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Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles

Robert C. Denicola*

The word "copyright" evokes images of books, movies, or sound recordings. Further reflection might yield visions of paintings, photographs, or sculptural works. Few, however, associate copyright with belt buckles, table lamps, or pencil sharpeners—yet to some unsettled extent, even these items have their place in the copyright scheme.

Copyright law has reluctantly embraced a variety of works embodied in utilitarian objects, while simultaneously purporting to exclude the general province of industrial design. The courts have concluded that a light bulb protruding from Michelangelo's David ought not render the statue unprotected,1 while insisting that the overall design of modern street lights lies beyond the scope of copyright protection.2 The grudging inclusion of selected useful objects has led both Congress and the courts to seek a rationale that could stand fast against the deluge of mass-produced industrial goods. Although the search has not gone well, the decision to exclude the general appearance of commercial products from copyright protection remains unshaken.3 The result has been a patchwork of ad hoc decisions, united only by their common references to statutory formulations that do little more than restate the dilemma.

The legal status of commercial design, however, is only partially fixed by copyright principles. Design patents4 long of-

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ffered the possibility of protection for the ornamental design of a useful product. Their integration into a general patent regime directed primarily at mechanical rather than aesthetic innovation, however, severely undermined their practical utility. Consequently, alternative proposals have become a congressional fixture, spawning a raft of conflicting academic analysis. The failure to win more specialized protection has encouraged efforts to assimilate design protection into the law of copyright. Indeed, even passage of a sui generis design statute would do little to deflect attempts to secure the more expansive monopoly offered by copyright.

This Article examines the current status of useful articles under the Copyright Act of 1976 and proposes an alternative analysis of their copyrightability. Congress, borrowing heavily from prior administrative and judicial formulations, has constructed an elaborate mechanism to differentiate protectible "applied art" from unprotectible "industrial design." Thus, the Act rejects both wholesale inclusion and exclusion of utilitarian objects, leaving it to the courts to define and defend a middle ground. Against the backdrop of Justice Holmes's admonition to avoid judicial determinations of artistic merit or worth, the list continues to grow. See Esquire, Inc. v. Ringer, 591 F.2d 796, 800 n.12 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979). The list continues to grow. See H.R. 20, 97th Cong., 1st Sess. (1981), reprinted in 2 COPYRIGHT L. REP. (CCH) ¶ 20,097 (1981).

The more recent articles are noted and summarized in COPYRIGHT OFFICE, BIBLIOGRAPHY ON DESIGN PROTECTION (Supp. 1976).

Recent design protection bills have carefully preserved the proprietor's right to rely on the copyright alternative. See, e.g., H.R. 20, 97th Cong., 1st Sess. § 927 (1981), reprinted in 2 COPYRIGHT L. REP. (CCH) ¶ 20,097 (1981); S. 22, tit. II, supra note 6, § 227.

5. See infra note 30.
6. See, e.g., S. 22, tit. II, 94th Cong., 1st Sess. §§ 201-235, 122 CONG. REC. 3856-59 (1975), reprinted in S. REP. No. 473, 94th Cong., 1st Sess. 39-47 (1975) [hereinafter cited as S. 22, tit. II]. Counting unsuccessful design protection bills has become a popular pastime. See In re Nalbandian, 661 F.2d 1214, 1218 n.1 (C.C.P.A. 1981) (Rich, J., concurring) ("Records I made in the mid 50's show that, beginning in 1914, some 45 bills were introduced . . ."); Dulin, Design Protection: Walking the Pirate Plank?, 12 BULL. COPYRIGHT SOCIETY 321, 325 (1965) ("In the fifty years since 1914, 55 design protection bills have been introduced . . ."); Note, Protection for the Artistic Aspects of Articles of Utility, 72 HARV. L. REV. 1520, 1520 (1959) ("to date more than thirty-five such bills have been unsuccessfully introduced"); Comment, Trade Regulation: Legal Protection of Commercial Design, 1959 WIS. L. REV. 652, 662 ("During the period of 1914 to 1959, forty-eight bills were introduced . . ."). Since 1914, approximately seventy design protection bills have been introduced in Congress, none of which has been enacted into law." Esquire, Inc. v. Ringer, 591 F.2d 796, 800 n.12 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979). The list continues to grow. See H.R. 20, 97th Cong., 1st Sess. (1981), reprinted in 2 COPYRIGHT L. REP. (CCH) ¶ 20,097 (1981).

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10. It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the
however, few touchstones developed. Yet, a discriminating approach is both defensible and desirable. Industrial design differs in important respects from the traditional subject matters of copyright, and presents a less compelling claim to the statutory monopoly. But it is unwise, if not in fact impossible, to exclude from the scope of copyright all works capable of serving some useful purpose. The attempts of the Congress, the Copyright Office, and the courts to delimit the boundaries of copyright in useful articles have been only partially successful. Their efforts have a transient quality conspicuous even in a legal regime populated by concepts as ephemeral as "idea," "expression," and "creativity." A good portion of the difficulty arises from the tendency to focus exclusively on the results of the creative effort. This Article suggests that it is the process of creation that distinguishes industrial design from applied art and other forms of authorship traditionally recognized by copyright law.

I. INITIAL ENCOUNTERS

The uneasy relationship between copyright and utilitarian articles has its roots in a series of piecemeal additions to the statutory subject matter. The constitutional provision authorizing federal copyright legislation, with its reference to "Authors" and their "Writings," gives little hint of the scope of modern copyright law. The initial exercise of the copyright power in 1790 was confined to maps, charts, and books. In 1802, coverage was extended to "prints." Musical compositions were brought within the statutory framework in 1831, and photography one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251-52 (1903) (Holmes, J.). See Mazer v. Stein, 347 U.S. 201, 214 (1954) ("Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.").

graphs followed in 1865. Not until 1870, when protection was extended to "painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts," did three-dimensional objects gain protection. The emphasis on "fine arts," however, served to maintain a respectable distance between copyright and useful articles. Under the Copyright Act of 1909, the immediate precursor of the current statute, however, claims of copyright in utilitarian objects could not be so easily dismissed.

Among the items eligible for copyright under the 1909 Act were those specified in section 5(g): "Works of art; models or designs for works of art." With the deletion of all reference to the "fine arts," a major barrier to copyright in the design of useful objects apparently fell. No logic could demonstrate that crystal wine glasses, pearl rings, or even handsome radio cabinets were not "works of art." The Copyright Office, however, quickly moved to exclude useful articles from the scope of copyright by resurrecting the very distinction so recently abandoned by the Congress. In a 1910 regulation defining "works of art," the Copyright Office restricted the newly established classification to "the so-called fine arts," expressly excluding "[p]roductions of the industrial arts utilitarian in purpose and character."

The "industrial arts," however, proved difficult to contain. In 1917, the Copyright Office amended the regulation to permit registration of "artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture." By 1949, the breach was significantly wider: "This class includes published

18. Id. § 5(g).
20. Works of Art. This term includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture). Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented. No copyright exists in toys, games, dolls, advertising, novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics, or any smaller articles.

COPYRIGHT OFFICE, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT, BULL. NO. 15, § 12(g) (1910).
or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enameled, glassware, and tapestries, as well as works belonging to the fine arts . . . .”

Forty years after Congress had forsaken the limitation, the Copyright Office formally abandoned the attempt to restrict the reach of copyright to works of the “fine arts.” A reference to “works of artistic craftsmanship” was all that remained of the barrier between copyright and the design of utilitarian products. Attention then shifted from administrative to judicial formulations.

In 1954, the United States Supreme Court considered a copyright infringement claim involving china statuettes of Balinese dancing figures. The contestants in Mazer v. Stein were rival lamp manufacturers. The copyright owner, with the addition of the appropriate hardware, employed the statuettes as bases for table lamps. The statuettes, sans sockets and wiring, were registered with the Copyright Office as “‘works of art’ and ‘reproductions of a work of art.’” A competitor copied the figures and put them to a similar use.

The defendants premised their response to the charge of infringement chiefly on the federal design patent law, which protects “any new, original and ornamental design for an article of manufacture.” Only design patents, they argued, could monopolize the appearance of mass-produced utilitarian articles. The Court did not agree: “Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold.” The contention that useful articles were beyond the limits of copyright was formally put to rest:

The dichotomy of protection for the aesthetic is not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents. We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law.

22. 37 C.F.R. § 202.10(a) (1949).
27. Id. at 218. The Copyright Office had by this time registered a variety of utilitarian articles, including “book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays.” Id. at 221 (Douglas, J., concurring). Some of these items, however, may not be protected under the more intricate standard currently in effect. See infra notes 71-76 and accompanying text.
Mazer, however, fell far short of a wholesale endorsement of copyright in the design of useful objects. The Court was quick to point out the narrow issue for decision: "The case requires an answer, not as to a manufacturer's right to register a lamp base but as to an artist's right to copyright a work of art intended to be reproduced for lamp bases."28 The statuettes, as works of art, were entitled to copyright. Neither prior nor subsequent use in utilitarian articles, nor the fact that they were conceived expressly for such an end, jeopardized that status. Utility and art were no longer mutually exclusive, but it was still only the latter that could command copyright. Mazer answered one question, yet wisely eschewed another. The use to which "works of art" are put is irrelevant, the Court declared, but the bounds of that statutory classification remained uncertain. A dancing figure qualified, but the Court had said nothing of the forms displayed by toasters or automobiles, or the designs of wedding gowns or belt buckles.

Those seeking protection for the full range of industrial design could find comfort in the Court's echo of Justice Holmes: "Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art."29 Yet to apply the statutory criterion, some conception of art, or more precisely some conception of section 5(g) "works of art," remained a necessity. Most of the suggested models, however, did not assimilate industrial design.

Tests emphasizing aesthetic merit had little to recommend them. The "inventiveness" criterion of federal design patent law imposed a similar analysis in that regime with disastrous results.30 In the copyright sphere, most judges prudently

28. 347 U.S. at 205.
29. Id. at 214.

The overlap between the subject matters of design patent and copyright raises the possibility of dual protection. Early case law put the creator to an election. See, e.g., In re Blood, 23 F.2d 772, 773 (D.C. Cir. 1927) (hosiery ticket); Louis De Jonge & Co. v. Breuker & Kessler Co., 182 F. 150, 152 (E.D. Pa. 1910)

Unlike copyright, with its modest requirements of originality, generally understood to be "little more than a prohibition of actual copying," Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951) (quoting Hoague-Sprague Corp. v. Frank C. Meyer Co., 31 F.2d 583, 586 (E.D.N.Y. 1929)), and some minimal degree of creativity or effort, see Denicola, Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works, 81 COLUM. L. REV. 516, 520-22 (1981), the barriers to design protection are imposing. As a result of the novelty requirement, independent creation is not sufficient. Rather, the design must produce a new visual impression, generally measured with reference to an ordinary observer. See 2 A. DELLEr, WA=KR ON PATENTS § 159 (1964). The design must also be "ornamental," thus necessitating at least a minimal assessment of its aesthetic impact. Id. § 160.

The reference in section 171 of the design patent law to provisions relating to inventions, however, introduces a more troublesome requirement. See 35 U.S.C. § 171 (1976). Section 103 of the patent statute prohibits the issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103 (1976). The "non-obviousness" test is a 1952 codification of the "inventiveness" standard generally applied to applications for both mechanical and design patents. See 2 A. DELLEr, supra, § 161. Whatever utility the standard may have with respect to mechanical patents, however, it has been little short of ruinous in the design patent regime.

On a doctrinal level, application of the "person having ordinary skill in the art" standard in the design context has generated a semantic dispute between proponents of an "ordinary observer" standard and those who advocate an "ordinary designer" benchmark. See In re Nalbandian, 661 F.2d 1214, 1216-17 (C.C.P.A. 1981) (reviewing the conflicting case law). One suspects that the semantics have little substantive impact. "It is probably true . . . that . . . courts will, with phraseology of their own choosing, continue to find designs patentable or unpatentable according to their judicial 'hunches.'" Id. at 1218 (Rich, J., concurring). On a more fundamental level, an obviousness test for aesthetic contributions appears to demand the very artistic judgments and analysis wisely shunned by copyright law. But cf. Belding Heminway Co. v. Future Fashions, Inc., 143 F.2d 216, 217-18 (2d Cir. 1944) ("That there may be as outstanding aesthetic invention as there is mechanical, only barbarians would deny." Unfortunately, the barbarians cannot be relied on to recuse themselves.). The Commissioner of Patents and Trademarks has acknowledged that "the concept of unobviousness is not well suited to ornamental designs." Address by Commissioner of Patents and Trademarks Gerald Mossinghoff, ABA
shunned the role of art critic.\textsuperscript{31} A more appealing approach was to turn to history in an attempt to cabin the reach of copyright. In one of the series of cases brought by the plaintiff in \textit{Mazer}, the Ninth Circuit stated, "A thing is a work of art if it appears to be within the historical and ordinary conception of the term art."\textsuperscript{32} The rationale admitted statuettes, but excluded a cardboard photo holder.\textsuperscript{33} Although this formulation was perhaps an improvement over purely subjective evaluations of artistic merit, as a practical matter it could furnish little guidance in specific cases. With museums proudly displaying the pottery, weapons, furnishings, and other artifacts of preceding cultures, the sweep of the rationale might well exceed the expectations of its proponents. Emphasis on a "colloquial rather than a philosophical significance"\textsuperscript{34} for

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Reliance on so subjective a standard inevitably has its price. "In final analysis it depends upon the judgment of the judge or judges who have the last say," Gold Seal Importers, Inc. v. Morris White Fashions, Inc., 124 F.2d 141, 143 (2d Cir. 1941) (invalidating design patent for lack of inventiveness). A study by the Patent and Trademark Office indicated that an astonishing 68\% of design patents challenged in federal courts during the period from 1973 to 1977 were held invalid. \textit{Patent and Trademark Office, Study of Court Determinations of Patent Validity/Invalidity, 1973-1977, reprinted in 455 Pat. Trademark & Copyright J. (BNA) D-1 - D-3 (1979)}.

Although the sample produced by decisions to contest validity is undoubtedly biased toward questionable patents, the statistics clearly justify the ill repute generally attached to design patent law. The insecurity is particularly troubling in light of the effort and expense necessary to obtain issuance of a design patent. Because of the necessity of evaluating novelty and nonobviousness, the patent application process is substantially more protracted than copyright registration procedures. In 1975, the average time between filing and issuance was reported to be about twenty-one months. \textit{Copyright Office, Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1975 Revision Bill 187 (Draft 1975)} [hereinafter cited as Second Supplementary Report]. Costs, including attorney's fees, can quickly become prohibitive for small enterprises, particularly when a number of new designs are to be introduced. It is hardly surprising that both the Copyright Office and the Patent and Trademark Office have urged the enactment of alternative design protection legislation. \textit{Id.} at 186-87, 203; Address by Commissioner of Patents and Trademarks Gerald Mossinghoff, \textit{supra}.


32. Rosenthal v. Stein, 205 F.2d 633, 635 (9th Cir. 1953).

33. \textit{See} Bailie v. Fisher, 258 F.2d 425, 426 (D.C. Cir. 1958). \textit{-} The historical approach to the "works of art" classification has also been championed in the academic literature. \textit{See} Comment, \textit{supra} note 6, at 660.

"works of art" only transferred aesthetic judgments to a different jury. Moreover, given the selective additions to the statutory subject matter that preceded the "works of art" classification, there was no reason to suspect that the new category was intended to subsume every object that either curator or bumpkin might label "art."

In retrospect, Mazer v. Stein did little to clarify the issue of copyright in the design of commercial products; it merely enjoined the automatic excision of all utilitarian articles. Although the Copyright Office Regulations soon reflected the Court's narrow holding, the administrative response did not end with codification. Determined to close the door that Mazer left ajar, the Copyright Office sought a formulation that would accommodate Mazer, yet exclude the general realm of industrial design. After one aborted attempt, it settled on the "separability" standard that has come to dominate current analysis:

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

Mazer had quickly become the limit of copyright in useful articles.

Even the guarded terms of Mazer and its regulatory progeny, however, brought major change. Overcoming a long-standing exclusion, graphic designs adorning textiles were now securely within the subject matter of copyright. The regula-

35. In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile material or textile product. The potential availability of protection under the design patent law will not affect the registrability of a work of art . . . .

36. See 37 C.F.R. § 202.10(c) (Supp. 1956).


tions said as much. Indeed, any two-dimensional graphic work could arguably be “identified separately” from the utilitarian article to which it was applied, and copyright registrations were issued in connection with graphic designs appearing on products ranging from shoe soles to dinnerware. Yet there were limits. When the graphic elements went beyond mere applique and became more intimately associated with the utilitarian features of the article, protection was denied.

The test of separate identity and independent existence could be particularly troublesome when the copyright claim was directed at three-dimensional aspects of utilitarian articles. Some objects presented little difficulty. The “Flying Lady” hood ornament could be detached from the accompanying Rolls-Royce, yielding a perfectly independent statuette. With a bit more imagination, gargoyles could be mentally chiseled from pediments, and lamp shades and sockets stripped from dancing figures. The case law, however, presented greater challenges. For example, it seemed natural to extend protection to children’s coin banks shaped in forms ranging from dogs to humans, despite the difficulty in identifying features “capable of existing independently.” The “work of art” was the bank itself. If the overall shape of a cocker spaniel bank was protectible, could anything more than aesthetic prejudice exclude the overall shapes of tea kettles, home computers, or food processors? Other cases similarly undermined the administrative criterion. Copyright was upheld in a ring box with no men-

40. See 37 C.F.R. § 202.10(b) (Supp. 1956) (current version at 37 C.F.R. § 202.10(a) (1981)). See also supra note 35.
43. See Eltra Corp. v. Ringer, 579 F.2d 294 (4th Cir. 1978) (type-face design); Vacheron & Constantin-Le Coultre Watches Co. v. Benrus Watch Co., 155 F. Supp. 932 (S.D.N.Y. 1957) aff’d on other grounds, 260 F.2d 637 (2d Cir. 1958) (appearance of watch face not copyrightable under initial post-Mazer regulation, 37 C.F.R. § 202.10(c) (Supp. 1956)).
tion of separability, and registration issued for a series of molds used in the manufacture of ceramic figures. Yet such objects offered no obviously separable elements; the art lay in the articles themselves.

The gap between copyright and industrial design was further narrowed when copyright was recognized in an antique telephone shape used as the outer casing of a pencil sharpener. The court, concluding that the Copyright Office regulations did not preclude protection because "the telephone casing could be separated physically from the pencil sharpener," declared the casing a "work of art" and enjoined the defendant from distributing a substantially similar product. But casings, covers, and cabinets could be removed from a host of commercial products, and the regulations offered little basis for distinctions.

Despite the shortcomings of the doctrinal formulations, both the courts and the Copyright Office maintained the conviction that copyright protection for the general design of commercial products was inappropriate. Efforts to achieve a general revision of the copyright law began within a year after the decision in *Mazer v. Stein*, and throughout the twenty-one years of legislative machinations that preceded the enactment of the current statute, the Copyright Office consistently counseled against the extension of copyright to industrial design.

49. *Id.*
50. The basic criterion applied by the Copyright Office to determine registrability as a work of art is the existence of artistic features which can be identified separately from any utilitarian article and which are capable of existing independently from the article as works of art. The difficulty of administering this criterion is one reason for the support given by the Copyright Office for specialized design legislation.

51. In the years since the Mazer decision, full protection under the copyright law has not proved inappropriate for "works of art" used as a design or decoration of useful articles. We do not believe, however, that it would be appropriate to extend the copyright law to industrial designs as such.

II. THE COPYRIGHT ACT OF 1976

A. THE REVISION EFFORT

The decision to undertake a major revision of United States copyright law provided proponents of protection for industrial design a unique opportunity. Influenced perhaps by the position of the Copyright Office, however, their energies focused not on copyright per se, but rather on a series of companion bills offering sui generis protection for ornamental designs of useful articles.

In a 1961 report, the Copyright Office reaffirmed its opposition to the extension of copyright in useful articles beyond that available under its existing regulations.\(^52\) Noting the anticompetitive consequences of broad protection for commercial design, the report concluded that the duration of copyright and the potential liability of innocent distributors, together with other specifics of the copyright system, made copyright protection unsuitable for industrial design.\(^53\) Instead, the report urged consideration of separate industrial design legislation. The suggestion was hardly novel. Bills for the protection of industrial design had been introduced regularly since the turn of the century,\(^54\) and the issue had generated a plethora of conflicting analysis. The Copyright Office itself had developed an extensive bibliography on the subject.\(^55\)

During the 1960's, separate design protection bills passed the Senate on three occasions.\(^56\) In 1969, the Senate formally joined the design proposals with copyright revision.\(^57\) Carried by the momentum of the revision effort, design protection legislation appeared as Title II of the general copyright revision bill when the Senate ultimately forwarded the legislation to the House in 1976.\(^58\) Title II provided protection for the "original ornamental design of a useful article."\(^59\) "Staple or commonplace" designs were excluded, together with those "dictated solely by a utilization function of the article."\(^60\) Protection ex-

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\(^{52}\) See id.

\(^{53}\) See id. See generally Ringer, The Case for Design Protection and the O'Mahoney Bill, 7 BULL. COPYRIGHT SOC'Y 25 (1960).

\(^{54}\) See supra note 6.


\(^{56}\) H.R. REP. No. 1476, supra note 3, at 50.

\(^{57}\) Id.

\(^{58}\) Id. at 49-50.

\(^{59}\) S. 22, tit. II, supra note 6, § 201(a).

\(^{60}\) Id. § 202. In an effort to win congressional approval, the three-dimen-
tended for a maximum of ten years, and prohibited the manu-
ufacture, importation, or sale of articles "the design of which has
been copied from the protected design, without the consent of
the proprietor." The bill established administrative machin-
ery for the registration of protectible designs, but left to the
President the designation of the appropriate governmental of-

Title I provided that copyright in works utilized in connection with useful articles was unaffected
by the protection available under Title II, unless the proprietor
actually obtained a Title II registration.

Title II, designated the Design Protection Act of 1975, did
not survive consideration in the House. The Judiciary Commit-
tee "chose to delete Title II in part because the new form of de-
sign protection provided by Title II could not truly be
considered copyright protection and therefore appropriately
within the scope of copyright revision." The House Report
made passing reference to the bill's failure to designate a spe-
cific agency to administer the system, although the Copyright
Office had by this time volunteered its services, and to the un-
resolved issue of protection for typeface designs. The prin-
cipal objection, however, was more fundamental:

Finally, the Committee will have to examine further the assertion of
the Department of Justice, which testified in opposition to the Title,
that Title II would create a new monopoly which has not been justified
by a showing that its benefits will outweigh the disadvantage of remov-
ing such designs from free public use.

Proponents of specialized design protection were left only with

sional shape of wearing apparel was also excluded. Id. § 202(3). See SECOND
SUPPLEMENTARY REPORT, supra note 30, at 204.
61. S. 22, tit. II, supra note 6, § 205.
62. Id. § 208. "Innocent" retailers were afforded a broad measure of protec-
tion. Id. § 208(a)(2).
63. Id. § 230.
64. S. 22, tit. I, 94th Cong., 1st Sess. § 113(c), 122 CONG. REC. 3841, 3845
(1975), reprinted in S. REP. No. 473, 94th Cong., 1st Sess. 12 (1975). Passage of
Title II would thus not have eliminated the need to confront the issue of copy-
right in useful articles.
65. S. 22, tit. II, supra note 6, § 235.
66. H.R. REP. No. 1476, supra note 3, at 50.
67. S. REP. No. 473, 94th Cong., 1st Sess. 166 (1975); SECOND SUPPLEMEN-
TARY REPORT, supra note 30, at 205-06.
68. H.R. REP. No. 1476, supra note 3, at 50. The question of copyright or
other protection for typeface designs had stirred considerable controversy during
the latter stages of the revision effort. Of particular concern was the possi-
bility of "creating exclusive rights for a few big manufacturers, who would use
them to enforce tying arrangements between their machines and fonts," and
the specter of "suits to enjoin publication of printed matter" composed from in-
fringing type. SECOND SUPPLEMENTARY REPORT, supra note 30, at 201.
69. H.R. REP. No. 1476, supra note 3, at 50. The Conference Committee ac-
an invitation to try again.70

The legislative energy necessary to grapple with the issue of design protection was apparently exhausted in the formulation of Title II. In the copyright revision bill itself, there was old wine in old bottles. The cornerstone of the revision bill's approach to copyright in useful articles was a narrow codification of Mazer,71 which Congress read as holding "that works of art which are incorporated into the design of useful articles, but which are capable of standing by themselves as art works separate from the useful article, are copyrightable."72 The "works of art" classification of the 1909 Act was abandoned and replaced by a reference to "pictorial, graphic, and sculptural works."73 This new category endeavored to supply "as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design."74 The line, however, was neither clear nor new. After declaring that "pictorial, graphic, and sculptural works" included works of "applied art," the definition stated:

[T]he design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.75

70. The issues raised by Title II have not been resolved by its deletion from the Copyright Revision Bill. Therefore, the Committee believes that it will be necessary to reconsider the question of design protection in new legislation during the 95th Congress. At that time more complete hearings on the subject may be held and, without the encumbrance of a general copyright revision bill, the issues raised in Title II of S. 22 may be resolved. H.R. REP. No. 1476, supra note 3, at 50. "The full range of design protection issues, however, stands as one of the most significant and pressing items of unfinished business now on the Congressional agenda." Ringer, The Unfinished Business of Copyright Revision, 24 U.C.L.A. L. Rev. 951, 976 (1977). For the latest effort, see H.R. 20, 97th Cong., 1st Sess. (1981), reprinted in 2 COPYRIGHT L. REP. (CCH) ¶ 20,097 (1981).

71. "Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise." 17 U.S.C. § 113(a) (1976). See also 17 U.S.C. § 101 (1976) (definition of "pictorial, graphic, and sculptural works").

72. H.R. REP. No. 1476, supra note 3, at 50.


74. H.R. REP. No. 1476, supra note 3, at 55. The Report refers to the effort to achieve clear lines and distinctions twice in the space of three paragraphs, apparently seeking credit at least for good intentions.

75. 17 U.S.C. § 101 (1976). In its entirety, the definition states:
The administrative regulations of the 1950's were now formally codified in the Copyright Act of 1976.\textsuperscript{76}

The legislative history sheds additional light on the familiar criteria of separate identity and independent existence. Two-dimensional graphic works and three-dimensional carvings or statues incorporated into utilitarian articles can exist independently as works of art and are thus eligible for copyright.\textsuperscript{77} Congress was unmistakably clear, however, that it intended to exclude industrial design from the subject matter of copyright:

On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.\textsuperscript{78}

The reference to "physically or conceptually" separable elements perhaps extended prior law, but little else was new. "Applied art" was in and "industrial design" was out. Yet at some point the two met, and "separability" had already proven a poor benchmark.

The failure to win protection for industrial design reflects more than the vagaries of the legislative process. Sixty years of unsuccessful lobbying suggests more substantive difficulties.
One can appreciate the reluctance of Congress to subsume industrial design within the scope of copyright, or to authorize a more specialized monopoly, by considering the basic arguments generally used to support the recognition of proprietary rights in intellectual property.

The Constitution, authorizing legislation "To promote the Progress of Science and useful Arts," suggests an incentive rationale designed to encourage artistic and inventive activity through the prospect of exclusive rights in the tangible results of creative efforts. Such stimuli may be necessary, it is argued, when the ease of copying impedes the producer's ability to extract through the market the reward that consumers would otherwise willingly pay. Without protection against copying, there may be less investment of resources in creative activity than society would wish. Such proprietary rights must be limited, of course, or the public will be effectively denied the benefits sought by the constitutional mandate. At this level, the copyright and patent laws reflect a balance between incentive and dissemination through competition.

This economic perspective is sometimes supplemented by moral appeals. The idea of a natural right to the fruits of one's labors, and the aversion to permitting the enrichment of another at the producer's expense, are no less powerful here than in other areas of the law. In the realm of artistic works, there is the further notion that the intimate relationship between art and artist justifies special efforts to preserve the integrity of the work. From both economic and moral vantage points, however, the case for expansive design protection is weak.

The most obvious effect of extending copyright or more specialized protection to the design of commercial products would be the exclusion of such designs from the public domain, thus preventing their free use by competing manufacturers. The necessity of such an artificial incentive, however, is hardly

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81. "The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.'" Mazer v. Stein, 347 U.S. 201, 219 (1954).
82. See Denicola, supra note 30, at 519-20.
84. At present, only those designs capable of meeting the stringent requirements of design patent law may remain outside the public domain. See supra note 30.
In one sense, manufacturers do not have the option of discontinuing the creation of industrial designs, since all products must take on some shape and appearance. Thus the question is not whether manufacturers will design, but rather how large an investment of resources they will devote to the development of designs possessing some particular virtue or appeal. Even without the stimulus provided by the prospect of a statutory monopoly, there appear to be significant incentives to invest in design. If that is indeed the case, restraints on competition may achieve little in the way of increased design activity.

The most obvious incentive to produce appealing designs is the desire to attract customers, since "between two products equal in price, function, and quality, the better looking will outsell the other." Even a design that is merely different rather than "better" may have its advantages, because it may appeal to a desire for diversity or distinctiveness and aid in marketing by differentiating the product from its rivals. By accentuating performance characteristics such as strength, durability, or workmanship, an appropriate design may increase sales even when aesthetic appeal is not a significant consideration. Effort invested in design may also result in enhanced performance or reduced production costs.

Given the obvious advantage of a well conceived product design, the question becomes whether the risk of appropriation by a competitor will nevertheless cause manufacturers to significantly decrease their investment of resources in design activity. For several reasons, the answer may often be "No." The cost of creating an appealing design, for example, may represent only a small fraction of total product development and production costs. With so much at stake, a manufacturer is unlikely to forego the substantial benefits of a well designed product merely because a competitor might gain a marginal advantage.

85. This was the chief justification for the opposition of the Department of Justice to Title II of the revision bill. Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary, 94th Cong., 1st Sess. (1975) (testimony of Irwin Goldbloom), reprinted in 14 OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 139-40 (1977).
87. If the cost of manufacturing a more attractive product is high enough to price the resulting article above the range consumers are willing to pay, however, even a statutory monopoly will not prompt production, if indeed production is desirable. The prospect of a monopoly in a product that cannot be sold at a profit is hardly enticing.
saving through design piracy. If the design is indeed advantageous, even a relatively short lead time may be sufficient to permit recovery of design costs. In addition, the risk of copying may frequently be overstated. Outside the limited reach of design patent law, no legal barrier currently exists to prevent design piracy. Yet variations in product appearance continue to be the norm. Indeed, there are disincentives to copying. Product differentiation may be as valuable to a competitor as to the design originator. Major competitors may be reluctant to tarnish their image by engaging in design piracy, since consumers frequently associate copies with lower quality and desirability. Copying may sometimes cause consumers to confuse the copy with the original, thus creating potential liability in an action for trademark infringement or unfair competition.88 Even when

88. In an effort to forestall confusion and deceit, the common law of unfair competition has long prohibited the copying of nonfunctional product and container shapes that the public has come to associate with a particular manufacturer. See 1 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION § 7:23 (1973). This common law protection, however, was called into question by the Supreme Court's decisions in Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964), and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964). Both decisions indicated that state law could not prohibit the copying of articles left unprotected by federal patent and copyright law, regardless of the potential for consumer confusion. Sears and Compco, however, had little effect on the protection of product shapes under federal trademark law. The Patent and Trademark Office has continued to extend protection to shapes and configurations that function as an indication of source. See, e.g., In re Mogen David Wine Corp., 372 F.2d 539 (C.C.P.A. 1967) (protection denied for lack of source significance); In re Days-Ease Home Product Corp., 197 U.S.P.Q. (BNA) 566 (T.M. Trial App. Bd. 1977) (registration granted for shape of liquid drain opener container). Even shapes and designs that have not been federally registered as trademarks have been able to escape the thrust of Sears and Compco through the invocation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1976), which prohibits any "false designation of origin, or any false description or representation." See, e.g., SK&F, Co. v. Premo Pharmaceutical Laboratories, Inc., 625 F.2d 1055, 1065-66 (3d Cir. 1980); Ives Laboratories, Inc. v. Darby Drug Co., 601 F.2d 631, 641-44 (2d Cir. 1979) (dicta), on remand, 488 F. Supp. 394 (E.D.N.Y. 1980), rev'd on other grounds, 638 F.2d 538 (2d Cir. 1981), rev'd on other grounds, 102 S. Ct. 2182, 2193 (1982) (White and Marshall, JJ., concurring) ("The use of a product or package design that is so similar to that of another producer that it is likely to confuse purchasers as to the product's source may constitute 'false designation of origin'... "); Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1215-16 (8th Cir. 1976), cert. denied, 429 U.S. 861 (1976). With surprising pluck, several courts have simply rejected the rationale of Sears and Compco and continued to offer protection under state unfair competition law. See, e.g., SK&F, Co. v. Premo Pharmaceutical Laboratories, Inc., 625 F.2d 1055, 1064-65 (3d Cir. 1980); Time Mechanisms, Inc. v. Qonaar Corp., 422 F. Supp. 805, 908-10 (D.N.J. 1976); Duo-Tint Bulb & Battery Co. v. Moline Supply Co., 46 Ill. App. 3d 145, 150-51, 360 N.E.2d 798, 802 (1977) (dicta).

The Supreme Court retreated from its unbending approach to preemption in Goldstein v. California, 412 U.S. 546 (1973), holding that the patent and copyright clause did not preclude state protection of "writings," and that the 1909
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copying does occur, its impact may be modest if the utilitarian

Copyright Act did not preempt protection of works that it had left "unattended," since for such works Congress had "drawn no balance." Id. at 570. The Court again considered the relationship between federal and state protection for intellectual property in Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974). After declaring that the constitutional clause did not withdraw from the states all power to regulate with respect to "discoveries," thus completing the analysis of the clause begun by Goldstein, the Court concluded that state protection of intellectual property was not void under the supremacy clause even when extended to areas covered by federal legislation, unless the state scheme clashed with federal objectives. Id. at 478-79.

In the context of federal trademark registration, the Court of Customs and Patent Appeals has on numerous occasions taken pains to point out that trademark protection does not conflict with the objectives of design patent law. See, e.g., In re Honeywell, Inc., 497 F.2d 1344, 1348 (C.C.P.A.), cert. denied, 419 U.S. 1080 (1974); In re World's Finest Chocolate, Inc., 474 F.2d 1012, 1015 (C.C.P.A. 1973); In re Mogen David Wine Corp., 322 F.2d 925, 929-30 (C.C.P.A. 1964). Consequently, there appears to be little danger that even state trademark protection for nonfunctional product shapes is preempted by federal design patent law. See Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc., 428 F. Supp. 689, 699-99 (N.D. Ga. 1976).

The preemptive force of federal copyright law is now delimited by section 301 of the Copyright Act of 1976, 17 U.S.C. § 301 (1976). State protection of works within the subject matter of copyright is preempted if the rights afforded are equivalent to copyright. One might argue that since the design aspects of useful articles are copyrightable only if separable from the utilitarian aspects of the object, nonseparable designs are thus not within the subject matter of copyright. See Vermont Castings, Inc. v. Evans Prods. Co., 215 U.S.P.Q. (BNA) 758 (D. Vt. 1981). See also Leonard Storch Enterprises, Inc. v. Mercenthaler Linotype Co., 202 U.S.P.Q. (BNA) 623 (E.D.N.Y. 1979) (1909 Act). Cf. Goldstein, Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright, 24 U.C.L.A. L. Rev. 1107, 1118-20 (1977) (making an analogous argument with respect to ideas, procedures, and other contributions expressly excluded from copyright by 17 U.S.C. § 102(b) (1976)). Such an approach, however, ignores the basic premise of the subject matter test. Essentially a codification of Goldstein, the test is apparently intended to permit state regulation of areas left "unattended" by copyright law. Yet Congress has in fact drawn a balance with respect to industrial designs, excluding all nonseparable elements from protection. The viability of state laws touching industrial design should therefore turn on whether the state rights are "equivalent" to copyright.

Since relief under principles of state trademark or unfair competition law generally requires a showing of consumer confusion or deception, these state regimes have not been considered "equivalent" to copyright protection for purposes of section 301. See, e.g., DC Comics, Inc. v. Filmination Associates, 486 F. Supp. 1273, 1278 (S.D.N.Y. 1980); John H. Harland Co. v. Clarke Checks, Inc., 207 U.S.P.Q. (BNA) 664, 668 (N.D. Ga. 1980). Thus the traditional common law protection extended to nonfunctional product shapes and features that have acquired source significance is not preempted by current copyright law. Occasionally, however, despite the consumer confusion rhetoric, protection appears to rest primarily on a notion of misappropriation through unauthorized copying. See, e.g., Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc., 428 F. Supp. 689, 694 (N.D. Ga. 1976); Denicola, Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols, 1982 Wis. L. Rev. 158, 166-81. When the misappropriation rationale is surreptitiously implemented by means of federal law, such as sections 32 or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114, 1125(a) (1976), see, e.g., Boston Professional
qualities of the original cannot be duplicated because of mechanical patent or trade secret protection, or because of the copier's less sophisticated production capabilities.

The moral claims to industrial design protection are also significantly weaker than those that might be made with respect to other artistic works. The threat of unjust enrichment is less worrisome than in other contexts, since we associate industrial design with the well-lighted drafting rooms of large commercial entities, and thus there are no images of starving novelists or destitute painters to tug at our heartstrings. For similar reasons, we are less concerned with artistic reputation or integrity. On a less emotional level, the arguments offered suggest that both the risk of appropriation and the extent of the potential harm are generally less for the industrial designer than for the novelist, movie producer, or songwriter. Finally, the exclusion of industrial design from the scope of copyright need not be taken as an indictment of its validity or importance. The law of intellectual property covers but a small portion of the full range of creative activity, and there is no dishonor in joining the theories of Einstein or the insights of Freud in the public domain.

Copyright protection for industrial design would also present severe practical difficulties. The idea-expression dichotomy and the "substantial similarity" test of copyright infringement may be too ephemeral to adequately protect legitimate competitive interests, particularly when commercial realities limit the


89. [T]he fact that a product of the mind has cost its producer money and labor, and has a value for which others are willing to pay, is not sufficient to ensure to it this legal attribute of property. The general rule of law is, that the noblest of human productions—knowledge, truths ascertained, conceptions, and ideas—become, after voluntary communication to others, free as the air to common use.

International News Serv. v. Associated Press Inc., 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting). See, e.g., 17 U.S.C. § 102(b) (1976) ("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.").
range of design alternatives. In addition, the specter of infringement may actually inhibit experimentation with new designs, or require additional expenditures to assess potential legal risks.

The arguments for and against design protection are long-standing. They inevitably rest on a host of assumptions that cannot possibly hold across the wide range of goods and markets encompassed by the controversy. The fact remains, however, that Congress has emphatically declined to extend copyright protection to industrial design, and the Copyright Act of 1976 must be construed in light of that fundamental decision. Yet, care must be taken to avoid indiscriminate application of the statutory exclusion to works whose origins lie beyond the confines of the design process.

B. CONVENTIONAL MODELS

The Copyright Office regulation that introduced the separability test, following the Supreme Court decision in Mazer v. Stein, excluded from the "works of art" classification any article whose "sole intrinsic function is its utility." That formulation, however, had the disquieting potential to defeat all efforts to bar industrial design from the scope of copyright. Given judicial reluctance to assess artistic merit, there was no ready response to the claims of industrial designers that their work was not solely utilitarian, since it was also offered as art. An object serving aesthetic as well as utilitarian ends appeared beyond the reach of the regulatory limitation. Obviously, the administrative intent was not to abandon the grist for its mill, but the difficulty did underscore the primitive nature of the doctrinal machinery.


The concept of a useful article, as embodied in the "sole intrinsic function" standard, played a role in an important 1966 decision that provided designers a welcome precedent. In Ted Arnold Ltd. v. Silvercraft Co., the court recognized copyright in the casing of a pencil sharpener simulating the appearance of an antique telephone: "[W]e would not agree with defendant that its 'sole intrinsic function... is its utility.' Customers are paying fifteen dollars for it, not because it sharpens pencils uncommonly well, but because it is also a decorative conversation piece."94

As the revision effort was nearing its conclusion, another case tested the bounds of the useful article classification. Esquire, Inc. v. Ringer was a mandamus action to compel the Register of Copyrights to issue a registration for the design of an outdoor lighting fixture "of pleasing shape... well suited to accompany structures of so-called functional design." The Copyright Office denied registration on the ground that the work lacked features that could be identified separately as art. Esquire argued that its fixtures were modern sculptures, and thus their "sole intrinsic function" was not utility. The district court apparently agreed: "These outdoor lights serve both to decorate and to illuminate. Indeed, during the day they are exclusively decorative." On appeal, however, Esquire's summary judgment was reversed. In a novel interpretive maneuver, the court alluded to the deletion of the word "sole" in the revision bill's definition of "useful article," and proceeded to construe the existing regulation in light of the as yet inoperative statutory formulation.98

The separability test contained in the 1976 Act's definition of "pictorial, graphic, and sculptural works" is by its terms applicable to copyright in the design of a "useful article." The latter is described in section 101 as "an article having an intrinsic function that is not merely to portray the appearance of the article or to convey information." The substitution of "an intrinsic function" for "sole intrinsic function" avoids the embar-

94. Id. at 736 (footnote omitted).
97. Id. at 941.
98. 591 F.2d at 804.
100. Id. (definition of "useful article").
rassment caused by the prior formulation, but only at the expense of introducing new discomfort. If the Copyright Office regulation arguably left nothing subject to the separability test, the statutory definition may render it applicable to virtually all three-dimensional works. Almost any sculptural work can be put to functional uses ranging from bookends or doorstops to paperweights or architectural elements. Unless the Delphic reference to "intrinsic function" is shamelessly exploited, few objects will escape this new formulation. Indeed, one court has already held that a toy plane is a "useful article" under the 1976 Act, since children can use the plane to develop their imagination.

These definitional difficulties illustrate two points about copyright in utilitarian objects. The most obvious is that useful articles do not comprise a distinct class easily isolated from other forms of authorship. Definitions can do little more than focus attention on one portion of a spectrum ranging from bicycles to busts of Beethoven. As a result, the issue of copyright in utilitarian articles cannot be evaded by semantic stratagems and even eventual passage of sui generis design legislation or the overhaul of the existing design patent regime cannot eliminate the copyright implications of aesthetically pleasing useful objects. The definitional debate also has less obvious implications. Despite the knowledge that a bust of Beethoven may be useful in holding down papers or holding up books, an analogy to the design of baby carriages or food processors strikes us as silly. We feel confident that the specialized legislative machinery is inappropriate for such a work, regardless of the difficulties inherent in formulating a less inclusive definition. Even if the statutory description of useful articles should happen to encompass all three, we would expect the bust to survive the subsequent analysis with full copyright protection intact. Our instincts suggest a helpful insight. We may feel comfortable extending protection to the appearance of the bust

101. See supra text accompanying note 92.
despite its possible usefulness in part because its form is independent of its utility. The bust is thus distinguishable, quantitatively if not qualitatively, from carriages or kitchen appliances whose forms are more intimately responsive to function. As Part III of this Article suggests, this notion of the relative independence of form and function may provide a rational perspective on the otherwise largely irrational dictates of the separability test. The 1976 Act obliges both the Copyright Office and the courts to continue their efforts to distinguish applied art and industrial design. The only assistance the Act offers, however, is the statement that the design of a useful article is protectible only to the extent that it “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.”

Because Mazer provided the focal point for the congressional analysis, it is tempting to approach the separability test in essentially physical terms. In Mazer, the dancing figures at issue could be physically separated from the utilitarian objects into which they had been incorporated by the twist of a socket and a sharp tug on an electric cord. Reliance on this simplistic notion of physical separation, however, is misplaced. The legislative history unequivocally indicates that pictorial works adorning useful articles are entitled to copyright, yet the pattern dyed into a bolt of cloth or painted on a china cup cannot be physically detached from the object itself. In addition, some features of utilitarian objects that can be physically separated are clearly not intended to fall within the scope of copyright. An ordinary television cabinet may be physically removed from the set itself, yet protection will not be forthcoming. Physical separability is a poor touchstone, inaccurate as a descriptive concept, and devoid of normative implications. The legislative history acknowledges the necessity of a more esoteric approach, referring at one point to “some element that, physically or conceptually, can be identified as separable.” The notion of conceptual separability, however, can be little more than an invitation to thoughtful analysis. It has meaning only in the

105. Professor Nimmer argues that even the dancing figures in Mazer could not pass muster under a test of strict physical separability from the utilitarian aspects of the article since the statuettes, by virtue of their use as lamp bases, are a utilitarian feature of the object. 1 M. Nimmer, supra note 83, § 2.08[B][3].
context of a specific normative theory or model. Although there has been no shortage of such models, each with its own advantages, none appears able to discharge satisfactorily the legislative mandate.

One possible approach to the separability criterion is to interpret it as an inquiry into one's willingness to recognize the design as art, in spite of its utilitarian properties. This approach was urged by the lighting manufacturer in *Esquire*. The effect of this approach, however, is to bring the analysis full circle to the 1909 Act's "works of art" classification. If any design that might be labelled "art" is automatically treated as conceptually separable from the utilitarian aspects of the object, one is left with a dilemma. If judges continue to shun evaluations of merit or worth, the test will cease to be a meaningful barrier to copyright in industrial design, a result clearly in conflict with the legislative intent. If judges instead accede to the role of art critics, discrimination against nonrepresentational art will become inevitable. While judges may likely recognize as art a lamp base in the form of a human figure, they are less likely to accord similar recognition to an abstract shape, equally unresponsive to function, particularly if it "looks like" a lamp base. This is precisely the danger foreseen by Justice Holmes, and echoed in *Mazer* and the district court decision in *Esquire*. Perhaps, as the appellate court in *Esquire* rationalized, there is less need for concern when the disparate treatment results from the application of a standard that is not itself dependent on artistic judgments, but that observation offers no comfort here. Decisions on copyrightability would rest entirely on judicial perceptions of artistic value, an approach at odds with the legislative directive that the category of "pictorial, graphic, and sculptural works" carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic

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107. "Esquire on the other hand, interprets § 202.10(c) to allow copyright registration for the overall shape or design of utilitarian articles as long as the shape or design satisfies the requirements appurtenant to works of art—originality and creativity." 591 F.2d at 806 (footnote omitted).

108. Indeed, this was essentially the position initially adopted by the Copyright Office in response to the *Mazer* decision. Before being replaced by the separability standard, copyright in the shape of a useful article was permitted only "where the object is clearly a work of art in itself." 37 C.F.R. § 202.10(c) (Supp. 1956).


110. See supra note 10.

111. 414 F. Supp. at 941.

112. 591 F.2d at 805. The standard utilized to settle Esquire's claim barred copyright for the "overall design or configuration" of all utilitarian objects. *Id.*
quality.”113 The approach urged by the manufacturer in Esquire, which would extend copyright to any design deserving of the appellation “art,” simply cannot implement the legislative distinction between applied art and industrial design embodied in the separability test.114

The vision of administrators or judges assessing the aesthetic merits of coffee pots and home computers has prompted numerous alternative models of the separability criterion. An aura of objectivity can be regained by transforming the judicial role from critic to pollster, and various formulations thus have emphasized consumer judgments. In its most expansive form, this approach may simply focus on consumer evaluations of aesthetic appeal, measured perhaps by success in the marketplace.115 This approach, of course, merely taps an alternative source of critical evaluation without overcoming the inherent objections to conditioning legal protection on aesthetic appeal or interest. One would hardly expect the legal status of Star Wars or Macbeth to be determined by their showing at the box office.

A slightly more refined approach might attempt to dispense with the necessity of individual aesthetic appraisals by establishing general categories of commercial products for which aesthetic appeal carries particular significance.116 Protection

113. H.R. REP. No. 1476, supra note 3, at 54.
114. The position of the Register of Copyrights and the District of Columbia Circuit Court, excluding the overall shape of all utilitarian objects, however, is equally unavailing. See infra notes 128-48 and accompanying text.
115. “We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles’ wearers who have used them as ornamentation for parts of the body other than the waist.” Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980). “Customers are paying fifteen dollars for it, not because it sharpens pencils uncommonly well, but because it is also a decorative conversation piece.” Ted Arnold Ltd. v. Silvertcraft Co., 259 F. Supp. 733, 736 (S.D.N.Y. 1966) (copyright upheld in pencil sharpener simulating antique telephone). Appeals to consumer evaluations of commercial designs are not unique to this country. “A work of craftsmanship suggests to me a durable, useful, handmade object and a work of artistic craftsmanship suggests something, whether of practical utility or not, which its owner values because of its artistic character.” George Hensher Ltd. v. Restawhile Upholstery Ltd., [1974] 2 All E.R. 420, 423.
could then be extended in a nondiscriminatory manner to all
designs in selected markets. This approach, however, is only
marginally less troublesome than direct appeal to consumer
taste. Because the marketability of almost any product is de-
pendent to some degree on its physical attractiveness, classifi-
cation would be hopelessly arbitrary.\textsuperscript{117} Even if limited to
products traditionally reflecting a special concern for aesthetics,
this model would sweep far wider than the legislative in-
tent. Purchases of automobiles, kitchen appliances, and
furniture, for example, often rest on little more than an appeal-
ing appearance, yet their designs do not generally meet the leg-
islative vision of separability.\textsuperscript{118}

A narrower form of this market perspective was suggested
by \textit{Kieselstein-Cord v. Accessories by Pearl, Inc.}.\textsuperscript{119} In that case
the plaintiff successfully obtained copyright registrations for
the design of two elaborately sculptured belt buckles. In an ac-
tion for copyright infringement, however, the district court
granted summary judgment for the defendant, holding that the
buckles could not satisfy the separability standard.\textsuperscript{120} The Sec-
ond Circuit disagreed:

We see in appellant’s belt buckles conceptually separable sculp-
tural elements, as apparently have the buckles’ wearers who have used
them as ornamentation for parts of the body other than the waist. The
primary ornamental aspect of the Vaquero and Winchester buckles is
conceptually separable from their subsidiary utilitarian function.\textsuperscript{121}

\textit{Kieselstein-Cord} appears to offer the prospect of protection
whenever the ornamental aspects of the design are of “pri-

\textsuperscript{117} See, e.g., \textit{R. Loewy}, supra note 86, at 119 (sales increase attributed to
more attractive design for car battery).

\textsuperscript{118} H.R. Rep. No. 1476, supra note 3, at 55.

\textsuperscript{119} 632 F.2d 989 (2d Cir. 1980). Photographs of the articles are reproduced
in 632 F.2d at 995, a helpful practice all too uncommon in the case reports.
Reading both the trial and appellate opinions in \textit{Esquire}, for example, is not un-
like attempting to comprehend a book on modern architecture, painting, or
sculpture without examining the illustrations.

\textsuperscript{120} 489 F. Supp. 732, 736 (S.D.N.Y.), rev’d, 632 F.2d 989 (2d Cir. 1980). The
court held that the copyrightability of one of the buckles was determined by
the 1909 Act and accompanying regulations, while the 1976 Act was applicable
to the second of plaintiff’s two designs, although it found the test for
copyrightability “to be virtually the same.” 489 F. Supp. at 735. As Professor
Nimmer notes, however, although the court’s decision to apply the 1909 Act to
the first buckle was correct, its justification was not. 1 M. \textit{Nimmer}, supra note
83, \S 2.08[B][3] n.106.2.

\textsuperscript{121} 632 F.2d at 993.
mary" importance to the consumer. Although this formulation would presumably exclude the design of most common useful objects, it too fails to provide a satisfactory approach to separability. Attempts to determine an article's "primary" attraction to consumers will frequently prove fruitless. There is no reason to expect anything approaching unanimity on such an issue, and even individual consumers generally will have mixed motives that cannot be neatly ranked in the required hierarchy. Does the "ornamental aspect" of an expensive sofa, for example, become "primary," and its utilitarian function "subsidiary," if its owner permits no one to sit on it?122

Professor Nimmer offers a still narrower model linking copyright to consumer appeal, suggesting that "conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities."123 Professor Nimmer acknowledges, however, that his approach is not without its difficulties.124 It cannot avoid the evidentiary problems that trouble all models emphasizing consumer judgments and motivations. Moreover, the difficulty with Nimmer's approach is particularly acute, since the standard generally will require conclusions concerning markets that do not in fact exist. The predictive nature of the inquiry can only underscore the significance of judicial perceptions of beauty and taste.

At a more fundamental level, it is not apparent why a willingness to purchase a nonfunctional version of the design ought to be the touchstone for protection. This standard, together with other variations on the marketability theme, is essentially a measure of the success or desirability of the design. Since the congressional decision to exclude industrial design per se from the scope of copyright reflects a desire to ensure vigorous competition in the marketing of commercial products, a test that predicates protection on the appeal or success of the design appears counterproductive. Marketability, whether or not considered apart from the utilitarian aspects of the article,

122. See George Hensher Ltd. v. Restawhile Ltd., [1974] 2 All E.R. 420, 430 ("I do not think that whether or not a work is to be regarded as artistic depends on whether or not the primary inducement for its acquisition or retention is its functional character.").

123. 1 M. Nimmer, supra note 83, § 2.08[B][3]. Such an approach had been suggested, and questioned, even before the Supreme Court's decision in Mazer. See Note, Protecting the Artistic Aspects of Articles of Utility: Copyright or Design Patent?, 66 Harv. L. Rev. 877, 882 n.33 (1953).

124. 1 M. Nimmer, supra note 83, § 2.08[B][3].
is irrelevant to the legislative distinction between applied art and industrial design. The walls of numerous garages and basements, for example, attest to the attraction of well-polished hubcaps, yet that should not automatically remove such objects from the realm of industrial design. On the other hand, works of applied art that are clearly copyrightable, such as graphic designs on china or fabrics, may well be unmarketable as pure works of art. Attempts to equate the statutory requirement of separability with consumer assessments of merit or value are simply incompatible with the legislative decision to eschew aesthetic distinctions.

The case law, however, offers one approach to the separability criterion that avoids reliance on aesthetic judgments, if only through the sheer irrationality of its distinctions. The theory is most extensively articulated in Esquire, Inc. v. Ringer. In response to the plaintiff's claim that the designs of its outdoor lighting fixtures were copyrightable works of art, the Register of Copyrights argued that the overall shape of utilitarian articles is never eligible for copyright. Although technically decided under the 1909 statute, the Court of Appeals for the District of Columbia concluded that the Register's contention accurately reflected the scope of copyright under both the 1909 and 1976 Acts. Mazer was of no help to the plaintiff, the court reasoned, because that case had dealt only with "a 'feature' segregable from the overall shape of the table lamps."

The appeal of such an approach is obvious. It avoids the specter of copyright in "the whole realm of consumer products . . . and industrial products" without the necessity of appraising the artistic merits of their overall designs. The 1976 Act appears to offer some limited support for such an unbending approach. The definition of "pictorial, graphic, and sculptural works" refers to "features that can be identified

126. After viewing a photograph of one of the Mazer statuettes, see R. Brown, Kaplan and Brown's Cases on Copyright 136 (1978), one might well disagree with Professor Nimmer's conclusion that the statuette "would still be marketable to some significant segment of the community simply because of its aesthetic qualities," 1 M. Nimmer, supra note 83, § 2.08 [B] [3].
129. Id. at 803.
130. Id. at 805.
131. Id. at 801.
separately,"\textsuperscript{132} arguably alluding to something less than the overall shape of the useful object, even though this follows the statement "[s]uch works shall include works of artistic craftsmanship insofar as their form . . . are concerned."\textsuperscript{133}

The \textit{Esquire} rationale has been used to deny copyright protection to the overall shapes of numerous articles, including hubcaps,\textsuperscript{134} mechanical games,\textsuperscript{135} and toy airplanes.\textsuperscript{136} It was also cited in the district court opinion denying copyright in the overall design of the Kieselstein-Cord belt buckles.\textsuperscript{137} The complete excision of overall shapes suggested by \textit{Esquire}, however, is difficult to reconcile with a considerable number of cases decided under the 1909 Act, and \textit{Esquire} itself concluded that the 1976 revision merely codified existing standards.\textsuperscript{138} The overall shapes of coin banks, for example, have consistently been granted protection when the prerequisites for copyright have been met, despite their apparent status as "useful

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\textsuperscript{132} 17 U.S.C. § 101 (1976) (definition of "pictorial, graphic, and sculptural works").

\textsuperscript{133} \textit{Id.} (emphasis added). The legislative history similarly refers to "elements" that may be identified separately from the utilitarian aspects of the article. H.R. Rep. No. 1476, \textit{supra} note 3, at 55. The report further states that "copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such." \textit{Id.} This, however, appears to be merely a statement of the simple truism that when only a portion of a work is copyrightable, the statutory protection extends to that portion alone. \textit{Cf.} 17 U.S.C. § 103(b) (1976) (stating a similar principle for works containing non-original material). If the overall shape itself is separable from the utilitarian aspects of the work, the limitation is simply inapplicable. Indeed, the report itself speaks of copyright in works "employed as the design of a useful article." H.R. Rep. No. 1476, \textit{supra} note 3, at 103.

\textsuperscript{134} \textit{See} Norris Indus., Inc. v. Int'l Tel & Tel Corp., 212 U.S.P.Q. (BNA) 754 (N.D. Fla. 1981), \textit{aff'd}, 696 F.2d 918 (11th Cir. 1983).

\textsuperscript{135} \textit{See} Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980).

\textsuperscript{136} \textit{See} Gay Toys, Inc. v. Buddy L Corp., 522 F. Supp. 622 (E.D. Mich. 1981). Despite the court's unwavering confidence ("Clearly, without question, the defendant's toy airplane is both useful and utilitarian," \textit{Id.} at 625.), its conclusion that the toy is a "useful article" is open to serious question. "A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article . . ." 17 U.S.C. § 101 (1976) (definition of "useful article"). Whatever utility the toy may have derives entirely from the fact that it portrays the appearance of an airplane, thus apparently falling squarely within the statutory exception. Reference to separability and independent existence is therefore unnecessary. \textit{See, e.g.}, Monogram Models, Inc. v. Industro Motive Corp., 492 F.2d 1281 (6th Cir.), \textit{cert. denied}, 419 U.S. 843 (1974) (copyright upheld in model airplane kit).

\textsuperscript{137} \textit{See} Norris Indus., Inc. v. Int'l Tel & Tel Corp., 696 F.2d 918 (11th Cir. 1983); Kieselstein-Cord v. Accessories by Pearl, Inc., 489 F. Supp. 732, 736 (S.D.N.Y. 1980).

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articles." The shapes of pajama bags and of molds employed in the manufacture of ceramic figures, together with ring boxes, and the antique telephone shape utilized for the pencil sharpener in *Ted Arnold Ltd. v. Silvercraft Co.*, have all been accepted for registration by the Copyright Office. The Second Circuit also repudiated the attempt to exclude the overall shape of useful objects from the scope of copyright in *Kieselstein-Cord*, in which the court held that the overall shapes of the plaintiff’s belt buckles were copyrightable under both the prior and present statutes. A more recent case indicates that the overall shape of eyeglass display cases may also be copyrightable.

The distinction between product features and overall shape or design suggested in *Esquire* cannot be translated into a coherent model of the separability test. On a literal level, the “distinction” cannot be reconciled with the definitional structure of the 1976 Act. The statutory description of a “useful article” concludes with the statement: “An article that is normally a part of a useful article is considered a ‘useful article.’”

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143. 259 F. Supp. 733 (S.D.N.Y. 1966). The court in *Esquire* attempted to distinguish *Ted Arnold* by arguing that the telephone casing could be physically separated from the sharpening mechanism housed within. 591 F.2d at 802 n.19. Indeed, the opinion suggests that if *Esquire* itself had specifically limited its application to the housing of its lighting fixtures, excluding the base, electric components and light bulb, a different case would have been presented. *Id.* at 806. The concession, however, completely undermines the overall shape rationale used to justify the court’s decision. The Copyright Act itself precludes protection of the “mechanical or utilitarian aspects” of “pictorial, graphic, and sculptural works.” 17 U.S.C. § 101 (1976) (definition of “pictorial, graphic, and sculptural works”). Mechanical entrails can be removed from a multitude of consumer and industrial products, leaving cabinets or casings that would then be entitled to copyright. If the elimination of wiring, transistors or gears is sufficient to satisfy the separability test, a broad segment of industrial design will fall within the scope of copyright. It is unlikely that the *Esquire* court would actually countenance such a result.

144. 632 F.2d at 994.


tending protection to even a "feature" of a utilitarian product, such as the design of a handle or control knob or, presumably, a lamp base, is thus by definition permitting copyright in the overall shape of a "useful article." On a more substantive level, the proscription against copyright in overall shapes or designs is not an accurate reflection of the legislative intent. Congress clearly did not wish to disturb the protection accorded the Balinese dancing figures in *Mazer v. Stein.* Assume, however, that the plaintiffs operated a more diversified enterprise, offering in addition to their table lamps a companion cigarette lighter in which the head of an identical figure lifts to expose the internal mechanism. The statuette is now the overall shape of a useful article. It seems absurd to contend that the statuette is copyrightable in one context but not the other, merely because the utilitarian aspects have been internalized. And if the point is conceded for a Balinese dancer, what of a more abstract form reflecting twentieth rather than nineteenth century visions? The only justification for the whimsical approach espoused in *Esquire* is the desire for a levee to hold back the flood. There are, however, more discriminating barriers.

III. APPLIED ART AND INDUSTRIAL DESIGN

A. THE DESIGN PROCESS

The objective of the separability test, according to its legislative history, is to divide copyrightable "applied art" from uncopyrightable "industrial design." Rational application of the standard thus requires some appreciation of the distinctive nature of industrial design.

In a sense, the origins of industrial design can be traced to the earliest attempts to fashion natural materials into more useful forms. Not until the Industrial Revolution brought the capacity to manufacture unlimited quantities of identical products, however, did a discreet conception of industrial design begin to emerge. Initially, industrial design was little more than a belated attempt to conceal the patent ugliness prolifer-
ated by developing technologies.151 This concept of industrial
design as decoration, however, was gradually replaced by a vi-
sion premised on a more intimate relationship between the na-
ture of a product and its appearance. In 1894, Frank Lloyd
Wright declared that "the machine is here to stay," and chal-
 lenged the designer to "use this normal tool of civilization to
best advantage instead of prostituting it as he has hitherto
done in reproducing with murderous ubiquity forms born of
other times and other conditions."152 The twentieth century
soon saw industrial design become an integral aspect of prod-
cut development.153

The dominant feature of modern industrial design is the
merger of aesthetic and utilitarian concerns. It is the influence
of nonaesthetic factors, the nexus between what the product
must do and how it must look, that distinguishes true industrial
design from other artistic endeavors. The industrial designer
as engineer—a perspective no less valid than industrial de-
signer as artist—is subject to the functional constraints inher-
ent in each undertaking. The designer cannot follow wherever
aesthetic interests might lead. Utilitarian concerns influence,
and at times dictate, available choices. Indeed, aesthetic suc-
cess is often measured in terms of the harmony achieved be-
tween competing interests.154 The merger of aesthetics and
utility defines the designer's craft, so that "[w]hatever else he
is or isn't—artist, engineer, salesman, planner, management
consultant, inventor—the industrial designer is a problem
solver."155

The most obvious factor influencing and directing the de-
signer's creativity is the necessity of accommodating the func-
tional operation of the product. At its most fundamental level,
this consideration simply excludes any form that significantly
interferes with the utility of the article. Modern approaches to
industrial design, however, generally seek a relationship be-

151. "Looking at the machine, they saw a new thing, a thing that seemed to
cry out for decorative embellishments. These decorations were usually gar-
ered from classical ornaments and from major raids into the animal and vege-
table kingdoms. Thus, giant hydraulic presses dripped with acanthus leaves,
pineapples, stylized wheat sheaves." V. PAPANEK, supra note 150, at 23.
152. Id.
153. Id. at 23-24.
154. "All design is a compromise of conflicting requirements and the most
satisfying results are those where the priorities of the conflicting needs have
been correctly assessed . . . ." F. ASHFORD, THE AESTHETICS OF ENGINEERING
155. INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, DESIGN IN AMERICA 5
between form and function far more intimate than simple compatibility. Raymond Loewy, perhaps the design profession's most celebrated practitioner, speaks of the "natural form" and "self-expression of the machine." The notion of form reflecting function is a basic tenet of contemporary design: "The best designs are those in which the appearance springs truly from the structure, and is a logical expression of it." Perusal of any of the multitude of books collecting illustrations of "modern" design confirms the general acceptance of this fundamental credo. The notion of expressing function through form differs in an important respect from the more primitive requirement that form be compatible with function, since the former is itself a purely aesthetic concern, expressing one conception of "good" design. In this sense, the principle suggests limitations not unlike those imposed on any artist by internal or external conceptions of artistic merit or worth. When practiced, however, the principle operates to intensify the nexus between form and function.

Other utilitarian considerations can, of course, be identified: "[T]he following things should be treated respectfully: function, ease of operation, maintenance, cost of upkeep, storage, cost of manufacturing, packing, shipping, display, safety, fail-safe operations, . . . all these and more are involved in doing the job properly . . . ." Such concerns can be served poorly or well, but they cannot be ignored. Their cumulative influence can render the designer's task quite unlike that confronting the painter or sculptor.

156. R. LOEWY, supra note 86, at 13.
158. See, e.g., K. BAYNES, supra note 150; INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, supra note 155; R. LOEWY, supra note 86; PENTAGRAM DESIGN PARTNERSHIP, PENTAGRAM: THE WORK OF FIVE DESIGNERS (1972).
159. Other purely aesthetic considerations may, of course, be operative. The designer may feel constrained by current trends in fashion or taste. See, e.g., F. ASHFORD, supra note 154, at 114-16; R. LOEWY, supra note 86, at 34. Aesthetic options may also be limited by a desire to maintain a particular corporate design style, see F. HENRION & A. PARKIN, DESIGN COORDINATION AND CORPORATE IMAGE (1966), or to relate the appearance of components or accessories.
B. Copyright in Useful Articles

The legislative history describes the separability test as an attempt "to draw as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design."\(^{161}\) In truth, of course, there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns. Only a model appealing directly to the considerations underlying the separability standard can avoid purely arbitrary distinctions.

Taking *Mazer* as its touchstone, Congress sought to isolate pictorial, graphic, and sculptural works that are "incorporated into a product,"\(^{162}\) or "employed as the design of a useful article."\(^{163}\) Congress thus attempted to distinguish artistic works that are merely utilized in the design process from those that result from the process itself. The distinction could, of course, be implemented by excluding all works created with some utilitarian application in view, but this would overturn *Mazer*, together with a host of other eminently sensible decisions, in favor of an intractable factual inquiry of questionable relevance. Any such categorical approach would also undermine the legislative determination to preserve an artist's ability to exploit utilitarian markets.\(^{164}\) Alternatively, the statutory directive requires a distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear. Copyrightability, therefore, should turn on the relationship between the proffered work and the process of industrial design. Because the dominant characteristic of industrial design is the influence of nonaesthetic, utilitarian concerns, copyrightability ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations. Only such a direct assessment of the nature of the claimant's contribution can implement the congressional decision to exclude the general realm of industrial design, while preserving exclusive rights in "applied art."

Analysis of the relationship between form and function is not new to copyright law. In an effort to avoid monopolization of functional attributes, the law has long denied protection in instances in which utilitarian requirements *dictated* a particu-

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\(^{161}\) H.R. REP. NO. 1476, supra note 3, at 55.
\(^{162}\) Id.
\(^{163}\) Id. at 105.
The relationship between form and function, however, is seldom so direct. Typically, a variety of forms will be compatible with functional objectives. The choice is thus constrained rather than dictated. The separability test, devised to exclude industrial design from the scope of copyright, suggests that even this weaker relationship between form and function is sufficient to preclude protection. The statutory criterion limiting protection to "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article" should therefore be viewed as an attempt to identify elements whose form and appearance reflect the unconstrained perspective of the artist. Such features are not the product of industrial design; their form is not responsive to nonaesthetic interests. They are in this sense pure art, regardless of the context in which they appear. Two-dimensional graphic works appearing on useful articles, for example, do not fall within the statutory exclusion because their appearance is not affected by functional concerns. Only artistic motives influence the choice of flowers, birds, or geometric patterns. Similarly, the Mazer statuettes remain copyrightable despite their use as lamp ba-

165. See, e.g., Brown Instrument Co. v. Warner, 161 F.2d 910, 911 (D.C. Cir.), cert. denied, 332 U.S. 801 (1947); Taylor Instrument Co. v. Fawley-Brost Co., 139 F.2d 98, 100 (7th Cir. 1943), cert. denied, 321 U.S. 785 (1944). "The Copyright Office has taken the position that calculating and measuring devices such as slide rules, wheel dials, etc. may not claim copyright where the elements appearing on the device (e.g., calibrations, numbers in regular progression, etc.) are necessary functional expressions of the underlying mathematical principle, formula or other 'idea.'" 1 M. NiMMA, supra note 83, § 2.08[D][1] n.158. Similarly, the Copyright Office has refused to register the patterns imprinted on integrated circuit chips because of "the danger that the desired protection could go beyond the purpose of copyright." Hearings on H.R. 1007 Before the Subcommittee on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary, 96th Cong., 1st Sess. (1979) (testimony of Jon Baumgarten, General Counsel, Copyright Office), reprinted in 2 Copyright L. Rep. (CCH) ¶ 20,029, at 10,049 (1979). The limitation is sometimes implemented by holding that "forms of expression dictated solely by functional considerations" do not evince the originality or creativity essential to copyright. 1 M. NiMMA, supra note 83, § 2.01[B]. The attempt to avoid monopolization of functional characteristics is part of the more general attempt to preclude the extension of copyright to "ideas." See Baker v. Selden, 101 U.S. 99 (1879); Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738 (9th Cir. 1971); Morrissey v. Proctor & Gamble Co., 379 F.2d 675 (1st Cir. 1967); 17 U.S.C. § 102(b) (1976).

166. The distinction is explicitly drawn in recent design protection bills. Title II of the revision bill, S. 22, tit. II, supra note 6, would have afforded protection to an "original ornamental design of a useful article," id. § 201, but excluded "a design that is . . . dictated solely by a utilization function of the article that embodies it," id. § 202.

ses, because their form is not responsive to utilitarian demands. Although created specifically for use in lamps, their form reflects purely aesthetic visions.\footnote{168}

The notion of distinguishing applied art from industrial design by examining the extent to which utilitarian considerations influence artistic expression has rarely surfaced in the case law. A few decisions make passing reference to similar ideas,\footnote{169} but the approach has never been used as a general model of the separability criterion. Yet no other model appears capable of successfully implementing the legislative decision to maintain unrestrained competition in the marketing of useful articles, subject only to an artist's exclusive rights in "incorporated" art.

A model emphasizing the influence of utilitarian factors frees the judicial analysis from its unfortunate fixation on appearance alone. If the ultimate aim is to distinguish applied art from industrial design, theories focusing only on appearances cannot achieve the desired end. It is the process more than the result that gives industrial design its distinctive character. Although the shape of an old-fashioned telephone, for example, would likely be excluded from copyright under any of the alternative interpretations of the separability test, what of the design of a pencil sharpener fashioned to present a similar appearance? The decision in \textit{Ted Arnold Ltd. v. Silvercraft Co.}\footnote{170} to protect such a work may well be correct. Although

\footnote{168. This is not to say that whenever "the appearance of an article is determined by esthetic (as opposed to functional) considerations," H.R. Rep. No. 1476, supra note 3, at 55, it is therefore copyrightable. Such a standard would permit protection for virtually the whole of industrial design, in clear contravention of the legislative intent. It is the fact that the form of the \textit{Mazer} statuettes is independent of their function, and thus unrelated to their utility, that "separates" it from the utilitarian aspects of the lamp.

169. In the case of costume jewelry, while the overall form is to some extent pre-determined by the use for which it is intended, the creator is free to express his idea of beauty in many ways. Unlike an automobile, a refrigerator or a gas range the design of a necklace or of a bracelet, may take as many forms as the ingenuity of the artist may conceive. Trifari, Krussman & Fishel, Inc. v. Charel Co., 134 F. Supp. 551, 553 (S.D.N.Y. 1955) (copyright upheld in costume jewelry). "Plaintiff concedes that the dimensions it designed were limited by the dimensions of the pencil sharpener casing. But this does not mean that the antique telephone is merely utilitarian. There was still room here for considerable artistic expression." Ted Arnold Ltd. v. Silvercraft Co., 259 F. Supp. 733, 735-36 (S.D.N.Y. 1966) (copyright upheld in pencil sharpener casing). "The shapes of the toys and their dimensions and configurations also appear to have been dictated primarily by utilitarian considerations." Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905, 915 (2d Cir. 1980) (denying copyright in "sculpture" of mechanical games).

170. 259 F. Supp. 733 (S.D.N.Y. 1966).}
the appearance of the two products is similar, the creative process is not. In the context of a pencil sharpener, the form represents an essentially arbitrary conception responsive only to aesthetics.171

The perspective afforded by this suggested approach to the separability standard may explain the superficial appeal of many competing models. In some instances, for example, physical separability may underscore the unconstrained, artistic nature of a particular product feature. The ability to remove a hood ornament without affecting an automobile's performance evidences its purely aesthetic origins. Art equally divorced from utilitarian influence, however, may often escape such narrow vision. Two-dimensional graphic works are not in reality

171. Emphasis on the creative process has long been part of copyright law, particularly with respect to objects claiming protection by virtue of their status as "works of art" (now "pictorial, graphic, and sculptural works"). "It is not necessarily a 'work of art,' something displaying artistic merit, but it is 'objet d'art'—something upon which the labors of an artist as such have been employed." Pellegrini v. Allegri, 2 F.2d 610, 611 (E.D. Pa. 1924).

The current Copyright Office regulations require that "to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form." 37 C.F.R. § 202.10(a) (1981). Although the process of industrial design is surely "creative" in a colloquial sense, the influence of nonaesthetic, functional considerations undermines the unfettered artistic creativity traditionally recognized by copyright. "That degree of creativity necessary to define objects as works of art is not supplied through innovations which are solely utilitarian or mechanical." Gardenia Flowers, Inc. v. Joseph Markovits, Inc., 280 F. Supp. 776, 781 (S.D.N.Y. 1968). "Illustrative of the requirement of minimal creativity are those cases which deny copyright protection to ... forms of expression dictated solely by functional considerations." 1 M. Nimmer, supra note 33, § 2.01[B] (footnotes omitted). The significance of artistic freedom in the creative process was recently emphasized in connection with a legislative attempt to include within the scope of copyright the patterns imprinted on integrated circuit chips.

The subcommittee should assure itself that—within the constraints of chip purpose and size—the designer's choice of a particular layout, and the representation of the designer's labors in the "photographic masks" and "imprinted patterns", is not dictated by the function to be performed by the chip and does represent a creative choice from among different possibilities. This standard is implicit in our assumption that the works to be protected are the result of "authorship."

Hearings on H.R. 1007 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary, 96th Cong., 1st Sess. (1979) (testimony of Jon Baumgarten, General Counsel, Copyright Office), reprinted in 2 COPYRIGHT L. REP. (CCH) ¶ 20,029, at 10,049 (1979). Although the outcome of the industrial design process may not be dictated by function, one could argue that the influence of nonaesthetic concerns does indeed undermine the artistic creativity that marks the work of the sculptor or painter. The requirement of creativity may thus lend further support to a distinction between those shapes and configurations that are responsive to function, and those aspects of useful articles that are independent of utilitarian considerations.
physically detachable from the objects on which they appear. Three-dimensional shapes, whether coin banks,\textsuperscript{172} pajama bags,\textsuperscript{173} jewelry,\textsuperscript{174} or pencil sharpeners\textsuperscript{175} may also represent essentially arbitrary artistic conceptions, despite the absence of physical separability. Similarly, since utilitarian factors will significantly influence the overall shape of most useful articles,\textsuperscript{176} a general rule of exclusion such as that expounded in \emph{Esquire} is not without justification, yet it too sweeps too broadly.\textsuperscript{177} Such draconian models can at best only approximate the distinctions pursued in the revision effort. Only direct reference to the legislative conceptions of "applied art" and "industrial design" embodied in the separability test can produce more discriminating results.

Emphasis on artistic independence has the additional advantage of neutralizing the arbitrary nature of the "useful article" characterization. The statutory category comprising articles "having an intrinsic utilitarian function" may yield too rich a harvest,\textsuperscript{178} but works at the margin will generally survive inspection in any event. When utility is peripheral, as in paperweights or bookends, form is generally not significantly constrained by function, and thus the work will retain protection regardless of its characterization.

Attention to functional influences on form and appearance may also alleviate the de facto discrimination against nonrepresentational art that has regrettably accompanied much of the current analysis. It is difficult to quarrel with


\textsuperscript{177}See supra notes 128-48 and accompanying text.

\textsuperscript{178}See supra notes 99-102 and accompanying text.
Judge Gesell's observation in *Esquire* that copyrightability ought not depend on adherence to particular artistic visions or styles. There is no justification for limiting copyright to works reflecting aesthetic regimes in which the standard of merit is resemblance to external objects, while excluding those which seek virtue in the relationship of forms within the work itself. Yet, since the ordinary observer can more easily recognize a representational work that has been incorporated into a utilitarian object, emphasis on physical separability will frequently cause more abstract forms to be either overlooked or thought too "integrated" to satisfy the statutory requirement. The general exclusion of overall shapes has a similarly pernicious effect. To avoid a crass or tasteless appearance, a utilitarian article is more likely to be given an abstract rather than representational form, although either may be arbitrary with respect to the underlying utility. Thus a ban on copyright in overall shape will fall heavily on abstract forms, barring works whose origins may lie far from the practical influences of the design process. The discrimination is diminished, however, under a model that places direct emphasis on the relationship between form and function. The shape of a Mickey Mouse telephone is copyrightable because its form is independent of function. A telephone shape owing more to Arp, Brancusi, or Moore than Disney may be equally divorced from utilitarian influence. An abstract shape employed as a lamp base may embody an artistic conception as untainted by utilitarian concerns as the *Mazer* statuettes. In all instances, unless the legislative distinction between applied art and industrial design is ignored, copyrightability must turn on the extent to which the...
work reflects either the independent perspective of the artist or
the more integrated approach of the designer.

A model requiring assessments of artistic independence
and utilitarian influence cannot offer the neat divisions prom-
ised by many of the alternative formulations. The distinctions
drawn by current analysis, however, often prove illusory, or are
maintained at too great a cost. The concepts of "applied art"
and "industrial design" communicate the simple truth that
some forms are more responsive to utility, and thus less the
product of untrammeled aesthetic visions, than others. No
mechanical test appears capable of capturing that relationship
over a significant portion of the spectrum. Difficult judgments
cannot be avoided, and only artificial divisions can succeed in
making easy work of cases such as *Esquire* or *Kieselstein-
Cord.*

**IV. CONCLUSIONS**

When copyright in "pictorial, graphic, and sculptural
works" ventures beyond the narrow confines of the "fine arts,"
the slope becomes slippery indeed. Current law expressly pre-
serves exclusive rights in works of art applied to utilitarian
ends, yet wisely endeavors to exclude the general design of
commercial products. The distinction between copyrightable
"applied art" and uncopyrightable "industrial design" has gen-
erally been pursued through mechanical models offering the
seductive security of unbending rules and ostensibly objective

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183. In *Esquire,* the Court of Appeals for the District of Columbia declined
to venture beyond mechanical formulas. There was no attempt to assess the
nature of the plaintiff's contribution. If its lighting fixtures had assumed the
appearance of giant Balinese dancers, one can presume the court would have
duly noted their conceptual independence. That the plaintiff chose a less hor-
rific form does not exclude the possibility of a similarly untainted artistic con-
ception. The task of judging the extent to which *Esquire*'s forms reflect
aesthetic decisions unrelated to function may be an unenviable one, but the
legislative distinction between applied art and industrial design requires it. If
the *Esquire* decision is correct, the credit is to chance rather than reason.

The Second Circuit's examination of Kieselstein-Cord's belt buckles is
more promising. Although unable to articulate a coherent rationale for its con-
clusion that the sculptural designs were conceptually separable from the utili-
tarian aspects of the works, the court did not retreat to stock alternatives. Its
intuition, and that of the Copyright Office which granted registration, appears
well founded. Although clearly constrained in some respects by functional ne-
cessities, the buckles' overall shapes appear largely devoid of utilitarian influ-
ence, reflecting instead the purely aesthetic judgments of their creator. See,
e.g., Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc., 95 F.R.D. 95 (D. Del.
1982) (expressing willingness to inquire into the conceptual separability of the
shape of eyeglass display cases).
criteria. The arbitrary divisions inevitably engendered by traditional analysis, however, can only crudely approximate the distinctions pursued in the revision effort.

The Copyright Act of 1976 invites a more discriminating analysis. The standard of separate identity and independent existence encourages a thoughtful appraisal of the character of the claimant's contribution. The exclusion of industrial design from the scope of copyright is best understood as an attempt to bar forms influenced in significant measure by utilitarian concerns. Thus, copyright is reserved to product features and shapes that reflect even in their utilitarian environment the unconstrained aesthetic perspective of the artist. Nothing short of a candid assessment of the nature of the proffered work can successfully implement the prudent, yet fragile, distinction between applied art and industrial design.