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## Protection for Typeface Designs: A Copyright Proposal

Terrence J. Carroll

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# COMMENTS

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## PROTECTION FOR TYPEFACE DESIGNS: A COPYRIGHT PROPOSAL

Terrence J. Carroll†

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Copyright © 1994 Terrence J. Carroll.

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“There is . . . much difference to my eyes between the leaded bourgeois type of a *Times* article and the slovenly print of an evening halfpenny paper. . . .”

—Sherlock Holmes, *The Hound of the Baskervilles*<sup>1</sup>

## I. INTRODUCTION

With the advent of personal computers and desktop publishing, the use of customized typefaces and fonts<sup>2</sup> is becoming commonplace. Companies such as International Typeface Corporation (ITC), Monotype, Apple, Adobe Systems, and Microsoft are heavily involved in the typeface and font industry, employing artisans to develop typefaces and skilled engineers to encode those typefaces into fonts, and licensing the typefaces and fonts into products.<sup>3</sup> Adobe Systems alone spent 5.8 million dollars on typeface production in fiscal 1992.<sup>4</sup> It may come as a surprise to many to discover that much of the product of this industry is afforded little or no copyright protection. In the

1. ARTHUR C. DOYLE, *THE HOUND OF THE BASKERVILLES*, reprinted in 2 *THE ANNOTATED SHERLOCK HOLMES* 22 (William S. Baring-Gould ed., Clarkson N. Potter, Inc. 1978) (1967).

2. As used in this comment, the word “typeface” refers to the formations of the printed letters. A “typeface” can be defined as a set of letters, numbers, or other symbolic characters, whose forms are related by repeating design elements consistently applied in a notational system and are intended to be embodied in articles whose intrinsic utilitarian function is for use in composing text or other cognizable combinations of characters. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668.

The term “typeface” means a set of letters, alphabets, numerals, figurative signs, punctuation marks, and the like, intended to provide the means for composing text by any graphic technique such as printing. Typefaces are distinguished one from the other by the differences in the repeating design elements consistently applied throughout the typeface. These design elements may be limitless, and include such aspects as the degree of stroke contrast, angle of emphasis, stroke shape, serif or non-serif (sanserif), curved form, and arch form.

*Eltra v. Ringer*, 194 U.S.P.Q. (BNA) 198 (E.D. Va. 1976) (*Eltra I*), *aff’d on other grounds*, 579 F.2d 294 (4th Cir. 1978).

A typeface is distinguished from a “font,” which is an article “in which a typeface resides as the implement of printing technology, regardless of medium or form.” H.R. 1790, 102d Cong., 1st Sess. § 1001(b)(4) (1991) (defining “typefont”). That is, a font is the embodiment of a typeface into an article from which the typeface may be reproduced. Examples include a font file residing on a computer’s disk, a film font used in photographic typesetting, and physical metal type.

An alternative definition of “font” often used in the printing industry is a subset of a typeface consisting of letters, numeral, and punctuation marks of single size and style. See *United States v. Heemsoth-Kerner Corp.* (Bauer Type Foundry, Inc.) 31 C.C.P.A. 75 (1943). This is a different sense from that employed in this article.

3. See *Apple, Microsoft announce cross license agreement for outline font technology, printer software*, Businesswire, Sept. 19, 1989, available in DIALOG, Buswire file.

4. ADOBE SYSTEMS, INC., 1992 ANNUAL REPORT 34 (1993).

view of some typeface designers, the lack of protection has injured designers both economically and artistically.<sup>5</sup>

This comment discusses the options available for protecting the intellectual property of typefaces. It reviews the requirements for copyright protection, applies those requirements to typeface design, and concludes that typefaces are appropriate subject matter of copyright. The comment goes on to analyze the problems associated with protecting typefaces with copyright in light of the various tests for protecting copyright in a design for a useful article.

The comment discusses the only reported case to have directly addressed the issue of typeface copyright, *Eltra v. Ringer*,<sup>6</sup> which denied a writ of mandamus commanding the registration of such a copyright. With the benefit of hindsight and subsequent developments in copyright law, the comment analyzes the *Eltra* decision and concludes that if the case were presented today, its outcome should be to allow copyright.

The comment presents several arguments that have been put forth in opposition to such copyright and discusses each. It concludes that correction of the *Eltra* holding through another judicial proceeding is not likely, and proposes an amendment to the Copyright Act to permit copyright of typeface.

## II. REQUIREMENTS FOR COPYRIGHT: § 102(A)

The requirements for copyrightable subject matter are set forth in § 102 of the Copyright Act of 1976.<sup>7</sup> The section consists of two parts: § 102(a) describes the requirements a work must meet to be copyrightable, while § 102(b) describes limitations on copyrightable subject matter. Under § 102(a), a work is subject to copyright if it is an original work of authorship fixed in a tangible medium of expression.<sup>8</sup> Thus, there are three requirements for a work to be subject to copyright: it must be original, it must be fixed in tangible form, and it must be a "work of authorship."<sup>9</sup>

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5. Electronic mail from Charles Bigelow, President, Bigelow & Holmes, Associate Professor, Computer Science and Art, Stanford University, to Terry Carroll (June 29, 1993) (on file with author).

6. *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978).

7. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-1010 (1988 & 1992 Supp.)).

8. "Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. 102(a).

9. The approach taken by courts has varied as to whether these elements are formulated as three requirements, or whether the elements of creative expression as a work of authorship and

### A. *Originality*

The requirement for originality is easily met. "Original" in this context means only that the work has its origin in the author.<sup>10</sup> There is no requirement that the work be different from everything that has come before: it need only embody a minimum level of creativity and owe its origin to the author claiming copyright.<sup>11</sup> To use an extreme example, if two poets, each working in total isolation and unaware of one another's work, were to compose identical poems, both of the poems would meet the originality requirement for purposes of the copyright statute.<sup>12</sup>

When a typeface designer produces a typeface, the work originates with that designer. Certainly the design of the typeface is constrained by the requirement that the typeface be recognizable as letters, and the shapes of the letters are, after all, elements in the public domain.<sup>13</sup> However, in designing a typeface, the designer adds much more than the mere forms of the letters. Any copyright that might subsist in a typeface design would encompass only those added elements, and not the forms of the letters themselves.<sup>14</sup>

### B. *Fixation*

The fixation requirement is also not a significant hurdle for the copyright of typeface design. A work is "fixed" when it is embodied in a medium of expression with sufficient permanence that it may be perceived for more than a transitory period.<sup>15</sup>

In the case of a typeface, there are at least two methods of easily meeting the fixation requirement. First, and most simply, the typeface

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that of originality are treated as a single requirement with two subparts: originality and creativity. See *Baltimore Orioles, Inc., v. Major League Baseball Players Ass'n*, 805 F.2d 663, 668 n.6 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987). In some approaches, the phrase "original works of authorship" is taken as a whole, incorporating both the originality and creativity requirements. See, e.g., *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 355-57 (1991).

10. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951).

11. *Id.* at 101-104.

12. *Feist*, 499 U.S. at 345-46.

13. An element in the public domain is one that is not subject to copyright. *Sieff v. Continental Auto Supply*, 39 F. Supp. 683, 688 (D. Minn. 1941). Public domain sources are available to be used by anyone. *Sawyer v. Crowell Pub. Co.*, 46 F. Supp. 471, 474 (S.D.N.Y. 1942), *aff'd* 142 F.2d 497 (2d Cir. 1944), *cert. denied*, 323 U.S. 735 (1944).

14. "The copyright in a . . . derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not employ any exclusive right in the preexisting material." 17 U.S.C. § 103(b).

15. "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101.

may be depicted on sheets of paper. Alternatively, the typeface may be embodied into a font, from which the typeface may be perceived by ordinary use of the font to print text.

### C. *Work of Authorship*

Typefaces, at least certain of them, are sufficiently creative works of expression to rise to the level of works of authorship. A typeface's use is not merely to communicate, but also to express. This may be seen from examining how typefaces are used and designed.

In the advertising industry, a typeface is chosen with great care, not just for the strictly utilitarian functions of clarity and readability, but for its ability to evoke a particular image or feeling in the consumer. As one commentator has noted, "[a]s long as people will peruse the printed word, designers, art directors, writers, and editors will agonize over the choice of a typeface."<sup>16</sup> Advertisers characterize typefaces as "having a raw, urgent, look,"<sup>17</sup> "suggesting stretching,"<sup>18</sup> or as "the perfect typeface for imagining the body behind the words in this sweet ad."<sup>19</sup> Typefaces are carefully chosen for such subtle effects as allusion to a historical period, a sense of modernity, or "atmosphere value."<sup>20</sup>

It is also worth noting the opinions expressed by typeface designers of their craft. Renowned typeface designer Hermann Zapf believed that a typeface necessarily embodies the expression of the time in which it was designed.<sup>21</sup> Frederick W. Goudy, perhaps the most famous typeface designer of the 20th century, described the design of a typeface:

The perfect model for a type letter is altogether imaginary; there is no copy for the designer today except the form created by some earlier artist, and the excellence of a designer's work depends entirely upon the degree of imagination and feeling he can include in

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16. Anthony Vagnoni, *Editorial*, *ADVERTISING AGE*, Aug. 3, 1992, at 3C.

17. Bob Blewett, *The Big Face Off; It's Their Words (For And) Against Yours, As We Ask Font-wise Professionals to Air Their Love/hate Relationship With Advertising Typography* (pt. 1), *ADVERTISING AGE*, Aug. 3, 1992, at 8C.

18. *Id.*

19. Jim Poole, *The Big Face Off; It's Their Words (For And) Against Yours, As We Ask More Font-wise Professionals to Air Their Love/hate Relationship With Advertising Typography* (pt. 2), *ADVERTISING AGE*, Oct. 5, 1992, at 21C.

20. Electronic mail from Charles Bigelow, President, Bigelow & Holmes, Associate Professor, Computer Science and Art, Stanford University, to Terry Carroll (Oct. 9, 1992) (on file with author).

21. Hermann Zapf, *The Expression Of Our Time In Typography*, Lecture Delivered at Gallery 303, New York City (May 2, 1966), in *HERITAGE OF THE GRAPHIC ARTS 2-17* (Chandler B. Grannis, ed., 1972).

the rendition of that traditional form. . . . But form alone is not enough; type must show life and power, that is, expression. Many types have correct enough forms, yet lack entirely that vibrant quality of life and vigor which comes naturally from the hand of a craftsman who is intent on personal expression and is not merely attempting to display his draftsmanship for an exact and precise finish.<sup>22</sup>

Behavioral studies verify that the value of a typeface derives from its aesthetics, and not from any utilitarian purpose. Studies show that variation of typeface has little impact on utilitarian aspects of typeface, such as the readability of text and the legibility of words.<sup>23</sup> In the studies performed by Paterson and Tinker,<sup>24</sup> of the readability of various typefaces in common use, the typefaces were found, in general, to be equally readable. These tests found that there were no significant differences among the rates of reading text in 8 of the 10 typefaces tested.<sup>25</sup> Only two of the tested typefaces, "American Typewriter" and "Old English," were found to have any significant differ-

22. FREDERICK W. GOUDY, *TYPOLOGIA: STUDIES IN TYPE DESIGN AND TYPE MAKING* 40-41 (1940). Goudy continues:

Type design involves craftsmanship of a high order; but good technique alone is not enough. A design devoid of emotion, rhythm, and expression, yet technically excellent, merely betrays the fact that it has been produced by one who has nothing of value to express. To produce a line by mere mechanical deftness is one thing; to draw a line of delicacy and refinement, subtle and expressive, instinct with life, vigor, and variety, is something else, and can be done only by one who possesses strongly a due regard and feeling for these qualities. In any types of distinction, the qualities of interest and personality, beauty and charm, are essential, and when the type exhibits them, fine technique, while desirable, is of secondary importance.

*Id.* at 69.

23. Clive Lewis & Peter Walker, *Typographical Influences on Reading*, 80 *BRIT. J. PSYCHOL.* 241, 243 (1989). See also Donald G. Paterson & Miles A. Tinker, *Studies of Typographical Factors Influencing Speed of Reading*, 16 *J. APPLIED PSYCHOL.* 605 (1932); Miles A. Tinker & Donald G. Paterson, *Influences of Type Form on Speed of Reading*, 12 *J. APPLIED PSYCHOL.* 359 (1928).

As used here, the term "readability" refers to the ability of the subjects to read text printed in various typefaces. In contrast, other studies have measured legibility of the individual letterforms, and have noted some differences in the ability to recognize individual letters (but not of words or sentences as a whole) when perceived from various distances. See, e.g., Barbara Elizabeth Roethlin, *Relative Legibility of Different Faces of Printing Types*, 23 *AM. J. PSYCHOL.* 1-36 (1912); Harold E. Burt & Coryne Basch, *Legibility of Bodini, Baskerville Roman, and Cheltenham Type Faces*, 7 *J. APPLIED PSYCHOL.* 237 (1923). The extrapolation of studies of legibility of letters printed in a particular typeface to the readability of text printed in that typeface is questionable. Paterson & Tinker, *supra*, at 606.

24. Paterson & Tinker, *supra* note 23, at 605.

25. *Id.* at 609.



ences in readability.<sup>26</sup> Because of the specific attributes of these two typefaces, they merit specific discussion.

American Typewriter is a non-proportional, or monospaced, typeface.<sup>27</sup> In the Paterson and Tinker studies, text printed in the American Typewriter typeface was read 5.1% more slowly than text in the other typefaces.<sup>28</sup> This is apt to be due to the non-proportional property of the typeface, in that the uniformity of letter size impedes the perception of characteristic word forms.<sup>29</sup>

The other typeface that showed differences in readability was Old English,<sup>30</sup> a heavy, ornate, decorative typeface with angular features, also known as "Black Letter" or "Gothic."<sup>31</sup> Generally, Old English is not used when readability is a primary objective, but is rather used for effect, to suggest antiquity or Germany.<sup>32</sup> Newspaper mastheads are frequently set in such type.<sup>33</sup> In the Paterson and Tinker studies, text printed in an Old English type was read 16.5% more slowly than other typefaces.<sup>34</sup>

The Paterson and Tinker studies concluded that most typefaces in common use are equally easy to read.<sup>35</sup> Where there were deviations from the standard of readability, as in the American Typewriter and Old English typefaces, the typefaces were *less* easy to read than the

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26. *Id.*

27. In a non-proportional typeface, every letter occupies the same amount of horizontal space, regardless of its shape. For example, a thin letter such as "I" takes just as much space as a wider letter, such as "M." In contrast, in a proportional typeface, thin letters will occupy less horizontal space as the wider letters. Electronic mail from Charles Bigelow, President, Bigelow & Holmes, Associate Professor, Computer Science and Art, Stanford University, to Terry Carroll (June 11, 1993) (on file with author). Examples of non-proportional typefaces include the Courier and Monaco typefaces, reproduced as figures 3 and 4 in the appendix. Of the typefaces reproduced in the appendix, Courier is the one most similar to (although far from identical to) the American Typewriter typeface used in the Paterson and Tinker studies.

Non-proportional typefaces are used where it is important that the number of characters that fit in a particular measured horizontal area is predictable. The best example of an application of a non-proportional typeface is a typewriter: since a typewriter advances a fixed amount of space with each key struck, the use of a non-proportional typeface ensures that the printed characters track the advancement of the carriage. Non-proportional typefaces are frequently used for presentation of data in financial reports (because of their ability to ensure that all figures, letters, punctuation and reference marks line up uniformly) and for representation of text of computer program listings (because the structure of the program is more apparent when indentations, word spaces, etc., occupy an even metric of space). *Id.*

28. Paterson & Tinker, *supra* note 23, at 609.

29. *Id.* at 612.

30. *Id.* at 609.

31. For an example of a typeface of this type, see the "BobGothic" typeface reproduced as figure 8 in the appendix.

32. MARSHALL LEE, *BOOKMAKING* 77 (2d ed. 1979).

33. *Id.*

34. Paterson & Tinker, *supra* note 23, at 609.

35. *Id.* at 613.

norm.<sup>36</sup> No typefaces in the study were easier to read than the norm.<sup>37</sup> The studies suggest that the criterion used in selecting a typeface is its expressive and creative characteristic, the pleasant and attractive characters and design elements. Because there is no advantage in readability of any one typeface over the norm, readability is generally not a major factor in selecting a typeface.

Underscoring this expressive aspect is the artistry that is the aim in a typeface design. Typefaces are commonly designed with aim toward connoting a secondary meaning that complements the primary meaning conveyed by the words in print.<sup>38</sup> This characteristic has been variously labeled as “congeniality,” “typographical allusion,” “atmosphere value,” or “typeface personality.”<sup>39</sup>

In designing a typeface, there are numerous artistic decisions to be made. Should serifs<sup>40</sup> be employed or should the typeface be sans serif?<sup>41</sup> What weight should be used for the typeface: hairline, light, medium, demibold, bold, or extra bold? Should strokes be uniform or stressed?<sup>42</sup> Should the arms of letters be straight, bowed, or con-

36. *Id.* at 609.

37. *Id.*

38. Lewis & Walker, *supra* note 23, at 243.

39. *Id.*

40. A “serif” is a finishing stroke applied to a letter’s stem, for example, the short horizontal strokes found at the base and cap of a capital letter “T” in some typefaces. F.C. AVIS, *TYPEFACE TERMINOLOGY* 40 (1965). Several examples of typefaces with serifs are depicted in the appendix, including Times (figure 1), New York (figure 2), Courier (figure 3), BobGothic (figure 8), Koch Roman (figure 9), and Palatino (figure 12).

41. “Sans serif” (or “sanserif”) refers to a typeface without serifs. *Id.* at 39. Examples of sanserif typefaces included in the appendix are Monaco (figure 4), Helvetica (figure 5), and Geneva (figure 6).

In addition to deciding whether a typeface should include serifs, a typeface designer must also decide what types of serif should be employed, and how the serifs interact with the body of the letterform. A serif may be bracketed to the stem, or flat. A “bracket” is a curved connecting line used to unite a serif with a stem; a flat serif is one not bracketed to the stem. *Id.* at 13, 23. The serifs in the Times (figure 1, appendix) and New York (figure 2, appendix) typefaces are examples of bracketed serifs; the serifs in the Courier typeface are examples of flat serifs.

Other options with regard to serifs are whether the bracket should be curved or straight, and the degree of curve or angle employed. Serifs may be a hair line, slur, spurred, or concave stub. A “hair line serif” is a serif consisting of a very fine line which joins the stem with little or no bracketing. *Id.* at 25. A “slur serif” is a serif of bulbous formation. *Id.* at 43. A “spur” is a line extending or completing a serif. *Id.* at 44. A “stub” is a short or rounded serif, either concave or convex. *Id.* at 46.

42. “Stress” is “[t]he apparent inclination of round letters, bowls, etc., principally suggested by the position of the thickest part of the curved stroke.” *Id.* at 46. Where a typeface employs stress, the stress may be vertical, horizontal, diagonal, or mixed. BENJAMIN BAUERMEISTER, *A MANUAL OF COMPARATIVE TYPOGRAPHY: THE PANOSE SYSTEM* xv (1988). The stress is most easily observed in the capital letter “O”. Examples of unstressed typefaces in the appendix are the Courier (figure 3), Monaco (figure 4), Helvetica (figure 5), and Geneva (figure 6) typefaces. Examples of typefaces employing horizontal stress are the Times (figure 1), New York (figure 2), and Venice (figure 11) typefaces. Examples of typefaces employing diago-

cave?<sup>43</sup> Should openings be horizontal, vertical, or wedged?<sup>44</sup> Should the typeface contain extra features, such as ligatures,<sup>45</sup> finials,<sup>46</sup> or flourishes?<sup>47</sup> This is just a short list of a few of the artistic choices made by a typeface designer.

Perhaps the most concise summary of the expressive qualities of typeface is from a noted and respected commentator on copyright law, the late Professor Melville B. Nimmer:

It is hardly open to debate that typeface designs may embody not only the minimal originality and creativity necessary to support a copyright, but may, indeed, exemplify these elements in very marked degree. "The famous printer-designers, Fournier (1764), and later Bondoni (1818) have laid the main stress on the aesthetic qualities in book-making. The controversy between exponents of the Bauhaus style and the traditionalists in typography (Reiner 1946) was not simply a question of function; it was also one of aesthetics, and aesthetic traditions . . . Marderstein, like his American interpreter and confrere, Porter Garnett, does not admit expedience or compromise in the act of printing. Only excellence in aesthetic fulfillment is accepted."<sup>48</sup>

In summary, despite its important property of depicting text, a typeface nonetheless has an expressive aspect that, barring any justification for exclusion, qualifies it as a work of authorship protectable by copyright.

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nal stress include the Koch Roman (figure 9), Zapf Chancery (figure 10), and (subtly) Palatin (figure 12) typefaces.

43. See BAUERMEISTER, *supra* note 42, at xvi.

44. This is a reference to the angle at which the openings of letters such as the uppercase "C" is set. *Id.* at xvi. Horizontal openings are those which are horizontally parallel. The appendix includes two typefaces with horizontal openings: Helvetica (figure 5) and Geneva (figure 6). Vertical openings have the arms terminating in a single vertical line. An example of a typeface with horizontal opening is the Monaco typeface, reproduced as figure 4. A wedge opening occurs when either of the opening angles of the arms is not vertical or horizontal; Koch Roman (figure 9) is an example. *Id.* at xvi.

45. A "ligature" is a set of two or more tied letters, combined to share features in common. *Avis*, *supra* note 40, at 28. A common example is a lowercase "f" followed by a lowercase "i", combined so that an ornamental dot at the top of the "f" also serves as the dot over the "i". See the Times typeface in figure 1 for an example. Many of the typefaces reproduced in the appendix include some ligatures.

46. A "finial" is a special design of a letter, used as an alternative to the standard form when the letter is the last in a word or line. *Id.* at 23.

47. A "flourish" is an extension of or addition to a normal letter, or an ornamental line or shape. *Id.* at 24. The appendix includes two examples of typefaces with flourishes: Zapf Chancery (figure 10) and Venice (figure 11).

48. 15 OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 1038, 1040 (1977) (statement of Melville B. Nimmer, quoting B. ZACHRISSON, LEGIBILITY OF PRINTED TEXT 74 (1965)).

### III. LIMITATIONS ON COPYRIGHT: § 102(B) AND THE PROBLEM OF USEFUL ARTICLES

While § 102(a) describes what can be copyrighted, § 102(b) makes clear that copyright extends only to the expression in the copyrighted work, and not to any facts or useful aspects of the work.<sup>49</sup> Section 102(b) denies copyright to works that would otherwise be granted it, and limits the scope of copyright to works that do become copyrighted.

Difficulties arise when a work of authorship that qualifies for copyright is embodied in a useful article.<sup>50</sup> A design for a useful article qualifies as a pictorial, graphic, or sculptural work only if the design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and that are capable of existing independently of, the utilitarian aspects of the article.<sup>51</sup> Copyright protection extends only to those features, and not to the utilitarian aspects.<sup>52</sup>

#### A. *Mazer v. Stein*

The seminal case dealing with the separability of expression and utilitarian aspects of a useful article is the 1954 case of *Mazer v. Stein*,<sup>53</sup> decided under the Copyright Act of 1909. In *Mazer*, Reglar of California, a lamp company operated by the plaintiff, had created a series of lamps that incorporated statuettes depicting Balinese dancers into the lamp bases. Reglar submitted an application to the Copyright office to register the copyright in the statuette as a "work of art"<sup>54</sup> or a "reproduction of a work of art,"<sup>55</sup> and the Copyright Office registered

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49. "In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." 17 U.S.C. § 102(b).

50. "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." *Id.* § 101.

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

17 U.S.C. § 101.

52. *Id.*

53. *Mazer v. Stein*, 347 U.S. 201 (1954).

54. Copyright Act of 1909, ch. 320, § 5(g), 35 Stat. 1075 (repealed 1978).

55. *Id.* § 5(h).

the copyright. Once the lamps were marketed, the defendant's lamp manufacturing company copied the statuette into lamps of its own manufacture and sold them. The plaintiff brought suit for copyright infringement, which was dismissed for lack of copyrightable subject matter.<sup>56</sup>

The defendant's position was that, when an artist's works are intended for articles of manufacture, the works are protected not by the copyright law, but by design patent law,<sup>57</sup> if at all.<sup>58</sup> The U.S. Supreme Court disagreed. It noted that the predecessor statute had restricted subject matter of copyright to "models or designs intended to be perfected as works of the fine arts."<sup>59</sup> The Copyright Act of 1909 had removed this limitation, and extended protection to "all the writings of an author."<sup>60</sup> The 1909 phrase was similar in form to the Copyright Clause of the U.S. Constitution that authorized federal copyright law.<sup>61</sup> However, the court found that the legislative history of the 1909 Copyright Act indicated that Congress did not intend the statutory phrase to mean that the statute went as far as the Constitution authorized, but rather was intended to be a codification of the practices and regulations of the Copyright Office that were in effect at the time of the statute's enactment.<sup>62</sup> The specific regulation pointed to by the court was the former 37 C.F.R. § 202.8:

Works of art (Class G)—(a)—In General. This class includes works of artistic craftsmanship, in so far as their forms but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture.<sup>63</sup>

Thus, the Court reasoned that the statuette was eligible for copyright under the 1909 Copyright Act as a work of artistic craftsmanship. This was true despite the fact that the statuette incorporated into

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56. *Stein v. Mazer*, 111 F. Supp. 359 (D. Md. 1953), *rev'd*, 204 F.2d 472 (4th Cir. 1953), *aff'd*, 347 U.S. 201 (1954).

57. Patent law, then as now, allowed for the registration of patents for designs. Patent and Copyright Act of 1870, ch. 230, § 71, 16 Stat. 209 (current version at 35 U.S.C. § 171 (1988)). The difficulties inherent in applying design patent law to typeface are discussed, *infra* part V.C.1.

58. *Mazer v. Stein*, 347 U.S. 201, 205 (1954).

59. *Id.* at 209 (quoting the Copyright Act of 1870, § 86, 16 Stat. 212).

60. *Id.* at 210 (quoting the Copyright Act of 1909).

61. "Congress shall have the Power . . . To promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8.

62. *Mazer*, 347 U.S. at 210.

63. *Id.* at 212-13 (quoting 37 C.F.R. § 202.8 (1949) (revoked, Jan. 1, 1978)).

a lamp base had a utilitarian purpose as well as an expressive one. The court reasoned that, by terms of the Copyright Office regulation incorporated into the Act, protection subsisted only "in so far as their forms but not their mechanical or utilitarian aspects are concerned."<sup>64</sup> That is, the copyright extended only to the expressive aspect and not to the utilitarian one, but the utilitarian element did not impair the copyright on the expressive element.

In *Mazer*, determining the boundary between the expressive and utilitarian elements was not difficult. The copyrightable statuette could easily be physically separated from the uncopyrightable lamp. The court did not need to deal with the question where a conceptual, rather than physical, separation is needed.

### B. *Conceptual Separability*

In the years since *Mazer*, the issue of conceptual separability has frequently arisen, and courts, particularly the Second Circuit, have devised a number of tests to deal with the issue. There is a clear trend toward tests that are more and more likely to result in a finding that typeface designs are copyrightable.

#### 1. *Kieselstein-Cord v. Accessories by Pearl*

The 1980 case *Kieselstein-Cord v. Accessories by Pearl*<sup>65</sup> articulated a test under which the copyrightability of a useful article depended on whether the article's design had a completely separate ornamental use.<sup>66</sup> In *Kieselstein-Cord*, the articles in question were two ornamental belt buckles.<sup>67</sup> Although the court did not expressly articulate a test as such for conceptual separability, the court found that there was such separability.<sup>68</sup> The court noted that the buckles had a separate ornamental use, and that the utilitarian function was "subsidiary" to the primary ornamental aspect,<sup>69</sup> and held that the buckles were proper subject matter of copyright.<sup>70</sup>

To apply this test to typeface, it is necessary to consider both the expressive and utilitarian aspects of the typeface in question, and determine whether the design has a completely separate ornamental use. As noted above, the expressive aspect of a typeface is the "typeface personality," or the typeface's ability to connote a secondary meaning

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64. *Id.* at 212.

65. *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980).

66. *Id.* at 993-94.

67. *Id.* at 990.

68. *Id.* at 993.

69. *Id.*

70. *Kieselstein-Cord*, 632 F.2d at 993-94.

to complement the primary meaning that is being conveyed by the words in print.<sup>71</sup> However, this is in essence a secondary aspect. By definition, a typeface design includes the utilitarian element of representing text.<sup>72</sup> It is not possible for the typeface to have a completely separate ornamental function. Under the *Kieselstein-Cord* test, then, it is likely that typeface design would be found not to be proper subject matter of copyright.

## 2. *Carol Barnhart v. Economy Cover Corporation*

*Carol Barnhart v. Economy Cover Corp.*,<sup>73</sup> decided in 1985, was the first case to enunciate a test under which at least some typeface designs might be subject to copyright. Unlike *Kieselstein-Cord*, which required a completely separate use that was wholly ornamental, *Carol Barnhart* embraced the first test for conceptual separability. The *Carol Barnhart* court, like the *Kieselstein-Cord* court, noted the House Report's language that for a useful article to be copyrightable, it must contain some expressive element that can be identified, either physically or conceptually, as separable from the utilitarian element.<sup>74</sup> The *Carol Barnhart* court, however, took that language a step further than the *Kieselstein-Cord* court, and articulated the first test incorporating a conceptual test.

The works in question in *Carol Barnhart* were four mannequins of partial human torsos.<sup>75</sup> In affirming the district court's finding that the mannequins were not subject to copyright, the court stated that in order for copyright to exist in a useful article, the expressive aspects of the work must be capable of being conceptualized as existing independently of their utilitarian function.<sup>76</sup>

This test, as applied to a typeface design, depends to a great extent on the particular typeface for which copyright is sought. A typical typeface used for the composition of text (e.g., the Times typeface<sup>77</sup>) is not likely to be perceived as being conceptually separate from the article in which it is embodied.<sup>78</sup> Upon examining such a typeface, it is the functional elements that are perceived: the shapes of the letters and the letters' ability to represent text. On the other hand,

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71. Lewis & Walker, *supra* note 23, at 243.

72. See note 2, *supra*.

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

74. *Id.* at 417 n.3.

75. *Id.* at 412.

76. *Id.* at 418.

77. See appendix, figure 1.

78. But see 15 OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 1054, 1097 fig. 4 (1977) (depicting typeface design elements in nonsense non-letter shapes).

in the case of most decorative typefaces, the expressive element is quite evident upon even a cursory examination. It is apparent from examining the "San Francisco" typeface,<sup>79</sup> for example, that its main purpose is not merely to portray text, but also to depict the text in a humorous and expressive way. For other typefaces (e.g., "Koch Roman"<sup>80</sup>), whether the expressive element is likely to be perceived as being conceptually separate is likely to be highly dependent upon the observer.

### 3. *Brandir International v. Cascade Pacific Lumber*

The most recent test for conceptual separability to have been adopted was proposed by Professor Robert Denicola,<sup>81</sup> and was adopted by the Second Circuit in 1987 in *Brandir Int'l v. Cascade Pacific Lumber*.<sup>82</sup> Professor Denicola suggests that the goal of such a test is to minimize protection afforded to the components of the work that are suggested by the functional aspect of the utilitarian article, while at the same time protecting the aspects that are truly expressive.<sup>83</sup> To this end, the Denicola test inquires into which aspects of the work are dictated by the functional constraints of the article, and which aspects reflect unconstrained perspective of the artist.<sup>84</sup> The *Brandir* court clearly articulated its adoption of the Denicola test:

To state the Denicola test in terms of conceptual separability, if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian aspects. Conversely, where the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists. We believe that Professor Denicola's approach provides the best test for conceptual separability, and, accordingly, adopt it here.<sup>85</sup>

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79. See appendix, figure 7.

80. See appendix, figure 9.

81. Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 *MINN. L. REV.* 707 (1983).

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

83. Denicola, *supra* note 81, at 741.

84. *Id.* at 742.

85. *Brandir*, 834 F.2d at 1145. It has been suggested that the Second Circuit's adoption and/or application of the Denicola test differs somewhat from the test as described by Professor Denicola. See Sally M. Donohue, *The Copyrightability of Useful Articles: the Second Circuit's Resistance to Conceptual Separability*, 9 *TUORO L. REV.* 327, 349, 353 (1990); Shira Perlmutter, *Conceptual Similarity and Copyright in the Designs of Useful Articles*, 37 *J. COPYRIGHT SOC'Y U.S.A.* 339, 368 (1990). See also *National Theme Prods., Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1353 (S.D. Cal. 1988). To the extent that the Second Circuit departs from Professor



Applying this test, the court denied copyright to a bicycle rack constructed of metal tubing and modeled after a wire sculpture of continuous undulating wire.<sup>86</sup>

Although the *Brandir* court applied the Denicola test to deny copyright, it is this latest test that is most favorable to allowing copyright for typeface. As previously shown,<sup>87</sup> typeface design is a highly artistic endeavor. A typeface designer makes numerous artistic choices in the design process. The constraints of the design imposed by the utilitarian function are merely that the letters be easily readable. Nonetheless, typefaces will differ a great deal from one another depending on the artistic objectives of their designers, and still convey the letters. Under the Denicola test, all of these variations, not being imposed by the utilitarian aspect, are protectable. Therefore, under the Denicola test, now adopted as law in the Second Circuit, most typeface designs are subject to copyright.

#### IV. *ELTRA V. RINGER*

##### A. *The Eltra v. Ringer Decision*

The only reported case directly confronting the issue of copyright for typeface is *Eltra v. Ringer*,<sup>88</sup> in 1978.

In *Eltra*, Eltra Corporation, a manufacturer of typesetting equipment, submitted an application to the Register of Copyrights to register copyright in the design of a typeface under the 1909 Copyright Act.<sup>89</sup> Specifically, Eltra sought to register the typeface as a work of art under the then-existing provisions of § 5(g) of the Act.<sup>90</sup> Section 5(g) allowed registration on "[w]orks of art; models or designs for works of art."<sup>91</sup> The Register refused to register the copyright,<sup>92</sup> basing its refusal on its regulation 202.10(c), which stated:

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 repre-

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Denicola's articulation of the test, this comment is concerned with the test as enunciated by the Second Circuit in *Brandir*.

86. *Brandir*, 834 F.2d at 1145.

87. See discussion *supra* part II.C.

88. *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978).

89. *Id.* at 295-96.

90. *Id.* at 295-96.

91. "The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs: . . . (g) Works of art; models or designs for works of art." Copyright Act of 1909, § 5(g).

92. *Eltra*, 579 F.2d at 296.

sentation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.<sup>93</sup>

*Eltra* filed a mandamus action seeking to compel the Register to accept the registration.<sup>94</sup> The district court found that the typeface design was indeed a “work of art” that would normally be subject to copyright.<sup>95</sup> However, the court also found that the Copyright Office had had a “long-standing practice” of refusing such registrations,<sup>96</sup> and noted that Congress had never enacted any statute to overrule this practice.<sup>97</sup> According to the district court, this inaction indicated an acquiescence on the part of Congress to the administrative interpretation given to the statute by the Copyright Office.<sup>98</sup> Given this acquiescence, the district court found the work not registerable and dismissed the suit.<sup>99</sup>

The Court of Appeals for the Fourth Circuit affirmed the district court’s judgment on other grounds.<sup>100</sup> Specifically, the court of appeals disagreed with the district court’s finding that a typeface design was a “work of art.”<sup>101</sup> Because the court of appeals found that the design was not a “work of art,” it could not be registered for copyright.<sup>102</sup>

The *Eltra* court rested its holding on two grounds. First, the court held that the expression in the typeface could not be sufficiently separated from its utilitarian aspects.<sup>103</sup> Second, although the 1909 Copyright Act was the operative law for the *Eltra* decision, the court examined the 1976 Copyright Act’s legislative history for guidance in discerning the intent of the earlier legislation.<sup>104</sup> Each of these bases of decision will be examined in turn.

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93. 37 C.F.R. 202.10(c) (revoked, Jan. 1, 1978), noted in *Eltra*, 579 F.2d at 297.

94. *Eltra*, 579 F.2d at 296.

95. *Eltra v. Ringer*, 194 U.S.P.Q. (BNA) 198, 201 (E.D. Va. 1976) (*Eltra I*), *aff’d on other grounds*, 579 F.2d 294 (4th Cir. 1978).

96. *Id.*

97. *Id.* at 202.

98. *Id.*

99. *Id.*

100. *Eltra*, 579 F.2d 294.

101. *Id.* at 289.

102. *Id.*

103. *Id.* at 298.

104. *Id.* at 297-98.

### B. *Eltra's Application of Conceptual Separability*

Foreshadowing the tests that would develop over the next fifteen years in the Second Circuit,<sup>105</sup> the *Eltra* court cited the legislative history to the 1976 Copyright Act.<sup>106</sup> This legislative history noted that copyright could subsist in the design of a useful article, so long as the expressive element could be separated from the utilitarian element, either conceptually or physically.<sup>107</sup> Despite this citation, however, the court went on to apply a test that required physical separation, and not one that allowed for conceptual separation.

In determining whether the typeface design was a "work of art," the *Eltra* court held that the typeface was a utilitarian work. The court was unable to separate the expressive aspects of the work from the utilitarian aspects, and denied copyright.<sup>108</sup> In so doing, the court relied on *Mazer v. Stein*.<sup>109</sup>

At the time of the *Eltra* decision, *Mazer* remained the preeminent case dealing with the subsistence of copyright in works of art that were also useful articles. At that time, the determination was very easy. If, as in *Mazer*, the ostensible work of art could be *physically* separated from the useful article and exist independently of it, the work could be subject to copyright. This is precisely the distinction that the *Eltra* court made:

The important fact, which must not be overlooked in analyzing *Mazer*, is that the Supreme Court in that case was dealing with a statuette, which though incorporated in a commercial article, was capable of existing independently and had itself been registered as a *separate* "work of art" under § 5(g). And it was that type of "applied art" which the court found copyrightable under *Mazer*.<sup>110</sup>

The *Eltra* court took this to be the core holding of *Mazer*. Furthermore, it interpreted the Copyright Office regulation as being a mere restatement of the *Mazer* holding, and placed the regulation on equal stature with *Mazer*. Interpreting *Mazer* through the regulation, the *Eltra* court found that "it is patent that typeface is an industrial design in which the design cannot exist independently and separately

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105. See discussion *supra* part III.B.

106. *Eltra*, 579 F.2d at 297.

107. *Id.* at 297, n.10 ("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.") (quoting H.R. REP. No. 1476, *supra* note 2, at 55, reprinted in 1976 U.S.C.C.A.N. at 5668) (emphasis added).

108. *Id.* at 298.

109. *Id.* at 296 (citing *Mazer v. Stein*, 347 U.S. 201 (1954)).

110. *Id.* at 297.

as a work of art. Because of this, typeface has never been considered entitled to copyright under the provisions of § 5(g)."<sup>111</sup>

Thus, although the court cited language that called for tests of both physical and conceptual separability, the court ignored the possibility of conceptual separation, and relied upon what was essentially a physical test.

### C. *Eltra's Use of Legislative History*

The *Eltra* court found additional support for its holding in the legislative history to the 1976 Copyright Act.<sup>112</sup> Specifically, it referred to the report of the House Committee on the Judiciary that accompanied the 94th Congress's H.R. 2233, the bill that eventually became the Copyright Act of 1976.<sup>113</sup> As the *Eltra* court noted, one passage of the House Report strongly suggests that a typeface cannot be copyrighted:

[T]he Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. . . . The Committee has considered, but chosen to defer, the possibility of protecting the design of typefaces. . . . The Committee does not regard the design of typeface, as thus defined, to be a copyrightable 'pictorial, graphic, or sculptural work' within the meaning of this bill and the application of the dividing line in section 101.<sup>114</sup>

The *Eltra* court noted this passage as confirmation that the 1909 Act did not permit copyright for typeface.<sup>115</sup>

However, *Eltra* was decided under the 1909 Copyright Act, and the legislative history that the court consulted was that of the 1976 Copyright Act. The legislative history of a subsequent Congress is a hazardous basis for determining the legislative intent of an earlier Congress,<sup>116</sup> a view acknowledged by the *Eltra* district court.<sup>117</sup> In particular, reference to the 1976 Act and its legislative history to con-

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111. *Eltra*, 579 F.2d at 298.

112. *Id.* at 297-98.

113. H.R. REP. NO. 1476, *supra* note 2, reprinted in 1976 U.S.C.C.A.N. at 5659.

114. *Id.* at 55, reprinted in 1976 U.S.C.C.A.N. at 5668-69.

115. *Eltra*, 579 F.2d at 298.

116. *United States v. Texas*, 113 S. Ct. 1631, 1635 n.4 (1993); *Pension Benefit Guaranty Corp. v. LTV Corp.*, 496 U.S. 633, 650 (1990); *United States v. Price*, 361 U.S. 304, 313 (1960).

117. *Eltra v. Ringer*, 194 U.S.P.Q. (BNA) 198, 202 (E.D. Va. 1976) (*Eltra I*), *aff'd on other grounds*, 579 F.2d 294 (4th Cir. 1978).

strue the terms of the 1909 Act have been the subject of criticism.<sup>118</sup> Nonetheless, in the *Eltra* decisions, both the court of appeals<sup>119</sup> and the district court<sup>120</sup> used the legislative history of the 94th Congress's Copyright Act of 1976 as the basis for interpreting the 60th Congress's Copyright Act of 1909.

The Copyright Act of 1976 introduced substantial changes in copyright law in many areas, including preemption of state law,<sup>121</sup> duration,<sup>122</sup> and determination of royalties.<sup>123</sup> However, much of the 1976 Act was a mere codification of case law as it had existed prior to the date of enactment,<sup>124</sup> or a recodification of law already codified in the 1909 Act.<sup>125</sup>

As reports of the Judiciary Committees of both the House of Representatives<sup>126</sup> and the Senate<sup>127</sup> make clear, the 1976 Act did not purport to change the requirements for a work to be subject to copyright.<sup>128</sup> Because of this constancy, courts have felt free to apply the holdings of cases in this area that were decided under the 1909 Act, or even earlier, in construing the 1976 Act.<sup>129</sup> With respect to

118. See, e.g., Christopher P. Bussert, *Copyright Law: A Review of the "Separability Test" and a Proposal For New Design Protection*, 10 RUTGERS COMPUTER & TECH. L. J. 59, 84-86 (1984).

119. *Eltra*, 579 F.2d at 297-98.

120. *Eltra I*, 194 U.S.P.Q. at 202.

121. 17 U.S.C. § 301.

122. *Id.* §§ 302-305.

123. *Id.* §§ 801-810.

124. See, e.g., *id.* § 107; H.R. REP. NO. 1476, *supra* note 2, at 66, *reprinted in* 1976 U.S.C.C.A.N. at 5680; S. REP. NO. 473, 94th Cong., 1st Sess. 39, 61-62 (1975), *reprinted in* 5 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT app. 4A (1988).

125. See, e.g., 17 U.S.C. § 102; H.R. REP. NO. 1476, *supra* note 2, at 51, *reprinted in* 1976 U.S.C.C.A.N. at 5664; S. REP. NO. 473, *supra* note 124, at 50.

126. The phrase "original works of authorship," which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present [1909] copyright statute. This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them. H.R. REP. NO. 1476, *supra* note 2, at 51, *reprinted in* 1976 U.S.C.C.A.N. at 5664.

127. The phrase "original works of authorship," which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present [1909] copyright statute. This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them. S. REP. NO. 473, *supra* note 124, at 50.

128. *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 355 (1991).

129. The *Feist* case in particular is replete with examples of this principle, citing at least three cases that had been decided under the 1909 Act: *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966), *cited in Feist* at 354; *Goldstein v. California*, 412 U.S. 546 (1973), *cited in Feist* at 347; *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981), *cited in Feist* at 347. Although decided in 1981, *Miller* was governed by the 1909 Copyright Act. See *Miller*, 650 F.2d at 1376.

pictorial, graphic, and sculptural works, the maintenance of the status quo between the 1909 and 1976 Acts is shown not only in both houses' legislative history and in the treatment by the courts, but is also implied by the statute itself.<sup>130</sup>

The portion of the legislative history that discusses the subject matter of copyright is discussing an area of law that was unchanged by the 1976 Copyright Act. As such, the proper interpretation of this portion is not as the 94th Congress's explanation of its own 1976 statute, but rather as its interpretation of the 60th Congress's Copyright Act of 1909. Such a view may be accorded great weight by a court,<sup>131</sup> and the *Eltra* court's use of the legislative history was not illegitimate. However, as shall be shown, it is questionable whether the legislative history, particularly the passage in the House Report that discusses typeface designs, is deserving of the weight that the *Eltra* court gave it.

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130. This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.

17 U.S.C. § 113(b).

One prominent commentator, Melville Nimmer, has gone further in the analysis of this subsection, and has concluded that this passage, in itself, serves to incorporate the 1909 Act's provisions for copyrightable subject matter into the 1976 Act unchanged. 1 NIMMER, *supra* note 124, § 2.15, at 2-179 to 2-180. As attractive as this appears, insofar as it supports this comment's thesis, this position is not sound.

Section 113(b) addresses the extent of the exclusive rights as defined in § 106. It limits the right of an owner of copyright in a work that portrays a useful article to object to that article's display in materials such as advertisements. In an attempt to show that this subsection requires that the subject matter of copyright is unchanged by the 1976 Act, Nimmer emphasizes that § 113 addresses itself to the entire Copyright Act, including the subject matter provisions of § 102, and not merely to § 113. 1 *id.* at 2-180.

However, the conclusion that nothing in the Act limits the rights conferred under § 106 does not, by itself, indicate that the types of works for which those rights are conferred is unchanged. Nimmer relies on the fact that a design of an automobile is used by the House Report as a hypothetical to illustrate both limitations. 1 *id.* at 2-179 (referring to H.R. REP. NO. 1476, *supra* note 2, at 55, 105, reprinted in 1976 U.S.C.C.A.N. at 5668, 5720). However, it is not clear that this consistency in two examples separated by 50 pages is sufficient to link the two as strongly as Nimmer does.

Nevertheless, § 113(b) remains as an unambiguous indication in the text of the statute of the 1976 Congress's intent to maintain the status quo in certain areas of copyright law. As such, it supports the unambiguous indications in both houses' legislative histories that the subject matter provisions were unchanged as well.

131. See, e.g., *Seatrain Shipbuilding Corp. v. Shell Oil Co.*, 444 U.S. 572, 598 (1980) (“[W]hile the views of subsequent Congresses cannot override the unmistakable intent of the enacting one . . . such views are entitled to significant weight.”).

#### D. *The Eltra Legacy*

*Eltra* was decided on two major bases: a test of physical separability and the strength of a recent legislative history. However, each of these bases has sufficiently eroded so that *Eltra* does not serve as a compelling precedent.

##### 1. Conceptual Separability

As noted,<sup>132</sup> *Eltra* applied what was essentially a test for physical separation, and not a test for conceptual separation as is currently applied. In fairness to the *Eltra* court, this was an accurate reflection of copyright jurisprudence as it existed at the time of the decision.<sup>133</sup> At that time, *Mazer* was the leading case in copyright for useful articles. The few cases that dealt with copyright of useful articles had either depended upon physical separability,<sup>134</sup> or were cases where the expression in the article was readily perceived as an adornment on a physical object for the purposes of enhancing the object's appearance.<sup>135</sup> Cases in which the conceptual separation of an article's expression and usefulness was called into play had not yet been decided.<sup>136</sup>

It is unfortunate that *Eltra* was decided before the jurisprudence of conceptual separability had evolved to its present state. In the years since the *Eltra* decision, the question of conceptual separation has been studied more closely by the courts, and the tests discussed<sup>137</sup> have risen to meet the challenges. It is doubtful that a court faced with such a decision today would apply as simplistic a test as that used in *Eltra*. With the benefit of hindsight and the development of tests like the *Denicola-Brandir* test, a court today can properly discern the expressive elements of a typeface and allow copyright to subsist.

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132. See discussion *supra* part IV.A.

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

134. E.g., *Mazer*, 347 U.S. 201 (1954).

135. See, e.g., *Monogram Models, Inc. v. Industro Motive Corp.*, 492 F.2d 1281, 1284 (6th Cir. 1974), *cert. denied*, 419 U.S. 843 (1974) (model airplane kit held copyrightable); *E.I.Horsman & Aetna Doll Co. v. Kaufman*, 286 F. 372 (2d Cir. 1922), *cert denied*, 261 U.S. 615 (1923) (doll's head held copyrightable); *Ted Arnold Ltd. v. Silvercraft Co., Inc.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (pencil sharpener in the shape of an antique telephone held copyrightable); *Blazon, Inc. v. DeLuxe Game Corp.*, 268 F. Supp. 416 (S.D.N.Y. 1965) (child's hobby horse held copyrightable).

136. "Since *Mazer v. Stein* was decided before the principle of 'conceptual separability' was explicitly identified as a criterion of copyrightability of the design of a useful article, it is not surprising that the Court's opinion does not illuminate the distinction between 'physical' and 'conceptual' separability." *Carol Barnhart*, 773 F.2d at 421 n.2 (Newman, J., dissenting).

137. See discussion *supra* part III.B.

## 2. Legislative History

While *Eltra*'s use of the House Report was legitimate, the viability of using the passage discussing typeface<sup>138</sup> as if it were an unmistakable expression of congressional intent is questionable.

Generally, legislative history is considered a valid aid in determining the intent of an ambiguous statute.<sup>139</sup> When there is no doubt as to the meaning of the statute, the statute will be construed as written, without resort to the legislative history.<sup>140</sup> Given this rule, we must first determine if the statute, as written, is ambiguous.

Section 102, while not defining the term "works of authorship," provides a list of categories of works that are included within the scope of that term.<sup>141</sup> One of these categories is that of "pictorial, graphic, and sculptural works."<sup>142</sup> This category includes "works of fine, graphic, and applied art."<sup>143</sup> As noted above, a typeface is clearly a work of graphic art and/or applied art.<sup>144</sup>

However, the statute places limitations on such works if they are designs for useful articles:

[s]uch 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>145</sup>

Thus, there are two other important questions that must be answered in order to recognize copyright. First, is a typeface a design for a "useful article?" Second, if it is such a design, can the pictorial,

138. See discussion *supra* part IV.C.

139. *E.g.*, *Commissioner v. Estate of Bosch*, 387 U.S. 456, 463 (1967). Note, however that some jurists, most notably United States Supreme Court Justice Antonin Scalia, are particularly suspicious of the use of legislative history, and regard only the text of the statute as authoritative. See, *e.g.*, *Edwards v. Aguillard*, 482 U.S. 578, 636-638 (1987) (Scalia, J., dissenting); *United States v. R.L.C.*, 112 S.Ct 1329, 1340 (1992) (Scalia, J., concurring).

140. *Kuehner v. Irving Trust Co.*, 299 U.S. 445, 449 (1936).

141. 17 U.S.C. § 102(a).

142. *Id.* § 102(a)(5).

143. *Id.* § 101 ("Pictorial, graphic, and sculptural works' include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.").

144. See *supra* notes 16-22, 40-48 and accompanying text.

145. 17 U.S.C. § 101 (definition of "pictorial, graphic, and sculptural works").



graphic, or sculptural features of the typeface be identified separately from and exist independently of the utilitarian aspects of the article?

The threshold question that must be answered here is, "Is a typeface design a design of a useful article?" The definition in § 101 states in pertinent part, "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."<sup>146</sup>

In the case of a typeface design, the useful article is the font in which the typeface will eventually be embodied. It is without question that a font is a useful article. It has a utilitarian function, to produce textual output, whether on paper, a computer screen, or other media. However, it is misleading to consider a typeface a design for a useful article; rather, the font is an article whose purpose is to embody the typeface design.

Fonts of a given type are generally identical except for the data that describes the typeface that they encode. Despite the clear differences between the Times<sup>147</sup> and Helvetica<sup>148</sup> typefaces, for example, a bitmapped font that embodies one is identical to a bitmapped font that embodies the other, except for the data that describes the typeface embodied. A typeface design is capable of being embodied in any number of fonts that may use very different methods of reproducing the typeface. In this respect, the typeface design is no more a design for a font than a photograph taken for a book cover is a design for a book cover. In both cases, the putative "useful article," whether it is the font or the book cover, is little more than the medium for the representation of the work of authorship. One would never consider a photograph a "design for a useful article," and thereby attempt to limit its copyright, merely because it was intended to be placed on a book cover.<sup>149</sup> In the same way, to consider a typeface design as nothing more than a design for a font, rather than recognizing that a font is nothing more than the medium that carries a typeface, is akin to saying that a tail is something that wags a dog.

The conclusion is that a typeface is not a design for a useful article. As such, the question of whether its expressive element may be separated from the utilitarian element of an article for which it is a design is moot. Without further examination, we may conclude that

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146. *Id.* § 101 (definition of "useful article").

147. *See* appendix, figure 1.

148. *See* appendix, figure 5.

149. Of course, the photograph image is conceptually separable from the book cover, and hence is not so limited. Nevertheless, for the purpose of distinguishing a design *for* a useful article from a design *embodied in* a useful article, the comparison is apt.

the typeface is a pictorial, graphic, or sculptural work, and subject to copyright.

However, what if, *arguendo*, a typeface is considered a design for a useful article? In that case, the predicate of the § 101 definition attaches, and the typeface's copyright extends only so far as the pictorial, graphic, or sculptural features of the typeface can be identified separately from and are capable of existing independently of, the utilitarian aspects of the article.<sup>150</sup> This breaks down into two questions: 1) can the pictorial, graphic, or sculptural features of the typeface be identified separately from the utilitarian aspects of the font, and 2) are the pictorial, graphic, or sculptural features of the typeface capable of existing independently of the utilitarian aspects of the font?

Again, the answer to each of these questions is in the affirmative. First, as the users of typeface make clear, the pictorial, graphic, or sculptural features, that is, the features that give the typeface its personality, can be identified separately from the utilitarian aspects of the font.<sup>151</sup> Secondly, as noted above,<sup>152</sup> with the benefit of the *Denicola-Brandir* test and the other tests developed for conceptual separability, it is possible to separate a typeface's expressive aspects from the purely utilitarian aspects of the font.

A very strong argument may be made, then, that the copyright statute is not ambiguous with respect to typeface, and that a reference to a legislative history is not appropriate on that ground.

However, there is an alternate ground upon which to review the legislative history. In addition to using legislative history to construe an ambiguous statute, a court may use it as a means of verifying that its own interpretation of the statute is correct.<sup>153</sup> If the history contains an expressed legislative intention contrary to the statutory language, the presumption that the Congressional intent is properly reflected in the statutory language is questionable.<sup>154</sup> It must be conceded that, if a court contemplated granting a copyright in a typeface, it could justifiably look to legislative history to see if anything in the legislative history indicated an intent contrary to the meaning of the

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150. 17 U.S.C. § 101 (definition of "useful article").

151. See *supra* notes 16-20 and accompanying text.

152. See discussion *supra* part III.B.3.

153. [T]he plain language of this statute appears to settle the question before us. Therefore, we look to the legislative history to determine only whether there is "clearly expressed legislative intention" contrary to that language, which would require us to question the strong presumption that Congress expresses its intent through the language it chooses.

*I.N.S. v. Cardoza-Fonseca*, 480 U.S. 421, 432 n.12 (1987).

154. *Id.*

statute and thereby consider the same damaging passage relied upon by the *Eltra* court.

Now, however, we examine the weight that should be accorded this passage. There are several considerations that suggest that little reliance should be placed upon it.

First, as noted earlier, the proper construction of this passage is as the 94th Congress's interpretation of the 1909 statute enacted by the 60th Congress,<sup>155</sup> or in Professor Nimmer's words, "a suggested interpretation of the 1909 Act rather than as a statutory command to the courts."<sup>156</sup> There is no assurance that the 94th Congress's views accurately reflect those of the 60th Congress. As Nimmer points out, as an expression of the 94th Congress's interpretation of the 60th Congress's legislation, the House Report's statement on typeface design is to be given due weight, but is not binding upon the court.<sup>157</sup>

Furthermore, it is worth noting that the view expressed in the House Report is only in the House Report. Substantial portions of the House and Senate Reports are word-for-word identical.<sup>158</sup> However, there is no passage in the Senate Report that is in any way similar to the passage in the House Report that discussed typeface.<sup>159</sup> Therefore, as far as the Senate is concerned, the statutory text speaks for itself, and that text contains no provision that excludes typeface.<sup>160</sup>

The passage in the House Report must be understood in the context of its time.<sup>161</sup> In 1976, typeface designs were the province of professional printers; the "desktop publishing" industry did not yet ex-

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155. See discussion *supra* part IV.C.

156. 1 NIMMER, *supra* note 124, § 2.15, at 2-180.

157. 1 *id.* § 2.15, at 2-178.10.

158. Compare *e.g.*, notes 126 and 127, *supra*.

159. S. REP. No. 473, *supra* note 124.

160. Nimmer argues that the House Report itself is ambiguous on the issue. 1 NIMMER, *supra* note 124, § 2.15, at 2-178.7. He bases this on the fact that the Report characterizes as unanswered the question "should typeface designs be given the protections of the title?" 1 *id.* at 2-178.7 n.4. However, when read in context, it is clear that by the phrase "the title," the House Report is referring not to Title 17 (Copyright) of the United States Code, as one might think, but rather is referring to Title II of S. 22, the Senate version of the bill that ultimately became the Copyright Act of 1976. H.R. REP. No. 1476, *supra* note 2, at 50, *reprinted in* 1976 U.S.C.C.A.N. at 5663.

Title II contained the Design Protection Act of 1975, which, had it been enacted, would have added provisions to Title 17 for the protection of ornamental designs of useful articles. S. REP. No. 473, *supra* note 124, at 39-47. Title II was not present in the House version of the bill, and was not enacted. H.R. CONF. REP. No. 1733, 94th Cong., 2nd Sess. 82 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5810, 5823. Thus, the House Report is not asserting that Title 17, as enacted, leaves the question of protection open, but rather that Title II, *had it been enacted*, would have left the question open.

161. See *A Pocket History of Font Technology*, THE SEYBOLD REPORT ON DESKTOP PUBLISHING (Seybold Publications, Inc., Media, Pa.), Oct. 16, 1989, at 13-18.

ist. Because of the relatively small number of potential licensees of a given typeface, the problem of typeface copying was one that was capable of being handled by contract.<sup>162</sup> Copyright, while perhaps helpful, was not a necessity.

In contrast, the 1980s brought forth the personal computer and inexpensive printing equipment, creating the new industry of "desktop publishing" and a corresponding increase in the demand for new and different typeface designs. Today, computer programs exist that make it easy for users to create new fonts that copy existing typeface designs.<sup>163</sup>

The circumstances existing at the time the House Report was written are substantially different from today's. The House Report is simply not applicable to the issue of copyright of typeface designs today.

### 3. Summary

In summary, both of the legs on which the *Eltra* decision stands are weak. Even if legislative history is referenced, the passage discussing typeface is a poor basis from which to infer congressional intent. The passage represents only the view of one committee of a single house of Congress, the Judiciary Committee of the House of Representatives, and does not reflect the equally important views of the Senate, which is silent on the issue. It purports to divine the intent of a Congress sitting 67 years earlier. When combined with the courts' advances in determination of conceptual separability, the other linchpin of the *Eltra* decision, it is clear that the precedential value of that decision is very limited. Considering nearly twenty years of advances in both law and technology, a court sitting to decide the issue of typeface copyright today should accord *Eltra* little or no weight. A court deciding the issue of typeface copyright today should apply the modern tests of conceptual similarity, and to the extent that those tests reflect a work of authorship in the typeface, recognize its copyright.

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162. See ALEXANDER LAWSON, ANATOMY OF A TYPEFACE 126-28 (1990). See also *Seybold Spats Brace Industry For Mighty Windows Font War*, THE HARD COPY OBSERVER (Lyra, Newton Highlands, Mass.), Mar. 1992, at 1, 3 [hereinafter *Seybold Spats*].

163. Examples of such programs include *Fontographer*, a product of Altsys Corp., Richardson, Texas, and *FontChameleon*, *FontFiddler*, *FontHopper* and *FontMonger*, products of Ares Software Corp., Foster City, California.

E. *The Copyright Office Regulation and the Chevron Doctrine*

Unfortunately, there is a significant obstacle to a judicial recognition of copyright in typeface. In February 1992, the Copyright Office codified the *Eltra* holding as Copyright Office regulation 202.1(e): "[The following are examples of works not subject to copyright and applications for registration of such works will not be entertained:] typeface as typeface."<sup>164</sup>

Although registration is generally a condition precedent for bringing a suit for copyright infringement,<sup>165</sup> a claimant of copyright may bring suit for infringement if the application for registration has been submitted to and refused by the Copyright Office.<sup>166</sup> However, registration is highly desirable, because it provides *prima facie* evidence of validity of the copyright and of the facts presented on the certificate (e.g., the identity of the author of the work),<sup>167</sup> and under certain conditions, qualifies the copyright holder for attorney's fees and statutory damages.<sup>168</sup> Consequently, the value of an unregistered copyright is significantly less than that of a registered copyright.

However, in light of the new regulation, it is highly unlikely that a court will recognize a typeface copyright and order the Copyright Office to register it. Under the doctrine enunciated in *Chevron, U.S.A., Inc. v. N.R.D.C.*,<sup>169</sup> if a statute is silent or ambiguous with respect to a specific issue, the construction given to that statute by an agency responsible for the administration of the statute will be applied as long as the agency's interpretation of the statute is reasonable.<sup>170</sup> It is not necessary for the court reviewing the regulation to conclude that the agency's construction is the only one possible.<sup>171</sup> Rather, such legislative regulations are given controlling weight unless they are ar-

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164. 57 Fed. Reg. 6201 (1992), codified at 37 C.F.R. § 202.1(e) (1992). Technically, this regulation restricts what may be registered, and is not a legally binding statement of what may be copyrighted. A plaintiff may bring a claim of copyright infringement even if the Copyright Office has refused to register the work on the ground that the work is not subject to copyright. 17 U.S.C. § 411(a). However, the Copyright Office's decision whether to register the work is dependent upon its determination of whether the work is subject to copyright. 17 U.S.C. § 410(a)-(b). As a practical matter, the issues of whether a work is subject to copyright and whether the Copyright Office will register the work amount to the same question of law.

165. 17 U.S.C. § 411.

166. *Id.*

167. *Id.* § 410(c).

168. *Id.* § 412.

169. *Chevron, U.S.A., Inc. v. N.R.D.C.*, 467 U.S. 837 (1984).

170. *Id.* at 843.

171. *Id.* n.11.

bitrary, capricious, or manifestly contrary to the statute or otherwise violate the law.<sup>172</sup>

The Copyright Office, through its director, the Register of Copyrights,<sup>173</sup> is authorized to establish regulations for administration of its functions and duties.<sup>174</sup> These functions and duties include the examination and determination of whether a particular work submitted for registration of copyright constitutes copyrightable subject matter.<sup>175</sup> The *Chevron* doctrine is therefore applicable to the Copyright Of-

172. *Id.* at 844.

173. *See* 17 U.S.C. § 701(a).

174. 17 U.S.C. § 702.

175. 17 U.S.C. § 410(a). Some cracks may be appearing in the applicability of the *Chevron* doctrine to Copyright Office regulations that govern standards of copyright. Recently, the premise that the Copyright Office has the authority to set standards that a work must meet in order to be copyrighted has been called into question. In reporting the Copyright Reform Act of 1993, H.R. 897, 103d Cong., 1st Sess., the House Judiciary Committee criticized "attempts by the Copyright Office to shape the scope of copyright . . ." H.R. REP. NO. 388, 103d Cong., 1st Sess. 11 (1993). The Committee noted:

The Committee considers this gatekeeper role to exceed the Office's limited examination function. The function of the examination process is not to influence directly or indirectly the scope of copyright that a court might accord, nor to weed out works, which though copyrightable in their entirety, may, in the Office's opinion, may [sic] be the subject of frivolous or overreaching infringement claims. The Office's function is to examine the material deposited for registration and to evaluate, using the standards for copyrightability developed in the courts, whether the material meets those standards. If the material meets those standards, registration is required.

*Id.* at 11. The Committee pointed to the February 1992 regulation proscribing the registration of typeface as an example of the Copyright Office exceeding its authority. *Id.* at 11, n.20.

The Committee drives home its point:

Notwithstanding Section 410 of title 17, United States Code, it is the courts which have been vested by Congress with the ultimate determination of copyrightability, not the Copyright Office. In determining whether to register a claim to copyright, the Copyright Office should be guided by court decisions on what constitutes an original work of authorship.

*Id.* at 17 (citations omitted).

Accordingly, the proposed Copyright Reform Act includes an amendment that expressly sets forth the Copyright Office's limited scope of review. Under the amendment, registration may be refused only if "the Register of Copyrights determines, in accordance with this title [Title 17, United States Code], that there is no reasonable possibility that a court would hold the work . . . to be copyrightable subject matter." H.R. 897, *supra*, § 5. As the Committee notes in the House Report, "[t]he Copyright Office is thus directed to defer to the courts, not vice versa." H.R. Rep. No. 388 at 18.

If a court accepts the argument that regulation 202.1(e) was promulgated in excess of the authority of the Copyright Office, this would significantly undermine the applicability of the *Chevron* doctrine, and a challenge may be successful. This argument is likely to be even more persuasive if the Copyright Reform Act is enacted.

The Act passed the House of Representatives on November 20, 1993, 139 CONG. REC. H10308, H10312 (daily ed. Nov. 20, 1993) and was referred to the Senate. 139 CONG. REC. S16717 (daily ed. Nov. 20, 1993). At the time of this writing, the bill was under consideration by the Senate Judiciary Committee. 139 CONG. REC. S17054 (daily ed. Nov. 23, 1993).

face.<sup>176</sup> As such, 202.1(e) has controlling weight over the issue of whether the Copyright Office may be ordered to register a copyright in typeface.

By terms of the Copyright Act of 1976,<sup>177</sup> the Register of Copyrights' refusal to register may be appealed under the Administrative Procedure Act of 1946.<sup>178</sup> However, in view of the *Chevron* doctrine, assuming a consistent enforcement of regulation 202.1(e) in a way that is not arbitrary or capricious,<sup>179</sup> the regulation will be upheld and the Office will not be ordered to register a copyright in typeface design. As a result, the Copyright Office regulation has the practical effect of elevating a relatively obscure 4th Circuit decision, which would not ordinarily bind the courts of any other circuit, to an authority of nearly statutory level, binding even the U.S. Supreme Court.

#### V. STATUTORY COPYRIGHT FOR TYPEFACE: A PROPOSED AMENDMENT TO THE COPYRIGHT STATUTE

Due to regulation 202.1(e) and the *Chevron* doctrine, a judicial decision that recognizes copyright in a typeface or orders its registration is highly unlikely. For that reason, Congress should amend the current Copyright Act to expressly permit copyright for the design of typefaces.<sup>180</sup>

176. See, e.g., *Atari Games Corp. v. Oman*, 888 F.2d 878, 887 (D.C. Cir. 1989) (Silberman, J., concurring) (*Chevron* applies to categorical distinctions by Copyright Office, but not to individual office actions).

177. *Id.* § 701(d). The availability of a remedy via the Administrative Procedures Act removed the remedy of mandamus that was the subject of *Eltra. Nova Stylings, Inc. v. Ladd*, 695 F.2d 1179 (9th Cir. 1983).

178. Act of June 11, 1946, as amended by ch. 324, 60 Stat. 237 (current version at 5 U.S.C. §§ 551-559, 701-706 (1988)).

179. The reviewing court shall . . . (2) hold unlawful and set aside agency action, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(B) contrary to constitutional right, power, privilege, or immunity;

(C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;

(D) without observance of procedure required by law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or

(F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

5 U.S.C. § 706(2).

180. While the current view is that a typeface cannot be copyrighted, this does not mean that commercially available computer fonts are not copyrightable. That question depends on the nature of the font. If a font does no more than simply depict the unprotected typeface, then the font is not protected. However, if the font is made up of a series of instructions that instruct a

### A. Treatment in Other Jurisdictions

The idea of affording copyright protection to a typeface is not a novel or radical one. Several other nations have recognized the expressive characteristics of typeface and afford it copyright or similar protection. England recognized copyright in typeface design as long ago as 1916.<sup>181</sup> The current United Kingdom copyright statute,<sup>182</sup> which covers England, Wales, Scotland and Northern Ireland,<sup>183</sup> expressly recognizes typeface as a protected artistic work.<sup>184</sup> Canada protects typeface through its Industrial Design Act, which provides copyright-like protection for "features of shape, configuration, pattern or ornament and any combination of those features that, in a finished

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computer or printer to form the shapes of the letters, or to perform such functions as scaling, italicizing, or emboldening the typeface, then the font may be copyrighted as a literary work; specifically, a computer program. Registrability of Computer Programs That Generate Typefaces, 57 Fed. Reg. 6201 (1992). Examples of fonts meeting this criteria include fonts using Microsoft Corp.'s TrueType specification or using Adobe Systems Inc.'s PostScript language. See MICROSOFT CORPORATION, TRUETYPE FONT FILES (1992); ADOBE SYSTEMS INC., POSTSCRIPT LANGUAGE TUTORIAL AND COOKBOOK 197-225 (1985). See also *Current Developments: Proprietary Rights*, THE COMPUTER LAWYER, Feb. 1990, at 26 (reporting Adobe Corporation's successful registration of copyright in a font program). This has the ironic effect of turning copyright on its head: a font program in object code format (in which format its expression as a literary work cannot be perceived), whose sole value is the *functional* aspect of reproducing the shapes of letters, is protected by copyright, while the *expressive* aspect of the font, the typeface encoded into it, is not.

An interesting question is whether the copyright on such a font may be used to protect the putatively unprotectable data that make up the typeface design. A number of font vendors are testing this. Adobe Systems Inc., Bitstream, Inc., FontShop Canada Ltd., Q.E.D. Publishing Co., and Emigre Graphics have filed suit in the District of Massachusetts against SWFTE International Ltd., alleging copyright infringement on the basis of SWFTE's business practices in producing its fonts. Adobe Systems, Inc., et al. v. SWFTE Int'l Ltd., No. 93-11068H (D. Mass. filed May 17, 1993). SWFTE's practice was to load copyrighted fonts into a commercial font editor program, and extract the data comprising the typeface designs, from which it then produced its own fonts having identical typeface designs. The case remains pending as this comment goes to press. See William M. Bulkeley, *Font War: That's My Type*, WALL ST. J., Nov. 11, 1993, at B1.

181. Stephenson, Blake and Co. v. Grant, Legros & Co., 115 L.T.R. 666, 61 Sol. J. 55 (1916), reprinted in E.J. MACGILLIVRAY, COPYRIGHT CASES 1911-1916 326-329 (1969), *aff'd* 116 L.T.R. 268 (1917), noted in 13 Eng. and Empire DIGEST 68, 68-69. The court recognized that the typeface design was subject to copyright under the then-current Copyright Act of 1911, An Act to Amend and Consolidate the Law Relating to Copyright, 1911, 1 & 2 Geo. 5, ch. 46 (Eng.). However, the plaintiff's victory was hollow. The court held that the copyright protected only the design in its entirety, with all the letters in their particular order. The defendant's embodiment of them into a font of his own, as opposed to a reproduction of the design with the letters in the same order, was held not to infringe. MACGILLIVRAY, *supra* at 327-28.

182. Copyright, Designs and Patents Act, 1988, ch. 48 (Eng.).

183. William R. Cornish, *United Kingdom*, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 1[1], at U.K.-7 (Melville B. Nimmer & Paul Edward Geller eds., 1992).

184. While the Act does not expressly list typeface designs in its list of protected works, § 54 expressly refers to a typeface as a copyrighted work. See Copyright, Designs and Patents Act, *supra* note 182, § 1, 54.



article, appeal to and are judged solely by the eye."<sup>185</sup> Italy also permits protection of typefaces in its design protection legislation,<sup>186</sup> as does Germany.<sup>187</sup> In 1973, a treaty allowing for the international protection of typeface design was adopted at Vienna.<sup>188</sup> France, Germany, Hungary, Italy, Liechtenstein, Luxembourg, the Netherlands, San Marino, Switzerland, the United Kingdom and Yugoslavia signed the agreement.<sup>189</sup>

In the United States, the most recent effort to protect typeface designs is a separate set of legislation protecting industrial designs.<sup>190</sup> Unfortunately, because such legislation encompasses not only typeface designs, but any industrial designs, its passage has been impeded by fears that it would afford monopolistic advantages to manufacturers of utilitarian objects that would be the subject of the bill.<sup>191</sup> A design protection bill was proposed by the Senate as Title II to the Copyright Act of 1976,<sup>192</sup> but this bill was deleted by the House Judiciary Committee.<sup>193</sup> Ironically, one of the reasons stated to justify the bill's deletion was its lack of a provision expressly extending protection to typeface design.<sup>194</sup> Repeated attempts to enact design protection have uniformly met with failure.<sup>195</sup>

185. Industrial Design Act, R.S.C., ch. I-9, § 2 (1985), amended by ch. 15, 1988 S.C., § 18 (1988) (Can.).

186. Italian Design Law of 1940, noted in J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 DUKE L.J. 1143, 1243 n.525 (1983).

187. Act Concerning Copyright In Designs, translated in 6 IIC STUDIES: STUDIES IN INDUSTRIAL PROPERTY AND COPYRIGHT LAW, GERMAN INDUSTRIAL PROPERTY, COPYRIGHT AND ANTI-TRUST LAWS 76-79 (Friedrich-Karl Beier, Gerhard Schrickler & Eugen Ulmer, eds., 1983).

188. Vienna Agreement for the Protection of Type Faces and Their International Deposit, reprinted in WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), RECORDS OF THE VIENNA DIPLOMATIC CONFERENCE ON THE PROTECTION OF TYPE FACES 1973 (1980) (hereinafter Vienna Agreement). See also André Françon, *The Vienna Agreement for the Protection of Type Faces and their International Deposit*, COPYRIGHT, May, 1976, at 129.

189. While the treaty was signed by eleven states, it will not go into effect until at least five of the signatories have ratified or acceded to it. Vienna Agreement, *supra* note 188, art. 35. At the time of this writing, the necessary ratifications have not yet occurred. Paul Edward Geller, *International Copyright: An Introduction*, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 183, § 4[1][c][i], n.392.1.

190. See, e.g., Introduction of the Design Innovation and Technology Act of 1991, 137 CONG. REC. H2249-50 (daily ed. Apr. 16, 1992); Introduction of Industrial Design Protection Act, 135 CONG. REC. E337 (daily ed. Feb. 7, 1989).

191. 138 CONG. REC. E1223-24 (daily ed. May 4, 1992) (statement of Rep. Kanjorski).

192. S. REP. NO. 473, *supra* note 124, at 39-42.

193. H.R. CONF. REP. NO. 1733, *supra* note 160, at 82, reprinted in 1976 U.S.C.C.A.N. at 5823.

194. "The [House Judiciary] Committee chose to delete Title II in part because . . . Title II left unanswered [the question] should typeface designs be given the protections of the title?" H.R. REP. NO. 1476, *supra* note 2, at 50, reprinted in 1976 U.S.C.C.A.N. at 5863.

195. Denicola, *supra* note 81, at 707 n.606.

### B. *The Proposed Legislation*

Because of the historic tendency of design protection legislation to fail and the limitations inherent in a judicially-recognized copyright for typeface, the method of protection that makes the most sense is an amendment to existing copyright law, such that the statute expressly permits typeface to be copyrighted. The following amendments are suggested; text being added is indicated by italics.

First, the definition of "pictorial, graphic, and sculptural works"<sup>196</sup> should be modified to expressly include typeface designs:

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, *typeface designs*, and technical drawings, including architectural plans.

Second, a definition of "typeface design" should be added to the list of definitions<sup>197</sup> in the Copyright Act. The following definition is proposed, to be added after the definition of "transmit":

A "*typeface design*" consists of a set of letters, numbers, or other symbolic characters, whose forms are related by repeating design elements consistently applied in a notational system.<sup>198</sup>

Finally, in order to avoid certain undesirable consequences of protecting typeface design with copyright,<sup>199</sup> the following subsection

Some have suggested that the North American Free Trade Agreement, Dec. 8-Dec. 17, 1993, Canada-Mexico-United States, 32 I.L.M. 605, (hereinafter "NAFTA") requires its signatories to enact design protection legislation. NAFTA Article 1713 § 1 provides:

Each Party shall provide for the protection of independently created industrial designs that are new or original. A party may provide that:

(a) designs are not new or original if they do not significantly differ from known designs or combinations of known design features; and

(b) such protection shall not extend to designs dictated essentially by technical or functional considerations.

NAFTA, Article 1713, § 1.

Despite this provision, the United States' implementation of NAFTA, perhaps viewing existing design patent provisions as satisfying the United States obligations under Article 1713, does not make provisions for additional design protection. See the North American Free Trade Agreement Implementation Act, Pub. L. No. 103-182, §§ 331-335, 107 Stat. 2057, 2113-2116 (1993). The requirements for novelty and nonobviousness imposed upon design patents by the patent statute, 35 U.S.C. §§ 102-103, 171, appear to be permissible restrictions under NAFTA Article 1713 § 1(a), *supra*.

196. 17 U.S.C. § 101.

197. *Id.*

198. This is the definition used in the most recent failed design protection bill. H.R. 1790, *supra* note 2, § 1001(b)(4).

199. See *infra* parts V.C.4 and V.C.6.

is proposed to be added to § 113, "Scope of exclusive rights in pictorial, graphic, and sculptural works," following subsection (d):

*(e) In the case of a typeface design, it is not an infringement of copyright to depict an article printed with the typeface in any literary, pictorial, graphic, or audiovisual work, or to use the typeface in the ordinary course of typing, composing text, typesetting, or printing.*

### C. *Potential Objections to Extending Copyright to Typeface*

A number of arguments against typeface copyright have been put forth. These fears will be examined and put to rest.

#### 1. Design Patent

One objection to allowing copyright for typeface is that protection for typeface already exists in the form of design patent law, making further protection unnecessary.

Under U.S. patent law, one may obtain a design patent for new, original ornamental designs for articles of manufacture.<sup>200</sup> Typeface is patentable under this provision, and several patents for typeface design have been issued.<sup>201</sup> Because U.S. intellectual property law already provides for protection for typeface design, it is legitimate to question if additional protection in the form of copyright is justified.

However design patent provides insufficient protection for typeface, for three reasons: the stringent requirements of novelty and non-obviousness, the excessive protection afforded by patent protection, and the short duration of patent protection.

First, the requirements for a design patent are much higher than for a copyright. In order for a design to be patented, it must meet the same requirements as an invention that is the subject of a utility patent.<sup>202</sup> A typeface must be novel<sup>203</sup> and non-obvious<sup>204</sup> to qualify for a design patent. Unlike a work being copyrighted, it is not enough that the design be original to its author.

A design is considered novel only if: 1) prior to the invention of the design, the design has not been known or used by others in the United States or described in a printed publication in any country,<sup>205</sup>

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200. 35 U.S.C. § 171.

201. *E.g.*, Typeface Design, U.S. Des. Patent No. 289,773, Bigelow, et al., inventors (May 12, 1987).

202. 35 U.S.C. § 171.

203. *Id.* § 102.

204. *Id.* § 103.

205. *Id.* § 102(a).

and 2) in the year prior to the date of the patent application, the design was not described in any printed publication in any nation and was not in public use or on sale in the United States.<sup>206</sup> At the very least, this requires an extensive and expensive search by a patent applicant, an obstacle not present in copyright.

Even more troublesome than the novelty requirement is the requirement of non-obviousness. A design is considered nonobvious if the differences between the design and previously publicly available designs are such that the design would have been obvious at the time of "invention" to a person having ordinary skill in the relevant art.<sup>207</sup> The issue of nonobviousness as applied to design patents is a difficult one, a fact that has been recognized by one Commissioner of Patents and Trademarks.<sup>208</sup> Applied to typeface design, this means that even a novel and original typeface design is not protectable if another typeface designer could have designed the same typeface. Such a standard is highly subjective, and not particularly useful.

Beyond the difficulties in assessing novelty and nonobviousness of a typeface design, it is unclear exactly why those requirements should be present for the protection of one species of works of authorship when they are not present for other works under copyright law.

A second inadequacy with design patent as a method of protecting typeface is that, compared to copyright, it affords too much protection. A copyright in a pictorial work includes the right to reproduce the copyrighted work, to prepare derivative works based upon the copyrighted work, to distribute the copyrighted work, and to display the copyrighted work publicly.<sup>209</sup> An infringement occurs when one of these four exclusive rights is violated.<sup>210</sup> However, if a similar or identical work is created independently of an earlier copyrighted work, no infringement occurs.<sup>211</sup> For there to be infringement, the second work must be in some way copied or derived from the first work. In contrast, a design patent protects the design as described and claimed in the patent, not merely the particular work as originated by the author. A patent confers upon the patentee the right to exclude

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206. 35 U.S.C. § 102(b).

207. *Id.* § 103.

208. "[T]he concept of unobviousness is not well suited to ornamental designs. We believe a registration system . . . would serve industry better at lower cost." Then-Commissioner of Patent and Trademarks Gerald Mossinghoff, Address at the American Bar Ass'n Patent, Trademark, and Copyright Section (Aug. 8, 1981), noted in *In re Nalbandian*, 661 F.2d 1214, 1219 (C.C.P.A. 1981) (Rich, J., concurring).

209. 17 U.S.C. § 106.

210. *Id.* § 501.

211. *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 720 (9th Cir. 1976).

others from making, using, or selling the patented design.<sup>212</sup> Any person who makes, uses, or sells a patented design without authority infringes the patent;<sup>213</sup> independent creation is not a defense.<sup>214</sup> A design patent prevents a similar typeface from being independently created by another designer, even if the design is entirely original to that designer.

This means that the protection afforded by a patent is far greater than that afforded by copyright. A typeface patentee is not only protected against copying; the patentee is also granted a monopoly over the typeface, capable of being asserted against anyone using the design, even if the design independently originates with the second author.

A third difficulty with design patent as a protection for typeface is the relatively short duration of the term. A design patent affords protection for only 14 years.<sup>215</sup> This short duration is justifiable based upon monopoly power conferred by the patent, as distinguished from the relatively weaker protection from copying that is conferred by copyright. However, it still forces works of authorship into the public domain far earlier than would occur if the work were covered by copyright. This does not reflect the interests that justify a longer term of protection for copyrighted works. The term of protection offered by copyright and design patent were once much closer than they are today. In 1870, for example, the duration of a design patent ranged from three and a half years to 14 years, at the election of the patentee.<sup>216</sup> At that same time, copyright endured for 28 years, renewable for 14 additional years.<sup>217</sup> In the years since then, maximum design patent protection has remained fixed at 14 years.<sup>218</sup> Copyright protection, on the other hand, has steadily lengthened, and today generally endures for a term of the life of the author and fifty years after the author's death.<sup>219</sup> The reasons for this increase include the objective of ensuring that a work does not fall into public domain within its author's lifetime and the recognition of the extended commercial life that has been afforded to copyrighted works as a result of the tremendous growth in communications media.<sup>220</sup> These reasons are as appli-

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212. 35 U.S.C. § 271.

213. *Id.* § 271(a).

214. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 477-78 (1974).

215. 35 U.S.C. § 173.

216. Patent and Copyright Act of 1870, ch. 230, § 73, 16 Stat. 209.

217. *Id.* §§ 87-88.

218. 35 U.S.C. § 173.

219. 17 U.S.C. § 302(a). In the case of works made for hire, duration is until the earlier of 75 years from first publication or 100 years from creation. *Id.* § 302(c).

220. H.R. REP. NO. 1476, *supra* note 2, at 134, *reprinted in* 1976 U.S.C.C.A.N. at 5750.

cable to the artistry in a typeface design as to that in any other artistic work.<sup>221</sup>

## 2. Difficulty in Assessing Similarity

A second objection to allowing copyright protection for typeface is that typefaces are very similar in appearance to one another, and that distinguishing among them is so difficult that effective enforcement of a typeface copyright cannot be obtained. This objection does not withstand scrutiny.

A *prima facie* showing of copyright infringement requires that the plaintiff demonstrate that the defendant copied material from the copyrighted work and that the copying constituted improper appropriation of protected expression.<sup>222</sup> Copying may be shown by circumstantial evidence by demonstrating that the defendant had access to the copyrighted work and that the two works are so similar that the later work must have been based on the first.<sup>223</sup> The objection is that because of the innate similarities inherent in a typeface, it would be nearly impossible to determine whether the expression in the defendant's typeface was derived from the expression in the plaintiff's typeface.<sup>224</sup> There are a number of answers to this objection.

First, a review of copyright cases that examine typeface shows that this fear is not justified. In *Steinberg v. Columbia Pictures Industries, Inc.*,<sup>225</sup> a poster advertising the film *Moscow On The Hudson* was found to be similar to the plaintiff's illustration for the cover of *The New Yorker* magazine.<sup>226</sup> As one element supporting the finding of infringement, the court found that the typeface used for the words "Moscow On The Hudson" was sufficiently similar to that used on the *The New Yorker* cover to reinforce the argument that defendants had copied the magazine illustration.<sup>227</sup>

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221. Another reason for the lengthy term of copyright put forth by the 94th Congress was the perceived need for uniformity with other nations, a prerequisite to the United States' eventual adherence to the Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971, 828 U.N.T.S. 221. H.R. REP. NO. 1476, *supra* note 2 at 135, reprinted in 1976 U.S.C.C.A.N. at 5751. This factor is not applicable to the term afforded to copyright in typefaces; the leading international agreement with respect to typeface protection requires a minimum term of 15 years. Vienna Agreement, *supra* note 188, art. 9.

222. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

223. *Id.* at 468.

224. 15 OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 1194, 1196 (1977) (testimony of Irwin Karp, Nov. 6, 1974).

225. *Steinberg v. Columbia Pictures Industries, Inc.*, 663 F. Supp. 706 (S.D.N.Y. 1987).

226. *Id.*

227. *Id.* at 711 n.1.

In *Roulo v. Russ Berrie & Co.*, the court, in denying defendant's motion for summary judgment, noted similarities of size, shape, color and typeface in a greeting card as one characteristic justifying preservation of the question of substantial similarity for the jury.<sup>228</sup>

Furthermore, while this comment is addressed to typeface as applied to copyright, it is worth noting that judicial determinations of similarity of typeface may be found in several other cases, particularly trademark cases, without any problems distinguishing the various designs.<sup>229</sup> Such determinations have not been confined to intellectual property cases.<sup>230</sup>

Of course, there may be cases where the differences are difficult for a lay finder of fact to determine. However, expert testimony is admissible in cases where specialized knowledge assists the trier of fact to determine a fact in issue.<sup>231</sup> Expert testimony can and has been used to determine similarity of works in copyright cases.<sup>232</sup>

In addition, the patronizing view that a jury must necessarily be unable to comprehend the differences among typefaces is in direct conflict with the fact that the general public's demand for the typeface is driven by exactly these differences. As one writer and designer has noted,

What I keep wondering is if typefaces are all that hard to tell apart, if they all look the same to the general public, why do members of the public buy any new ones? In theory, if they all look the same, users should be content with the half dozen that come with their computers. If, on the other hand, they want more because they *can* tell them apart, there's no reason not to protect the designs

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228. *Roulo v. Russ Berrie & Co.*, No. 82-C2668, 1986 WL 4718 at \*4 (N.D. Ill., Apr. 14, 1986).

229. See, e.g., *Venetianaire Corp. of America v. A & P Import Co.*, 429 F.2d 1079, 1081 (2d Cir. 1970) (noting similarity of spelling and typeface of words "hygienic" and "hygien" in finding trademark infringement); *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1431 (7th Cir. 1985), cert. denied, 475 U.S. 1147 (1986) (noting similarity of typefaces in logos of retail stores).

230. See *Matter of Gateway Press, Inc.*, No. 90-2, 1990 U.S. Comp. Gen. LEXIS 1319, at ¶ 513 (Comp. Gen. Dec. 21, 1990) (ruling of Comptroller General, noting "significant differences" between Eras Ultra typeface as required by government contract and Avant Garde Bold typeface furnished by bidder).

231. FED. R. EVID. 702.

232. See, e.g., *Selle v. Gibb*, 741 F.2d 896, 899 (7th Cir. 1984) (noting testimony of music professor to determine whether two songs could have been written independently). *Accord*, *Branch v. Ogilvy & Mather, Inc.*, 765 F. Supp. 819, 823-24 (S.D.N.Y. 1990) (expert testimony admitted to show substantial similarity between plaintiff's cookbook and defendant's advertisements). See also *Midway Mfg. Co. v. Bandai-America*, 546 F.Supp. 125, 138 (D.N.J. 1982), cert. denied, 475 U.S. 1047 (1986) (expert testimony admissible to show that copying has occurred, but not to show that the elements taken copied were protected expression).

and rely on juries and judges to make the distinctions they can apparently make very well when shopping.

Seems as if those opposed to design protection want to have it both ways.<sup>233</sup>

Furthermore, not all copyright cases require a showing of similarity to determine if the defendant copied protected expression. The copying may be admitted, with the only disputed issue being whether the copying was authorized.<sup>234</sup> The mere fact that evidentiary difficulties might arise in some typeface copyright cases does not justify denying protection to all typeface, including those cases where no such difficulties would arise.

In addition, denying copyright does not succeed in eliminating the difficulty. In the absence of copyright protection, the typeface industry has relied upon contracts between the various typeface companies to license typeface designs.<sup>235</sup> A recent lawsuit between International Typeface Corporation (ITC) and Monotype Corporation is a case in point.<sup>236</sup> For several years, ITC had licensed a number of typefaces to Monotype.<sup>237</sup> As a condition to the contract, Monotype agreed that it would not market the ITC fonts under any other name.<sup>238</sup> In 1990 and 1991, Monotype contracted to supply Microsoft Corporation with 35 typefaces.<sup>239</sup> ITC examined samples of the typefaces and concluded that Monotype had created the designs by copying those it had licensed from ITC.<sup>240</sup> ITC sued for breach of contract and Monotype defended by asserting that its typefaces were independently created, not copied from the ITC designs.<sup>241</sup> In the end, the issue of similarity was as prominent in this case as if the typefaces had

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233. Message from Kathleen Tinkel to J.A. Levin (Nov. 24, 1993), in Compuserve Desktop Publishing Forum, Type & Typography section, message no. 412917 (on file with author).

234. See, e.g., *Gilliam v. American Broadcasting Companies*, 538 F.2d 14 (2d Cir. 1976) (determination of whether defendant broadcasting company's admitted editing of plaintiff's television comedy program was authorized creation of derivative work); *Rural Tel. Serv. Co., Inc. v. Feist Publications, Inc.*, 663 F. Supp. 214, 216-17 (D. Kan. 1987), *aff'd on other grounds*, 916 F.2d 718, *rev'd on other grounds*, 499 U.S. 340 (1991). (determination of whether defendant's admitted copying of plaintiff's telephone directory constituted infringement of copyright).

235. *Seybold Spats*, *supra* note 162, at 1, 3. The contractual approach provides sufficient protection to prevent a licensee from engaging in unauthorized reproduction of the typeface that is the subject of the contract. However, it provides no protection against unauthorized reproduction by third parties who are not bound by the contract. Hence, the availability of the contract approach in no way obviates the need for copyright protection.

236. *Monotype-ITC Suit Tests Design Originality*, THE SEYBOLD REPORT ON DESKTOP PUBLISHING (Seybold Publications, Inc., Media, Pa.), Jan. 1, 1992, at 18-19.

237. *Seybold Spats*, *supra* note 162, at 1, 3.

238. *Id.*

239. *Id.*

240. *Id.*

241. *Id.*



been protected by copyright instead of by contract.<sup>242</sup> Denying copyright does not eliminate the evidentiary difficulty; it merely shifts it from copyright law to contract law.<sup>243</sup>

### 3. Preemption of the Alphabet

Another concern is that allowing a copyright on typeface will amount to protecting letters themselves, making any form of written communication an infringement. Framed as a constitutional issue, as it was by the government in *Eltra*,<sup>244</sup> this could be seen as a restraint on free expression in violation of the First Amendment.<sup>245</sup>

Existing provisions in U.S. copyright law are already in place to prevent this from being a concern. Copyright in a derivative work such as a typeface extends only to the material contributed by the work's author, and does not include any pre-existing material employed in the work.<sup>246</sup> In the case of a typeface design, this means that while the original components of a typeface are protected by copyright, the original underlying letterforms on which the typeface is based remain in the public domain. As noted by the district court in *Eltra*,

No one suggests that the use of existing typeface designs long in the public domain cannot adequately protect against such apprehension. The suggestion that a typeface design, an "original" work of art whose designer is entitled to intellectual protection, must be denied a copyright because of First Amendment considerations is a

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242. *Seybold Spats*, *supra* note 162, at 3-4.

243. One is reminded of Professor Karl Llewellyn's famous comment: "The court must decide the dispute that is before it. It cannot refuse because the job is hard, or dubious, or dangerous." K. N. LLEWELLYN, *THE BRAMBLE BUSH: ON OUR LAW AND ITS STUDY* 41 (1960). While Professor Llewellyn was commenting on the requirement for a court to decide the dispute before it, as distinguished from the issue of whether such a dispute should be subject to decision, the principle is the same.

244. The defendant also argues that because typeface designs in general are the means by which the communication of ideas in printed form is made, the copyrighting of typeface designs ultimately will lead to restrictions not only upon use of those designs, but also upon the free dissemination of ideas by means of printed form. Thus such designs should be put in a category different from other utilitarian designs. Cited in support of this are various expressions from the Government Printing Office and representatives of publishers. . . . The Government Printing Office has expressed concern that the need to secure authorization from copyright proprietors prior to reproduction would have an "impact on the dissemination of information contained in Government publications sold to the public." Commercial publishers have expressed fears of potential infringement problems.

*Eltra I*, 194 U.S.P.Q. at 201.

245. U.S. CONST. amend I.

246. 17 U.S.C. § 103(b).

strained and tenuous extension of that section of the Bill of Rights.<sup>247</sup>

#### 4. Casual Infringement

Another objection is that allowing copyright on typeface would expose casual users of a copyrighted typeface to charges of infringement. For example, if a book was incidentally displayed in a motion picture, would the typeface used on the book's cover provide the basis for a suit for copyright infringement?<sup>248</sup> Existing provisions for fair use may or may not be sufficient to avoid this problem. For this reason, the proposed amendment includes a modification to § 113, "Scope of exclusive rights in pictorial, graphic, and sculptural works," to resolve the issue.

A "fair use" of a copyrighted work is not an infringement of copyright.<sup>249</sup> Fair use is a case-by-case determination, and requires the assessment of four factors: the purpose and character of the use; the nature of the copyrighted work; the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and the effect of the use upon the potential market for, or value of, the copyrighted work.<sup>250</sup>

247. *Eltra I*, 194 U.S.P.Q. at 201.

248. HOUSE COMM. ON THE JUDICIARY, 88TH CONG., 1ST SESS., COPYRIGHT LAW REVISION PART 2, DISCUSSION AND COMMENTS ON REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL PROVISION OF THE U.S. COPYRIGHT LAW 344 (Comm. Print 1963) (comment of Motion Picture Ass'n of America, Inc.).

249. 17 U.S.C. § 107.

250. *Id.* Here is an example of how the four factors might be applied to the hypothetical example posed in the text above, that of a typeface on a book cover being displayed in a commercial motion picture.

1) *The purpose and character of the use.* *Id.* § 107(1). Works of a commercial nature are less likely to be considered a fair use than are those for non-profit educational purposes. *Id.* The example posed here is that of a typeface being used in a commercial motion picture. Because this is a commercial endeavor, this factor weighs against a finding that the use is a fair use.

2) *The nature of a copyrighted work.* *Id.* § 107(2). A work that is factual in nature is generally afforded less protection than a work of fiction or fantasy. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 563 (1985). It is difficult to predict how a court would rule on this factor. On the one hand, as noted above, the thing that gives value to the typeface as a copyrightable work is its aesthetic value, not its utilitarian function of making text readable. In this case, there is an argument that this point should weigh against a finding of fair use. On the other hand, it is arguable that the mere incidental use of the typeface in a film is not for the purpose of aesthetics, but merely to portray the information on the object portrayed in the film.

3) *Amount and substantiality of the portion used in relation to the copyrighted work as a whole.* 17 U.S.C. § 107(3). This factor looks to see how much of the copyrighted work was used in the second work. This is, of course, a very fact-specific question: did the book cover as depicted in the motion picture use just a few letters of the typeface, or did it show most or all of the letters? If only a few representative letters are included on the book, this factor would weigh in favor of a finding of fair use. However, if a large amount of text is displayed in the copyrighted typeface, this factor may argue against fair use.

The result of a fair use analysis is difficult to predict. Many cases would result in fair use, particularly if the fourth factor, the effect of the use upon the potential market for or value of the copyrighted work, were appropriately weighted. However, the analysis necessary to permit the casual use described is somewhat convoluted, and far from certain. Therefore, any amendment of the copyright act to extend copyright to typeface should clarify this issue and ensure that incidental uses could not be considered infringement. The proposed legislation accomplishes this by incorporating the limitation as an amendment to § 113:

*In the case of a typeface design, it is not an infringement of copyright to depict an article printed with the typeface in any literary, pictorial, graphic, or audiovisual work.*

##### 5. Extension of Copyright by Republishing in a Different Typeface

Another fear is that allowing a copyright for typeface would permit an author to extend the duration of a copyright on a literary work by republishing it in a different typeface. This point is already avoided both by Copyright Office regulation<sup>251</sup> and by statute.<sup>252</sup> Copyright Office regulations do not allow for registration of a work that is a mere variation of typographical ornamentation or lettering.<sup>253</sup> Even if the new edition was considered subject to copyright as a derivative work,<sup>254</sup> the copyright in such a work is independent of that of the preexisting material, and does not affect or enlarge the scope or duration of the underlying literary work's copyright.<sup>255</sup>

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4) *The effect of the use upon the potential market for, or value of, the copyrighted work.* *Id.* § 107(4). This factor has been characterized as the single most important element of fair use. *Harper & Row*, 471 U.S. at 566. In the case at hand, this factor is easily resolved in favor of fair use. There is little chance of a typeface being casually depicted in a motion picture having the result of reducing the market for that typeface. Because of the insignificant impact on the market for the typeface, this factor would nearly always favor a finding of fair use.

251. 37 C.F.R. § 202.1(a) (1992).

252. 17 U.S.C. § 103(b).

253. 37 C.F.R. § 202.1(a).

254. A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

17 U.S.C. § 101.

255. *Id.* § 103(b).

## 6. Limitations on Distributing Printed Works

A final objection that will be discussed is the possibility that a copyright in typeface would allow the copyright holder to halt the distribution of printed matter set in the typeface.<sup>256</sup> The fear is that a copyright holder could extort an exorbitant license fee from a publisher, effectively holding the publisher's work hostage.<sup>257</sup>

There are two difficulties with this argument. First, as noted above, even under current law, a typeface may be the subject of a design patent.<sup>258</sup> There is no reason to expect that an owner of the copyright of a typeface is more prone to this abuse than is an owner of a design patent covering a typeface design. Indeed, because independent creation is a defense to copyright infringement and not to patent infringement,<sup>259</sup> the potential for such a threat is less for copyright than for patent.

A second problem with this complaint is that it is not clear why this potential for abuse is not present with any other copyright. A publisher of a book that contains photographs, for example, would be subject to liability should a copyrighted photograph be reproduced without the consent of the copyright holder. It is not clear why this fear is more pronounced with a copyright in a typeface than it is for a copyright in a photograph.

However, it is recognized that the goal of protecting a typeface by copyright is to prevent the typeface from being copied by other designers, and from being embodied in a font without the authority of the copyright holder. For that reason, as a matter of policy, it may be desirable to ensure that the copyright holder is unable to exercise a copyright beyond this limit, and not allow it to extend to enjoining the publication and distribution of a book printed in the typeface. To this

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256. [Use of an infringing typeface in a book] could lead to the issuance of an injunction against the further distribution of the book and its infringing type face, and indeed to the destruction of all existing copies produced by the publisher in all innocence and at great expense.

15 OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 1194, 1197 (1977) (testimony of Irwin Karp, Nov. 6, 1974).

257. If you were to accord copyright to typeface designs of text matter, assuming originality of their ornamental features, there would be placed in the hands of copyright owners an opportunity to make egregious demands upon publishers. You would proliferate litigation because you would proliferate putative copyrights. Even if publishers were to succeed in defense of such actions, they would still have the expense of defending the lawsuits for copyright infringement.

15 OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 1217, 1220 (1977) (statement of Alfred H. Wasserstrom, June 12, 1975).

258. See *supra*, note 200 and accompanying text.

259. See *supra*, note 209 and text following.

end, the proposed legislation includes the following limitation as an amendment of § 113.

*In the case of a typeface design, it is not an infringement of copyright . . . to use the typeface in the ordinary course of typing, composing text, typesetting, or printing.*

This limitation is similar to one incorporated into the United Kingdom copyright statute,<sup>260</sup> and is similar to one that had been part of the most recently proposed design protection bill in the United States.<sup>261</sup>

## VI. CONCLUSION

A typeface design is an artistic work of authorship that deserves the same copyright protection as any other artistic work. Under the current interpretation of United States law, however, typeface is completely unprotected by copyright. Because of the *Eltra* decision and its codification into Copyright Office regulations, typeface will remain unprotected until express legislation is enacted by Congress to correct this.

The 1980s saw an explosion in personal computing. When the 1976 Copyright Act was enacted, "desktop publishing" did not exist; the problem of pirating typeface did not exist on any appreciable scale. Today, as more individuals use personal computers, and fonts and typefaces are copied and traded by countless users, the importance of protecting the expression in typeface has increased. The legislation proposed in this comment provides that protection.

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260. "It is not an infringement of copyright in an artistic work consisting of the design of a typeface . . . to use the typeface in the ordinary course of typing, composing text, typesetting or printing . . ." Copyright Designs and Patents Act, *supra* note 182, § 54(1)(a).

261. "It is not an infringement of a typeface that is a design protected under this chapter to reproduce, modify, or distribute printed materials using the typeface." H.R. 1790, *supra* note 2, § 1009(h).

## APPENDIX

ABCDEFGHI  
JKLMNOPQR  
STUVWXYZ  
abcdefghi  
jklmnopqr  
stuvwxyz  
1234567890  
£ ¢ ∞ § ¶ ° ß \$ %  
Æ æ Œ œ fi fl

Figure 1: Times

ABCDEFGHI  
JKLMNOPQR  
STUVWXYZ  
abcdefghi  
jklmnopqr  
stuvwxyz  
1234567890  
£ ¢ ∞ § ¶ ° ß \$ %  
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Figure 2: New York

ABCDEFGHI  
JKLMNOPQR  
STUVWXYZ  
abcdefghi  
jklmnopqr  
stuvwxyz  
1234567890  
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¶ ° ß \$ %  
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Figure 3: Courier



ABCDEFGHI  
JKLMNOPQR  
STUVWXYZ  
abcdefghi  
jklmnopqr  
stuvwxyz  
1234567890  
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Figure 4: Monaco

ABCDEFGHI  
JKLMNOPQR  
STUVWXYZ  
abcdefghi  
jklmnopqr  
stuvwxyz  
1234567890  
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Figure 5: Helvetica

ABCDEFGHI  
JKLMNOPQR  
STUVWXYZ  
abcdefghi  
jklmnopqr  
stuvwxyz  
1234567890  
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Figure 6: Geneva

**A B C D E F G H I**  
**J K L M N O P Q R**  
**S T U V W X Y Z**  
**a b c d e f g h i**  
**j k l m n o p q r**  
**s t u v w x y z**  
**1 2 3 4 5 6 7 8 9 0**

Figure 7: San Francisco

A B C D E F  
G H I J K L M  
N O P Q R S  
T U V W X Y Z  
a b c d e f g h i  
j k l m n o p q r  
s t u v w x y z  
1 2 3 4 5 6 7 8 9 0  
ß æ œ fi ff

Figure 8: BobGothic

ABCDEF  
GHIJKLM  
NOPQRS  
TUVWXYZ  
abcdefghi  
jklmnopqr  
stuvwxyz  
1234567890

Figure 9: Koch Roman

*A B C D E F G H I*  
*J K L M N O P Q R*  
*S T U V W X Y Z*  
*a b c d e f g h i*  
*j k l m n o p q r*  
*s t u v w x y z*  
*1 2 3 4 5 6 7 8 9 0*  
*£ ¢ ∞ § ¶ ° ß \$ %*  
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Figure 10: Zapf Chancery

A B C D E F G H I  
J K L M N O P Q R  
S T U V W X Y Z  
a b c d e f g h i  
j k l m n o p q r  
s t u v w x y z  
1 2 3 4 5 6 7 8 9 0  
ß \$ %  
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Figure 11: Venice



ABCDEFGHI  
JKLMNOPQR  
STUVWXYZ  
abcdefghi  
jklmnopqr  
stuvwxyz  
1234567890  
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Figure 12: Palatino