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# I'm a Little Treepot: Conceptual Separability and Affording Copyright Protection to Useful Articles

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## I'M A LITTLE TREEPOT: CONCEPTUAL SEPARABILITY AND AFFORDING COPYRIGHT PROTECTION TO USEFUL ARTICLES

*Sonja Wolf Sahlsten*\*

### Abstract

To determine if a useful article—generally ineligible for copyright protection—has pictorial, graphic, or sculptural features that are copyrightable, the Copyright Act and the legislative intent expressed through the Act's legislative history require that those artistic features be identified separately and capable of existing independently of the utilitarian function of the work. If the artistic features are either physically or conceptually separable from the utilitarian function of the work, then they are copyrightable. However, determining if artistic features are conceptually separable from the utilitarian function of the work has proven to be extremely difficult.

Since *Mazer v. Stein*, the U.S. Supreme Court's only decision in this area, courts and scholars have created more than eight different tests for conceptual separability. Some of these tests are entirely inconsistent with the Copyright Act and its purpose; others are overly abstract or difficult to apply; still others require judges to make subjective determinations of artistic worth. As a result, one court may find a work copyrightable, and another court may find the same work uncopyrightable depending on the test applied.

To address these and other problems facing those seeking copyright protection for artistic features of useful articles, this Note proposes a test for conceptual separability that is based on an ordinary, reasonable observer standard and that provides factors to guide the fact-finder's inquiry. This Note's proposed test for conceptual separability is whether an ordinary, reasonable observer can perceive aesthetic features separate from the article's utilitarian function. In performing this analysis, the factors that the fact-finder may consider fall into three main categories: (1) objective indicia of public perception; (2) use of the work separate from function; and (3) marketability information. This suggested test is consistent with the Copyright Act, simplifies conceptual separability analysis, and provides much needed clarity for copyrightability in the area of useful articles.

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## INTRODUCTION

“Of the many fine lines that run through the Copyright Act, none is more troublesome than the line between protectible pictorial, graphic and sculptural works and unprotectible utilitarian elements of useful articles.”<sup>1</sup> The Copyright Act affords copyright protection to pictorial, graphic, and sculptural works,<sup>2</sup> but expressly denies copyright protection to any mechanical or utilitarian aspects of these works.<sup>3</sup> To illustrate the difficulty of drawing this troublesome line, consider the following three works and their potential for obtaining copyright protection. First, envision an intricate tabletop sculpture of a tree. The handmade, ceramic tree sculpture has a hollow trunk, intertwining branches, and detailed bark. Second, imagine an ordinary ceramic teapot. Intuition and the law would conclude that the tree sculpture is copyrightable and that the simple ceramic teapot is not. Now, consider a third work—the same tree sculpture except that one of the branches is now a handle and another is now the spout for a teapot that holds liquid in the trunk. How does one determine if the tree teapot, or “treepot,” is copyrightable? Should copyright protection be unavailable for the work because it is a useful article, or is there something about the work that should be protectable? If a competitor made an exact replica of the treepot and sold it in the same market at a lower price, would the original artist have any recourse?

The Copyright Act stipulates that for the treepot to be copyrightable, it must have pictorial, graphic, or sculptural features “that can be identified separately from, and are capable of existing independently of, the utilitarian” tea-holding “aspects of the article.”<sup>4</sup> The legislative history of the Copyright Act adds that artistic elements that are physically or conceptually separable from the utilitarian aspects of the article are eligible for copyright protection.<sup>5</sup> Therefore, since the

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1. 1 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.5.3 (3d ed. 2005).

2. 17 U.S.C. §§ 101–02 (2012).

3. *Id.* Mechanical and utilitarian creations fall under the ambit of patent law and are entitled to patent protection if they meet the requirements of utility, novelty, and non-obviousness. 35 U.S.C. §§ 101–03. Although a utility patent offers robust protection for the utilitarian function of a work, a utility patent will not cover aesthetic features of that work. *See id.* § 101. Design patents are more likely to provide some protection for aesthetically pleasing useful articles because design patents are issued for “new, original and ornamental design[s]” of articles of manufacture. *Id.* § 171. However, to receive a design patent, the design must be “*primarily* ornamental” and not dictated primarily by functional considerations. *See* L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) (emphasis added). Thus, if functional considerations largely or entirely dictate the overall design of the work, as with many useful articles, then it will not receive design patent protection. *See id.* Consequently, copyright protection often represents the best protection for artistic features of useful articles.

4. *See* 17 U.S.C. §§ 101–02.

5. H.R. REP. NO. 94-1476, at 55 (1976).

treepot's sculptural features cannot be physically separated from the work, the copyrightability of the treepot turns on whether its artistic sculptural elements are conceptually separable from its utilitarian function. Unfortunately, courts and scholars have advanced more than eight inconsistent tests for conceptual separability, ranging from tests that egregiously violate the intention and focus of the Copyright Act to tests that are too abstract or impractical to apply. As a result, one court may find the sculptural aspects of the treepot copyrightable, but another may not, depending on which test the court applies.

Part I of this Note focuses on copyright protection for useful articles before the 1976 Copyright Act by examining the evolution of earlier versions of the Copyright Act, the contributions of Copyright Office regulations, and the role of the U.S. Supreme Court. Part II explores the codification of the conceptual separability standard in the 1976 Copyright Act and that Act's legislative history.

Part III discusses the various tests for conceptual separability developed and modified by the U.S. Court of Appeals for the Second Circuit, the most active Circuit in the area of conceptual separability. Part IV focuses on the additional tests for conceptual separability that legal scholars and courts outside of the Second Circuit have created. In both Parts III and IV, each test is thoroughly discussed, analyzed, and critiqued based on its consistency with the Copyright Act, its legislative intent, and general concepts of copyright law.

Part V explains how each of the existing tests for conceptual separability either strays from the Copyright Act by misapplying conceptual separability, creates confusion by omitting guidance on how to apply the test, or both. With the Supreme Court silent in this area since 1954, the state of conceptual separability analysis is in need of reexamination and simplification. Part VI of this Note proposes a test for conceptual separability that is based on an ordinary, reasonable observer standard and that gives the fact-finder factors to guide the inquiry. The proposed test for conceptual separability is whether an ordinary, reasonable observer can perceive aesthetic features separate from the article's function. In this analysis, the factors that the fact-finder may consider fall into three main categories: (1) objective indicia of public perception; (2) use of the work separate from function; and (3) marketability information. The proposed test is consistent with the Copyright Act, simplifies conceptual separability analysis, and clarifies copyrightability in the area of useful articles.

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## I. COPYRIGHT PROTECTION FOR USEFUL ARTICLES BEFORE THE 1976 COPYRIGHT ACT

By 1909, after a series of amendments to the Copyright Act, Congress eliminated the old “fine arts” requirement and paved the way for granting copyright protection to useful articles.<sup>6</sup> However, the Copyright Office, which writes regulations interpreting the Copyright Act, was reluctant to abandon the “fine arts” limitation and did not eliminate it until 1948.<sup>7</sup> Soon after, the Supreme Court considered the issue of copyrightability of useful articles in *Mazer v. Stein*<sup>8</sup> and determined that an otherwise copyrightable work does not lose its copyright protection if incorporated into a useful article.<sup>9</sup> The Copyright Office responded to this ruling and created the separability standard in its next round of regulations.<sup>10</sup>

### A. *The Copyright Act—Broadening the Scope of Copyright Protection*

The ambiguity surrounding the copyrightability of useful articles began with a series of additions to copyrightable subject matter in the Copyright Act. The first Copyright Act, enacted in 1790, allowed copyright protection for maps, books, and charts.<sup>11</sup> In 1802, Congress extended coverage to “historical or other print[s],”<sup>12</sup> and it afforded photographs protection in 1865.<sup>13</sup> Congress gave three-dimensional statues and models or designs “intended to be perfected and executed as a work of the fine arts” protection in 1870—the first time it extended copyright protection beyond two-dimensional works.<sup>14</sup> Although recognizing copyright protection for three-dimensional objects opened the door for copyright protection of useful articles,<sup>15</sup> the 1870 amendment’s emphasis on “fine arts” allowed the door to open no more than a crack.

The 1909 Copyright Act eliminated the “fine arts” language and broadened the scope of copyright protection to include all “[w]orks of

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6. Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075, 1077 (amended 1976).

7. See 37 C.F.R. § 202.8 (1949).

8. 347 U.S. 201 (1954).

9. *Id.* at 218.

10. 37 C.F.R. § 202.10(c) (1960).

11. Act of May 31, 1790, ch. 15, 1 Stat. 124, 124 (current version at 17 U.S.C. §§ 101–805 (2012)).

12. Act of Apr. 29, 1802, ch. 36, 2 Stat. 171, 171 (repealed 1831).

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

14. Act of July 8, 1870, ch. 230, 16 Stat. 198, 214 (repealed 1909).

15. Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC’Y 339, 341–42 (1990).

art; models or design for works of art.”<sup>16</sup> With this amendment, Congress broadened copyright beyond the purely aesthetic and formally allowed protection for useful articles.<sup>17</sup> Even though nothing in the 1909 Copyright Act barred protection for useful articles, the Copyright Office<sup>18</sup> quickly issued regulations to exclude useful articles from copyright protection and to reestablish the “fine arts” limitation explicitly abandoned by Congress in the 1909 Copyright Act.

### B. Copyright Office Regulations—The Slow Death of the “Fine Arts” Limitation

In 1910, the Copyright Office issued regulations that defined “works of art” as “all works belonging fairly to the so-called fine arts.”<sup>19</sup> The regulations also expressly prohibited copyright protection for “[p]roductions of the industrial arts utilitarian in purpose and character” despite the presence of artistic designs or features.<sup>20</sup> These regulations narrowed the scope of the Copyright Act by reintroducing the “fine arts” limitation that Congress had just removed in the 1909 Act.<sup>21</sup> However, while the 1910 regulations were in effect, the Copyright Office allowed registration of utilitarian objects such as candlesticks, inkstands, ashtrays, clocks, and saltshakers,<sup>22</sup> but none of these registrations were compliant with the Copyright Office’s rigid traditional “fine arts” standard.<sup>23</sup>

Possibly recognizing that courts were not applying its 1910 regulations, or that the regulations were impracticable to apply, the Copyright Office amended the regulations in 1917 to allow copyright protection for “artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.”<sup>24</sup> Although the Copyright Office moved a step closer to the broader language of the Copyright Act, it was not until 1948 that the Copyright Office officially abandoned

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16. Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075, 1077 (amended 1976).

17. Perlmutter, *supra* note 15, at 342.

18. The Copyright Office and its director, the Register of Copyrights, are responsible for all administrative functions and duties under the Copyright Act. 17 U.S.C. § 701 (2012). The Register of Copyrights is also authorized to establish regulations consistent with the Copyright Act. *Id.* § 702.

19. COPYRIGHT OFFICE, BULL. NO. 15, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT 8 (1910).

20. *Id.*

21. *See id.*

22. Perlmutter, *supra* note 15, at 342 (citing *Mazer v. Stein*, 347 U.S. 201, 221 (1954) (Douglas, J., dissenting)).

23. *See* COPYRIGHT OFFICE, *supra* note 19, at 8.

24. COPYRIGHT OFFICE, BULL. NO. 15, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT 9 (1917).

the “fine arts” limitation.<sup>25</sup> In its new regulation, the Copyright Office defined “[w]orks of art” as “works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings, and sculpture.”<sup>26</sup> With this regulation, nearly forty years after Congress eliminated the “fine arts” requirement with the 1909 Act,<sup>27</sup> the Copyright Office finally removed the “fine arts” limitation and ceased its efforts to confine copyright protection in this area.

### C. *The Supreme Court Addresses Copyright of Artistic Designs in Useful Articles*

In 1954, the Supreme Court made its first and, to this date, only venture into the statutory and administrative fold of copyright protection for useful articles in *Mazer v. Stein*.<sup>28</sup> The works at issue in *Mazer* were china statuettes of male and female dancers for use as lamp bases in conjunction with lampshades, electrical wiring, and sockets.<sup>29</sup> The plaintiff who manufactured the lamp submitted the statuettes, without the other lamp components attached, to the Copyright Office for registration as “works of art,” and was granted certificates of copyright registration.<sup>30</sup> Although the manufacturer sold a negligible number of statuettes without the lamp components, the overwhelming majority of the manufacturer’s profits were from sales of the statuette in the functional lamp assembly.<sup>31</sup> The plaintiff brought suit against competing manufacturers who copied the statuettes without permission and sold their own lamps featuring the copied statuettes.<sup>32</sup>

The Supreme Court framed the issue as follows: “Can statuettes be protected . . . when the copyright applicant intended primarily to use the statuettes in the form of lamp bases . . . ?”<sup>33</sup> In holding that the statuettes were copyrightable, the Court looked to the evolution of the Copyright Act, the legislative history of the 1909 Act, and the Copyright Office regulations as confirmation that the change in scope from “works of the fine arts” to “works of art” was intended to allow copyright protection for works of this nature.<sup>34</sup> The Court endorsed the

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25. See 37 C.F.R. § 202.8 (1949).

26. *Id.*

27. See Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075, 1077 (current version at 17 U.S.C. § 102 (2012)).

28. 347 U.S. 201 (1954).

29. *Id.* at 202.

30. *Id.* at 202–03.

31. *Id.* at 203.

32. *Id.*

33. *Id.* at 204–05.

34. *Id.* at 213–14.



move away from the “fine arts” limitation and cautioned that “[i]ndividual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.”<sup>35</sup> Finally, the Court determined that there was “nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration.”<sup>36</sup>

In *Mazer*, the Supreme Court established that an otherwise copyrightable work does not lose its protection when incorporated into a useful article.<sup>37</sup> However, the Court did not offer guidance on how to determine when and what elements of useful articles are copyrightable.<sup>38</sup> The task of providing this guidance, taken on by the lower courts and the Copyright Office, has generated inconsistent regulations, tests, standards, and decisions.

#### D. Copyright Office Regulations Post-*Mazer*—Origins of the Separability Standard

In 1960, the Copyright Office authored a regulation to comply with its understanding of the new Supreme Court precedent in *Mazer* while still intending to exclude the broad realm of industrial design from copyright protection.<sup>39</sup> This 1960 regulation contained limitations not found in the *Mazer* opinion:

If the sole intrinsic function of an article is its utility the fact that the article is unique and attractively shaped will not qualify it as a work of art. However if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving or pictorial representation which can be *identified separately* and are *capable of existing independently* as a work of art, such features will be eligible for registration.<sup>40</sup>

This regulation, which established what came to be known as the separability standard, introduced new complexities into the increasingly

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35. *See id.* at 214.

36. *Id.* at 218.

37. *Id.*

38. *See id.*

39. After *Mazer*, the Copyright Office consistently maintained that copyright protection was inappropriate for the overall design of industrial products. *See* Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 715, 717 (1983). The typical argument against extending copyright protection to industrial design is that doing so would remove the design from the public domain and confer a monopoly to the manufacturer. *See id.* at 722. According to opponents of copyright protection for industrial design, this type of monopoly, and the competitive advantage it provides, should only be afforded to patent holders. *See id.* at 722 & n.84.

40. 37 C.F.R. § 202.10(c) (1960) (emphasis added).

unclear area of copyright protection for useful articles. First, this regulation required a determination of the “sole intrinsic function” of an article<sup>41</sup>—an inquiry entirely created by the Copyright Office and addressed by neither the Copyright Act nor the Supreme Court.<sup>42</sup>

Most importantly, the regulation went beyond the holding of *Mazer*—that otherwise copyrightable works do not lose protection if incorporated into a useful article<sup>43</sup>—and articulated a specific standard to determine when an artistic feature of a useful article may be eligible for copyright protection.<sup>44</sup> This new regulation would afford copyright protection to artistic features of useful articles that could be “identified separately and [were] capable of existing independently” of the article’s utilitarian function.<sup>45</sup> However, the regulation did not define “identified separately” or “existing independently,” nor did it offer guidance on how to make these factual determinations.<sup>46</sup>

## II. CODIFYING THE SEPARABILITY STANDARD FOR COPYRIGHTABILITY OF USEFUL ARTICLES: THE 1976 COPYRIGHT ACT AND ITS LEGISLATIVE HISTORY

Congress formally codified the Copyright Office’s regulations setting out the separability standard in the 1976 Copyright Act.<sup>47</sup> The path to its codification warrants an examination of the Act’s legislative history and the intent of the Congress that passed the 1976 Copyright Act. At the request of Congress in the late 1950s, the Copyright Office assessed the state of copyright law in preparation for comprehensive reform of the 1909 Copyright Act.<sup>48</sup> In 1961, the Register of Copyrights reported the findings of the Copyright Office to Congress.<sup>49</sup> On the topic of copyright of useful articles, the Register acknowledged *Mazer*’s approval of copyright protection for works of art incorporated in useful articles but cautioned against “extend[ing] the copyright law to industrial design[.]”<sup>50</sup> Instead of using copyright law, the Register

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41. *Id.*

42. Perlmutter, *supra* note 15, at 346; see Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075, 1077 (current version at 17 U.S.C. § 102 (2012)); *Mazer*, 347 U.S. 201.

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

44. See 37 C.F.R. § 202.10(c).

45. Perlmutter, *supra* note 15, at 346 (quoting 37 C.F.R. § 202.10(c)).

46. See *id.* at 346.

47. See 17 U.S.C. § 101 (1976).

48. See Denicola, *supra* note 39, at 717–18.

49. STAFF OF H. COMM. ON THE JUDICIARY, 87TH CONG., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 14–15 (Comm. Print 1961) [hereinafter REPORT OF THE REGISTER OF COPYRIGHTS].

50. *Id.* at 13. See *supra* note 39 for an explanation of the Copyright Office’s opposition to expanding copyright protection to industrial design.

proposed enacting separate industrial design legislation that would grant the design of useful articles *sui generis* protection.<sup>51</sup>

The Senate's design protection effort based on the Register's recommendations appeared in Title II of the general copyright revision bill and provided protection for the "original ornamental design of a useful article"<sup>52</sup> but excluded designs "dictated *solely* by a utilitarian function of the article."<sup>53</sup> Title II, known as the Design Protection Act of 1975,<sup>54</sup> passed the Senate but not the House.<sup>55</sup> The House rejected Title II, in part, because the *sui generis* protection it granted "could not truly be considered copyright protection and therefore appropriately within the scope of copyright revision."<sup>56</sup>

Upon rejecting the Copyright Office's suggested *sui generis* protection approach to useful articles, Congress codified the Copyright Office's existing regulations, including its separability standard, in the 1976 Copyright Act.<sup>57</sup> This Act, as amended, is the current copyright law of the United States.<sup>58</sup> Section 102(a) of the Copyright Act affords copyright protection to categories of "works of authorship," including "pictorial, graphic, and sculptural works."<sup>59</sup> By replacing the "works of art" classification of the 1909 Copyright Act with the "pictorial, graphic, and sculptural works" category, Congress sought to end copyright's typical association with the fine arts.<sup>60</sup> Section 101, which defines "[p]ictorial, graphic, and sculptural works," states:

Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be *identified separately from, and are capable of existing independently of,* the utilitarian aspects of the article.<sup>61</sup>

With this definition, Congress formally adopted the Copyright Office's regulations of the 1950s and 1960s granting protection to

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51. REPORT OF THE REGISTER OF COPYRIGHTS, *supra* note 49, at 13, 16.

52. 122 CONG. REC. S3856-59 (1976) (daily ed. Feb. 19, 1976).

53. *Id.* at 3856-57 (emphasis added).

54. *Id.* at 3859.

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

56. *Id.*

57. 17 U.S.C. § 101 (1976).

58. 17 U.S.C. §§ 101-805 (2012).

59. *Id.* § 102(a)(5).

60. *Id.* § 101.

61. *Id.* § 101 (emphasis added).

elements of useful articles capable of being “identified separately” from and “existing independently” of the useful article.<sup>62</sup> The 1976 Copyright Act’s most significant deviation from the Copyright Office’s regulations relates to the definition of “useful article.” Section 101 of the 1976 Copyright Act defines “useful article” as “an article having an intrinsic utilitarian function,”<sup>63</sup> and deletes the word “sole” contained in the Copyright Office regulation.<sup>64</sup> This change broadens the scope of useful articles from works that have *exclusive* utilitarian function to works that have *any* utilitarian function, thereby narrowing the scope of copyright protection by subjecting more works to the separability standard.<sup>65</sup>

Although the Copyright Act defines neither “identified separately” nor “existing independently,”<sup>66</sup> the legislative history of the Copyright Act provides some guidance on what these terms, which the Copyright Office created but never defined,<sup>67</sup> may mean. For example, Congress clarified that two-dimensional paintings and three-dimensional statues incorporated into useful articles can still exist independently as works of art and, therefore, do not lose their copyright protection.<sup>68</sup> However, the Legislature made clear that it intended to exclude industrial design from protection regardless of any aesthetically pleasing features.<sup>69</sup> The House Report articulated this intent as follows:

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 . . . 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.<sup>70</sup>

The most significant contribution of this report was the prospect that an element not physically separable, but merely conceptually separable

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62. 37 C.F.R. § 202.10(c) (1960).

63. 17 U.S.C. § 101.

64. Perlmutter, *supra* note 15, at 350 (noting the difference between the 1976 Copyright Act and the language found in 37 C.F.R. § 202.10(c) (1960)). Compare 17 U.S.C. § 101 (“A ‘useful article’ is an article having an *intrinsic utilitarian function* that is not merely to portray the appearance of the article or to convey information.” (emphasis added)), with 37 C.F.R. § 202.10(c) (“If the *sole intrinsic function* of an article is its utility the fact that the article is unique and attractively shaped will not qualify it as a work of art.” (emphasis added)).

65. Perlmutter, *supra* note 15, at 350.

66. See 17 U.S.C. § 101.

67. See *supra* notes 45–46 and accompanying text.

68. H.R. REP. NO. 94-1476, at 55 (1976).

69. *Id.*

70. *Id.* (emphasis added).

from the useful article, could be copyrightable.<sup>71</sup> This language about conceptual separability has spawned different interpretations of the separability standard and led to the development of a multitude of tests across the Circuit Courts of Appeal and among legal scholars.

### III. THE SECOND CIRCUIT—CREATING TESTS FOR CONCEPTUAL SEPARABILITY AND EVOLVING TO THE *BRANDIR* TEST

The Second Circuit has been the most active in interpreting the statutory language and legislative intent of the separability standard in the 1976 Copyright Act.<sup>72</sup> In the process, the Second Circuit has created, modified, and recreated tests for conceptual separability.<sup>73</sup> What follows is an explanation of the evolution to the *Brandir* test, the Second Circuit's current standard and a leading test for conceptual separability. Although some of the Second Circuit's early separability analysis was fairly consistent with the Copyright Act and its legislative intent, the Circuit's current approach to conceptual separability is a process-based test that improperly focuses on the designer's motivation, intent, and process rather than on the final work as the Copyright Act and its legislative intent require. The test for conceptual separability that this Note proposes is devoid of any process-based determinations and properly focuses the conceptual separability analysis on the work and its features.

#### A. Kieselstein-Cord: *The "Primary" Versus "Subsidiary" Standard*

In 1980, the Second Circuit first took up the issue of separability under the 1976 Copyright Act in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, holding that two decorative belt buckles were copyrightable.<sup>74</sup> The belt buckles at issue were not ordinary buckles confined to the purpose of securing pants around the wearer's waist; rather, they were sculpted designs made of precious metals that wearers displayed as ornamental jewelry separate from the belt.<sup>75</sup> The manufacturer registered the buckles with the Copyright Office as "jewelry," but the certificate that the Copyright Office issued listed the buckles as "original sculpture and design."<sup>76</sup>

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71. *Id.*

72. *See, e.g.,* *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987); *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411 (2d Cir. 1985); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980).

73. *See, e.g.,* *Brandir*, 834 F.2d at 1144; *Barnhart*, 773 F.2d at 418; *Kieselstein-Cord*, 632 F.2d at 993.

74. *Kieselstein-Cord*, 632 F.2d at 993.

75. *Id.* at 990.

76. *Id.* at 990–91.

In subsequent infringement litigation, a manufacturer selling copies of the belt buckles argued that the buckles could not be protected by copyright because they were useful articles without any features that could be identified separately from, or capable of existing independently of, the utilitarian aspects of the buckles.<sup>77</sup> The district court agreed and held that the copyrights were invalid because they “fail[ed] to satisfy the test of separability and independent existence of the artistic features.”<sup>78</sup>

At issue before the Second Circuit was whether the buckles were copyrightable.<sup>79</sup> The court acknowledged that the task of determining when a pictorial, graphic, or sculptural feature “can be identified separately from, and [is] capable of existing independently of, the utilitarian aspects of the article”<sup>80</sup> is difficult because either physical or conceptual separability can satisfy the separability requirement.<sup>81</sup> In response to the defendant’s argument that physical separability is required and conceptual separability is insufficient, the court stated that such an interpretation “flies in the face of the legislative intent” that specifically allows physical *or* conceptual separability to satisfy the standard.<sup>82</sup>

In holding that the belt buckles had conceptually separable sculptural elements, the court was influenced by evidence that the buckle wearers used the buckles for ornamentation on parts of the body other than the waist.<sup>83</sup> The court continued that, “[t]he primary ornamental aspect of the . . . buckles is conceptually separable from their subsidiary utilitarian function.”<sup>84</sup> Thus, the *Kieselstein-Cord* standard that developed is also known as the “primary/subsidiary test for conceptual separability.”<sup>85</sup>

The Second Circuit created this “primary ornamental aspect” and “subsidiary utilitarian function” language as a test for conceptual separability but did not define the terms in the opinion.<sup>86</sup> The primary versus subsidiary distinction was also not founded in the Copyright Act or its legislative history.<sup>87</sup> Moreover, courts and commentators have

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77. *Id.* at 991–92.

78. *Id.* at 991 (alteration in original) (quoting 17 U.S.C. § 101 (1980)).

79. *Id.*

80. 17 U.S.C. § 101 (2012).

81. *Kieselstein-Cord*, 632 F.2d at 993 (citing H.R. REP. NO. 94-1476, at 55 (1976)).

82. *Id.*

83. *Id.*

84. *Id.*

85. Barton R. Keyes, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L.J. 109, 123 (2008); see *Kieselstein-Cord*, 632 F.2d at 993.

86. See *Kieselstein-Cord*, 632 F.2d at 993.

87. See Perlmutter, *supra* note 15, at 359.

criticized the standard for failing to provide guidance on how to make the primary versus subsidiary determination and for leaving many other questions unanswered, including how to determine which aspects are primary or subsidiary and how much the ornamental aspect must dominate the utilitarian function to be conceptually separable.<sup>88</sup>

This Note advances a test that incorporates a portion of the primary/subsidiary test in its second factor. This factor, which considers the use of the work separate from function, allows inquiry into the extent that any ornamental aspects of the work are prominent enough to create an alternate use of the work exclusively as art. This factor of the proposed test provides a list of relevant indications that the work has an alternate use as art and, therefore, avoids some of the criticism facing the vague *Kieselstein-Cord* test.

#### B. Barnhart: *The “Wholly Unnecessary” and “Inextricably Intertwined” Standards*

The Second Circuit had a chance to revisit copyright protection for artistic features of useful articles five years after *Kieselstein-Cord* in *Carol Barnhart Inc. v. Economy Cover Corp.*, where the court, applying a variation of its own conceptual separability test, found that four mannequins of partial human torsos used for displaying clothing were not copyrightable.<sup>89</sup> The mannequins at issue, created by plaintiff Barnhart, were two female and two male life-size torsos—one of each nude and one of each clothed with a shirt.<sup>90</sup> Barnhart applied for copyright registration of the pieces as “sculptures,” and the Copyright Office approved the application.<sup>91</sup> In an action for copyright infringement against a manufacturer of substantially similar mannequins, the district court determined that the Barnhart mannequins had no aesthetic features that could exist physically or conceptually separate from the mannequins as useful articles and were, therefore, not copyrightable.<sup>92</sup>

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88. See *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 421 (2d Cir. 1985) (Newman, J., dissenting) (criticizing the “primary” versus “subsidiary” standard for not providing enough guidance to the trier of fact to determine what constitutes the “primary ornamental aspect” and the “subsidiary utilitarian function”); Thomas M. Byron, *As Long as There’s Another Way: Pivot Point v. Charlene Products as an Accidental Template for a Creativity-Driven Useful Articles Analysis*, 49 IDEA 147, 179 (2008) (further explaining how the test allows judges to insert their artistic judgment into the analysis in direct opposition to the mandate keeping judges out of the role of art critic); Keyes, *supra* note 85, at 123–24 (suggesting that the test’s lack of detail would allow judges to use their own personal biases regarding art in the conceptual separability analysis); Perlmutter, *supra* note 15, at 359 (pointing out a number of questions the court left unanswered, including the hypothetical situation where the ornamental and utilitarian aspects are equal).

89. *Barnhart*, 773 F.2d at 418 (majority opinion).

90. *Id.* at 412.

91. *Id.* at 413.

92. *Id.* at 414.

On appeal, the Second Circuit noted that since the mannequins were concededly useful articles, the remaining copyrightability issue was whether they possessed aesthetic or artistic features that were physically or conceptually separable from their utilitarian function.<sup>93</sup> Instead of applying the “primary” versus “subsidiary” standard that it created in *Kieselstein-Cord*,<sup>94</sup> the court quoted the “primary” and “subsidiary” language in passing<sup>95</sup> and simply concluded that the artistic features were both physically and conceptually inseparable from the utilitarian purpose of displaying clothing.<sup>96</sup> The court explained the distinction between the belt buckles in *Kieselstein-Cord* and the mannequins in *Barnhart* as follows:

[T]he ornamented surfaces of the buckles were not in any respect required by their utilitarian functions; the artistic and aesthetic features could thus be conceived of as having been added to, or superimposed upon, an otherwise utilitarian article. The unique artistic design was *wholly unnecessary* to performance of the utilitarian function. In the case of the Barnhart forms, on the other hand, the features claimed to be aesthetic or artistic . . . are *inextricably intertwined* with the utilitarian feature, the display of clothes.”<sup>97</sup>

Although briefly quoting *Kieselstein-Cord*, the Second Circuit actually articulated a new, more stringent standard by requiring that the artistic elements be “wholly unnecessary” to the utilitarian function of the article.<sup>98</sup> Commentators have characterized this as an objective test<sup>99</sup> that finds conceptual separability if the article’s utilitarian function does not require the aesthetic features of a useful article.<sup>100</sup> Conversely, if the function of the article mandates the artistic and aesthetic features, the features are neither conceptually separable nor copyrightable.<sup>101</sup> Some scholars have praised the test for being objective enough to reduce opportunities for judges to inject their ideas and opinions of art into the conceptual separability analysis.<sup>102</sup>

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93. *Id.*

94. *See supra* notes 84–86 and accompanying text.

95. *See Barnhart*, 773 F.2d at 419.

96. *Id.* at 418.

97. *Id.* at 419 (emphasis added).

98. Perlmutter, *supra* note 15, at 362.

99. *See* Keyes, *supra* note 85, at 138.

100. *See id.* (citing *Barnhart*, 773 F.2d at 419).

101. *See id.* at 125 (citing Nathan C. Rogers, *Copyright Protection: A Dead Fish for Sculptors of Taxidermy Mannequins?*, 6 J. INTEL. PROP. L. 159, 167 (1998)).

102. *See, e.g.,* Keyes, *supra* note 85, at 138.



However, this new standard, like the one it modified, is not defined or established in the Copyright Act or the Act's legislative history.<sup>103</sup> Furthermore, "inextricably intertwined" is new language without precedent, and the *Barnhart* decision provides no guidance on how to determine when function dictates an artistic feature of a useful article.<sup>104</sup> The test does not allow for consideration of how much, or in what ways, function dictates the artistic features.<sup>105</sup> By not allowing for this type of quantitative or qualitative consideration, the court determined that if function requires a design element at all, it is not conceptually separable and, therefore, not copyrightable.<sup>106</sup> Some judges and scholars have also criticized the test for being a test of physical separability rather than conceptual separability.<sup>107</sup> "Inextricably intertwined" is too high of a hurdle for copyrightability because artistic features will most likely only escape inextricable intertwinement with the useful functions if they are physically separable as well.<sup>108</sup>

The test this Note proposes focuses on an ordinary observer's perception of the work. It utilizes a standard that is truly one of conceptual separability and avoids unintentionally crossing the boundary to physical separability. It is also structured to avoid being more rigorous than the Copyright Act intended.

### C. Judge Newman Dissenting in *Barnhart*: The Ordinary, Reasonable Beholder Standard

Judge Jon Newman's insightful dissent in *Barnhart* examined the meaning of conceptual separability, surveyed the various possible standards for determining conceptual separability, and proposed another new test.<sup>109</sup> Judge Newman first pointed out what he declared to be "the obvious point" that conceptual separability must mean something other

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103. See 17 U.S.C. § 101 (2012); H.R. REP. NO. 94-1476, at 55 (1976).

104. Keyes, *supra* note 85, at 138.

105. *Id.*

106. *Id.*

107. See *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 425 (2d Cir. 1985) (Newman, J., dissenting) (stating that the "inextricably intertwined" test is essentially a test of physical separability that ignores, or at least misapplies, conceptual separability); *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) (arguing that the *Barnhart* majority's test is one of physical separability); Byron, *supra* note 88, at 175 (stating that the "inextricably intertwined" test is too similar to physical separability). *But see* Keyes, *supra* note 85, at 138 (reasoning that the test from *Barnhart* is different enough from physical separability to allow copyright protection in situations where physical separability is lacking).

108. See Byron, *supra* note 88, at 175; Perlmutter, *supra* note 15, at 362 (explaining that the "inextricably intertwined" standard almost always requires physical separability).

109. *Barnhart*, 773 F.2d at 420–22 (Newman, J., dissenting).

than physical separability.<sup>110</sup> By extension, a feature could be conceptually separable from the utilitarian function of the useful article without being physically separable.<sup>111</sup> Judge Newman's principle disagreement with the majority's "inextricably intertwined" standard was that it "misapplie[d], if it d[id] not ignore, the principle of conceptual separability" and essentially required physical separability.<sup>112</sup>

Disappointed with the majority's approach, Judge Newman examined a number of alternative standards to determine conceptual separability, the first of which was a test that would focus on the primary usage of the article.<sup>113</sup> Under this standard, an article used primarily to serve its utilitarian function would not be considered conceptually separable even if the artistic elements of the article had a secondary use solely as a work of art.<sup>114</sup> Judge Newman explained that the major flaw with a usage standard was that it would deny copyright protection to some works displayed and considered as art by a minority of consumers if a majority of consumers used the article for its utilitarian function.<sup>115</sup>

Judge Newman next discussed the "primary" versus "subsidiary" standard from *Kieselstein-Cord*,<sup>116</sup> which he characterized as being similar to the usage standard.<sup>117</sup> Judge Newman criticized this test as providing the fact-finder with insufficient guidance to measure the "primary" and "subsidiary" classifications of a given article.<sup>118</sup>

Judge Newman then considered the marketability approach advocated by Professor Melville Nimmer,<sup>119</sup> discussed in Section IV.C. This approach argues that conceptual separability exists when there "is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities."<sup>120</sup> Judge Newman pointed out that the drawback of this standard, which Nimmer himself admitted, is that a majority of people may *recognize* some works as works of art, but only a few people, perhaps less than a "significant segment of the community," would be willing to *purchase* those works just for display

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110. *Id.* at 421.

111. *Id.*

112. *Id.* at 425 (internal quotation marks omitted).

113. *Id.* at 421.

114. *Id.*

115. *Id.*

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

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

118. *Id.*

119. *Id.*

120. *Id.* (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[B][3] (Matthew Bender, rev. ed. 2014)).

in their own homes rather than for their utilitarian function.<sup>121</sup> Judge Newman recognized the inequity of using marketability of the work to determine copyrightability.<sup>122</sup>

Finally, Judge Newman rejected the notion that conceptual separability exists when the design of a useful article is so aesthetically pleasing that it can be appreciated for its artistic qualities.<sup>123</sup> As he accurately noted, Congress has affirmatively rejected this approach and requires that the artistic features be more than just recognized and appreciated; rather, they must be identified separately from and capable of existing independently of the useful article.<sup>124</sup>

After surveying and rejecting four alternative approaches to conceptual separability, Judge Newman articulated his own test—whether the article “stimulate[s] in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”<sup>125</sup> Judge Newman explained that, in making this determination, the fact-finder should consider the perspective of the “ordinary, reasonable observer” as the relevant beholder for the inquiry.<sup>126</sup> Therefore, conceptual separability exists, according to Judge Newman, when “the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously.”<sup>127</sup>

Applying his own test, Judge Newman determined that the two nude mannequins would be unlikely to create the concept of a mannequin with the utilitarian function of displaying clothing in the mind of an observer; rather, an ordinary observer would conceive of the forms exclusively as sculptural art.<sup>128</sup> As for the clothed mannequins, Judge Newman perceived a triable issue of fact regarding conceptual separability and would have remanded this issue for application of his test at trial.<sup>129</sup>

Other courts aptly refer to Judge Newman’s test as the “temporal displacement test” because it adds a temporal component to the separability requirement.<sup>130</sup> For a feature to be copyrightable, the beholder must be able to envision the artistic concept of the feature without simultaneously contemplating the utilitarian function.<sup>131</sup> Judge

121. *Id.* at 422.

122. *Id.*

123. *Id.*

124. *Id.* (citing H.R. REP. NO. 94-1476, at 55 (1976)).

125. *Id.*

126. *Id.*

127. *Id.*

128. *Id.* at 424.

129. *Id.* at 426.

130. *See Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987) (internal quotation marks omitted).

131. *See Barnhart*, 773 F.2d at 422–23 (Newman, J., dissenting).

Newman provided a list of relevant considerations to assist a fact-finder in making this determination, including whether and to what extent the object has been displayed or used separately from its utilitarian purpose.<sup>132</sup> Judge Newman further explained that expert testimony would generally be necessary to gather the requisite information for this inquiry.<sup>133</sup>

Although Judge Newman provided some guidance on how to apply his test, the majority criticized his test for being “so ethereal as to amount to a ‘non-test’ that would be extremely difficult, if not impossible, to administer or apply.”<sup>134</sup> Some scholars have echoed the majority’s concerns about the complexity of applying Judge Newman’s temporal displacement test.<sup>135</sup> They criticize the test for allowing judges’ personal conceptions of art to influence their separability analysis.<sup>136</sup> Judge Newman’s test is probably more rigorous than the statutory conceptual separability requirement—that the artistic features “be identified separately”<sup>137</sup>—because the test requires that the artistic elements completely displace, at least temporarily, the utilitarian function in the mind of the ordinary observer.<sup>138</sup>

Overall though, Judge Newman’s test has strong intuitive appeal—copyright should protect works that an ordinary observer can perceive as works of art.<sup>139</sup> Consistent with *Mazer*, under Judge Newman’s test, a work would not lose its copyright protection if incorporated into a useful article.<sup>140</sup> Moreover, Judge Newman’s focus on the actual appearance of the useful article, rather than the designer’s process of making it, is consistent with the focus of the Copyright Act.<sup>141</sup> Yet, despite its conceptual appeal and praise from scholars, courts have not adopted Judge Newman’s temporal displacement test.<sup>142</sup>

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132. *Id.* at 423.

133. *Id.*

134. *Id.* at 419 n.5 (majority opinion).

135. See Keyes, *supra* note 85, at 140 (“[T]he issue presented by Judge Newman’s test is so abstract that the ordinary reasonable person standard is not suitable.”); Perlmutter, *supra* note 15, at 377 (stating that Judge Newman’s test “is more complex than necessary”).

136. See Keyes, *supra* note 85, at 140 (explaining that judges’ personal opinions about what constitutes art will inevitably influence their beliefs about whether an ordinary reasonable person would view the work in question as art). *But see* Perlmutter, *supra* note 15, at 376 (acknowledging some risk of discrimination based on notions of conventional art, but explaining that this risk can be reduced by adopting guidelines that ask fact-finders to disregard their opinion of the artistic merit of the work).

137. 17 U.S.C. § 101 (2012).

138. See Perlmutter, *supra* note 15, at 377.

139. See *id.* at 375–76.

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

141. See Perlmutter, *supra* note 15, at 375.

142. See Jacob Bishop, Note, *Stealing Beauty: Pivot Point International v. Charlene Products and the Unfought Battle Between the Merger Doctrine and Conceptual Separability*,

The test that this Note proposes incorporates and capitalizes on many of the positive aspects of Judge Newman's test while avoiding its key shortcomings. Like Judge Newman's test, the suggested test's determinative inquiry is the perception of the ordinary, reasonable observer. The proposed test, borrowing from Judge Newman's use of factors, provides three objective factors and identifies key determinations related to each. Most importantly, the proposed test does not require the complete temporal displacement that Judge Newman's test mandates. In this way, the ordinary, reasonable observer standard of the proposed test more closely comports with the Copyright Act and maintains strong intuitive appeal.

#### D. *The Brandir Test: The Designer's Influence Standard*

In 1987, the Second Circuit again interpreted the meaning of conceptual separability and again modified its standard, incorporating themes from Professor Robert Denicola's test that turns on "the extent to which the work reflects artistic expression uninhibited by functional considerations."<sup>143</sup> The article at issue in *Brandir International, Inc. v. Cascade Pacific Lumber Co.* was a bicycle rack made of bent tubing in the now-familiar sinusoidal wave shape.<sup>144</sup> The designer of the bicycle rack originally constructed various sculptures made of continuous pieces of bent wire.<sup>145</sup> The artist had no intention of building a bicycle rack until a bicycle-enthusiast friend suggested that one of the sculptures would be a great design for a bicycle rack that would allow bicycles to be parked and locked under the upper-loops and over the lower-loops.<sup>146</sup> With that suggestion, the artist modified the design of the wire sculpture to optimize its use as a bicycle rack.<sup>147</sup>

The Copyright Office refused registration and determined that the bicycle rack did not contain any element that was capable of existing independently as a copyrightable work apart from the overall shape of the useful article.<sup>148</sup> In subsequent infringement litigation against a manufacturer making similar bicycle racks, the district court agreed that the bicycle rack did not have separable artistic elements and was, therefore, not entitled to copyright protection.<sup>149</sup>

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2006 WIS. L. REV. 1067, 1085; Gayle Coleman, Comment, *The Protection of Useful Articles and the Elusive Concept of Conceptual Separability*: *Brandir International Inc. v. Cascade Pacific Lumber Co.*, 13 NOVA L. REV. 1417, 1426 (1989).

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

144. *Id.* at 1143.

145. *Id.* at 1146.

146. *Id.*

147. *Id.* at 1146–47.

148. *Id.* at 1146.

149. *Id.* at 1143.

The Second Circuit framed the issue of separability as a complicated one for which courts “have had difficulty framing tests by which the fine line establishing what is and what is not copyrightable can be drawn.”<sup>150</sup> It emphasized that its own precedent created in *Kieselstein-Cord* and *Barnhart* called for a conceptual separability analysis in determining copyrightability of useful articles.<sup>151</sup> The court recognized that it had applied disparate tests in *Kieselstein-Cord* and *Barnhart*, but it characterized *Barnhart* as distinguishing *Kieselstein-Cord* rather than overruling it.<sup>152</sup>

The court then turned its attention to an article written by Professor Denicola and suggested that it could help resolve the differences between the two precedents and the majority and dissenting opinions in *Barnhart*.<sup>153</sup> Professor Denicola had suggested that the confusion regarding conceptual separability stemmed from an effort to draw a clear line between works of industrial design and artistic works incorporated into useful articles when there is really “no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.”<sup>154</sup>

Then, in a turn away from its own previously articulated tests and standards, the court adopted Professor Denicola’s test for conceptual separability, which it rearticulated as follows: “[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. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”<sup>155</sup> The court formed the *Brandir* test on the determination that it was consistent with the court’s decisions in *Kieselstein-Cord* and *Barnhart*, was easier to apply than the tests articulated in either of those cases, and avoided discrimination against abstract art.<sup>156</sup>

Despite the Second Circuit’s confidence in creating the *Brandir* test, it was the subject of a vigorous dissent from Judge Ralph Winter.<sup>157</sup> Judge Winter criticized the majority for “diminish[ing] the statutory concept of ‘conceptual separability’ to the vanishing point.”<sup>158</sup> Many elements of useful articles suggest, at least at some level, both artistic

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150. *Id.*

151. *Id.* at 1144.

152. *Id.*

153. *Id.* at 1145 (citing Denicola, *supra* note 39, at 741–42).

154. *Id.* (quoting Denicola, *supra* note 39, at 741).

155. *Id.*

156. *Id.*

157. *Id.* at 1151 (Winter, J., concurring in part and dissenting in part).

158. *Id.*

and functional considerations.<sup>159</sup> The *Brandir* test would deny copyright protection to such elements for reflecting both considerations.<sup>160</sup> Judge Winter preferred the ordinary, reasonable beholder test articulated in Judge Newman's dissent in *Barnhart*.<sup>161</sup> Notably though, Judge Winter did not quote or cite to Judge Newman's language that requires *complete temporal displacement* of the artistic features from the utilitarian function.<sup>162</sup> Rather, Judge Winter's articulation merely requires that "an ordinary reasonable observer . . . perceive an aesthetic concept not related to the article's use."<sup>163</sup> This is less rigorous than complete temporal displacement.

Judge Winter also faulted the majority for allowing "copyright protection [to] depend upon largely fortuitous circumstances" by focusing on the process of creating the article.<sup>164</sup> Judge Winter correctly criticized the *Brandir* test for improperly determining copyrightability based on the *process* of creating the work rather than on the *result* of the creative process—the final work itself.<sup>165</sup> Most importantly, this focus is inconsistent with the Copyright Act, which explicitly places its focus on how the final article is perceived, not how it was created.<sup>166</sup> Additionally, some commentators have criticized the *Brandir* test for inviting judges to engage in subjective artistic judgment beyond their legal expertise.<sup>167</sup> Professor Denicola, however, praises the process-focused test for allowing judges to suspend their subjective notions of artistic merit and focus on the more objective process of how the artist created the work.<sup>168</sup>

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159. See Byron, *supra* note 88, at 177.

160. See *id.*; Perlmutter, *supra* note 15, at 373 (noting that denying copyright protection for dual-motivated works would be inconsistent with the spirit of *Mazer*).

161. *Brandir*, 834 F.2d at 1151 (Winter, J., concurring in part and dissenting in part) (citing *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting)).

162. *Id.* (quoting Judge Newman's dissent only for the requirement that the article "stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function" (quoting *Barnhart*, 773 F.2d at 422 (Newman, J., dissenting))); *Barnhart*, 773 F.2d at 423 (Newman, J., dissenting) (discussing the requirement for a "temporal sense of separateness").

163. *Brandir*, 834 F.2d at 1151 (Winter, J., concurring in part and dissenting in part).

164. *Id.*

165. See Coleman, *supra* note 142, at 1435.

166. See 17 U.S.C. § 101 (2012) (making no reference to the process of creating the article, but rather inquiring whether the final article has "features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article"); *Brandir*, 834 F.2d at 1152 (Winter, J., concurring in part and dissenting in part); Coleman, *supra* note 142, at 1435; see also Perlmutter, *supra* note 15, at 374 (noting that in other areas of copyright law, including infringement and copyrightability of any other work, motive and intent are irrelevant).

167. See Matthew C. Broaddus, Comment, *Designers Should Strive to Create "Useless" Products: Using the "Useful Article" Doctrine to Avoid Separability Analysis*, 51 S. TEX. L. REV. 493, 507–10 (2009).

168. See Keyes, *supra* note 85, at 137.

Finally, the *Brandir* test is difficult to apply because it is fundamentally incompatible with the reality of the artistic design process. In most circumstances, the artistic design process does not follow a retraceable, step-by-step series of events and decisions that lead to the final design of an article.<sup>169</sup> Rather, it is typical for artists and designers to create and reject multiple ideas before arriving at a final design. Even if it were possible to reconstruct an artist's or designer's creative process, it is unrealistic to expect a fact-finder to be able to determine whether the artistic features were significantly influenced by functional considerations.<sup>170</sup> Although purportedly objective, the test requires the fact-finder to determine facts about the designer's inherently subjective processes, motivations, and intentions.<sup>171</sup> Moreover, since the test turns on subjective factors such as the designer's motivation and intent, problems of proof will likely exist when a designer, who has a personal stake in the ultimate determination of copyrightability, must testify to such matters.<sup>172</sup>

The Second Circuit's current process-based test for conceptual separability, most recently articulated in *Brandir*, is fundamentally inconsistent with the Copyright Act and difficult to apply. Therefore, this Note's proposed test for conceptual separability draws more from Judge Winter's dissent and is exclusively focused on how the ordinary, reasonable observer views the final work and its features rather than the process of creating the work.

#### IV. OUTSIDE THE SECOND CIRCUIT—A MULTITUDE OF TESTS CREATED BY COURTS AND SCHOLARS

Scholars and courts beyond the Second Circuit have taken different approaches to interpreting the Copyright Act's separability standard. Based on these varying interpretations, they have promulgated different tests for conceptual separability. Though these tests attempt to facilitate the conceptual separability analysis and comport with the Copyright Act, they have all received criticism for falling short in critical ways. This Part analyzes and critiques the tests created by these courts and scholars with an eye toward their compliance with the separability standard of the Copyright Act and the fundamental principles of copyright law.

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169. See Coleman, *supra* note 142, at 1435.

170. See *id.* at 1436; Perlmutter, *supra* note 15, at 374 (noting that a key difficulty for a fact-finder applying the *Brandir* test is determining the level of functional considerations present in the mind of the designer, which may vary throughout the design process).

171. Perlmutter, *supra* note 15, at 375.

172. *Id.*



### A. Professor Goldstein's "Equally Useful" Test

Professor Paul Goldstein set forth a test for conceptual separability that is very similar to the Second Circuit's test in *Barnhart*.<sup>173</sup> Under Goldstein's test, a pictorial, graphic, or sculptural feature of a useful article is conceptually separable if "it can stand on its own as a work of art traditionally conceived, and if the useful article in which it is embodied would be equally useful without [the pictorial, graphic, or sculptural feature]."<sup>174</sup> Although almost identical to the *Barnhart* test, Goldstein's test replaces the *Barnhart* requirement that the artistic features be "wholly unnecessary"<sup>175</sup> to functionality with the requirement that the utilitarian function be "equally useful" without the artistic features.<sup>176</sup>

Although adopted by the district court<sup>177</sup> and the dissent in *Pivot Point International, Inc. v. Charlene Products*,<sup>178</sup> which this Note addresses in Section IV.B, Goldstein's test is flawed in at least two critical ways. First, as the majority in *Pivot Point* recognizes, Goldstein's test comes too close to requiring physical separability to achieve copyright protection for artistic elements of useful articles.<sup>179</sup> Second, and more egregious given the evolution of the law, the phrase "work of art traditionally conceived"<sup>180</sup> in Goldstein's test reintroduces subjective determinations of artistic merit that Congress explicitly removed from the Copyright Act<sup>181</sup> and that the Copyright Office subsequently eliminated from its regulations.<sup>182</sup> Unfortunately, Goldstein's test allows judges' personal biases and opinions of the nature of the work to enter the determination of whether a useful article is copyrightable, which would likely have a disproportionately harmful

173. See 1 GOLDSTEIN, *supra* note 1, § 2.5.3.1(b); see also Bishop, *supra* note 142, at 1085; Broaddus, *supra* note 167, at 508.

174. 1 GOLDSTEIN, *supra* note 1, § 2.5.3.1(b).

175. *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985).

176. See 1 GOLDSTEIN, *supra* note 1, § 2.5.3.1(b); see also Bishop, *supra* note 142, at 1085.

177. See *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 170 F. Supp. 2d 828, 833 (N.D. Ill. 2001), *rev'd and remanded*, 372 F.3d 913 (7th Cir. 2004).

178. See *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 933–34 (7th Cir. 2004) (Kanne, J., dissenting) (explaining that Professor Goldstein's test is a reasonable interpretation of the conceptual separability required by the Copyright Act).

179. See *id.* at 924 (majority opinion) (explaining that when applied alone, Goldstein's test is "tied too closely to physical separability" and does not follow "Congress' determination that artistic [features that are] conceptually [separable] from . . . utilitarian design" can qualify for copyright protection); see also Broaddus, *supra* note 167, at 509.

180. 1 GOLDSTEIN, *supra* note 1, § 2.5.3.1(b).

181. Compare Act of July 8, 1870, Pub. L. No. 41-230, ch. 230, § 86, 16 Stat. 198, 212 (1870), with Act of Mar. 4, 1909, Pub. L. No. 60-34, ch. 320, § 5, 35 Stat. 1075, 1076–77 (1909) (repealed 1976) (eliminating the "fine arts" requirement of the previous Copyright Act).

182. See 37 C.F.R. § 202.8 (1949) (removing the "fine arts" requirement from the Copyright Office regulations in compliance with the Copyright Act of 1909).

impact on useful articles that often incorporate modern or abstract art rather than “traditional” art.<sup>183</sup>

The test that this Note advances avoids requiring physical separability and instead tests conceptual separability. Furthermore, it does not require that the separable artistic features be “works of art as traditionally conceived” as Goldstein’s test requires.<sup>184</sup> The proposed test recognizes that modern and abstract artistic features of useful articles are just as entitled to copyright protection as traditional artistic features. By focusing on an ordinary, reasonable observer’s perception of the work rather than the work’s status as “traditional art,” the suggested test does not discriminate against modern or abstract art.

#### B. *The Seventh Circuit: Pivot Point—A Hybrid of Second Circuit Approaches*

The U.S. Court of Appeals for the Seventh Circuit addressed the issue of conceptual separability in *Pivot Point*, another case involving mannequins, and arrived at yet another test for conceptual separability by combining two prominent Second Circuit tests.<sup>185</sup> The Pivot Point mannequin at issue in the case was made for hair stylists and beauticians to practice and display their work and, according to its creator, captured the “hungry look” of high-fashion models.<sup>186</sup> Pivot Point obtained copyright registration for the design of the mannequin and, upon discovering that Charlene brought a strikingly similar mannequin to the market, sued for copyright infringement.<sup>187</sup>

The district court applied Professor Goldstein’s test for conceptual separability and determined that the mannequin could not be copyrighted because “even though one can conceive of [the mannequin] as a sculpture displayed as art, it would not be *equally* useful if the features that Pivot Point want[ed] to copyright were removed.”<sup>188</sup> On appeal, Pivot Point argued that the conceptual separability inquiry should focus on whether the article was a “work of art,” as Pivot Point asserted its mannequin was.<sup>189</sup> However, Charlene requested that the Seventh Circuit affirm the district court’s application of Professor Goldstein’s test.<sup>190</sup>

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183. See Keyes, *supra* note 85, at 139.

184. See 1 GOLDSTEIN, *supra* note 1, § 2.5.3.1(b).

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

186. *Id.* at 915.

187. *Id.* at 915–16.

188. *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 170 F. Supp. 2d 828, 833 (N.D. Ill. 2001), *rev’d and remanded*, 372 F.3d at 917.

189. *Pivot Point*, 372 F.3d at 923.

190. *Id.*

The Seventh Circuit rejected each of these proposed tests—Pivot Point’s preferred “work of art” test because it required judicial evaluation of artistic merit and Professor Goldstein’s test for being “tied too closely to physical separability.”<sup>191</sup> For guidance in determining what test to apply, the Seventh Circuit thoroughly reviewed the evolution of the conceptual separability doctrine in the Second Circuit<sup>192</sup> and adopted a test that synthesized two precedents from that circuit:

Conceptual separability exists, therefore, when the artistic aspects of an article can be “conceptualized as existing independently of their utilitarian function.” *Carol Barnhart*, 773 F.2d at 418. This independence is necessarily informed by “whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.” *Brandir*, 834 F.2d at 1145.<sup>193</sup>

Applying this process-oriented test to the mannequin at issue, the court found that the features of Pivot Point’s mannequin could be conceptualized as existing independently from the mannequin’s use in hair and makeup training because they were the result of the designer’s artistic judgment.<sup>194</sup> The court noted that the designer’s artistic judgment was unconstrained by functional considerations and that he “had carte blanche” to implement the “hungry look” vision however he saw fit.<sup>195</sup> Because the court found that the mannequin “was the product of a creative process unfettered by functional concerns,” the court held that the sculptural features of the mannequin were conceptually separable from its utilitarian function and thus entitled to copyright protection.<sup>196</sup>

The *Pivot Point* majority made a commendable effort to survey and synthesize the myriad of tests used to determine conceptual separability.<sup>197</sup> Despite its valiant effort, the hybrid test that *Pivot Point* adopted has been criticized as having many of the same flaws as the *Brandir* test,<sup>198</sup> the prominent test that *Pivot Point* incorporates.<sup>199</sup> In his

191. *Id.* at 924.

192. *Id.* at 924–30.

193. *Id.* at 931.

194. *Id.*

195. *Id.* at 931–32 (explaining that Pivot Point only requested that the mannequin designer create the “hungry look” of runway models and did not give any specific dimensions or measurements that would be required to satisfy functional concerns).

196. *Id.* at 932.

197. *See id.* at 924–30 (providing in-depth analysis of Second and Fourth Circuit conceptual separability jurisprudence); Byron, *supra* note 88, at 188.

198. *See* Byron, *supra* note 88, at 188.

dissenting opinion in *Pivot Point*, Judge Michael Kanne criticized the majority's process-oriented approach for being inconsistent with the Copyright Act, which "looks to the useful article as it exists, not to how it was created."<sup>200</sup> Judge Kanne believed that congressional intent required that the article itself, not the process of creating the article, determine conceptual separability and, ultimately, copyrightability.<sup>201</sup> Others have agreed with Judge Kanne's criticism of the process-oriented approach because the design process of a useful article will inevitably be influenced by functional considerations, at least to some extent.<sup>202</sup> Given that reality, the *Pivot Point* test would nearly categorically prevent useful articles from being granted copyright protection.<sup>203</sup>

The Seventh Circuit's adoption of a process-based test for conceptual separability is inconsistent with the Copyright Act and the reality of the design process of useful articles. Therefore, instead of examining the artist's process of creating the work, this Note's proposed test comports with the Copyright Act and its legislative intent by focusing exclusively on how an ordinary, reasonable observer views the final work and its features.

### C. Professor Nimmer's Marketability Standard

Professor Nimmer advanced the most unique test for conceptual separability, determining copyrightability based on the marketability of the work.<sup>204</sup> Specifically, his test finds conceptual separability "where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities."<sup>205</sup> The U.S. Court of Appeals for the Fifth Circuit has adopted Professor Nimmer's "marketability test" in the limited context of clothing design,<sup>206</sup> but courts have not otherwise adopted it as a general test for conceptual separability.

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199. See *supra* notes 155–72 and accompanying text.

200. *Pivot Point*, 372 F.3d at 933–34 (Kanne, J., dissenting) (adding that "it simply is irrelevant to inquire into the origins of [the work's artistic features]").

201. *Id.* at 934.

202. See 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:144 (2014) (pointing out that "obviously" the "design of a useful article is influenced by being the design of a useful article"); see also Keyes, *supra* note 85, at 137.

203. See Keyes, *supra* note 85, at 137.

204. See 1 NIMMER & NIMMER, *supra* note 120, § 2.08(B)[3].

205. *Id.*

206. *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 421 (5th Cir. 2005) (acknowledging that, despite its weaknesses, it was the best test available for the factual situation of clothing design).

Nimmer himself admitted that his test “is itself not altogether satisfactory,” primarily because it is difficult to prove.<sup>207</sup> Nimmer’s marketability test is also a strange concept for copyright law since copyright is usually focused on the work itself, not its success in the marketplace.<sup>208</sup> As a result, the marketability test is likely to favor more conventional or mainstream forms of art at the expense of modern or abstract works.<sup>209</sup> In his dissent in *Barnhart*, Judge Newman recognized this inequity and explained that some works, even if *recognized* as works of art by a majority of people, would not be copyrightable under Nimmer’s test if only a few people—less than some “significant segment of the community”—would be willing to *purchase* those works for display in their own homes.<sup>210</sup>

As a practical matter, the term “significant” lacks a quantitative threshold, and the term “community” is also unclear in scope.<sup>211</sup> It is unclear if the community would be based on geographic region, patronage of the arts, or some other variety of factors.<sup>212</sup> In either case, under this test, the same work might be deemed protectable based on its market success in one community but denied protection based on its lack of popularity in another community with different tastes.

The test for conceptual separability that this Note proposes incorporates Nimmer’s marketability test into one of its factors. The third factor of the proposed test, marketability information, allows the fact-finder to consider facts about the marketability of the work that indicate that an ordinary, reasonable observer could perceive aesthetic features separate from the article’s function. Marketability information can objectively instruct on how an ordinary, reasonable observer perceives the artistic aspects of the work but should not control the copyrightability determination. Therefore, marketability is incorporated as a factor of the proposed test where it can contribute to, but not dominate, the analysis.

## V. PROBLEMS WITH EXISTING TESTS FOR CONCEPTUAL SEPARABILITY

The current state of conceptual separability analysis is in dire need of reexamination and simplification. With no guidance on the issue

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207. 1 NIMMER & NIMMER, *supra* note 120, § 2.08(B)[3]; Denicola, *supra* note 39, at 734 (emphasizing the evidentiary problems facing any model focusing on consumer judgments and motivations).

208. 1 NIMMER & NIMMER, *supra* note 120, § 2.08(B)[3]; *see also* Byron, *supra* note 88, at 180 (noting that success in the marketplace is an unconventional way to determine copyrightability).

209. *See* 1 NIMMER & NIMMER, *supra* note 120, § 2.08(B)[3]; Keyes, *supra* note 85, at 136.

210. *See* Carol Barnhart Inc. v. Econ. Cover Corp., 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting); *see also* Byron, *supra* note 88, at 180.

211. *See* Byron, *supra* note 88, at 180.

212. *See id.*

from the Supreme Court since *Mazer v. Stein*<sup>213</sup> in 1954, the Circuit Courts of Appeal and legal scholars have created and modified a multitude of tests for conceptual separability. This Note has discussed the eight major tests for conceptual separability,<sup>214</sup> but variations of the eight major tests and other less influential tests also exist.<sup>215</sup> With each decision in this area, there is a possibility that the court will articulate additional tests, especially given the tendency of dissenting judges to propose a different test than the majority adopts.<sup>216</sup>

Absent from the cacophony of these multiple tests is any consideration of the need for consistency or reliability among the designers and creators of useful articles. Depending on which test is applied, the very same article may be deemed copyrightable by one court and not copyrightable by another. The doubt surrounding whether a work will be eligible for copyright protection raises concern for designers and creators of useful articles.<sup>217</sup> The uncertainty that the multitude of inconsistent tests for conceptual separability creates unfairly prejudices designers and creators of useful articles. Artists, authors, and musicians who create more traditional copyrightable works are not similarly prejudiced because the copyrightability of their works is much more predictable.<sup>218</sup>

Most importantly, many of the tests for conceptual separability have strayed too far from their intended purpose—to determine if, as the Copyright Act requires, the pictorial, graphic, or sculptural features can be “identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”<sup>219</sup> The explicit focus of this inquiry is on the final work and its features.<sup>220</sup> Neither the Copyright Act, the Act’s legislative history, nor the Copyright Office regulations make reference to the process of creating the work as a way to determine conceptual separability.<sup>221</sup> However, two of the leading

213. 347 U.S. 201 (1954).

214. *See supra* Parts III–IV.

215. By one count, the number of tests for conceptual separability is ten. *See Broadus, supra* note 167, at 504.

216. *See, e.g.,* *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 934 (7th Cir. 2004) (Kanne, J., dissenting); *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); *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting).

217. For example, if copyright protection for their works is unpredictable, designers of useful articles might be discouraged from developing new works for fear that they would have no recourse against unauthorized copying. *See Keyes, supra* note 85, at 136.

218. The usual requirement for copyright protection of non-useful articles is that the work be an original work of authorship fixed in a tangible medium of expression. *See* 17 U.S.C. § 102(a) (2012).

219. *Id.* § 101.

220. *See id.*

221. *See id.*; H.R. REP. NO. 94-1476, at 55 (1976); 37 C.F.R. § 202.10(c) (1960).

tests for conceptual separability, the *Brandir* test in the Second Circuit and the *Pivot Point* test in the Seventh Circuit, both erroneously place the focus of conceptual separability analysis on the process of creating the work rather than the features of the work itself.<sup>222</sup>

This misplaced focus is not only inconsistent with the statutory formulation of the Copyright Act; it also has the detrimental effect of unnecessarily complicating the conceptual separability analysis. By requiring inquiry into the designer's artistic influences, decisions, and processes, these process-based tests invite problems of proof.<sup>223</sup> Moreover, the tests create the risk that the ultimate decision of copyrightability will turn on events in the designer's process rather than the conceptual separability of the features of the final work itself. Refocusing on whether certain features of the final work can be "identified separately" from and are "capable of existing independently" of the utilitarian function would likely simplify the conceptual separability analysis into a more manageable inquiry and make the analysis more consistent with the Copyright Act.<sup>224</sup>

Other leading tests are flawed because they use a much more rigorous test for conceptual separability than the Congress who created the Copyright Act likely intended by effectively applying a standard of only physical, and not conceptual, separability.<sup>225</sup> The Copyright Act's legislative history clearly states that artistic features either "physically or conceptually" separable from the utilitarian function of the article are copyrightable.<sup>226</sup> Therefore, any test that requires physical separability necessarily goes beyond this legislative intent and into a more rigorous requirement for copyrightability of useful articles. Despite this plain language in the Act's legislative history, the tests applied in *Barnhart* and by Professor Goldstein come too close to exclusively requiring physical separability.<sup>227</sup>

Most of the key tests for conceptual separability also run afoul of a general principle of copyright law—that judges should not be involved in subjective determinations of artistic worth. The U.S. Supreme Court established this principle over 100 years ago in *Bleistein v. Donaldson Lithographing Co.*,<sup>228</sup> and numerous other courts have embraced and

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222. See *supra* notes 155–72, 193–203 and accompanying text.

223. See, e.g., Perlmutter, *supra* note 15, at 375.

224. *Id.* at 346 (quoting 37 C.F.R. § 202.10(c) (1957)).

225. See, e.g., *supra* notes 137–38 and accompanying text.

226. H.R. REP. NO. 94-1476, at 55 (1976) (emphasis added).

227. See *supra* notes 97–108, 173–79 and accompanying text.

228. 188 U.S. 239, 251 (1903) ("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.").

echoed it in conceptual separability cases.<sup>229</sup> Some authors have criticized Judge Newman's ordinary, reasonable beholder standard, the *Brandir* designer's influence standard, Professor Goldstein's "equally useful" test, and the *Pivot Point* hybrid approach for violating the *Bleistein* mandate to keep judges out of the business of art critiquing.<sup>230</sup>

Finally, the existing tests for conceptual separability do not provide the fact-finder with enough guidance on how to make the separability determination that each test requires. Particularly, the *Kieselstein-Cord* and *Barnhart* tests have been criticized for introducing new terminology to the test for conceptual separability but failing to define or thoroughly explain that new terminology.<sup>231</sup> By nature, any test for conceptual separability is abstract—at least to a certain extent. However, providing the fact-finder with objective factors to guide their analysis could reduce confusion in this area.

An improved test for conceptual separability would: give designers of useful articles guidelines for determining if their work is copyrightable; comport with the Copyright Act and its legislative intent; align with general concepts of copyright law; and be easily applied in court to determine copyrightability in infringement and invalidity litigation.

## VI. PROPOSED TEST FOR CONCEPTUAL SEPARABILITY

In short, this Note's proposed test for conceptual separability is whether an ordinary, reasonable observer can perceive aesthetic features separate from the article's function. In applying this test, the factors that the fact-finder may consider fall into three main categories: (1) objective indicia of public perception; (2) use of the work separate from function; and (3) marketability information. This reasonable observer standard with objective guiding factors addresses many of the problems facing the current state of conceptual separability for copyright of useful articles.

The key determination of the proposed test for conceptual separability is whether the ordinary, reasonable observer can perceive aesthetic features separate from the article's function. This test is similar to the tests Judge Newman proposed in his dissent in *Barnhart*<sup>232</sup> and

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229. See, e.g., *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 924 (7th Cir. 2004) ("[T]his approach [that] necessarily involves judges in a qualitative evaluation of artistic endeavors [is] a function for which judicial office is hardly a qualifier."); *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 423 (2d Cir. 1985) (Newman, J., dissenting) ("The need for the inquiry [as to the nature of art] is regrettable, since courts must not become the arbiters of taste in art or any other aspect of aesthetics.")

230. See *supra* notes 136, 167, 180–83, 198 and accompanying text.

231. See *supra* notes 86–88, 103–06 and accompanying text.

232. See *Barnhart*, 773 F.2d at 422 (Newman, J., dissenting).



Judge Winter proposed in his dissent in *Brandir*<sup>233</sup> in that all three involve the ordinary, reasonable observer standard. However, the suggested test for conceptual separability is closer to Judge Winter's test than Judge Newman's test because it does not require complete temporal displacement of the utilitarian function by the aesthetic features. The proposed test only requires that the ordinary, reasonable observer perceive aesthetic features separate from the article's function, not that the reasonable observer perceive the aesthetic features at a time when the observer is not contemplating the functional features. Under the proposed test, aesthetic features perceived *simultaneously* with the utilitarian function in the mind of the ordinary, reasonable beholder would satisfy the conceptual separability inquiry. By forgoing the complete temporal displacement requirement of Judge Newman's test,<sup>234</sup> the suggested test avoids criticism directed at other tests for approaching physical separability and being more rigorous than the Copyright Act intended.<sup>235</sup>

Of course, the ordinary, reasonable observer does not decide cases; the fact-finder does. Under the proposed test, the fact-finder will make the conceptual separability decision based on a hypothetical ordinary, reasonable observer's perception of the work. Since the conceptual separability determination is abstract by nature, even under the proposed test, the following factors should guide the fact-finder: (1) objective indicia of public perception; (2) use of the work separate from function; and (3) marketability information. These factors should not be treated as independent requirements for conceptual separability. Rather, they are guidelines that the fact-finder should analyze and balance when considering conceptual separability.

The first factor aiding the fact-finder in determining if an ordinary, reasonable observer could perceive aesthetic features separate from the article's function is the objective indicia of public perception of the work. Criteria to consider under this factor include whether the work is displayed in art museums or galleries, whether the work's artistic features, rather than its utilitarian function, have garnered recognition by the public or media, and whether the work is otherwise presented for public viewing. If these and related questions indicate that ordinary members of the public can perceive the article's artistic features separate from the article's function, then this first factor weighs in favor of finding conceptual separability.

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233. *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).

234. *See Barnhart*, 773 F.2d at 423 (Newman, J., dissenting).

235. *See supra* notes 137–38 and accompanying text.

The second factor of the suggested test for conceptual separability is use of the work separate from its function. Under this factor, the key question for the fact-finder is whether, and to what extent, the work has an alternate use as a work of art apart from its utilitarian function. Indications that the work does have an alternate use exclusively as art include instances of individuals displaying or using the work in a manner for which it is entirely nonfunctional, collecting quantities of the work beyond the quantity necessary for utility, displaying the work after the utilitarian function is either broken or removed, and displaying and considering the work as art. This second factor weighs in favor of conceptual separability if these considerations about usage of the work indicate that an ordinary, reasonable observer can perceive the article's artistic features separate from the article's function.

The third and final factor to consider in the proposed test for conceptual separability is marketability information. This factor is designed to help the fact-finder determine if facts about the marketability of the work indicate that the ordinary, reasonable observer could perceive aesthetic features separate from the article's function. Relevant facts to consider under this factor include to what extent the work would be marketable to consumers, even if the work had no utilitarian use; to what extent the work is advertised and marketed based on its artistic features; and whether consumers indicate that aesthetic, rather than functional, concerns dictated their purchase of the work. Marketability information indicating that the work's artistic features, separate from the article's function, influenced ordinary consumers to purchase the article weighs in favor of finding conceptual separability.

These three factors, and the considerations related to each, may be presented with the aid of survey responses and expert testimony, and courts should generally allow this type of evidence. These factors should not be applied as a rigid three-part test where the absence of evidence relating to one factor necessarily precludes a finding of conceptual separability. Rather, these factors should be treated as guidelines for determining the ultimate question of whether the ordinary, reasonable observer could perceive aesthetic features separate from the article's function.

The proposed ordinary, reasonable observer test with guiding factors is a good test for conceptual separability because it is designed to be consistent with copyright and other areas of law. Tort law and criminal law both successfully rely on the reasonable person standard for many key determinations.<sup>236</sup> Copyright law uses the ordinary, reasonable observer standard to decide similar conceptual issues of copyright law,

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236. *E.g.*, RESTATEMENT (SECOND) OF TORTS § 283 (1965); 1 WHARTON'S CRIMINAL LAW § 27 (15th ed. 2014); *see also* Sandra F. Sperino, *The Tort Label*, 66 FLA. L. REV. 1051, 1062 n.75 (2014) (discussing other uses of the "reasonable person" standard).

including whether an allegedly infringing work is “substantially similar” to an allegedly infringed copyrighted work.<sup>237</sup> Factors play a prominent role in other areas of copyright law as well—most notably the four ubiquitous fair use factors.<sup>238</sup>

Finally, and most importantly, the proposed test and its associated factors solve the problems facing the existing tests for conceptual separability. First, it closely comports with the Copyright Act and its legislative intent. Rather than focusing on the designer’s process of creating the work, the suggested test properly focuses on the work itself. The factors give designers, at the time of creation, and courts, at the time of litigation, guidance in determining if the aesthetic aspects are conceptually separable from the functional features of the work and are therefore copyrightable. The suggested test is not based on artistic merit and does not invite the fact-finder to make subjective determinations of aesthetic worth. Instead, the proposed test instructs the fact-finder to carefully observe the work and consider the existence and relative weight of all the factors to objectively determine if an ordinary, reasonable observer could perceive aesthetic features separate from the article’s function. Finally, the proposed test and associated factors have strong intuitive appeal. At its most basic level, the proposed test echoes *Mazer* and says that artistic features of useful articles that an ordinary observer can view as separable are entitled to copyright protection. This approach is consistent with the Copyright Act, its legislative intent, and the general principles of copyright law.

Returning to the treepot example from the Introduction, the proposed test would let the fact-finder answer the critical question of whether an ordinary, reasonable observer can perceive aesthetic features separate from the treepot’s tea-holding function. The test would not allow the fact-finder to make determinations regarding the artistic worth of the treepot or investigate the designer’s process and motivation for creating the work. Instead, the test would require the fact-finder to focus on the work itself and consider the three factors and the relevant considerations of each. Of course, the parties would put on evidence going to each of the three factors: (1) objective indicia of public perception; (2) use of the work separate from function; and (3) marketability information. If, on balance, these factors weighed in favor of determining that an ordinary, reasonable observer could perceive aesthetic features separate from the treepot’s function, those aesthetic features would be copyrightable.

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237. See PATRY, *supra* note 202, § 9:81.

238. See 17 U.S.C. § 107 (2012).

## CONCLUSION

The numerous existing tests for conceptual separability have made copyright protection of useful articles an exceedingly difficult area of copyright law. Confusion surrounding the proper test for conceptual separability discourages innovation by designers of useful articles and leads to inconsistent results across different courts. With consumer demand pushing for aesthetically pleasing useful articles, today more than ever, utilitarian works increasingly reflect both aesthetic and functional concerns. Given that reality, courts need a test for conceptual separability that is consistent with the Copyright Act, offers more predictability to designers of useful articles, and is easily applied.

The test for conceptual separability that this Note proposes—whether an ordinary, reasonable observer can perceive aesthetic features separate from the article’s function—addresses the problems currently facing conceptual separability and brings much needed simplification to this area of copyright law. Most importantly, the proposed test is consistent with the Copyright Act and its legislative intent. Moreover, the three factors associated with the proposed test—objective indicia of public perception, use of the work separate from function, and marketability information—provide guidance typically lacking in the existing tests for conceptual separability. If the Supreme Court acts to resolve the inconsistent application of conceptual separability amongst the Circuit Courts of Appeal, it should adopt this Note’s proposed ordinary, reasonable observer test and its corresponding guiding factors.

