Copyright Protection for Useful Articles: Can the Design of an Object be Conceptually Separated from the Object's Function?

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COPYRIGHT PROTECTION FOR USEFUL ARTICLES:
CAN THE DESIGN OF AN OBJECT BE CONCEPTUALLY
SEPARATED FROM THE OBJECT'S FUNCTION?

I. INTRODUCTION

If created today, would Michelangelo’s David be afforded copyright protection? To what extent, if at all, should the purpose for which David was created, and its primary function, carry any weight in determining whether such protection should be granted?

Under the Copyright Act of 1976, pictorial, graphic, or sculptural works constitute proper subject matter for copyright protection. On the other hand, “useful articles,” that is articles having an “intrinsic utilitarian function,” do not receive copyright protection. What, then, happens to copyright protection when “sculptural” forms are put to “utilitarian” ends, or alternatively, when “useful articles” encompass “sculptural” forms? Do the utilitarian aspects bootstrap their way to protection because the article contains sculptural aspects that are copyrightable? Or, are the sculptural aspects of a useful article not protected because these aspects are part of an unprotected work?

Rather than completely denying or affording protection for useful articles which contain pictorial, graphic, or sculptural elements,

2. 17 U.S.C. § 102(a)(5) (1991). The Copyright Act provides the author of the work with exclusive rights, such as (1) the right to reproduce the copyrighted work; (2) the right to prepare derivative works; (3) the right to distribute copies of the work, transfer ownership of the work, rent, lease, or lend the work; (4) the right to perform the work publicly; and (5) the right to display the work publicly. Id. § 106. These exclusive rights are subject to exceptions, most notably, fair use. In simplistic terms, fair use entitles others to use a portion of a copyrighted work for scholarly use. See id. § 107.
3. 17 U.S.C. § 101 (1991). The Copyright Act defines “useful articles” as those objects which have an “intrinsic utilitarian function.” Id. The simplest definition of a “useful article” is what the lay person considers a “product,” the purpose or function of which goes beyond the product’s mere appearance. In other words, products having a “use” beyond aesthetic pleasure are “useful articles” having an “intrinsic utilitarian function.” Thus, a television set is a useful article in that it receives and displays visual images. Although the visual images may be pleasing to the eye, the intrinsic quality of the television is in its utilitarian function of receiving and displaying the visual images, not in the visual images themselves. Nor is the shape or design of the television its intrinsic function, even though the shape may be very pleasing. Thus, in the Copyright Act, Congress was distinguishing between function and appearance. Typical useful articles include automobiles, refrigerators, clothing, and telephones. See H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5667.

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Congress determined that the copyrightable work embodied in a useful article is protected. When artistic forms are incorporated into useful articles, the Act provides that the artistic elements of the useful article may be copyrighted to the extent that the artistic elements are “separable” from, and are capable of existing “independently” of the utilitarian aspects of the work.

At first blush, this test seems simple. In determining what aspects of a useful article are subject to protection, all that the Copyright Office or a court has to do is separate the artistic parts from the utilitarian parts, and then grant protection to the separated artistic parts. This test would, in fact, be simple if it hinged only on the physical separation of the artistic elements from the utilitarian elements of the article. However, such simplicity is not found in copyright law. In determining separability, Congress has also properly declared that the pictorial, graphic, or sculptural aspects of the useful article could either be “physically or conceptually” separable from the utilitarian elements of the useful article for protection to be granted to the artistic features. Physical separability poses no real problem, for if the pictorial, graphic, or sculptural element can be physically taken from the useful article without affecting the functioning of the useful article, then that which is separated is protected. The more difficult issue is determining what is meant by conceptual separability.

Since the enactment of the 1976 Copyright Act, courts have struggled to define “conceptual separability,” and have thus far failed to create a satisfactory or workable test for determining

4. The 1976 Copyright Act defines “pictorial, graphic, and sculptural works” to include: [T]wo-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. 17 U.S.C. § 101 (1991).

5. Id.


7. 17 U.S.C. § 101 (1991). Physical separation in the most fundamental case would occur, for example, in a table lamp for which the stem had a decoration attached to it. The decoration could be physically removed from the lamp, while the structural parts of the lamp (base, shaft, wiring, etc.) remained intact. Since the decorative stem is completely unnecessary for the functioning of the lamp and could be physically removed, the stem would meet the test for physical separability. See infra notes 6-7, 23-33 and accompanying text.
whether conceptual separability has been met by particular elements of a useful article. In addition, copyright scholars have noted the complexity and difficulty of this issue, but have provided little guidance for courts to construct a plausible test that will protect only the artistic elements of a useful article, without extending protection to the article's utilitarian features.

The purpose of this comment is to examine the shortcomings of the judicial decisions involving conceptual separability. As discussed below, the reasoning expressed in the relevant decisions fails to protect many "authors" of an otherwise copyrightable work that has a utilitarian function. That is, works which would normally pass the test for copyright protection fail simply because the work has been presented in, or has had applications as a useful article. Through an analysis of legislative history and judicial interpretation, this comment highlights the conflicting, subjective, and unworkable tests created by the judiciary and legal scholars. The comment then proposes a test which avoids the pitfall of requiring judges to make artistic value judgments.

Under the 1976 Act, no one would question that if Michelangelo had recently completed work on David, the sculpture would be afforded copyright protection. What if, instead of creating David solely for "artistic" purposes, Michelangelo created David as a life-size mannequin, (albeit an expensive mannequin), and David was not presented in a museum, but instead in a department store to

10. See discussion infra parts II.B., III.A-C.
11. See discussion infra parts II.B.2, III.B-C.
12. Under the Copyright Act, for any work to receive copyright protection, it must meet the originality and fixation requirements. Originality is not defined in the Act, but has been judicially defined as the work owing its origin to the author, but contains no requirement that the work be substantially original. See Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903). Fixation is defined in the Act as:

A work is "fixed" in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is "fixed" for purposes of this title if a fixation of the work is being made simultaneously with its transmission.

display clothing? Under the prevailing tests, it would be impossible to conceptually separate the "artistic" copyrightable elements from the "utilitarian" elements. As a result, copyright protection would not be available for David, a result not intended by the Copyright Act. To ensure copyright protection for future artistic works, a new test must be developed.

II. BACKGROUND

A. The Evolution of Protection for Applied Art Prior to the 1976 Act

1. The Origin of Separability

Just before the enactment of the Copyright Act of 1909, in Bleistein v. Donaldson Lithographing Co., the Supreme Court was faced with the issue of whether an artistic work is copyrightable when its primary purpose and function is that of a useful article. At issue was a painted advertisement for a circus which defendant copied. Plaintiff sued for infringement and defendant contended that infringement did not occur because advertisements were not proper subject matter for copyright protection. The Supreme Court held that simply because an article's primary function is utilitarian in nature, the article is not barred from copyright protection. In asserting that copyright protection is not dependent upon an article's artistic value, Justice Holmes drew what should be an incontrovertible line, stating, "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside the narrowest and most obvious limits."

The 1909 Act was enacted shortly thereafter. Under the 1909 Act, protection was made available for "[w]orks of art; models or designs for works of art." In implementing the Act, the Copyright Office wavered as to whether protection should be afforded to the

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15. 188 U.S. 239 (1903).
16. Id.
17. Id.
18. Id.
applied arts or only to the fine arts. The Office ultimately accepted utilitarian objects for copyright but at the same time adopted regulations that rejected such registration.\(^{21}\) Finally, in 1948, the Copyright Office changed its view on this matter and formally determined that works of art include "works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned."\(^{22}\)

The only time that the Supreme Court has directly faced the issue of the copyrightability of artistic aspects in a useful article was in \textit{Mazer v. Stein}.\(^{23}\) \textit{Mazer} involved copyright protection for table lamps, wherein the base of the lamps were sculptural figures in the shape of both male and female dancing figures made of semivitreous china.\(^{24}\) Respondents had copyrighted the bases separately from the other parts of the lamp as "works of art" under the 1909 Act,\(^{25}\) and controversy ensued as to whether the statuettes' protection subsisted when the statuettes were subsequently used as lamp bases by adding electric wiring, sockets and lamp shades.\(^{26}\) Petitioner copied the lamp bases and petitioned for review of the court of appeals' decision upholding the copyright in the bases.\(^{27}\)

In granting certiorari, the Supreme Court summarized the issue in the following manner: "Stripped down to its essentials, the question presented is: Can a lamp manufacturer copyright his lamp bases?"\(^{28}\) The Court emphasized that the issue actually involved the artist's right to copyright art work intended to be used for lamp bases, as opposed to a manufacturer's right to register the lamp base.\(^{29}\) Another issue raised by petitioner was whether copyright protection was available for works of art that are mass-produced.\(^{30}\) The Court rejected petitioner's claim that mass-produced works of art are not protected by interpreting the deletion of the fine arts clause of the 1870 Act to mean the end of the verbal distinction between works of

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24. Id. at 202.
27. Id. at 203-04.
28. Id. at 205.
29. Id.
30. \textit{Mazer}, 347 U.S. at 204-05.
the fine arts and works of applied art.\textsuperscript{31} The Court noted that works of applied art are afforded copyright protection, "in so far as their form but not their mechanical or utilitarian aspects are concerned."\textsuperscript{32} After determining the threshold question of whether mass-produced works of art may be copyrighted, the Court held that the statuettes were copyrightable since the statuettes represented a form of artistic craftsmanship, and were not part of the mechanical or utilitarian aspects of the lamp.\textsuperscript{33}

Responding to the \textit{Mazer} decision, the Copyright Office in 1957 developed regulation 202.10(c)\textsuperscript{34} which was subsequently adopted in the 1976 House Report regarding protection of useful articles.\textsuperscript{35} Federal regulation, section 202.10(c) stated that if "the sole intrinsic function of an article is its utility, the fact that it is unique and attractively shaped will not qualify it as a work of art."\textsuperscript{36} Three years later, the Copyright Office amended this regulation by deciding that artistic features of a useful article could obtain protection, provided that such features, "can be identified separately and are capable of existing independently as a work of art."\textsuperscript{37} It was this amended version of the regulation\textsuperscript{38} which made separability a crucial element in determining which aspects of, and to what extent useful articles are protected. As will be seen, applying the separability requirement proved far more troublesome than merely espousing it in a regulation.

2. \textit{Early Applications of Separability and Adoption of the Separability Test in the 1976 Act}

In 1966, a New York district court was presented with \textit{Ted Arnold Ltd. v. Silvercraft Co., Inc.},\textsuperscript{39} a case with facts very similar to \textit{Mazer}, but which arose in light of the regulation enacted by the

\begin{footnotesize}
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\item \textsuperscript{31} \textit{Id.} at 211-13. Fine art consists of works having the intrinsic function or purpose to be beautiful; objects of fine art are created for the primary or sole purpose of conveying the object's appearance. Thus, the object's intrinsic function is to be beautiful. Useful articles, on the contrary, have the primary function or concern to be "used" for some purpose beyond their appearance or beauty. \textit{See supra} note 3. Thus, a painting by Picasso has the intrinsic function of conveying its appearance, whereas an automobile has the intrinsic function to transport people, with its appearance being a secondary function.
\item \textsuperscript{32} \textit{Mazer,} 347 U.S. at 212.
\item \textsuperscript{33} \textit{Id.} at 218.
\item \textsuperscript{34} 37 C.F.R. § 202.10(c) (1957).
\item \textsuperscript{35} H.R. REP. NO. 1476, \textit{supra} note 3, at 54-55.
\item \textsuperscript{36} 37 C.F.R. § 202.10(c) (1957) (amended 1960).
\item \textsuperscript{37} 37 C.F.R. § 202.10(c) (1960).
\item \textsuperscript{38} \textit{Id.}
\item \textsuperscript{39} 259 F. Supp. 733 (S.D.N.Y. 1966).
\end{itemize}
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Copyright Office as it stood in 1960. Ted Arnold involved a simulation antique telephone which encased a pencil sharpener. Defendant had substantially copied the telephone pencil sharpener, but maintained that plaintiff's copyright was invalid because it was not a work of art but rather a work of utility. Perhaps for the first time, a court discussed the concept of physical separability. The court remarked, "It is crucial at this point to make clear that the copyrighted article is the simulation of an antique telephone, not the pencil sharpener inside, and not the combination of the two." The court concluded that the copyright for the antique telephone, apart from the mechanics of the pencil sharpener, was valid, since "[t]he telephone casing could be separated physically from the pencil sharpener." The court embraced the reasoning from Mazer when it concluded that, just as the statuette was unnecessary to support a lamp, the antique telephone was unnecessary to encase a pencil sharpener.

Between the Copyright Office's promulgation of section 202.10(c) and the passage of the 1976 Act, there were few other developments in this area. One case of interest, which was one of the final cases concerning works of applied art decided under the 1909 Act, is Esquire, Inc. v. Ringer. Although the case was decided in 1978, the articles in question were copyrighted prior to the effective date of the 1976 Act, which occurred on January 1, 1978. Since the 1976 Act had already passed, the court looked both to the 1976 Act and the House Report on the Act for guidance. Since consideration of the 1976 Act played a significant role in the court's determination in Esquire, this comment's discussion will first turn to the language of the 1976 Act and the legislative reports concerning works of applied art; thereafter the decision in Esquire will be reviewed.

The 1976 Act does not give exhaustive guidance in determining whether a useful article or features of that article qualify for copyright protection. On the general issue of copyright protection of use-

40. 37 C.F.R. § 202.10(c) (1960).
42. Id. at 734.
43. Id.
44. Id.
45. Ted Arnold, 259 F. Supp. at 735 (emphasis added).
46. Id.
49. Esquire, 591 F.2d at 802-04.
ful articles, the Act provides, "[c]opyright protection subsists in . . . pictorial, graphic and sculptural works." Further, the Act defines "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An item that is normally part of a useful article is considered a 'useful article.'" In order to determine the scope of copyright protection for "pictorial, graphic, or sculptural works" when such work consists of, or is part of a "useful article," one must turn to both the Act's definition of these works and the House Report. In defining "pictorial, graphic, and sculptural works," the Act states,

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.

Although the Act defines the scope of protection for useful articles, this language, standing alone, can support varying interpretations. Thus, it is necessary to look to the House Report for additional explanation.

The House Report begins its discussion of pictorial, graphic, and sculptural works by noting that this category does not carry with it an implied element of "artistic taste, aesthetic value, or intrinsic quality." This first statement opens the door for the inclusion and discussion of works of "applied art." Much of what is noted by the Report is the historical development of protection for works of applied art. Beginning with Mazer, the Report remarks that protection subsists despite factors such as mass production, commercial exploitation, and the potential availability of design patent protection.
The language that follows this introduction, qualified by the Report to "draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design," is the language that has caused the crux of the confusion in this area of law. The Committee Report explained:

The Committee has added language to the definition of "pictorial, graphic, and sculptural works" in an effort to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection. The declaration that "pictorial, graphic, and sculptural works" include "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned" is classic language: it is drawn from Copyright Office regulations promulgated in the 1940's and expressly endorsed by the Supreme Court in the Mazer case.

The second part of the amendment states that the "design of a useful article . . . 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."

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

Prior to the House Report, which was the result of determinations made by the Legislative Committee, the Senate had suggested a different approach to copyright protection for useful articles. The that any of the useful articles discussed in this comment could meet the stringent requirements to receive patent protection. See 1 DONALD S. CHISUM, PATENTS §§ 1.01-5.06 (1991). Thus, copyright is the only protection that these items could realistically receive.

Senate proposed that copyright protection should be afforded to useful articles subject only to the limitation that the design be original, and was not "dictated solely by the utilitarian function of the article that embodies it; or is composed of three-dimensional features of shape and surface with respect to men's, women's, and children's apparel." For the designs that could meet this lower standard, the Senate suggested that protection begin when the useful article was made public and would last for five years, with the opportunity for a five year renewal.

In proposing this new form of protection, the Senate aptly noted,

The title is intended to offer the creator of ornamental designs of useful articles a new form of protection directed toward the special problems arising in the design field, and is intended to avoid the defects of the existing copyright and design patent statutes by providing simple, easily secured, and effective design protection.

The House Committee did not accept this proposal but instead chose to adopt and "clarify" the existing state of protection for useful articles. By examining subsequent case law, this comment will discuss and then analyze the various interpretations that this "clarifying" language has been given by different courts and legal scholars.

Returning to Esquire, in which the manufacturer of outdoor lighting fixtures sought copyright protection for the "overall shape" of the fixtures as a "work of art," the appellate court applied the 1909 Act and Copyright Office and also looked to the House Report and the 1976 Act for guidance and support of its findings. The plaintiff filed a complaint after the Register of Copyrights refused to register the lighting fixtures. The Register's refusal was premised on section 202.10(c), which denied registration of utilitarian articles when the design elements for which registration is sought "are directly related to the useful functions of the article." According to the Register, the fixtures or their overall shape did not contain "ele-

61. *Id.* at 162.
62. *Id.*
63. *Id.* at 161.
65. See discussion *infra* parts II.B., III.A-C.
67. *Id.* at 799.
68. *Id.* at 798 (citing the Register's appellate brief).
ments, either alone or in combination, which are capable of independent existence . . . apart from the utilitarian aspect."\textsuperscript{69}

After discussing the rationale upon which registration was denied, the court reviewed the 1909 Act and section 202.10(c). The court concluded that the Register adopted a proper interpretation of the regulation since only the features of a utilitarian article could be protected, (not the article as a whole), and only to the extent that these features "can be identified separately and are capable of existing independently as a work of art."\textsuperscript{70} For further support, the court looked to the House Report and the new Act in relation to works of utility.\textsuperscript{71} The court began by noting that although the new Act was not applicable in this case, it was designed in part to codify and clarify existing law.\textsuperscript{72} The court noted the legislative language concerning separability, in that, unless the shape of a utilitarian article "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{73} However, after mentioning this language, the court brushed it aside by declaring, "any possible ambiguity raised by this isolated reference disappears when the excerpt is considered in its entirety. The underscored passages indicate unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright."\textsuperscript{74}

In addressing the separability issue, the court simply determined that only features or particular aspects of a utilitarian article may meet this standard.\textsuperscript{75} Thus, the court distinguished \textit{Mazer}, reasoning that the statuette was a separable feature of the overall design of the lamp, but in this case, the shape of the fixture was not a feature of the fixture but rather part of the fixture's overall design which was not subject to protection.\textsuperscript{76} Therefore, under \textit{Esquire}, separability turned on the issue of whether protection was sought for a feature of the overall design, as opposed to the overall design itself, and whether such a feature was separable from the utilitarian aspects of the article.\textsuperscript{77} In other words, the \textit{Esquire} court would only

\begin{itemize}
\item \textsuperscript{69} Id.
\item \textsuperscript{70} \textit{Esquire}, 591 F.2d at 800.
\item \textsuperscript{71} Id.
\item \textsuperscript{72} Id.
\item \textsuperscript{73} Id. at 803 (citing H.R. REP. No. 1476, supra note 3, at 55.)
\item \textsuperscript{74} \textit{Esquire}, 591 F.2d at 803-04.
\item \textsuperscript{75} Id.
\item \textsuperscript{76} Id. at 805.
\item \textsuperscript{77} Id. at 803.
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grant protection for artistic "features" of an article which were "physically" separable from the utilitarian aspects of the article.

B. Judicial Interpretation Since the Enactment of the 1976 Act

1. The Emergence of Conceptual Separability?

The first decision to consider the language of the House Report on the new Act, specifically the language, "some element that, physically or conceptually, can be identified as separable from the utilitarian object," was *Kieselstein-Cord v. Accessories by Pearl, Inc.* 78

Until this case, conceptual separability had no fundamental difference in meaning from physical separability, beyond the distinction that one could conceive of physically separating a particular element of the utilitarian object, such as the floral engraving on the back of a chair. Judge Oakes in *Kieselstein-Cord*, however, extended the theory of conceptual separability beyond the limited theory of physical separation, and in doing so opened the door for dispute in this complex and nebulous area of the law. 79 The Second Circuit has been presented with the most intriguing and troublesome cases regarding works of applied art, and the decisions from this jurisdiction are of great import. 80 The Supreme Court has not been faced with the issue of separability in works of applied art since its decision in *Mazer*. Therefore, as of the moment, the Second Circuit remains the authority on this issue. 81

Judge Oakes began the majority opinion by aptly noting that the issue presented before the court "is on a razor's edge of copyright law." 82 The utilitarian objects at issue were decorative, expensive belt buckles, elaborately designed and made of precious metals, such as gold and silver. 83 The belt buckles did not contain elaborate ornamentation, such as jewels or floral designs, rather, the designs or shapes of the buckles themselves were very "original" and distinctive. 84 The design of the buckles departed from the traditional geo-

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78. 632 F.2d 989 (2d Cir. 1980).
79. *Id.*
80. *See infra* note 138.
81. By "authority," it is not suggested that other circuits must follow the holdings of the Second Circuit. But, since the Second Circuit has had the greatest number of opportunities and the most difficult cases in this area, the opinions espoused by it should be influential upon other courts.
83. *Id.*
84. *Id.* at 990-91.
metric rectangle. 85 Instead, the designs contained a rectangular base, but were curved with grooves, containing several surface levels. 86 Describing the belt buckles in more detail is not significant to the analysis; what is important is that the buckles did not contain any "ornaments" that could be physically separated from the buckle itself. 87 Instead, the design of the buckle was the ornament for which protection was sought. 88 Of further interest was the fact that of the two belt buckles at issue, one was copyrighted prior to the enactment of the new Act, while the other was copyrighted after the 1976 Act became effective. 89

Since the defendant admitted to copying the plaintiff's belt buckles, the issue before the court was whether the copyrights granted for the belt buckles were valid. 90 Defendant asserted that the buckles were not copyrightable as works of utility, because nothing in the buckles could be identified separately from the utilitarian aspects. 91 Although both the 1909 and the 1976 Acts needed to be applied to the two buckles separately, the court was left with the problem of determining "when a pictorial, graphic, or sculptural feature can be identified separately from, and [is] capable of existing independently of, the utilitarian aspects of the article. This problem is particularly difficult because . . . such separability may occur either 'physically or conceptually.' " 92

Rather than echoing the narrow view that conceptual separability is equated to physical separability with the added component of conceiving the physical separation, Judge Oakes asserted the doctrine that copyright cannot subsist in the conceptual separation of an artistic element "flies in the face of the legislative intent as expressed in the House Report." 93 Unfortunately, in Kieselstein-Cord, Judge

85. Id. at 990.
86. Judge Oakes' description of the two buckles was as follows:
The Vaquero gives the appearance of two curved grooves running diagonally across one corner of a modified rectangle and a third groove running across the opposite corner. On the Winchester buckle two parallel grooves cut horizontally across the center of a more tapered form, making a curving ridge which is completed by the tongue of the buckle. A smaller single curved groove flows diagonally across the corner above the tongue.

Kieselstein-Cord, 632 F.2d at 990.
87. Kieselstein-Cord, 632 F.2d at 993.
88. Id. at 991.
89. Id.
90. Id. at 991.
91. Id. at 991-92.
92. Id. at 993 (citation omitted).
93. Id.
Oakes never espoused a test for determining the sufficiency of conceptual separability. In fact, he barely analyzed his basis for concluding that the buckles' design had reached the level of sufficient conceptual separability. Instead, Judge Oakes based his analysis on consumer reaction to the buckles. He stated, "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." As a result, the judge determined that the primary ornamental aspect of the buckles was conceptually separable from their subsidiary utilitarian function.

A few years later, the Eleventh Circuit decided Norris Industries, Inc. v. International Telephone and Telegraph Corp., a case in which plaintiff sued for infringement of a copyright on wire spoke wheel covers for automobiles. Although there was dispute among the parties over which Act applied, the court determined that, even though the 1909 Act applied in this controversy, the same result would follow under either Act. The court reasoned that the 1976 Act was simply a clarification of already existing principles because the House Report indicated that Congress was endorsing the Copyright Office's regulations in regard to the registrability of utilitarian articles. Therefore, the court looked to the 1976 Act and the House Report as "useful aids" in determining the issue of whether the wheel covers were copyrightable under the 1909 Act.

After first determining that the wheel covers fell under the

94. Id.
95. Id. at 993. In a dissenting opinion, Judge Weinstein stressed that, although the buckles were very attractive, they were nothing more than useful articles, because the artistic aspects were inseparable from the utilitarian function of holding up trousers. He was willing to accept that the narrow view of separability would in fact deny protection to otherwise artistic objects, if these objects were not useful articles. He stated:

The result does deny protection to designers who use modern three-dimensional abstract works artfully incorporated into a functional object as an inseparable aspect of the article while granting it to those who attach their independent representational art, or even their trite gimmickry, to a useful article for purposes of enhancement. Moreover, this result enables the commercial pirates of the marketplace to appropriate for their own profit, without any cost to themselves, the works of talented designers who enrich our lives with their intuition and skill. The crass are rewarded, the artist who creates beauty is not. ... It is the originator's success in completely integrating the artistic designs and the functional aspects of the buckles that preclude copyright.

Id. at 994. (Weinstein, J., dissenting).
97. Id.
98. Id. at 920.
99. Id. at 921.
100. Id.
"useful article" category, the court asked whether any element or elements could be physically or conceptually separable from the utilitarian article. After eliminating the aspects of the wheel cover that were strictly parts, the court had to determine if the arrangement of the spokes could be identified separately from the utilitarian article. In holding that the spokes did not meet this test, the court cited the Copyright Register's explanation that "the placement of the spokes is an inseparable component of the wheel cover. The spokes are attached to the rim and to the hub, and once the spokes are removed from their position the pattern ceases to exist."

In response to this reasoning, the plaintiff argued that the pattern of the spokes was conceptually separable. The court disagreed and held that the design of the spokes and the wheel covers themselves did not meet the test of conceptual separability because, the spokes were "not superfluous ornamental designs, but functional components of utilitarian articles." In an attempt to distinguish Kieselstein-Cord, the court remarked that the form of jewelry has traditionally been afforded copyright protection, whereas the shape of a useful article has traditionally not been afforded copyright protection. Nonetheless, the court failed to note that in Kieselstein-Cord, the belt buckles were considered "useful articles."

At the same time that the Eleventh Circuit decided the Norris case, the Ninth Circuit decided Fabrica Inc. v. El Dorado Corp. Fabrica was a copyright action for infringement of a carpet display folder. The folder was described as a distinctive, high-quality display folder, covered by simulated white suede, with stitching along the borders and brass tips on the corners, featuring a unique fold-out book format. The defendant admitted that it copied the folder but denied infringement on the basis that the folders were works of utility with inseparable features. The court agreed with the defendant but provided little discussion on the issue of separability.

101. Id. at 922-23.
102. Id. at 923.
103. Id.
104. Id.
105. Id. at 924.
106. Id.
108. 697 F.2d 890 (9th Cir. 1983).
109. Id.
110. Id. at 892.
111. Id.
112. Id. at 893-94.
court simply noted that the folders lacked any artistic feature which was identifiable as separate from the utilitarian aspects, because the folder's only purpose was to market the carpeting. The court did not extrapolate on this point, and one wonders how much emphasis the court placed on the purpose or intent behind the creation of the useful article, or features of that article.

Shortly thereafter, the Sixth Circuit was presented with a dispute over the copyrights for toy airplanes in *Gay Toys, Inc. v. Buddy L Corp.* The significance of this case is founded upon the court's interpretation of new language in the 1976 Act in regard to useful articles, and the court's determination that toys which portray useful articles are not themselves useful articles under the statutory definition.

At issue were model airplanes that were allegedly copied by petitioner. The district court concluded that the toys were useful articles since a "toy airplane is useful and possesses utilitarian and functional characteristics in that it permits a child to dream and to let his or her imagination soar." The court of appeals flatly rejected this broad interpretation of the term "useful article." Instead, the appellate court maintained that in spite of the fact that the definition of "useful article" had been expanded by the 1976 Act, the Act did not sweep all articles which have a "use" into the category of "useful articles." Rather, for an article to fall within the category of "useful articles," it must have "an intrinsic utilitarian function that is not merely to portray the appearance of that article." Toy airplanes are not "useful articles" because the toys are merely a model or portrayal of the "useful article." The court remarked, "a toy airplane is to be played with and enjoyed . . . . [O]ther than the portrayal of a real airplane, a toy airplane, like a painting, has no intrinsic utilitarian function." Therefore, since the toys were not "useful articles," it was irrelevant to discuss separability.
"useful articles" which qualify as "sculptural works" are limited by the separability test.124 As to the toys before the court, copyright protection would subsist in the expression of the idea, provided that the other requirements for copyrightability are met.125 The Gay Toys decision is significant in that toys were held not to have an "intrinsic utilitarian function," either in the utilitarian object the toy represented nor in the fact that toys function as play-things for children.126 Thus, according to this court, whatever utilitarian function the toys may have, this function is not its "intrinsic" function.127 The concept of a useful article, then, is not so broad as to include any article which may have a significant utilitarian function, so long as such function is not considered "intrinsic."

Approximately one year later, the ball was back in the Ninth Circuit's court. In Poe v. Missing Persons,128 the plaintiff had created what he titled "artwork in the medium of soft sculpture," whereby the soft sculpture represented a woman's swimsuit.129 The swimsuit was based on a two-piece swimsuit made primarily of clear plastic.130 The female anatomical parts which are traditionally covered by two-piece swimsuits were covered in this swimsuit by filling the plastic pockets with crushed colored rock in the appropriate areas.131 Infringement was alleged to have occurred through the unauthorized use of a model wearing the sculpture, which was then displayed on the cover of a Missing Persons' musical album.132

Since the plaintiff was appealing the grant of summary judgment in favor of the defendant, the issue presented for the court of appeals was whether or not a genuine issue of material fact existed.133 In reviewing the result below, the court had to decide whether the article in question fell within the category of "useful articles" by virtue of the "fact" that it was a swimsuit, or whether it was a "sculptural work." As a sculptural work, it would not be lim-

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124. Id.
125. The other requirements under the Act are originality and fixation, as discussed supra, note 12.
126. Gay Toys, 703 F.2d at 973.
127. Id.
128. 745 F.2d 1238 (9th Cir. 1984).
129. Id. at 1239-41.
130. Id. at 1241.
131. Id.
132. Missing Persons is a musical group, which gained popularity in the late 1970's and early 1980's. Poe, 745 F.2d at 1240-41.
133. Id. at 1241 (quoting M/V American Queen v. San Diego Marine Constr., 708 F.2d 1483, 1487 (9th Cir. 1983)).
ited by the separability requirement for "useful articles." Since determination of whether the article was a swimsuit (and thus a "useful article") raised a question of fact, as opposed to a question of law, summary judgment was held inappropriate.

The Ninth Circuit distinguished Gay Toys on the grounds that the articles in that case were "toys" as a matter of fact, so that the determination that "toys" are not "useful articles" was a question of law. Whereas, in Poe, the categorization of the article raised a factual question; it was not a question of law. The court then identified four types of relevant evidence which could aid the trier of fact in determining whether the article is in fact a "useful article": 1) expert evidence regarding the usefulness of the article; 2) evidence of plaintiff's intent in designing the article, as it weighs on the issue of utilitarian function; 3) testimony of custom within the art and clothing trade in regard to the article in question; and 4) the marketability of the article as a swimsuit.

2. Current State of Conceptual Separability

This comment examines two of the leading cases in which the contemporary test for separability, either physical or conceptual, has been developed. Since these cases represent the state of the law as it now stands, much of this comment's analysis focuses on the various tests and factors which have been presented by both the majority and dissenting opinions in these cases.

In 1985, the Second Circuit decided Carol Barnhart Inc. v. Economy Cover Corp., a case that exposed the shortcomings of the statutory language and prior case law on the issue of separability. Barnhart involved four styrene mannequins for which the plaintiff held copyrights. The mannequins were very different from con-

134. 745 F.2d 1238, 1242 (9th Cir. 1984).
135. Id. at 1242-43. Poe was heard before a jury.
136. 745 F.2d at 1242.
137. Id. at 1243.
138. Id. (citing, Trans-World Mfg. v. Al Nyman & Sons, Inc., 95 F.R.D. 95, 99 (D. Del. 1982); Sarony Products v. Guerlain, Inc., 513 F.2d 716 (9th Cir. 1975); Norris Indus. v. Inl'l Tel., 696 F.2d 918, 922 (11th Cir. 1983); Cf. May v. Morganelli-Heumann & Associates, 618 F.2d 1363, 1368 (9th Cir. 1980); M. Nimmer, NIMMER ON COPYRIGHT § 2.08 (B) at 2-96.2-2.96.3 (1984)).
139. Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985); Brandir Inl'l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142 (2d Cir. 1987).
140. Barnhart, 773 F.2d 411.
141. Id.
142. Id. at 412-13.
ventional mannequins because they were not representations of the entire body.\textsuperscript{143} The life-size mannequins developed by the plaintiff were created to display shirts, jackets and sweaters, and therefore only represented the front of the human torso, but contained no neck, arms, or back.\textsuperscript{144} Of the four mannequins, two represented male and two represented female torsos.\textsuperscript{145} For both genders, there was one nude and one clothed torso, with the clothed torsos having pre-sculpted dress shirts in order to display such clothing as sweaters and jackets, without the store having to place a dress shirt on the mannequin.\textsuperscript{146} The nude torsos were anatomically accurate as to the frontal aspects, whereas the backs were hollowed-out to hold excess fabric when the garment was fitted onto the form.\textsuperscript{147} Defendant admitted copying the mannequins developed by plaintiff, thereby prompting an infringement action.\textsuperscript{148}

Although it is not of great importance to imagine or perceive the mannequins' actual appearance, what is important is to understand that the mannequins were distinctively different from the traditional, full-figured mannequins of the time. As a result of their uniqueness, the mannequins pushed the language of the 1976 Act to its limits, and forced the court to determine what is perhaps the most difficult test under the separability requirement. What made the copyrightability of the mannequins such a difficult issue was that it was the design itself of the mannequins for which copyright protection was sought.\textsuperscript{149} Unlike a pencil sharpener encased in an antique telephone, no part or element of the mannequins could be physically separated (either literally or figuratively).\textsuperscript{150} Instead, if protection were to be afforded for the mannequins, such protection would have to be founded wholly upon conceptual separability of some artistic element which was, however, inextricably intertwined with the physical requirements of utility.\textsuperscript{151}

Since the mannequins were “useful articles” under the statute, the issue presented in Barnhart was whether the mannequins “possess[ed] artistic or aesthetic features that were physically or concep-
tually separable from their utilitarian dimension." In writing the
majority opinion, Judge Mansfield ruled that the mannequins were
not proper subject matter for copyright protection because there was
no aesthetic or artistic features which were separable from the utili-
tarian aspects of the article, for such features "cannot be conceptual-
ized as existing independently of their utilitarian function."

After invalidating the copyrights on the mannequins, Judge
Mansfield attempted to distinguish Kieselstein-Cord from Barn-
hart. He stressed that the crucial difference between the belt
buckles and the mannequins was the fact that the belt buckles con-
tained "ornamentation" in their design. Judge Mansfield reasoned
that since there was no visual ornamentation present in the manne-
quins, then there was no artistic or aesthetic aspect which could be
conceptually separate from and independent of the utilitarian aspects
of the mannequins. He commented:

What distinguishes those buckles from the Barnhart forms is
that the ornamented surfaces of the buckles were not in any
respect required by their utilitarian functions; the artistic and
aesthetic features could thus be conceived of as having been
added to, or superimposed upon, an otherwise utilitarian article.
The unique artistic design was wholly unnecessary to the per-
formance of the utilitarian function.

In juxtaposing the mannequins with the belt buckles, Judge
Mansfield reasoned that the shape of the figure was "inextricably
intertwined with the utilitarian feature..." He concluded there-
fore, that in order for a mannequin to function, the functional re-
quirements dictate that the form or overall design must be that of the
human figure, these designs or artistic features could not be concep-
tually (or physically) separated from their utilitarian function. On
the other hand, a belt buckle could function as such without
ornamentation.

In dissent, Judge Newman denounced the holding and rationale
of the majority and proposed a new test for determining conceptual

152. Id. at 414.
153. Id. at 418.
154. Id. at 418-19. For a discussion of Kieselstein-Cord v. Accessories by Pearl, Inc.,
632 F.2d 989 (2d Cir. 1980), see supra footnotes 78-95 and accompanying text.
155. Id.
156. Id. 418-19.
157. Id. at 419 (citation omitted).
158. Id.
159. Id.
160. Id. at 419.
separability. In beginning his analysis Judge Newman stated that whatever conceptual separability means, it must mean something different than physical separability, and thus it becomes “obvious that a design feature can be ‘conceptually separable’ from the utilitarian aspect of a useful article even if it cannot be separated physically.” Judge Newman then surveyed the previously proposed tests before offering his standard for conceptual separability.

Judge Newman started with Judge Oakes’ opinion in Kieselstein-Cord, discounting this test due to its inability to give guidance to the trier of fact. He also faulted Judge Oakes’ test for placing emphasis on whether the “utilitarian” or the “artistic” aspect was “primary” to the article. Judge Newman implied that under this test the belt buckles would not be afforded protection because the buckles were primarily used to fasten belts.

Judge Newman next referred to Professor Nimmer’s approach, which suggested that conceptual separability existed when “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.” Judge Newman swiftly pointed out that this approach would provide protection only for popular art, and many forms which are artistic and popularly pleasing would fail to meet this standard because those who are willing to purchase these articles may not be a “significant segment of the community.”

Lastly, he challenged the view that protection should be afforded whenever the “form has sufficient aesthetic appeal to be appreciated for its artistic qualities.” This approach was unacceptable to Judge Newman because it had been rejected by Congress and flew in the face of the House Report’s mandate that the copyrightable features of a work of applied art must be physically or conceptually separable from the utilitarian aspects of the article.

After criticizing these earlier tests for determining conceptual

161. Id. at 419-26 (Newman, J., dissenting).
162. Id. at 421 (footnote omitted).
163. Id. at 421-22.
164. Id. at 421.
165. Id. at 421 (Newman, J., dissenting).
166. Id.
167. Id. (emphasis added) (quoting NIMMER, supra note 8, § 2.08[B], at 2-100 (footnote omitted)).
168. Id. at 421-22 (Newman, J., dissenting).
169. Id. at 422.
170. Id.
separability, Judge Newman proposed what has been described as a "displacement test."³⁷¹ Judge Newman asserted that the artistic features of a useful article are separable when the article stimulates in the ordinary observer a "concept" which is independent from the article's utilitarian "concept."³⁷² Further, this "concept" which is perceived independently from the utilitarian function is to be conceived at a different moment than the concept of the article's utility.³⁷³ As Judge Newman explained:

[T]he article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function. The test turns on what may reasonably be understood to be occurring in the mind of the beholder or, as some might say, in the "mind's eye" of the beholder. This formulation requires consideration of who the beholder is and when a concept may be considered "separate."

I think the relevant beholder must be that most useful legal personage - the ordinary, reasonable observer . . . .

I think the requisite "separateness" exists whenever the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously . . . whether the concept of the utilitarian function can be displaced in the mind by some other concept.³⁷⁴

Judge Mansfield responded to Judge Newman's "displacement" test via a footnote in the majority opinion.³⁷⁵ He criticized the novel approach by Judge Newman as being "so ethereal as to amount to a 'non-test' that would be extremely difficult, if not impossible, to administer or apply."³⁷⁶ This criticism was founded on the premise that the "displacement" test would depend on how the article was displayed, and almost any article could be displayed in such a fashion that it would meet the requisite standard.³⁷⁷ Further, Judge Mansfield noted that under Judge Newman's standard, copyright protection could be founded upon "temporary flight of fancy that could attach to any utilitarian object . . . depending on how it is displayed."³⁷⁸

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171. Perlmutter, supra note 21, at 375-77.
173. Id.
174. Id. at 422.
175. Id. at 419 n.5.
176. Id. at 419 n.5 (Newman, J., dissenting).
177. Id.
178. Id.
As a result of the majority opinion in *Barnhart*, it remained uncertain whether purely "conceptual" separability was a strong enough doctrine to provide an independent foundation for copyright in the artistic elements of a useful article. Further, Judge Mansfield's statement distinguishing the mannequins from the belt buckles, questioned if conceptual separability could ever be found solely in the design of a useful article.\[^{179}\]

Judge Mansfield's majority opinion did not, however, settle the issue of conceptual separability. A few years after *Barnhart*, the Second Circuit was once again confronted with the issue of conceptual separability in *Brandir International Inc. v. Cascade Pacific Lumber Co.*\[^{180}\] This case afforded Judge Oakes another opportunity to analyze this troublesome theory and shed more light on his opinion in *Kieselstein-Cord*.

The article in dispute in *Brandir* was the "RIBBON Rack" bicycle rack, made of bent tubing, which was adapted from an original wire sculpture.\[^{181}\] The defendant admitted to copying the bicycle rack, but denied infringement, thereby raising the issue of conceptual separability once again.\[^{182}\]

Judge Oakes' opinion for the court claimed that, since *Kieselstein-Cord* was distinguished in *Barnhart*, the former case was still good law.\[^{183}\] Rather than expand on his holding or rationale in *Kieselstein-Cord*, Judge Oakes decided to adopt the reasoning from Professor Denicola's article on applied art.\[^{184}\] Denicola's test stressed the relationship between the final work and the process in which that design came to fruition.\[^{185}\] Thus, if an article's process is dictated solely by utilitarian concerns, which, as most industrial designs are, nothing in the article deserves copyright protection.\[^{186}\] On the other hand, those aspects of the design "whose origins lie outside the design process, despite the utilitarian environment in which they appear," should be afforded copyright protection.\[^{187}\] Under Denicola's view, the determination of copyright "ultimately should depend on the extent to which the work reflects artistic expression uninhibited

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\[^{179}\] *Id.* at 418-19. For a more detailed discussion of this point, see *infra* notes 229-40 and accompanying text.

\[^{180}\] 834 F.2d 1142 (2d Cir. 1987).

\[^{181}\] *Id*.

\[^{182}\] *Id*.

\[^{183}\] *Id.* at 1144.


\[^{185}\] *Brandir*, 834 F.2d at 1145; Denicola, *supra* note 9, at 741.

\[^{186}\] *Brandir*, 834 F.2d at 1145; Denicola, *supra* note 9, at 741.

\[^{187}\] *Brandir*, 834 F.2d at 1145; Denicola, *supra* note 9, at 741 (citation omitted).
by functional considerations." Judge Oakes embraced Denicola's analysis and then rephrased the test for conceptual separability as follows: "[I]f design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists."

Through the Denicola test, Judge Oakes sought to harmonize the apparent conflict between Barnhart and Kieselstein-Cord. He rationalized that, under the Denicola test, the mannequins which were denied copyright protection by the court would fail because the artistic features found in the anatomical design and the sculpted clothing "showed clearly the influence of the functional concerns."

In applying this test to the bicycle racks, Judge Oakes denied copyright protection by concluding that, although the form of the rack was artistic, this artistic form was "influenced in significant measure by utilitarian concerns . . . ." Therefore, under the Denicola test, when the artistic features follow the utilitarian requirements, conceptual separability does not exist, and the artistic features are not protected by copyright.

After applying the Denicola standard, Judge Oakes commented that if the sculpture had not been adapted to fulfill the needs of the utilitarian article (namely a bicycle rack), then the design would be protected. That is, if the original artist had by chance previously created a sculpture without utilitarian considerations, and subsequently such a sculpture could function as a bicycle rack without utilitarian adaptations, then such a design would pass the Denicola test, despite its utilitarian end.

What differentiates Judge Oakes' conceptual separability test from others is that his test requires an inquiry into the "artist's" intent when designing the object. In determining whether the design of the article was compelled by utilitarian or purely aesthetic needs, Judge Oakes remarked that the parties would be "required to

188. Brandir, 834 F.2d at 1145; Denicola, supra note 9, at 741 (citation omitted).
189. Brandir, 834 F.2d at 1145.
190. Id.
191. Id.
192. Id. at 1147.
193. Id.
194. Id. at 1148.
195. Id. at 1147.
196. Id. at 1147-48.
present evidence relating to the design process and the nature of the work . . . " 197 Under this test, if any features could be identified as existing independently of utilitarian influences, such features would be considered the result of artistic judgment or intention and would receive protection. 198 However, just as Barnhart may not have overruled Kieselstein-Cord, it is questionable as to whether the rationale of Brandir will set precedent, and/or replace the reasoning of Barnhart. 199

III. Analysis

Distinguishing between what does and does not qualify as art is inevitably a subjective and arbitrary procedure, but also a truly important one. The need for distinguishing between an object’s functional and aesthetic qualities is founded upon Congress’ legitimate fear that granting copyright protection to useful articles would deter progress. 200 Since copyright protection provides the copyright owner with exclusive rights, 201 protecting the functional aspects of a useful article would fundamentally give the copyright owner a monopoly over that article, stifling progress of the arts and sciences by depriving others of the economic incentive to create. 202 Such a result would be contrary to the purpose of affording copyright protection in the first place. As provided in the Constitution, “The Congress shall have the Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . ” 203 Therefore, the ultimate purpose of copyright is to promote science and art and protection of the author’s rights is seen as a necessary

197. Id. at 1145.
198. Id. at 1145-48.
199. Since Judge Mansfield distinguished Barnhart from Kieselstein-Cord on the basis that one case involved mannequins and the other involved belt buckles, Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411, 418-19 (2d Cir. 1985), it seems that any case could be distinguished from prior cases on the basis that different objects are in question. Also, the mere fact that Judge Oakes chose to create his own test, as opposed to following the majority’s rationale in Barnhart, leaves the door open for the next majority opinion to discard his test.
203. U.S. CONST. art. I, § 8, cl. 8. “Writing” under this part of the Constitution has been defined very liberally to encompass all forms of expression. See Burrows-Giles Lithographing Co. v. Sarony, 111 U.S. 53 (1884); Nimmer, supra note 8, § 1.06.
means for such promotion.\textsuperscript{204} By providing the author with exclusive rights for a limited term,\textsuperscript{205} authors will be encouraged to create, because they will be assured the fruits of their labor.\textsuperscript{206} Without assurance of protection, many authors would be discouraged from creative activity, and progress would lag.\textsuperscript{207}

There is a delicate balance between providing enough protection to encourage creation and providing too much protection which, although protecting the original author, discourages or prohibits others in a similar field from pursuing their own efforts.\textsuperscript{208} The law concerning the protection of useful articles has shown just how difficult this balancing can become, especially when commercial products are involved and much of the economy depends on competition within commercial fields.\textsuperscript{209}

As is clear from the House Report, the useful article itself is not intended to be protected.\textsuperscript{210} Instead, protection may be granted only for the aesthetic elements which are either physically or conceptually separable from the utilitarian aspects of the article.\textsuperscript{211} As straightforward as this distinction may seem, courts have found it very difficult to apply a consistent standard in separating the artistic from the functional.\textsuperscript{212} Ideally, if founded on a fixed standard, even if arbitrarily fixed, drawing the line between the aesthetic and the functional elements of an object would eliminate the vastly differing opinions concerning what may be and what should not be considered "art." But, as will be suggested below, judges have either followed highly abstracted tests, or have on their own initiative chosen to draw their own subjective line between art and utility.\textsuperscript{213} Chronologically surveying the contemporary opinions involving the application of conceptual separability to useful articles, it will be shown that

\begin{itemize}
  \item[204.] 347 U.S. at 219; Nimmer, supra note 8, § 1.03[A].
  \item[206.] Mazer, 347 U.S. at 219; Nimmer, supra note 8, § 1.03[A].
  \item[207.] Mazer, 347 U.S. at 219; Nimmer, see supra note 8, § 1.03[A].
  \item[208.] Mazer, 347 U.S. at 219; Nimmer, supra note 8, § 1.03[A]. "Author" in this context refers to any person who is the creator of an original, fixed expression, in any tangible medium, such as print, motion picture, sculpture, or music. See generally id. §§ 1.06, 1.08[B], [F]; Burrows-Giles Lithographing Co. v. Sarony, 111 U.S. 53 (1884), the Court interpreted "author" under art. I, § 8, cl. 8, of the Constitution, to mean "[h]e to whom anything owes its origin." Id. at 58.
  \item[209.] See generally Nimmer, supra note 8, § 2.08.
  \item[212.] See supra notes 78-199 and accompanying text.
  \item[213.] See infra notes 214-55 and accompanying text.
\end{itemize}
these tests fail either in their reasoning or application. Once these
tests have been criticized, either a new standard or a more objective
test can be created, one which sufficiently protects artists and
removes from the judiciary the impossible and inherently non-judic-
ial task of judging what qualifies as "art."

A. Kieselstein-Cord: Recognition of Separability in the Design of
the Object

As noted earlier, the importance of the Kieselstein-Cord case is
not found in its rationale, but rather in both the subject matter of the
dispute and the holding that the ornamental features were conceptu-
ally separable from the utilitarian requirements of the belt buckles. In light of the Barnhart decision, it was unfortunate
that Judge Oakes chose to label the separable protected features as
"ornamental." Labeling the features as ornamental suggests that
these features were attached or added onto the belt buckles. From
the language of the opinion it is difficult to determine whether Judge
Oakes was using the term "ornamental" to mean an embellishment
upon the article, or simply an addition within the article which adds
beauty to the function. In his opinion, it appears that by "orna-
mental," Judge Oakes was simply trying to distinguish between "ar-
tistic" features and "utilitarian" features, thereby suggesting that he
meant any ornamental aspect which adds beauty to the mere func-
tional elements of the object. Although precisely defining this term
is very important to this issue of law, his decision did not turn on
whatever meaning Judge Oakes meant to give to "ornamental."

As also noted earlier, Judge Oakes provided very little explana-
tion as to the court's determination that the buckles' design met the
criteria for conceptual separability. He concluded that conceptual

\[214. \text{Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980).}
\[215. \text{773 F.2d 411 (2d Cir. 1985). See infra notes 226-36 and accompanying text.}
\[216. \text{Kieselstein-Cord, 632 F.2d at 993.}
\[217. \text{See Barnhart, 773 F.2d at 418. See also infra notes 226-36 and accompanying text.}
\[218. \text{This distinction is very important, for an ornament which embellishes an object is a}
\text{physical addition which is not completely integrated into the article's functional elements. On}
\text{the other hand, an ornament which adds beauty to the article may do so intrinsically through}
\text{the article's design. Thus, an embellished ornament may be physically separated without af-
\text{fecting the article's function, whereas a design which is ornamental may only be conceptually}
\text{separated.}
\[219. \text{Kieselstein-Cord, 632 F.2d at 993.}
\[220. \text{Id.}
\[221. \text{See supra notes 78-95 and accompanying text.}
separability existed, and then explained that body ornamentation has been an art form for centuries and that many of the owners of the buckles wore them solely for appearance or jewelry, not as functional belt buckles. The question thereby raised, but not explored, is should the ultimate use the consumer chooses for the article be determinative or even relevant in deciding whether there are aesthetic features which are conceptually separable from the utilitarian aspects? Judge Oakes' line of inquiry seems to be misplaced. An inquiry into consumer use is relevant when the court is determining whether or not an object should be considered a useful article, but consumer use should carry much less weight when determining conceptual separability. Either the design of the buckle is separable from the utilitarian aspects of the buckle when it was first manufactured, or separability is lacking. Although the use a consumer puts to an object may highlight its artistic features, this subsequent use is neither what gives the object artistic qualities nor what gives it artistic worth. What actually occurs after the product has left the manufacturer does not bear on whether an article is artistic or contains any element which is conceptually separable. If the buckles had not been so popular nor worn as anything but a belt buckle, would the court fail to find conceptual separability? If so, the result would be a determination based on judicial speculation about consumer taste and court decisions defining what is artistic. This test could only lead to inequitable results in the courts. If apart from this line of reasoning, the court would still have found the design of the buckles separable, then consumer use is properly considered a post hoc rationalization. Thus, the decision in Kieselstein-Cord leaves us with little more than the tautology that conceptual separability existed in the belt buckles, because it existed in the belt buckles. The most persuasive verdict on the insufficiency of the Kieselstein-Cord rationale comes from Judge Oakes himself. It was Judge Oakes who developed the extensive and different test for conceptual separability in Brandir.

222. Kieselstein-Cord, 632 F. 2d at 993-94.
223. Judge Mansfield asserted that the problem with a test based on the ordinary person's observation was that such an observation may attach to a temporary flight of fancy, resulting in protection for every useful article. Carol Barnhart v. Economy Cover Corp., 773 F.2d 411, 419 n.5 (2d Cir. 1985). Judge Newman also pointed out that a test based on consumer use fails to account for the object's actual and intended use. Id. at 421 (Newman, J., dissenting).
224. Kieselstein-Cord, 632 F.2d at 993. This test has been described as, "We know it when we see it." Perlmutter, supra note 21, at 359.
225. Brandir Int'l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142 (2d Cir. 1987); see supra notes 184-95 and accompanying text.
B. *Barnhart: Narrowing the Scope of “Conceptual.”*

The mannequins involved in the *Barnhart* case could be protected only if the overall design could be protected, and the court was forced to determine whether any aspect of the mannequins could be conceptually separated from the utilitarian requirements of the articles.\(^\text{226}\) A reading of Judge Mansfield's majority opinion suggests that he was following the reasoning from *Kieselstein-Cord*,\(^\text{227}\) because he gives little in the way of defining conceptual separability, but determines that it cannot be found in the figures.\(^\text{228}\)

As noted in the dissent, whatever is meant by "conceptual," it must have a different meaning than "physical."\(^\text{229}\) As simple as that statement may appear, Judge Mansfield's opinion either fails to recognize this distinction or intends to restrict conceptual separability to the imagination of physical separation.\(^\text{230}\) Judge Mansfield fails to find conceptual separability in *Barnhart* because "the life-size configuration of the breasts and the width of the shoulders, are inextricably intertwined with the utilitarian feature, the display of clothes."\(^\text{231}\) Thus, for Judge Mansfield, nothing could actually or conceptually be removed from the mannequins which was not also a functional or utilitarian part of the mannequin.\(^\text{232}\) But is Judge Mansfield right in that conceptual separability is merely conceiving of physical separation? If so, then why did the language of the House Report state, "[u]nless the shape . . . contains some element that, physically or conceptually, can be identified separably from the utilitarian aspects of that article, the design would not be copyrighted."\(^\text{233}\) Thus, conceptual must mean something other than physical, contrary to Judge Mansfield's analysis.

Judge Mansfield also failed to consider whether conceptual separability might lie in the design of the mannequins; that is, not in any part of the object taken separately, but in the design of the object itself as an artistically separate element from the utilitarian requirements of the object. Few would question that in order for a mannequin to function, there must be a life-like representation of the

\(^{226}\) *Barnhart*, 773 F.2d at 417.

\(^{227}\) *Kieselstein-Cord*, 632 F.2d at 993.

\(^{228}\) *Barnhart*, 773 F.2d at 418-19.

\(^{229}\) See *id.* at 420; see *supra* note 162 and accompanying text.

\(^{230}\) See *Barnhart*, 773 F.2d at 418-19.

\(^{231}\) *id.*

\(^{232}\) *Id.* at 419.

human chest and width of shoulders, but how the designer chooses to actually represent or design these necessities may reach the level of creativity and originality sufficient to achieve an aesthetic quality. Although the Barnhart forms required that there be an accurate representation of the human chest and shoulders, because the forms were to function as mannequins, there was no requirement that the mannequins be designed lacking arms, having hollowed-out backs, made of styrene, or even have the particular shape chosen for the breasts or shoulders. In fact, the mannequins could have been designed in a form which was more muscular, heavy, or twisted. When the physical manifestation of an object is not completely dictated by its function, design can reach the level of aesthetic beyond the physical addition of an unnecessary part which can be easily identified as "artistic."

Judge Mansfield's failure to recognize conceptual separability independent of physical separation is further illustrated in his attempt to distinguish the mannequins from the Kieselstein-Cord belt buckles.\footnote{234} He declared that what separates the mannequins from the belt buckles was that in the belt buckles, "the artistic and aesthetic features could thus be conceived of as having been added to, or superimposed upon, an otherwise utilitarian article."\footnote{235} If separation is dependent upon whether or not one could conceive of the artistic features as added to or superimposed upon the object, then the mere design of the object could never meet this test, because only ornaments of embellishment may be added to or superimposed upon the design. This line of reasoning employed by Judge Mansfield effectively eliminates conceptual separability, in that separate inquiries into either physically adding or conceptually imagining such a physical addition are species of the same genus, namely physical separation. To give effect to the legislative intent, conceptual separability should, however, rest on an independent determination, regardless of whether any part can actually be or imagined to be physically detached, and recognized as artistic.\footnote{236}

Returning to the original premise of this comment, would David be afforded copyright protection under the Barnhart test? If David were created life-sized as a mannequin for clothing displays, Judge Mansfield would have to answer no. According to the logic of the Barnhart opinion, since nothing of David could be "conceived of

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234. Barnhart, 773 F.2d at 419.
235. Id.
236. Barnhart, 773 F.2d at 420 (Newman, J., dissenting); H.R. REP. No. 1476 supra note 3, at 55.
as been added to, or superimposed upon, an otherwise utilitarian article," there would not be any form of copyright protection for David. That is, since David does not contain any ornamental embellishment, nothing could be physically separated or imagined to be physically separated as solely artistic. The result of such a narrow view of separation, and what reeks of either misplaced artistic elitism or poor reasoning, is in fact discouragement of progress in the arts, the fundamental object of copyright law. The post-modern art age has expanded beyond the traditional art forms and often manifests and represents itself in everyday items. If copyright law fails to recognize art forms which have not yet become either mainstream or historically recognized, then it is failing in its ultimate purpose of promotion of progress, for progress does not evolve through recognition of the historical, but through recognition of what is current.

The short-sightedness of the majority's opinion was recognized by Judge Newman. Although Judge Newman made some important points in his dissent, the test he suggested, as Judge Mansfield aptly remarked, is too subjective and ephemeral to provide either much guidance to, or uniformity in, subsequent decisions. Judge Newman's "displacement" test has an attractive intellectual flavor to it, but is too abstracted from ordinary observation. The assertion that conceptual separability exists when the object stimulates "in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function . . . [and these] are not inevitably entertained simultaneously," rests on unstated and untested assumptions about how the reasonable observer thinks. It is doubtful whether any observer would look at a useful article and take note of a concept that is completely free from the object's intended and actual use. It is difficult to imagine that the ordinary observer viewing a mannequin at a clothing store would be able to conceive of the mannequin as aesthetically pleasing without at the same time thinking of the display function served by the mannequin. The ordinary observer is more likely to consider the object for its use, and at the

237. Barnhart, 773 F.2d at 419.
238. A simple example would be a sculpture of a chair, which functions as a chair, but is shaped like an "s." That is, its legs are curved in one direction, and its back is curved in the opposite direction, creating somewhat of a visual illusion, while being able to function as a chair. Therefore, although the design of the chair is completely functional, it is that design alone which encompasses aesthetic qualities.
240. Barnhart, 773 F.2d at 419 n.5.
241. Id. at 422 (Newman, J., dissenting).
same time consider its aesthetic appeal. Even if such a phenomenon could occur, application of this standard could never find its way to the neighborhood of objectivity. A judge’s opinion of whether a reasonable observer could independently conceive of a concept other than the article’s utilitarian concept leads directly into an inquiry of artistic value. Given the particular object in question, a judge would be forced to consider what level of artistic appeal that object may have to the reasonable observer, and whether that level of appeal is sufficient to create a concept independent of the object’s utilitarian purpose. Copyright law should be wary of any test which grants or denies protection on the basis of the reasonable observer’s judgment as to aesthetic quality. In order to promote the advancement of art, a society must recognize what is on the cutting edge, and the reasonable observer test recognizes only what is either on its way or what is already mainstream. The very nature of the word “reasonable” suggests recognition as “art” of that which is not too excessive, esoteric or unrecognized as an art form. It is a contradiction to suggest that the reasonable observer would recognize the most up to date forms of expression as forms of “art.”

Clearly, Judge Newman’s test does have some undeniable appeal to it, if only there was a way to take the ordinary observer and test whether the two concepts (utility and aesthetic) could be entertained independently. At least one scholar has also found Judge Newman’s test very attractive, but unworkable. In a thorough analysis of conceptual separability, Shira Perlmutter suggests that an adaptation of Judge Newman’s test is the best solution. According to Perlmutter,

This adaptation would preserve the core of the test—the emphasis on the ordinary observer’s ability to perceive the object as a work of art. It would drop, however, the “either/or” aspect—the additional requirement that this perception be capable of completely displacing the perception of usefulness. Instead, it would be sufficient if the observer could perceive of the article as having both functions, whether simultaneously or at one time.

242. It was also noted by Judge Mansfield that such a test could be met by “a temporary flight of fancy that could attach to any utilitarian object.” Barnhart, 773 F.2d at 419 n.5. Judge Newman’s test probably avoids this pitfall because his test is based on the ordinary, reasonable observer, which by its very definition is not swayed by “temporary flight of fancy.” Id. at 422 (Newman, J., dissenting).

243. Perlmutter, supra note 21, at 375.

244. Id. at 377.

245. Id.
Although Perlmutter removes perhaps the most ephemeral requirement of Judge Newman's test, her test is subject to similar pitfalls.

Leaving aside the problems of subjective interpretation of artistic quality as discussed above, an inherent problem with tests which use a reasonable person standard to determine whether an object contains an artistic concept is that such a standard is highly dependent upon the object's presentation. For example, if the Barnhart mannequins were displayed in a museum, they would easily pass Perlmutter's test, because the reasonable observer at a museum assumes that what is on display is in fact "art." On the other hand, if the reasonable observer views the same forms in a department store, the concept of dual functions is less likely. Or even if the reasonable observer viewed the mannequins in a department store on display as both sculpture and as functional mannequins, the likelihood is greater that the test would be met than if the mannequins were used solely for their utilitarian purpose. Beauty may or may not be in the beholder's eye, but whether an object is considered artistic or not by the ordinary observer is often dictated by the manner of its presentation.

C. Brandir: Inquiry Into Artistic Intention

As noted earlier, the Brandir case presented Judge Oakes with another opportunity to analyze conceptual separability in regard to useful articles. The new test adopted by Judge Oakes shifted the focus from consumer use or perception to the process of creation. Accordingly, if the process in which the article's design came to fruition was dictated by utilitarian concerns, then conceptual separability would not be found. Only when the design elements could be independently identified from the functional requirements can conceptual separability be found. The requirement of artistic independence in this test, although analyzed in terms of the creation process,

246. Perlmutter's test falls prey to the same result that judges will be left with the overly subjective determination of what the reasonable person's concept of "art" may be. Also, the reasonable person standard fails to take into account art forms or artistic expressions which have not yet received popular acceptance. See supra notes 238-42 and accompanying text.

247. Thus, Perlmutter's test is much like the Kieselstein-Cord consumer use test, which should be employed in determining whether the object is in fact a useful article, rather than in an inquiry of conceptual separation. See supra notes 94-95, 221-22 and accompanying text.


249. Id. at 1145.

250. Id.

251. Id.
sounds much like Judge Newman’s separate concept test.\textsuperscript{252} Thus, the Denicola/Oakes test has two major flaws: Inquiries into artistic intent are very difficult; and whenever an article is created with the ultimate purpose to be a useful article, it is doubtful that utilitarian concerns could ever be completely put aside.

Only in the most clear-cut cases when an artist creates an article without any utilitarian considerations, and subsequently that article is "used" without any adaptation, could the Denicola/Oakes test be passed and objectively applied. In most cases, the ultimate design of the useful article is a compromise of artistic and utilitarian concerns. Inherent within the definition of usefulness is the requirement that an article serve a function. Thus, a television must have a screen, a belt buckle must fasten around the waist, and a mannequin must be able to display clothing. Therefore, no matter the design of any of the elements, the designer must never completely lose sight of the article’s ultimate use.

Also, just as Judge Newman’s test was too subjectively ephemeral to be functional, the Denicola/Oakes test is too rigidly unrealistic to be functional.\textsuperscript{253} How is the court to determine whether the designer’s intent was free from utilitarian influences, when in actuality most people do not think in these ‘‘either/or’’ intellectual categories? For instance, how can it be determined whether the breast of a mannequin was shaped because the designer was only concerned with its aesthetic appearance, or was influenced by the fact that in order for the mannequin to function, the breast must reflect reality? As Judge Weinstein noted in his dissent in \textit{Kieselstein-Cord}, under such a test, only the crass would be rewarded with copyright protection.\textsuperscript{254}

Under the latest test employed by Judge Oakes, even the belt buckles for which he granted protection in \textit{Kieselstein-Cord}, must have been influenced by utilitarian considerations. The buckles were shaped to allow a belt to pass through, with a metal notch to hold the belt in place. Since the buckles were made of precious, expensive metals, their size had to be at least partly dependent upon utilitarian concerns. Since the designs of the buckles were not created independently of functional influences, they would apparently fail the Den-
Once again, what about David? Clearly if Michelangelo were creating his sculpture with the intention that it fulfill the use of a mannequin, the very fact that David would need to be of human height would be based on a functional influence. Further, how could a court determine if Michelangelo chose to represent the shape of the human body in such detail because of purely aesthetic intent or functional influence? Due to the Denicola/Oakes test's failure to account for the practical requirements that affect all aspects in the creation of a useful article, such a test should not be accepted.

IV. Proposal

A. Senate Report

The simplest, and possibly the only way to assure that creators will be encouraged to invent without forcing the Copyright Office and the courts to apply an extremely abstract and subjective test would be to follow the Senate's suggestion that all ornamental designs of useful articles be afforded protection for an initial five years, with a renewal term of five years. Such short term protection, according to the Senate, would provide for "simple, easily secured, and effective design protection." By the language of the report, especially in providing that protection be easily secured, the Senate was alluding to all ornamentation which lends beauty to the object. Analysis would rest solely on identifying the design of the useful article, and then granting protection for that design. Other doctrines of copyright law would avoid the grant of exclusive rights to certain designs. For example, the merger doctrine would prohibit protection for designs of useful articles of which the design could not have been made any differently. That is, when an idea necessitates a certain form of expression, then under copyright law, the idea and expression are said to merge, resulting in denial of copyright protection for

257. Id. at 161.
258. Id.
259. See Kern River Gas Transmission Co. v. Coastal Corp., 899 F.2d 1458 (5th Cir. 1989), cert. denied, 111 S. Ct. 374 (1990). Under the merger doctrine, when an idea can be manifested in only one form or very few forms of expression, the idea and expression are said to merge, and there will not be copyright protection for the expression of that idea. See Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738 (9th Cir. 1971); see also 3 Nimmer, supra note 8, § 13.03[B][3].
that expression.\textsuperscript{260} For instance, the Ninth Circuit did not have to analyze conceptual separability in \textit{Herbert Rosenthal Jewelry Corp. v. Kalpakian}, because it determined that the expression of plaintiff's bee shaped jewelry pin had merged with the idea of a bee pin.\textsuperscript{261} Since the idea of a bee pin could only be expressed in very limited forms, the idea and expression were held to be indistinguishable.\textsuperscript{262}

Other requirements for copyright, such as originality, would avoid over-broad protection.\textsuperscript{263} Although meeting the originality requirement takes no great artistic effort, this requirement does eliminate common shapes from the ambit of copyright.\textsuperscript{264} A common automobile tire could not receive protection for its overall design because the circular shape is common and unoriginal. It should also be noted that in determining whether the originality requirement has been satisfied, the overall design must be considered, not a divisional piecemeal analysis.\textsuperscript{265} Thus, although a clock may be nothing but a collection of individually unoriginal numbers, dots, lines, and geometric shapes, if these features taken as a whole show some form of originality in their arrangement, then the overall design has met the originality requirement.\textsuperscript{266}

Therefore, keeping in mind the merger doctrine and originality requirement, the Senate Report's suggestion seems the most logical. Provided that the creator of the useful article has met these requirements, then a copyright should be granted for the article's design. This approach avoids the problematic and inapplicable tests that have evolved for conceptual separability. The Copyright Office and courts would be relieved of the nebulous task of trying to determine whether some intellectualized concept of the aesthetic could be found, or was influenced, in the design either simultaneously or independently by the designer or the ordinary observer. In light of the fact that copyright protection would subsist in the useful article for a short duration, any harmful results of over-inclusive protection would be short-lived.\textsuperscript{267} Since protection would only be for a short time, the thwarting of other artists' incentive to create would be min-

\textsuperscript{260} See Kern River, 899 F.2d 1458; see also Nimmer, supra note 8, § 13.03[B][3]. The rationale is simple: by affording protection for such an expression, copyright would be acting like a patent by also protecting the idea. See Nimmer, supra note 8, § 13.03[B][3].

\textsuperscript{261} Herbert Rosenthal, 446 F.2d at 742.

\textsuperscript{262} Id.

\textsuperscript{263} See supra note 12.

\textsuperscript{264} Nimmer, supra note 8, § 2.01.

\textsuperscript{265} Atari Games Corp. v. Oman, 888 F.2d 878, 881 (D.C. Cir. 1989).

\textsuperscript{266} See id.

imal, especially when compared to the life of the author plus fifty years, which is the period of protection normally granted for copyrighted material.\textsuperscript{268}

Another theory of alleviating the problem of over-broad protection would be to limit the scope of derivative work protection for useful articles.\textsuperscript{269} In light of the merger doctrine’s narrow scope, intra-industry competitors could be handcuffed by copyrights which protect ideas which, although potentially manifested in a limited amount of expressions, are beyond merger. In these cases, perhaps a sliding scale for the inclusiveness of what is considered a derivative work would be sufficient. Under this sliding scale, the expression of ideas for useful articles which barely escape merger would receive minimal protection by the derivative works right, and those ideas which have more forms of expression would receive greater derivative works right protection, up to the usual point of protection for derivative works.\textsuperscript{270} For instance, the Barnhart mannequins may fit in the category of useful articles in which idea and expression are narrowly beyond the scope of the merger doctrine, and as such the mannequins would only be protected from unauthorized replication or near-replication. On the other hand, another party could take the idea and part of the expression and create nude and clothed hollowed-out chest mannequins, but would have to alter the forms. Such alterations could consist of a different representation of the human figure.

B. \textit{Gay Toys and Poe: Limiting the Scope of Useful Articles}

Although the Senate’s proposal is the best solution to the problem of protection of useful articles, other solutions should be explored. Since the Senate’s proposal was not accepted by the House,\textsuperscript{271} barring an amendment to the Copyright Act, separating

\textsuperscript{268} 17 U.S.C. \textsection 302(a) (1991).
\textsuperscript{269} 17 U.S.C. \textsections 101, 103 (1991). The Act defines a derivative work as:

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

\textit{Id.} \textsection 101.

\textsuperscript{270} Under the Act, copyright for a derivative work “extends only to the material contributed . . . and does not imply any exclusive right in the preexisting material.” 17 U.S.C. \textsection 103(b) (1991).

the aesthetic elements from the functional elements of a useful article will remain a necessary task. One means of decreasing the confusion in the conceptual separability test would be to not apply the test for all the articles which are now considered useful. As the court held in *Gay Toys*, simply because the article had a use did not mean that it was a useful article.°272 Perhaps this is what Judge Oakes was thinking in *Kieselstein-Cord*, when he suggested that if the aesthetic features are "primary" then conceptual separability exists.°273 If Judge Oakes had shifted his focus and determined that if the aesthetic features were "primary" then the object is not a "useful article" at all, some of the difficulty in his analysis would be alleviated.

Although a shift in Judge Oakes' analysis would be helpful, any inquiry into "primary" and "secondary" qualities will lead back to the problems highlighted by this comment.°274 Thus, if useful articles are to be so defined, a different method must be used. Since useful articles are defined as articles which have an "intrinsic utilitarian function," the scope of this definition lies in the interpretation of what is meant by "intrinsic."°275 Up until now courts have equated intrinsic with the article's use. That is, articles which are functional only in their appearance have an intrinsic aesthetic function, whereas objects which have a use beyond mere appearance have an intrinsic utilitarian function.

By restricting the range of "useful articles" within the currently broad scope that anything which has a use beyond appearance is considered a useful article, many articles which push the conceptual separability tests to their inapplicable extremes would be protected without an inquiry into separability. Perhaps then, after determining that an object has a use beyond its mere appearance, the analysis of whether the object is in fact a useful article should be based on weighing its usefulness versus its aesthetic features to determine whether the object should fit in a narrower definition of "useful articles." In weighing these two constants, the Copyright Office or courts could consider: how much the object's design differs or is similar from other objects which have the same or similar use; the overall cost of producing the article, compared to its functional costs alone; consumer response and use of the article; the type of materials used for the article; and whether the article is one which is typically

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274. Judges will then have to determine either through the ordinary observer or the designer's intent, which quality was primary and which was secondary.
viewed by the public (that is items such as belt buckles which are worn as clothing should weigh heavily on the non-useful side of the balance, whereas an automobile engine part which is not manufactured nor typically used to be viewed by the public would weigh heavily on the useful article side of the balance). Apportioning the relative weight for each factor would be on an ad hoc basis, depending upon the object in question. Although ad hoc balancing always has a subjective flavor to it, such balancing would have a greater basis in concrete factors than the tests for conceptual separability. Also, since a determination of whether an object is in fact a useful article is only preliminary to an inquiry into conceptual separability (if the article is considered a useful article), this balancing will give a greater objective foundation for the inquiry into conceptual separability by forcing the court to consider these factors only under the guise of "usefulness."

C. Another Standard for Conceptual Separability?

The primary problem with the doctrine of conceptual separability is that in its evolution to date, the doctrine rests on abstract principles and an overly subjective application. Judge Newman has made the best attempt to develop a test that would encourage the arts and sciences without stifling competition. What is important to extract from Judge Newman's test is that conceptual separation can be independently sufficient to support a copyright for the useful article's design. Thus, the concept of the design, if sufficiently aesthetic and, according to Judge Newman, able to cause the ordinary observer to perceive the aesthetic independently of the functional, would result in copyright protection for the design. As both Judge Mansfield and Shira Perlmutter remarked, the primary problem with this test is the inability to determine whether an independent aesthetic conception could or would exist in the ordinary observer.

Perhaps the only possible way to avoid these nebulous and overly-intellectualized tests and to achieve a test which has a better chance at objectivity, is to devise one for which errors occur on the

276. See Poe v. Missing Persons, 745 F.2d 1238 (9th Cir. 1989); see also supra notes 134-38 and accompanying text.
277. Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985) (Newman, J., dissenting); see supra notes 161-74 and accompanying text.
278. Barnhart, 773 F.2d at 421.
279. Id. at 421-22.
280. Id. at 419 n.5; see supra notes 175-77 and accompanying text.
281. Perlmutter, supra note 21, at 377; see supra note 245 and accompanying text.
side of over-protection, thereby encouraging original creation. A possible approach would be to afford protection for the design of any useful article which has a design which may be conceived of separately from the article's utilitarian function, provided that the design is non-obvious (original) and the expression of the design does not merge with the idea of the useful article.282

V. Conclusion

Michelangelo's David should be afforded protection, whether it was created as a traditional sculpture or as a mannequin, and regardless of whether it is displayed in a museum or a clothing store. When pushed even slightly to their logical extremes, the previously developed tests for conceptual separability fail to achieve this result, either due to their esoteric requirements or their dependence upon improper factors. In light of this fact, either a new test for conceptual separability or a new standard for copyright protection for useful articles should be developed.

Since the ultimate purpose of copyright law is to promote the progress of arts and sciences as a whole,283 any doctrine of copyright law which bases the protection of an object on subjective court interpretation of artistic merit is in serious danger of thwarting that progress. Progress in the arts and sciences is the result not of the perpetuation of the commonplace, but of the invention of unrealized expression. If we are unable to strike an exact balance between protecting original expression and promoting competition, it would be wiser to error in favor of over-protecting expression. Although too much error in the name of protection would curtail progress, there are other means to assure that protection will not reach this extent. In light of these considerations, the Senate's proposal strikes the most logical balance between protection and competition, by granting protection for all designs which give the useful article an "ornamental appearance," but limiting the protection to a maximum of ten years.284 In terms of the principals of copyright law, it is questionable whether a sufficient test for conceptual separability can be developed. The mere abstract nature of the term itself suggests the inevitability of inconsistency in its application. Although conceptual separability may be intellectually interesting, neither the Copyright

282. For a discussion of the originality requirement, see supra note 12. For a discussion of the merger doctrine, see supra notes 259-62 and accompanying text.
Office's original creation of conceptual separability, the House's clarification of this doctrine, nor the courts' attempts to apply it have resulted in a test which can be fairly and uniformly administered; it is time for this approach to yield to a different standard for determining protection for the artistic features of a useful article.

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