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Stephen Langs

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THE DEFINITIONAL SCOPE OF AN INTRINSIC UTILITARIAN FUNCTION UNDER THE 1976 COPYRIGHT ACT: ONE MAN'S USE IS ANOTHER MAN'S ART

STEPHEN LANGS*

INTRODUCTION

Under the 1976 Copyright Act ("1976 Act"),¹ "pictorial, graphic, [or] sculptural works"² are proper subject matter warranting copyright protection.³ The designs of useful articles,⁴ however, are not copyrightable.⁵ The exception to this exception, otherwise known as the question of separability,⁶ is that useful articles enjoy

* At the time of publication, this article was being considered in the Nathan Burkan Memorial Writing Competition.

1. 17 U.S.C. §§ 101-1101 (1996).

2. *Id.* § 101.

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned

Id.

3. *See id.* § 102(a)(5).

4. *See id.* § 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. An article that is normally a part of a useful article is considered a 'useful article.'").

5. *See id.*

[T]he 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.

Id.; *see also* *OddzOn Prod., Inc. v. Oman*, 924 F.2d 346, 349 (D.C. Cir. 1991) ("Congress excluded the design of useful articles from the realm of copyright").

6. For an examination on the issue of separability, see Raymond M. Polakovic, Comment, *Should the Bauhaus Be in the Copyright Doghouse? Rethinking Conceptual Separability*, 64 U. COLO. L. REV. 871 (1993). *See also* Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341 (1987); Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN.

copyright protection to the extent that pictorial, graphic, or sculptural features can exist independently of, and separately from the utilitarian aspects of the article.⁷

Consequently, if an article seeking copyright protection is defined as a pictorial, graphic, or sculptural work, the article is copyrightable except for its mechanical or utilitarian aspects.⁸ If an article is defined as a useful article, then its design is not copyrightable except to the extent that copyrightable pictorial, graphic, or sculptural features can be identified and are capable of existing independently of and separately from the article.⁹ The question preceding any discussion concerning the copyrightability of an article is determining whether the article seeking protection is properly defined as a pictorial, graphic, or sculptural work or as a useful article.

This question was recently addressed by the Fourth Circuit in *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., Inc.*¹⁰ In that case, the court was faced with the question of “whether animal mannequins used by taxidermists to mount animal skins [were] copyrightable.”¹¹ Before deciding the issue of copyrightability, however, the court had to determine whether the mannequins were “useful articles” or “sculptural works” as defined by the 1976 Act.¹² The court found that the principal utilitarian aspect of the animal mannequins was their portrayal of animal expressions.¹³ The animal mounts were properly defined as sculptural works, and the court held that the artistic “portrayal of the animal’s body expression” was copyrightable.¹⁴

Distinguishing pictorial, graphic, or sculptural works from useful articles must be based on the purposes of copyright law. The ultimate goal of copyright law is to foster the creation and dissemination of intellectual works and to promote the growth of learning and culture for the public welfare.¹⁵ “The Constitution, [under art.

L. REV. 707 (1983); Rebecca Ishaq Foster, Comment, *Protect the Bastard Child of the Arts: Copyright Protection for Theatrical Costumes*, 22 SW. U. L. REV. 431 (1993); Gary S. Raskin, Comment, *Copyright Protection for Useful Articles: Can the Design of an Object Be Conceptually Separated from the Object’s Function?*, 33 SANTA CLARA L. REV. 171 (1993).

7. See 17 U.S.C. § 101. See *supra* note 4 for the definition of useful articles.

8. See 17 U.S.C. §§ 101, 102(a)(5).

9. See *id.* § 101.

10. 74 F.3d 488 (4th Cir. 1996).

11. *Id.* at 491.

12. *Id.*

13. See *id.* at 494.

14. *Id.*

15. See, e.g., *Harper & Row, Publishers, Inc. v. Nation Enters., Inc.*, 471 U.S. 539,

I, § 8, cl. 8], does not establish copyrights, but provides that Congress shall have the power to grant such rights if it thinks best. Not primarily for the benefit of the author, but primarily for the benefit of the public, such rights are given.”¹⁶ By securing “the award[s] due them for their contribution[s] to society,” granting authors exclusive rights in their works for a limited time is a means to promoting the growth of learning and culture for the public welfare because “copyright stimulates their creation and dissemination of intellectual works.”¹⁷

Courts are in the unenviable position of striking a balance between protecting the works of authors and promoting the public interest.¹⁸ Some commentators note that if a balance cannot be struck between protecting original expression and promoting public progress, then it is wiser to err in favor of over-protection.¹⁹ Unfortunately, broadening the scope of protection when unnecessary undermines the goals of copyright because it comes at the expense of public learning and welfare.²⁰

This paper addresses the issue of how courts should determine the appropriate analytical starting point before defining the scope of copyright protection afforded any particular article. Under a “primary functional significance” analysis, the utilitarian functions of an article seeking copyright protection are weighed against its aesthetic functions. If aesthetic qualities are found to be primary, then the article is properly defined as a pictorial, graphic, or sculptural work. Conversely, if utilitarian functions are primarily significant, then the article is properly defined as a useful article subject to the question of separability.

Apportioning the relative weight of aesthetic functionality and utilitarian functionality necessarily occurs on an ad hoc basis. However, the purpose of copyright is to promote the arts and sciences

546 (1985); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 450 (1984); REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 3-6 (1961) [hereinafter REPORT ON THE GENERAL REVISION].

16. H.R. No. 2222, 60th Cong. (1908).

17. REPORT ON THE GENERAL REVISION, *supra* note 15, at 3-6.

18. See U.S. CONST. art. I, § 8, cl. 8 (the purpose of copyright law is “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”).

19. See, e.g., Raskin, *supra* note 6, at 209-10.

20. See, e.g., REPORT ON THE GENERAL REVISION, *supra* note 15, at 3-6 (the secondary purpose to fostering and creating intellectual works for public welfare is rewarding authors for their works; however, “the interests of authors must yield to [] public welfare where [these interests] conflict”).

for public welfare. Thus, the appropriate scope of copyright should be determined based on the specific article seeking protection and not on a general categorization of the article.²¹ Whether particular articles possess an intrinsic utilitarian function beyond portraying appearance or conveying information is a question of fact. Rather than favoring over-protection and holding that certain articles do not possess an intrinsic utilitarian function beyond portraying appearance or conveying information as a matter of law,²² a case-by-case analysis to determine "usefulness" protects the interests of authors, the public welfare, and establishes clearer guidelines to address future issues of this nature.

I. BACKGROUND

Useful articles are articles having an intrinsic utilitarian function beyond portraying their own appearance or conveying information.²³ They need not be complex or highly technical devices like cars or computers. Useful articles "can be as mundane a technology as a hand-cranked pencil sharpener."²⁴ So long as articles retain "an intrinsic utilitarian function,"²⁵ they are defined as useful and their designs are not copyrightable unless particular elements of their designs satisfy the separability test. The purpose of this paper is to explore the various interpretations of "intrinsic utilitarian function" and to examine the metes and bounds defining the judicial scope of what constitute useful articles.²⁶ This paper analyzes existing statutory language and judicial interpretations of that language, and asserts that the appropriate starting point in defining the proper scope of copyright protection is determined under a "primary functional significance" analysis. Accordingly, a brief review of the development of copyright protection afforded useful articles is necessary in order to determine the proper definitional scope of intrinsic utilitarian functions.

21. See, e.g., Note, *Protection for the Artistic Aspects of Articles of Utility*, 72 HARV. L. REV. 1520, 1525-26 (1959); cf. *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970 (6th Cir. 1983).

22. See, e.g., *Gay Toys*, 703 F.2d at 972-73.

23. See 17 U.S.C. § 101 (1996) ("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.").

24. Polakovic, *supra* note 6, at 872 (citing *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966)).

25. 17 U.S.C. § 101 (emphasis added).

26. See *infra* Part I.B.2.

A. *The Development of Copyright Protection Concerning Useful Articles*

In 1903, the Supreme Court decided *Bleistein v. Donaldson Lithographing Co.*²⁷ In *Bleistein*, the Court was faced with the question of whether artistic works are copyrightable when their principal functions “are among the useful arts.”²⁸ At issue was a painted circus advertisement the defendant had copied.²⁹ The plaintiff sued for infringement.³⁰ The defendant argued that advertisements were not proper subject matter warranting copyright protection.³¹ The Court held that the advertisement’s utilitarian function, i.e., promoting the circus “to increase trade and to help make money,” did not bar copyright protection.³² Under *Bleistein*, articles serving principally utilitarian functions such as advertisements may be proper subject matter for copyright protection. Unfortunately, the Court did not define the extent or scope of such protection. Consequently, the answer to this question is answered by examining the evolution of protection for useful articles following *Bleistein*.

1. Examining Protection Prior to the 1976 Act

The Copyright Act of 1909 (“1909 Act”)³³ was enacted shortly after *Bleistein*. The 1909 Act provided copyright protection to “[w]orks of art.”³⁴ In implementing the 1909 Act, however, the Copyright Office³⁵ could not determine whether protection was

27. 188 U.S. 239 (1903). See also Raskin, *supra* note 6, at 174, for a further discussion of *Bleistein*.

28. *Bleistein*, 188 U.S. at 249.

29. *See id.* at 242.

30. *See id.* at 240.

31. *See id.*

32. *Id.* at 251.

33. 17 U.S.C. §§ 1-216 (1909), amended by 17 U.S.C. §§ 101-810 (1978) (current version at 17 U.S.C. §§ 101-1101 (1996)). See also Raskin, *supra* note 6, at 174, for a further discussion of the 1909 Act.

34. 17 U.S.C. § 5(g) (1909), amended by 17 U.S.C. §§ 101-810 (1978) (current version at 17 U.S.C. §§ 101-1101 (1996)); see also Denicola, *supra* note 6, at 710.

Among the items eligible for copyright under the 1909 Act were those specified in section 5(g) With the deletion of all reference to the “fine arts,” a major barrier to copyright in the design of useful objects apparently fell. No logic could demonstrate that crystal wine glasses, pearl rings, or even handsome radio cabinets were not “works of art.”

Id. (footnotes omitted).

35. Under the direction of the Register of Copyrights, the Copyright Office is charged with all administrative functions and duties under the 1976 Copyright Act. See 17 U.S.C. § 701 (1996). The Register of Copyrights is responsible for establishing and

properly available to applied works of art, i.e., useful articles, or only to works of fine art. The Copyright Office was accepting utilitarian objects for copyright registration while adopting regulations rejecting such registrations.³⁶ Ultimately, however, the Copyright Office promulgated regulation 202.8 in 1948 which defined works of art to include “works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned.”³⁷ Hence, under regulation 202.8, the designs of useful works of art were proper subject matter warranting copyright protection.³⁸

In *Mazer v. Stein*,³⁹ the Supreme Court endorsed regulation 202.8 and held that aesthetic and artistic elements subsisting in useful articles are copyrightable. At issue in *Mazer* were identical copies of lamp bases sculpted in the form of Balinese Dancers.⁴⁰ The respondents had registered the lamp bases for copyright as “works of art”⁴¹ under the 1909 Act separately from the mechanical parts of the lamp.⁴² Ignoring the functional aspect of their intended use as lamp bases, the Court held that original works of art do not cease to be copyrightable as works of art when they are incorporated into the designs of useful articles.⁴³ The lamp bases were deserving of copyright protection because they represented a form of

promulgating regulations to administer the Copyright Act. *See id.* § 702. *See also* Raskin, *supra* note 6, at 174-75 for a further discussion of the Copyright Office’s promulgated regulations.

36. “In a 1910 regulation defining ‘works of art,’ the Copyright Office restricted the newly established classification to ‘the so-called fine arts,’ expressly excluding ‘[p]roductions of the industrial arts utilitarian in purpose and character.’” Denicola, *supra* note 6, at 710 (quoting COPYRIGHT OFFICE, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT, BULL. NO. 15, § 12(g) (1910)). However, the Copyright Office amended this regulation in 1917 to allow registration of “artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.” 37 C.F.R. § 201.4(7) (1917); *see also* Raskin, *supra* note 6, at 175; Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC’Y 339, 342-43 (1990).

37. Raskin, *supra* note 6, at 175 (quoting 37 C.F.R. § 202.8 (1949)).

38. The 1976 Act, contrary to the 1909 Act, does not refer to “works of art” as proper subject matter warranting copyright protection. This classification was abandoned in favor of a new category referring to “pictorial, graphic, and sculptural works.” 17 U.S.C. § 102(a)(5) (1996).

39. 347 U.S. 201 (1954). *See also* Raskin, *supra* note 6, at 175-76 for a further discussion of *Mazer*.

40. *See Mazer*, 347 U.S. at 202.

41. Note that the 1976 Act abandoned the term “works of art” in favor of “pictorial, graphic, and sculptural works.” 17 U.S.C. § 102(a)(5).

42. *See Mazer*, 347 U.S. at 202.

43. *See id.* at 218.

artistic craftsmanship and were not part of the mechanical or utilitarian aspects of the lamp.⁴⁴ The Court concluded 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.”⁴⁵

Responding to the Court’s decision in *Mazer*, the Copyright Office promulgated regulation 202.10.⁴⁶ This regulation embodied the principle, affirmed in *Mazer*, that commercial use does not disqualify an otherwise registrable work of art from copyright protection.⁴⁷ However, in attempting to define the eligibility of artistically shaped utilitarian articles for copyright protection, regulation 202.10(c) stated that if “the sole intrinsic function of an article is its utility, the fact that it is unique and attractively shaped will not qualify it as a [protectable] work of art.”⁴⁸ The Copyright Office amended this regulation three years later by granting protection to those artistic features of useful articles that “can be identified separately and are capable of existing independently as” works of art.⁴⁹ “It was this amended version of the regulation which made separability a crucial element in determining which aspects of, and to what extent useful articles are protected.”⁵⁰ In sum, regulation 202.10 denied copyright protection to useful articles incorporating aesthetically pleasing designs incapable of existing independently as protectable works of art under the 1909 Act.

*Esquire, Inc. v. Ringer*⁵¹ is a good example of regulation 202.10’s application. The question on appeal was whether the overall shape of a utilitarian object is an article eligible for copyright.⁵² In *Esquire*, the manufacturer of outdoor lighting fixtures sought copyright protection for the overall shape of its fixtures as a “work

44. See *id.*; cf. 37 C.F.R. § 202.8 (1949).

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

46. See 37 C.F.R. § 202.10 (1957). See also Raskin, *supra* note 6, at 176, for a further discussion of section 202.10.

47. See 37 C.F.R. § 202.10(b) (“The registrability of a work of art is not affected by the intention of the author as to the use of the work.”).

48. 37 C.F.R. § 202.10(c) (amended 1960).

49. 37 C.F.R. § 202.10(c) (1960).

50. Raskin, *supra* note 6, at 176 (footnote omitted). See also *supra* note 6 for a list of authorities discussing and examining the difficulties associated with applying the separability test to useful articles.

51. 414 F. Supp. 939 (D.D.C. 1976), *rev’d*, 591 F.2d 796 (D.C. Cir. 1978). For an in-depth discussion of *Esquire*, see Aleksandra A. Miziolek, Casenote, *Copyright Law—Copyright Protection for Industrial Designs Under the 1976 Copyright Acts*, 25 WAYNE L. REV. 923 (1979).

52. See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 798, 804 (D.C. Cir. 1978).

of art" under the 1909 Act.⁵³ Although the case was decided in 1978, the articles in question were subject to the 1909 Act and accompanying regulations because the 1976 Act was not effective until January 1, 1978.⁵⁴

The Register of Copyrights refused Esquire's application for copyright protection.⁵⁵ The Register cited regulation 202.10(c) as precluding registration of the designs of utilitarian articles, such as lighting fixtures, "when all of the design elements . . . are directly related to the useful functions of the article."⁵⁶ According to the Register, the lighting fixtures or their overall shape did not contain "elements, either alone or in combination, which are capable of independent existence as a copyrightable" work of art under the 1909 Act.⁵⁷

Esquire argued that it designed its lighting fixtures with the intent of creating modern art.⁵⁸ Under regulation 202.10, Esquire maintained, "that as long as the overall shape of a utilitarian article embodies *dual* intrinsic functions—aesthetic and utilitarian—that shape may qualify for registration."⁵⁹ Hence, Esquire contended that the sole intrinsic function of its lighting fixtures was not utility; rather, they also possessed aesthetic functions properly warranting copyright protection.⁶⁰ The district court agreed with Esquire and found that the lighting fixture's "sole intrinsic function" was not utility in that the fixtures served "both to decorate and illuminate."⁶¹ The court held that the lighting fixtures were proper subject matter warranting copyright protection.⁶² However, after acknowledging that the 1976 Act was not applicable to the instant question, the United States Court of Appeals for the District of Columbia Circuit reversed the lower court's decision and denied copyright registration based on an examination of the Act's statutory language and legislative history.⁶³

53. See *id.* at 798-99.

54. See *id.* at 799 n.8; Raskin, *supra* note 6, at 177.

55. See *Esquire*, 591 F.2d at 798.

56. *Id.* (quoting 37 C.F.R. § 202.10(c) (1976)). "Form follows function, in the credo of one school of art." *Id.* at 807 (Leventhal, J., concurring).

57. *Id.* at 798 (footnote omitted).

58. See *id.* at 800.

59. *Id.* at 804.

60. See *id.* at 800, 804.

61. *Esquire, Inc. v. Ringer*, 414 F. Supp. 939, 941 (D.D.C. 1976), *rev'd*, 591 F.2d 796 (D.C. Cir. 1978).

62. See *id.*

63. See *Esquire*, 591 F.2d at 799 n.8, 802-05.

2. Examining Protection After the 1976 Act

Whereas regulation 202.10(c) defined articles as useful if their “sole intrinsic function” was their utility, the 1976 Copyright Act denies copyright protection to articles “even if [their] *sole* intrinsic function is *not* utility.”⁶⁴ Under the 1976 Act, articles are defined as useful if such articles possess “*an* intrinsic utilitarian function.”⁶⁵ Hence, “articles which are functional only in their appearance have an intrinsic aesthetic function [and are copyrightable], whereas objects which have a use beyond mere appearance have an intrinsic utilitarian function [and are not copyrightable].”⁶⁶

The 1976 Act broadly defines an article as “useful” and not subject to copyright protection if it possesses *any* intrinsic use or function beyond merely portraying the appearance of the article or conveying information. Courts have generally interpreted any use beyond portraying appearance or conveying information under the 1976 Act as an intrinsic utilitarian function.⁶⁷ Under these interpretations, for example, Esquire could not have argued that its lighting fixtures were copyrightable sculptural works *because* they possessed an additional use, i.e., to illuminate, beyond merely portraying appearance or conveying information. This additional use would have qualified the lighting fixtures as useful articles under the 1976 Act.

64. Mark A. LoBello, *The Dichotomy Between Artistic Expression and Industrial Design: To Protect or Not to Protect*, 13 WHITTIER L. REV. 107, 127 (1992).

65. 17 U.S.C. § 101 (1996) (emphasis added) (“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.”).

66. Raskin, *supra* note 6, at 208. Courts have generally interpreted any use beyond portraying appearance as an intrinsic utilitarian function. *See, e.g.,* Mazer v. Stein, 347 U.S. 201 (1954); Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903); Masquerade Novelty, Inc. v. Unique Indus., 912 F.2d 663 (3d Cir. 1990); Whimsicality, Inc. v. Rubie’s Costume Co., 891 F.2d 452 (2d Cir. 1989); Brandir Int’l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142 (2d Cir. 1987); Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985); Poe v. Missing Persons, 745 F.2d 1238 (9th Cir. 1984); Fabrica Inc. v. El Dorado Corp., 697 F.2d 890 (9th Cir. 1983); Norris Indus. v. International Tel. & Tel. Corp., 696 F.2d 918 (11th Cir. 1983); Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980); Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978); Gay Toys, Inc. v. Buddy L Corp., 522 F. Supp. 622 (E.D. Mich. 1981), *rev’d*, 703 F.2d 970 (6th Cir. 1983); Ted Arnold Ltd. v. Silvercraft Co., 259 F. Supp. 733 (S.D.N.Y. 1966).

Recently, however, some courts have recognized that simply because certain articles possess utilitarian functions does not mean such functions are intrinsic to those articles. *See, e.g.,* Poe, 745 F.2d at 1241-42; Gay Toys, 703 F.2d at 973-74.

67. *See supra* note 66 and cases cited therein.

Considering the legislative history of the 1976 Act, the court in *Esquire* observed that

[i]n deleting the modifier “sole” from the language taken from § 202.10(c), the draftsmen of the 1976 Act must have concluded that the definition of “useful article” would be more precise without this term. Moreover, Congress may have concluded that literal application of the phrase “sole intrinsic function” would create an unworkable standard. For as one commentator has observed, “[t]here are no two-dimensional works and few three-dimensional objects whose design is absolutely dictated by utilitarian considerations.”⁶⁸

The principal provisions of regulation 202.10(c) are retained in present statutory language.⁶⁹ Eligible articles warranting copyright protection under the 1909 Act were defined as “works of art.”⁷⁰ The 1976 Act replaced this term with a more precise definition of

68. *Esquire*, 591 F.2d at 804 (quoting Comment, *Copyright Protection for Mass-Produced, Commercial Products: A Review of the Developments Following Mazer v. Stein*, 38 U. CHI. L. REV. 807, 812 (1971)).

The 1976 Act defines pictorial, graphic, or sculptural features as “works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned” 17 U.S.C. § 101.

The inspiration for this definition *supra* stems from Copyright Office Regulation 202.10(c) under the 1909 Act. See *supra* notes 46-65 for a discussion of 37 C.F.R. § 202.10(c) (1957). Section 101 and § 202.10(c) are virtually identical.

The only difference is that the 1909 Regulation would have denied copyright to an attractive article only if “the sole intrinsic function” of the article is utility. The 1976 Act, however, would deny copyright to the shape of a utilitarian article even if its *sole* intrinsic function is *not* utility. Thus, “a work is a ‘useful article’ and therefore denied copyright for its shape as such, if it has ‘an intrinsic utilitarian function.’” . . . The narrow avenue of potential protection under the [1976 Act] is based on the nature of the design. Even if the article has aesthetic features, the separability test will provide protection only to those aspects that can actually be identified independent of any functional considerations.

LoBello, *supra* note 64, at 127 (quoting 1 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 2.08[B] (1988)). Unfortunately, the legislative history of the 1976 Act does not account for this statutory change between “the sole intrinsic function” of an article and “an intrinsic function.” It is unclear whether Congress intended to narrow the scope of protection afforded useful articles or whether this change in language was merely an oversight in drafting § 101.

69. See 17 U.S.C. §§ 101-810 (1994); Miziolek, *supra* note 51, at 926 n.28 (“Regulations 202.10(c) and 202.10(a) were both impliedly repealed by the 1976 Copyright Act”) (citing 17 U.S.C. §§ 101-810 (1976)).

70. See Copyright Act of 1909, 17 U.S.C. §§ 1-216, amended by 17 U.S.C. §§ 101-810 (1978) (current version at 17 U.S.C. §§ 101-1101 (1994)).

“pictorial, graphic, and sculptural works.”⁷¹ This new definition includes useful articles only to the extent that they embody features qualifying as pictorial, graphic, or sculptural works that are capable of existing independently of, and separately from the article.⁷²

In short, the extent to which articles serving utilitarian functions may properly receive copyright protection under the 1976 Act depends on whether such articles are defined as useful. The designs of useful articles are copyrightable insofar as pictorial, graphic, or sculptural⁷³ features “can be identified separately . . . and are capable of existing independently” of the utilitarian aspects of such articles.⁷⁴ Accordingly, the development and evolution of what constitutes an intrinsic utilitarian function must be considered in order to determine a definition for useful articles.

B. *How Intrinsic Utilitarian Functions Are Defined*

The 1976 Act fails to articulate clearly whether and when utilitarian functions serve as *intrinsic* utilitarian functions of useful articles. The Act does not define what may constitute “intrinsic utilitarian functions.” It is necessary, then, to examine the legislative history of the 1976 Act for additional explanation and further guidance.

1. Legislative History

The 1976 House Report (“Report”) observes that the copyrightability of pictorial, graphic, and sculptural works does not mean that protection stems from “artistic taste, aesthetic value, or intrinsic quality.”⁷⁵ Much of the Report’s introduction reviews the historical development of protection for useful articles.⁷⁶ Starting with *Mazer*, the Report acknowledges “that protection subsists de-

71. 17 U.S.C. § 101 (1994).

72. *See id.*

73. Note that under the 1909 Act the term used to define copyrightable articles was “works of art.” *See supra* notes 34-38 and accompanying text.

74. 17 U.S.C. § 101.

75. H.R. REP. No. 94-1476, at 54 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5667. Copyright protection does not depend on an article’s artistic value. In his famous copyright caveat, Justice Holmes warned that “[i]t would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.” *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). *See also* Raskin, *supra* note 6, at 178-80 for a further discussion on the legislative reports of the 1976 Copyright Act.

76. *See* H.R. REP. No. 94-1476, at 47-50, 53, *reprinted in* 1976 U.S.C.C.A.N. at 5660-63, 5666-67. *See also supra* Part I.A for a discussion on the development of copyright protection concerning useful articles.

spite factors such as mass production, commercial exploitation, and the potential availability of design patent protection."⁷⁷ Purporting to draw "as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design," the Report states that Congressional intent is not to afford copyright protection to the shapes of industrial articles even though they may be aesthetically pleasing.⁷⁸ Hence,

although the shape of an industrial product may be aesthetically satisfying and valuable, [Congress'] intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design—that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable.⁷⁹

The above language does not establish any guidelines to determine whether something qualifies as a useful article. The Report merely reiterates a familiar definition, in that, useful articles are articles having an intrinsic utilitarian function that does more than simply portray appearance or convey information.⁸⁰ Though the Report cites examples of "utilitarian articles such as textile fabrics, wallpaper, containers, and the like," e.g., automobiles, planes, and industrial products,⁸¹ nowhere does the Report specify what constitutes an intrinsic utilitarian function.

Unfortunately, the line between copyrightable pictorial, graphic, or sculptural works and uncopyrightable industrial designs is not so clear as to permit an immediate understanding of when articles seeking copyright protection are considered useful for copyright purposes. The task of ascertaining this distinction falls to the

77. Raskin, *supra* note 6, at 178 (citing H.R. REP. NO. 94-1476, at 54, *reprinted in* 1976 U.S.C.C.A.N. at 5667-68).

78. H.R. REP. NO. 94-1476, at 55, *reprinted in* 1976 U.S.C.C.A.N. at 5668-69; *see also* LoBello, *supra* note 64, at 115.

79. H.R. REP. NO. 94-1476, at 55, *reprinted in* 1976 U.S.C.C.A.N. at 5668-69.

80. *See id.* at 54, *reprinted in* 1976 U.S.C.C.A.N. at 5667-68.

81. *Id.* at 55, *reprinted in* 1976 U.S.C.C.A.N. at 5667-68.

judiciary. Accordingly, judicial interpretations of intrinsic utilitarian functions must be considered in order to determine what makes up a useful article subject to the separability test.

2. Judicial Interpretations

Neither the 1976 Act nor its legislative history provide any instructions to determine whether utilitarian functions are intrinsic to particular articles. "Since useful articles are defined as articles which have an 'intrinsic utilitarian function,' the scope of this definition lies in the interpretation of what is meant by 'intrinsic.'"⁸² Generally, courts have considered uses,⁸³ i.e., functions, beyond portraying appearance or conveying information as intrinsic utilitarian functions under the 1976 Act.

The first court to examine the language of the 1976 House Report was the Second Circuit in *Kieselstein-Cord v. Accessories by Pearl, Inc.*⁸⁴ At issue in *Kieselstein* were designer belt buckles. In his majority opinion, Judge Oakes noted that "these [were] not ordinary buckles; they [were] sculptured designs cast in precious metals—decorative in nature and used as jewelry is . . . , principally for ornamentation."⁸⁵ The designer of the belt buckles successfully registered his belt buckles with the Copyright Office as original sculptures and designs.⁸⁶ The defendant admitted to copying the designs but asserted that the buckles qualified as "useful articles" under the 1976 Act and were not entitled to copyright protection because no "pictorial, graphic, or sculptural features [could be] identified separately," whether physically or conceptually, from the "utilitarian aspects' of the buckles."⁸⁷

Agreeing with the defendant that the belt buckles were useful articles, Judge Oakes, however, found protectable design elements conceptually separable from the utilitarian aspects of the buckles.⁸⁸ Unfortunately, Judge Oakes did not discuss any pertinent utilitarian aspects of the buckles or what intrinsic utilitarian functions subsisted in the buckles to qualify them as useful articles subject to the separability test. Indeed, the only reference to utility is Judge

82. Raskin, *supra* note 6, at 208 (citation omitted).

83. "Use" is defined as "a particular service or end," for example, "purpose, object, [or] function." WEBSTER'S THIRD NEW INT'L DICTIONARY 2523 (1976).

84. 632 F.2d 989 (2d Cir. 1980).

85. *Id.* at 990.

86. *See id.* at 990-91.

87. *Id.* at 991-92.

88. *See id.* at 993.

Oakes' observation that "[t]he primary ornamental aspect of the [belt] buckles is conceptually separable from their subsidiary utilitarian function."⁸⁹ Judge Oakes never stated what constituted this "subsidiary utilitarian function."

Judge Weinstein did not forget the significance of considering the utilitarian functions of the buckles in his dissent. "The works sued on are . . . indubitably belt buckles and nothing else; their innovations of form are inseparable from the important function they serve—helping to keep the tops of trousers at waist level."⁹⁰ Though his discussion focused on the issue of conceptual separability, Judge Weinstein cited other examples of what qualified as useful articles, including telephones, "piggy-banks," scarves, dinnerware, lighting fixtures, shoes, watchfaces, socks, and clothes.⁹¹ Yet, neither Judge Oakes' majority opinion nor Judge Weinstein's dissenting opinion offer any insight as to what utilitarian functions are considered intrinsic to the above articles. As a result, *Kieselstein* accepts without argument that utilitarian functions beyond aesthetic functions are intrinsic to the articles in question, e.g., that an intrinsic utilitarian function of belt buckles is keeping pants from falling below waistlines.

Subsequent to *Kieselstein*, the Second Circuit decided *Carol Barnhart Inc. v. Economy Cover Corp.*⁹² The plaintiff in *Barnhart* alleged copyright infringement of four human torso display forms.⁹³ As in *Kieselstein*, the defendant admitted to copying the plaintiff's works, but denied liability on the grounds that the mannequins were utilitarian articles that did not possess separable artistic elements which could be subject to copyright.⁹⁴ The Second Circuit agreed, and denied copyright protection because the mannequins could not satisfy the separability test.⁹⁵

Moreover, as in *Kieselstein*, the court paid small deference to the question of usefulness. The court accepted without argument that the plaintiff's works were useful articles as defined in the 1976 Act.⁹⁶ Noting that the mannequins' function is to display clothes,

89. *Id.*

90. *Id.* at 994 (Weinstein, J., dissenting).

91. *Id.* at 996 (Weinstein, J., dissenting) (citations omitted).

92. 773 F.2d 411 (2d Cir. 1985).

93. *See id.* at 413.

94. *See id.*

95. *See id.* at 418-19.

96. *See id.* at 414-15 ("[s]ince the [mannequins] are concededly useful articles, the crucial issue in determining their copyrightability is" the question of physical or conceptual separability).

the court found no protectable aesthetic or artistic qualities separable from the utilitarian aspects of the articles under the separability test.⁹⁷ Indeed, Judge Newman's dissent emphasized the indisputable nature of the mannequins' usefulness: "each has the 'intrinsic utilitarian function' of serving as a means of displaying clothing and accessories to customers of retail stores."⁹⁸

The utilitarian function of these articles obviously extends beyond merely portraying the mannequins' appearance. However, the court did not discuss why or explain how the function of displaying or modeling clothing qualifies as an intrinsic utilitarian function. *Barnhart* is a good example of accepting *any* use—aside from portraying appearance or conveying information—as an intrinsic utilitarian function.

Two years later, in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*,⁹⁹ the Second Circuit was presented with another opportunity to examine the definitional scope of intrinsic utilitarian functions. At issue in *Brandir* was the copyrightability of bicycle racks.¹⁰⁰ These racks were formed from continuous undulating pieces of steam pipe bent into form "to permit parking under as well as over the rack's curves. . . . Its undulating shape is said . . . to permit double the storage of conventional bicycle racks."¹⁰¹ The court held that the bicycle racks, as useful articles, did not satisfy the separability test and were therefore not subject to copyright.¹⁰²

Adopting a standard suggested by Professor Denicola,¹⁰³ the court approached the question of copyrightability by examining "the relationship between the proffered work and the process of industrial design."¹⁰⁴ The court noted "that 'the dominant characteristic of industrial design is the influence of nonaesthetic, utilitarian concerns'" and concluded "that copyrightability 'ultimately depend[s] on the extent to which the work reflects artistic expression uninhibited by functional considerations.'"¹⁰⁵ In other words, "if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be con-

97. *See id.* at 418.

98. *Id.* at 420 (Newman, J., dissenting).

99. 834 F.2d 1142 (2d Cir. 1987).

100. *See id.* at 1143.

101. *Id.* at 1146-47.

102. *See id.* at 1148.

103. *See generally* Denicola, *supra* note 6, at 741-42.

104. *Brandir*, 834 F.2d at 1145 (quoting Denicola, *supra* note 6, at 741).

105. *Id.* (quoting Denicola, *supra* note 6, at 741).

ceptually separable from the utilitarian elements."¹⁰⁶ The court approached the problem of copyrightability from a design oriented perspective, "derogating protection on grounds of functional considerations."¹⁰⁷ Hence, the court recognized the significant role utilitarian functions play in the analysis of determining the scope of copyright protection.

The court proceeded to examine the manufacturing history behind the development of the bicycle racks.¹⁰⁸ The court observed that the original design of the racks stemmed from wire sculptures formed from continuous undulating pieces of wire.¹⁰⁹ The sculptures were created and displayed "as a means of personal expression, but apparently were never sold [as works of art]."¹¹⁰ Their utilitarian function was not discovered until a bicycle enthusiast suggested to the designer that the sculptures could serve as excellent bike racks, "permitting bicycles to be parked under the overloops as well as on top of the underloops."¹¹¹ The designer then met with Brandir several times before negotiating a deal to manufacture the design as Brandir RIBBON Racks.¹¹²

Brandir spent some \$100,000 on advertising and promotional literature, targeting architectural and landscaping magazines.¹¹³ RIBBON Racks were featured in *Popular Science*, *Art and Architecture*, and *Design 384* magazines.¹¹⁴ The design won an Industrial Designers Society of America award in the spring of 1980.¹¹⁵ Moreover, sales of RIBBON Racks exceeded \$1.3 million, ranging in price from \$395 to \$2,025 for stainless steel models.¹¹⁶

The court held that the bicycle racks were not copyrightable because they did not satisfy the separability test.¹¹⁷ In support of its holding, the court noted that the design was influenced in significant measures by utilitarian concerns.¹¹⁸ The court stated that

[i]n creating the RIBBON Rack, the designer has clearly adapted

106. *Id.*

107. LoBello, *supra* note 64, at 124.

108. *See Brandir*, 834 F.2d at 1146.

109. *See id.*

110. *Id.*

111. *Id.*

112. *See id.*

113. *See id.*

114. *See id.*

115. *See id.*

116. *See id.*

117. *See id.* at 1148.

118. *See id.* at 1147.

the original aesthetic elements to accommodate and further a utilitarian purpose. These altered design features of the RIB-BON Rack, including the spacesaving, open design achieved by widening the upper loops to permit parking under as well as over the rack's curves, the straightened vertical elements that allow in- and above-ground installation of the rack, the ability to fit all types of bicycles and mopeds, and the heavy-gauged tubular construction of rustproof galvanized steel, are all features that combine to make for a safe, secure, and maintenance-free system of parking bicycles and mopeds.¹¹⁹

The court found that "form and function were inextricably intertwined, . . . [t]he design being as much the result of utilitarian pressures as aesthetic choices. Indeed, the visually pleasing proportions and symmetry of the rack represent design changes made in response to functional concerns."¹²⁰ Unable to separate artistic elements physically or conceptually from utilitarian aspects, the court denied copyright protection.¹²¹

The court's analysis of how useful articles develop from original works of art suggests an approach in determining whether a particular use constitutes an intrinsic utilitarian function of an article seeking copyright protection. Factors the court examined in determining the usefulness of the racks included: how much the bicycle racks differed in design from the sculptural wire-work, the utilitarian reasons behind such design changes, manufacturing considerations and materials, advertising costs, how the rack was promoted, and sales.¹²² These factors tend to establish the degree of an article's functionality in relation to its artistic elements. Hence, under *Brandir*, it is possible to draw distinctions between mere utilitarian functions and intrinsic utilitarian functions because the Second Circuit, as well as Professor Denicola, recognize that functionality exists in various states of degrees.¹²³

*Gay Toys, Inc. v. Buddy L Corp.*¹²⁴ further demonstrates that simply because articles have uses that go beyond portraying appearances or conveying information does not mean that such uses are intrinsic utilitarian functions of these articles.¹²⁵ The Sixth Circuit in *Gay Toys* recognized that there is a definitional difference be-

119. *Id.*

120. *Id.*

121. *See id.* at 1148.

122. *See id.* at 1146-47.

123. *See id.* at 1145-48; Denicola, *supra* note 6, at 741-47.

124. 703 F.2d 970 (6th Cir. 1983).

125. *See id.* at 973.

tween utilitarian functions and intrinsic utilitarian functions. The issue raised on appeal in *Gay Toys* was whether toys, in this case, model airplanes, were copyrightable subject matter under the 1976 Act.¹²⁶ The district court had asked whether the toy planes possessed any utility, and concluded that “[t]oys are useful.”¹²⁷ “A plane,” the court reasoned, “is a thing to play with. Play is an integral part of growing up. Children need toys. A toy airplane is useful and possesses utilitarian and functional characteristics in that it permits a child to dream and to let his or her imagination soar.”¹²⁸ Finding that toys met the definitional requirements of section 101 of the 1976 Act, the district court held that toys are useful articles and not copyrightable.¹²⁹

The Sixth Circuit began its discussion by reviewing the legislative history of the 1976 Act.¹³⁰ The court stated that

it might be argued that certain changes made by the 1976 Act broaden the “useful article” exception. The exception that developed under the 1909 Act disallowed copyright protection to articles whose *sole* intrinsic function was utility. On the other hand, the 1976 Act disallows copyright protection to articles which have *an* intrinsic utilitarian function.¹³¹

The court, however, read Congress’ intent to exclude from copyright protection industrial products such as automobiles, food processors, and television sets.¹³² The court said that toys function more like paintings in that they are to be looked at and enjoyed.¹³³ “The function of toys is much more similar to that of works of art than it is to the ‘intrinsic utilitarian function’ of industrial products.”¹³⁴ Acknowledging that toys are meant to be played with, a use beyond merely portraying appearance or conveying information, the court declared that not all uses beyond portraying appear-

126. *See id.* at 971.

127. *See Gay Toys, Inc. v. Buddy L Corp.*, 522 F. Supp. 622, 625 (E.D. Mich. 1981), *rev’d*, 703 F.2d 970 (6th Cir. 1983).

128. *Id.*

129. *See id.* at 626-27.

130. *See Gay Toys*, 703 F.2d at 973. *See also supra* Part I.B.1 for a discussion of the 1976 Act’s legislative history.

131. *Gay Toys*, 703 F.2d at 973-74 (citing Melville B. Nimmer, *The Subject Matter of Copyright Under the Act of 1976*, 24 UCLA L. REV. 978, 1001-03 (1977)). *See supra* note 68 and accompanying text for a discussion on this point.

132. *See Gay Toys*, 703 F.2d at 973 (citing H.R. REP. No. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668).

133. *See id.*

134. *Id.*

ances are intrinsic utilitarian functions. Hence, toys are not useful articles because they “do not even have *an* intrinsic function other than the portrayal of the real item” as a matter of law; rather, they are copyrightable pictorial, graphic, or sculptural works.¹³⁵

A year after *Gay Toys*, the Ninth Circuit decided *Poe v. Missing Persons*.¹³⁶ The court in *Poe* had to decide whether a bathing suit served as a utilitarian article of clothing or as a copyrightable sculptural work.¹³⁷ Titled “Aquatint No. 5,” Gregory Poe described his swimsuit “as an eccentric and controversial” piece of art and not clothing.¹³⁸ Poe sued for copyright infringement because defendants had published a photograph of the swimsuit on an album cover without Poe’s permission.¹³⁹ The defendants conceded that Poe designed the article, but that as a swimsuit, it was an uncopyrightable useful article.¹⁴⁰ Poe appealed the district court’s granting of the defendants’ motion for summary judgment on the grounds that there existed a disputed issue of material fact as to whether “Aquatint No. 5” was a utilitarian article of clothing or a copyrightable work of art.¹⁴¹

On appeal, the defendants cited *Gay Toys, Inc. v. Buddy L Corp.*¹⁴² to support their position that usefulness is a question of law and not fact.¹⁴³ The court, however, distinguished *Gay Toys* from the present case by observing that “[n]o factual issue was presented as to whether the copied articles were toys. The Sixth Circuit held in *Gay Toys* that toy airplanes are protectible because they have no intrinsic utilitarian function other than to portray real airplanes.”¹⁴⁴ The issue before the Ninth Circuit was whether Poe designed a functional swimsuit or a copyrightable pictorial, graphic, or sculptural work.¹⁴⁵

The court noted that Poe’s swimsuit could potentially be used as an article of clothing based on evidence showing that it was worn

135. *Id.* at 974 (holding that toys do not have intrinsic functions other than to portray their own appearances).

136. 745 F.2d 1238 (9th Cir. 1984).

137. *See id.* at 1239, 1241.

138. *Id.* at 1240.

139. *See id.* at 1239.

140. *See id.*

141. *See id.*

142. 703 F.2d 970 (6th Cir. 1983). *See also supra* notes 124-35 and accompanying text for a discussion on *Gay Toys*.

143. *See Poe*, 745 F.2d at 1242.

144. *Id.* at 1242-43.

145. *See id.* at 1243.

for modeling purposes.¹⁴⁶ However, the court did not decide whether Poe “created an article of clothing which can *function* as a swimsuit.”¹⁴⁷ In other words, the court recognized that Poe’s swimsuit might possess a “use” beyond portraying its own appearance; but the court did not decide whether such use constituted an intrinsic utilitarian function beyond merely portraying appearance. Instead, the court remanded the case for trial in order to determine whether Aquatint No. 5 possessed an intrinsic utilitarian function beyond portraying appearance so as to be considered a useful article properly subject to the separability test.¹⁴⁸

The Ninth Circuit identified four factors relevant to the question of usefulness:

- (1) expert evidence may be offered concerning the usefulness of the article and whether any apparent functional aspects can be separated from the artistic aspects;
- (2) evidence of Poe’s intent in designing the article may be relevant in determining whether it has a utilitarian function;
- (3) testimony concerning the custom and usage within the art world and the clothing trade concerning such objects also may be relevant; and
- (4) the district court may also consider the admissibility of evidence as to Aquatint No. 5’s marketability as a work of art.¹⁴⁹

As in the *Brandir* case, these factors focus on the degree of functionality in relation to artistic elements. Moreover, *Poe* illustrates the significance of determining whether particular uses of articles, perhaps utilitarian in nature, are intrinsic utilitarian functions of the articles. This question is not decided as a matter of law; rather, it is more appropriately decided as a question of fact.

In deciding whether animal mannequins constituted useful arti-

146. *See id.* at 1241.

147. *Id.* at 1242.

148. *See id.* at 1242-43.

149. *Id.* at 1243 (citing *Norris Indus., Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (“useful” articles are those “designed primarily to serve a utilitarian function”); *May v. Morganelli-Heumann & Assocs.*, 618 F.2d 1363, 1368 (9th Cir. 1980) (genuine dispute as to custom and usage within architectural profession precludes summary judgment); *Saxony Prods. v. Guerlain, Inc.*, 513 F.2d 716 (9th Cir. 1975) (district court erred in granting summary judgment after conducting a perfume “sniff test”); *Trans-World Mfg. v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95, 99 (D. Del. 1982) (refusing summary judgment on copyrightability of eyeglass display case, and that stating “such a conclusion should be made by the trier of fact on the basis of expert testimony rather than as a matter of law by this Court”); 1 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 2.08[B] (1984) (suggesting that courts might look to see if an article with no utilitarian use would still be marketable to some significant segment of the community simply because of its aesthetic qualities)) (footnote omitted).

cles, the Fourth Circuit recently had an opportunity to address this issue as a question of fact in *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*¹⁵⁰ In that case, the defendant argued that the plaintiff's mannequins were not copyrightable sculptural works because they possessed "the utilitarian function of acting as mounts for animal skins for display."¹⁵¹ In determining the usefulness of plaintiff's mannequins, however, the court noted that the defendant's argument overlooked the distinction between mannequins and plastic foam pellet stuffing used in taxidermy.¹⁵²

A mannequin provides the creative form and expression of the ultimate animal display, whereas pellets do not. Even though covered with a skin, the mannequin is not invisible but conspicuous in the final display. The angle of the animal's head, the juxtaposition of its body parts, and the shape of the body parts in the final display is little more than the portrayal of the underlying mannequin. . . . Thus, any utilitarian aspect of the mannequin exists "merely to portray the appearance" of the animal.¹⁵³

The court emphasized that the author's portrayal of the animal form exists in the final product.¹⁵⁴ "It is the portrayal of the animal's body expression given by the mannequin that is thus protectable under the Copyright Act."¹⁵⁵ The court found that the mannequins' usefulness subsisted in their portrayal of the appearance of animals.¹⁵⁶ The Fourth Circuit effectively held that the mannequins' use of acting as mounts for animal skins for display was insufficient to qualify as an intrinsic utilitarian function. Although the animal mannequins possessed a utilitarian function beyond merely portraying appearance, i.e., to act as mounts, the court found that the mannequins' primary function was to portray animal expressions and that this function outweighed their utilitarian function to act as animal skin mounts.

In sum, courts have generally considered articles possessing uses beyond portraying appearance or conveying information as intrinsic utilitarian functions making such articles useful articles as

150. 74 F.3d 488 (4th Cir. 1996).

151. *Id.* at 493.

152. *See id.* at 493-94.

153. *Id.* (quoting 17 U.S.C. § 101 (1994)).

154. *See id.*

155. *Id.* (citing *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663 (3d Cir. 1990); *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1507 (9th Cir. 1987); *Kamar Int'l, Inc. v. Russ Berrie and Co.*, 657 F.2d 1059, 1061 (9th Cir. 1981)).

156. *See id.* at 494.

defined by the 1976 Act.¹⁵⁷ Indeed, these courts seemed more than anxious to assume usefulness¹⁵⁸ so as to grapple with the concept of separability. On the other hand, some courts recognize that simply because certain articles possess utilitarian functions does not mean such functions are intrinsic to those articles.¹⁵⁹ The challenge, then, is to strike a balance between these extremes to determine what constitute intrinsic utilitarian functions.

One approach to this inquiry is "to err" in favor of over-protection.¹⁶⁰ Unfortunately, broadening the scope of protection, when unnecessary, undermines the goals of copyright protection because it comes at the expense of public welfare.¹⁶¹ *Gay Toys* is a good example of over-protection. *Gay Toys* could be broadly read to suggest that toys are copyrightable pictorial, graphic, or sculptural works as a matter of law because they do not possess an intrinsic utilitarian function other than to portray appearance.¹⁶² *Poe* suggests, however, that determining whether something should properly be defined as useful is not a question of law; rather, it is a question of fact.¹⁶³ The question remains, however, as to how intrinsic utilitarian functions are defined.

Moreover, neither the 1976 Act nor its legislative history provide any instructions to determine whether particular uses qualify as intrinsic utilitarian functions. The judiciary has also been unsuccessful in establishing guidelines to determine whether articles possessing utilitarian functions constitute intrinsic utilitarian functions. Hence, this paper suggests the following analysis to determine the definitional scope of intrinsic utilitarian functions in relation to articles seeking copyright protection.

II. ANALYSIS

Distinguishing art from useful articles is inevitably subjective

157. See *supra* note 66 and cases cited therein.

158. In other words, courts have seemed more than anxious to assume that most articles possess an intrinsic utilitarian function beyond portraying appearance or conveying information so that they may address the issue of separability.

159. See, e.g., *Superior Form*, 74 F.3d at 493 (finding mannequin use as animal skin mount insufficient to qualify as intrinsic utilitarian function); *Poe v. Missing Persons*, 745 F.2d 1238, 1241-42 (9th Cir. 1984); *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 973-74 (6th Cir. 1983).

160. See, e.g., *Raskin*, *supra* note 6, at 209-10.

161. See *supra* notes 18-20 and accompanying text.

162. See *Gay Toys*, 703 F.2d at 974 ("[T]oys do not even have an intrinsic function other than the portrayal of the real item.").

163. See *Poe*, 745 F.2d at 1242-43.

and arbitrary.¹⁶⁴ Congress has evidenced, however, its concern that granting copyright protection to useful articles would stifle progress in the arts and sciences.¹⁶⁵ Copyright protection grants copyright owners exclusive rights,¹⁶⁶ and protecting functional aspects of useful articles would effectively deliver a monopoly to the owners over their respective articles. This would have a chilling effect on others to create and contribute to the arts and sciences.¹⁶⁷ This result is contrary to the ultimate goals of copyright legislation in that the purpose of copyright is to promote art and science for public welfare.¹⁶⁸ Protecting the rights of authors is seen as a necessary means for such promotion.¹⁶⁹ "Without assurance of protection, many authors would be discouraged from creative activity, and progress would lag."¹⁷⁰ Authors are encouraged to create for the public benefit because they are assured of receiving the fruits of their labors by granting them exclusive rights in their works for a limited term.¹⁷¹

The challenge is striking a balance between granting enough protection to encourage creation and too much protection which discourages, indeed, may prohibit others from pursuing their own efforts in a similar field.¹⁷² "The law concerning the protection of useful articles has shown just how difficult this balancing can become, especially when commercial products are involved and much of the economy depends on competition within commercial fields."¹⁷³ Therefore, before determining the appropriate scope of copyright protection, the first step in balancing the interests between public progress and authors' rights is to define whether the

164. See, e.g., Raskin, *supra* note 6, at 195.

165. See H.R. REP. No. 94-1476, at 54-55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5667-69; see also *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985); Raskin, *supra* note 6, at 195.

166. 17 U.S.C. § 106 (1994).

167. See *Mazer v. Stein*, 347 U.S. 201, 219 (1954); 1 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 1.03[A] (1994); Raskin, *supra* note 6, at 195.

168. See U.S. CONST. art. I, § 8, cl. 8 (Congress has the power to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .").

169. See *Mazer*, 347 U.S. at 219; NIMMER, *supra* note 167, § 1.03[A]; Raskin, *supra* note 6, at 195-96.

170. Raskin, *supra* note 6, at 196; see also *Mazer*, 347 U.S. at 219; NIMMER, *supra* note 167, § 1.03[A].

171. See *Mazer*, 347 U.S. at 219; REPORT ON THE GENERAL REVISION, *supra* note 15, at 3-6; NIMMER, *supra* note 167, § 1.03[A].

172. See Raskin, *supra* note 6, at 196.

173. Raskin, *supra* note 6, at 196 (footnote omitted).

article seeking protection is a pictorial, graphic, or sculptural work or a useful article under the 1976 Act.

For example, the Sixth Circuit approached this question by weighing the usefulness of toy airplanes against their aesthetic appeal in *Gay Toys*. The court recognized that "a toy airplane is to be played with and enjoyed, but a painting of an airplane, which is copyrightable, is to be looked at and enjoyed."¹⁷⁴ Observing that "[t]he intention of Congress was to exclude from copyright protection *industrial* products such as automobiles, food processors, and television sets,"¹⁷⁵ the court analogized "[t]he function of toys . . . to that of works of art" because "toys do not even have *an* intrinsic function other than the portrayal of the real item."¹⁷⁶

The holding in *Gay Toys*, however, could be read overly inclusive as granting too much protection by categorizing all toys as proper subject matter warranting copyright protection. Under the Sixth Circuit's analysis, one is hard pressed to find any toy that might qualify as a useful article, because the court held as a matter of law that the only intrinsic function of toys is to portray appearance.¹⁷⁷ Basing copyright protection as to an entire class of articles is inconsistent with the basic premises of copyright protection.¹⁷⁸ Such a ruling undermines the purpose of copyright law because it comes at the expense of promoting the public interest.¹⁷⁹

Drawing an analytical starting point before addressing the appropriate scope of an article's copyright protection is analogous to Judge Oakes' analysis concerning conceptual separability in *Kiesel-*

174. *Gay Toys*, 703 F.2d at 973.

175. *Id.* (emphasis added).

176. *Id.* at 973-74.

177. *See id.* Moreover, in a 1910 regulation defining "works of art" under the 1909 Act, the Copyright Office declared that "[n]o copyright exists in toys, games, [or] dolls." COPYRIGHT OFFICE RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT, BULL. No. 15, § 12(g) (1910); *see also* Denicola, *supra* note 6, at 710 n.20.

178. *Cf.* Note, *supra* note 21, at 1525. "[A]ny attempt to base copyright on a generalization as to an entire functional class seems inconsistent with the growing recognition that even the most narrowly utilitarian objects, if imaginatively designed, can be a source of aesthetic pleasure." *Id.* Indeed, there may exist toys whose "sole intrinsic function" is that of utility. For example, the KOOSH ball in *OddzOn Products, Inc. v. Oman*, 924 F.2d 346, 346 (D.C. Cir. 1991), was found to have been developed "to teach youngsters with poor eye-to-hand coordination how to play catch." *Id.* at 347. Though not raised on appeal, the court raised the question as to how the toy might be properly defined, i.e., as a useful article or as a copyrightable sculptural work. *See id.* at 350.

179. *See supra* notes 15-17, 165-71 and accompanying text.

stein-Cord.¹⁸⁰ In addressing this question, Judge Oakes suggested that if aesthetic features are “primary,” then conceptual separability exists.¹⁸¹ Similarly, shifting this inquiry to usefulness and determining that aesthetic qualities are primary,¹⁸² may weigh against finding the article seeking copyright protection to be useful. In short, under a “primary functional significance” analysis, if an article’s primary functionality is aesthetic rather than utilitarian, then the article should properly be defined as a pictorial, graphic, or sculptural work warranting copyright protection.¹⁸³ Conversely, if an article’s utilitarian considerations outweigh its aesthetic qualities, the article should be defined under the 1976 Act as an unprotectable useful article.

The analysis begins by examining the specific article seeking copyright protection in order to define the article as a pictorial, graphic, or sculptural work or a useful article. The Copyright Office or courts should first consider potential functions of the article, i.e., whether uses of the article include aesthetic or utilitarian functions or both. For example, the district court in *Gay Toys* held that a utilitarian function of toy airplanes was to allow children to play, dream, and let their imaginations soar.¹⁸⁴ Another example is the argument in *Superior Form* that animal mannequins, similar to the human mannequins in *Carol Barnhart*,¹⁸⁵ function as mounts for animal skins for display.¹⁸⁶ These uses extend beyond the definition of “merely to portray the appearance of the article.”¹⁸⁷

The next step is ascertaining whether the article seeking copyright protection is “in fact” a useful article, i.e., the question becomes whether the “use” in question qualifies as an intrinsic utilitarian function beyond portraying appearance or conveying information.¹⁸⁸ This is accomplished by weighing the significance of

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

181. *Id.*

182. See Raskin, *supra* note 6, at 208.

183. Note, however, that “[j]udges will then have to determine either through the ordinary observer or the designer’s intent, which quality was primary and which was secondary.” Raskin, *supra* note 6, at 208 n.274.

184. See *Gay Toys, Inc. v. Buddy L Corp.*, 522 F. Supp. 622, 625 (E.D. Mich. 1981), *rev’d*, 703 F.2d 970 (6th Cir. 1983).

185. *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985).

186. See *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 493 (4th Cir. 1996).

187. 17 U.S.C. § 101 (1994).

188. As noted, most courts until recently considered any use beyond portraying appearance or conveying information as an intrinsic utilitarian function. *Superior*

an article's "artistic or aesthetic" functionality against its "intrinsic utilitarian" functionality. Balancing an article's various "uses" against each other helps identify the degree of the article's utilitarian use because it measures the relative weight and importance of aesthetic functionality versus utilitarian functionality. The difficulty is deciding at which point any particular use becomes "an intrinsic utilitarian function" under the 1976 Act.¹⁸⁹

Apportioning the relative weight of aesthetic functionality and utilitarian functionality necessarily occurs on an ad hoc basis.¹⁹⁰ Although a case-by-case analysis maintains a subjective flavor,¹⁹¹ the Copyright Office and courts could rely on concrete factors already examined in previous cases to help determine whether specific items seeking copyright protection qualify as pictorial, graphic, or sculptural works or useful articles.¹⁹² These factors, albeit not dispositive, tend to establish the degree of an article's utilitarian function in relation to its aesthetic appeal.

For example, in addressing the issue of separability, the court in *Brandir* considered the similarities and differences between the design of the article seeking protection from other articles having the same or similar use.¹⁹³ It considered the reasons behind these

Form, *Gay Toys*, and *Poe* stand for the proposition that this principle is not necessarily true, i.e., simply because an article possesses an additional utilitarian function beyond portraying appearance does not mean that such use should be considered an intrinsic utilitarian function. See *supra* note 66 and cases cited therein.

This paper's suggested approach to the issue of defining an article seeking copyright protection considers both notions. It recognizes that neither the 1976 Act, its legislative history, nor case law have ever precisely defined "intrinsic utilitarian function" as this term is used in its statutory context, see *supra* Part I.B, while at the same time qualifying the definitional scope of "intrinsic utilitarian function" to exclude any use beyond portraying appearance or conveying information and only including an article's use that is primarily and significantly utilitarian rather than aesthetic in nature. This is accomplished by weighing an article's aesthetic and utilitarian functions against each other. An article's appropriate definition turns on whether aesthetic or utilitarian considerations outweigh the other. Hence, in keeping with *Superior Form*, *Gay Toys*, and *Poe*, an article can possess both aesthetic and utilitarian functions and receive copyright protection under the 1976 Act because it is properly defined as a pictorial, graphic, or sculptural work even though the article possesses an additional use beyond merely portraying appearance or conveying information.

189. See *supra* note 188.

190. See Raskin, *supra* note 6, at 209.

191. See *id.* Compare Justice Holmes' famous copyright caveat: "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

192. See *supra* Part I.B.2.

193. See *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1146-47 (2d Cir. 1987).

design changes also relevant.¹⁹⁴ The court examined the overall cost of manufacturing the article compared to its functional costs alone.¹⁹⁵ It looked to consumer response and use of the article, manufacturing considerations, and the type of materials used for the article.¹⁹⁶ These factors reflect whether the article's design was significantly influenced by utilitarian considerations.¹⁹⁷

The court in *Brandir* held that the bicycle racks seeking protection went through a transformation from an originally copyrightable sculptural work to unprotectable useful articles because the utilitarian considerations in producing the racks outweighed their aesthetic considerations.¹⁹⁸ The original design was changed to accommodate bicycle storage.¹⁹⁹ The type of material used in the original sculpture was changed to galvanized steel to survive inclement weather.²⁰⁰ The court noted that consumers saw bicycle racks rather than sculptural artwork.²⁰¹ The court determined that the use which extended beyond merely portraying appearance, i.e., the use as a bicycle storage rail, was sufficient enough to be defined as an intrinsic utilitarian function. Hence, the bicycle racks, which were seeking copyright protection, were defined as useful articles subject to the separability test because their utilitarian functionality outweighed any aesthetic considerations.

Similarly, the court's challenge in *Poe* was determining whether Poe designed a "functional swimsuit or a work of art" before ascertaining the appropriate scope of copyright protection.²⁰² Noting that "[t]he evidence presented by both sides at the hearing on the motion for a summary judgment shows that Poe was attempting to create a work of art which portrayed an article of clothing,"²⁰³ the court concluded that a genuine issue of material fact existed because it was unclear to what extent Poe's "swimsuit" could be "used" as such, i.e., whether Poe's swimsuit was by definition a useful article under the 1976 Act. Remanding the case for trial, the court established four factors relevant to the question of usefulness.

194. *See id.*

195. *See id.*

196. *See id.*

197. *See id.*

198. *See id.*

199. *See id.*

200. *See id.*

201. *See id.* at 1147.

202. *Poe v. Missing Persons*, 745 F.2d 1238, 1243 (9th Cir. 1984).

203. *Id.* at 1242.

First, the Ninth Circuit said that expert evidence is relevant in determining whether an article possesses an intrinsic utilitarian function.²⁰⁴ Second, in subscribing to Professor Denicola's approach, the court said that evidence of the author's intent in designing the article may indicate the degree of its utilitarian functions.²⁰⁵ Third, evidence of custom and usage concerning the article in question within the art world may be relevant.²⁰⁶ Finally, evidence concerning the article's marketability as a work of art should be considered.²⁰⁷

Under a "primary functional significance" analysis, the Fourth Circuit in *Superior Form*, for example, could have weighed the usefulness of the animal mannequins against their aesthetic appeal by considering the above enumerated factors in *Brandir* and *Poe*. The Fourth Circuit emphasized the mannequins' importance in portraying the ultimate expressive aspects of the final product.²⁰⁸ "Even though covered with a skin, the mannequin is not invisible but conspicuous in the final display."²⁰⁹ In determining whether this quality was principally influenced by aesthetic or utilitarian considerations, the court could have examined the similarities and differences between the design of the animal mannequins and other mannequins.

The court was quick to point out, for example, that the human mannequins in *Carol Barnhart*, which were held to be uncopyrightable useful articles, were primarily "used to display clothes for commercial sale . . . and were not designed for portraying themselves."²¹⁰ The Fourth Circuit concluded that the Second Circuit did not find that the author in *Carol Barnhart* "fixed a mode of expression in a tangible form for the purpose of displaying or portraying the article," i.e., the primary function was not aesthetic; rather, it was utilitarian.²¹¹

Conversely, the court in *Superior Form* found that the animal mannequins were "intended to give body expression to the final displays and to constitute a permanent portrayal of the animal."²¹² In

204. See *id.* at 1243.

205. See *id.*

206. See *id.*

207. See *id.*

208. See *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 493-94 (4th Cir. 1996).

209. *Id.* at 494.

210. *Id.*

211. *Id.*

212. *Id.*

support of this contention, the court could have relied on evidence of the author's intent to create a copyrightable sculptural work, evidence concerning the animal mannequins' marketability as sculptural works to show aesthetic significance, and evidence of consumer response, i.e., whether consumers purchased the animal mannequins primarily for aesthetic reasons. These factors indicate whether the mannequins' designs were significantly influenced by artistic considerations and whether the mannequins' principal function was primarily aesthetic.²¹³

Though the mannequins served a utilitarian function as mounts for animal skin displays, the court concluded that the principal utilitarian aspect was to "portray the appearance" of the animal.²¹⁴ The usefulness of the animal mannequins as mounts did not outweigh their aesthetic features and qualities. Hence, the animal mannequins were defined as sculptural works properly warranting copyright protection.

The above factors are germane considerations in determining the significance of an article's aesthetic or utilitarian qualities. These factors tend to establish whether an article's particular use stems principally from utilitarian considerations rather than aesthetic appeal and whether form and function are inextricably intertwined.²¹⁵ These factors also help explain the degree of an article's utilitarian use because they identify the relative weight of aesthetic functionality versus utilitarian functionality. In short, the difficulty of deciding at which point "use" becomes "an intrinsic utilitarian function" under a "primary functional significance" analysis is more clearly focused when examined as a question of fact on an ad hoc basis after considering the factors discussed in both *Brandir* and *Poe*.

CONCLUSION

Under the 1976 Copyright Act, "pictorial, graphic, and sculptural" works are proper subject matter warranting copyright protec-

213. Cf. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987). The Second Circuit found that form and function were inextricably intertwined, the design of the bicycle racks at issue "being as much the result of utilitarian pressures as aesthetic choices. . . . [D]esign changes [were] made in response to functional concerns." *Id.* at 1147. Hence, utilitarian considerations outweighed aesthetic functionality to define the bicycle racks as useful articles.

214. *Id.*

215. See *id.* at 1147 (stating that when form and function are inextricably intertwined, separability does not exist).

tion. The exception to this rule is that the designs of useful articles are not copyrightable except to the extent that pictorial, graphic, or sculptural design features may physically or conceptually exist separately from the article. Useful articles are defined as having an intrinsic utilitarian function beyond portraying appearance or conveying information. So long as articles possess "an intrinsic utilitarian function," they are defined as useful and their designs are not copyrightable unless particular elements of their designs satisfy the separability test. Unfortunately, the 1976 Act and its legislative history do not provide instructions to determine what constitute intrinsic utilitarian functions. Moreover, the judiciary has been unsuccessful in establishing guidelines on how to answer this question.

Because the purpose of copyright law is to promote the arts and sciences for public benefit, the appropriate scope of copyright protection turns on defining the specific article seeking protection and not on a general categorization of the article. Whether particular articles possess intrinsic utilitarian functions is a question of fact and not a question of law. Indeed, some articles presently afforded copyright protection may properly be defined as useful articles because they possess intrinsic utilitarian functions beyond portraying appearance.

Determining whether a particular use qualifies as an intrinsic utilitarian function should be done on an ad hoc basis under a "primary functional significance" analysis by considering the relevant factors discussed in *Brandir* and *Poe*. This permits the Copyright Office and courts to weigh the interests of authors against public progress. Rather than favoring over-protection, as illustrated in *Gay Toys*, and holding that certain categories of articles, for example, toys, do not possess intrinsic utilitarian functions beyond portraying appearance as a matter of law, a case-by-case analysis to determine "usefulness" protects the interests of authors, the public welfare, and establishes clearer guidelines to address future issues of this nature.