

COPYRIGHT PROTECTION FOR “USEFUL ARTICLES”

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I. APPLICABLE SCOPE OF THE COPYRIGHT ACT

Copyright protection subsists in “original works of authorship.”¹ Although the Copyright Act leaves the term “original work” undefined, the originality that is necessary to support a copyright requires independent creation, not novelty.² In other words, originality requires that the work owes its origin to the author, and that it is not copied from other works.³

Pictorial, graphic, and sculptural works are one of the eight broad enumerated categories of works that enjoy copyright protection.⁴ (The other seven are literary works, musical works, dramatic works, pantomimes and choreographic works, motion pictures and other audiovisual works, sound recordings, and architectural works.) Pictorial, graphic, and sculptural works are defined in 17 U.S.C. § 101 as:

two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

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¹ 17 U.S.C. § 102(a) (2000).

² E. Mishan & Sons, Inc. v. Marycana, Inc., 662 F. Supp. 1339, 1340-43 (S.D.N.Y. 1987).

³ Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).

⁴ 17 U.S.C. § 102(a) (2000).

This definition carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic quality.⁵ In other words, it does not have to be any good to be eligible for a copyright.

Works of applied art are included in the definition of pictorial, graphic and sculptural works.⁶ Works of applied art are said to “encompass all original pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection.”⁷

However, the protections afforded by copyright law are limited where items have utilitarian functions. Copyright may not be claimed in “any idea, procedure, process, system, method of operation, concept, principle, or discovery”⁸ The reasoning behind this policy is the premise that copyright laws cannot be used to obtain a monopoly on a method for performing commercial or scientific functions. Indeed, the particular expression of an idea is capable of copyright protection, but the idea, itself, is not.

II. HISTORY OF COPYRIGHT PROTECTION FOR USEFUL ARTICLES

The Copyright Act has gone through an evolution regarding its treatment of useful articles. Beginning in 1879, the Supreme Court laid the foundation for the copyrightability of solely or primarily utilitarian works. In *Baker v. Selden*,⁹ plaintiff Selden claimed that the defendant’s work embodied a system that was similar to Selden’s work. Selden had obtained copyright protection for a book which provided a novel system on the art of bookkeeping and which included blank forms with ruled lines and headings and which permitted the entire operation of a day, week or month to be reported on one page, or on two pages that faced each other in an account book. Defendant’s work produced the same result, but the columns were arranged differently and the headings were different. Selden alleged he had secured copyright protection through the exclusive right to the use of his bookkeeping system that was explained by his book by reasoning that no one could use his system without using substantially the same ruled lines and headings that he had appended to his book in illustration of the system.

⁵ S. REP. NO. 94-473, at 53 (1975) [hereinafter SENATE REPORT]; H.R. REP. NO. 94-1476, at 54 (1976) [hereinafter HOUSE REPORT].

⁶ HOUSE REPORT at 54; 17 U.S.C. § 101 (2000).

⁷ HOUSE REPORT at 54.

⁸ 17 U.S.C. § 102(b) (2000).

⁹ *Baker v. Selden*, 101 U.S. 99 (1879).

The Court dismissed the complaint holding that the record failed to demonstrate that defendant had violated Selden’s copyright and that the matter Selden alleged was infringed was not even capable of copyright protection. The Court reasoned that there was a distinction between an author’s original writing which was capable of copyright protection, and the art or practical knowledge explained by the writing, which generally was not capable of such protection.

The principle that arises from *Baker v. Selden* is “where the use of the art or the idea, which a copyrighted work explains, necessarily requires a copying of the work itself, then such copying will not constitute an infringement of copyright.”¹⁰

Although the text of the current Copyright Act does not allude to the *Baker v. Selden* doctrine, the Act actually confirms the basic principle that copyright protection is not available for “any idea, procedure, process, system method of operation, concept, principle or discovery”¹¹ Subsequently, the 1909 Copyright Act excluded from copyright protection productions of industrial arts that were utilitarian in purpose and character, even if they were artistically made or ornamented.¹²

In *Mazer v. Stein*, the U.S. Supreme Court reviewed the history of copyright coverage in analyzing whether a valid copyright existed for statuettes copyrighted as works of art, and then subsequently used as bases for table lamps. The Copyright Act of 1870 had defined copyrightable subject matter to include “a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts.”¹³ In 1909, Congress enlarged the scope of copyright protection to include eleven general categories, including “works of art; models or designs for works of art” and it deleted the “fine arts” clause in the former Act.¹⁴

The *Mazer* Court noted that an implementing regulation to the 1909 Copyright Act provided that works of art included “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 orna-

¹⁰ See *Autoskill, Inc. v. Nat’l Educ. Support Sys., Inc.*, 793 F. Supp. 1557, 1564 (D. N.M. 1992), *aff’d*, 994 F.2d 1476 (10th Cir.), *cert. denied*, 510 U.S. 916 (1993).

¹¹ 17 U.S.C. § 102(b) (2000).

¹² COPYRIGHT OFFICE, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT, BULLETIN NO. 15, at 8 (1910); *Mazer v. Stein*, 347 U.S. 201 (1954).

¹³ Ch. 230, § 86, 16 Stat. 212.

¹⁴ S. REP. NO. 59-6187, at 4 (1909); 35 Stat. 1076 (1909).

mented.”¹⁵ However, the Copyright Office subsequently determined that the regulation “made no reference to articles which might fairly be considered works of art although they might also serve a useful purpose,” and therefore reworded the regulation in 1917 to state:

Works of art and models or designs for works of art. This term includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture.) The protection of productions of the industrial arts utilitarian in purpose and character even if artistically made or ornamented depends upon action under the patent law; but registration in the Copyright Office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.¹⁶

As the *Mazer* Court noted, numerous works of art which possessed utilitarian aspects were registered as a result of the 1917 rewording of the regulation.¹⁷ However, because the government felt that the definition made no reference to articles which might fairly be considered works of art although they might also serve a useful purpose, the Copyright Act was eventually reworded to define works of art as “works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware and tapestries”¹⁸ The *Mazer* court ratified this regulation and upheld the copyright for the statuettes in question, noting that nothing in the copyright statute provides for invalidation of a copyright registration of an article that was intended for use in industry.¹⁹

Many courts subsequently interpreted *Mazer* broadly, that any useful article, if aesthetically pleasing, could be copyrighted as to its physical form.²⁰ However, the Copyright Office did not agree with such open-ended application, and in 1959 adopted a regulation, which provided that if the *sole* intrinsic function of an article was its utility, the fact that it was unique and attractive would *not* qualify it as a copyrightable work of art.²¹ However, the regulation did provide that if the shape of a utilitarian arti-

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

¹⁶ *Id.* at 212 n.24 (citing 37 C.F.R. § 201.4(7) (1939)).

¹⁷ *Id.* at 212.

¹⁸ 37 C.F.R. § 202.8 (1949).

¹⁹ 347 U.S. at 218.

²⁰ *See, e.g.,* *Boucher v. DuBoyes*, 253 F.2d 948 (2d Cir. 1958) (artistic jewelry); *Scarves by Vera, Inc. v. United Merchants & Mfgs.*, 173 F. Supp. 625 (S.D.N.Y. 1959) (designs printed on scarves); *Rushton v. Vitale*, 218 F.2d 434 (2d Cir. 1955) (doll).

²¹ *See* 37 C.F.R. § 202.10(c) (1977).

cle incorporated features which could be identified separately, and were capable of an independent existence as a work of art, then those features would be eligible for copyright registration.²²

The 1959 regulation, however, provided no clear answer to the inherent problem in delineating whether copyright protection existed for works of applied art. Questions arose both as to when the sole intrinsic function of a work was to be found in its utility, and as to when artistic features could be considered to be identified separately and capable of existing separately as works of art. Courts were in conflict regarding these issues, applying either a restrictive or an expansive interpretation.

In two of the last cases addressing this issue decided under the 1909 Copyright Act, a conflict emerged between U.S. Circuit Courts of Appeal. In *Esquire, Inc. v. Ringer*,²³ the District of Columbia Circuit applied a restrictive interpretation of the 1959 regulation, § 202.10(c), whereas the Second Circuit in *Kieselstein-Cord v. Accessories by Pearl, Inc.*,²⁴ applied a more expansive interpretation.

In *Esquire*, the district court had found an outdoor lighting fixture to be registrable because the fixture’s sole intrinsic function was not its utility, since it served to “decorate and illuminate” and, therefore, in daylight its purpose was solely decorative.²⁵ The D.C. Court of Appeals reversed, denying copyright in the lighting fixture since, although it had a pleasing shape, it was devoid of decoration. The Court of Appeals endorsed the Register’s view that the regulation section properly barred “copyright registration of the overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape or configuration may be.”²⁶

In *Kieselstein-Cord*, the district court had denied copyright status to two decorative belt buckles made of precious metal and used as jewelry, finding that they failed the test of separability and independent existence of the artistic features. However, the Second Circuit Court of Appeals reversed, finding that the artistic features of the buckles were conceptually, even if not physically, separable from the utilitarian features, and therefore eligible for copyright.²⁷

²² *Id.*

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

²⁴ 632 F.2d 989 (2d Cir. 1980).

²⁵ 414 F. Supp. 939 (D.D.C. 1976). An application of the lower court’s reasoning would mean that no attractively shaped useful article could have a utility as its sole intrinsic function, because all have the additional function of being decorative. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §2.08[B][3] (2006).

²⁶ 591 F.2d at 800.

²⁷ 632 F.2d at 994. It is worth noting that the *Kieselstein-Cord* dissent felt the lower court was correct on both the law and the facts in denying copyright protection to the belt buckles. *Id.* The dissent argued that, although the

Meanwhile, due in part to the open-ended impact of the district court decision in *Esquire*, the House Committee amended the original Senate version of a new law revising the Copyright Act in 1976, so that the final Act included the following words in the definition of pictorial, graphic and sculptural works:

Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a *useful article*, as defined in this section, shall be considered a pictorial, graphic or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.²⁸

Further, the statute defined a useful article as “an article that has an intrinsic utilitarian function which does not merely portray the appearance of the article or convey information.”²⁹

This significant change from prior law meant courts need no longer determine if an article’s function is *solely* utilitarian.³⁰ Now, if an article has *any* intrinsic utilitarian function, it may be denied copyright protection unless its artistic features can be identified separately and can exist independently as a work of art.³¹ This test is sometimes known as the Separability Test.³²

III. TREATMENT OF USEFUL ARTICLES TODAY

Due in part to the open-ended impact of the lower court decision in *Esquire*, the Copyright Act was further amended to its present state, which defines a useful article as “an article that has an intrinsic utilitarian function which does not merely portray the appearance of the article or convey information.”³³

Further, the statute provides that the definition of pictorial, graphic and sculptural works includes the design of a useful article if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural

buckles were aesthetically pleasing, they were just belt buckles and nothing more and that the innovations of their form were inseparable from their important function of aiding in keeping the “tops of trousers at waist level.”

Id.

²⁸ 17 U.S.C. § 101 (2000) (emphasis added); 1 NIMMER & NIMMER, *supra* note 25, § 2.08[B][3].

²⁹ 17 U.S.C. § 101 (2000).

³⁰ *Fabrica, Inc. v. El Dorado Corp.*, 697 F.2d 890, 893 (9th Cir. 1983).

³¹ *Id.* (citing HOUSE REPORT, *reprinted in* 1976 U.S.C.C.A.N. 5668).

³² *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346 (D.C. Cir. 1991).

³³ 17 U.S.C. § 101 (2000).

features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.³⁴ As stated *supra*, this test is often referred to as the Separability Test.³⁵ However, the Separability Test carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic quality.³⁶ In other words, the design need not meet any standard of good taste. This significant change from prior law means that courts need no longer determine whether an article's function is *solely* utilitarian. Now, the design of a useful article may be capable of copyright protection under the pictorial, graphic and sculptural work category.³⁷

IV. DISCRETION OF COPYRIGHT OFFICE

The Register of Copyrights's powers of acceptance or rejection are in some degree discretionary and not just ministerial.³⁸ In fact, Section 410(a) of the Copyright Act requires registration and the issuance of a certificate if the Register, "after examination," determines that the "material deposited constitutes copyrightable subject matter and that the other legal and formal requirements" have been met.³⁹ However, Section 410(b) provides that registration must be refused if the Register determines that the "material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason." Thus, the Register may determine whether registration is required or prohibited.

Nimmer suggests that the language in Section 410(a), "other legal and formal requirements," grants the Register, within limits, the discretionary authority to construe ambiguous provisions of the Copyright Act relating to registration.⁴⁰ However, courts have held that the Copyright Office does not have authority to give legal opinions or to define legal terms.⁴¹

In fact, the Copyright Office "does not undertake the making of comparisons of copyright deposits to determine similarity between works, nor does it give legal opinions or advice on such matters as: (1) the validity or status of any copyright other than the facts shown in the records of the Office; (2) the rights of persons, whether in connection with cases of alleged copyright infringement, contracts between authors and publishers or

³⁴ *Id.*; *Fabrica*, 697 F.2d at 893 (citing HOUSE REPORT, reprinted in 1976 U.S.C.C.A.N. 5668).

³⁵ *OddzOn Prods.*, 924 F.2d 346.

³⁶ SENATE REPORT at 5; HOUSE REPORT at 54.

³⁷ *Fabrica*, 697 F.2d at 893.

³⁸ *Bouve v. Twentieth Century-Fox Film Corp.*, 122 F.2d 51 (D.C. Cir. 1941).

³⁹ *See, e.g., House of Hatten, Inc. v. Baby Togs, Inc.*, 668 F. Supp. 251, 253 (S.D.N.Y. 1987).

⁴⁰ 2 NIMMER & NIMMER, *supra* note 25, § 7.21[A].

⁴¹ *Bartok v. Boosey & Hawkes, Inc.*, 523 F.2d 941, 946 (2d Cir. 1975).

other matters of a similar nature; . . . (4) the sufficiency, extent or scope of compliance with the copyright law.”⁴²

Further, a Copyright Office Circular states that among its other functions, it “serves as an office of record, a place where claims to copyright are registered when the claimant has complied with the requirements of the copyright law.”⁴³ Indeed, the Copyright Office cannot: (1) compare for similarities copies of works deposited for registration; and (2) advise on questions of possible copyright infringement or prosecution of copyright violations.⁴⁴

Thus, the discretion of the Register is not unlimited. For example, the Register may not refuse to register a work merely because of a disagreement with the author regarding the proper classification.⁴⁵ Further, the Register’s discretionary acts are subject to judicial review and correction.⁴⁶ (However, the scope of review is limited to whether the decision was “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.”)⁴⁷

How has this evolution impacted actual application of copyright protection in the commercial world? Two examples of “useful” or functional items, are toys and furniture.

V. COPYRIGHT PROTECTION FOR TOYS

Some courts have denied copyright protection to toys by reasoning that the reproduction of real items in toy form lacks the necessary element of originality to support a valid copyright because such reproduction does not reflect any independent creation, or distinguishable variation from preexisting works, and there is nothing that is recognizably the author’s own contribution which would separate the toys from the actual item they represent.⁴⁸

Similarly, in *Durham Industries, Inc. v. Tomy Corp.*, the plaintiff claimed copyright in plastic wind-up figures of Disney characters Donald Duck, Mickey Mouse and Pluto Dog.⁴⁹ The defendant toy company conceded that it had used plaintiff’s figures as models when it created virtually indistinguishable versions of the same Disney figures. The court found

⁴² 37 C.F.R. § 201.2(a)(1) (2006).

⁴³ U.S. LIBRARY OF CONGRESS, COPYRIGHT OFFICE, CIRCULAR 1B, LIMITATIONS ON THE INFORMATION FURNISHED BY THE COPYRIGHT OFFICE (2003).

⁴⁴ *Id.*

⁴⁵ *Bouve*, 122 F.2d 51.

⁴⁶ *Bailie v. Fisher*, 258 F.2d 425, 426 (D.C. Cir. 1958).

⁴⁷ *Atari Games Corp. v. Oman*, 888 F.2d 878, 881 (D.C. Cir. 1989).

⁴⁸ *See, e.g., Jackson v. Quicksip Co.*, 110 F.2d 731, 732 (2d Cir. 1940) (no copyright for toys or badges, alone or fastened to a book).

⁴⁹ 630 F.2d 905 (2d Cir. 1980).

that the plaintiff's models lacked the necessary element of originality to support a valid copyright since such reproduction did not reflect any independent creation, or distinguishable variation from preexisting works, and there was nothing that was recognizably the author's own contribution which would separate the toys from the prototypical Disney characters.⁵⁰

In *Little Souls, Inc. v. Les Petits, Inc.*, the court held that the facial features of a doll were not sculptural features that could be identified separately from nor were they capable of existing independently of their utilitarian features which were designed to make the doll's face more realistic.⁵¹ The court did find that the doll's facial expressions were protectable.

In *OddzOn Products, Inc. v. Oman*, the Court denied copyright protection to a toy ball designed from hundreds of floppy, wiggly, elastomeric filaments radiating from a core, because it did not reflect enough creative work beyond the object's basic shape to justify protection, and because its tactile qualities were dependent upon and inseparable from utilitarian features of the object.⁵²

However, other courts have held that toys are indeed capable of copyright protection. Generally, courts have held that toys may be entitled to copyright protection as long as: (1) the toys do not have a utilitarian function; (2) the toys' authors have contributed something more than a "merely trivial" variation of the real item which is recognizable as something that is the author's own work; and (3) the toys qualify as pictorial, graphic or sculptural works.⁵³

In *Gay Toys*, the district court had held that a toy airplane was a useful article.⁵⁴ The court reasoned that toys are necessary parts of growing up, and that toys allow children to "dream and let his or her imagination soar."⁵⁵ The court also found that the appearance of the toy could not exist independently of the plane itself. Relying on the reasoning in the *Esquire* court of appeals decision and the *Kieselstein-Cord* dissent, the district court found that because the toy was a useful article, and because its features could not be identified separately or could not exist independently of the utilitarian nature of the toy, the toy was not copyrightable.⁵⁶

⁵⁰ *Id.* at 910.

⁵¹ 789 F. Supp. 56, 58 (D. Mass. 1992).

⁵² 924 F.2d 346 (D.C. Cir. 1991).

⁵³ *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 972-74 (6th Cir. 1983) (copyright granted to toy airplane because lacking any intrinsic utilitarian function).

⁵⁴ *Gay Toys, Inc. v. Buddy L Corp.*, 522 F. Supp. 622 (E.D. Mich. 1981).

⁵⁵ *Id.* at 625.

⁵⁶ *Id.* at 625-26.

However, the Sixth Circuit Court of Appeals then vacated the lower court's judgment. In *Gay Toys, Inc. v. Buddy L Corp.*, the Sixth Circuit reviewed the statutory scheme of 17 U.S.C. § 101 and noted that copyright protection is extended to "pictorial, graphic, and sculptural works" generally, and that an exception is carved out by exempting "useful articles" from copyrightability.⁵⁷ However, it also noted that certain particular features of useful articles may be separately copyrighted.⁵⁸ The court found that the statutory definition of useful articles suggests that toys are copyrightable, because a toy airplane, like a painting, has no intrinsic utilitarian function. The only intrinsic function toys do have is the portrayal of real items.⁵⁹

The Sixth Circuit found that, under the lower court's reasoning, virtually any pictorial, graphic, and sculptural work would not be copyrightable as a useful article. Such reasoning of the useful article exception would "swallow the general rule."⁶⁰ In other words, whereas a real leaf blower functions as one, a toy leaf blower does not. It merely functions as a toy.

In *Monogram Models, Inc. v. Industro Motive Corp.*, the Sixth Circuit followed its decision in *Gay Toys* and, citing to many cases which found various items copyrightable, observed that practically anything novel can be copyrighted, and held that a scale plastic model airplane qualified.⁶¹ Indeed, in *Rushton v. Vitale*, the court granted protection for a doll which resembled a real chimpanzee that had appeared on the *Howdy Doody* children's television show by reasoning that the author need only have contributed something more than a "merely trivial" variation that is recognizably the author's own work.⁶² Thus, under *Gay Toys*, toys are not "useful articles" because their only intrinsic function is in fact to be used as toys. Therefore, it is not necessary to demonstrate that design features are separately identifiable or that they are capable of existing independently of any utilitarian aspects of the toy.

However, in order to be capable of copyright protection, toys must still qualify under the Copyright Act as pictorial, graphic, or sculptural works. In *Seip v. Commonwealth Plastics, Inc.*, the plaintiff made a *drawing* of a "Combination Rattle-Shaker-Horn-Dry Bubble Blower Pipe-

⁵⁷ 703 F.2d at 972.

⁵⁸ *Id.*

⁵⁹ *Id.* at 973, 974.

⁶⁰ *Id.* at 973.

⁶¹ 448 F.2d 284, 287-88 (6th Cir. 1971).

⁶² 218 F.2d 434, 435 (2d Cir. 1955). *See also* *Ideal Toy Corp. v. Sayco Doll Corp.*, 302 F.2d 623 (2d Cir. 1962) (doll may be copyrighted); *Blazon, Inc. v. DeLuxe Game Corp.*, 268 F. Supp. 416, 421 (S.D.N.Y. 1965) (statutes or models of animals or dolls copyrightable); *Fisher-Price Toys v. My-Toy Co., Inc.*, 385 F. Supp. 218 (S.D.N.Y. 1974) (original combination of features into new dolls made dolls copyrightable).

Toy,” and filed a copy of the drawing in the Copyright Office.⁶³ Eight years later, the defendant applied for a patent for a “Toy Whistle” which it manufactured. To aid in selling the whistle, defendant developed an advertising card which showed the upper portion of the body of a boy blowing a whistle. Plaintiff brought suit for alleged copyright infringement. The court held that the article which plaintiff had copyrighted, the physical hand-drawn picture of an idea, bore no resemblance to the defendant’s display card.⁶⁴ As such, the plaintiff’s *idea* could not be copyrighted and there was no infringement.

Courts have, in fact, found that toys are graphic or sculptural works. The Second Circuit in *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, upheld the copyrightability of toy changeable robotic action figures which were part of the toy manufacturer’s “Transformer” series, as sculptural works.⁶⁵ In *Kamar International v. Russ Berrie & Co., Inc.*, the Ninth Circuit found that the defendant had infringed on plaintiff’s copyright for certain stuffed animals.⁶⁶ In a subsequent appeal regarding the right to statutory damages, the Ninth Circuit cited to *Gay Toys* as authority for the fact that toys are copyrightable.⁶⁷

In *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, the Third Circuit overruled a lower court that had found that certain “nose masks” which resembled the noses of a pig, an elephant and a parrot were useful articles.⁶⁸ The appellate court supported its conclusion by relying on the Sixth Circuit’s decision in *Gay Toys*, and found that there was no need to utilize the “useful article” analysis because the masks had no utility that did not derive from their appearance.⁶⁹

In *OddzOn Products, Inc. v. Register of Copyrights*, the Court of Appeals for the District of Columbia analyzed in detail the lower court’s decision to affirm the Copyright Office’s denial of appellant toy maker’s application for copyright protection for its toy KOOSH ball.⁷⁰ The

⁶³ 85 F. Supp. 741 (D. Mass. 1949).

⁶⁴ *Id.* at 741-42.

⁶⁵ 780 F.2d 189, 191 (2d Cir. 1985).

⁶⁶ 752 F.2d 1326 (9th Cir. 1984).

⁶⁷ *Kamar Int’l v. Russ Berrie & Co., Inc.*, 829 F.2d 783 (9th Cir. 1987).

⁶⁸ 912 F.2d 663, 671 (3d Cir. 1990).

⁶⁹ *Id.* at 670. However, after the court held that the masks were copyrightable as sculptural works, it noted that copyrights only protect expressions of ideas and not ideas themselves, and that the plaintiff might have a difficult time in demonstrating infringement on its masks because the masks were relatively straightforward representations of animal noses. *See also* *Poe v. Missing Persons*, 745 F.2d 1238, 1242 (9th Cir. 1984) (citation to *Gay Toys* holding that toy airplanes are protectible because they have no intrinsic function other than to portray real airplanes).

⁷⁰ 924 F.2d 346 (D.C. Cir. 1991).

KOOSH ball was a patented, trademarked item designed from hundreds of floppy, wiggly, elastomeric filaments radiating from a core, originally designed to teach youngsters with poor eye-to-hand coordination how to play catch. The Copyright Office had found that there was no copyrightable authorship to the spherical shape of the ball. It also found that the feel of the object was a functional part of the work and therefore not a basis for registration. The district court had analyzed the visual aspect of the ball and found that, not only did the ball approximate a sphere, there was not enough creative work beyond the object's basic shape to justify protection. The district court had also found that the Copyright Office did not abuse its discretion in ranking the tactile qualities of the KOOSH ball as dependent upon and inseparable from the utilitarian features of the object, and therefore not protectable. The Court of Appeals affirmed.⁷¹

In *The Kyjen Co., Inc. v. Vo-Toys, Inc.*, plaintiff designed, manufactured, and distributed stuffed animals and plush toys which were marketed mostly as pet toys, for which it obtained copyright registrations.⁷² Plaintiff alleged copyright infringement when defendant manufactured and marketed toys which were allegedly so similarly designed that even the number of decorative stitches were identical.⁷³ Defendant claimed the copyrights were invalid because it asserted that the plaintiff's founder was not the original author of the toys.⁷⁴ However, the court found that defendant presented no evidence to create a genuine issue of fact regarding the authorship of the toy designs. There were no genuine issues of fact as to the validity of the copyrights. Further, the Court found that the evidence was uncontradicted that the changes made to one of the original toys (the use of a ring for its body, addition of hands, and removal of feet and tail) warranted copyright protection.⁷⁵

Kikker 5150 v. Kikker 5150 USA, LLC involved a dispute between rival manufacturers of miniature working motorcycles over alleged in-

⁷¹ However, it is worth noting that in dicta, the *OddzOn* appellate court stated that the appellant had failed during the application process or in the lower court to challenge the Copyright Office's treatment of the ball as a "useful article." Because the appellant had never challenged the initial issue as to whether the ball was a useful article, the ball was subjected to the useful article separability test, and the appellate court was unable to address that issue. The court implied that its decision would not preclude a determination in a possible subsequent infringement action, that the KOOSH ball would indeed be copyrightable. *Id.* at 350. Thus, possibly had the appellant previously challenged the useful article treatment of the ball, the court might have followed the *Gay Toys* holding that toys are not useful articles, and found that the toy warranted copyright protection.

⁷² 223 F. Supp. 2d 1065, 1066 (C.D. Cal. 2002).

⁷³ *Id.*

⁷⁴ *Id.* at 1067.

⁷⁵ *Id.* at 1069.

fringement of copyright.⁷⁶ Defendant alleged the motorcycles were not copyrightable because: (1) they were “useful articles”; and (2) they were copies of other motorcycles, and lacked the necessary element of originality.⁷⁷ Plaintiff argued that the motorcycles were toys because their very small size limited the real purpose of the “pocket bikes” to the amusement of adults and older children, and that they were too small and otherwise unsuitable for transportation or any other real-life utilitarian purpose to constitute anything other than a toy.⁷⁸

Defendant argued that the motorcycles were *not* toys because they had an intrinsic function far beyond the mere portrayal of a motorcycle, and in fact were designed to be ridden and raced. Also, if plaintiff’s argument were accepted, other similar items, such as NASCAR race cars and three-wheeled all-terrain vehicles designed primarily for amusement and not for transportation, would then be eligible for copyright protection.

The plaintiff’s certificate of registration described the nature of the works as “three dimensional, sculptural features and design elements of [a] miniature motorcycle.” After the plaintiff was unable to locate another copyright on any similar item, the court found that a photograph of a man riding one of the motorcycles demonstrated that the motorcycle served a utilitarian function of transportation and was, therefore not eligible for copyright protection as such.

However, the court, in citing to *Fabrica, Inc. v. El Dorado Corp.*,⁷⁹ found that there were genuine issues of fact as to whether various design elements of the motorcycles could be identified separately and were capable of existing independently as a work of art, and whether there existed a requisite degree of originality to warrant copyright protection. The court, in citing to *Gay Toys*, stated that “toys are not useful articles; therefore toys may be copyrighted,”⁸⁰ and it quoted the *Gay Toys* statement that “toys do not even have an intrinsic function other than the portrayal of the real item.”⁸¹

The *Kikker 5150* case suggests that in order for a toy itself to be copyrightable, it must not possess any utilitarian function. However, the case does imply that even if a toy is found to have a utilitarian function, design elements of the toy may still be copyrightable if they are able to survive the separability test and are able to exist independently as works of art. Thus, although there is no bright line, generally speaking, because toys’ only intrinsic functions are typically the portrayal of real items, they are

⁷⁶ No. C 03-05515 SI, 2004 U.S. Dist. LEXIS 16859 (N.D. Cal. Aug. 13, 2004).

⁷⁷ *Id.* at *16-17.

⁷⁸ *Id.* at *18-19.

⁷⁹ 697 F.2d at 893.

⁸⁰ *Kikker 5150*, 2004 U.S. Dist. LEXIS at *18.

⁸¹ *Id.*

not “useful articles” and will generally be capable of copyright protection if they qualify under the Copyright Act as pictorial, graphic or sculptural works.

VI. COPYRIGHT PROTECTION FOR FURNITURE

As stated previously, the Copyright Act excludes from copyright protection any “useful article,” which the Act defines as any article “having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁸² A work of art, however, does not lose its copyrightability even if it has some utilitarian aspects so long as the art’s “sculptural features . . . can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”⁸³ This language was intended to distinguish creative works that enjoy protection from elements of industrial design that do not.⁸⁴

However, the line that is drawn between protectable pictorial, graphic and sculptural works and unprotectable utilitarian elements of industrial design is not so clear.⁸⁵ The “fine line” between the protectable and unprotectable is that of separability, an abstract concept describing the potential for a particular artistic work to be considered, either physically or conceptually, apart from its utilitarian aspects.⁸⁶

The circuit courts that have addressed the interpretative problem of separability recognize that the wording of the statute “does not supply categorical direction, but rather requires the Copyright Office and the courts ‘to continue their efforts to distinguish applied art and industrial design.’”⁸⁷ The Seventh Circuit opined that Congress purposefully provided only general policy guidance to be implemented on a case-by-case basis through the Copyright Office and the courts, to account for the endless factual scenarios to which its policy guidance would have to be applied.⁸⁸

“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.”⁸⁹ The statutory separability requirement confines copyright protection to those aspects of the design that exist apart from its

⁸² 17 U.S.C. § 101 (2000).

⁸³ *Id.*

⁸⁴ See HOUSE REPORT at 55 (stating that the purpose behind this language was “to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.”).

⁸⁵ *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 921 (7th Cir. 2004).

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ 1 NIMMER & NIMMER, *supra* note 25, § 2.08(B), at 2-101.

utilitarian value, and that could be removed without reducing the usefulness of the item.⁹⁰

The following tests have been suggested for determining when the artistic and utilitarian aspects of useful articles are conceptually separable: (1) the artistic features are "primary" and the utilitarian features "subsidiary";⁹¹ (2) the useful article "would still be marketable to some significant segment of the community simply because of its aesthetic qualities";⁹² (3) the article "stimulates in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function";⁹³ (4) the artistic design was not significantly influenced by functional considerations;⁹⁴ (5) the artistic features "can stand alone as a work of art traditionally conceived, and . . . the useful article in which it is embodied would be equally useful without it";⁹⁵ and (6) the artistic features are not utilitarian.⁹⁶

When sculptural features and utilitarian aspects of an article are not separable, the work is not copyrightable, although it may be protectable on a more limited basis with a design patent.⁹⁷ The *Superior Form* court distinguished the Supreme Court's holding in *Mazer*, in holding that, unlike the copyrightable design of a statue portraying a dancer which is included as the base of a utilitarian lamp, the industrial design of a "unique, aesthetically pleasing chair" is not subject to copyright protection because it cannot be separated from the chair's utilitarian function.⁹⁸ The Fourth Circuit reasoned that the objective in designing a chair is to create a utilitarian object, even if it is an aesthetically pleasing one; whereas the objective in creating a statue of a dancer is to express the concept of a dancer.⁹⁹ "As the Act makes the distinction, a useful article has as its function something more than portraying its own appearance."¹⁰⁰

In *Collezione Europa U.S.A., Inc. v. Hillsdale House, Ltd.*,¹⁰¹ a furniture company that freely admitted that it had produced "knock off" pieces

⁹⁰ *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 170 F. Supp. 2d 828, 832 (N.D. Ill. 2001), *rev'd on other grounds*, 372 F.3d 913 (7th Cir. 2004).

⁹¹ *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 623 F.2d 989, 993 (2d Cir. 1980).

⁹² 1 NIMMER & NIMMER, *supra* note 25, § 2.08 [B][3], at 2-101.

⁹³ *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985).

⁹⁴ *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

⁹⁵ 1 PAUL GOLDSTEIN, *COPYRIGHT: PRINCIPLES, LAW & PRACTICE* § 2.5.3, at 2:67 (1989).

⁹⁶ WILLIAM F. PATRY, 1 *COPYRIGHT LAW & PRACTICE* 285 (1994).

⁹⁷ *Superior Form Builders v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 493 (4th Cir.), *cert. denied*, 519 U.S. 809 (1996).

⁹⁸ *Id.*

⁹⁹ *Id.*

¹⁰⁰ *Id.* (citing 17 U.S.C. § 101).

¹⁰¹ 243 F. Supp. 2d 444, 448 (M.D. N.C. 2003).

of furniture based on another furniture company's line of copyrighted furniture containing decorative features of sculpted leaves made out of a pewter-look material, sought a declaratory relief action after the copyright owner asked the infringing company to cease and desist its infringement. Because the copyrighted material was described as "sculpted features on 3-dimensional sculpture," the court found that the certificates of registration referred to and were limited to the sculpted leaves adorning the furniture.¹⁰² The court found that the sculpted features of the furniture, although embedded within the design of the furniture itself, were sufficiently separable from the utilitarian aspects of the design so as to be validly copyrightable.¹⁰³

The *Collezione* court distinguished the holding in *Magnussen Furniture v. Collezione Europa USA*, an unpublished case,¹⁰⁴ which analyzed whether iron tables were copyrightable. The copyright owner in *Magnussen* described its tables as:

The design features suggest concepts such as flowers, fountains and waves. With these features, the overall "look" of the tables draws the eye from the waving serpentine curls and undulating swirls below, upwards to the simpler geometric circle and bow tie-like elements angled around the apron frame. Floating in the center are eye-catching petal formations which support brass balls. The transparent glass top gives the overall effect that there is no table at all, or that the object is a work of art which is more than a mere table.¹⁰⁵

The *Magnussen* court found that the tables were not copyrightable because the sculptural features of the table did not appear to be conceptually separable from the table's utilitarian function.¹⁰⁶ Thus, because the primary function of furniture is to serve a utilitarian purpose, furniture, by itself, may not be copyrighted unless an aspect of the design exists apart from its utilitarian value, and which can be removed without reducing the usefulness of the item.

VII. COPYRIGHT INFRINGEMENT

In a copyright infringement action, the plaintiff must demonstrate (1) ownership of the copyright and (2) copying by the defendant.¹⁰⁷ Plaintiff

¹⁰² *Id.* at 453.

¹⁰³ *Id.* at 457-58.

¹⁰⁴ 43 U.S.P.Q.2d 1218 (4th Cir. 1997).

¹⁰⁵ *Id.* at 1220 n.1.

¹⁰⁶ *Id.* at 1220.

¹⁰⁷ *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).

must own a valid copyright and defendant must have copied constituent elements of the work that are original.¹⁰⁸

As to the first element of infringement, the plaintiff's ownership, the requirements are: (1) originality in the author; (2) copyrightability of the subject matter; (3) citizenship status of the author such as to permit a claim of copyright; (4) compliance with applicable statutory formalities; and (5) if the plaintiff is not the author, a transfer of rights or other relationship between the author and the plaintiff so that the plaintiff may be the valid copyright claimant.¹⁰⁹ Evidence of a valid copyright certificate, if timely obtained, constitutes prima facie evidence of the validity of the copyright and of the facts stated in the registration certificate.¹¹⁰ The burden then shifts to the defendant to counter the evidence provided by the plaintiff,¹¹¹ and rebut the presumption of validity.¹¹²

As to the second element, the defendant's copying, absent direct evidence of copying, the plaintiff can infer copying by proving the defendant's access to the copyrighted material, and substantial similarity of the accused infringement.¹¹³

Linking these factors, the prevailing definition of access is the opportunity to copy. In *Smith v. Little, Brown & Co.*, the district court held that access merely requires that the defendant had an *opportunity* to see plaintiff's work, not that defendant *actually* saw plaintiff's work.¹¹⁴ The court found, that because plaintiff's manuscript was in the defendant's office and one of defendant's employees had the opportunity to see it, defendant had access.

If no particular channel of communication has been established between plaintiff and defendant, access may be found if plaintiff's work has been widely disseminated. In *Fisher-Price Toys v. My-Toy Co.*, because plaintiff's dolls were advertised in trade journals and were displayed at toy fairs, the court found that the defendant had access to the allegedly infringed items.¹¹⁵

The second element of copying involves substantial similarity. The similarities in question must be so striking as to preclude the possibility that defendant independently produced the same item.¹¹⁶ In fact, even if

¹⁰⁸ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

¹⁰⁹ *Carol Cable Co. v. Grand Auto, Inc.*, 4 U.S.P.Q.2d 1056, 1061 (C.D. Cal. 1987).

¹¹⁰ 17 U.S.C. § 410(c) (2000); cf. *Southern Bell Tel. & Tel. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th Cir. 1985).

¹¹¹ *In Design v. Lauren Knitwear Corp.*, 782 F. Supp. 824, 829 n.11 (S.D.N.Y. 1991).

¹¹² *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980).

¹¹³ *Sid & Mary Krofft Television Prods.*, 562 F.2d at 1162.

¹¹⁴ 245 F. Supp. 451, 458 (S.D.N.Y. 1965), *aff'd*, 360 F.2d 928 (2d Cir. 1966).

¹¹⁵ 385 F. Supp. 218, 220 (S.D.N.Y. 1974).

¹¹⁶ *Ferguson v. Nat'l Broad. Co.*, 584 F.2d 111 (5th Cir. 1978).

copying is conceded by the defendant, infringement will not be found unless the copying is substantial. The Ninth Circuit uses a two-part test to determine whether two works are “substantially similar,” involving an extrinsic and an intrinsic component.¹¹⁷

The extrinsic test objectively considers whether substantial similarities exist in both ideas and expression. The extrinsic test questions whether two works share a similarity of ideas and expression based on external, objective criteria, using analytic dissection of the work and expert testimony, and it is usually decided by the court.¹¹⁸ A lower standard of proof is required when a high degree of access is shown. If the plaintiff satisfies the extrinsic test, then the intrinsic test questions whether an ordinary reasonable observer would find a substantial similarity of expression of the idea.¹¹⁹ Case law suggests that if the extrinsic test is satisfied, the intrinsic test must be determined by a jury and summary judgment must be denied.¹²⁰

In *A & A Plush v. SKM Enterprises, Inc.*, the court analyzed whether certain plush toys were substantially similar.¹²¹ The court found that although the two works depicted the same subject matter — a stuffed teddy bear — it could not conclude as a matter of law that the works shared a similarity of expression.¹²² The two items had distinguishable features such as color, shape, size, anatomy, facial expressions and proportion of body parts such that the court found that the total concept and feel of each toy was different.¹²³ Thus, copyright protection is generally available for toys and for the design aspect of furniture if it exists apart from its utilitarian value, when the owner of the work possesses a valid copyright and if the owner can demonstrate that the defendant has copied the work.

CONCLUSION

Copyright protection for useful items is part of the larger issue of intellectual property protection for product design in general. Intellectual property can give a business a competitive advantage in the marketplace. But conversely, failure to protect intellectual property rights, or failure to steer clear of competitors’ intellectual property, can place a business at a competitive *dis*advantage. The prudent product designer now will *not* depend upon copyright alone for protection, and trade dress protection has

¹¹⁷ *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994).

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Id.* (citing *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996)).

¹²¹ 47 U.S.P.Q.2d 1438 (C.D. Cal. 1998).

¹²² *Id.* at 1445.

¹²³ *Id.*

become problematic absent established secondary meaning.¹²⁴ Accordingly, the best protection for product design is likely a design patent in the United States, and a design registration in foreign jurisdictions. A design patent is a legal form of protection more or less unique to the United States, which permits a patent to be applied for and issued for the design and overall appearance of an item. A design patent must be novel and non-obvious, like any patent. Its term is fourteen years, and it is non-renewable.

¹²⁴ The U.S. Supreme Court alluded to the possibility of copyright protection for product design in its 2000 decision in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000), in which it critically weakened the availability of trade dress protection for product design, as opposed to packaging. The gist of the Court’s ruling was that trade dress for a product design can never be inherently distinctive, but to be protected must have acquired “secondary meaning,” that is, its primary significance is to identify in the minds of the public the source of the product rather than the product itself. Usually, secondary meaning is shown through survey evidence, which is expensive to develop. This sets up a virtually impossible test to meet, since by the time a product will have been on the market long enough to have acquired secondary meaning, it will be long past the time when others have knocked it off. For example, a recent decision in the Sixth Circuit, *Herman Miller, Inc. v. Palazetti Imports and Exports, Inc.*, 270 F.3d 298 (6th Cir. 2001), was the rare case where a product was deemed to have been on the market long enough to have achieved secondary meaning, in that case, the famous Eames chair; but the trade dress owner Herman Miller, Inc. was held to be barred by laches (delay) from enforcing it, anyway. This case is an example of the exception that proves the new rule. In 2001, the Supreme Court followed up *Wal-Mart* in *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), where it stressed that functional as opposed to decorative aspects of product design cannot serve as protected trade dress. The Court rejected trade dress claims of a maker of temporary road signs, holding that “the party asserting trade dress has the burden to establish the non-functionality of alleged trade dress features. . . . In general terms, a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Id.* at 32. See also *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778 (9th Cir. 2002) (wheelchair securement system design is not fanciful, but is wholly functional, and therefore not protectable as a trademark). The Supreme Court noted, “[T]he producer can ordinarily obtain protection for a design that is inherently source identifying (if any such exists), but that does not yet have secondary meaning, by securing a design patent *or copyright* for the design — as, indeed, [Samara] did for certain elements of the designs in this case. The availability of these other protections greatly reduces any harm to the producer that might ensue from our conclusion that a product design cannot be protected under [Lanham Act] § 43(a) without a showing of secondary meaning.” *Wal-Mart*, 529 U.S. at 214 (emphasis added).

