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Dorothy Schrader
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COPYRIGHT OFFICE REGISTRATION OF INDUSTRIAL DESIGNS

Dorothy Schrader†

I. THE COPYRIGHT ACT OF 1976

A. *Statutory Provisions*

Under section 102 of the Copyright Act of 1976, copyright protection exists in "original works of authorship fixed in any tangible medium of expression."¹ Section 102 further places works of authorship into seven categories, one of which includes works of art known as "pictorial, graphic, and sculptural works."² The statutory definition of pictorial, graphic, and sculptural works embodies the language of the Copyright Office's former work of art regulations, issued in 1956³ and 1959.⁴ The Copyright Act now provides that:

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; *the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.*⁵

Moreover, a useful article is defined in section 101 of the Act as "an article having *an intrinsic* utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article.'"⁶

Thus, the design of an article having any useful function can be considered a pictorial, graphic, or sculptural work only if it incorporates artistic features that "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."⁷ Consequently, only those articles which contain artistic features separate from the function of the article will enjoy copyright protection.

† A.B., 1960, University of Southern California; J.D., 1963, Harvard University. Associate Register of Copyrights for Legal Affairs, United States Copyright Office.

1. 17 U.S.C. § 102(a) (1988).

2. *Id.* § 102(a)(5).

3. 37 C.F.R. § 202.1 (1956).

4. 37 C.F.R. § 202.10 (1959).

5. 17 U.S.C. § 101 (1988) (emphasis added).

6. *Id.* (emphasis added).

7. *Id.*

B. *Continuity of the Copyrightability Standard from the Act of 1909 to the Act of 1976*

Clear legislative history supports the view that the copyrightability standard applied under the old Copyright Act,⁸ and clarified by the Court of Appeals for the District of Columbia in *Esquire, Inc. v. Ringer*,⁹ is the same standard embodied in the new Copyright Act. The House Report concerning the 1976 Copyright Act clearly expresses this point and provides a helpful explanation of the principal of separability in determining whether a utilitarian article contains copyrightable subject matter.¹⁰ The Report states: "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."¹¹ This distinction is seen in the second part of the amendment which reads as follows:

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.¹²

The above language articulates what is referred to as the principle of separability. In applying this principle, a two-dimensional "painting, drawing or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers and the like."¹³ However, the shape of an industrial product is protected, only if some pictorial, graphic, or sculptural element can be identified as separable from the utilitarian aspects of that product. Furthermore, if any such elements are identified, the copyright extends only to that element and not to the utilitarian article as a whole.¹⁴

II. JUDICIAL AND ADMINISTRATIVE BACKGROUND

Section 5(g) of the Copyright Act of 1909¹⁵ specified that works of art were eligible for copyright. The Copyright Office's regulations pursuant to the 1909 Act provided: "Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if

8. Title 17 U.S.C., in effect until December 31, 1977.

9. 591 F.2d 796 (D.C. Cir.), cert. denied, 440 U.S. 908 (1978).

10. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 50, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5663.

11. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 54 (1976).

12. *Id.*; see also 17 U.S.C. § 101 (1988).

13. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 55 (1976).

14. For a full explanation of the principle of separability, see *id.* at 54-58.

15. Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075, 1077.

artistically made or ornamented.”¹⁶ With only minor modification, this regulation remained in effect until 1948.

The Copyright Office's regulations, which were adopted in 1948 and remained in effect on December 31, 1977, defined “works of art” in the following manner: “This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilization aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings, and sculpture.”¹⁷ This general definition excluded the utilitarian aspects of a work from copyright protection as a work of art. Also, it did not establish a precise test for differentiating protected artistic designs from nonprotected designs.

The Copyright Office's works of art regulation was upheld by the Supreme Court in *Mazer v. Stein*.¹⁸ The Court held that a work of art did not lose its right to protection under copyright law when it was incorporated in a utilitarian article and reproduced in a substantial number of copies. Moreover, the potential availability of design patent protection did not foreclose copyright protection.

Although the Court upheld the Copyright Office's regulation, *Mazer* was interpreted by some as opening the door of copyright law to an even broader class of applied designs—those where function and aesthetic appearance tend to merge. In reaction to pressure for increased protection of designs, the Copyright Office issued a clarifying regulation in which the separability test was explicitly stated for the first time.¹⁹ The separability test, now codified in the current Copyright Act, was expressed in the Copyright Office's regulations as follows:

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.²⁰

The separability test was upheld by the United States Court of Appeals for the District of Columbia Circuit in *Esquire, Inc. v. Ringer*.²¹ In *Esquire*, the court considered whether the Register of Copyrights, in refusing to

16. U.S. COPYRIGHT OFFICE, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT § 12(g) (1909), reprinted in A. WEIL, AMERICAN COPYRIGHT LAW 625 (1917).

17. 37 C.F.R. § 202.10 (1948).

18. 347 U.S. 201 (1954).

19. 37 C.F.R. § 202.10 (1959).

20. *Id.*

21. 591 F.2d 796 (D.C. Cir.), cert. denied, 440 U.S. 908 (1978).

register designs of outdoor lighting fixtures, had adopted a permissible interpretation of the regulation. The court agreed with the Register's view that Congress, in enacting the Copyright Act of 1909, adopted a policy against copyrighting industrial designs. The Register's reading of section 202.10(c) was characterized by the *Esquire* court as "a reasonable and well-supported interpretation."²² The interpretation was held to reflect both administrative expertise and consistent application.²³

More recently, the Eleventh Circuit applied the separability test and agreed with the Copyright Office that the design of a wire wheel cover did not qualify as a work of art since there were no artistic features that could exist independently of the useful article.²⁴

Two district court cases also sharply illustrate the dividing line between utilitarian objects entitled to copyright protection and those objects not entitled. In *Ted Arnold Ltd. v. Silvercraft Co.*,²⁵ copyright was accorded only to the design encasing a pencil sharpener and not to the entire useful article. The court in *Silvercraft* held: "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."²⁶ Consequently, the overall shape of an attractive, useful article—a pencil sharpener—could not be copyrighted. In *SCOA Industries, Inc. v. Famolare, Inc.*,²⁷ the Copyright Office refused to register a claim to copyright a series of wavy lines produced on a shoe sole because they were not separable. The court held there was no infringement where a competitor merely incorporated those wavy lines into its shoe soles.²⁸

In *Kieselstein-Cord v. Accessories By Pearl, Inc.*,²⁹ the Second Circuit considered the question of whether handcrafted belt buckles containing sculptured designs were copyrightable. As the court admitted, the issue presented was "on a razor's edge of copyright law."³⁰ The *Kieselstein-Cord* court applied the separability test differently from any other court. The court recognized that the belt buckles were registered by the Copyright Office as jewelry, and the Office has considered artistic jewelry to be copyrightable as works of art since 1948.³¹ In holding the belt buckles to be copyrightable, the *Kieselstein-Cord* court found the design formed on the surface of the buckles to be a conceptually separate design.³² In summation,

22. *Id.* at 800.

23. *Id.* at 804-05.

24. *Norris Indus., Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir.), *cert. denied*, 464 U.S. 818 (1983).

25. 259 F. Supp. 733 (S.D.N.Y. 1966).

26. *Id.* at 734.

27. 192 U.S.P.Q. (BNA) 216 (S.D.N.Y. 1976).

28. *Id.*

29. 632 F.2d 989 (2d Cir. 1980).

30. *Id.* at 990.

31. *Id.* at 993; *see also* Warner, *Copyrighting Jewelry*, 31 J. Pat. Off. Soc'y 487 (1949).

32. *Kieselstein-Cord*, 632 F.2d at 993. In the same sense, a design on wallpaper "or a floral

the court held that the Copyright Office implicitly considered the belt buckles in question to contain a copyrightable work of art.³³

III. PRACTICAL APPLICATION OF THE SEPARABILITY TEST

As described in the House Report on the Copyright Act of 1976,³⁴ for an applied design to be copyrightable, the artistic features must not only be separate, but must also be capable of an independent existence. This separation and independence can be either physical or conceptual. In either case, the test for determining copyrightability of an applied design can be restated this way: (1) It must be possible to perceive a fully functioning useful article, with its basic, overall shape intact, which is able to exist even if one were to remove certain features; and (2) those separate, artistic features must themselves meet the Copyright Act's minimal standard of original creative expression.³⁵ Irrelevant to the application of this test are such factors as the aesthetic value of the design, whether the shape could be designed differently, and the amount of work which went into the creation of the design.³⁶

The Copyright Office now has more than thirty years experience in applying the separability test. The test is both reasonable and workable. The task of differentiating between designs protected by copyright law and those unprotected is a difficult one in borderline cases. This, however, would be true of any alternative test. The separability test has also functioned as a barrier to protection of industrial designs in general. As noted in the 1976 House Report, industrial products—such as furniture, television sets, automobiles, appliances, and the like—which are at least in part designed to be aesthetically pleasing, are not protected under the copyright law by application of the separability test.³⁷

The separability test is criticized by some writers and designers because the test works to exclude functional modern designs rather than to include meritorious, artistic efforts. In the early development of the separability test, the Copyright Office was more concerned with this drawback of the test than

relief design on silver flatware" is considered separable. See H.R. REP. NO. 1476, 94th Cong., 2d Sess. 55 (1976).

33. *Kieselstein-Cord*, 632 F.2d at 994.

34. See *supra* notes 13-14 and accompanying text.

35. For example, the wavy pattern on the soles in *SCOA Indus., Inc. v. Famolare, Inc.*, 192 U.S.P.Q. (BNA) 216 (S.D.N.Y. 1976) would not have been copyrightable even if considered conceptually separable from the shape of the useful article, since the wavy pattern was not sufficiently original and creative. See H.R. REP. NO. 1476, 94th Cong., 2d Sess. 54-55, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5667-68.

36. U.S. COPYRIGHT OFFICE, COMPENDIUM OF COPYRIGHT OFFICE PRACTICES § 505.05 (1984). Section 505.05 provides as follows:

Separability test: factors not relevant in determining registrability. In applying the test of separability, the following are not relevant considerations: 1) the aesthetic value of the design, 2) the fact that the shape could be designed differently, or 3) the amount of work which went into the making of the design. Thus, the mere fact that a famous designer produces a uniquely shaped food processor does not render the design of the food processor copyrightable.

37. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 55 (1976).

in recent years. Testifying in favor of the Design Protection Act of 1960, Mr. Arthur Fisher, Register of Copyrights, agonized over the unfairness of the test to modern functional design. In his testimony, Register Fisher stressed that modern use of designs was being denied copyright protection. In his opinion, this was a completely illogical result.³⁸ Register Fisher's words contrast sharply with the recommendation by the 1976 House Subcommittee to the Copyright Office to incorporate the separability test in explicit statutory language.

Judicial acceptance of the separability test certainly has contributed to its credibility. Time and experience have also allowed the Copyright Office to become more assured in its application of the test. The fundamental issue remaining is whether the copyright laws should be stretched to accommodate aesthetically pleasing designs, or whether an objective test, such as the separability test, should be applied to foreclose copyright protection of most designs. The Copyright Office has concluded that the latter course is correct because of the statutory language in support of that position.³⁹ The practical effect of this approach is that most applied designs are not protected by copyright nor are they effectively protected by the design patent law.

IV. CONCLUSION

Application of the separability test means that the basic design of any utilitarian article is not protected by copyright. Products containing a two-dimensional design—for example, floral pattern on dinnerware or

38. See *Design Protection: Hearings on S. 2075 and S. 2852 Before the Subcomm. on Patents, Trademarks & Copyrights of the Senate Comm. on the Judiciary*, 86th Cong., 2d Sess. 81-82 (1960). Register Fisher's testimony read as follows:

What we are trying to do is take an artistic form of art or representation of art, such as the Balinese dancers, and there we are issuing certificates [of copyright registration].

As the opposite extreme, the contemporary, modern use of the best designs of often more beautiful art which is not representational, we are not registering. We think this is a wholly illogical position, frankly—I confess this in open hearing—to say that on a piece of furniture an elk head on the back of a bench is subject to registration because our grandfathers had elk heads on their benches, and a modern contemporary design for a piece of furniture by the Miller Co. of Michigan which represents the most modern, most beautiful design is not registerable. Or similarly a picture on a plate which is of flowers or forest or an animal is protected, but a more beautiful piece of Swedish or Danish chinaware designed for example, by George Jensen, and which might appear in a museum is not registerable.

We think this is a wholly questionable position. As a result, we are being sued with increasing frequency, and there is a great deal of time and money in my office and that of the Attorney General being spent in trying to sustain this illogical line in the hope that we will be relieved of this by Congress. This is what we are trying to do.

We don't like it a bit, and I spend much of my time, as the Librarian said, on something which is really foreign to the basic purposes of copyright.

Id.

39. See 17 U.S.C. § 101 (1988).

flatware—are generally protected, but only with respect to the two-dimensional design. The greatest impact of the separability test has been in the case of the three-dimensional design of articles of utility. Relatively few of these designs can pass the separability test, and virtually no modern, functional design can pass the test.

Finally, it is important to understand that the separability test is not applied unless some part of the work can be classified as a useful article. The separability test is never applied to works that fall within the traditional concept of works of art—for example, paintings, sculptures, and graphic prints—which have no purpose other than to be appreciated aesthetically. At the same time, acceptance of an object for display in an art museum does not make that object a work of art under copyright law. If the article has a useful aspect within the meaning of copyright law, the separability test would then be applied.