Ltd. v. University Tutorial Press Ltd.* 2 Ch. 601, 609).
- [129] *Id.* (*citing* Copyright Act, 1956, § 3(1)(a)).
- [130] *Id.* (*citing* Copyright Act, 1956, § 48).
- [131] *Id.* (*citing* Copyright Act, 1956, § 3(1)(c)).
- [132] *Id.* (*citing* Copyright Act, 1956, § 3(1)(a)).
- [133] *Id.* (*citing* Copyright Act, 1956, § 3(5)(a)).
- [134] *Id.* (*citing* Copyright Act, 1956, § 48).
- [135] *Id.* at 372 (*citing* *Bradbury, Agnew and Co. v. Day* 32 TLR 349, for proposition that re-enactment on stage of a cartoon first published in *Punch* held to be reproduction in a material form). 134.
- [136] *Id.* (*citing* Copyright Act, 1956, § 9 (8)).
- [137] *Id.* (*citing* Copyright Act, 1956, § 49(1)).
- [138] *Id.* (*citing* *British Northrop Ltd. v. Texteam Blackburn Ltd.* 1973 FSR 241). *Compare* *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187 (S.D.N.Y. 1934) (picture of a dress may be copyrighted but the dress itself may not be).
- [139] Copyright Act 1956, § 3, defines artistic works as follows:

- (I) In this Act “artistic work” means a work of any of the following descriptions, that is to say,
 - (a) the following, irrespective of artistic quality, namely paintings, sculptures, drawings, engravings and photographs;
 - (b) works of architecture, being either buildings or models for buildings;
 - (c) works of artistic craftsmanship, not falling within either of the preceding paragraphs.

[140] 1963 VR 719.

[141] Copyright Statute “An Act relating to copyright and for other purposes”, Number 63, June 27, 1968.

[142] *Cuisenaire*, *supra* note 140 at 730.

[143] See *supra* text accompanying note 138.

[144] See *supra* note 7.

[145] See, e.g., Baillie, *Design Copyright Protection in the United Kingdom*, 15 Int'l Lawyer 92 (1981); Cornish, *Cumulative Protection for Industrial Designs*, 8 U. Brit. Col. L. Rev. 219 (1973).

[146] See *Merchant Adventurers v. M. Grew*, (1972) 1 Ch. 242.

[147] See *P.S. Johnson and Associates Ltd. v. Bucko Enterprises Ltd. and Others*, (1975) 1 N.Z.L.R. 311.

[148] See *British Leyland Motors Corp. Ltd. v. Wyatt Interpart Co., Ltd.*, (1979) FSR 583.

[149] Baillie, *supra* note 144, at 101.

[150] See, e.g., *Hoover P.L.C. v. George Hulme (Sto) Ltd. and another*, (1982) FSR 565, (1982) 3 Common Mkt. L.R. 186 (manufacturer of spare parts held not to have infringed on plaintiff's copyright in the design of the parts). This is contrary to the established view that "copyright does exist in drawings for spare parts, that copy spares do infringe and that there is no implied license for a third party to manufacture spares on a speculative basis." Victoria, *Patents Trade Marks, Copyright*, (1982) J. Bus. L. 518, 520.

[151] Registered Designs Act, 1949 (Ch. 88) § 8(2). The Act provides for an initial five-year term, *id.* § 8(1), which may be renewed twice. The design registration term is shorter than the copyright term of life of the creator plus fifty years, in order to avoid simultaneous protection under both systems. Thus if a design has been "industrially applied" and either is or could have been registered under the Registered Designs Act, the registered design term of protection will apply in place of the copyright term.

Designs which do not qualify for registration (perhaps because they are not novel, or are functional) gain longer protection than those that do. And while this longer period of protection is admittedly against copying alone, and not against independent but similar creations, the result is likely to seem anomalous to anyone who thinks that the real danger to a designer in practice is plagiarism.

... Designers commonly feel that it is against pirates that they deserve protection, and this may be one explanation of the suspicion that to make copyright available would in practice render the registration system redundant.

Cornish, *supra* note 144, at 127, 128.

This argument is especially relevant to determining what the duration of the initial design copyright term should be. See *supra* text accompanying note 116. If, as suggested, designers are most concerned about plagiarism, the more extensive monopoly offered by the design patent would be superfluous.

[152] (1975) 1 N.Z.L.R. 311.

[153] Crew, *Undesirable in Theory, Absurd in Practice – The Protection of Industrial Design in England and New Zealand*, 2 Auckland U.L. Rev. No. 4, 1, 10 (1974).

[154] *Id.* (citing Sunday News, 21 July, 1979).

[155] See *supra* text accompanying notes 67–69.

[156] Moorhead Bill § 901(a).

[157] *Id.* § 901(b)(3).

[158] *Id.* § 902(b). Besides the safeguards provided by the bill, U.S. copyright law also sets minimum, albeit modest, standards for creativity, which the proposed amendment makes no mention of lowering. See, e.g., *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945). (The author must add "some substantial, not merely trivial, originality.")

[159] See *supra* note 9 and accompanying text.

[160] See Crew, *supra* note 152 at 12.

[161] See Nimmer, *supra* note 11, at 2-96.3.

[162] See 591 F. 2d at 801 n.15 (citing Register's Brief).

[163] *Id.*

[164] *Id.*

[165] *See* Nimmer, *supra* note 11, at 2-96.

[166] *See* 591 F.2d at 801 n. 15.

[167] *See* Nimmer, *supra* note 6, at 2-96.

[168] Moorhead Bill § 902(b).

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