

Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law

BARTON KEYES*

I. INTRODUCTION

“Of the many fine lines that run through the Copyright Act, none is more troublesome than the line between protectible pictorial, graphic and sculptural works and unprotectible utilitarian elements of industrial design.”¹

As this statement suggests, the copyrightability of products of industrial design is one of the most confusing aspects of American copyright law. For these works, availability of protection turns on a doctrine known as “separability.” Countless everyday objects have been analyzed under the separability doctrine, including belt buckles, casino uniforms, and mannequin heads, just to name a few.² The United States Copyright Act (hereinafter “Copyright Act”) classifies such objects as pictorial, graphic, or sculptural (“PGS”) works.³ PGS works constitute a very significant category of copyrightable material; 90,749 of the 509,746 basic copyright registrations in the fiscal year ending September 30, 2006, were for PGS works.⁴ This Note

* Chief Managing Editor, *Ohio State Law Journal*; J.D., The Ohio State University Moritz College of Law, expected 2008. B.A. *magna cum laude* in Political Science and Theater, Case Western Reserve University, 2005. I would like to thank my wife, Kate, for all of her love and support, especially throughout law school and the Note-writing process. I could not have done this without her patience. Thanks also to my parents, Bart and Mary Pat, for their (still) ongoing guidance. Finally, thanks to Professor Edward Lee for his insights, and to Managing Editor Ben Suesskind and everyone else who tackled the character-building task (to avoid a more colorful description) of editing this Note. All mistakes remain my own.

¹ 1 PAUL GOLDSTEIN, *COPYRIGHT: PRINCIPLES, LAW AND PRACTICE* § 2.5.3, at 99 (1989).

² *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) (belt buckle); *Galiano v. Harrah’s Operating Co., Inc.*, 416 F.3d 411 (5th Cir. 2005) (casino uniform); *Pivot Point Int’l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913 (7th Cir. 2004) (mannequin head).

³ PGS 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.” 17 U.S.C. § 101 (2000).

⁴ U.S. COPYRIGHT OFFICE, *ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS* 63 (2006), available at <http://www.copyright.gov/reports/annual/2006/index.html>. In its breakdown of types of registered works, the Report does not use the label “PGS works,” but instead uses the label “[w]orks of the visual arts, including two-dimensional works of fine and graphic art, sculptural works, technical drawings and models, photographs,

discusses the separability requirement, which courts use to determine whether the design of a useful article qualifies as a protectible PGS work.⁵

A determination of separability, either physical or conceptual, is a prerequisite to copyright protection for the design of a useful article.⁶ In its statutory form, the separability inquiry asks whether the aesthetic features of a useful article can be identified separately from, and can exist independently of, the work's utilitarian functions.⁷ Soon after the Copyright Act of 1976 took effect, the United States Court of Appeals for the Second Circuit began developing the conceptual separability doctrine. Over the course of several years, the Second Circuit formulated a standard for conceptual separability, although, as discussed below, even that circuit found it difficult to apply.⁸ Then, over twenty-five years after the 1976 Act took effect, the conceptual separability doctrine again made waves in the intellectual property law community.⁹ The resurgence of the doctrine began in 2004 with *Pivot Point International v. Charlene Products, Inc.*¹⁰ In *Pivot Point*, the Seventh Circuit applied the Second Circuit's test and determined that the design of a mannequin head meant to depict a fashion model satisfied conceptual separability because the designer's judgment was unaffected by functional concerns.¹¹ The following year, the Fifth Circuit issued its opinion in

cartographic works[,] commercial prints and labels, and works of applied arts." As of publication, the fiscal year 2006 data was the most current information available.

⁵ See 17 U.S.C. § 101 (2000) (indicating that useful articles are only copyrightable if they meet the separability requirement). Section 101 defines a 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."

⁶ See, e.g., 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[B][3] (2000) [hereinafter NIMMER]; Raymond M. Polakovic, Comment, *Should the Bauhaus Be in the Copyright Doghouse? Rethinking Conceptual Separability*, 64 U. COLO. L. REV. 871, 874 (1993) ("In determining whether a useful article should be copyrightable, the court must decide whether the artistic element of the article is separable from its utilitarian application.").

⁷ See 17 U.S.C. § 101 (2000) ("[T]he 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.").

⁸ See Part III.E, *infra*.

⁹ See *Mannequin Head Depicting "Hungry Look" High-Fashion Runway Model is Protected by Copyright, After All, Federal Appellate Court Rules*, ENTERTAINMENT LAW REPORTER, Nov. 2004, at 18 (discussing the Seventh Circuit's decision in *Pivot Point*).

¹⁰ 372 F.3d 913 (7th Cir. 2004).

¹¹ *Id.* at 931.

Galiano v. Harrah's Operating Co.,¹² holding that creatively designed casino uniforms failed to satisfy the conceptual separability requirement.¹³ It did so, however, by applying a very different test from the one adopted by the Seventh Circuit in *Pivot Point*, focusing on the marketability of the uniforms absent their utilitarian function.¹⁴ Thus, separability has caused conflict among circuits even twenty-five years after Congress codified the doctrine. This suggests that the currently available tests are both confusing and unable to effectively determine the copyrightability of useful articles.

It is impossible to deny the importance of the separability doctrine. It implicates both industrial design (sometimes referred to as applied art) and fashion design.¹⁵ The categories of works subject to separability analysis are vast; courts have applied the doctrine to determine the copyrightability of the designs of a variety of everyday objects, including furniture,¹⁶ shoes,¹⁷ and objects of entertainment for both children¹⁸ and adults.¹⁹ Thus, the separability doctrine enjoys widespread application to countless products that directly affect people's day-to-day lives. Given this fact, and given the very recent split between the Fifth and Seventh Circuits, separability is still "alive and well," to borrow a phrase from Judge Oakes of the *Brandir* court.²⁰

¹² 416 F.3d 411 (5th Cir. 2005).

¹³ *Id.* at 418.

¹⁴ Compare *Galiano*, 416 F.3d at 422 (finding a lack of separability because the plaintiff's uniform designs were not "marketable independently of their utilitarian function") with *Pivot Point*, 372 F.3d at 932 (finding separability because plaintiff's mannequin head was "the product of a creative process unfettered by functional concerns").

¹⁵ See generally Mark A. LoBello, *The Dichotomy between Artistic Expression and Industrial Design: To Protect or not to Protect*, 13 WHITTIER L. REV. 107 (1992); Jennifer Mencken, *A Design for the Copyright of Fashion*, 1997 B.C. INTELL. PROP. & TECH. F. 121201 (1997).

¹⁶ *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 196 F.App'x 166, 171 (4th Cir. 2006) (refusing to reverse the district court's finding that furniture design was not copyrightable because it did not meet the separability requirement).

¹⁷ *Elya, Inc. v. Kohl's Dept. Stores*, No. 06 Civ 195 (GEL), 2006 WL 2645196, *1099 (S.D.N.Y. Sept. 13, 2006) (granting defendant's motion to dismiss copyright infringement claim because shoe design did not meet separability requirement).

¹⁸ *Spinmaster, Ltd. v. Overbreak LLC*, 404 F. Supp. 2d 1097, 1104 (N.D. Ill. 2005) (granting preliminary injunction because aesthetic features of flying saucer boy were separable from utilitarian functions).

¹⁹ *ConWest Res., Inc. v. Playtime Novelties, Inc.*, 84 U.S.P.Q.2d 1019, 1023-24, 1028 (N.D. Cal. Nov. 17, 2006) (denying preliminary injunction because aesthetic features of sculptures of a body part were not separable from utilitarian functions).

²⁰ *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987) (noting that conceptual separability is "alive and well" in the Second Circuit).

though its application (and accompanying confusion) has spread well beyond the Second Circuit. This Note explores the development of the various conceptual separability tests that courts and commentators have offered and discusses their respective strengths and weaknesses.

Because the currently available tests do not adequately serve the purposes of the separability doctrine and copyright law, this Note proposes an alternative balancing test. It directs courts to balance 1) the degree to which the designer of a useful article is influenced by aesthetic considerations, as opposed to functional ones, when designing the article, and 2) the degree to which the design of the useful article is dictated by its utilitarian function. As discussed below, the proposed balancing test is better than the currently available tests for two reasons. First, the test allows the conceptual separability determination to turn on only the subjective and objective elements of the design process. This limited focus ensures that the inquiry is not influenced by judges' or mainstream consumers' biases about the nature of art. Second, the test ensures that copyright protection is more predictable. If designers can feel confident in advance that their works will receive copyright protection, they will be more likely to create artistically-influenced useful articles, which benefits the public by ensuring that a wide variety of designs for useful articles is available.

Part II of this Note provides background by explaining the definitions of PGS works and useful articles. Part III discusses the development of the separability doctrine, beginning with the doctrine's origins before the adoption of the Copyright Act of 1976. It then addresses the evolution of conceptual separability after the 1976 Act took effect, focusing on the rich history of conceptual separability in the United States Court of Appeals for the Second Circuit, as well as the recent conflicting decisions of the Seventh and Fifth Circuits. Part IV summarizes the five major conceptual separability tests that courts and commentators have articulated. It proceeds to discuss the shortcomings of the currently available tests. Finally, Part V of this Note proposes the alternative two-factor balancing test for conceptual separability, which directs courts to balance 1) the degree to which the designer of a useful article is influenced by aesthetic considerations, as opposed to functional ones, when designing the article, and 2) the degree to which the design of the useful article is dictated by its utilitarian function.

II. BACKGROUND: THE SEPARABILITY DOCTRINE AND THE COPYRIGHT ACT

Before venturing into a detailed analysis of conceptual separability, some background information is necessary. Therefore, this Part discusses the definitions in the Copyright Act that are most relevant to an analysis of conceptual separability. The U.S. Constitution grants Congress the power

“[t]o 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.”²¹ Pursuant to its Copyright Clause power, Congress enacted the Copyright Act of 1976 (“Copyright Act” or “Act”).²² The Copyright Act sets forth several definitions, including those that have generated the confusion addressed by this Note.

Section 102 of the Act defines generally the scope of copyright law. It provides that copyright protection subsists “in original works of authorship fixed in any tangible medium of expression”²³ It then gives a non-exhaustive list of categories of “works of authorship,” which includes “pictorial, graphic, and sculptural works.”²⁴ Thus, under the explicit terms of the Copyright Act, PGS works are eligible for copyright protection.

Section 101 of the Act defines PGS works. The first part of the definition provides a non-exhaustive list of types of works that fall within the category. It includes “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.”²⁵

For purposes of this Note, the second part of the definition of PGS works is more important because it provides the statutory basis for the separability requirement.²⁶ It first says that “works of artistic craftsmanship” are PGS works (and thus copyrightable) only “insofar as their form but not their mechanical or utilitarian aspects are concerned.”²⁷ It then provides that “the design of a useful article” is only a PGS work if its PGS features are identifiable “separately from, and are capable of existing independently of, the utilitarian aspects of the article.”²⁸ It is this language that has given rise

²¹ U.S. CONST., art. I, § 8, cl. 8.

²² 17 U.S.C. § 101 *et. seq.* (2000 & Supp. 2004). The 1976 Act is not the first Copyright Act; the most notable previous version was the 1976 Act’s predecessor, the Copyright Act of 1909. However, because the differing applications of the separability doctrine developed primarily after the adoption of the 1976 Act, this Note will discuss only the relevant provisions of the 1976 Act.

²³ 17 U.S.C. § 102(a) (2000).

²⁴ 17 U.S.C. § 102(a)(5) (2000).

²⁵ 17 U.S.C. § 101 (2000).

²⁶ See Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1345 (1987) (noting the role of the definition in imbedding the separability test in the Copyright Act).

²⁷ 17 U.S.C. § 101 (2000).

²⁸ *Id.* The full text of the provision reads as follows:

“Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art

to the separability doctrine.

The definition of PGS works provides a cross-reference to the § 101 definition of a useful article. A useful article is “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”²⁹ Examples of useful articles include decorative belt buckles,³⁰ elaborate bicycle racks,³¹ ornate lighting fixtures,³² and board games.³³

The Copyright Act’s definitions of PGS works and useful articles essentially mandate a three-step inquiry for courts in trying to determine whether a work is copyrightable. First, the court must determine if the work satisfies the first part of the definition of a PGS work in § 101. Second, if it does, it is potentially a PGS work and the court must then consider whether the work meets the § 101 definition of a useful article.³⁴ Third, if the work is a useful article, the court must determine if the work satisfies the second part

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.*

Id. (emphasis added).

²⁹ *Id.* A prior Copyright Office regulation had implemented an analysis similar to separability if an article’s “sole intrinsic function [was] its utility.” 37 C.F.R. § 202.10(c) (1959) (emphasis added). For a discussion suggesting that the 1976 Act’s use of the phrase “having an intrinsic utilitarian function” could allow more works to qualify for protection, see Melville B. Nimmer, *The Subject Matter of Copyright Under the Act of 1976*, 24 UCLA L. REV. 978, 1002 (1977).

³⁰ See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 991–92 (2d Cir. 1980) (decorative belt buckles useful article but design still copyrightable).

³¹ See *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1143 (2d Cir. 1987) (“RIBBON” bicycle rack useful article and not copyrightable).

³² See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978) (ornate lighting fixture useful article and not copyrightable).

³³ *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 915 (2d Cir. 1980) (board game useful article and not copyrightable). *But c.f.* *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 973 (6th Cir. 1983) (holding that a toy airplane is not a useful article because, while it is meant to be played with, its function is to portray a real airplane).

³⁴ If the work is not a useful article, then it is not subject to the separability requirement and is thus copyrightable subject to requirements of originality and fixation, the Copyright Act’s generally applicable prerequisites for protection. See 17 U.S.C. § 102 (2000).

of the § 101 PGS works definition, the separability requirement.³⁵ If the work satisfies all three of these inquiries, it is a PGS work and the work's non-utilitarian features can receive copyright protection. Framed this way, the copyrightability of useful articles does not seem like a particularly difficult concept. However, as the next Part of this Note will demonstrate, judicial development of the separability doctrine has been anything but simple.

III. THE DEVELOPMENT OF THE SEPARABILITY DOCTRINE IN THE COURTS

The Copyright Act does not give courts much guidance in determining whether a work meets the separability requirement.³⁶ As demonstrated by the discussion that follows, this lack of guidance has caused courts great difficulty in developing a test for separability. Subpart A contains a discussion of *Mazer v. Stein*, a Supreme Court decision that predates the 1976 Act, and the subsequent regulation promulgated by the U.S. Copyright Office (hereinafter "Copyright Office"). Subpart B discusses *Esquire Inc. v. Ringer*, a case decided by the Court of Appeals for the D.C. Circuit in 1978, the year the 1976 Act took effect. Subparts C and D explain physical and conceptual separability, respectively. These are the two different types of separability that can satisfy the statutory requirement. As shown in subpart D, the House Report accompanying the 1976 Act indicates that separability can be accomplished either physically or conceptually. Subpart E addresses Conceptual Separability's evolution in the Court of Appeals for the Second Circuit. Finally, subparts F and G discuss the recent inconsistent applications of conceptual separability in the Seventh and Fifth Circuits in *Pivot Point* and *Galiano*, respectively.

A. *Mazer v. Stein* and its Aftermath

The Supreme Court of the United States decided *Mazer v. Stein*³⁷ in 1954. While decided well before the adoption of the 1976 Act, *Mazer* is essential to any discussion of separability because the 1976 Act essentially codified the holding in *Mazer*.³⁸ In *Mazer*, the respondents (the plaintiffs in

³⁵ See *Gay Toys*, 703 F.2d at 974 ("This [separability] provision applies only to items that are first, as a whole, disallowed copyright protection as 'useful articles'").

³⁶ The Act's lack of clarity on this point is quite significant in the field of copyright law. See GOLDSTEIN, *supra* note 1, and accompanying text.

³⁷ 347 U.S. 201 (1954).

³⁸ See NIMMER, *supra* note 6, (noting that the holding in *Mazer v. Stein* has been expressly adopted by the Copyright Act of 1976).

the district court) manufactured and sold lamps.³⁹ One of them created original sculptures of dancing men and women.⁴⁰ The respondents successfully registered the statuettes, without any lamp components added, with the Copyright Office as “works of art” under the Copyright Act of 1909.⁴¹ They sold the statuettes throughout the United States, both as lamp bases and as statuettes on their own, though sale as lamp bases constituted all but an insignificant portion of the sales.⁴² The petitioners (defendants), who were also lamp manufacturers, copied the statuettes and sold them as lamp bases.⁴³ The Supreme Court concluded that the statuettes were eligible for copyright protection.⁴⁴ In doing so, the Court rejected the petitioner’s argument that enactment of the design patent laws denies protection to artistic articles embodied in manufactured articles.⁴⁵ It held that the statuettes

³⁹ *Mazer*, 347 U.S. at 202. It seems that decorative lighting fixtures serve as excellent examples of useful articles, as they have been the object of copyright litigation on several occasions. See *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978) (discussed in II.B, *infra*); see also *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1147 (9th Cir. 2003) (lamp not copyrightable because, among other reasons, plaintiff did not design any separable features); *Smith & Hawken, Ltd. v. Gardendance, Inc.*, No. C 04-1664 SBA, 2005 WL 1806369, *4 (N.D. Cal. July 28, 2005) (garden torch not copyrightable because aesthetic features not separable from functional aspects).

⁴⁰ *Id.* The female statuette consisted of a dancer in a floor length skirt with her right leg crossed over her left, her left arm reaching up behind her head and her right arm reaching down behind her back. Unfortunately, such a cursory written description probably fails to convey the aesthetic value of the statuette-turned-lamp-base. Thankfully, a photograph is available at Cool Copyright, <http://www.coolcopyright.com/cases/chp4/mazerstein.htm> (last visited Jan. 27, 2008).

⁴¹ See *Mazer*, 347 U.S. at 202–03. For a brief practical discussion of the benefits of copyright registration, see Lara Pearson, *When Use Alone Just Isn’t Enough: The Benefits of Federally Registering Trademarks & Copyrights*, NEV. LAW., Dec. 2002, at 15, 16. For a more in-depth exploration of the procedures and incentives associated with registration, see Moses Brace, *Searching for Substance in the Midst of Formality: Copyright Registration as a Condition Precedent to the Exercise of Subject-Matter Jurisdiction by Federal Courts over Copyright Infringement Claims*, 14 J. INTEL. PROP. L. 111, 120–23 (2006).

⁴² *Mazer*, 347 U.S. at 203.

⁴³ *Id.* The petitioners in *Mazer* were not the only designers who copied the respondents’ designs; the Court noted that the respondents had brought a series of infringement suits against various defendants. *Id.* at 203 n.2.

⁴⁴ See *id.* at 214.

⁴⁵ See *id.* at 215–16. The Court summarized petitioners’ argument:

[C]ongressional enactment of the design patent laws should be interpreted as denying protection to artistic articles embodied or reproduced in manufactured articles. . . .

. . . .

could be copyrighted regardless of patentability.⁴⁶ The Court also explained that the use or intended use of the statuettes in lamp bases did not bar their subsequent registration as copyrightable works of art.⁴⁷ Finally, the Court approved of a Copyright Office regulation that allowed protection as works of art for “works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned.”⁴⁸

Mazer, to an extent, paved the way for the separability doctrine and the cases applying it. The holding, including the Court’s approval of the regulation, suggests that the Court believed that useful articles are copyrightable despite their utilitarian features.⁴⁹ After *Mazer*, the Copyright Office promulgated a new regulation to implement the holding.⁵⁰ This regulation, which contains some language eventually adopted in Congress’s definition of PGS works in the 1976 Act, still failed to draw a clear line for copyright protection of useful articles.⁵¹

If an industrial designer can not satisfy the novelty requirements of the design patent laws, then his design as used on articles of manufacture can be copied by anyone.

Id. (internal quotations omitted).

⁴⁶ *Id.* at 217 (“[T]he patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted.”).

⁴⁷ *See id.* at 218. Note that “works of art” was a category of protectible works under the 1909 Act, which was in effect at the time of the *Mazer* decision. Articles classified as “works of art” under the 1909 Act included works of applied art and industrial design; such works now fall into the broader category of PGS works under the 1976 Act. *See* Melville B. Nimmer, *The Subject Matter of Copyright Under the Act of 1976*, 24 UCLA L. REV. 978, 998 (1977).

⁴⁸ *See Mazer*, 347 U.S. at 212–13 (citing 37 C.F.R. § 202.8 (1949)).

⁴⁹ *See* NIMMER, *supra* note 6, at § 2.08[B][3] (“The *Mazer* opinion can be read to mean that any useful article, at least if it is aesthetically pleasing in appearance, is subject to copyright protection with respect to its form.”).

⁵⁰ *Id.* The regulation provided:

If the sole function of an article is utility, the fact that it 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.

37 C.F.R. § 202.10(c), 24 Fed. Reg. 4955, 4958 (1959).

⁵¹ *See* NIMMER, *supra* note 6, at § 2.08[B][3] (“[T]his Regulation too offered no ready answer to the linedrawing problem inherent in delineating the extent of copyright protection available for works of applied art.”).

B. *Esquire: Application of the Post-Mazer Regulation*

The regulation promulgated after *Mazer* was at issue in *Esquire, Inc. v. Ringer*.⁵² In *Esquire*, the Court of Appeals for the D.C. Circuit considered whether the Register of Copyrights had acted appropriately in denying the registration application for Esquire's "artistic design[s] for lighting fixture[s]."⁵³ The articles at issue were "outdoor luminaries or floodlights, of contemporary design, with rounded or elliptically-shaped housings."⁵⁴ The district court had ruled in favor of Esquire, concluding that *Mazer* compelled the Register to accept the registration.⁵⁵ To deny Esquire's application in the light of upholding the issuance of the copyrights in *Mazer* would, according to the district court, give "certain copyright privileges to traditional works of art, but not to abstract, modern art forms."⁵⁶

The Court of Appeals reversed, holding that the Register had adopted a reasonable interpretation of the post-*Mazer* regulation.⁵⁷ The Register interpreted the regulation "to bar copyright registration of the overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape or configuration may be."⁵⁸ The Court rejected Esquire's interpretation that the regulation allowed registration for the shape or design of utilitarian articles if they were original and creative.⁵⁹

It is not entirely clear from *Esquire* how far the D.C. Circuit would have allowed the Register to go in interpreting the regulation. It is also not clear how far the Register would have gone. After all, the second sentence of the regulation explicitly contemplates protection for some features of utilitarian

⁵² 591 F.2d 796 (D.C. Cir. 1978).

⁵³ *Id.* at 798.

⁵⁴ *Id.* The court noted that Esquire's more detailed description indicated that:

[T]he lighting fixtures are provided with decorative housings having two different styles of artistic configuration. The ELLIPTRA I and ELLIPTRA II fixtures include oblate housings having a rounded upper portion, a cylindrical band between the upper and lower portions, and a cylindrical lower edge portion. The ELLIPTRA III design utilizes a generally cupshaped housing having a generally elliptical cross section tapering into a rounded rear portion.

Id. at 798 n.2 (internal citation omitted). A photograph of a representative fixture appears in CRAIG JOYCE ET AL., COPYRIGHT LAW 192 (6th ed. 2003, reprint 2005).

⁵⁵ See *Esquire*, 591 F.2d at 799.

⁵⁶ *Id.*

⁵⁷ *Id.* at 800.

⁵⁸ *Id.*

⁵⁹ See *id.* In reaching its decision, the Court of Appeals referred to the 1976 Act and its legislative history despite the fact that the lighting fixtures were created before the applicable date of the 1976 Act (and were thus subject to the 1909 Act). See *id.*

articles.⁶⁰ Perhaps the problem for *Esquire* was that its artistic creation served as the lamp housing itself.⁶¹ In *Mazer*, on the other hand, the artistic creation was a statuette combined with a lamp base.⁶² However, relying on this distinction to justify the different outcomes of the two cases certainly seems to allow judges to make determinations based on their own subjective opinions of what is “art.”⁶³ After all, the facts of both cases boil down to a lighting manufacturer designing uniquely shaped fixtures. The only real difference is that the designer in *Mazer* physically joined an artistic element to a functional one, while in *Esquire*, the artistic element was itself functional.

One would hope that Congress would resolve the difficulties surrounding separability when it adopted the 1976 Act. Unfortunately, as discussed below, this was not the case. Congress only partially succeeded in its goal of drawing a clear line to determine the copyrightability of useful articles.⁶⁴

C. *The Simple but Harsh: Physical Separability*

One formulation of the separability requirement is “physical separability.” Courts that have invoked this doctrine have said that an aesthetic feature in a PGS work is copyrightable if it can be physically separated without reducing the utility of the article and if the aesthetic feature can, on its own, serve as a traditional work of art.⁶⁵ Thus, an eagle sculpture welded to a lighting fixture would be physically separable from the lighting fixture (the eagle sculpture being the PGS feature and the lighting fixture being the useful article).⁶⁶ Assuming the eagle sculpture meets the originality

⁶⁰ 37 C.F.R. § 202.10(c), 29 Fed. Reg. 4955, 4958 (1959) (“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.”).

⁶¹ See *Esquire*, 591 F.2d at 798 n.2 (describing the lighting fixtures).

⁶² See *Mazer*, 347 U.S. at 203.

⁶³ See Eric Setliff, *Copyright and Industrial Design: An “Alternative Design” Alternative*, 30 COLUM. J.L. & ARTS 49, 52 (2006) (arguing that various articulations of the separability doctrine all result in line drawing that reflects each court’s subjective opinions of what constitutes art, thus causing unpredictable and unfair outcomes).

⁶⁴ See John B. Fowles, *The Utility of a Bright-Line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in Leicester v. Warner Bros.*, 12 UCLA ENT. L. REV. 301, 310 (noting that, after Congress passed the 1976 Act, some courts adopted a relatively straightforward “physical separability” test while others promulgated several different common-law “conceptual separability” tests).

⁶⁵ GOLDSTEIN, *supra* note 1, at 106.

⁶⁶ *Id.*

requirement,⁶⁷ it would be protectible, though the lighting fixture would not.

Physical separability on its face seems relatively easy to apply. However, on its own, it can lead to arbitrary distinctions, such as the one in *Esquire*.⁶⁸ It is easy to see how seemingly insignificant changes in a fact pattern could lead to an opposite result under this test. Suppose that a court today would apply physical separability to the works at issue in *Mazer*. If the facts were the same (the plaintiff designs the statuette separately and then incorporates it into the lamp base), the statuette seems to pass the physical separability test. If the plaintiff instead makes the statuette the lamp base itself (perhaps by putting wiring through the body of the dancer and including a recessed lamp socket in the top of the dancer's head), a court might find that the statuette is not protectible because it is not physically separable from the useful article. This is a troubling result, as the statuette is no less artistically designed simply because it doubles as a lamp base.⁶⁹ Thus, while physical separability is simple, it suffers from the arbitrary distinctions it can create.⁷⁰ Perhaps it is for this reason that conceptual separability developed.⁷¹

D. *The Complex but Flexible: Conceptual Separability*

Upon examining § 101 of the 1976 Act, one will notice that the words “physical” and “conceptual” do not appear in the definition of PGS works.⁷² Rather, these terms derive from the legislative history accompanying the Copyright Act. The House Committee on the Judiciary explained that the design of an industrial product would not be copyrightable under the 1976 Act unless it “contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article.”⁷³

⁶⁷ Originality is one of the two basic prerequisites for copyright protection; the other is fixation. 17 U.S.C. § 102 (2000) (indicating that protection subsists in “original works of authorship fixed in any tangible medium of expression . . .”). For a discussion of these requirements, see NIMMER, *supra* note 6, §§ 2.01 (originality), 2.03[B] (fixation).

⁶⁸ For example, under the physical separability test, the *Esquire* plaintiff would have prevailed if it had designed its fixture housing separately and then welded it to a preexisting lighting fixture. GOLDSTEIN, *supra* note 1, at 107.

⁶⁹ Indeed, such a result would seem to conflict with *Mazer*'s holding that a work is copyrightable even if the creator intends it to possess utilitarian functions. See *Mazer v. Stein*, 347 U.S. 201, 218 (1954).

⁷⁰ See GOLDSTEIN, *supra* note 1, at 107.

⁷¹ *Id.* (suggesting that the legislative history of the 1976 Act introduced conceptual separability to avoid the arbitrary distinctions created by physical separability).

⁷² 17 U.S.C. § 101 (2000).

⁷³ H.R. REP. No. 94-1476, at 55 (1976). The full paragraph containing the quoted language reads:

Importantly, the language of the House Report suggests that PGS elements of a useful article can receive copyright protection even if they are only conceptually, but not physically, separable.⁷⁴ The notion of copyright protection for works that possessed only conceptual separability became quite important, especially in the Second Circuit. It was there that the issue of conceptual separability received the most detailed analysis in three particularly important cases.⁷⁵

E. The Second Circuit: The Home of Conceptual Separability

There are three major conceptual separability cases in the Second Circuit: *Kieselstein-Cord*, *Carol Barnhart*, and *Brandir*. Together, these three cases represent an in-depth exploration of the conceptual separability doctrine and an ambitious attempt to develop an effective test over several years. Unfortunately, as indicated by the fact that different circuits are still in disagreement about the test for conceptual separability, the efforts of the Second Circuit have served as the beginning of the debate, not the end.

The first noteworthy case in the Second Circuit involved ornate belt buckles.⁷⁶ In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, the plaintiff (Kieselstein-Cord) designed the buckles from original renderings he had

In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. 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. The same is true when a statute [sic] or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.

Id. As will be demonstrated below, the Committee failed in its goal "to draw as clear a line as possible," at least to the extent one believes that inconsistency among the courts indicates failure to draw a clear line.

⁷⁴ See Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y U.S.A. 339, 351 (noting that language allowing for protection of articles that are conceptually but not physically separable "opened new vistas of protection, blurring the dividing line between art and non-art, and set the stage for subsequent analysis.").

⁷⁵ See *id.* at 358.

⁷⁶ *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 990 (2d Cir. 1980).

conceived and sketched.⁷⁷ The buckles each contained rounded corners, sculpted surfaces, several surface levels, and rectangular cut-outs at one end for the belt attachment.⁷⁸ One of the buckles, the Winchester model, experienced great commercial success; the plaintiff sold it in both men's and women's sizes in silver and gold, and in a smaller size to be worn around the neck or elsewhere on the body besides the waist.⁷⁹ Both the Winchester and Vaquero models were donated by the plaintiff and accepted into the permanent collection of the Metropolitan Museum of Art.⁸⁰

The defendant made exact copies of the plaintiff's buckles but used common metal instead of precious metal.⁸¹ Thus, the only issues were whether the buckles could be protected by copyright and whether the copyrights were adequate.⁸² The district court found that the belt buckles were not copyrightable because they did not meet the requirements of separability and independent existence of artistic features.⁸³

The Court of Appeals reversed.⁸⁴ It first noted the lack of assistance provided by the relevant authorities in determining copyrightability for works of applied art.⁸⁵ The court then adopted the suggestion of the House Report,

⁷⁷ *Id.*

⁷⁸ *Id.* The court described the "Vaquero" model as consisting of "two curved grooves running diagonally across one corner of a modified rectangle and a third groove running across the opposite corner." *Id.* The court described the "Winchester" model as follows: "two parallel grooves cut[ting] horizontally across the center of a more tapered form, making a curving ridge which [was] completed by the tongue of the buckle. A smaller single curved groove flow[ed] diagonally across the corner above the tongue." *Id.* Photographs of both models appear in the opinion, *id.* at 995, and are also available at CoolCopyright, <http://www.coolcopyright.com/cases/chp4/kieselsteinpearl.htm> (last visited Jan. 27, 2008).

⁷⁹ *Kieselstein-Cord*, 632 F.2d at 991. The Winchester experienced such great commercial success that it accounted for ninety-five percent of the plaintiff's jewelry sales in 1979. *Id.*

⁸⁰ *Id.*

⁸¹ *Id.* Copying was not in dispute, as some of the defendant's order blanks even referred to its buckles as "Barry K Copy," "BK copy," and "Barry Kieselstein Knock-off." *Id.*

⁸² *Id.* The second issue, whether the copyrights were adequate, would require analysis of copyright notice standards under both the 1909 and 1976 Acts, which is beyond the scope of this Note. In any case, this issue was not relevant on appeal. *Id.*

⁸³ *Id.*

⁸⁴ *Id.* at 994.

⁸⁵ *Kieselstein-Cord*, 632 F.2d at 992-93 ("[N]one of the authorities—the Mazer opinion, the old regulations, or the statute—offer any ready answer to the line-drawing problem inherent in delineating the extent of copyright protection available for works of applied art.") (quoting NIMMER, *supra* note 6, § 2.08[B](3)).

accepting the idea that separability can occur either physically or conceptually.⁸⁶ The Court found conceptually separable elements in the belt buckles, as had consumers who had worn the buckles as ornamentation on different parts of the body.⁸⁷ However, the Court of Appeals did not formulate a clear test for conceptual separability; it merely stated that “[t]he primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function.”⁸⁸ The court then classified the buckles as jewelry, and noted that the form of jewelry is copyrightable.⁸⁹

Judge Weinstein dissented, noting that the buckles were aesthetically pleasing, but concluding that “their innovations of form are inseparable from the important function they serve—helping to keep the tops of trousers at waist level.”⁹⁰ Judge Weinstein further argued that the plaintiff’s ability to completely integrate the artistic and functional aspects of the buckles precluded copyright protection.⁹¹ While not explicitly rejecting conceptual separability as a basis for copyright protection, Judge Weinstein essentially advocated a physical separability test.⁹²

In *Kieselstein-Cord*, the Second Circuit laid the foundation for protecting the PGS elements of a useful article on the basis of conceptual separability alone.⁹³ However, in doing so, it did not formulate a readily discernable test for conceptual separability.⁹⁴ The court’s analysis has been characterized as a “primary/subsidiary test for conceptual separability.”⁹⁵ Even so, the court’s

⁸⁶ *Id.* at 993. The court explicitly rejected the defendant’s argument that copyright protection could not be based in conceptual separability alone. *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.* at 994 (Weinstein, J., dissenting). Notably, the majority opinion mentioned that consumers often wore the buckles on other parts of the body. *Id.* at 991 (majority opinion). Perhaps this fact itself disproves Judge Weinstein’s assertion that the aesthetic design of the buckles was inseparable from their utilitarian function. *See* Perlmutter, *supra* note 74, at 360 (noting that consumers saw the works as more than just belt buckles).

⁹¹ *Kieselstein-Cord*, 632 F.2d at 994 (Weinstein, J., dissenting).

⁹² Perlmutter, *supra* note 74, at 360 (observing that, while Judge Weinstein quoted the House Report language, *see supra* note 73, he also cited *Esquire* with approval).

⁹³ *See Kieselstein-Cord*, 632 F.2d at 993.

⁹⁴ *See* Perlmutter, *supra* note 74, at 359 (pointing out a number of issues the court left unanswered in applying its primary/secondary dichotomy).

⁹⁵ *See* Fowles, *supra* note 64, at 311. The primary/subsidiary label is an appropriate description of the court’s conclusion, as the court found the buckles copyrightable by separating the primary aesthetic or ornamental function of the buckles from their

opinion does not provide enough detail as to how this separation should be determined. A test which lacks such detail would still leave open the door for judges to give effect to their own personal biases regarding the nature of art.⁹⁶ Not long after the *Kieselstein-Cord* decision, however, the Second Circuit revisited conceptual separability.

In *Carol Barnhart, Inc. v. Economy Cover Corp.*, the Second Circuit considered the copyrightability of mannequins of partial human torsos used to display articles of clothing.⁹⁷ The plaintiff designed four life-sized human torso forms, without arms, legs, or backs, made out of expandable white styrene, meant to display clothing.⁹⁸ The plaintiff's president stated that the forms' commercial success made him believe they were being purchased for their artistically sculptured features, not merely their function.⁹⁹

The defendant, Economy, copied the plaintiff's forms and sold them at a lower price.¹⁰⁰ When Carol Barnhart sued for infringement, the district court granted Economy's motion for summary judgment because the forms did not meet the separability requirement.¹⁰¹

The Court of Appeals affirmed, holding that "the aesthetic and artistic features of the Barnhart forms [were] inseparable from the forms' use as utilitarian articles."¹⁰² In doing so, the court explained that the aesthetic

subsidiary utilitarian function as part of a trouser height-maintenance system. *See Kieselstein-Cord*, 632 F.2d at 993.

⁹⁶ Commentators have said that the primary/secondary distinction was not even necessary to the court's conclusion, and that it was not meant to serve as a test for future cases. Instead, the court based its decision on a "we know it when we see it" rationale. Perlmutter, *supra* note 74, at 359.

⁹⁷ *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 412 (2d Cir. 1985).

⁹⁸ *Id.* Two of the forms represented male torsos and two represented female torsos. Two of the torsos, one male and one female, were unclad and meant to display shirts and sweaters; the other two were sculpted with shirts to display sweaters and jackets. *Id.* The forms were anatomically accurate and life-like except for the fact that they had hollow backs to hold excess fabric when a piece of clothing was placed onto the form. *Id.*

Photographs of the two male forms are available at Cool Copyright, <http://www.coolcopyright.com/cases/chp4/barnharteconomy.htm> (last visited Jan. 27, 2008). Photographs of all four of the forms appear in CRAIG JOYCE ET AL., *COPYRIGHT LAW* 188 (6th ed. 2003, reprint 2005).

⁹⁹ *Carol Barnhart*, 773 F.2d at 413. Note that the great commercial success was due to purchases by Barnhart's primary customers, visual merchandisers, and not, for example, purchases by home consumers for display in living rooms. *See id.*

¹⁰⁰ *Id.* Copying was not in dispute, as Economy conceded copying and substantial similarity for the purposes of its summary judgment motion. *Id.*

¹⁰¹ *Id.* at 414 (explaining the district court's holding that the forms were not copyrightable because they "possessed no aesthetic features that could exist, either physically or conceptually, separate from the forms as utilitarian articles").

¹⁰² *Id.* at 418.

satisfaction and value of the forms, as indicated by the fact that they were used for purposes other than modeling clothes, was not enough to show that the forms had features that were physically or conceptually separable from their utilitarian function—displaying clothes.¹⁰³

The court went on to distinguish the mannequins from the belt buckles at issue in *Kieselstein-Cord*. It noted that the conceptually separable ornamental aspects of the belt 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.”¹⁰⁴ The aesthetic or artistic features of the mannequins, such as the anatomically correct configurations of the shoulders or breasts, were “inextricably intertwined with the utilitarian feature, the display of clothes.”¹⁰⁵

The majority opinion in *Carol Barnhart* can be read as adopting the following test for conceptual separability: If the artistic and aesthetic features of a useful article are mandated by the utilitarian functions of the article, those features are not conceptually separable and thus are not copyrightable; if, on the other hand, the features are not mandated by the article’s utilitarian functions, they can be conceived of as having been added to the useful article and are thus conceptually separable and copyrightable.¹⁰⁶

Judge Newman, in his dissent, summarized four possible tests for conceptual separability and then offered his own.¹⁰⁷ The first test concerns usage; it would deny copyrightability to an article that primarily serves its utilitarian function.¹⁰⁸ Newman warned that the problem with this approach

¹⁰³ *Id.* The other uses of the forms included their use “as decorating props and signs without any clothing or accessories.” *Id.* Presumably, these uses were by the same purchasers who also used the forms for their clothing display function.

The court also rejected Barnhart’s contention that the forms should be subject to a lower level of scrutiny because they fit the “traditional category of sculpture of the human body.” *Id.* The court noted that this argument was not supported by the statute or legislative history, and that accepting it would run counter to the policy of avoiding discrimination based on subjective concepts of art. *See id.*

¹⁰⁴ *Id.* at 419 (emphasis added).

¹⁰⁵ *Carol Barnhart*, 773 F.2d at 419 (emphasis added).

¹⁰⁶ *See* Nathan C. Rogers, *Copyright Protection: A Dead Fish for Sculptors of Taxidermy Mannequins?*, 6 J. INTEL. PROP. L. 159, 167 (1998) (noting that the court distinguished Barnhart’s mannequins from the belt buckles in *Kieselstein-Cord* because the design of the mannequins was “entirely dictated by utility” and because the utilitarian and aesthetic elements were “inextricably intertwined”) (internal citations omitted).

¹⁰⁷ *Carol Barnhart*, 773 F.2d at 419–22 (Newman, J., dissenting).

¹⁰⁸ *Id.* at 421 (“An article used primarily to serve its utilitarian function might be regarded as lacking ‘conceptually separable’ design elements even though those design elements rendered it usable secondarily solely as an artistic work.”).

is that it would deny protection to designs of art displayed by a minority because a majority uses them as useful articles; the copyrightability of a work of art should not be denied just because a majority of people use it as something else.¹⁰⁹

The next standard, which Newman derived from *Kieselstein-Cord*, would grant protection “whenever the decorative or aesthetically pleasing aspect of the article can be said to be ‘primary’ and the utilitarian function can be said to be ‘subsidiary.’”¹¹⁰ This approach, according to Judge Newman, gives the finder of fact very little guidance as to what is being measured by the classifications “primary” and “subsidiary.”¹¹¹

Judge Newman next explained Professor Nimmer’s approach: “conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.”¹¹² Judge Newman identified the problem with this approach as potentially granting protection only to popular art.¹¹³

The fourth test would find conceptual separability “whenever the design of a form has sufficient aesthetic appeal to be appreciated for its artistic qualities.”¹¹⁴ This test fails because it was rejected by Congress in the House Report, which stated that if the artistic features cannot be identified separately, there is no protection even if the features are “aesthetically satisfying and valuable.”¹¹⁵

¹⁰⁹ *See id.* As an example, Judge Newman explained, “[t]he copyrightable design of a life-size sculpture of the human body should not lose its copyright protection simply because mannequin manufacturers copy it, replicate it in cheap materials, and sell it in large quantities to department stores to display clothing.” *Id.* Thus, it seems he was concerned that the usage test would deny protection to creators who are motivated by artistic considerations but whose works end up having both artistic and practical value.

¹¹⁰ *Id.*

¹¹¹ *Id.* Commentators have expressed this same concern with the primary/subsidiary test. *See* Perlmutter, *supra* note 74, at 359.

¹¹² *Carol Barnhart*, 773 F.2d at 421 (Newman, J., dissenting) (quoting NIMMER, *supra* note 6, at § 2.08).

¹¹³ *Id.* at 422. Judge Newman further suggests that the class of people who would recognize the purely aesthetic qualities of such an article would be larger than the class of people who would actually purchase it for those aesthetic qualities; thus, while a large number of people might consider an object art, it might still fail to be marketable to a “significant segment of the community.” *See id.*

¹¹⁴ *Id.*

¹¹⁵ *Id.* (quoting H.R. REP. NO. 94-1476, at 55 (1976)). To illustrate, Judge Newman uses the example of an artistically designed chair worthy of display in a museum. The fact that it has artistic value alone does not satisfy conceptual separability, he argues,

Finally, Judge Newman offered his own test for conceptual separability. He concluded that in order for the design to be conceptually separate, “the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”¹¹⁶ He explained, “[t]he 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.”¹¹⁷

Judge Newman explained that the “beholder” in his test is “the ordinary, reasonable observer” used in other areas of copyright law.¹¹⁸ Thus, the finder of fact “determines the issue in light of the impressions reasonably expected to be made upon the hypothetical ordinary observer.”¹¹⁹

Judge Newman further elaborated that the necessary separateness is present “whenever the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously.”¹²⁰ He used the example of an artistically designed chair; the utilitarian function of the chair cannot be displaced in the mind of the ordinary observer by some other concept, no matter how artistically designed the chair is.¹²¹

Judge Newman insisted that it is not sufficient for the design of an article to create in the ordinary observer’s mind any concept distinct from the utilitarian function; a non-utilitarian concept is separate from the concept of the utilitarian function only if the ordinary observer can entertain the non-utilitarian concept without simultaneously contemplating the utilitarian function.¹²² Finally, Judge Newman noted that under his test, judges will have to partake in some assessment as to the nature of art, but that such a

because the observer still sees a “well-designed chair,” not a piece of art whose design is conceptually separate from its utilitarian function. *See id.*

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting). For example, Newman explains that courts use a hypothetical ordinary observer when determining copyright infringement. *Id.*

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ *Id.* Judge Newman goes on to note that this displacement may occur, however, when viewing other useful objects if the ordinary observer does not at all perceive the utilitarian function. *Id.* Even the chair example may not be as concrete as Judge Newman makes it out to be. One could imagine an artistically designed chair that has a large spike protruding from the top of the seat, or one that has no seat at all. Because these two examples would completely fail to carry out the utilitarian function of a chair—providing a place to sit—perhaps the ordinary observer would not at all perceive the utilitarian function, causing Judge Newman’s test to be satisfied. Such a possibility indicates that even Judge Newman’s test is limited by judges’ individual biases and concepts of art.

¹²² *Id.* at 423.

threshold assessment is inevitable because the non-utilitarian concept offered to satisfy conceptual separability will often be the concept of the article as a work of art.¹²³ However, Judge Newman allowed for consideration of other evidence in making conceptual separability determinations, such as the fact that an object has been used in a non-utilitarian manner, the extent of such use, and whether such use resulted from purchases, as well as expert opinion and survey evidence.¹²⁴ While Judge Newman's opinion was not for the court, it is valuable as a discussion of possible conceptual separability tests. His preferred test was also advocated by a dissenting judge in the Second Circuit's next conceptual separability case.¹²⁵

Two years later, the Second Circuit again considered conceptual separability in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*¹²⁶ In *Brandir*, the Court of Appeals considered the copyrightability of a bicycle rack known as the "RIBBON Rack."¹²⁷ The rack was made of bent tubing and was said to have originated from a wire sculpture.¹²⁸ Brandir's owner explained that he had created the wire sculpture as a means of personal expression and had not considered its utilitarian application until he accidentally juxtaposed another wire sculpture, one of a bicycle, on the first sculpture.¹²⁹ Brandir marketed and sold the rack and, in November 1982, discovered that Cascade was selling a similar product.¹³⁰ Brandir sued Cascade for copyright infringement, and the district court granted Cascade's motion for summary judgment.¹³¹

¹²³ *Id.*

¹²⁴ *Carol Barnhart*, 773 F.2d at 423 (Newman, J., dissenting).

¹²⁵ See *infra* note 147 and accompanying text.

¹²⁶ *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

¹²⁷ *Id.* at 1143.

¹²⁸ *Id.* The shape of the upright rack when viewed at a perpendicular angle, as indicated by a picture attached to the opinion, could be said to resemble a serpent seen from a bird's-eye view. *Id.* at 1150. A photograph is also available at CoolCopyright, <http://www.coolcopyright.com/cases/chp4/brandircascade.htm> (last visited Jan. 27, 2008).

¹²⁹ *Brandir*, 834 F.2d at 1146. Part of what made the RIBBON Rack commercially successful was the fact that bicycles could be parked both on top of the underloops and under the overloops. See *id.* Upon discovering the potential usefulness of the sculpture design as a bicycle rack, the creator met with other developers and submitted plans, including dimensions, to a fabricator. See *id.* Thus, the large form of the sculpture was not contemplated or created until after the creator considered its use as a bicycle rack.

¹³⁰ *Id.*

¹³¹ See *id.* at 1143. Brandir also sued for trademark infringement and unfair competition, legal theories that are beyond the scope of this Note.

The Court of Appeals affirmed.¹³² It ratified the notion of conceptual separability as a basis for copyright protection, but noted that it was unclear as to how it should apply the doctrine.¹³³ The court explicitly rejected Judge Newman's test from *Carol Barnhart*.¹³⁴ Instead, the court adopted an analysis proposed by Professor Denicola that "[c]opyrightability . . . should turn on the relationship between the proffered work and the process of industrial design."¹³⁵ The court explained, "where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists."¹³⁶

Thus, the Second Circuit adopted a conceptual separability test that seems to turn on the subjective design process of the creator.¹³⁷ It gave three reasons for adopting this test. First, the court believed the approach was consistent with its previous cases.¹³⁸ Second, the court believed the test's

¹³² *Id.*

¹³³ *Id.* at 1144 ("'Conceptual separability' is thus alive and well, at least in this circuit. The problem, however, is determining exactly what it is and how it is to be applied.").

¹³⁴ *Id.* at 1147 ("[I]t is not enough that, to paraphrase Judge Newman, the rack may stimulate in the mind of the reasonable observer a concept separate from the bicycle rack concept.").

¹³⁵ *Brandir*, 834 F.2d at 1145 (quoting Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983)).

¹³⁶ *Id.* In full, the court articulated the test as follows:

To state the Denicola test in the language of conceptual separability, if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.

Id.

¹³⁷ However, the court stated:

The work itself will continue to give "mute testimony" of its origins. In addition, the parties will be required to present evidence relating to the design process and the nature of the work, with the trier of fact making the determination whether the aesthetic design elements are significantly influenced by functional considerations.

Id. at 1145–46. Thus, while the test turns on the subjective considerations of the designer during the design process, it allows finders of fact to consider objective evidence of those subjective considerations; a designer's statement that his process was influenced only by artistic, not utilitarian, concerns, is not conclusive.

¹³⁸ *Id.* at 1145. The court explained that the previous conceptual separability cases would have come out the same way. In *Kieselstein-Cord*, the artistic aspects of the belt

emphasis on utilitarian influence in the design process would help courts avoid having to make subjective determinations of what constitutes art.¹³⁹ Finally, the court believed that, as a practical matter, the Denicola test would not be too difficult to administer.¹⁴⁰ Applying its newly adopted test, the Court of Appeals held that the RIBBON Rack was not copyrightable because its design was influenced by utilitarian concerns.¹⁴¹

Judge Winter dissented from the court's judgment on the copyright claim.¹⁴² He argued that the majority's approach "diminishe[d] the statutory concept of 'conceptual separability' to the vanishing point."¹⁴³ He also stated that the majority's focus on the design process made copyrightability turn on "largely fortuitous circumstances" surrounding the creation of the work.¹⁴⁴ Rather than attempt to reconcile *Carol Barnhart* with *Kieselstein-Cord*, Judge Winter said they are irreconcilable and concluded that the *Carol Barnhart* court used a physical, not a conceptual, separability test.¹⁴⁵ Finally, Judge Winter indicated that he prefers Judge Newman's ordinary observer

buckles were the result of purely aesthetic choices, while the artistic elements of the torsos in *Carol Barnhart* were influenced by the torsos' utilitarian functions. *Id.*

¹³⁹ *See id.* ("[T]he test's emphasis on the influence of utilitarian concerns in the design process may help . . . to alleviate the de facto discrimination against nonrepresentational art that has regrettably accompanied much of the current analysis.") (citations omitted).

¹⁴⁰ *Id.*

¹⁴¹ *Brandir*, 834 F.2d at 1147–48. The court noted that, while the rack may have been derived from earlier artistic sculptures, its final form was heavily motivated by utilitarian considerations. *See id.*

¹⁴² Judge Winter actually concurred in part and dissented in part. He concurred in the majority's reversal of the district court's grant of summary judgment on the trademark and unfair competition claims, but dissented from the majority's judgment on the copyright claim. *Id.* at 1150 (Winter, J., concurring in part and dissenting in part). Thus, for present purposes, the important part of Judge Winter's opinion is his dissent.

¹⁴³ *Id.* at 1151.

¹⁴⁴ *Id.* Later, Judge Winter disagreed that protection turns on whether the designer "serendipitously chose the final design of the Ribbon Rack during his initial sculptural musings or whether the original design had to be slightly modified to accommodate bicycles." *Id.* at 1152.

¹⁴⁵ *Id.* 1151. In reaching this conclusion, Judge Winter focused on language in the *Carol Barnhart* opinion distinguishing the aesthetic features of the belt buckles in *Kieselstein-Cord*. That language noted that, unlike the aesthetic features of the torsos, those of the buckles were "added to, or superimposed upon, an otherwise utilitarian article." *Id.* at 1151 (quoting *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985)) (emphasis supplied by Judge Winter, but not in original).

test for conceptual separability.¹⁴⁶

The conceptual separability jurisprudence of the Second Circuit can be summarized as follows: The test for conceptual separability asks whether the design elements are influenced by aesthetic considerations, independent from utilitarian concerns.¹⁴⁷ Dissenters believe that conceptual separability should turn on whether the article can stimulate in the mind of an ordinary observer a concept that is unrelated to the utilitarian functions of the article.¹⁴⁸ The dispute over the appropriate standard for conceptual separability is no longer limited to the Second Circuit. As indicated by Subparts F and G below, the substance of the modern conceptual separability debate is not merely the views of a few dissenting judges. It is instead a clash in the prevailing jurisprudence of different circuits.

F. Pivot Point: *The Seventh Circuit Follows Suit*

While conceptual separability was primarily developed in the Second Circuit, it later found its place in other circuits. The Court of Appeals for the Seventh Circuit recently considered the issue of conceptual separability in *Pivot Point International, Inc. v. Charlene Products, Inc.*¹⁴⁹ In *Pivot Point*, Passage, the plaintiff's founder, sought to develop a mannequin that would depict a runway model's "hungry look."¹⁵⁰ He believed that such a mannequin could be marketed to high-end hairstylists.¹⁵¹ Passage hired Heerlein, a German artist, to create a sculpture of a female head.¹⁵² Passage discussed his "vision" with Heerlein but did not give specific dimensional requirements.¹⁵³ Heerlein then created a plaster sculpture entitled "Mara" and assigned his rights in the sculpture to Pivot Point.¹⁵⁴ Pivot Point

¹⁴⁶ *Id.* at 1151 ("[T]he relevant question is whether the design of a useful article, however intertwined with the article's utilitarian aspects, causes an ordinary reasonable observer to perceive an aesthetic concept not related to the article's use.").

¹⁴⁷ See *Brandir*, 834 F.2d at 1145 (majority opinion).

¹⁴⁸ See *id.* at 1151 (Winter, J., concurring in part and dissenting in part); *Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting).

¹⁴⁹ 372 F.3d 913 (7th Cir. 2004).

¹⁵⁰ *Id.* at 915. Photographs of Pivot Point mannequins are available at Pivot Point Store, http://www.pivotpointshop.com/ProductCart/pc/viewCat_P.asp?idCategory=100 (last visited Jan. 27, 2008). Although the website does not appear to market the original Mara mannequin at issue in the case, one can see by viewing some of the mannequins that the designs have distinguishing features.

¹⁵¹ *Pivot Point*, 372 F.3d at 915.

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.*

successfully marketed and sold the Mara mannequin, and eventually sold different versions, altering the types and lengths of hair, skin tones, and makeup, but leaving intact the original facial features.¹⁵⁵

The defendant marketed a “Liza” mannequin, “which was very close in appearance to Pivot Point’s Mara” and had “strikingly similar facial features.”¹⁵⁶ The district court granted the defendant’s motion for summary judgment, holding that the Mara mannequin was not copyrightable because it did not satisfy conceptual separability.¹⁵⁷ In doing so, the district court adopted Professor Goldstein’s conceptual separability test, which asks whether the aesthetic features can stand alone as art and whether the article would still serve its utilitarian function without the aesthetic features.¹⁵⁸

The court of appeals reversed.¹⁵⁹ It rejected the Goldstein test as protecting too narrow a class of works.¹⁶⁰ After discussing the Second Circuit conceptual separability cases,¹⁶¹ the court adopted the prevailing Second Circuit test and held that conceptual separability exists when “the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.”¹⁶² The court then found that the Mara sculpture was copyrightable because it was the product of Heerlein’s artistic judgment, thus allowing the sculpture to be

¹⁵⁵ *Id.* at 915–16.

¹⁵⁶ *Id.* at 916. Charlene Products’ mannequins can be seen at <http://www.charleneproducts.com/> (follow “products” link, then select “lady mannequins”) (last visited Jan. 27, 2008). While the company offers a Liza mannequin, it is not clear how closely the Liza mannequin resembles the allegedly infringing mannequin in *Pivot Point*.

¹⁵⁷ *See Pivot Point*, 372 F.3d at 917.

¹⁵⁸ *See id.* (explaining the district court’s holding that a PGS feature in a useful article “is conceptually separable if it can stand on its own as [sic] work of art traditionally conceived, and if the useful article in which it is embodied would be equally useful without it”) (quoting GOLDSTEIN, *supra* note 1, at 109).

¹⁵⁹ *Pivot Point*, 372 F.3d at 932.

¹⁶⁰ *See id.* at 924 (“[W]e believe that the test, at least when applied alone, is tied too closely to physical separability and, consequently, does not give a sufficiently wide berth to Congress’ determination that artistic material conceptually separate from the utilitarian design can satisfy the statutory mandate.”).

The court also rejected a test offered by Pivot Point that would have required a finding of conceptual separability in “a ‘work of art’ integrated into a useful article, or a ‘work of art’ put to unexpected use, since the independent concepts of art and utility coexist.” *Id.* at 923 (internal citation omitted). The court rejected this test, however, because it involved “judges in a qualitative evaluation of artistic endeavors—a function for which judicial office is hardly a qualifier.” *Id.*

¹⁶¹ *Id.* at 924–28. The court discussed the same cases addressed in Part III.E., *supra*.

¹⁶² *Id.* at 931 (quoting *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145(2d Cir. 1987)).

conceptualized as existing independently of its use in hair display or makeup training.¹⁶³

Judge Kanne dissented, stating that the Goldstein test was a reasonable explanation of the statutory language and that the Mara sculpture failed this test.¹⁶⁴ He pointed out that the statute looks to the useful article as it exists and not to the creative process.¹⁶⁵ Finally, Judge Kanne concluded that even if the majority's test were acceptable, Mara would fail the test because, from the beginning, Pivot Point intended that the sculpture serve a functional purpose and commissioned the sculpture's creation to fulfill that purpose.¹⁶⁶

¹⁶³ *Id.* at 931. The court noted that there was "no evidence that Heerlein's artistic judgment was constrained by functional considerations;" Passage gave him no dimensional requirements and did not mention functional considerations. *Id.* at 931-32. It is unclear from the opinion, but perhaps the result would have been different if Passage had indicated to Heerlein his intention to market the mannequin as a hair display or makeup training tool. Such a result would, of course, validate Judge Winter's concern that the Second Circuit's process-influence test would cause protection to turn on largely fortuitous circumstances. See *Brandir*, 834 F.2d at 1151 (Winter, J., concurring in part and dissenting in part).

¹⁶⁴ *Pivot Point*, 372 F.3d at 933 (Kanne, J., dissenting) ("[The aesthetic] features are incapable of being identified separately from the utilitarian use of those features. Without features, the mannequin's head and neck would be little more than an egg on a stick, useless for its intended purpose.").

¹⁶⁵ *Id.* at 934.

¹⁶⁶ *Id.* This point introduces an additional issue into the conceptual separability discussion: copyright ownership. Judge Kanne noted that Pivot Point intended the sculpture to serve a functional purpose; however, it was Heerlein who designed the mannequin with hardly any input from Pivot Point. *Id.* at 915. The default owner of a copyright in a work is the author or creator of that work (in this case, Heerlein). 17 U.S.C. § 201(a) (2000). This is why Heerlein had to assign his copyright interest to Pivot Point. If we accept as true the proposition that Heerlein's design was driven only by artistic, not functional, influence (as the *Pivot Point* majority did), then the *Pivot Point*/Second Circuit conceptual separability test would be satisfied with regards to Heerlein.

Pivot Point, on the other hand, originally commissioned the work with functional considerations in mind. Thus, if Pivot Point had designed Mara itself, the *Pivot Point*/Second Circuit conceptual separability test would not be satisfied. However, instead of creating the mannequin itself, Pivot Point outsourced the work to a designer and did not inform him of any functional concerns it had. When Heerlein created Mara, copyright vested in him (since his design process satisfied conceptual separability). He was then able to transfer the copyright to Pivot Point, an entity which probably would not have met the conceptual separability requirement, and therefore could not have enjoyed copyright protection had it designed the exact same mannequin itself.

This dichotomy could allow persons or companies to circumvent the limits of conceptual separability by hiring product designers and giving them vague artistic direction while concealing the intended functional applications of the commissioned works. In such situations, courts might attempt to assess conceptual separability from the

G. Galiano: *The Fifth Circuit Counters*

The Court of Appeals for the Fifth Circuit considered conceptual separability and rejected the *Pivot Point* standard only one year after the Seventh Circuit's decision.¹⁶⁷ In *Galiano v. Harrah's Operating Co., Inc.*, Galiano had entered into an agreement with Harrah's which provided that Galiano would design uniforms for Harrah's casino employees, and the companies' exchanges led to several proposed sketches.¹⁶⁸ Galiano, which could not produce patterns of the sketch designs or make the finished uniforms, entered into a manufacturing agreement with one of Harrah's suppliers.¹⁶⁹ After the contract between Galiano and Harrah's expired and the companies failed to extend it, Harrah's continued to order the Galiano-designed uniforms from its suppliers.¹⁷⁰ Over three years later, Galiano registered the sketches with the Copyright Office.¹⁷¹

Galiano sued Harrah's for copyright infringement.¹⁷² The district court ruled in favor of Harrah's and held that Galiano's copyright was valid only to the extent that it protected the two-dimensional artwork and that the artistic and utilitarian elements of the uniforms were not conceptually separable.¹⁷³

perspective of the entity that commissions the product and not the author. However, there is no statutory basis for such an assessment, as the Copyright Act vests copyright in the author of a work, not the person or entity who commissions it (and the work made for hire doctrine, 17 U.S.C. §§ 201(b) & 101 (2000), would not apply in this situation). Because copyright vests upon fixation, not transfer, it makes sense to assess separability with regard to the original author, not the author's assignee.

¹⁶⁷ *Galiano v. Harrah's Operating Co., Inc.*, 416 F.3d 411 (5th Cir. 2005).

¹⁶⁸ *Id.* at 413.

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

¹⁷¹ *Id.* The certificate of registration classified the sketches as "2-dimensional artwork." *Id.* (internal citation omitted). The registered collection consisted of "more than fifty colored and numbered illustrations, including sketches of uniform style shirts, blouses, vests, jackets, pants, shorts, ensembles, elaborate masquerade-type costumes, and unique head gear and a dozen pages of silkscreen artwork." *Id.* Examples of items in the collection included chef hats shaped like vegetables and uniform shirts with asymmetric closures, piped mandarin collars, embroidered logos, star-shaped buttons, and coin designs. *Id.* at n.3.

¹⁷² *Id.* at 414.

¹⁷³ *See Galiano*, 416 F.3d at 414. The court of appeals noted that the lower court reasoned that "copyright law does not allow one to copyright 'clothing designs' in which the artistic and utilitarian qualities are indivisible . . ." *Id.* The court further explained the district court's holding: "Because none of these design features has intrinsic value as a work of art that can exist independently of the uniform wearing apparel, the district court concluded, they do not qualify for copyright protection." *Id.* at 415.

The Fifth Circuit affirmed.¹⁷⁴ It found that Galiano's designs lacked conceptual separability but declined to adopt the *Pivot Point* test.¹⁷⁵ The court did not reject the *Pivot Point* test outright but refused to apply it because it was not clear how much influence *Pivot Point* would carry in the federal courts.¹⁷⁶ Instead, the court adopted Professor Nimmer's test, which it believed was more appropriate for garment design cases.¹⁷⁷ This test asks whether the useful article would be marketable if it had no utilitarian function.¹⁷⁸ The court went on to state that the *Pivot Point* and Nimmer tests might not necessarily be incompatible and, therefore, adopted Nimmer's marketability test only for clothing design.¹⁷⁹ It concluded that Galiano made no showing that the designs were marketable independently of their function as casino uniforms.¹⁸⁰

IV. WEAKNESSES OF THE CURRENTLY AVAILABLE TESTS

This Part articulates the currently available conceptual separability tests and discusses the weaknesses of each. Subpart A discusses the marketability test proposed by Professor Nimmer and adopted by the Fifth Circuit in *Galiano*. Subpart B addresses the design process test proposed by Professor Denicola and applied by the Second and Seventh Circuits in *Brandir* and *Pivot Point*, respectively. Subpart C addresses the objective test adopted by the Seventh Circuit in *Carol Barnhart*. Subpart D considers Professor Goldstein's test, which Judge Kanne advocated in his dissent in *Pivot Point*. Finally, Subpart E discusses the somewhat ethereal test Judge Newman articulated in his dissent in *Carol Barnhart*. As indicated below, some primary flaws run through several of the tests. Some of the tests require judges to make conceptual separability determinations based on popular notions of art or on their own biased conceptions of art. Some of the tests do

¹⁷⁴ *Id.* at 423.

¹⁷⁵ *Id.* at 418.

¹⁷⁶ *Id.*

¹⁷⁷ *Id.* at 421.

¹⁷⁸ *Id.* (“[I]t may be concluded that conceptual separability exists where there is 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.”) (quoting NIMMER, *supra* note 6, at § 2.08[B][3]).

¹⁷⁹ *Galiano*, 416 F.3d at 421. However, the court also seemed to acknowledge that the Nimmer test has weaknesses, though it believed that it was the best one available for the fact pattern and that any weaknesses failed to offset the benefits of the test. *See id.* (noting that sometimes, a court must “favor what might be a sub-optimal prophylactic rule”).

¹⁸⁰ *Id.* at 422.

not acknowledge the realities of the industrial design process and the inevitable impact of functional concerns. These problems can cause unpredictability and can reduce or eliminate designers' incentives to develop artistically inspired useful articles.

A. *The Nimmer/Galiano Marketability Test*

Professor Nimmer suggests that "conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities."¹⁸¹ This is the standard adopted by the Fifth Circuit in *Galiano*.¹⁸² The major problem with this test is that it will always favor protection for works that more closely resemble mainstream art. While the test may reduce the amount by which judges' personal opinions of the nature of art influence outcomes, the test significantly increases the influence of the personal opinions of other people.¹⁸³ Furthermore, the test's community standard could lead to different outcomes in different courts for the same article. This lack of consistency is certainly not a desirable side effect, especially considering that it is inconsistency among the courts that has led to the confusion surrounding conceptual separability in the first place. Finally, this test would allow protection to turn on fortuitous circumstances beyond the designer's control. If copyright protection is unpredictable, designers will be less likely to develop new designs for useful articles for fear that the designs will be copied.

B. *The Brandir/Pivot Point Design Process Test*

Professor Denicola argued that the separability inquiry should focus on the design process. He explained that "copyrightability ultimately should

¹⁸¹ NIMMER, *supra* note 6, at § 2.08[B][3].

¹⁸² See *Galiano*, 416 F.3d at 419.

¹⁸³ The test could also harm designers whose works are targeted to a narrow class of consumers if a larger class of consumers would not purchase the work for its aesthetic qualities. To illustrate his marketability test, Professor Nimmer uses the example of an automobile incapable of locomotion; it is not likely, he says, that anyone would purchase it "simply to display its attractive shape." NIMMER, *supra* note 6, at § 2.08[B][3].

While it might be true that the vast majority of consumers would not make such a purchase, one can imagine an automobile enthusiast who would purchase an imaginatively designed, non-drivable automobile simply for its aesthetic qualities. If the designer creates the non-moving automobile with such an enthusiast in mind, the designer should not be denied copyright protection merely because he chose to design his work for a narrow class of collectors who do not make up a "significant segment of the community." Such a result would discourage the development of nontraditional art forms.

depend on the extent to which the work reflects artistic expression uninhibited by functional considerations.”¹⁸⁴ The Second Circuit gave effect to this test in *Brandir* when it stated, “if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements.”¹⁸⁵ This is the same test adopted by the Seventh Circuit in *Pivot Point*.

As Professor Denicola notes, a process-based approach would force judges to look beyond appearance alone.¹⁸⁶ In turn, this would help prevent judges’ personal biases from influencing their decisions. Furthermore, this test would, to an extent, allow the designer’s intent to affect the copyrightability of his or her work. However, standing alone, this test is problematic because it ignores the fact that the design process of a useful article will inherently be influenced by functional considerations. Even the most artistic designers of useful articles will want consumers to purchase those articles; thus, they will inevitably be influenced by functional considerations, at least to some degree. The *Pivot Point* test would prevent such designers from obtaining copyright protection. Furthermore, as Judge Winter noted in his dissent in *Brandir*, a process-based test could promote inconsistency by allowing copyrightability to turn on fortuitous circumstances.¹⁸⁷ Such inconsistency is intolerable.

¹⁸⁴ Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983). Professor Denicola argues that “[o]nly such a direct assessment of the nature of the claimant’s contribution can implement the congressional decision to exclude the general realm of industrial design, while preserving exclusive rights in ‘applied art.’” *Id.*

¹⁸⁵ *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

¹⁸⁶ Denicola, *supra* note 184, at 743. Professor Denicola further argues that tests that focus on appearance cannot distinguish industrial design from applied art, and that “[i]t is the process more than the result that gives industrial design its distinctive character.” *Id.* (emphasis omitted).

¹⁸⁷ See *Brandir*, 834 F.2d at 1150 (Winter, J., concurring in part and dissenting in part). Judge Winter further notes that copyright protection is meant to establish incentives for designers to create their works, and thus, should not depend on “purely fortuitous events.” *Id.* at 1152.

Under the process distinction, two designers who independently create the exact same work could be treated differently if one considers functional requirements and the other does not. The Denicola test allows copyright protection for the designer who does not consider function, despite the fact that the two works are the same. This result seems absurd because it encourages designers not to consider whether their works will be commercially successful or to refuse to act on such considerations if they do come to mind.

C. *The Carol Barnhart Objective Test*

The Second Circuit applied an objective test in *Carol Barnhart*. According to that court, the aesthetic features embodied in a useful article are conceptually separable from that article if they are not required by the article's utilitarian features.¹⁸⁸ Professor Patry offers a very similar formulation of an objective test. He argues that conceptual separability is met when a useful article embodies original pictorial, graphic, or sculptural elements and when the form or function of the work does not require those elements.¹⁸⁹ He says, however, that the aesthetic features need not be completely uninfluenced by functional considerations.¹⁹⁰

This test has some advantages. First, the *Carol Barnhart* test is different enough from physical separability so as to actually allow protection when physical separability is lacking. This is not the case for all of the tests. Second, the objective test greatly reduces the chance that a judge's personal biases regarding the nature of art will control the outcome of litigation. Determining whether an element is dictated by the form or function of a useful article merely requires an inquiry into whether there was an alternative design choice available. Still, the test is not without its flaws. The test's biggest problem is that it does not clarify when a feature of a useful article is dictated by function. The court's articulation of the test suggests that this is a "yes or no" issue; that is, if a design element is required by function at all, no matter how little the degree, the design is not conceptually separable (though the Patry formulation avoids this problem by allowing some functional influence). Furthermore, by directing judges to consider the original PGS elements embodied in a useful article, the test invites judges to isolate and analyze individual aspects of the work. However, it is the overall design of the work, not any individual element, for which the designer seeks copyright

¹⁸⁸ See *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985).

¹⁸⁹ 1 WILLIAM F. PATRY, *COPYRIGHT LAW AND PRACTICE* 285 (1994). Professor Patry says of conceptual separability:

It should be satisfied when (1) original pictorial, graphic, or sculptural elements can be identified as being embodied in a three-dimensional useful article; and (2) those elements are not dictated by either the form or the functions of the useful article. Contrary to the Copyright Office definition, it should not be necessary that the conceptually separable elements be independent of the useful article.

Id.

For an interesting discussion of a similar approach, one that would adopt trademark law's "alternative design" standard, see Setliff, *supra* note 63, at 71–75.

¹⁹⁰ PATRY, *supra* note 189, at 285. Professor Patry explains, "[c]ontrary to the *Brandir* majority, it also should not be necessary that the conceptually separable elements be uninfluenced by the form or functions of the useful article." *Id.* Thus, his test allows designers to entertain practical concerns that will allow them to better sell their works.

protection.¹⁹¹

D. *The Goldstein Test*

Professor Goldstein articulates conceptual separability as follows: “a pictorial, graphic, or sculptural feature incorporated in the design of a useful article is conceptually separable if it can stand on its own as a work of art traditionally conceived, and if the useful article in which it is embodied would be equally useful without it.”¹⁹² The district court applied this test—and the Seventh Circuit rejected it—in *Pivot Point*.¹⁹³ Judge Kanne also promoted this test in his dissent from the Seventh Circuit’s opinion.¹⁹⁴ The Goldstein test has two problems. The first part of the test (asking whether the PGS feature can stand on its own as a traditional work of art) invites finders of fact to use their own personal biases and opinions of the nature of art in determining whether a useful article is copyrightable. The test would therefore hurt designers who wish to explore modern or abstract art with their useful articles. The second part of the test, as noted by the majority in *Pivot Point*, is very similar to physical separability.¹⁹⁵ Thus, the test would fail to provide an alternative means of protection for design elements that do not meet the rigorous physical separability standard.

E. *The Newman Test*

In his dissent in *Carol Barnhart*, Judge Newman explained that to be conceptually separable, PGS elements “must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”¹⁹⁶ The “beholder” in Judge Newman’s test is the “ordinary,

¹⁹¹ Thus, a better formulation would be a requirement that the useful article embody a potential PGS work as a whole, as opposed to a requirement that the individual elements embody a PGS work.

¹⁹² GOLDSTEIN, *supra* note 1, at 109. Professor Goldstein provides a few examples that helpfully illustrate his point: he notes that an ornamental belt buckle, a statuette used as a lamp base, and a novelty slipper shaped like a bear’s paw would all be conceptually separable. *Id.*

¹⁹³ See *Pivot Point Int’l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 917 (7th Cir. 2004).

¹⁹⁴ *Id.* at 933 (Kanne, J., dissenting).

¹⁹⁵ *Id.* at 924 (majority opinion).

¹⁹⁶ *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting). Commentators have labeled this test the “temporal displacement” test. PATRY, *supra* note 189, at 278; see also Christine Haight Farley, *Judging Art*, 79 TUL. L. REV. 805, 847 (2005).

reasonable observer.”¹⁹⁷ This test again allows copyrightability to turn on a judge’s personal biases. The judge’s personal opinions of what constitutes art will inevitably influence the judge’s belief of whether a reasonable observer would see the work as embodying something other than its utilitarian functions. Furthermore, while the hypothetical “reasonably ordinary observer” standard may be effective in other areas of law, it does not work in this context. If the standard does work, it does so when applied in cases where the issue is relatively objective. That is not the case here. Judge Newman’s test is not asking, for example, whether a reasonable observer would see one work as substantially similar to another work. Judge Newman’s question for the reasonable observer is one that touches on the nature of art. Ordinary reasonable people will always disagree about the nature of art because it is a matter of personal taste and imagination. For the same reason, ordinary reasonable people would disagree about whether a useful article can evoke a separate concept. Thus, the issue presented by Judge Newman’s test is so abstract that the ordinary reasonable person standard is not suitable.

Clearly, the major tests that have been proposed by the courts and commentators have failed to simplify the conceptual separability doctrine. An obvious effect of this failure is confusion and disagreement among the courts. Perhaps even more alarming is the unpredictability this lack of clarity causes when it comes to the availability of copyright protection for the design of a particular useful article. The next Part suggests a test that would do away with this confusion and unpredictability.

V. A PROPOSED ALTERNATIVE TEST

This Part proposes a resolution to the conceptual separability debate. Subpart A proposes an alternative test for conceptual separability. The proposed test urges courts to balance two factors: 1) the degree to which the design process is influenced by aesthetic considerations, as opposed to functional ones, and 2) the degree to which the design of a useful article is dictated by its utilitarian function. Subpart B discusses the advantages of the proposed balancing test and argues that the test serves the goals of copyright law.

While this Note focuses on conceptual separability, courts should continue to use physical separability as a first step in their analysis. Physical separability is a much simpler doctrine than conceptual separability.¹⁹⁸

¹⁹⁷ *Carol Barnhart*, 773 F.2d 422 (Newman, J., dissenting).

¹⁹⁸ See Fowles, *supra* note 64, at 310 (noting that physical separability is a relatively straightforward test). By applying the physical separability test first, courts would be able to avoid the inherent uncertainty of conceptual separability if a useful article satisfies

Furthermore, it gives effect to Congress's intent. As evidenced by the House Report, Congress believed that physical separability is enough for copyright protection.¹⁹⁹ Indeed, the relative simplicity of physical separability may make it tempting to eliminate the doctrine of conceptual separability altogether, especially considering the confusion conceptual separability has caused. However, this is not an option for two reasons. First, in many situations, physical separability will not be enough to afford the most desirable level of protection. As discussed above, the physical separability standard can lead to very harsh, arbitrary results.²⁰⁰ Second, eliminating conceptual separability as an alternative means of obtaining protection would directly conflict with the intent of Congress, as evidenced by the House Report accompanying the Copyright Act of 1976.²⁰¹ Clearly, conceptual separability is a necessary alternative means to obtaining copyright protection for useful articles.

A. *The Proposed Alternative Test*

A conceptual separability test must balance the need to protect artistic expression with the need to make utilitarian products widely available. Courts could accomplish this difficult task by applying a two-factor balancing test. Courts should balance: 1) the degree to which the designer's subjective process is motivated by aesthetic concerns, and 2) the degree to which the design of a useful article is objectively dictated by its utilitarian function.

The first factor requires courts to consider the degree to which aesthetic concerns, as opposed to functional ones, motivate the designer. Unlike the *Brandir* design process test, the first factor does not require that the design process be completely uninfluenced by functional considerations in order for conceptual separability to be satisfied. Instead of making this a clear "yes or no" question, the proposed balancing test makes the question one of degree. If the design is driven more by functional than aesthetic choices, then the first factor weighs against conceptual separability. On the other hand, if aesthetic considerations are the primary influence in the design process, then this factor supports a finding of conceptual separability. Because the design process of useful articles will inevitably involve attention to both aesthetic

physical separability. See NIMMER, *supra* note 6, at § 2.08[B][3] ("Given physical separability, the inquiry regarding conceptual separability need not be reached . . .").

¹⁹⁹ H.R. REP. NO. 94-1476, at 55 (1976).

²⁰⁰ See Part III.C., *supra*.

²⁰¹ H.R. Rep. 94-1476, at 55 (1976). ("Unless the shape of an . . . 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 . . .") (emphasis added).

and utilitarian concerns, courts must take note of the degree to which one type of concern predominates over the other in the design process. That is, if aesthetic concerns greatly dominate the design process, this factor should weigh more heavily towards a finding of conceptual separability than if aesthetic concerns are only mildly more influential than functional concerns. The same approach would apply in cases where functional concerns appear to predominate; the degree of predominance should determine how heavily this factor weighs against conceptual separability.

In considering the first factor, courts should look to both subjective evidence, such as the designer's testimony as to his or her process, as well as objective evidence, such as correspondence or meetings between the designer and other parties that might shed light on the design process. By considering the design process as a matter of degree, courts will avoid penalizing designers who are aware of the realities of the consumer marketplace. After all, traditional "artists," such as painters, must consider the marketability of their works if they wish to make a living. Designers of useful articles should also be able to entertain such practical considerations without forfeiting copyright protection. However, this factor of the test also allows courts to deny protection when utilitarian concerns influence a designer too much, thus sustaining the notion that function is not the subject of copyright.

The second factor is derived from the *Carol Barnhart* objective test. However, it is somewhat modified from the Second Circuit's articulation. Under the proposed balancing test, courts should consider the degree to which the design of a useful article is dictated by its utilitarian function.²⁰² If the design is mostly dictated by function, this factor should weigh against conceptual separability, and therefore, against copyright protection. Conversely, if the design is hardly dictated by function at all, this factor should weigh in favor of a finding of conceptual separability. Unlike the *Carol Barnhart* test, this factor acknowledges that in some cases, the aesthetic features of a useful article may be somewhat, but not entirely, dictated by its form or function. For example, the utilitarian function of a table lamp dictates that it has a flat bottom and fits on a table. However, the function does not completely dictate the shape or width of the base. Some elements of the base, such as its color, are not dictated by function at all. Other elements of the lamp's design provide similar examples. Most would agree that a lamp's utilitarian function dictate that it have a shade; however, the size and shape of that shade are not completely dictated by function. The rigid *Carol Barnhart* test could deny protection when the design of a work is

²⁰² Cf. *supra* note 188 and accompanying text. The *Carol Barnhart* formulation suggests that separability should depend on a clear "yes or no" determination of whether the design of a useful article is dictated by its form or function. In contrast, the proposed two-factor balancing test makes this question one of degree.

only somewhat dictated by function. The proposed balancing test allows the court to treat this issue as a matter of degree rather than as an absolute. Furthermore, this factor would not be detrimentally difficult to apply because courts could consider objective evidence, such as the plausibility of alternative designs (evidence of which could be provided by the designer and other experts).

The second factor serves an important function: it limits the availability of copyright protection. The first factor allows protection to turn on the designer's subjective process. Focusing on the subjective process is desirable because it prevents copyrightability from turning on the biases of judges or consumers. However, if the test focused solely on the designer's subjective process, it would provide too much protection. Theoretically, aesthetic considerations could heavily dominate the design process, but the resulting product design could be almost entirely dictated by function. Such a situation may arise when a designer creates a useful article that is the first of its kind. The designer may focus his or her design process almost entirely on aesthetics and give minimal consideration to functionality. Still, the resulting design could turn out to be the only possible form in which the product could function. It would be inconsistent with the purposes of copyright law to grant protection to such a design because that is exactly the type of work that should not be subject to monopoly control.²⁰³ The second prong of the proposed balancing test would allow a court to find that the design, while artistically motivated, is not conceptually separable.

B. Advantages of the Proposed Two-Factor Balancing Test

The two-factor balancing test has several major strengths. First, the test focuses only on the design process (both the subjective and objective elements). The test does not consider other elements, such as the marketability of the work.²⁰⁴ The elimination of other elements is ideal because it makes copyright protection more predictable for designers, as they are in an easy position to judge the extent to which functional considerations influence the overall design process and dictate certain design choices.

²⁰³ The requirement of originality, which is a prerequisite for the copyrightability of any work, is another limit. If a design, whether artistically motivated or not, is almost completely dictated by function, there is a good chance that it would not be original enough to qualify for protection in the first place. The second factor of the proposed balancing test, in addition to serving as a limit on the first factor, would also serve as a supplement to the originality requirement. The second factor would fill in any gaps where the design of a useful article is original but almost completely dictated by function (such a gap could clearly exist when a product is the first of its kind).

²⁰⁴ See *supra* page 136 (discussing marketability test proposed by Professor Nimmer and adopted by the Fifth Circuit in *Galiano*).

Because the balancing test focuses on only the design process, it prevents copyrightability from turning on fortuitous occurrences beyond the designer's control. By making protection more predictable and less subject to factors beyond the designer's control, the proposed test provides an incentive for designers to create artistically designed useful articles.

Second, by considering only the design process, the proposed balancing test ensures that copyrightability does not turn on judges' personal tastes. The test does not incorporate other standards that are based on the work being conceivable as art.²⁰⁵ Asking whether the product can stand alone as a traditional work of art, or whether an imaginary ordinary observer could conceive the product as art, invites judges to give effect to their own preconceived notions of the nature of art. This effectively would allow them to grant or deny protection based on their own biases and personal tastes. The proposed balancing test does not give judges the opportunity to allow their biases to affect the outcome. Instead, the only relevant perspective is that of the designer. This makes copyright protection much more predictable. Furthermore, eliminating the "traditional work of art" inquiry ensures that works will not be precluded from protection merely because they do not fall into the category of popular or mainstream art. Predictability of protection and elimination of a popular art standard in turn provides more incentive for designers to create artistically designed useful articles.

Third, because it balances both the subjective and objective elements of the design process, the proposed balancing test provides a much needed degree of flexibility. Unlike tests that would deny protection when the designer considers functional concerns at all,²⁰⁶ or when a design is dictated by function even minimally,²⁰⁷ the proposed balancing test takes account of the fact that utilitarian considerations and the design requirements of an article's function will influence the design process to different degrees in different cases.

The fact that the proposed test does not provide a bright line rule is not a weakness, but an advantage. Separability strives to balance the protection of artistic expression with the denial of protection for functionality. The line between the two is not always clear. A conceptual separability test needs to be flexible so that courts can deal successfully with those cases where the line is not clear. Furthermore, the flexibility inherent in the proposed test does not make the test detrimentally difficult to apply. Nor does it give judges too much discretion and allow them to base separability

²⁰⁵ See *supra* pages 139–40 (discussing Professor Goldstein's and Judge Newman's tests).

²⁰⁶ See *supra* pages 136–37 (discussing Professor Denicola's test, which was adopted by the Second Circuit in *Brandir*).

²⁰⁷ See *supra* pages 138–39 (discussing the *Carol Barnhart* test).

determinations on improper considerations, such as their own conceptions of art. Instead, the flexibility of the proposed test merely takes account of the reality that a useful article's function will inevitably impact its design, whether by influencing the designer's mental process or by requiring certain design elements.

The separability requirement exists in order to balance the need to protect artistic expression with the desire to deny protection to utilitarian function.²⁰⁸ This dichotomy derives from the ultimate purpose of copyright law: promoting the arts and sciences for public benefit through the widespread dissemination of works.²⁰⁹ Copyright law provides an author with a limited monopoly over his or her works; thus, it encourages artistic creation by ensuring that free-riders do not copy the author's work (which would cause a decrease in or the possible elimination of the original author's potential profit).²¹⁰ Eliminating free-riders spurs dissemination of works by providing an economic incentive to create. However, copyright protection must be limited; without limits, copyright would stifle dissemination by allowing permanent monopolies over any creation, making works less available to the public.²¹¹ The separability doctrine is one such limit. The doctrine creates an incentive for artistic creation by allowing for protection of truly aesthetic designs of useful articles. At the same time, the doctrine ensures that useful articles are widely available by denying protection to works that are purely utilitarian. The proposed conceptual separability test successfully balances these competing needs.

The two-factor balancing test furthers the ultimate goal of copyright law by encouraging the widespread dissemination of works for public benefit. Absent fair and predictable copyright protection for the design of useful articles, designers would not have any incentive to merge the useful and the artistic because designs could be copied freely, preventing the designer from benefiting from his or her artistic work. This would deny the public the benefit of a wide variety of choices. The proposed balancing test provides

²⁰⁸ See Note, *Rethinking Copyright for Advertisements*, 119 HARV. L. REV. 2486, 2501 (2006).

²⁰⁹ See CRAIG JOYCE ET AL., COPYRIGHT LAW 57 (6th ed. 2003); see also Stephen Langs, *The Definitional Scope of an Intrinsic Utilitarian Function Under the 1976 Copyright Act: One Man's Use is Another Man's Art*, 20 W. NEW ENG. L. REV. 143, 164 (1998).

²¹⁰ See JOYCE, *supra* note 209, at 57 n.10 (quoting *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("The immediate effect of our copyright law is to secure a fair return for an author's creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the public good.")).

²¹¹ See *id.* at 58. Joyce notes that copyright protection is limited by doctrines such as originality, fair use, and the idea/expression dichotomy. Separability is another limiting doctrine.

incentives for designers to incorporate aesthetic creativity in the design of useful articles by making protection predictable and allowing protection to turn on the design process only. The public would stand to benefit by having a variety of choices when it comes to useful articles, each choice having different aesthetic qualities. The two-factor balancing test, unlike the others discussed in this Note, properly balances the need to protect artistic expression with the need to deny protection for utilitarian function.

VI. CONCLUSION

The merger of functional products with artistic design has caused a tension between the interest in providing copyright protection for artistic expression and the interest in denying protection for utilitarian function. The separability requirement, incorporated into the Copyright Act of 1976, is Congress's attempt to resolve that tension. However, the courts have not reached a consensus as to how to apply the separability requirement. After the recent inconsistent *Galiano* and *Pivot Point* decisions by the Fifth and Seventh Circuit Courts of Appeals, both of which were written more than twenty-five years after the 1976 Act took effect, it is clear that the debate over conceptual separability is still alive and well. Conceptual separability is necessary to provide copyright protection for the artistic and aesthetic features of useful articles and deny protection to designs that are purely functional. However, it is a difficult concept, and courts have had great difficulty not only in defining a successful test for the doctrine, but in reaching a consensus on which test is appropriate. This has, in turn, led to confusion regarding the copyrightability of the designs of useful articles. Neither the test adopted by the Seventh Circuit in *Pivot Point* nor the test adopted by the Fifth Circuit in *Galiano* provide a satisfactory line for distinguishing between copyrightable artistic expression and uncopyrightable utilitarian function. The Newman and Goldstein tests are not suitable alternatives. The *Carol Barnhart* test, while a good start, is not, in itself, enough to successfully balance the protection of expression with the freedom of function.

This Note proposes an alternative, two-factor balancing test. It directs courts to balance 1) the degree to which the designer's subjective process is motivated by aesthetic considerations, as opposed to functional ones, and 2) the degree to which the product's design is dictated by its utilitarian function. The proposed test would allow protection for useful articles that truly involve artistic expression, but would deny protection for useful articles that are purely utilitarian in nature. The proposed test makes copyrightability more predictable. Furthermore, the test accounts for the realities of industrial design by allowing protection even if the design process is influenced by functional considerations or the product design is somewhat dictated by a

product's utilitarian function. Thus, the test accomplishes the balancing necessary to give designers incentives to produce aesthetically motivated useful articles. This in turn benefits the public by providing a wide variety of choices in the designs of useful articles. The proposed balancing test is better than the currently available tests because the proposed test successfully balances the competing considerations of copyright protection in industrial design and because it furthers the purposes behind American copyright law.