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# COPYRIGHT IN UTILITARIAN OBJECTS: BENEATH METAPHYSICS

*Michael J. Lynch\**

## I. INTRODUCTION

Patents and copyrights approach, nearer than any other class of cases belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very [subtle] and refined, and, sometimes, almost evanescent.<sup>1</sup>

Justice Story's familiar characterization of copyright as the "metaphysics of the law"<sup>2</sup> encourages the metaphysician in judges and scholars who may enjoy struggling with impenetrable abstractions even in cases where a common sense approach might reach simpler conclusions without the pleasure of deep cogitation. Among the opportunities for metaphysicians provided by the Copyright Act of 1976,<sup>3</sup> the scheme for protection of design features of useful articles stands out.<sup>4</sup> The statutory attempt to protect decorative aspects of an article while not preventing imitation of utilitarian features has been the occasion of particularly subtle analysis. This article will first demonstrate a crude, literal and physical approach which might have produced far more clarity, and results no less desirable. Then it will argue that the statutory definition setting the limits of statutory protection reaches contradictory results unless it is understood, in light of its evident purpose, to restrict copyright to those aspects of a useful article in which a monopoly can be awarded without necessarily extending to the utilitarian features of the article.

Many find it surprising that useful articles may be protected by copyright and so this article will begin with a brief summary of the development up to and including the Copyright Act of 1976. Before considering four principal cases, some attention will be given to the legislative history, to the basic principles of statutory construction, and

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1. *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841) (No. 4,901).

2. *Id.*

3. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (current version at 17 U.S.C. §§ 101-810 (1988)).

4. 17 U.S.C. § 102(a)(5) (1988) (works of authorship include "pictorial, graphic, and sculptural works").

to the policy considerations which govern what the law should seek to achieve, and what it should seek to avoid.

## II. ANTECEDENTS

In 1873, Congress first extended copyright protection to three-dimensional works<sup>5</sup> by adding to the list of items which could be copyrighted "statue[s], statuary, and . . . models or designs intended to be perfected [and executed] as works of the fine arts."<sup>6</sup> The phrase "intended . . . as works of the fine arts" appears to modify models or designs only, rather than statuary.<sup>7</sup> Still, it has been generally assumed that a significant change occurred in 1909 when the list of subjects of copyright included "works of art" without reference to the "fine" arts.<sup>8</sup>

The Copyright Office narrowly interpreted the scope of the purported change in the Copyright Act of 1909,<sup>9</sup> adopting regulations which provided, "[p]roductions of the industrial arts utilitarian in pur-

5. While two-dimensional useful articles exist, they have played an insignificant part in the questions to be discussed. *See, e.g.,* Beverly Hills Design Studio (N.Y.), Inc. v. Morris, 1989 Copyright L. Dec. (CCH) ¶ 26,447 (involving paper patterns for clothes-making). In the House Report on the Copyright Act of 1976, the discussion on the limited protection to be granted to useful articles mentioned wall paper as an example of a useful article, and the design on such paper as an "element" deserving of copyright protection. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 54-55 (1976), *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659-5801 [hereinafter H.R. REP. NO. 1476].

6. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (repealed 1916).

7. Professor Perlmutter cites a "curious 1882 amendment" regulating the places in which notice might be attached to "'molded decorative articles . . . or articles of pottery or metal subject to copyright.'" Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y. 339, 342 (1990) (quoting Act of Aug. 1, 1882, ch. 366, 22 Stat. 181). The language strongly implies that some lowly knick-knacks were already protected. *Id.*

8. *See* Mazer v. Stein, 347 U.S. 201, 211-13 (1954) (quoting *Joint Hearing on S. 6330 and H.R. 19853 Before the Comm. on Patents of the Senate and House of Representatives*, 59th Cong., 1st Sess. 11 (1906) (testimony of Herbert Putnam, Esq., Librarian of Congress)).

It is interesting to note that, as to three-dimensional works, the statutory language necessarily involved lawyers in making the determination of what was or was not a "work of art," a judgment for which Justice Holmes had declared them unfit in a well-known passage: "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). Justice Holmes' conclusion might have been questioned on the grounds that, whatever the fitness of lawyers and judges, Congress had certainly required them to make such judgments in the case of three-dimensional works and could be presumed to approve in the case of pictorial works as well. The approach of lawyers to the question of what is a work of art is beautifully captured in the acute judgment of the Ninth Circuit that "[a] thing is a work of art if it appears to be within the historical and ordinary conception of the term art." *Rosenthal v. Stein*, 205 F.2d 633, 635 (9th Cir. 1953), *followed in* *Baillie v. Fisher*, 258 F.2d 425, 426 (D.C. Cir. 1958).

9. Copyright Act of 1909, ch. 320, § 5, 35 Stat. 1077 (current version at 17 U.S.C. § 102 (1988)).

pose and character are not subject to copyright registration, even if artistically made or ornamented."<sup>10</sup>

This regulation, with minor clarifications, stood until the 1954 decision in *Mazer v. Stein*.<sup>11</sup> In that case, the Supreme Court declared that china statuettes of dancers, manufactured to be used as lamp bases, were entitled to copyright protection. It does not appear that this decision upset existing Copyright Office practices—the challenged statuettes had been registered. Furthermore, Justice Douglas, in a separate opinion, listed a variety of utilitarian articles which had been accepted by the Copyright Office since 1910, including book ends, door knockers, piggy banks and salt shakers.<sup>12</sup> Nevertheless, it is widely accepted that the *Mazer* decision stimulated the interest of manufacturers and the copyright bar because the number of registrations of ornamental designs of useful articles rose precipitously from 3,400 registrations in 1959 to 5,800 for the year 1960.<sup>13</sup>

Despite its prior history of accepting piggy banks and door knockers, following *Mazer*, the Copyright Office amended the applicable regulation twice, ending up with the following text, significant portions of which were appropriated by the drafters of the 1976 Act:

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>14</sup>

The emphasized language presumes an accepted standard for determining what is a work of art. By 1976, no generally accepted standard could be imagined. Learned commentators declared that a work of art is anything certified as such by a member of the "artworld."<sup>15</sup> On the other hand, other learned commentators opined that the same work is or is not a work of art depending upon how it is displayed.<sup>16</sup> These and other positions were argued with great complexity, leaving observers confused about the meaning of art, even as the status of art-

10. COPYRIGHT OFFICE, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT, Bull. No. 15, at 8 (1910), *reprinted in Mazer*, 347 U.S. at 212 n.23.

11. 347 U.S. 201 (1954).

12. *Id.* at 221 (Douglas, J., separate opinion).

13. *Design Protection: Hearing on S. 2075 and S. 2852 Before the Subcomm. on Patents, Trademarks, and Copyrights of the Senate Comm. on the Judiciary*, 86th Cong., 2d Sess. 58-59 (1960) (testimony of Arthur Fisher, Register of Copyrights).

14. 37 C.F.R. § 202.10(c) (1959) (revoked Jan. 1, 1978, 43 Fed. Reg. 966 (1978)) (emphasis added).

15. G. DICKIE, ART AND THE AESTHETIC: AN INSTITUTIONAL ANALYSIS 36 (1975).

Published by ~~CC~~ *Conditions, What is Art?*, in THE ARTS AND COGNITION 17 (D. Perkins & B. Leonard ed. 1977).

ists rose to unprecedented heights. Lawyers and judges with an exaggerated respect for artists then found themselves with no reliable way of distinguishing a work of art from a parking lot light fixture.<sup>17</sup>

### III. COPYRIGHT ACT OF 1976

In the 1976 Act,<sup>18</sup> the list of categories constituting the subject matter of copyright was tightened and generalized.<sup>19</sup> Under the 1909 Act,<sup>20</sup> most three dimensional works had sought protection under the category "works of art."<sup>21</sup> In the new list, three-dimensional works were included as "pictorial, graphic, and sculptural works," a term stripped of any "implied criterion of artistic taste, aesthetic value, or intrinsic quality."<sup>22</sup> Without any such criteria, a bicycle was as much a sculptural work as a bronze nude.

17. In *Esquire, Inc. v. Ringer*, Judge Gesell demonstrated this incapacity in a graceful, often-quoted passage:

These outdoor lights serve both to decorate and to illuminate. Indeed, during the day they are exclusively decorative. They are a type of sculpture which is both original and aesthetically pleasing. Surely they would satisfy a Gropius or a Brancusi far more than would a Rembrandt portrait, and to many they are more artistic than some examples of sculpture found at such museums as the Corcoran or the Hirshhorn. Art through the ages has often served a utilitarian purpose. The Caryatids of the Acropolis or Cellini's exquisite saltcellar are two of many examples of traditional art serving such a purpose. There has always been a close link between art and science. The forms represented by Esquire's fixtures emphasize line and shape rather than the realistic or the ornate but it is not for the Register to reject them on artistic grounds, or because the form is accommodated to a utilitarian purpose. There cannot be and there should not be any national standard of what constitutes art and the pleasing forms of the Esquire fixtures are entitled to the same recognition afforded more traditional sculpture.

414 F. Supp. 939, 941 (D.D.C. 1976), *rev'd*, 591 F.2d 796 (D.C. Cir. 1978) (citations omitted) (emphasis added).

This very passage is quoted and endorsed by Professor Melville Nimmer, who introduced it by saying, "it is difficult to quarrel with [Judge Gesell's] observations generally concerning the nature of art, and specifically the artistic content of the lighting fixtures there in issue." 1 M. NIMMER, *NIMMER ON COPYRIGHT* § 2.08[B], at 2-102.1 (1991). The assumption, apparently shared by a prominent jurist and a leading scholar, that Gropius, Brancusi, or anyone remotely connected to reality would prefer a parking lot light fixture to a Rembrandt portrait should be sufficient to convince doubters that the judgment of lawyers regarding artistic matters is confused and unreliable. Extensive research has turned up no other writer who has called attention to the absurdity of this contention.

18. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (current version at 17 U.S.C. §§ 101-810 (1988)).

19. 17 U.S.C. § 102(a) (1988).

20. Copyright Act of 1909, ch. 320, 35 Stat. 1075 (current version at 17 U.S.C. §§ 101-810 (1988)).

21. *Id.* § 5(g), at 1077. Another category, "[d]rawings or plastic works of a scientific . . . character," provided an alternative protection for works which may not have qualified as "works of art." *Id.* § 5(i).

22. H.R. REP. NO. 1476, 94TH CONG. 1ST SESS. 543.

The definition of "pictorial, graphic, and sculptural works," limited the extent to which "useful articles"<sup>23</sup> could claim inclusion in the category:

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>24</sup>

The derivation of the emphasized language from the Copyright Office regulation is obvious; however, the change from "existing independently as a work of art" to "existing independently of the utilitarian aspect" has unexpectedly raised questions susceptible to a highly metaphysical approach.

#### A. Legislative History

The House Report on the Copyright Act of 1976,<sup>25</sup> the most authoritative document in the legislative history, explained the pertinent part of the definition of "pictorial, graphic and sculptural works" in two paragraphs which have been cited in support of opposing positions in several of the cases.<sup>26</sup> That passage is quoted here, with emphasis placed on those phrases most pertinent to the later controversy:

This part of the amendment is an adaptation of language added to the Copyright Office Regulations in the mid-1950's in an effort to implement the Supreme Court's decision in the *Mazer* case.

In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile

23. The 1976 Act provides a definition:

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."

17 U.S.C. § 101 (1988). Such works are usually three-dimensional and protected as sculptural works under section 102(a)(5). *Id.* The definition of "useful article" has sometimes been confusing in application, but it has not led to the theoretical muddle which has arisen from the limitation of the definition of "pictorial, graphic, and sculptural work" which is the subject of this paper.

24. 17 U.S.C. § 101 (1988) (emphasis added).

25. H.R. REP. NO. 1476, *supra* note 5.

26. *See, e.g.,* Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411, 417 n.3 (2d Cir. 1985); Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 997 (2d Cir. 1980) (Weinstein, J. dissenting); Esquire, Inc. v. Ringer, 591 F.2d 796, 803 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 208 (1979).

fabrics, wallpaper, containers, and the like. The same is true when a statute or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although *the shape of an industrial product* may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or 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*. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and *would not cover the over-all configuration of the utilitarian article as such*.<sup>27</sup>

The suggestion that separate identification of an element might be achieved "physically or conceptually" is best understood in light of the examples provided of the carved chair and the flatware relief design, and the graphic design on fabric or wallpaper. These examples also help in giving a meaning to the statutory language "capable of independent existence" which does not necessarily coincide with "separately identifiable." In the Second Circuit, however, the concept of "conceptually separable" has swallowed up the statutory language in circumstances far removed from the narrow examples of the Report.<sup>28</sup>

The quoted passage also refers twice to the "shape" or "over-all configuration" of a useful article, expressing clearly that copyright protection should not extend to that shape. The prominent cases involving the question,<sup>29</sup> however, all involve protection for the entire shape of an article.<sup>30</sup> In the discussion of the case of *Esquire, Inc. v. Ringer*,<sup>31</sup> this

27. H.R. REP. NO. 1476, *supra* note 5, at 54-55 (emphasis added).

28. See *infra* notes 95-140 and accompanying text.

29. See generally *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); *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), *cert. denied*, 440 U.S. 908 (1979).

30. The primary meaning of the noun "shape" refers to visible surface or outline of an object. The best definition is stated in *Webster's New International Dictionary*: "Spatial form with respect to a relatively constant contour or periphery." WEBSTER'S NEW INT'L DICTIONARY 2302 (2d ed. 1957).

31. 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

article will consider the possibility that as to the shape of a useful article the apparent clarity of the House Report may contradict the statutory language when the housing of a useful article makes no contribution to its utility. The possibility was already illustrated by the facts in *Ted Arnold Ltd. v. Silvercraft Co., Inc.*<sup>32</sup> In any event, the cases from the Second Circuit have disregarded this limitation entirely.<sup>33</sup>

Although in enacting the statute Congress had modified the language of the prior regulation, substituting "existing independently of the utilitarian aspects" for "existing independently as a work of art," the House Report repeated the earlier phrasing as if to imply that the two were equivalent. Opinions under the 1976 Act have never openly argued that an article may not be protected because it is not a work of art; however, arguments for protection have usually emphasized the artistic qualities of the article in question. A peculiar class of useful objects will be discussed, such as paperweights, whose utility springs from simple physical properties (such as mass) to demonstrate that this limitation is ambiguous, and that a plausible interpretation is available which could obviate many difficulties.<sup>34</sup>

### B. Statutory Construction

The statute appears to require that two qualifications be met. The element or feature to be protected should be "identified separately from, and . . . capable of existing independently of, the utilitarian aspects of the article."<sup>35</sup> Elementary principles of statutory construction require that both of the two elements, "identified separately" and "capable of existing independently," are given independent meaning and are applied in each contested case.<sup>36</sup>

As will be seen, however, the analysis in the reported decisions ignores the requirement "capable of existing independently" while emphasizing separate identification, and concentrating on the statement from the legislative history that such identification may be physical or conceptual.<sup>37</sup> The line of analysis in the Second Circuit which considers *only* "conceptual separability" has gone so far as to grant protection to so-called "artistic elements" or "sculptural elements" of an article without specifying what those elements are, or how they may exist independently of the utilitarian aspects of the article.<sup>38</sup>

32. 259 F. Supp. 733, 734 (S.D.N.Y. 1966).

33. See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 994 (2d Cir. 1980) (Weinstein, J., dissenting).

34. See *infra* text accompanying notes 142-51.

35. 17 U.S.C. § 101 (1988).

36. "In construing a statute we are obliged to give effect, if possible, to every word Congress used." *Reiter v. Sonotone Corp.*, 442 U.S. 330, 339 (1979) (citing *United States v. Menasche*, 348

U.S. 319, 330-331 (1955)).

37. See *infra* notes 94-102 and accompanying text.

38. See *infra* notes 94-137 and accompanying text.



Professor Nimmer has considered the phrase "capable of existing independently" in connection with two cases, *Esquire, Inc. v. Ringer*<sup>39</sup> and *Kieselstein-Cord v. Accessories by Pearl, Inc.*,<sup>40</sup> and asked, "[d]oes this require physical, as distinguished from conceptual, separability?"<sup>41</sup> He concluded that physical separability was *not* required.<sup>42</sup> His judgment was based on the House Report's reference to the statuettes involved in the case of *Mazer v. Stein*<sup>43</sup> as an example of a work which could "exist independently."<sup>44</sup> Professor Nimmer insisted that since the statuette was the base, and the base was utilitarian, that *Mazer* could not be harmonized with the statute unless only "conceptual separability" was necessary for copyright protection.<sup>45</sup>

There are, however, reasons to conclude that the carved surfaces of the statuettes in *Mazer* are capable of existing independently of the utilitarian aspects in more than a "conceptual" way. Furthermore, and more significantly, Professor Nimmer did not consider whether his conclusion meant that the language "capable of existing independently" could therefore be ignored, yet that is the necessary implication of his judgment. This proposition is barred by the basic principle referred to above and sometimes expressed: "[I]t is presumed the Congress did not use superfluous words."<sup>46</sup>

This proverbial assumption of legislative proficiency would seem to demand an interpretation of "capable of existing independently" which requires that the utilitarian article be capable of physical existence without the pictorial or sculptural aspects, and vice versa. Such an interpretation, paradoxically, makes surplusage of the language "can be identified separately," since it is difficult (impossible?) to imagine a useful article divided into two physical entities which cannot be identified separately.

It will be argued, however, that emphasis on the literal interpretation of "capable of existing independently" suggested above would have provided reasonable and predictable results in the cases which have produced a theoretical muddle.

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39. 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

40. 632 F.2d 989 (2d Cir. 1980).

41. M. NIMMER, *supra* note 17, § 2.08[B], at 2-97.

42. *Id.*

43. 347 U.S. 201 (1954).

44. M. NIMMER, *supra* note 17, § 2.08[B], at 2-98.

45. *Id.*

46. *In re Barker*, 559 F.2d 588, 592 (C.C.P.A. 1977). Criticism of Professor Nimmer's disregard of the statutory language was expressed early by David A. Gerber. *See Gerber, Book Review*, 26 UCLA L. REV. 925, 939 (1979).

### C. Policy Considerations

The reasons why Congress has chosen to grant copyright protection to three-dimensional works of art, but not to three-dimensional works of utility, are not stated explicitly. At the outset of the preparation of the Copyright Act of 1976, the Register of Copyrights reported to Congress the conclusion that protection for useful articles was not desirable.<sup>47</sup>

The fear expressed by the Register that competition will be in some way restrained is not developed or analyzed as the legislation proceeded to passage. Since copyright protection gives a nearly absolute monopoly in the copying and sale of works protected, this conclusion leaves unspoken the reason why the restraint of competition is acceptable as to a particular literary, musical, or artistic work, but not acceptable in the case of a useful article. We may be satisfied with an intuitive decision that this is so, but it is awkward to assert that a novel kitchen utensil is more significant than the novels of Faulkner or a mousetrap more important than Mickey Mouse.<sup>48</sup>

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47. HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 13 (Comm. Print 1961).

We do not believe . . . that it would be appropriate to extend the copyright law to industrial designs as such. In this area there is a delicate balance between the need for protection on the part of those who originate and invest in a design, and the possible effect of protection, if overextended, in restraining competition.

*Id.*

48. The "monopoly" protection afforded by copyright is significantly qualified by the exclusion of ideas from copyright protection; however, this limitation is of uncertain application in the case of useful articles. The exclusion of ideas now found in the 1976 Act, 17 U.S.C. § 102(b), was expressly formulated in *Mazer v. Stein*, 347 U.S. 201, 217 (1954), but when applied to literary works, almost certainly reflects common understanding from far earlier. In *Baker v. Selden*, the creator of a system of accounting was denied the right to prevent copying of forms necessary to the use of the system published in his copyrighted explanation. 101 U.S. 99 (1879). While the idea/expression distinction is usually attributed to the case, the court's emphasis was on the denial of protection to practical systems, except under patent.

The freedom of ideas contributes to the progress of science and useful arts by allowing later creators to make use of the essence of earlier contributions. The distinction between ideas and expression often presents difficulty in verbal works, but its application becomes completely unpredictable in the case of musical or pictorial works, or the sculptural works generally involved in the useful article problem. A statement of the idea or ideas expressed in such a work can be formulated at any level of generality and will in most cases be at the whim of the critic. For that reason, the right to copy ideas, rather than expression, has little meaning in connection with such works.

The difficulty in identifying the unprotected ideas in such cases also disables the pro-competitive effects of the denial of copyright or the defense to infringement, which follows from demonstration that a work expresses ideas which can only be expressed in one way or in a very limited variety of ways. See, e.g., *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967); *NEC Corp. v. Intel Corp.*, 10 U.S.P.Q.2d (BNA) 1177 (N.D. Cal. 1989).

A corollary of the freedom of ideas is the complete defense to infringement actions afforded

The judgment that a free market is more important in useful articles than in art and literature is corroborated in related areas of American patent and trademark law. Patents while in some ways broader than copyright, protect for a much shorter period, and an applicant must meet far more stringent requirements. The device for which patent protection is sought is carefully examined, and measured against standards of novelty,<sup>49</sup> non-obviousness,<sup>50</sup> and utility.<sup>51</sup> Each of these three requirements is a barrier which disqualifies many interesting innovations. The Copyright Office, on the other hand, provides only a cursory examination to works seeking registration and imposes the lowest imaginable test of originality. The policy that useful articles should meet the stringent tests of patent rather than the minimal tests of copyright is also seen in the limitations of design patents and the trade dress aspect of trademark law.

Design patents protect not utility, but ornamental aspects of design.<sup>52</sup> Such patents cannot substitute for copyright protection of artistic aspects of useful objects, because the Patent Office approval is not swift, applications are often denied for obviousness or lack of novelty, and patents which have been granted are regularly invalidated if challenged.<sup>53</sup> Furthermore, the protection does not extend to elements of design which are functional rather than ornamental,<sup>54</sup> a distinction comparable to the "separability" test in copyright law.

The law of trademark and unfair competition also reveals an analogous concern in disallowing "trade dress" protection for the functional features of an object's design.<sup>55</sup> The meaning to be attributed to func-

by independent creation. But liability for "unconscious copying," first seen in cases of musical composition, has eliminated any reliable safe harbor for creators once they have been aware of the earlier work, no matter how honestly they may have avoided imitation. See *ABKCO Music, Inc. v. Harrisongs*, 722 F.2d 988 (2d Cir. 1983); *Fisher v. Dillingham*, 298 F.2d 145 (S.D.N.Y. 1924). Since industrial designers are as likely as pop musicians to be aware of earlier work in their field, fear of infringement should have some discouraging effect on their creativity.

Thus, some significant constraints on the copyright monopoly may be ineffective or uncertain in the case of useful articles and other sculptural works. While designers may feel constrained by the possibility of infringement, there is no indication that Congress took this into account in limiting the applicability of copyright in useful articles.

49. 35 U.S.C. § 102 (1988).

50. *Id.* § 103.

51. *Id.* § 101.

52. *Id.* § 171.

53. See Lindgren, *The Sanctity of the Design Patent: Illusion or Reality? Twenty Years of Design Patent Litigation Since Compro v. Day-Brite Lighting, Inc. and Sears, Roebuck & Co. v. Stiffel Co.*, 10 OKLA. CITY U.L. REV. 195 (1985).

54. *Kwik-Site Corp. v. Clear View Mfg. Co.*, 758 F.2d 167, 172 (6th Cir. 1985).

55. For a summary of the contrasting definitions of functionality in several circuits of the United States Court of Appeals, see Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1241 (1987).

tionality in this context is somewhat unsettled, but may exclude from protection a wider range of features than those excluded from copyright, even extending to purely decorative features which carry with them a great competitive advantage.<sup>56</sup> The unsettled definition of this limitation in the federal courts does not affect the conclusion that here, as in the patent and copyright laws, particular concern has been shown for the preservation of competition in the case of utilitarian objects. The power of state law to outlaw copying of functional aspects of utilitarian objects was preempted by the Supreme Court's decisions in *Sears, Roebuck & Co. v. Stiffel Co.*<sup>57</sup> and *Compco Corp. v. Day-Brite Lighting, Inc.*<sup>58</sup> Any question as to whether the erosion of the general holding of those cases had extended its application to useful articles was presumably laid to rest by the decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*<sup>59</sup>

Numerous proposals for copyright-like, short-term protection for designs of useful objects have died in Congress.<sup>60</sup> Another died in the 101st Congress.<sup>61</sup> While such bills typically provide a greater range of protection than that provided by the Copyright Act, they typically exclude designs "dictated solely by a utilitarian function of the article that embodies it."<sup>62</sup> Failure to pass such legislation is strongly related to fears (and desires) for the restriction of competition in replacement auto parts.

A less important motivation for limiting protection of useful designs may arise from the relative status of art and industrial design. There is some evidence that the Copyright Office has in the past sought to limit its responsibilities to "high-toned" subject matter.<sup>63</sup> The reiteration of the "fine arts" in Copyright Office regulations, following the deletion of that phrase from the 1909 Act, is some indication of such

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56. The theory of "aesthetic functionality" has been used to deny trademark protection to ornamental features merely because they are attractive to customers, and thus are "an important ingredient in the commercial success of the product." *Pagliari v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952). The application of this idea has been limited in the Ninth Circuit. *Vuitton Et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981). Its reception in other circuits has been qualified; see authorities collected in J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 7:26D (1984 & Supp. 1991).

57. 376 U.S. 225, *reh'g denied*, 376 U.S. 973 (1964).

58. 376 U.S. 234, *reh'g denied*, 377 U.S. 913 (1964).

59. 489 U.S. 141 (1989).

60. See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

61. H.R. 902, 101st Cong., 1st Sess. (1989).

62. *Id.*

63. See Derenberg, *Commercial Prints and Labels: A Hybrid in Copyright Law*, 49 YALE

an attitude.<sup>64</sup> Along the same line is the Copyright Office's internal insistence on "artistic features" as the element to be protected,<sup>65</sup> despite the declaration in the House Report that the adoption of the term "pictorial, graphic, or sculptural work" was deliberately used to avoid implications of artistic value.<sup>66</sup> While the rationale of supporting competition suggests that works of utility are more important than works of art, the pro-art rationale suggests they are less important. The post-1976 cases make much of the artistic significance of challenged works, but pay no attention to whether the case actually raises a possibility that a functional design might be monopolized.

#### D. Summary

Without belaboring the meager evidence of Congressional motivation, it is clear from the statute itself that utilitarian aspects of useful articles are intended to be outside the scope of copyright protection. It may be of use in evaluating the cases to consider a statement of this policy. For example, a designer may not use copyright to capture the value of functional aspects of a useful article. The designer, on the other hand, may capture the value of a decorative design of a useful article, no matter what a powerful market advantage beauty may provide, so long as the functional aspects are not necessarily included in the protection.<sup>67</sup> It is hoped that this statement of the manifest statutory intent is uncontroversial. The statutory language, of course, does not explicitly follow that statement, but it may be plausibly interpreted to that effect.

The simplest and most literal application of the statute to a design would demonstrate that the pictorial, graphic, or sculptural features for which protection is sought can exist apart from any utilitarian aspects of the article, *and* that the utilitarian aspects can exist apart from these pictorial, graphic, or sculptural aspects. No courts have demonstrated such a two-step application. It should be obvious that, if such a demonstration is successful, there is no possibility whatsoever of impairing competition as to utilitarian aspects of design. Only when such a demonstration is difficult to imagine should it be necessary to rely on the idea of "conceptual separability." In such a case, particular attention must be paid to insure that the protection considered does not extend to utilitarian aspects of the article. The cases, however, appear to have

64. 37 C.F.R. § 202.10(a) (1960); see *supra* text accompanying note 14.

65. LIBRARY OF CONGRESS COPYRIGHT OFFICE, COMPENDIUM OF COPYRIGHT OFFICE PRACTICES § 505.03 (1984) [hereinafter COPYRIGHT OFFICE PRACTICES].

66. See *supra* text accompanying note 22.

67. To the extent the doctrine of "aesthetic functionality" has life, this choice does not align perfectly with the law applicable to trademarks and trade dress.

placed far more emphasis on the artistic aspects to be protected, than on the utilitarian aspects to be left free. This article attempts to show that a primary focus on preserving the free use of utilitarian features is consistent with broad protection for artistic form.

#### IV. THE EARLY CASES

Analysis of the question of the extent of protection of design of useful articles has been stimulated greatly by the decisions in two contrasting cases shortly after the effective date of the Copyright Act of 1976.<sup>68</sup> In the first of these cases, *Esquire, Inc. v. Ringer*,<sup>69</sup> the United States Court of Appeals for the District of Columbia Circuit reversed the district court's issuance of a writ of mandamus by directing the Register of Copyrights to register a lighting fixture which the Register had refused, in accordance with regulations under the 1909 Act.<sup>70</sup> In the second case, *Kieselstein-Cord v. Accessories by Pearl, Inc.*,<sup>71</sup> the Second Circuit reversed a summary judgment for a defendant who mass-produced copies of two belt buckles, one of which was registered under the 1909 Act, and the other under the 1976 Act.<sup>72</sup>

Despite the limited application of the 1976 Act in these two cases, they have been the basis for all later discussions of the problem. Two additional cases with outstanding facts for illuminating difficulties have since been decided in the Second Circuit.<sup>73</sup> Opinions in these later cases offered interesting but unsatisfying theoretical proposals. This article will consider in depth the four cases referred to, noting in particular two approaches missing from the decisions. The first approach is a vigorous attempt to find an important element of the design which can physically exist independent of the utilitarian function. The second involves concentration not on the artistic elements to be protected, but on the utilitarian aspects which must be left free. By evaluating the extent to which copyright protection in a given case may inhibit competition as to utilitarian rather than aesthetic aspects, it is possible to determine whether the denial of protection is required for policy reasons.

##### A. *Esquire, Inc. v. Ringer*

*Esquire* arose under the 1909 Act, which protected three-dimensional shapes primarily as "works of art."<sup>74</sup> The district court granted

68. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (current version at 17 U.S.C. §§ 101-810 (1988)).

69. 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979).

70. *Id.* at 806.

71. 632 F.2d 989 (2d Cir. 1980).

72. *Id.* at 994.

summary judgment against the Register of Copyrights in a mandamus action, and the court of appeals reversed.<sup>75</sup> At issue was the Copyright Office policy excluding the overall shape of a utilitarian article, a modern parking lot light fixture. The regulation read in relevant part: "if the shape of a utilitarian article incorporates features . . . which can be identified separately and are capable of existing independently as a work of art."<sup>76</sup>

This language directs that the "features" which may be protected should be identified separately from the *shape*. The 1976 Act differs significantly, requiring that the "features" be identified separately from the utilitarian aspects of the article.<sup>77</sup> The House Report did not adequately recognize this difference, referring to "shape" and "over-all configuration" as unprotectable.<sup>78</sup> Despite the significant difference between the regulation and the comparable provisions of the 1976 Act, the court of appeals used the House Report to buttress its approval of the Copyright Office's restrictive interpretation of its regulation.<sup>79</sup>

The items like candlesticks, inkstands and chandeliers which the Copyright Office had accepted, and Justice Douglas had listed in his separate opinion in *Mazer v. Stein*,<sup>80</sup> were weakly distinguished in a footnote.<sup>81</sup> Also mentioned, without satisfactory grounds for distinction, was *Ted Arnold Ltd. v. Silvercraft*<sup>82</sup> in which the same regulation at issue in *Esquire* was held to permit copyright in a simulated antique telephone used as the casing for a pencil sharpener, since the sharpener and its casing could be physically separated.<sup>83</sup>

Under the 1976 Act, however, existence as a "work of art" is unnecessary; separation and independent existence are to be attributed to "sculptural features" and "utilitarian aspects."<sup>84</sup> There is no apparent reason why the overall shape should not be a "sculptural feature" if it is unnecessary to the utilitarian properties of the article.<sup>85</sup>

75. *Esquire, Inc. v. Ringer*, 591 F.2d 796, 798 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

76. See *supra* text accompanying note 14. The regulation may have been more restrictive than *Mazer v. Stein*, 347 U.S. 201 (1954), permitted.

77. For the definition in the 1976 Act, see *supra* text accompanying note 24.

78. See *supra* text accompanying note 27.

79. *Esquire*, 591 F.2d at 800-01.

80. 347 U.S. 201, 221 (1954) (Douglas, J., separate opinion).

81. *Esquire*, 591 F.2d at 802 n.19.

82. 259 F. Supp. 733 (S.D.N.Y. 1966).

83. *Esquire*, 591 F.2d at 802 n.19.

84. See Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (current version at 17 U.S.C. §§ 101-810 (1988)).

85. The Brief of the Copyright Office, quoted extensively in *Esquire*, contended vigorously that the overall shape of a utilitarian object could never be protected without frustrating the intent

The approach suggested by *Ted Arnold*, which may be characterized as the "rip-its-guts-out" approach, has obvious application to a lighting fixture. Pull out the wires, socket and bulb, and you have two separated and independently existing entities. The 1976 Act eliminated the question as to whether the wireless casing is art or not, leaving only the elements of separate identification and independent existence, which both seem to be present for the utilitarian and sculptural aspects of the light fixtures. The court of appeals in *Esquire* noted Plaintiff's concession that copyright protection was sought only for the housing of the light fixtures.<sup>86</sup> Without declaring that an application so limited would have met the requirements, the court concluded that because the applications were not so limited, the Register of Copyrights did not abuse discretion in refusing registration.<sup>87</sup>

Professor Denicola has noted the contention that the housing alone fits the statutory limits, and dismissed it, perhaps too abruptly:

Reliance on this simplistic notion of physical separation, however, is misplaced. The legislative history unequivocally indicates that pictorial works adorning useful articles are entitled to copyright, yet the pattern dyed into a bolt of cloth or painted on a china cup cannot be physically detached from the object itself. In addition, some features of utilitarian objects that *can* be physically separated are clearly *not* intended to fall within the scope of copyright. An ordinary television cabinet may be physically removed from the set itself, yet protection will not be forthcoming. Physical separability is a poor touchstone, inaccurate as a descriptive concept, and devoid of normative implications. The legislative history acknowledges the necessity of a more esoteric approach, referring at one point to "some element that, physically *or conceptually*, can be identified as separable." The notion of conceptual separability, however, can be little more than an invitation to thoughtful analysis. It has meaning only in the context of a specific normative theory or model.<sup>88</sup>

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of Congress. *Id.* at 801. From 1914, until the time of *Esquire*, more than 70 design protection bills died in Congress. *Id.* at 800 n.12. Yet, if the lighting fixtures at issue were protected by the copyright law, widespread protection for industrial designs would, in the Register's view, follow. *Id.* at 801. Consumer products—garments, toasters, bathtubs, and industrial products designed to have aesthetic appeal—subway cars, computers, etc., all would have a possibility of protection. *Id.*

The Copyright Office continues to insist that overall shape of a useful article may not be protected. The Compendium of Copyright Office Practices includes a "separability test" which declares that registration "can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence *apart from the shape of the useful article*." COPYRIGHT OFFICE PRACTICES, *supra* note 65, § 505.02 (emphasis added). The departure from the statutory language is obvious.

86. *Esquire*, 591 F.2d at 806. The claim noted by the court of appeals was not supported by the application and belatedly raised on oral argument.

87. *Id.*

88. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 730-31 (1983).



It is illogical here to dismiss physical separability because it cannot be applied to all cases. Indeed, Congress has shown an intention to provide protection for features beyond the physically separable, though it is unlikely that this intent went much beyond the examples given of patterns on paper or cloth, or carved into furniture. Such cases may require an "esoteric approach," "thoughtful analysis," and "a specific normative theory or model." When the feature for which protection is sought *can* be physically separated from the utilitarian work, however, the requirements of the statute are met in an unmistakable way, and further inquiry is unnecessary.

The only part of the passage quoted that directly opposes this conclusion is the unsupported assertion that a physically removable television cabinet cannot be protected. An ordinary television cabinet, though, is unoriginal, and fails to meet even the minimal requirements of creativity; it is a familiar box with moldings and knobs. If a picture tube is enclosed in the tummy of a naked lady, or Mickey Mouse, or some outlandish modern sculpture, why should the removable cabinet not receive copyright protection? Certainly protection of such an overall shape would not affect competition in utilitarian aspects.

There is a sense, however, in which the housing of the light fixture or of the television retains some utility after the electronics are removed. Professor Denicola notes Professor Nimmer's observation that even the dancing figures in *Mazer* could not meet a test of strict physical separability since a lamp base *is* utilitarian.<sup>89</sup> Stating the objection concretely, the lamp base holds the light bulb up off the ground, allowing illumination to cover a wider area. Similarly, the television cabinet raises the picture tube off the ground for a better viewing angle.

*Esquire* was decided under regulations intended to implement the Supreme Court's decision in *Mazer*. The district court relied on similarities to the *Mazer* case and it was then necessary for the court of appeals to distinguish the cases.<sup>90</sup> This was done by asserting that the *Mazer* lamp base could exist "independently as a work of art."<sup>91</sup> This approach, however, does not fairly meet Judge Gesell's contention that the *Esquire* lamp base is itself a piece of *modern, abstract* sculpture.<sup>92</sup>

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89. *Id.* at 730 n.105 (citing 1 M. NIMMER, NIMMER ON COPYRIGHT § 2.08[B][3] (1982)).

90. *Esquire*, 591 F.2d at 804-05.

91. *Id.* at 804.

92. See *supra* note 17 (quoting Judge Gesell's critical judgment). Justice Holmes' advice that lawyers and judges refrain from making aesthetic judgments here meets the twentieth century bourgeois determination not to be shocked by anything a hustler may contend is art. See

Furthermore, the different requirements of the 1976 Act would change the analysis considerably. Under the new formula, the object is to be severed physically or conceptually into two components. Arguably, the component for which protection is not sought must remain useful when the aesthetic component is removed. If the artistic lamp base exists independently, what is to be made of the remainder, a light bulb with wires lying on the table (*Mazer*) or on the ground (*Esquire*)? Is it still useful?

The utilitarian aspect of a base, which lifts the fixture off the ground, springs not from the conception of the designer, but from the simple physical properties of the object (in this case, height). The argument that such physical properties should not be relevant in the determination of separability and independent existence will be postponed for a later discussion of a variety of examples of the problem.<sup>93</sup> The facts in *Esquire*, however, permit the elimination of this more limited utilitarian aspect by a second tactic which can be characterized as the "hacksaw" approach.

In the "hacksaw" approach, two objects are separated and capable of existing independently when the top part of the lighting fixture's pole is either physically or conceptually severed, keeping together the segment enclosing the light bulb and the last few inches of the upright member and leaving behind all wiring. One of the separated objects is the casing, excluding for the upright (a sculptural work); the other is a light bulb hanging from a pole (a useful object). This approach is easily applied to the *Mazer* facts where the dancing figures on the surface of the lamp bases could be peeled away from an inner cylinder.<sup>94</sup> While the designer may object to the mutilation of his work conceptually or physically, the manufacturer will realize that copyright protection for the fragment provides all the defense against imitators that is required.

The analysis assumes that lighting fixtures do not achieve their function of area lighting in any unique way that cannot be accomplished without imitating the design of the fixture. If the *Esquire* housing had unique properties which enhanced the diffusion of light, the

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*supra* note 8 (description of Justice Holmes' admonition). Professor Nimmer, discerning some strange utility in a strip of fabric suspended from poles, noted the "Running Fence" of the notorious charlatan, "Christo," as an example of a work of art indistinguishable from a useful object. M. NIMMER, *supra* note 17, § 2.08[B], at 2-97. It is not clear whether Professor Nimmer believed that copiers of this stunt ought to pay royalties to Christo.

93. See *infra* text accompanying notes 140-51.

94. A more challenging set of facts would have been presented in *Mazer* had the lamp base been made of a translucent material allowing the light to be diffused from the entire body of the dancer. Again, the utility which comes from simple physical properties is involved, and the application of the statute is highly awkward unless some notice is taken of the special nature of this

sort of usefulness.

ease of maintenance, or any other functional property, then the proposed physical division would not have the effect of separating the useful from the decorative, and copyright protection would not follow.

Thus, under the 1976 Act, light fixtures, whether in the shape of Balinese dancers or in the shape of an upright pole from which extends a hollow translucent Frisbee large enough to hold a light bulb, should be copyrightable, despite the reluctance of the Copyright Office. If additional utility is found in the upright member of the housing which lifts the light bulb from the ground, protection may be extended only to the physically severable portion of the housing which encloses the bulb, thus preventing copiers from direct competition with the original. This may not be what Congress hoped to achieve, but it seems to be what they enacted.

This literal approach to the statute protects only decorative aspects of the design. That feature for which protection is claimed must be closely analyzed to determine whether any functional aspect would be included.<sup>95</sup> If so, the utilitarian aspects have not been separated, and copyright protection will be unavailable. The pro-competitive policy underlying the act is fully served by this approach. Had protection been granted in *Esquire*, it is difficult to imagine that competition in the field of parking lot light fixtures would have been impaired, or that progress in fixture design would have been impeded. These highly praised lighting fixtures were left unprotected by the *Esquire* decision, yet the design does not appear to have swept the field.

### B. *Kieselstein-Cord v. Accessories by Pearl, Inc.*

Some cases achieve academic fame through convenient pairing with a contrasting decision. The *Esquire* case was coupled with an alternative view when the Second Circuit decided *Kieselstein-Cord v. Accessories by Pearl, Inc.*<sup>96</sup> This case involved the blatant copying of a fashion designer's snazzy belt buckles. The court reversed a summary judgment denying copyright protection on the grounds that plaintiff's belt buckles were utilitarian works.<sup>97</sup>

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95. An interesting pair of lighting fixtures were the subject of the leading cases on preemption of state unfair competition laws under the patent laws of the United States. *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964). A sixties fad, pole lamps, was the subject of *Sears*. *Compco* involved an industrial fixture for fluorescent lights. The distinctive design of the lighting fixture in *Compco* had the function of increasing the strength of the feature, and could not be protected by the approach suggested here. The status of the pole lamps in *Sears* is less clear.

96. 632 F.2d 989 (2d Cir. 1980).

97. *Id.* at 994.

The court began by declaring that “[t]his case is on a razor’s edge of copyright law.”<sup>98</sup> That metaphor implies a sharp division, whereas the court’s analysis provides no bright lines. Even the pictures of the belt buckles are hazy.<sup>99</sup> The majority decision declares that it is “necessary to determine whether . . . there is a physically or conceptually separable artistic sculpture or carving capable of existing independently as a work of art.”<sup>100</sup> The court concludes by stating “[w]e see in appellant’s belt buckles conceptually separable sculptural elements.”<sup>101</sup> No attempt is made to describe those elements or show their existence independent of the utilitarian aspects of the belt buckle. The necessary result is to protect the overall shape of the buckle.

The exclusion of “overall shape,” which seemed inappropriate in *Esquire*, is not inconsistent with the statute when applied to a belt buckle. A belt buckle allows no opening for the “rip-its-guts-out” approach. Its shape, unlike that of the light fixture housing, cannot easily be distinguished from its function. It is possible, however, using the “hacksaw” approach, to divide each *Kieselstein-Cord* buckle approximately in half vertically. In each case, one half contains the tongue of the buckle and a simple square metal frame through which the belt passes. The other half of each buckle contains most of the unique and decorative features. Certainly, protection of that part would fully protect the creator from blatant “knock-offs.” In each case, the piece of metal can be physically separated and can exist independently, leaving behind a functioning buckle and thus satisfying the statute.

Whatever coherence and aesthetic appeal the metalwork may have comes from its graceful incorporation into a buckle. When the functioning elements are separated, what remains is a lump of metal no longer attractive to bourgeois taste. Though unattractive in itself, each non-functional remainder is the deliberate and original creation of the

98. *Id.* at 990.

99. The belt buckles in question are vaguely depicted in the district court’s opinion. *Kieselstein-Cord*, 489 F. Supp. 732, 733 (1980). In the court of appeals’ opinion, the belt buckles are somewhat more clearly depicted in a photo which shows the relation to the belt. 632 F.2d at 995. Perhaps because of the reflective precious metal surfaces, the pictures are somewhat mysterious. Clearer photos, but without belts attached, are found in M. NIMMER, *CASES AND MATERIALS ON COPYRIGHT* 70 (1985).

100. *Kieselstein-Cord*, 632 F.2d at 994. The “work of art” reference is drawn from regulations under the old statute, and runs counter to the clearly expressed Congressional intent to eliminate aesthetic questions. *See supra* text accompanying note 22. Although the court states the statutory formula correctly, this slip shows the orientation toward protecting art rather than toward freeing utility. The opinion also makes much of the fact, irrelevant under the new Act, that some trendy New Yorkers wore these belt buckles on shortened belts around the neck or elsewhere on their bodies. *Kieselstein-Cord*, 632 F.2d at 993. Apart from the fact that buckles are functional when fastening belts, whether or not they hold up pants, even if the buckle, or a gear or a wrench, were worn as a brooch or displayed on a pedestal, the independence of its shape from its function

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

designer, and almost surely qualifies as original and creative enough for copyright. This divisive method will be more satisfying than the court's approach for those who insist on knowing what "sculptural feature" has been judged separate from and independent of the utilitarian aspects of the buckle. As Judge Weinstein remarked in his dissent: "The artist has enhanced the appearance of the buckles by rendering their shape aesthetically pleasing without interfering with function. It is the originator's success in completely integrating the artistic designs and the functional aspects of the buckles that *preclude* [sic] copyright."<sup>102</sup> Judge Weinstein did not consider the possibility of a physical division of the buckle.

Furthermore, the shape of the *Kieselstein-Cord* buckle did not involve any advance in functional design. Copyright protection would not create a monopoly in any original method of buckling. The fragmentary protection suggested here would never permit a copyright holder to monopolize any special utilitarian value which an original design might incorporate.

## V. THE LATER CASES

The *Kieselstein-Cord* case established a pattern of greater attention to the "conceptual separability" found in the legislative history than for the words of the statute, and greater attention to the conceptual than to the physical aspects of the work. The next two important Second Circuit cases added to this pattern a concern for abstract theory. The facts presented in *Carol Barnhart Inc. v. Economy Cover Corp.*<sup>103</sup> and *Brandir International v. Cascade Pacific Lumber*<sup>104</sup> are particularly illuminating. The theories presented in these cases illustrate primarily the defects of the pattern described above.

### A. *Carol Barnhart Inc. v. Economy Cover Corp.*

In *Barnhart.*, the Second Circuit grappled with four styrofoam torsos to clarify the rule of *Kieselstein-Cord*.<sup>105</sup> Plaintiff, the producer of forms for the display of shirts and sweaters, sought protection for two models which simulated a male and female torso.<sup>106</sup> Copyright registration was sought after copying was discovered, and such registration was granted in one day. The Copyright Office's approval, however, did not bar the district court from reconsidering the question of whether the

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102. *Id.* at 994 (Weinstein, J., dissenting) (emphasis added).

103. 773 F.2d 411 (2d Cir. 1985).

104. 834 F.2d 1142 (2d Cir. 1987).

105. *Barnhart*, 773 F.2d at 418-19.

106. *Id.* at 412. Two other models included in the lawsuit came with sculpted shirts to be used for displaying jackets. *Id.* For simplicity, this analysis will be limited to the unclothed torsos.

article was suitable for copyright due to its utilitarian nature.<sup>107</sup> Summary judgment for defendant was upheld on appeal.<sup>108</sup>

The majority again ignored the requirement of independent existence, or equated it to separability. This case can be distinguished from *Kieselstein-Cord*, since “the ornamented surfaces of the buckles were not in any respect required by their utilitarian functions.”<sup>109</sup> Contrastingly, the artistic features of the Barnhart forms, “the life-size configuration of the breasts and the width of the shoulders, are inextricably intertwined with the utilitarian feature; the display of clothes.”<sup>110</sup>

Judge Newman in a lengthy and challenging dissent declared that the majority had misunderstood or misapplied “the interesting though esoteric issue of ‘conceptual separability.’”<sup>111</sup> After stating the statutory definition requiring both separability and independent existence, Judge Newman quoted the House Report that there must be “‘some element that, *physically or conceptually*, can be identified as separable from the utilitarian aspects of that article.’”<sup>112</sup> He then pointed out that “[i]n this Circuit it is settled, and the majority does not dispute, that ‘conceptual separability’ is distinct from ‘physical separability’ and, when present, entitles the creator of a useful article to a copyright on its design.”<sup>113</sup>

In attempting to harmonize *Kieselstein-Cord* with *Esquire* and other cases, Judge Newman not only elevates a term in the legislative history as a substitute for the two-part statutory requirement, he pursues the logic of this substitution rigorously, to a point where the majority cannot follow. To refute Judge Newman satisfactorily, the majority would have had to qualify their approval of *Kieselstein-Cord*, which they were unwilling to do.

In a provocative footnote, the dissent distinguishes the idea of “functionality” applied in trademark law to prevent capture under the guise of “trade dress” of a utilitarian design feature.<sup>114</sup> Judge Newman declares that “copyright law, however, does not deny copyright protection to a design simply because the design features are functional. If the design engenders a concept that is separable from the concept of

107. *Carol Barnhart Inc. v. Economy Cover Corp.*, 594 F. Supp 364, 365 (E.D.N.Y. 1984).

108. *Barnhart*, 773 F.2d at 412.

109. *Id.* at 419.

110. *Id.*

111. *Id.* (Newman, J., dissenting).

112. *Id.* at 420 (quoting H.R. REP. NO. 1476, 94th Cong., 2d Sess. 55 (1976), reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5668). The two references in the same paragraph denying protection to the overall shape of the useful article are, not surprisingly, omitted.

113. *Id.* (citations omitted) (emphasis added).

114. *Id.* at 420 n.1.

the utilitarian function, the design is copyrightable."<sup>115</sup> This startling conclusion expresses a judgment of the policy behind the limitation on useful works. Rather than seeing an attempt to preserve competition in functional objects, Judge Newman apparently believes that the primary purpose of the statutory provisions is to limit the coverage of copyright to those classy objects that can be called "art."

Conceding that copyright law will permit a designer to capture the value of useful designs, Judge Newman goes on to create a test which the majority aptly describes as a "bottomless pit."<sup>116</sup> Judge Newman carefully notes a possible danger: "Some might think that the requisite separability of concepts exists whenever the design of a form engenders in the mind of the ordinary observer any concept that is distinct from the concept of the form's utilitarian function."<sup>117</sup> But no! To go so far "would subvert the Congressional effort to deny copyright protection to designs of useful articles that are aesthetically pleasing."<sup>118</sup> To be more faithful to Congressional intent we must allow protection "only when the non-utilitarian concept can be entertained in the mind of the ordinary observer without at the same time contemplating the utilitarian function."<sup>119</sup>

One factor prompting Judge Newman to this extraordinary proposal is the nature of the work in question. Human torsos are a typical subject for traditional art. The majority cast doubt on this conclusion on the grounds that "[i]t would only be by concealing the open, hollowed-out rear half of the object, which is obviously designed to facilitate pinning or tucking in of garments, that an illusion of a sculpture can be created."<sup>120</sup> Artists working in ceramics, however, create exactly this type of hollow-backed torsos, so Judge Newman is more accurate on this point.<sup>121</sup>

Professor Brown also questions the artistic standing of the works in question: "The mannequins in *Barnhart*—I have seen them—are flimsy styrofoam shells. Frontal photographs create a solid sculptural impression that is quite lacking in the objects themselves."<sup>122</sup> The statutory definition of copy provides that "[t]he term 'copies' includes the material object, other than a phonorecord, in which the work is first

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115. *Id.*

116. *Id.* at 419.

117. *Id.* at 423.

118. *Id.*

119. *Id.*

120. *Id.* at 419 n.5.

121. For example, see the ceramic torso by artist Ron Cooper pictured in *Eye on . . . Hopper at Home*, HARPERS' BAZAAR, May 1990, at 119.

122. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1351 (1987).

fixed."<sup>123</sup> Professor Brown's objection relates to the copy, not to the work.<sup>124</sup>

Accepting Judge Newman's artistic nature of the work, the majority's characterization of the resulting "bottomless pit" remains accurate. The majority properly notes that the inquiry into the ordinary observer's concepts will require expert testimony and opinion surveys. The opinion notes that the public has been manipulated to accept Campbell soup can labels as works of art, and more could be said along this line.<sup>125</sup> We must consider that confusion as to what is an "art object" is widespread,<sup>126</sup> and that the legislative history of the 1976 Act clearly indicates that the change in statutory language from "work of art" to "pictorial, graphic, or sculptural work" was intended to eliminate such questions.

The availability of experts to testify on either side of more scientific questions is a cause for skepticism, if not scandal. The mental operation required to testify as to the question raised by Judge Newman's test presents an amusing challenge, requiring of witnesses a mental effort comparable to the (presumably impossible) test for initiation into the White Bear Club: Sit in the corner for one-half hour and do not think of a white bear.<sup>127</sup>

Neither the majority nor the dissent considered dividing the dummy into utilitarian and non-utilitarian elements. An imagined physical division again illustrates the problem of utility arising from simple physical properties. The *Barnhart* forms can be divided in two by the crude physical approach suggested. Application of the "hack-saw" approach can divide each display form by slicing vertically with a blade that extends from shoulder to shoulder. The remains are two solid styrofoam shells of comparable height, breadth and curvature, but

123. 17 U.S.C. § 101 (1988).

124. The term "work" is undefined in the statute, but by the definition of the term "copy" quoted, it is clear that the "work" is an abstraction, prior to any particular example. Thus, using the common meaning of the word "idea," it may accurately be stated that the Copyright Act protects nothing but "ideas." Section 102(b), of course, provides that "[i]n no case does copyright protection for an original work of authorship extend to any idea . . . regardless of the form in which it is . . . embodied in such work." *Id.* § 102(b). The philosophically peculiar theory of the Act appears to be that an idea is *embodied* in a work, which is distinct from any physical rendering or copy (and thus itself disembodied). This set of givens should provide the metaphysicians with so much to chew on that useful objects could be left to cruder minds for the present.

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

126. For a serious consideration from outside the art world, see generally E. BANFIELD, *THE DEMOCRATIC MUSE* (1984).

127. The suitable expert testimony would have to take the form: Though I cannot now contemplate this torso without being aware of both aspects, I recall that when first the lawyer presented it to me, for a brief period I wavered between thinking of it exclusively as an art object and thinking of it exclusively as a shirt dummy. No one familiar with literary art criticism and the general availability of expert testimony would expect difficulty in finding suitable witnesses.



reduced depth. One has the back of the unaltered form and a smooth, curved rectangular front. The other has the front of the unaltered mannequin with the bulges and cavities of human form, and a smooth sliced back. Each is suitable for the display of garments.

This approach might have been a convenient, unmetaphysical resolution of the issue of copyrightability; the division does not exclude utility from the sculptured shape, therefore, protection should be unavailable. The "hacksaw" can work again, however, to sever a segment of the contoured form, the breasts, preferably, as the most distinctive segment; the left or right half of the form would serve as well. By this device a portion is obtained which has no utility, and protection of which will prevent mechanical duplication without restraining competition in similar objects.

Without such a division, the contoured shape, as well as its uncountoured substrate, is useful for displaying shirts because of its simple physical dimensions—height and width comparable to a human torso. It will be argued in a later section that such simple properties cannot be captured by copyright, and ought not be used to justify a determination that sculptural properties have not been separated from useful elements.<sup>128</sup>

The contoured shape has another sort of utility, which is equally awkward for analysis. The extra advantage conveyed by the human contours is a more attractive appearance for the articles of clothing displayed on the form. This is a very tenuous sort of utility, quite close to Judge Joiner's analysis, rejected by the Sixth Circuit, of the utility of a toy airplane: "[I]t permits a child to dream and to let his or her imagination soar."<sup>129</sup> The contoured form may be more "useful" than a simple rectangle to a merchant because it may have slightly more aesthetic appeal to customers. Such "mercantile utility" cannot be accepted without unacceptable corollaries.<sup>130</sup> Certainly, display props are

128. See *infra* text accompanying notes 142-51.

129. *Gay Toys, Inc. v. Buddy L Corp.*, 522 F. Supp. 622, 625 (E.D. Mich. 1981), *vacated*, 703 F.2d 970 (6th Cir. 1983). Though Judge Joiner's attempt to establish utility from the child's viewpoint was reversed, neither the district court nor the court of appeals dealt with the question from the point of view of the parent. The toy is useful because you give it to your children and get a few minutes of quiet. The "utilitarian aspect" here is novelty, which is not copyrightable, and analogous to the utility that arises from simple physical properties. More recently, the exclusion of toys from the class of "utilitarian object" has been ignored by the Copyright Office in the case of the "Koosh" ball. See *OddzOn Prods. Inc. v. Oman*, 924 F.2d 346 (D.C. Cir. 1991).

130. If, for example, it were established that displaying shirts on hangers resulted in sales of  $x$ , use of the *Barnhart* forms resulted in sales of  $1.2x$ , and display of the shirts draped across a painting resulted in sales of  $1.5x$ , would that make the painting a useful article within the meaning of the Copyright Act? A similar, though unresolved case involved showcases for eyeglasses, which derived utility from simple physical properties and from beauty. *Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95 (D. Del. 1982), *later proceedings* (with pictures of the

useful to merchants as would be recorded music, or perfume sprayed in the store-air useful for a seduction. The statutory definition of "useful article" requires an "intrinsic utilitarian function," and the utility which comes from perceived beauty should not be used to prevent a finding that sculptural features have been separated from utilitarian aspects of a work.

In *Barnhart*, neither the majority nor the dissent considered whether granting protection would permit the copyright proprietor to capture the value of the function of a mannequin torso for display of shirts and sweaters. It seems obvious that the basic dimensions suitable for display of garments could not be monopolized, nor could the idea of human contours. Had protection been granted to plaintiff's design, competition would be unaffected, barring an exact reproduction of the protected form.

*B. Brandir International Inc. v. Cascade Pacific Lumber Co.*

It has been suggested, despite the court of appeals decision, and contrary to the Congressional intent suggested by the House Report, that the statutory language of the 1976 Act, if applicable, would have required that the lighting fixtures in *Esquire* receive copyright protection because the wiring could be ripped out. It has also been suggested that both the majority and dissenting opinions in *Kieselstein-Cord* overlooked a crude but honest analysis that would have secured protection and consistency with the statute by cutting apart the "work of art." In *Barnhart*, both the majority and the dissent concentrated on theory, perhaps because physical division of the article into a useful and a non-useful portion was particularly challenging due to the utility arising from simple physical properties.

In the next leading case, *Brandir International, Inc. v. Cascade Pacific Lumber Co.*,<sup>131</sup> the Register of Copyright denied registration to an article the design of which did not permit division into sculptural and useful features.<sup>132</sup> The simple bicycle rack at issue integrated form and function so perfectly that any protection against copying the overall shape would grant a monopoly in a shape both efficient and attractive.<sup>133</sup> The Court of Appeals for the Second Circuit on this occasion

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display cases), 750 F.2d 1552, 1556 (Fed. Cir. 1984). Summary judgment was withheld to permit testimony on "conceptual separability," and further reports of the controversy involve only the status of design patents. *Id.*

131. 834 F.2d 1142 (2d Cir. 1987).

132. *Id.* at 1143.

133. Another limitation of patent protection, as compared to copyright, is illustrated by this designer's failure to secure protection before marketing the design. Whatever possibilities the design may have had for a utility or design patent were lost when it was offered for sale. The possibility of copyright protection, however, could still be asserted.

departed from physical reality altogether and split over whether the determining factor should concern the state of mind of the actual designer, or that of an imaginary observer.<sup>134</sup>

The bicycle rack can be described simply as a length of pipe that begins with an upright section the height of a bicycle wheel. The pipe is then bent into a regular 180° (half circle) curve from which another vertical section descends to a similar curve just touching the ground. A bicycle wheel fits under each top curve and over each bottom curve. The number of segments can be extended to fit available space. The racks are widely seen at newer high school and college buildings.

The design is so simple and integrated that there literally is nothing but the overall shape. "Conceptual separation" of "artistic elements" cannot lead to copyright protection which leaves utilitarian aspects free to be copied. Nevertheless, the court of appeals found it difficult to apply the statute without the help of a theory. The majority chose the formula provided by Professor Denicola.<sup>135</sup> This formula asserts that the "statutory criterion limiting protection . . . should be viewed as an attempt to identify elements whose form and appearance reflect the unconstrained perspective of the artist."<sup>136</sup> More simply, copyrightability should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations.

Judge Winter, in a dissenting opinion, followed the theory proposed by Judge Newman (who dissented in *Barnhart*), which requires a determination of whether the ordinary observer could purify its mind of the thought of usefulness.<sup>137</sup> Both theories violate the apparent Congressional purpose to preserve competition as to useful aspects of articles, and demonstrate the preference of the courts to protect art rather than competition.<sup>138</sup>

In the district court, it appears that plaintiff had attempted to conform the facts to the Denicola theory. This was done by contending that the configuration of pipe at issue was created as a work of art and its useful qualities were noted later.<sup>139</sup> The court of appeals, while ac-

134. 834 F.2d 1142 (2d Cir. 1987).

135. *Id.* at 1145-47.

136. Denicola, *supra* note 88, at 742. Note the direct conflict of this formula with the language of H.R. REP. No. 1476, "even if the appearance of an article is determined by esthetic (as opposed to functional) considerations . . ." H.R. REP. No. 1476, *supra* note 5; see also *supra* text accompanying note 27.

137. *Brandir*, 834 F.2d at 1151 (Winter, J., dissenting).

138. The District of Columbia Circuit has reserved judgment on the *Brandir* test, while holding that the Copyright Office did not abuse its discretion in relying on this test to deny copyright to the "Koosh" ball. *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346 (D.C. Cir. 1991).

139. "In their motion papers the parties debate whether Levine first created his object as a piece of art with the intention of subsequently receiving its utility as a bicycle rack (as *Brandir*

cepting the theory, made light of this factual possibility, drawing from the deposition of the designer to describe the way a businessman's hobby of bending wire into "art" led a friend to note that the shape of one of artworks suggested a bike rack.<sup>140</sup> The deposition of David Levine, the designer/businessman, is notable because of his calculated testimony on the question of separability:

Q. Would you explain how you can separate the sculpture [sic] feature which you have described from the utilitarian feature of the rack?

A. The sculptural features of the rack are totally separate from its utilitarian features.

Q. How can you separate them?

A. Because it was a piece of sculpture. And the fact that it can be used as a bicycle rack is a purely accidental event.

Q. When you separate the sculptural features from the utilitarian features, what do you have left?

A. I cannot separate the sculptural features from the utilitarian features in the manner in which—to me, this is my sculpture . . . .<sup>141</sup>

The final question of this cross-examination is remarkable. It suggests that there are two entities to be considered when the question of separability and capability of independent existence are presented: that for which protection is sought, and that which will not be protected. It was previously contended that this suggestion describes the process which most clearly satisfies the statutory language. Even if separation is achieved conceptually, there must be two entities, for example the wrapping paper and the design printed on it, for separation and independence to be found.

## VI. THE UTILITY OF SIMPLE PHYSICAL PROPERTIES

The approach suggested here reached satisfactory results when applied to the reported cases. Protection can usually be afforded to attractive designs with clear analysis, by strictly adhering to statutory language, and by relying primarily on physical description and division of the article rather than vague references to protected shape as "artistic features" or "ornamental aspects." Theories dependent on evidence of mental processes of creators or critics are unnecessary. Most importantly, competition in original useful designs is carefully preserved.

Unfortunately, the approach does not help with the class of articles whose utility is derived not primarily from the quality of their de-

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contends); or whether Levine set out to design and manufacture a bicycle rack in the first place (as Cascade contends)." *Brandir Int'l, Inc.*, 1986 Copyright L. Dec. (CCH) ¶ 26,017, at 20,690.

140. *Brandir*, 834 F.2d at 1146.

141. 1986 Copyright L. Dec. ¶ 26,017, at 20,691 (quoting Transcript at 12).

sign, but from simple physical properties. The 1976 Act defines "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."<sup>142</sup> This includes such articles as paperweights and boxes, and requires that copyright in imaginative designs for such articles be subject to the limitations in the coverage of useful articles included in the definition of "pictorial, graphic and sculptural works." Analysis of more complex useful articles may be complicated to the extent that *part* of their utility stems from such simple properties.

Examples of utility arising from simple physical properties will be described to demonstrate the problem they create for interpretation of the statutory language. An interpretation of the statute will be offered which may solve these problems while clarifying others.

A bust of Beethoven can be used as a paperweight or a doorstop. This is true of any three-dimensional object with sufficient mass. Professor Denicola mentions this example, noting that analogies to baby carriages or food processors "seem silly," and concluding that "[e]ven if the statutory description of useful articles should happen to encompass all three, we would expect the bust to survive the subsequent analysis with full copyright protection intact."<sup>143</sup> He suggests that our expectation is justified because the form of the bust is independent of its utility. Coming after the concession that the statutory definition encompasses the bust, as well as the baby carriage, his confidence depends on the questionable willingness of judges to rely on intuition despite apparently contradictory statutory language. Furthermore, we cannot be confident that the protection proposed would extend to an aesthetically pleasing abstract design of a solid object *intended* to be used as a paperweight.

Another simple physical property accounting for the utility of an object is the quality of having a hollow inside and a closable opening. Bags,<sup>144</sup> boxes,<sup>145</sup> and coin banks<sup>146</sup> were involved in several cases under the 1909 Act at a time when the applicable regulations contained the requirements of separability and independent existence picked up in the 1976 Act. In each of these cases the Copyright Office

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142. 17 U.S.C. § 101 (1988).

143. Denicola, *supra* note 88, at 729.

144. R. Dakin & Co. v. A & L Novelty Co., 444 F. Supp. 1080 (E.D.N.Y. 1978) (stuffed animal functioning as pajama bag and pillow).

145. Dan Kasoff, Inc. v. Gresco Jewelry Co., 204 F. Supp. 694 (S.D.N.Y. 1962).

146. Goldman-Morgen, Inc. v. Dan Brechner & Co., 411 F. Supp. 382 (S.D.N.Y. 1976); Royalty Designs, Inc. v. Thifticheck Serv. Corp., 204 F. Supp. 702 (S.D.N.Y. 1962). In *L. Batlin & Son, Inc. v. Snyder*, the holding disapproved copyright in a bank for lack of originality. 394 F. Supp. 1389 (S.D.N.Y. 1975), *aff'd en banc*, 536 F.2d 486 (2d Cir. 1976). Usefulness was not mentioned.

had registered the work, and the copier did not raise the question of whether these utilitarian objects were properly the subject of copyright. Cellini's famous salt cellar, occasionally mentioned in the context of utility also belongs to this class.

In *Act Young Imports v. B and E Sales*,<sup>147</sup> a copier challenged registration of backpacks shaped like animals under the 1976 Act. Citing both *Barnhart* and *Kieselstein-Cord*, the district court declared, "[e]xamination of the backpacks yields the conclusion . . . that the artistic aspect of the backpack, that is the animal image, is separate from the useful function of the packs."<sup>148</sup> As in *Kieselstein-Cord*, there was no effort to describe what "artistic aspect" was capable of existing independently. Similarly, the facts do not indicate whether a separable animal shape was attached to an enclosure of regular shape, or whether the enclosure shared the animal shape.

The difficulties of applying the statute to boxes and bags can be illustrated by imagining an unadorned box with an attractive abstract shape, the same for both exterior and interior, and with no decorative aspects other than the overall shape. Unlike the *Esquire* design, which permitted the working parts to be torn from the hollow casing, in the case proposed, the utility comes from the hollowness itself.<sup>149</sup> On the one hand, the work cannot be separated into two independently existing entities, one which is decorative and one which is useful. On the other hand, no one could interpret a copyright in the article in such a way that the copyright holder appropriated the utilitarian function of a box.

An unexpected example of the problem created when utility arises from simple physical properties was noticed by the authors of a prominent casebook on copyright.<sup>150</sup> They cited a newspaper story of a small electronics firm marketing a compact radio antenna.<sup>151</sup> When the antenna was redesigned in the form of a modern sculpture orders increased by 500%.<sup>152</sup> The antenna is constructed of wire in which an electrical current can be induced, and its utility springs from that property. A straight wire has the best conductivity, so it is not likely that the sculptural shape has a unique utility.

The cases discussed previously include two additional examples of utility arising from simple physical properties. In the *Esquire* case, the

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147. 667 F. Supp. 85 (S.D.N.Y. 1986).

148. *Id.* at 87.

149. The *Esquire* housing presents the additional utilitarian aspect that it shields the wiring from the elements and from persons who might harm or be harmed. This aspect of the housing's utility springs entirely from its hollowness, and can be approached in the same way as the utility of bags and boxes.

150. R. BROWN & R. DENICOLA, CASES ON COPYRIGHT 181 (1990).

151. *Id.*

152. N.Y. Times, Feb. 12, 1989, at F3, col. 1.

housing's utility came in part from its height and in part from its hollowness. The human contours of the *Barnhart* torsos, taken as a whole, could not be separated from utilitarian aspects because any upright solid with height, width, and depth approximating those of a human torso can be used to display shirts. Each case suggests a crude evasion of part of the problem by seeking copyright protection for only a part of the article, the top disk of the light fixture, the surface of the breasts of the torso. The approach of seeking a part to protect does not work with paperweights and aerials, nor will it work with simple enclosures—boxes of original shape. It must be acknowledged that the elaborate theories propounded in *Barnhart* and *Brandir* apply as easily to cases of utility arising from simple physical properties as they do to any other sort of object. This flexibility does not make up for their defects.

An attempt to use the idea of "conceptual separability" to analyze paperweights and boxes points towards the inadequacy of that device. The shape of a paperweight can easily be conceived apart from its utility. Imagine a hologram, or a version of the shape in paper. If no attempt is made to conceive what is left behind after the shape is removed, this approach works well for paperweights. Unfortunately it works equally well for gears, or saw blades.

The difficulty of applying the statute to these hypothetical cases involving simple physical properties points toward a latent ambiguity in the statutory language, features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. The difficulties are minimized if separability and independent existence are sought in light of the obvious purpose of the limitation which is to remove utilitarian aspects from copyright protection. A sculptural feature should be judged as qualifying for copyright protection if it can be conceived separate and independent in such a way as to be capable of receiving copyright protection which would not necessarily extend to the utilitarian aspects of the object. The utilitarian aspects from which separation must be imagined should only include those sufficiently original to be possible subjects for copyright protection barring the statutory limitation. Weight, height, and conductivity are examples of uncopyrightable useful qualities difficult to imagine as existing separately, but which should not thereby disqualify a design from protection.

This simple interpretation allows the shapes of boxes, bags, paperweights and aerials to be protected without difficult analysis. As applied to the principal cases, it would allow protection to the *Esquire* light fixture housing and the contoured surface of the *Barnhart* mannequin. It would not affect the analysis of the *Kieselstein-Cord* buckle, but protection for a segment, as suggested earlier, would remain possi-

ble. The *Brandir* bike rack would still present no feature which could be isolated from its utility in such a way as to permit copyright coverage which would not also extend to the utilitarian aspects.

## VII. CONCLUSION

This article demonstrates that a simple-minded application of the statutory language to the facts of the leading cases reaches satisfactory and predictable results. This approach permits copyright protection to be extended to a wide range of attractive utilitarian designs and avoids both aesthetic judgments and dependence on the unverifiable mental states of imaginary beholders, venal experts or interested designers.

Unlike the leading cases, this approach does not ignore the statutory requirement that an aspect to be protected must be "capable of existing independently of the utilitarian aspects of the work." That language is given effect by considering the work which is divided, either physically or conceptually, into two describable portions. One portion retains a utilitarian function and may not be protected. The other portion, which may or may not be aesthetically pleasing, and may not be useful, is the work to be protected by copyright.

This analysis considered the problem of the utility of simple physical properties. This difficulty was first realized with the suggestion that small works of art could hardly be separated from their potential use, for example, paperweights. The functional aspect of a paperweight is, however, analogous to the functional aspects of many other objects including boxes, aerials and Caryatids. Non-recognition of such as "useful articles" would circumvent the statutory definition. Denying copyright protection to the shapes of these articles appears contrary to common sense. The solution of this conundrum is to recognize the ambiguity of the language by which protection of useful articles is limited, and to interpret the language which allows the broadest extent of copyright protection in a manner that will never permit copyright protection to extend to useful features.

Eagerness to protect "art" has created a theoretical muddle; concentration on protecting competition clarifies the situation, and still permits protection of all but the most purely utilitarian designs.



