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THE COPYRIGHT/PATENT BOUNDARY

*Viva R. Moffat **

INTRODUCTION

In passing the Copyright Act in 1976, Congress provided that “pictorial, graphic, and sculptural works” were to be protected, but at the same time made clear that works of industrial design, as opposed to works of applied art, were not to be protected by copyright law.¹ Put simply, “useful articles” are not copyrightable.² This is so because useful things belong in the patent realm, if they are to receive protection at all. Seemingly straightforward, this distinction—between applied art and industrial design, between copyright law and patent law—has long perplexed policy-makers, courts, and academics.

While the law and the language, as shall be seen, can be jargon-filled and obscure, at issue is a straightforward and real-world concern: whether and to what extent items like bicycle racks, smartphones, belt buckles, mannequins, and all manner of everyday products ought to be protected by some kind of exclusive right. Put another way, the question is whether copyright provides the proper form of protection for items of industrial design.

This article concludes emphatically that, while some kind of protection—that is, some kind of restriction on copying, be it design patent, trade dress, or a *sui generis* form of protection—may be appropriate, copyright law is not the right approach. More specifically, “not copyright” for industrial design is sufficiently im-

* Associate Professor, University of Denver Sturm College of Law. I presented this article at the Intellectual Property Scholars Conference at Stanford Law School, and appreciate the comments from many in attendance, including Mark McKenna, Jerome Reichman, Rebecca Tushnet, and Samson Vermont. I also thank Sarah Burstein, Bernard Chao, Alan Chen, Robert Denicola, Laura Heymann, and Sam Kamin for valuable feedback and Amanda Walck for outstanding research assistance.

1. Copyright Act of 1976 § 101, 17 U.S.C. § 101 (2012).

2. I use the term “useful articles” to refer to useful items or useful aspects of items that also have aesthetic elements.

portant that a bright-line rule excluding industrial design from copyright, in contrast to the nuanced standards currently employed, should be adopted.

A bright-line “not copyright” approach is important because if there is uncertainty, industrial designers are likely to pursue copyright rather than patent protection. This undermines the patent system and subverts the goals of that regime and of the federal intellectual property system generally. Patent law protects new, *useful*, and nonobvious inventions.³ The examination process is rigorous and expensive; many inventions receive no protection; those inventions that do receive protection are injected into the public domain after the twenty-year patent term expires.⁴ This last aspect is particularly noteworthy: useful inventions are free for all to copy after the patent term has expired. Under this quid pro quo, the inventor gets strong monopoly rights in exchange for releasing the work to the public after twenty years. Many inventors and designers might, however, prefer copyright protection if it were available. Copyright offers protection that is not as strong as patent, but it is vastly easier to obtain, in terms of time and money, and lasts much, much longer.⁵ If there is to be any meaning to the hurdles patent law places in the way of protection, copyright law cannot allow an end run around those requirements.

Delineating the boundary between copyright and patent law is thus fundamentally important to the federal intellectual property regime and to the goals of the patent system in particular. Drawing that line in the context of applied art and industrial design has proven to be particularly difficult, however.

In the deliberations leading up to the passage of the 1976 Copyright Act, Congress indicated that it intended to provide protection for the aesthetic aspects of useful articles to the extent those elements are “physically or conceptually separable” from the useful aspects of the work.⁶ When there is physical separability—as with, for example, a Mickey Mouse telephone—the analy-

3. 35 U.S.C. § 101 (2006) (new, useful inventions); *id.* § 103 (nonobviousness). To be clear, I am drawing a distinction here between copyrights and utility patents.

4. *Id.* § 154(a)(2).

5. 17 U.S.C. § 302(a) (2012) (for individually authored, nonanonymous works, the copyright term is the life of the author plus seventy years).

6. There is a long history pre-dating the 1976 Act, *see infra* notes 140–41 and the sources cited therein, but it is the conceptual separability notion, brought to the fore by the 1976 Act, that is the currently vexatious problem.

sis is relatively simple. The sculptural aspects of a Mickey Mouse telephone can be distinguished easily from the operable telephone components.⁷ One can imagine taking a hacksaw or some other tool and removing the old-school telephone pieces.

As in so many areas of the law, however, the easy cases are easy and the difficult cases are confounding. According to the legislative history, even when there is no physical separability, there might be “conceptual separability.”⁸ This has been a much more vexing issue for the courts to address.⁹ While the theory is straightforward—design elements are protectable, useful elements are not protectable—the application has proven to be quite thorny.¹⁰ The courts have developed a multitude of tests, none of which has turned out to be either practically or theoretically satisfying.

Brandir International, Inc. v. Cascade Pacific Lumber Co. provides an illuminating example.¹¹ The case involved the “ribbon” bicycle rack.¹² Familiar to many, the bicycle rack is described as both “elegant” and “functional” by the Industrial Designers Society of America.¹³ It is installed all over the world as a bicycle rack, and it is in the permanent collection of the Museum of Modern Art.¹⁴ It is iconic in and of itself, and it is an iconic example of the difficulty of determining “conceptual separability.” The aesthetic and functional elements of the bicycle rack are not physically separable. Unlike the Mickey Mouse telephone, one cannot imagine taking a hacksaw and cutting off the aesthetic or design elements of the ribbon rack. Determining whether these elements

7. The Mickey Mouse telephone example is borrowed from ROBERT P. MERGES, ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 492 (6th ed. 2012). An image of a Mickey Mouse phone is easy to find on the internet. See, e.g., PHONE PHUN NOVELTY TELEPHONES, <http://www.noveltytelephone.com/products/talkingmickey.html> (last visited Dec. 6, 2013).

8. H.R. REP. NO. 94-1476, at 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668; see *infra* Part I.A.

9. See *infra* note 91 and accompanying text.

10. See *infra* Part II.A.

11. 834 F.2d 1142 (2d Cir. 1987).

12. *Id.* at 1143. The Ribbon Rack is in the shape of a sound wave, more or less. An image is available on Brandir's website. BRANDIR INTERNATIONAL, INC., <http://www.ribbonrack.com> (last visited Dec. 6, 2013).

13. This is according to Brandir's website. See BRANDIR INTERNATIONAL, INC., *supra* note 12.

14. See *id.*

are "conceptually separable" is a problem of almost metaphysical dimensions.¹⁵

In *Brandir*, the Second Circuit discussed the variety of tests that had been used and ultimately settled on a test proposed by Professor Robert Denicola in a 1983 law review article.¹⁶ Only seven years after the passage of the Copyright Act of 1976, Denicola's influential article was just one of a number of proposals aimed at shaping the judicial approach to the useful article problem.¹⁷ The *Brandir* case is notable for its adoption of the Denicola test and for its recitation of the other tests used by the Second Circuit and other courts. In that case alone, the court discusses three or four formulations of a test for conceptual separability.¹⁸ Since the *Brandir* case, courts and scholars have continued to struggle with the conceptual separability problem. This article suggests a few reasons for this difficulty.

The first is that very few of the current tests or proposals even acknowledge, much less incorporate, the broader policy reasons for excluding useful articles from copyright protection. Nearly all of the proposals address the fact that Congress has sought to distinguish between applied art and industrial design, but virtually none of them explains why. The second, somewhat counterintuitive, drawback of the existing proposals is that many of them seek to delineate the exact contours of what is "aesthetic" or "art" or "artistic." This leads to complicated, fact-intensive, unpredictable tests that fail either to "get it right" or to advance the underlying purpose of the useful article doctrine.

These two observations, taken together, lead in a new direction. When it is acknowledged that the primary reason to exclude useful articles from copyright protection is to ensure that copyright does not intrude on either patent law or on the free copying of unpatented industrial designs, it becomes clear that drawing a

15. Michael J. Lynch, *Copyright in Utilitarian Objects: Beneath Metaphysics*, 16 U. DAYTON L. REV. 647, 647 (1991) (citations omitted) ("Among the opportunities for metaphysicians provided by the Copyright Act of 1976, the scheme for protection of design features of useful articles stands out.").

16. *Brandir*, 834 F.2d at 1145-46 (citing Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983)).

17. E.g., Denicola, *supra* note 16, at 708 & n.7 (claiming that "alternative proposals have become a congressional fixture, spawning a raft of conflicting academic analysis" and citing a publication by the U.S. Copyright Office summarizing this literature).

18. *Brandir*, 834 F.2d at 1144-46.

bright line is more important than ensuring the correctness of the nuances and contours of the line. Quite a number of scholars and industry insiders have advocated for a sui generis regime of protection for industrial design.¹⁹ This article remains agnostic as to that possibility, but it should be noted that a bright-line “not copyright” approach for useful articles would aid in the effective operation of such a system if enacted.²⁰

In devising a new approach, this article borrows from trademark law. Though not perfectly analogous, of course, trademark law is instructive because it has a channeling doctrine and a relatively bright-line rule animated by the overarching policy concern of excluding functional items from trademark law in order to preserve the patent bargain and the freedom to copy unpatented useful items. Trademark’s functionality doctrine is not concerned primarily with defining what is trademarkable.²¹ Instead, it is focused on what is *functional* and explicitly errs on the side of under-protection. Under that doctrine, an item will not receive trademark protection if it is functional, even if it satisfies the trademark criteria in other ways.²²

The approach proposed here similarly errs on the side of under-protection, incorporating this same burden-shifting, default-creating rule. Some items will be copyrightable—fixed, original expression—but nonetheless excluded from the copyright realm. In an infringement suit, the copyright proponent, even though it will have a copyright registration in hand, must demonstrate that its work is not useful if the useful article doctrine is raised as a defense.²³ Placing this burden on the copyright plaintiff will make

19. See *infra* Part II.B.

20. In other words, the bright-line rule proposed here would help channel works of industrial design away from copyright law. Where those works might end up—the public domain, patent law, or a sui generis regime—is beyond the scope of this article. In the wake of the *Apple v. Samsung* verdict, there has been a resurgence of interest in design patent law. See, e.g., Sarah Burstein, *Moving Beyond the Standard Criticisms of Design Patents*, 17 STAN. TECH. L. REV. (forthcoming 2013) (copy on file with the author) (arguing that the standard criticisms of the design patent system are not as strong as they appear and that they only obscure the crucial policy questions); Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 18 STAN. TECH. L. REV. (forthcoming 2014), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2355445 (arguing that if the design patent system can be justified it is on the basis that it protects items that blend form and function, items at the intersection of aesthetics and utility).

21. See *infra* Part III.A.1.

22. This is true at least in theory. The Lanham Act explicitly shifts the burden of proof to the trademark proponent to prove nonfunctionality. See *infra* Part III.A.1.

23. The Copyright Act differs from the Lanham Act in that it requires registration

it substantially more difficult for the plaintiff to prevail, as it makes clear that in the close cases there should be a finding of no copyright protection.

Creating this new default position is the most significant aspect of the approach proposed here. As for the copyright proponent's specific burden of proof in demonstrating non-usefulness, there are a few possibilities. The first is a rule of physical separability: if the copyright proponent demonstrates that the aesthetic elements can be physically separated from the useful aspects of the work, the aesthetic elements may be protected. Another approach borrows even more from trademark law: the copyright proponent must demonstrate that the elements sought to be protected are neither essential to the use or purpose of the work nor do they affect the cost or quality of the work.²⁴ The first approach provides a very bright-line that errs greatly on the side of "not copyright." The second possibility brings with it many of the problems inherent in trademark's functionality doctrine, but it has the benefit of the Supreme Court's imprimatur and some pre-existing judicial experience with the doctrine.

This article proceeds in three parts. Part I briefly summarizes the statutory language and legislative history concerning the useful article doctrine. The discussion then turns to the purposes of the doctrine and demonstrates that the underlying goal is to channel useful works *away* from copyright law in order to protect the integrity of the patent system. In other words, the doctrine is less about copyright law than it is about the intellectual property regime in a broader sense. Part II catalogs the current judicial approaches to the useful article doctrine, along with the multi-

before an infringement suit can be commenced. Compare 17 U.S.C. § 411(a) (2012) ("[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title."), with Lanham Act of 1946 § 43(a), 15 U.S.C. § 1125(a) (2012) ("Any person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . shall be liable in a civil action . . ."). Thus, a copyright plaintiff will always have a copyright registration certificate. The same is not true in trademark law: a trademark plaintiff may sue on an unregistered mark. The burden-shifting will therefore operate somewhat differently in copyright cases than it does in trademark cases. See *infra* Part III.A.

24. See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)) (discussing the two-part test for functionality in the context of trademark law).

tude of proposals for reform. Nearly all of them share two characteristics. The first is a failure to identify, either explicitly or implicitly, the policy purpose underlying the useful article doctrine. The second is a direct result of this failure: the tests and proposals are overly focused on getting the copyright questions right, and thus do not effectively channel industrial design away from copyright law. In Part III, the article proposes a different approach. Borrowing from trademark's channeling doctrine, functionality, the copyright owner ought to bear the burden of proving non-usefulness. There are a number of possibilities for the elements to be shown by the copyright proponent in order to overcome the burden, and two of them are discussed in this final part.

I. USEFUL ARTICLES, CONCEPTUAL SEPARABILITY, AND COPYRIGHT CHANNELING

This part briefly summarizes the legislative background of the useful article doctrine and then makes the case that the doctrine is animated by concerns not just about copyright law, but about the broader intellectual property regime and patent law in particular. The doctrine should operate to cleanly channel works away from copyright so that designers are not tempted to take copyright's advantages over patent's requirements, but, as will be demonstrated in Part II, the channeling effect, if any, of the current approaches is hardly clean.

A. *The Useful Article Doctrine and Conceptual Separability: Legislative Background*

The 1976 Copyright Act protects "pictorial, graphic, and sculptural works,"²⁵ allowing copyright protection for a broad range of artistic works, as well as industrial designs such as bicycle racks, mannequins, smartphones, and so on, which may be deemed sculptural works. The owner of a copyright in a "PGS" work has the right to control copies and derivatives of the work, the right to distribution, and the right to display the work.²⁶ Notwithstanding the broad language of "pictorial, graphic, and sculptural works," the Copyright Act makes clear that useful articles, or, more accu-

25. 17 U.S.C. § 102(a)(5) (2012).

26. *Id.* § 106(1)–(3), (5) (2012).

rately, any useful aspects of a work, are excluded from protection. The definition states that "PGS" 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.²⁷

A "useful article" is defined as an item "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."²⁸

The language of the Copyright Act is quite clear: useful articles, or aspects of works that are useful, are not the proper subject of copyright protection. Designs of useful articles are protectable only if they can be identified separately and if they exist independently of the utilitarian aspects.²⁹ As will be demonstrated below, however, the policy animating this rule is less clear. Perhaps for that reason, the application of the useful article doctrine has presented substantial difficulties.

There is scant legislative history concerning the doctrine. The brief discussion in the House Report does not discuss the reasons for the general principle articulated in the statute, nor does it

27. *Id.* § 101 (2012) (definition of pictorial, graphic, and sculptural works).

28. *Id.* (definition of a "useful article").

29. Congress considered—and then rejected—the possibility of providing copyright protection for designs *not* separable from or independent of the utilitarian aspects of the article. See H.R. REP. NO. 94-1476, at 50 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5663 (describing a provision passed by the Senate that would have created "a new limited form of copyright protection for 'original' designs which are clearly part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself."). The House Report states that this provision was rejected "in part because the new form of design protection . . . could not truly be considered copyright protection and therefore appropriately within the scope of copyright revision." *Id.* The House Report does not state *why* such protection was outside the scope of copyright. It certainly may be because protection of useful aspects of a work more properly belongs in the patent realm. Congress seems to have contemplated some alternative form of "design protection" and left for further consideration whether "creat[ing] a new monopoly" would be justified. *Id.* Concluding, the legislative history states that "the Committee believes that it will be necessary to reconsider the question of design protection in new legislation during [the next session]. At that time more complete hearings on the subject may be held and, without the encumbrance of a general copyright revision bill, the issues . . . may be resolved." *Id.* Those issues were not resolved, of course, and that fact lingers in the disputes about the useful article doctrine.

present a test or rule for resolving the close cases.³⁰ A significant portion of the Report's language follows and is instructive for what it includes—note the italics in the excerpt—and what is omitted:

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 statue 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.* The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design—that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful ar-

30. It must be noted that this brief discussion of the legislative history barely skims the surface of the long, and somewhat tortuous, history of protection for industrial design. This is not a recent problem, and it is not only a problem in the United States. The full scope of this history has been elucidated most fully by Professor Jerome Reichman. See J.H. Reichman, *Design Protection After the Copyright Act of 1976: A Comparative View of the Emerging Interim Models*, 31 J. COPYRIGHT SOC'Y U.S.A. 267 (1984) [hereinafter, Reichman, *Design After 1976*]; J.H. Reichman, *Design Protection and the Legislative Agenda*, 55 LAW & CONTEMP. PROBS. 281 (1992) [hereinafter, Reichman, *Legislative Agenda*]; J.H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6 (1989) [hereinafter, Reichman, *Design Protection and New Technologies*]; J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 DUKE L.J. 1143 (1983) [hereinafter, Reichman, *Design Before 1976*]; J.H. Reichman, *Past and Current Trends in the Evolution of Design Protection Law—A Comment*, 4 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 387 (1993) [hereinafter, Reichman, *Past and Current Trends*]. Professor Reichman's work in this area is nothing short of overwhelmingly impressive. It is impossible to summarize Reichman's approach in a single article, much less a footnote. For this footnote, suffice it to say that Reichman describes industrial design as "the intellectual property world's single most complicated puzzle." Reichman, *Past and Current Trends*, *supra*, at 387. He summarizes the history of industrial design protection as follows: "[F]rom a worldwide perspective, we thus find a recurring cyclical pattern that swings from states of chronic underprotection to states of chronic overprotection, and then back to underprotection once again. This two hundred-year-old cyclical pattern continues to unfold before our eyes." *Id.* at 388.

title as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.³¹

Note that the report indicates that even aesthetically pleasing elements of a work—that is, otherwise copyrightable elements—may not be copyrighted if they cannot be identified separately from the functional elements. The report mentions “conceptual separability” in this regard, and it is that phrase that has led to substantial doctrinal difficulty.³² What is missing from the Report is an explanation of the reasons for excluding useful articles from copyright protection. Understanding what animates the useful article doctrine would go a long way to resolving questions about how best to formulate and apply the doctrine.

B. *Why Exclude Useful Articles from Copyright Protection?*

The 1976 Copyright Act and the minimal legislative history regarding the useful article doctrine both indicate quite clearly that copyright law ought not protect useful articles, but there is little evidence concerning the reasons for the articulation of this principle. Neither the statute nor the legislative history states *why* it was felt important to draw this line between copyrightable works of applied art and uncopyrightable items of industrial design. Although the legislative history is scant, by looking there as well as to a variety of other sources, it is reasonable to conclude that the primary purpose of the “useful article” doctrine is to police the boundary between copyright law and patent law.³³ In other words,

31. H.R. REP. NO. 94-1476, at 55 (emphasis added).

32. See, e.g., Barton R. Keyes, Note, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L.J. 109, 110–12 (2008) (discussing the conceptual separability doctrine post Copyright Act of 1976 and outlining the lack of uniform doctrinal stability among the federal courts of appeals in developing and applying this doctrine).

33. This conclusion is in some ways obvious; there are casebook references and sometimes a throwaway line in a case. On the other hand, there is very little discussion of it in the legislative history, the case law, or the literature. See e.g., MERGES, ET AL., *supra* note 7, at 491 (“Awarding protection for functional works through copyright law—with its low threshold for protection and much greater duration—would undermine the role of the patent system as the principal means for protecting utilitarian works and hinder the process of sequential innovation essential to technological progress. Does the useful article doctrine reflect a similar objective?”). But see *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*,

the useful article doctrine is a channeling doctrine, meant to direct works away from the copyright realm and toward patent law, the public domain, or, perhaps, some other form of protection. In this section, I argue that this is the case, so far as can be determined, as a descriptive matter, and that, as a normative matter, this is the best justification for the useful article doctrine.

1. The Structure of the Intellectual Property Regimes

Some evidence that the purpose of the useful article doctrine is to channel certain works away from copyright law can be gleaned from the structure and nature of the federal intellectual property regimes. In particular, the comparison between patent law and copyright is instructive. Patent law provides substantially stronger rights than copyright law, yet the rights are much more difficult to obtain and last only twenty years, as compared to copyright's "life plus 70" nearly endless term.³⁴ Based on those differences alone, some inventors and designers might well prefer copyright over patent protection.³⁵

There are reasons to discourage some of these inventors and designers from pursuing copyright protection, however. The patent system is often described as involving a "bargain" in which a patent holder receives a package of exclusive rights in an invention for twenty years and, in exchange, the public, including competitors, have a "right to copy" the invention once the patent expires.³⁶ The rights that come along with a patent are potent: the patent holder may exclude all others from making, using, or sell-

372 F.3d 913, 932 (7th Cir. 2004) (Kanne, J., dissenting) ("All functional items have aesthetic qualities. If copyright provided protection for functional items simply because of their aesthetic qualities, Congress's policy choice that gives less protection in patent than copyright would be undermined."); *Am. Dental Ass'n v. Delta Dental Plans Ass'n*, 126 F.3d 977, 980 (7th Cir. 1997) (discussing the difference between the originality inquiry and usefulness: "A lamp may be entirely original, but if the novel elements are also functional the lamp cannot be copyrighted. This is not a line between intellectual property and the public domain; it is a line among bodies of intellectual-property law.").

34. Compare 17 U.S.C. § 302(a) (2012), with 35 U.S.C. § 154(a)(2) (2006).

35. This is obviously not true for all inventors and designers, particularly those whose works are likely to be quite remunerative (and therefore they would prefer patent's stronger protections) yet their shelf life is relatively short (and therefore they are indifferent to copyright's longer term).

36. See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) ("In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.").

ing the patented invention,³⁷ and the defenses to a claim of patent infringement are few.³⁸

To the extent that the patent bargain involves the strong version of a “right to copy” an unpatented item, then permitting other forms of protection for unpatented or formerly patented items interferes with this right to copy aspect of the bargain. For example, if an item that is under patent is also eligible for, and receives, copyright protection, that item cannot be freely copied once the patent expires because the copyright term is so much longer than the patent term. Even an “election” system, in which an inventor or designer might elect copyright protection over patent protection, imposes upon the “right to copy” and thus interferes with the patent bargain.

If the patent bargain is based on the policy decision that certain kinds of invention and innovation ought to be available for free copying sooner rather than later—the notion that competition is more important in certain areas than in others³⁹—that policy decision will be undermined if the terms of the patent bargain can be avoided by a retreat to copyright law by inventors and designers. Of the variety of potentially patentable items, it is the products of industrial design that lay the strongest claim to copy-rightability. In addition to being useful, works of industrial design are often also original, expressive works with substantial aesthetic value. Thus, the potential problems involving the interaction between copyright and patent are most acute in this area, and this is likely one reason the doctrine has presented such difficulty. Works of industrial design do indeed lie at the copyright/patent boundary.

2. Legislative History

Even if the patent bargain does not contemplate a strong form of the “right to copy” unpatented or formerly patented items—that is, if the expiration of the patent term means only that patent rights no longer attach, but that other rights may preclude

37. See 35 U.S.C. § 271(a) (2006) (“[W]hoever without authority makes, uses, offers to sell, or sells any patented invention . . . infringes the patent.”).

38. See *id.* § 282 (2006 & Supp. V 2012).

39. See Lynch, *supra* note 15, at 656 (“The judgment that a free market is more important in useful articles than in art and literature is corroborated in related areas of American patent and trademark law.”).

copying—courts ought to hesitate before allowing copyright to step into the breach with respect to items of industrial design.

The Copyright Act clearly states that useful articles are to be excluded from copyright's purview,⁴⁰ and the legislative history indicates that design protection was not passed at the time of the Copyright Act's revision because it did not fit well within the copyright scheme.⁴¹ According to the House Report, the design protection portion of the legislation was rejected "in part because [it] . . . could not truly be considered copyright protection and therefore appropriately within the scope of copyright revision."⁴² Indeed, many legislators contemplated the passage of a *sui generis* regime.⁴³ The fact that such a regime has not been enacted is not a particularly good reason to expand copyright to include industrial design.

The legislative history of the 1976 Copyright Act does not provide a clear statement concerning the purpose of the useful article doctrine. This is likely because there was no uniform understanding.⁴⁴ The primary reference in the legislative history is to *Mazer v. Stein*, a 1954 Supreme Court opinion.⁴⁵ But only so much can be drawn from this reference.

In *Mazer*, the Supreme Court considered copyright protection for a statuette used as a lamp base.⁴⁶ The manufacturer of the lamp base obtained a copyright registration for the statuette and sold copies, primarily as lamps.⁴⁷ The manufacturer brought suit against alleged infringers, and the issue ultimately presented to the Supreme Court was whether a "work of art" could be copyrighted if it was sold commercially.⁴⁸ The Court emphatically re-

40. 17 U.S.C. § 113(b) (2012).

41. See *supra* note 29.

42. H.R. REP. NO. 94-1476, at 50 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5663.

43. See *supra* note 29.

44. See Reichman, *Past and Current Trends*, *supra* note 30, at 388 (describing the evolving and cyclical nature of the approaches to design protection in the United States and abroad).

45. 347 U.S. 201 (1954); H.R. REP. NO. 94-1476, at 105 ("Section 113 deals with the extent of copyright protection in 'works of applied art.' The section takes as its starting point the Supreme Court's decision in *Mazer v. Stein* . . .").

46. *Mazer*, 347 U.S. at 203.

47. *Id.* at 202-03 ("[T]he statuettes were sold in quantity throughout the country both as lamp bases and as statuettes. The sales in lamp form accounted for all but an insignificant portion of respondents' sales.").

48. *Id.* at 204-05 (simplifying the issue raised in the petition for certiorari and determining the question presented to be: "Can a lamp manufacturer copyright his lamp ba-

jected the infringer's argument, asserting first that there was no question that "works of the fine arts" were protected under the Copyright Act,⁴⁹ and, second, that it did not matter whether those works were reproduced in large quantities or sold commercially.⁵⁰ These conclusions are consistent with the "nondiscrimination" principle, which is based on the notion that judges are not particularly well-suited to making artistic judgments and that copyright law ought not attempt to distinguish between "fine art" and "commercial art" or, more bluntly, good art and bad art.⁵¹ So, clearly the commercial exploitation of a work of art does not bar copyright protection, and this appears to be the primary holding of the Court: "We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration."⁵²

The legislative history, however, describes *Mazer's* holding as follows: "works of art which are incorporated into the design of useful articles, but which are capable of standing by themselves as art works separate from the useful article, are copyrightable."⁵³ This interpretation of the holding, even if not entirely accurate,

ses?").

49. *Id.* at 211-13. The Court stated that there was "a contemporaneous and long-continued construction of the statutes by the agency charged to administer them that would allow the registration of such a statuette as is in question here." *Id.* at 213.

50. *Id.* at 218 ("We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration.").

51. This principle was articulated in *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58-60 (1884) and *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). *Mazer* states the principle in this way: "Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. . . . [Original] expression, whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color, is copyrightable." 347 U.S. at 214.

52. *Mazer*, 347 U.S. at 218.

53. H.R. REP. NO. 94-1476, at 50 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5663. It is difficult to find this holding, at least explicitly, in *Mazer v. Stein*. Instead of articulating a separability standard, the Supreme Court appears to be reaffirming the nondiscrimination principle and stating that the patentability of the item does not necessarily bar copyright. *Mazer*, 347 U.S. at 217 ("We do hold that the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art[.]"). It is unclear from this statement whether the Court is contemplating some sort of separability in which the useful elements may be patented and the original expressive elements may be copyrighted, or if instead the Court assumes that the very same elements, if both useful and expressive, may be awarded both copyright and patent protection. The Court references design patent protection and does seem to indicate that the two might overlap without posing any problems: "The dichotomy of protection for the aesthetic is not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents." *Id.* at 218.

appears to be what Congress intended to incorporate into the 1976 Act, and it is certainly consistent with the statutory language as enacted. Neither the legislative history of the 1976 Act nor *Mazer v. Stein* mentions channeling or the interaction between copyright law and patent law.⁵⁴

In conjunction with the references to *Mazer v. Stein*, Congress referenced proposed “design legislation” that it ultimately rejected as part of the new copyright act. That legislation would have created

a new limited form of copyright protection for “original” designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself. Thus designs of useful articles which do not meet the design patent standard of “novelty” would for the first time be protected.⁵⁵

Congress declined to pass this legislation, “in part because the new form of design protection . . . could not truly be considered copyright protection” and left it for later consideration.⁵⁶ While many in Congress evidently anticipated that a sui generis regime for industrial design would eventually be enacted,⁵⁷ that has not yet occurred.⁵⁸

From the legislative history of the 1976 Act, including from the references to *Mazer v. Stein*, one can learn little regarding the purpose of the useful article doctrine except (1) that Congress did not consider industrial design to fall within the scope of the proposed copyright legislation, (2) that it might consider such protection later, and (3) that some kind of overlapping copyright and design legislation was not necessarily inappropriate.⁵⁹

54. *Mazer* does indicate that industrial design might be eligible for both copyright protection and design patent protection, but it does not mention utility patents. 347 U.S. at 218. For an in-depth discussion of various possibilities of cumulation of protection, see Reichman, *Legislative Agenda*, *supra* note 30, at 288.

55. H.R. REP. NO. 94-1476, at 50.

56. *Id.*; see *Esquire, Inc. v. Ringer*, 591 F.2d 796, 801 (D.C. Cir. 1978) (“In rejecting proposed Title II, Congress noted the administration’s concern that to make such designs eligible for copyright would be to create a ‘new monopoly’ having obvious and significant anticompetitive effects.”).

57. See Reichman, *Design Before 1976*, *supra* note 30, at 1147–48.

58. As discussed below, a variety of specialized regimes have been proposed in the years since the passage of the 1976 Act. See *infra* Part II.B.

59. Simultaneous copyright and design patent protection may present some of the same difficulties as overlapping copyright and utility patent protection, but in the 1976 Act, Congress apparently contemplated concurrent or overlapping copyright and design patent protection. See H.R. REP. NO. 94-1476, at 50.

Although this portion of the legislative history is less than perfectly clear,⁶⁰ we do know that Congress intended that the “useful” aspects of works should not receive copyright protection.⁶¹ It is a bit of a leap—although not an unreasonable one—to conclude that this is because “useful” items fall within the realm of utility patents. In other words, one justification for the useful article doctrine is to separate and draw a boundary between copyrightable expressive works and patentable useful inventions.

The conclusion that the very structure of the federal intellectual property system provides evidence as to the channeling purpose of the useful article doctrine is to some extent descriptive. The copyright statute and the legislative history provide some support for this view. There is some evidence that Congress was concerned with and motivated by a concern about channeling items or works to the patent realm, but the strength and contours of their commitment to this principle are not entirely clear.⁶²

The “not copyright” view of protection for industrial design does find substantial support in the statute and legislative history. As described above, the copyright statute states that useful articles may not be protected by copyright and indicates that the aesthetic aspects of those works must be identified and exist separately

60. Many of the Court’s references to “patents” in *Mazer v. Stein* appear to be references to design patents rather than utility patents. For example, the Court describes the petitioner’s argument as asserting “that congressional enactment of the design patent laws should be interpreted as denying protection to artistic articles embodied or reproduced in manufactured articles.” *Mazer v. Stein*, 347 U.S. 201, 215 (1954). The Court ends that paragraph, stating:

Petitioner urges that overlapping of patent and copyright legislation so as to give an author or inventor a choice between patents and copyrights should not be permitted. We assume petitioner takes the position that protection for a statuette for industrial use can only be obtained by patent, if any protection can be given.

Id. at 216. In the next paragraph, the Court holds “that the 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.” *Id.* at 217. This is somewhat ambiguous language. The Court appears to be talking about the copyright/design patent overlap but does not say so explicitly and seems to be more concerned with the nondiscrimination principle than with whether useful articles may be protected by copyright.

61. 17 U.S.C. § 101 (2012) (defining pictorial, graphic, and sculptural works to exclude the utilitarian aspects of those works).

62. See H.R. REP. NO. 94-1476, at 55 (“[T]he Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.”).

from the useful elements.⁶³ Finally, the fact that patent law protects “useful” articles and that copyright law excludes “useful” articles provides some evidence of an intent to create separate spheres of protection, in that the very subject matter of patent law and copyright law is distinct. The conclusions drawn from the structure of the intellectual property system are also animated by a normative perspective concerning the value of the freedom to copy. That view arises more from the Supreme Court’s jurisprudence in related areas than it does from the Copyright Act.

3. Trademark Law and Patent Preemption

In related contexts, Congress and the courts have indicated that allowing non-patent protection for patented, formerly patented, or potentially patentable items interferes with the goals of the patent system.⁶⁴ The scope and strength of this policy goal is less than perfectly clear, but the rough outlines of the notion have been fairly consistent. In addressing trademark protection for items that have been or might have been patented, Congress and the Supreme Court have articulated the “functionality” doctrine, by which functional aspects of an item may not receive trademark protection.⁶⁵ Similarly, the Court has applied preemption doctrine to prohibit states from providing rights that overlap with federal patent rights in some cases.⁶⁶ Although it is not clear the extent to

63. See 17 U.S.C. § 101 (definition of pictorial, graphical, and sculptural works).

64. See *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1507–08 (10th Cir. 1995) (discussing the purposes of the Patent Act); see also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001)) (internal quotation marks omitted) (regarding the possible conflict between trademark protection in the Lanham Act and patent protection, the Supreme Court held that the Lanham Act “does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity”); Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1515 (2004) (discussing the consequential effects of concurrent (or overlapping) copyright patent protection, and stating: “If the goal is to strengthen or expand the rights of intellectual property owners, providing increased incentives *within* any given legal regime, rather than allowing overlap, best serves the goals of the intellectual property system.”).

65. See 15 U.S.C. § 1052(e)(5) (2012); see also *TrafFix*, 532 U.S. at 30–31 (noting that a prior utility patent on a dual-spring design mechanism demonstrated a strong inference of the mechanism’s functionality, thus precluding petitioner’s attempt to obtain trade dress protection for the design).

66. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964) (quoting *Sola Elec. Co. v. Jefferson Elec. Co.*, 317 U.S. 173, 176 (1942)) (“When state law touches upon the area of these federal statutes, it is ‘familiar doctrine’ that the federal policy ‘may not

which courts or Congress are willing to apply the principle that unpatented useful or functional items ought to be free to copy, the principle persists. From these sources, it is reasonable to infer that the principle is one of the motivating factors for the useful article doctrine in copyright law.

a. Trademark Law

In the context of trademark law, a relatively bright line has been drawn, with both Congress and the courts making clear that “functional” marks may not be protected because protecting functional items is the province of patent law.⁶⁷ Trademark’s functionality doctrine serves to channel useful items to the patent realm. Functional elements of trade dress will not receive trademark protection, even if they would otherwise be trademarkable and even if they have not been or could not be patented.

The Lanham Act provides that the trade dress proponent must prove that the trade dress is not functional.⁶⁸ In *TrafFix v. MDI*, the Supreme Court emphasized that the functionality doctrine serves to direct works away from trademark law even when those

be set at naught, or its benefits denied’ by state law.”); see also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 168 (1989) (holding that the federal policy favoring free competition in ideas not meriting patent protection preempted a Florida statute prohibiting the use of a molding process that duplicated unpatented boat hulls or the sale thereof).

67. The Supreme Court has also expressed its commitment to the broad channeling principle in the copyright/trademark context. In *Dastar Corp. v. Twentieth Century Fox Film Corp.*, the Court held that a party could not assert trademark rights in a video series in which the copyright had expired, stating that “[t]o hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do.” 539 U.S. at 37–38. In this context, the Court explicitly referenced patent law and copyright in resolving a trademark question. *Id.* at 37. I discussed the *Dastar* case in a previous article, arguing that the Court asserted a strong policy preference for clearly delineating the boundaries of the federal intellectual property regimes and for a strong version of the “right to copy” formerly copyrighted and patented items but that it has not articulated this principle consistently over time or across different areas of intellectual property law. See Moffat, *supra* note 64, at 1475–76 (“Both mutant copyrights and backdoor patents arise in a variety of situations that the Court has not addressed. Further, the Court’s doctrine is both incomplete and flawed when viewed in the larger context of overlapping protection.”); see also Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55, 58–59 (2007) (asserting that “[w]ere courts to be more vigilant about policing the line between copyright claims and non-copyright claims . . . we might see a world in which the broad injunctive relief available to prevailing copyright owners appears less frequently” and critiquing *Dastar* on different grounds).

68. 15 U.S.C. § 1125(a)(3) (2012) (“In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”).

works are not patentable.⁶⁹ In reaching these conclusions, the Court referenced the beneficial effects of copying. According to the Court, “[t]rade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. . . . Allowing competitors to copy will have salutary effects in many instances.”⁷⁰ In other words, the trademark functionality doctrine is justified on the basis of concerns broader than those confined to trademark alone. In particular, the Court has indicated that providing trademark protection for functional items might impact the “right to copy” that patent law contemplates.⁷¹ As the Court has indicated, free copying of useful items is perhaps a general norm, with patent protection being the exception: “In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.”⁷²

As Professor Mark McKenna points out, courts have not been very clear about whether this “right to copy” takes a strong form—that all non-patented items may be copied—or a weaker form—allowing for copying when there is a competitive need.⁷³ The argument for the “right to copy” approach to trademark’s functionality doctrine is that the goals of the patent system will be undermined if trade dress protection can be obtained in addition to or instead of patent protection.⁷⁴ Inventors will, under some circumstances at least, choose trade dress protection over patent protection (to achieve a longer term of protection, for example, or to avoid the difficulty and cost of pursuing patent pro-

69. 532 U.S. at 32, 34.

70. *Id.* at 29.

71. *Id.* at 34–35.

72. *Id.* at 29.

73. Mark P. McKenna, (*Dys*)Functionality, 48 HOUS. L. REV. 823, 824 (2011) (“[D]espite its potential power [as the only true trademark defense], the functionality doctrine is quite inconsistently applied. This is true of mechanical functionality cases because courts differ over the extent to which the doctrine focuses on competitors’ *right* to copy unpatented features as opposed to their *need* to copy.”). While Professor McKenna suggests that the solution to this dispute lies in a clearer understanding of fair competition in trademark law, it is possible that the matter could be resolved by looking to patent law instead. If the force and terms of the “patent bargain” were clarified, the problem as it is expressed in the trademark context might be more manageable.

74. See, e.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 36–37 (2008). Previously, the Court noted that copyright and patent protections “are part of a ‘carefully crafted bargain,’ under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution.” *Id.* at 33–34 (internal citations omitted).

tection) or in addition to patent protection.⁷⁵ In *TrafFix*, the Court made clear that the functionality doctrine operated to preclude trademark protection for any functional or useful aspect of a product, regardless of whether it was patented.⁷⁶ Courts have interpreted and applied the functionality doctrine in a variety of ways. As it is presented in *TrafFix*, however, there can be no doubt that the doctrine is designed to exclude functional items from trademark protection because of the problems that would pose with regard to patent law.⁷⁷ How well the doctrine functions to achieve this purpose, and the strength of the Supreme Court's commitment to that purpose, are less clear.

b. Patent Preemption

Similar conclusions can be drawn from the Supreme Court's patent preemption jurisprudence. As with the functionality doctrine, there are stronger and weaker versions of patent preemption, but the basic understanding is that states may not provide patent-like protection for any items that might fall within patent's orbit. The strong version of this approach is exemplified in *Sears, Roebuck & Co. v. Stiffel Co.*, in which the Court held that "[a]n unpatentable article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so."⁷⁸ The *Sears* case, along with its companion, *Compco Corp. v. Day-Brite Lighting, Inc.*⁷⁹ sets forth the general rule that unpatented and formerly patented items must be free for all to copy. Both cases involved manufacturers of

75. McKenna, *supra* note 73, at 828 & n.20.

76. 532 U.S. at 29-30 ("A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device."); *see also id.* at 32 ("[E]ven if there has been no previous utility patent the party asserting trade dress has the burden to establish the nonfunctionality of alleged trade dress features.").

77. McKenna, *supra* note 73, at 827-28 ("Functionality, according to the Supreme Court, is not simply about competitive need for product features; it is also, even primarily, intended to police the boundary between trademark and patent law by channeling protection of useful product features exclusively to the patent system.").

78. 376 U.S. 225, 231 (1964).

79. 376 U.S. 234 (1964).

lamps suing under state unfair competition laws, seeking to prevent unauthorized copying of the lighting fixtures.⁸⁰ And in both cases, the Court rather sweepingly declared the state law preempted because it conflicted with patent policy by interfering with the right to copy.⁸¹

Not all of the Court's pronouncements have been so categorical, however. As Professor McKenna describes, in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,⁸²

[W]hile the Court held that the statute was indeed preempted and gave lip service to the general principle that patent protection is an exception to a general rule of free copying, the Court clearly retreated from its statements in *Sears* and *Compco* that states could not prevent copying of unpatented features themselves.⁸³

Notwithstanding this partial retreat,⁸⁴ the issue addressed by the Court evidences its concern about clarifying the boundaries of state competition law so as to avoid conflicting with federal patent law: "We must decide today what limits the operation of the federal patent system places on the States' ability to offer sub-

80. *Id.* at 234–35; *Sears*, 376 U.S. at 225–26.

81. *Compco*, 376 U.S. at 237 ("Today we have held in *Sears* . . . that when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."). See *Sears*, 376 U.S. at 230–31 (footnotes omitted) ("Thus the patent system is one in which uniform federal standards are carefully used to promote invention while at the same time preserving free competition. Obviously a State could not, consistently with the Supremacy Clause of the Constitution, extend the life of a patent beyond its expiration date or give a patent on an article which lacked the level of invention required for federal patents. To do either would run counter to the policy of Congress of granting patents only to true inventions, and then only for a limited time. Just as a State cannot encroach upon the federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws.").

82. 489 U.S. 141, 157 (1989) (holding a Florida statute protecting boat hull designs to be preempted by federal patent law because it "so substantially impedes the public use of the otherwise unprotected design and utilitarian ideas embodied in unpatented boat hulls as to run afoul of the teaching of our decisions in *Sears* and *Compco*").

83. McKenna, *supra* note 73, at 840–41.

84. Indeed, in the case, the Court sought to limit the broad sweep of *Sears* and *Compco*.

Read at their highest level of generality, the two decisions could be taken to stand for the proposition that the States are completely disabled from offering any form of protection to articles or processes which fall within the broad scope of patentable subject matter. . . . That the extrapolation of such a broad pre-emptive principle from *Sears* is inappropriate is clear from the balance struck in *Sears* itself.

Bonito Boats, 489 U.S. at 154.

stantial protection to utilitarian and design ideas which the patent laws leave otherwise unprotected.”⁸⁵ And the Court’s rhetoric, at least, in addressing the issue is quite sweeping. In describing the “patent bargain,” the Court states:

The attractiveness of such a bargain, and its effectiveness in inducing creative effort and disclosure of the results of that effort, depend almost entirely on a backdrop of free competition in the exploitation of unpatented designs and innovations. The novelty and nonobviousness requirements of patentability embody a congressional understanding, implicit in the Patent Clause itself, that free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception. Moreover, the ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure. State law protection for techniques and designs whose disclosure has already been induced by market rewards may conflict with the very purpose of the patent laws by decreasing the range of ideas available as the building blocks of further innovation. The offer of federal protection from competitive exploitation of intellectual property would be rendered meaningless in a world where substantially similar state law protections were readily available. To a limited extent, the federal patent laws must determine not only what is protected, but also what is free for all to use.⁸⁶

The Court did indeed articulate a narrower view of patent preemption in *Bonito Boats*,⁸⁷ but the general principle remains:

85. *Id.* at 143. There is clearly room for some state regulation, as evidenced by the Court’s upholding of state trade secret laws. *See, e.g., Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974); *see also Bonito Boats*, 489 U.S. at 155 (describing its holding in *Kewanee* as follows: “Despite the fact that state law [trade secret] protection was available for ideas which clearly fell within the subject matter of patent, the Court concluded that the nature and degree of state protection did not conflict with the federal policies of encouragement of patentable invention and the prompt disclosure of such innovations.”).

86. *Bonito Boats*, 489 U.S. at 151.

87. *See id.* at 154 (quoting *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232 (1964)) (“That the extrapolation of such a broad pre-emptive principle from *Sears* is inappropriate is clear from the balance struck in *Sears* itself. The *Sears* Court made it plain that the States ‘may protect businesses in the use of their trademarks, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as to the source of the goods.’ . . . [W]hile *Sears* speaks in absolutist terms, its conclusion that the States may place some conditions on the use of trade dress indicates an implicit recognition that all state regulation of potentially patentable but unpatented subject matter is not *ipso facto* pre-empted by the federal patent laws.”). McKenna is quite critical of the Court’s new approach:

The contrast with *Compco* in particular could hardly be more striking. In *Compco*, the Court expressly said that secondary meaning and nonfunctionality, and even the possibility of confusion, ‘may be relevant evidence in applying a State’s law requiring such precautions as labeling,’ but they were no basis ‘for imposing liability for or prohibiting the actual acts of copying and selling.’ *Bonito Boats* pretends *Sears* and *Compco* had never drawn this distinction and claims that those cases stand for a principle that the Court spe-

there is a concern about the creation of rights—whether federal or state, and however labeled—for items that are, were, or might be patentable, and the Court has continued, if only inconsistently, to police the boundary in ways that make it clear that interference with the patent realm is problematic and should be minimized, if not completely avoided. Notably, trademark’s functionality doctrine and the patent preemption jurisprudence are both explicitly concerned with the effort to preserve the patent realm and some degree of free copying of useful items not subject to patent.

The legislative and judicial approach to copyright’s useful article doctrine does not reflect even the inconsistent attention to the purposes and justifications for the channeling rules that trademark and preemption doctrine receive. It is logical, however, that if Congress and the courts have sought, however peripatetically, to prevent the encroachment of trademark law and state unfair competition law into patent’s purview, similar incursions by copyright law would be likewise frowned upon. Based on the somewhat circumstantial evidence, it is not unreasonable to conclude that the useful article doctrine is meant to serve a channeling function, directing works *away* from the copyright realm, *toward* the patent realm, or elsewhere, in order to bolster the patent bargain that ensures that useful items either receive the protection of a patent or may be freely copied. To the extent that this is true, the useful article doctrine is really about patent law and the interaction between patent law and other forms of protection, rather than about copyright law alone.

II. FAILING TO ACCOUNT FOR THE COPYRIGHT/PATENT BOUNDARY

Neither the current approaches to the useful article doctrine nor the myriad proposals for reform of that doctrine address the issue in a way that reflects the channeling function or the focus on the larger intellectual property ecosystem. Instead, the tests applied by the courts are varying, inconsistent, and ineffective at policing the copyright/patent boundary. The proposals for reform suffer from similar shortcomings.

cifically rejected.

McKenna, *supra* note 73, at 842 (footnote omitted) (quoting *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 238 (1964)).

Proposals for reform have proliferated; yet none has taken hold. I suggest here that this is because these various approaches share two distinguishing, and related, characteristics that render them incapable of leading to a satisfactory approach. First, very few take account of the policy reasons animating the useful article doctrine. Second, though it may at first blush seem an odd observation, the vast majority of the proposals for reform are too nuanced, too fact-dependent, and too careful.⁸⁸ They are, in short, overly focused on “getting it right” in terms of what ought to be protected by copyright law. This narrow focus comes at the expense of the underlying policy rationale for the useful article doctrine.

A. *The Case Law and Its Shortcomings*

It is hardly novel to assert that the various tests for conceptual separability are convoluted, complicated, and difficult to apply. As Professor Paul Goldstein puts it, “[o]f 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 useful articles.”⁸⁹ The legislative history obviously requires that courts “continue their efforts to distinguish applied art and industrial design.”⁹⁰ The problem is that, as one court points out, “[t]he difficulty lies not in the acceptance of that proposition [of conceptual separability], which the statutory language clearly contemplates, but in its application.”⁹¹ Conceptual separability is an inherently difficult

88. Nuanced, fact-dependent tests are, of course, not inherently problematic; they are the exactly right approach in some situations. The rules versus standards literature teaches that exact principle. For a brief summary of the literature (in the context of patent law) and citations to the major works in the area, see Tun-Jen Chiang, *The Rules and Standards of Patentable Subject Matter*, 2010 WIS. L. REV. 1353, 1398–401 (2010). In the case of the tests for “conceptual separability,” the current standards exhibit many of the problematic aspects of that approach. Being nuanced, fact-dependent, and often post-hoc, the conceptual separability tests are generally unpredictable, costly, and, in some cases, easily manipulable by the parties. These concerns, though significant, do not drive the solution proposed here, however.

89. 1 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.5.3, at 2:67 (3d ed. 2005).

90. Denicola, *supra* note 16, at 730.

91. *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 922–23 (7th Cir. 2004) (“It seems to be common ground between the parties and, indeed, among the courts and commentators, that the protection of the copyright statute also can be secured when a conceptual separability exists between the material sought to be copyrighted and the utilitarian design in which that material is incorporated.”).

enterprise, and the courts' struggle reflects that fact. In attempting to separate what are inseparable elements, courts have valiantly attempted to create tests that draw the appropriate line. But they have, for the most part, failed, because they have ignored or downplayed the policies animating the useful article doctrine in service of attempted accuracy. In other words, in trying to come up with a test that will get each case "right," the courts have ended up undermining the very purpose of the doctrine.

In *Pivot Point International, Inc. v. Charlene Products, Inc.*, the Seventh Circuit noted the variety of tests the courts have employed in making the conceptual separability determination.⁹² The plethora of tests and formulations on their own indicate the problematic nature of the endeavor.⁹³ The influential test proposed by Professor Robert Denicola and adopted by the Second Circuit asks whether the artistic design was influenced by functional or utilitarian factors.⁹⁴ Another approach asks whether the artistic features are primary and the utilitarian features secondary.⁹⁵ If so, the items may receive copyright protection.⁹⁶ Another test asks whether the item might be sold as art "because of its aesthetic qualities."⁹⁷ A similar approach inquires as to whether the artistic features might be able to "stand alone as a work of art traditionally conceived."⁹⁸ William Patry suggests a test that simply asks whether "artistic features are not utilitarian."⁹⁹ The Seventh Circuit in *Pivot Point*, after cataloging these various approaches,¹⁰⁰

92. *Id.* at 923.

93. The permutations of these tests, along with their advantages and shortcomings, have been extensively detailed and discussed by others. *See, e.g., infra* notes 122–36 and sources cited therein. It is not necessary to repeat that exercise here.

94. *See* *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) (citing Denicola, *supra* note 16, at 741).

95. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980).

96. *Id.*

97. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[B][3], at 2–99 (2013).

98. GOLDSTEIN, *supra* note 89, at 2:75.

99. *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 923 (7th Cir. 2004) (citing 1 WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 285 (1994)).

100. *See Pivot Point*, 372 F.3d at 922–30. In reviewing these approaches, the court noted that "[a]mong the circuits, the Court of Appeals for the Second Circuit has had occasion to wrestle most comprehensively with the notion of 'conceptual separability.' Its case law represents, we believe, an intellectual journey that has explored the key aspects of the problem." *Id.* at 924.

adopted something close to the Second Circuit's Denicola test—what it calls the “process-oriented approach.”¹⁰¹

Although many of the tests discuss the clear congressional intent to distinguish between copyrightable applied art and uncopyrightable industrial design, they do not identify, much less discuss or explain, the reasons for Congress' decision to draw this line. In other words, the tests do not grapple with the policy reasons motivating or justifying the useful article doctrine.

It is the failure to effectively address the policy questions that drives the approach proposed below in Part III. While nearly all the judicial opinions and all of the tests reference the legislative intent of the 1976 Copyright Act, as stated in the statutory language, to distinguish between works of applied art and items of industrial design, there is very little reference to the reasons for seeking to make this distinction. It seems beyond question that understanding the possible justifications for a rule assists in designing a test for implementing that rule. If, for example, the reason for the rule is to ensure even-handed treatment under copyright law for all kinds of artistic endeavors, regardless of form, medium, or style, such a policy principle might result in a test that is intentionally over-inclusive. On the other hand, if the policy purpose animating the rule is to preserve an area in which patent law is the only possible form of protection, the test ought to err in the other direction.

Even in the opinions that canvas the case law and discuss the issues surrounding the conceptual separability tests and the useful article doctrine in great detail, courts fail to refer to this underlying (or overarching) question. In *Pivot Point*, for example, the Seventh Circuit describes the statutory approach as asking the courts to distinguish between applied art and industrial design by distinguishing between the aesthetic and the functional, but the court does not indicate why it might be important to draw this distinction.¹⁰² Instead, the court merely states—in its twenty-one page opinion—that “[a]lthough the Congressional goal was

101. *Id.* at 930 (“The Second Circuit cases exhibit a progressive attempt to forge a workable judicial approach capable of giving meaning to the basic Congressional policy decision to distinguish applied art from uncopyrightable industrial art or design.”).

102. *Id.* at 920–21 (“It is common ground between the parties and, indeed, among the courts that have examined the issue, that this language, added by the 1976 Act, was intended to distinguish creative works that enjoy protection from elements of industrial design that do not.”).

evident, application of this language has presented the courts with significant difficulty.¹⁰³ The Seventh Circuit accepts this as the legislative mandate: Congress left to the courts the task of interpreting and applying the general directive that useful articles are not protectable.¹⁰⁴ The Seventh Circuit ultimately adopts the Second Circuit's process-oriented approach because it is "a progressive attempt to forge a workable judicial approach capable of giving meaning to the basic Congressional policy decision to distinguish applied art from uncopyrightable industrial art or design."¹⁰⁵

The other courts that have addressed the problematic nature of conceptual separability and its various and varying tests acknowledge this purpose, which is obvious from the statutory language, but they also fail to discuss the reasons that Congress might have drawn this line in the first place. The Second Circuit in *Brandir*, for example, begins its opinion by stating that "[i]n passing the Copyright Act of 1976 Congress attempted to distinguish between protectable 'works of applied art' and 'industrial designs not subject to copyright protection.'"¹⁰⁶ The court does not, however, discuss the policy reasons that might justify or explain this rule. The same is true of the other leading cases.¹⁰⁷

The second shortcoming of various current judicial approaches is that they are nuanced, fact-intensive, careful, and intent upon ensuring that original expression receives copyright protection. It may be odd to describe these characteristics as shortcomings, and

103. *Id.* at 921.

104. *Id.* ("In short, no doubt well-aware of the myriad of factual scenarios to which its policy guidance would have to be applied, Congress wisely chose to provide only general policy guidance to be implemented on a case-by-case basis through the Copyright Office and the courts.").

105. *Id.* at 930-31.

106. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1142-43 (2d Cir. 1987) (quoting H.R. REP. NO. 94-1476, at 54 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5667).

107. *See, e.g., Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 414-18 (2d Cir. 1985) (discussing the legislative history and the case law and concluding that "Congress has explicitly refused copyright protection for works of applied art or industrial design which have aesthetic or artistic features that cannot be identified separately from the useful article. Such works are not copyrightable regardless of the fact that they may be 'aesthetically satisfying and valuable'" (quoting H.R. REP. NO. 94-1476, at 55)). The *Carol Barnhart* court did not, however, mention the reasons for this congressional policy. The same is true of *Kieselstein-Cord v. Accessories by Pearl, Inc.* In that case, the court started the opinion by stating that the "case is on a razor's edge of copyright law," but did not discuss the reasons for the distinction. 632 F.2d 989, 990 (2d Cir. 1980).

they certainly are not problematic in all contexts, but they are counter-productive here.

In *Brandir*, for example, the court adopts a test in which copyrightability of the design is based on an inquiry about the design process.¹⁰⁸ As Professor Denicola stated, the question “should turn on the relationship between the proffered work and the process of industrial design.”¹⁰⁹ This means that in the case of the Ribbon Rack, the court inquired into the designer’s approach to creating the bicycle rack.¹¹⁰ The lower court had found that the designer, David Levine, had first created wire sculptures “each formed from one continuous undulating piece of wire.”¹¹¹ It was by happenstance that Levine thought of converting the wire sculptures into bicycle racks, and he thereafter “adapted the original aesthetic elements to accommodate and further a utilitarian purpose.”¹¹² From the reasoning in the case, it is clear that if Levine had happened to make a wire sculpture that accommodated bicycles, rather than modifying it later for that purpose, it would have been protectable under the court’s test. This is an odd result: *the very same design* might be protectable if the design process had been slightly different, or, even more troubling, if the designer’s testimony about the process had been different. In other words, the Second Circuit approach is extremely fact-sensitive, and in a way that is subject to manipulation by the parties. Such an approach leads neither to consistency nor to a reliable adversarial process.

These same concerns emerge from the Seventh Circuit’s “process oriented” approach. The Seventh Circuit believes, perhaps correctly, that this approach reconciles much of the case law, but it remains focused on the particulars of the design process in each case.¹¹³ In discussing *Carol Barnhart Inc. v. Economy Cover Corp.*, the Seventh Circuit makes clear that “it was the fact that the creator of the torsos was driven by utilitarian concerns, such as how display clothes would fit on the end product, that deprived the human torsos of copyright protection.”¹¹⁴ So the test relies on post hoc testimony of interested parties to resolve the question of

108. 834 F.2d at 1145–46.

109. Denicola, *supra* note 16, at 741.

110. *Brandir*, 834 F.2d at 1145–46.

111. *Id.* at 1146.

112. *Id.* at 1146–47.

113. *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 930 (7th Cir. 2004).

114. *Id.*

how the design arose, and under no circumstances could the question of protectability be resolved by looking at the design.¹¹⁵ Moreover, two identical works might be treated differently depending on the design process. That is a troubling result.¹¹⁶

Some of the other tests are problematic in the extent to which they ask courts to make artistic judgments. For example, Judge Newman in his dissent in *Carol Barnhart*, advocates what has been called the “temporal displacement” test in which the court would ask whether “the article . . . stimulate[s] in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”¹¹⁷ Similar approaches ask whether the primary use of the work is as a utilitarian article rather than as an artistic work, or whether the aesthetic aspects are “primary,” or whether the work may be sold as “art.”¹¹⁸ Each of these possibilities was rejected by the *Brandir* and *Pivot Point* courts as overly subjective, and rightly so.¹¹⁹

Assuming that the goal of the useful article doctrine is to exclude such works from copyright so that they are effectively channeled away from copyright law, the nuanced rules articulated by many courts are not effective.¹²⁰ If, as in the trademark context, the channeling function ought to trump other copyright concerns, a bright-line rule that errs on the side of underprotection is preferable. In discussing the functionality doctrine in trademark

115. The *Pivot Point* court describes the test as follows: “If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is ‘as much the result of utilitarian pressures as aesthetic choices,’ the useful and aesthetic elements are not conceptually separable.” *Id.* at 931 (citation omitted) (quoting *Brandir*, 834 F.2d at 1147).

116. Judge Kanne’s dissent in *Pivot Point* expresses the same concern: “Moreover, the ‘process-oriented approach,’ advocated by the majority drifts even further away from the statute. The statute looks to the useful article as it exists, not to how it was created.” *Id.* at 934 (Kanne, J., dissenting) (citation omitted).

117. *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting); see also W. PATRY, *LATMAN’S THE COPYRIGHT LAW* 44–45 (6th ed. 1986) (describing Judge Newman’s test as the “temporal displacement” test).

118. *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987).

119. *Pivot Point*, 372 F.3d at 924; *Brandir*, 834 F.2d at 1144–45.

120. A nuanced standard may be problematic in other ways as well. With respect to conceptual separability in particular, many of the tests are based on subjective or post hoc evidence, making them quite easily manipulable by the parties. A number of the tests appear to be deeply subjective, even metaphysical as described by one commentator, requiring the courts to make artistic judgments and engage in mental contortions impossible to perform in a consistent fashion. See Lynch, *supra* note 15, at 647. These factors, among others, mean that the current approaches are unpredictable, lead to inconsistent results, and certainly do nothing to deter litigation.

law, the Supreme Court made clear that certain items may well otherwise qualify for trademark protection—they may serve as identifiers of source and if copied may provoke consumer confusion—but they may nonetheless be freely copied.¹²¹ Adapting this reasoning and approach to copyright law involves a recognition that “getting it right” from a copyright perspective interferes with the channeling function of the useful article doctrine.

B. *The Proposals for Reform and Their Shortcomings*

The sheer number and variety of the tests for conceptual separability indicate that the tests—and perhaps the enterprise itself—are problematic, and the number and variety of proposals for reform confirm this. There is no dispute that the useful article doctrine, and the notion of conceptual separability in particular, have posed some of the most vexing issues in copyright law. Since Professor Robert Denicola’s article was published in 1983,¹²² and notwithstanding the adoption by some courts of the test he proposed,¹²³ proposals for reform have continued unabated. It is impossible to do justice to the work that has been done in this area. This article attempts to take a bird’s eye view, and from this perch, the proposals for reform demonstrate many of the same characteristics as the tests applied by the courts. First, the proposals generally do not take account of the over-arching motivation for the useful article doctrine. Second, the vast majority of the proposals are focused on accuracy with respect to copyright concerns, at the expense of other issues.

This discussion must begin with Professor Robert Denicola. In 1983, Denicola published an article canvassing the history of the useful article doctrine and the case law addressing conceptual separability following the passage of the 1976 Copyright Act.¹²⁴ Denicola proposed a test for determining conceptual separability that was developed in the Second Circuit¹²⁵ and adopted in the

121. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65 (1995).

122. Denicola, *supra* note 16.

123. *E.g.*, *Brandir*, 834 F.2d at 1145.

124. Denicola, *supra* note 16, at 707.

125. *Brandir*, 834 F.2d 1142. The Second Circuit also suggested that “the differences between the majority and the dissent in *Carol Barnhart* might have been resolved had they had before them the Denicola article on *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*.” *Id.* at 1145.

Seventh Circuit as the “process-oriented” approach.¹²⁶ Under Denicola’s approach, the touchstone is determining “the extent to which utilitarian considerations influence artistic expression.”¹²⁷ Based on a concern with drawing the line between applied art and industrial design and implementing to the extent possible, copyright’s nondiscrimination principle, the process-oriented approach as proposed by Denicola offers a nuanced approach to implementing these concerns.¹²⁸ Professor Denicola concluded that the determination was simply not amenable to bright lines or easy resolution:

When copyright in “pictorial, graphic, and sculptural works” ventures beyond the narrow confines of the “fine arts,” the slope becomes slippery indeed. Current law expressly preserves exclusive rights in works of art applied to utilitarian ends, yet wisely endeavors to exclude the general design of commercial products. The distinction between copyrightable “applied art” and uncopyrightable “industrial design” has generally been pursued through mechanical models offering the seductive security of unbending rules and ostensibly objective criteria. The arbitrary divisions inevitably engendered by traditional analysis, however, can only crudely approximate the distinctions pursued in the revision effort.

The Copyright Act of 1976 invites a more discriminating analysis. The standard of separate identity and independent existence encourages a thoughtful appraisal of the character of the claimant’s contribution. The exclusion of industrial design from the scope of copyright is best understood as an attempt to bar forms influenced in significant measure by utilitarian concerns. Thus, copyright is reserved to product features and shapes that reflect even in their utilitarian environment the unconstrained aesthetic perspective of the artist. Nothing short of a candid assessment of the nature of the proffered work can successfully implement the prudent, yet fragile, distinction between applied art and industrial design.¹²⁹

Much of this is unassailable, or at the very least quite convincing. But it has not prevented the courts from, seemingly endless-

126. *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 930 (7th Cir. 2004) (“This process-oriented approach for conceptual separability—focusing on the process of creating the object to determine whether it is entitled to copyright protection—is more fully articulated in *Brandir* and indeed reconciles the earlier case law pertaining to conceptual separability.”).

127. Denicola, *supra* note 16, at 743.

128. *Id.* (“A model emphasizing the influence of utilitarian factors frees the judicial analysis from its unfortunate fixation on appearance alone. If the ultimate aim is to distinguish applied art from industrial design, theories focusing only on appearances cannot achieve the desired end. It is the *process* more than the result that gives industrial design its distinctive character.”).

129. *Id.* at 747–48.

ly, addressing the exact nature of conceptual separability doctrine and how it might be implemented in the case law.¹³⁰ Neither has it stemmed the tide of critiques or new proposals for reform.

As described above in Part II.A, the Denicola approach, or some variation of it, has taken hold in a number of circuits.¹³¹ Professor Denicola powerfully argued that, as of 1983, “[t]he attempts of the Congress, the Copyright Office, and the courts to delimit the boundaries of copyright in useful articles have been only partially successful.”¹³² Unfortunately, notwithstanding Professor Denicola’s efforts, this remains the case. Since Professor Denicola published his influential article, the number and types of tests for conceptual separability have proliferated,¹³³ and the critiques of the courts’ doctrines have continued. Like Professor Denicola, many commentators are focused, to be blunt, on “getting it right.” That is, a priority for many is setting forth an approach that ensures that all copyrightable works or aspects of a work receive copyright protection, or that non-representational art, for example, is treated fairly. These are admirable goals, of course, but ones with serious downsides. This article suggests that “getting it right” in this context may be less important than other considerations.

Another set of proposals is based on the notion that copyright law is under-protective of industrial design or that it discriminates against certain kinds or forms of artwork. This is, in essence, another version of the accuracy critique, asserting generally that industrial design is under-protected. These proposals take different forms, with many suggesting *sui generis* regimes of protection for industrial design and others proposing that the copyright standards for protection of industrial design be more capacious in some ways.¹³⁴ For example, Professor Orit Fischman Afori has proposed a specialized form of design protection, while acknowledging that others have done so as well.¹³⁵ These proposals

130. See *supra* Part II.A.

131. See *supra* notes 101–05 and accompanying text.

132. Denicola, *supra* note 16, at 709.

133. See *supra* Part II.A.

134. See Reichman, *Design After 1976*, *supra* note 30, at 383; Reichman, *Past and Current Trends*, *supra* note 30, at 397–98.

135. Orit Fischman Afori, *Reconceptualizing Property in Designs*, 25 CARDOZO ARTS & ENT. L.J. 1105, 1108–09 (2008) (“Designs should enjoy a specially accorded law—a *sui generis* law—that has some important deviations from the copyright scheme. The idea of enacting a *sui generis* copyright law for design is not new. However, there is still a need to

are generally based on the idea that design is under-protected in the United States system and internationally.¹³⁶ Afori, for example, describes her approach:

I set down the doctrinal basis for my principal analysis by describing the triple protection designs enjoy in the U.S., through all three major intellectual property disciplines: copyright, patent and trademark. A closer inspection reveals that designs enjoy very limited protection by means of these three disciplines, since they do not fit exactly within each realm. The outcome is inappropriate and inadequate protection for designs.¹³⁷

Many of these proposals may be correct as a principled matter: industrial design clearly does not fit perfectly into our existing intellectual property regimes,¹³⁸ and it is an empirical question whether industrial designers might be in need of a greater incentive for the creation of their products.¹³⁹ Indeed, there is much evidence in the legislative history and elsewhere that Congress intended to leave industrial design out of the Copyright Act because it did not quite fit the copyright paradigm,¹⁴⁰ and there was an

accurately define the subject matter of this specially tailored law, and to sketch the mechanism for its separation from copyright law.”).

136. See, e.g., Richard G. Frenkel, Comment, *Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-TRIPs Era*, 32 LOY. L.A. L. REV. 531, 536 (1999) (concluding that “whether Congress chooses to borrow from the architectural copyright standards or create a fourth area of design protection, society will benefit from increased industrial design protection”); Regan E. Keebaugh, Note, *Intellectual Property and the Protection of Industrial Design: Are Sui Generis Protection Measures the Answer to Vocal Opponents and a Reluctant Congress?*, 13 J. INTELL. PROP. L. 255, 277 (2005) (“[T]he advantages of sui generis protection of industrial design include (1) allowing Congress to design legislation to serve the specific needs of individual industries and (2) giving Congress the ability to pass design protection legislation with limited scope and effect, thereby allowing Congress to strengthen protection for industries that support stronger protection and avoid opposition from industries that do not.”); Kimberly Allen Richards, Comment, *Should Furniture Become Fashion-Forward? Applying Fashion’s Copyright Proposals to the Furniture Industry*, 11 WAKE FOREST J. BUS. & INTELL. PROP. L. 269, 293 (2010) (arguing that the fashion industry’s proposed legislation “could be adapted to the furniture industry to help close the industry’s gap in intellectual property protection and preserve the incentive for the furniture industry to invest in creating original designs”).

137. Afori, *supra* note 135, at 1108.

138. See, e.g., Orit Fischman Afori, *The Role of the Non-Functionality Requirement in Design Law*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 847, 849 (2010) (“The aim of industrial design law, however, is not to encourage the development of new technologies, but rather to encourage the development of their external appearance.”).

139. This is a point on which this article remains decidedly agnostic.

140. See H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.A.N. 5659, 5668.

expectation that a separate form of protection would be created.¹⁴¹ Needless to say, this has not yet occurred.¹⁴²

If, in fact, industrial design is in need of some additional protection, a sui generis regime may be the right way to go. The available legislative history (indicating that Congress anticipated passing design legislation after 1976 and that Congress believed that copyright was not the appropriate home for design protection) counsels against tinkering with copyright doctrine to allow it to protect industrial design.¹⁴³

This, however, is just what another set of the proposals suggests. Rather than advocating for a separate system of protection for design, many commentators have followed the path blazed by Denicola, suggesting revisions designed to improve the doctrine.¹⁴⁴ Many of these proposals are animated by concerns that the current approaches discriminate against certain kinds of art—non-representational art, for example—or, as with the proposals for sui generis protection, that the current law is simply insufficiently protective of industrial design.

In assessing the problematic nature of many of the tests, Professor Keith Aoki was blunt:

This Article identifies distinctions used in copyright law that purport to be useful in resolving cases, but which, in fact, have resulted in

141. For a comprehensive review of the pre-1976 Act and the legislative history leading up to the 1976 Act, see Keith Aoki, *Contradiction and Context in American Copyright Law*, 9 CARDOZO ARTS & ENT. L.J. 303, 314–34 (1991).

142. In addition to the question of whether industrial design is in need of a bulked up set of rights, a question on which this article remains agnostic, the hurdles in the way of a new, specialized regime are substantial. There are at least two major barriers: (1) the theoretical work of designing a new system; and (2) the practical hurdle of enacting a new regime.

143. See Aoki, *supra* note 141, at 324–25; Denicola, *supra* note 16, at 719–20 (quoting H.R. REP. NO. 94-1476, at 50); see also Samson Vermont, *The Dubious Legal Rationale for Denying Copyright to Fashion*, 21 TEX. INTELL. PROP. L.J. 89 (2013). Professor Vermont critiques the notion that fashion designs are “useful articles” and thus excluded from copyright protection. *Id.* at 90 (footnote omitted) (“The official rationale for denying copyright to clothing, that a garment is a ‘useful article’ whose aesthetic features are inseparable from its utilitarian function, is unsound and thus may give way in time . . .”). Professor Vermont argues that opponents of the proposed sui generis fashion design protection legislation should reconsider that “if the bill fails . . . the courts may eventually hold that fanciful clothing is protectable under regular copyright.” *Id.* On the other hand, “[i]f the bill passes, the sui generis protection would likely preempt regular copyright, partly as a matter of statutory construction and partly because sui generis protection would eliminate an otherwise compelling policy reason for protecting clothing under regular copyright.” *Id.*

144. See, e.g., Ralph S. Brown, *Eligibility for Copyright Protection: A Search for Principled Standards*, 70 MINN. L. REV. 579, 607–09 (1985).

confusing, inconsistent, and erratic decisions. Faced with these contradictions, the courts, on the alleged mandate of Congress, have unsuccessfully sought to suppress the internal instability of their varying positions through the use of the doctrine of “conceptual separability.”¹⁴⁵

In the article, Aoki engages in a detailed review of the relevant law and legislative history.¹⁴⁶ Aoki did not provide a concrete proposal for reform but demonstrated clearly how the nondiscrimination principle—the notion that judges should not be making artistic judgments—is fraught with difficulty and nearly impossible to implement.¹⁴⁷ According to Aoki, this is particularly true with respect to industrial design protection. He states that “Holmes’ admonition in *Bleistein v. Donaldson Lithographing Co.* regarding aesthetic judicial restraint is invoked at such a high level of generality, that it becomes pathologically indeterminate, capable of providing potentially broad protection, or complete denial of protection, to industrial design.”¹⁴⁸ Aoki’s critique is really just that, a critique rather than a proposal for reform, but the issues he discussed in his 1991 article abound in the stream of proposals based on similar criticisms.

When these criticisms, revolving around a concern about under-protection generally and under-protection of “art” in particular, lead to concrete proposals, they tend to be even more nuanced and fact-dependent than the tests currently employed by the courts. In other words, they are aimed at getting the protectability questions—Is this original expression? Is it art? Is it aesthetic?—just right in every case.¹⁴⁹ Others are concerned with discrim-

145. Aoki, *supra* note 141, at 303–04 (footnotes omitted); see *id.* at 304–05 (alteration in original) (“Joseph Story wrote that copyright law approaches ‘what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle [sic] and refined, and sometimes, almost evanescent.’ There is no area of copyright where this is more true than the area of conceptual separability.”).

146. See *id.* at 323–25.

147. *Id.* at 383–84 (“Many of the courts which have grappled with the question of conferring intellectual property rights on the products of the industrial design process have focused on the aesthetic/utilitarian qualities of the object itself, producing an increasingly unintelligible body of law that focuses on the issue of ‘conceptual separability.’ Courts have clung to incoherent distinctions which have grown increasingly abstract with each new case, religiously invoking the phrase ‘form follows function.’”).

148. *Id.* at 382 (footnotes omitted).

149. Thomas M. Byron, *As Long as There’s Another Way: Pivot Point v. Charlene Products as an Accidental Template for a Creativity-Driven Useful Article Analysis*, 49 IDEA 147, 191–93 (2009) (proposing a “creativity” test that incorporates the idea/expression dichotomy, the merger doctrine, and the scenes a faire doctrine into the conceptual separability analysis); Stephen Langs, *The Definitional Scope of an Intrinsic Utilitarian Function*

ination against various forms of art, and these also can be characterized as "getting it right" kinds of approaches.¹⁵⁰ As with the

Under the 1976 Copyright Act: One Man's Use Is Another Man's Art, 20 W. NEW ENG. L. REV. 143, 172 (1998) ("Determining whether a particular use qualifies as an intrinsic utilitarian function should be done on an ad hoc basis under a 'primary functional significance' analysis by considering the relevant factors discussed in *Brandir* and *Poe*."); Mark A. LoBello, *The Dichotomy Between Artistic Expression and Industrial Design: To Protect or Not to Protect*, 13 WHITTIER L. REV. 107, 135 (1992) (proposing a "gradated" system in which "[r]ather than providing for uniform protection and its problematic inclusion or exclusion of broad categories of applied art and industrial design, a gradated scheme would provide some level of protection to all works"); Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y U.S.A. 339, 381 (1989) ("Given the nature of the problem, there can be no easy, predictable solution to the issue of copyright in useful articles. As in so many other areas of copyright law, each case poses unique facts that strain against abstract formulations, no matter how well conceived or articulated. Nevertheless, greater clarity is both possible and desirable. The proposed 'duality' test, applied in the framework of all the appropriate steps of copyright analysis, should minimize the confusion in this area and lead to more consistent results."); Gayle Coleman, Comment, *The Protection of Useful Articles and the Elusive Concept of Conceptual Separability: Brandir International Inc. v. Cascade Pacific Lumber Co.*, 13 NOVA L. REV. 1417, 1441-44 (1989) (recommending the retention of the conceptual separability requirement and the adoption of a four-part test combining the inquiries from a number of cases); Sally M. Donahue, Comment, *The Copyrightability of Useful Articles: The Second Circuit's Resistance to Conceptual Separability*, 6 TOURO L. REV. 327, 356-57 (1990) (proposing an amalgam of the *Kieselstein-Cord* test and the approach suggested by the dissent in *Carol Barnhart*: "Conceptual separability is found when the design features of a utilitarian article trigger in the mind of the ordinary responsible observer a concept separate from that evoked by its utilitarian function."); Raymond M. Polakovic, Comment, *Should the Bauhaus Be in the Copyright Doghouse?: Rethinking Conceptual Separability*, 64 U. COLO. L. REV. 871, 901 (1993) ("A more uniform approach, in which a useful article is treated essentially the same as a literary or artistic work, would assuage the current underprotection of useful articles without inappropriately removing from the public domain the underlying ideas embodied in the useful article.").

150. See, e.g., Darren Hudson Hick, *Conceptual Problems of Conceptual Separability and the Non-Usefulness of the Useful Articles Distinction*, 57 J. COPYRIGHT SOC'Y U.S.A. 37, 56-57 (2010) (footnotes omitted) ("There are, I suggest, two sufficiency tests for conceptual separability, a positive result for either of which is sufficient to warrant a finding of separability. First, if one can conceive of the item's aesthetic elements (that is, its design), without at the same time conceiving of its utilitarian aspects (that is, its function), then these elements are conceptually separable. Conversely, if one can conceive of the item's function without at the same time conceiving of its particular design, then its function and its design are likewise conceptually separable. Given this, I suspect it will almost always be possible to conceptually separate a work's function from its design, for it seems that while function often *restricts* design, it almost never *dictates* design. And so, it seems, virtually all useful articles will be in part potentially copyrightable. So, we might ask, what are the implications of this understanding of useful articles and conceptual separability? The first apparent implication is that, so far as copyright is concerned, any strong de facto distinction between, say, a sculpture and a blender, melts away. Many, I have no doubt, will rail against this result. But insofar as American copyright law is designed to protect 'authored works,' the 'artwork' label carries little weight. There are, after all, many artworks—indeed, many *great* artworks—that are disqualified from copyright protection, and many non-artworks that we want protected, even outside the realm of 'useful objects.'"); Matthew C. Broaddus, Comment, *Designers Should Strive to Create "Useless" Products: Using the "Useful Article" Doctrine to Avoid Separability Analysis*, 51 S. TEX. L.

Denicola approach, these critiques are in some ways unassailable. It is clearly the case that none of the current proposals are capable of perfectly drawing the line between applied art and industrial design, between the copyrightable and the noncopyrightable.

This article advocates simply abandoning the quest to find and articulate the perfect line.¹⁵¹ First, the line is so difficult to draw that the undertaking is simply not worth the effort. Second, it is far better to attempt to draw a brightline that is responsive to the policy considerations underlying the useful article doctrine.

While many of the criticisms of the useful article doctrine jurisprudence focus on the industrial design/applied art distinction, very few explore the reasons for this distinction. It is clear that Congress intended that industrial design not be protected by copyright law, but Congress did not explain *why* this was so. As discussed above in Part I, it appears that there was an expectation that a separate form of protection would be passed. It also seems that one justification—if not a motivating factor for Congress—for excluding useful articles from the copyright realm is to channel works out of copyright and either to the patent realm or the public domain (or, perhaps, a *sui generis* design protection scheme). But few of the proposals and even fewer of the cases discuss the channeling function of the useful article doctrine.¹⁵²

REV. 493, 494 (2009) (“This Comment will show how proper application of the statutory definition of ‘useful article’ could save courts time and trouble and offer increased protection to designers by allowing them to avoid the difficult, confusing, and dangerous pitfalls of separability analysis.”); Barton R. Keyes, Note, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L.J. 109, 112 (2008) (suggesting a test that turns “only [on] the subjective and objective elements of the design process” in part because “[t]his limited focus ensures that inquiry is not influenced by judges’ or mainstream consumers’ biases about the nature of art”).

151. Afori has taken this approach, to some extent. In a 2010 article, she discusses the difficulties in applying a nonfunctionality rule and proposes that the question of functionality simply be addressed only in the context of an infringement claim on a case-by-case basis and not at the registration stage:

Generally speaking, this kind of solution is common in intellectual property law and particularly in copyright law. The most problematic questions in copyright law, such as eligibility, scope of rights, exceptions, and limitations, where clear and certain rules are impossible to formulate, are resolved by applying an open standard on a case-by-case basis in the courts. This pragmatic approach should be used in the industrial design realm as well. The non-functionality requirement could therefore function as an open standard to be applied on a case-by-case basis.

Afori, *supra* note 138, at 871–72.

152. Indeed, they do not generally discuss any reasons for this distinction, appearing to take it as sufficient on its own. See *supra* Part II.A.

Many of these commentators are very careful and thoughtful about where and how to draw the line between industrial design and applied art, but very few of them even mention, much less discuss, *why* it is important to draw such a line.

There are a few exceptions, of course. Orit Fischman Afori, for example, acknowledges that the "underlying rationale [of the non-functionality requirement] involves the desire to avoid undermining patent law provisions, which under certain strict conditions provide protection of functional elements."¹⁵³ This does not drive her proposals, however. Rather, as with virtually all of the proposals for reform, Afori's is focused on copyright law or, more specifically, protection for industrial designs.¹⁵⁴

A few scholars have put forth ideas animated by the broader policy questions. In 1991, Michael Lynch proposed a rule based primarily on physical separability¹⁵⁵ and justified this approach with reference to the purpose behind the useful article doctrine, which he described as "restrict[ing] copyright to those aspects of a useful article in which a monopoly can be awarded without necessarily extending to the utilitarian features of the article."¹⁵⁶ Lynch observed that the focus on the meaning and definition of "art" led to nearly intractable problems: "Lawyers and judges with an exaggerated respect for artists then found themselves with no reliable way of distinguishing a work of art from a parking lot light fixture."¹⁵⁷ Lynch notes that the policy driving the useful article doctrine is not made clear in the statute or the congressional history,¹⁵⁸ but he concludes that there are reasons to believe that "a free market is more important in useful articles than in art and literature."¹⁵⁹ Lynch does not discuss the channeling function of the useful article doctrine explicitly, but he suggests that the

153. Afori, *supra* note 138, at 873.

154. *Id.* at 873-74.

155. Lynch, *supra* note 15, at 647. ("This article will first demonstrate a crude, literal and physical approach which might have produced far more clarity, and results no less desirable.").

156. *Id.*

157. *Id.* at 650.

158. *Id.* at 655 ("The reasons why Congress has chosen to grant copyright protection to three-dimensional works of art, but not to three-dimensional works of utility, are not stated explicitly.").

159. *Id.* at 656.

“pro-art rationale” of copyright protection has obscured concerns about monopolizing functional designs.¹⁶⁰

More recently, Sepehr Shahshahani addressed the policy question head on, claiming that “the numerous approaches to the design of useful article exclusion and its central problem of separability, though varied, share a fatal common trait: They fail to examine and serve the policy rationale of the doctrine.”¹⁶¹ Shahshahani argues that the reason for excluding useful articles from copyright protection is to prevent copyright law from protecting ideas.¹⁶² Shahshahani acknowledges that this is related to patent protection but does not explain why copyright ought not protect something that may be protected by patent,¹⁶³ except to say that “the raison d’être of the design of useful article exclusion is to guard the boundary between patent and copyright.”¹⁶⁴ Shahshahani’s proposed solution is to treat the useful article doctrine just as the merger doctrine is treated.¹⁶⁵ The problem is that this test is no different in the end than the myriad other tests for “conceptual separability.”¹⁶⁶ To ask whether an article can be produced without the design elements sought to be protected is only to ask whether those elements are separable in some way. Thus this proposal retains the nuance that is so problematic in the current approaches.

160. *Id.* at 658.

161. Sepehr Shahshahani, *The Design of Useful Article Exclusion: A Way Out of the Mess*, 57 J. COPYRIGHT SOC’Y U.S.A. 859, 859–60 (2010).

162. *Id.* at 860; *see also id.* at 876 (“It is the central contention of this article that the only sensible policy rationale for the design of a useful article exclusion is the same as the policy rationale served by the merger doctrine.”).

163. *Id.* at 860 (“The only sensible policy rationale of the DUA [design of a useful article] exclusion is to address this particularly acute merger problem by policing the border between patent and copyright and channeling the protection of functional ideas from copyright to patent.”).

164. *Id.* at 876.

165. *Id.* at 860, 876; *see generally* Morrissey v. Proctor & Gamble, 379 F.2d 675, 678–79 (1st Cir. 1967) (explaining the merger doctrine and applying it to rules for a sweepstakes); Nichols v. Universal Pictures Corp., 45 F.2d 119, 122 (2d Cir. 1930) (applying the merger doctrine to aspects of a play).

166. Shahshahani proposes that:

[T]he design of a useful article should not be copyrightable if the article cannot be efficiently produced in a way that would enable it to function effectively absent the design sought to be copyrighted. This will occur if the design for which copyright is sought is the only design or one of few designs that allow the article to function effectively and be mass produced.

Id. at 876.

While a few of the proposals address some of the policy concerns, none of them suggests an approach that clearly advances those policy concerns. Instead, many of the proposals remain stubbornly copyright focused, which leads, as we have seen, to nuanced, careful rules that do not just create uncertainty and inconsistency but fail to serve the channeling purpose intended by the useful article doctrine.

III. TAKING ACCOUNT OF THE COPYRIGHT/PATENT BOUNDARY

The sheer number of tests applied by the courts and proposals suggested by scholars for the reform of copyright's useful article doctrine is overwhelming. They vary in their baseline assumptions, they differ in their policy preferences, and they offer many quite different formulations. Nonetheless, they share some significant characteristics. First, they fail to address, either implicitly or explicitly, the policy purpose that animates the useful article doctrine. Broadly speaking, the useful article doctrine is not just about copyright law but is about the interaction between copyright law and other forms of protections for creative and inventive works. Second, perhaps because the approaches are so focused on copyright law alone, they seek accuracy at the expense of these policy concerns. This means that the tests tend to be nuanced, fact-based, and post hoc; this also means that they are unpredictable, sometimes inconsistent, and difficult to apply.

A bright-line rule that more effectively channels works away from copyright law is not just responsive to the policy goals of the useful article doctrine, it also provides a more consistent approach that ought to reduce the uncertainty endemic to the current doctrine. Taking as a starting point that the useful article doctrine is meant to channel works *away* from copyright law—toward patent law, or the public domain, or perhaps to a sui generis regime—this new approach looks to other channeling doctrines for guidance, trademark's functionality doctrine in particular. The channeling function, moreover, is best served by a bright-line rule, which should also provide a greater degree of predictability and consistency.

Borrowing from trademark law is one possibility. Trademark law employs the "functionality doctrine" to preclude protection for functional items regardless of their trademarkability in other respects, thus channeling works away from trademark that belong

elsewhere in the intellectual property universe. Copyright law should adopt a similar default rule in which “useful” works are presumptively not protected. Shifting the burden of proof would change the default to one of non-protectability. The burden could only be overcome by a showing on the part of the copyright proponent that the item sought to be protected is not, in fact, useful. This section describes how this burden-shifting rule would operate and then sets forth two possibilities for the elements to be shown by the plaintiff in order to overcome the burden.

A. *The “Not Copyright” Default for Useful Articles*

The useful article doctrine is intended, by its very terms, to exclude useful articles from the realm of copyright law. Less explicit is the channeling function served by the doctrine: useful articles are to be excluded from copyright law because such items are to be protected by patent law, or fall into the public domain. Because of the strictures of patent law, if potentially patentable items might receive copyright protection instead of or in addition to patent protection, many designers might select copyright law, and the useful designs will be protected for seventy years or more,¹⁶⁷ rather than falling into the public domain and being available for copying after the twenty-year patent term.¹⁶⁸ For this reason, copyright law must take account of patent law and policy.

In order to ensure that potentially patentable items—useful items—do not receive copyright protection, the courts should adopt a bright-line rule that errs on the side of under-protection. Such a rule will keep useful items out of copyright and deter designers from pursuing copyright protection or litigation in the close cases. As described in Part II above, the courts and scholars have generally not acknowledged this channeling function or grappled with the useful article doctrine’s place in the broader intellectual property regime.

In contrast, trademark law’s channeling doctrine, the functionality rule, has been articulated more explicitly as a doctrine that excludes items from the trademark realm in order to advance patent law policy.¹⁶⁹ It is clear that the functionality doctrine is at

167. 17 U.S.C. § 302(a) (2012).

168. 35 U.S.C. § 154(a)(2) (2006).

169. *E.g.*, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

least as much about patent law and the broader IP regime as it is about trademark law. As a result, the doctrine has been formulated and applied differently than copyright's useful article doctrine.

1. Trademark's Functionality Doctrine

The Lanham Act provides that trade dress may be protectable, but the proponent must prove that the elements sought to be protected are not *functional*.¹⁷⁰ "This burden of proof gives force to the well-established rule that trade dress protection may not be claimed for product features that are functional."¹⁷¹ Thus, there is a statutory commandment that functional items are excluded from the trademark realm. The Lanham Act emphasizes this exclusion from trademark with a burden-shifting rule that creates a default of "not trademark" for utilitarian items.¹⁷²

The Supreme Court has emphasized that the functionality doctrine in trademark law serves a channeling purpose, directing useful inventions to the patent realm and prohibiting trademark protection for such items.

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).¹⁷³

The functionality doctrine in trademark law is explicitly designed to direct functional, or useful, items to the patent realm; they simply may not be protected by trademark law. Placing the bur-

170. 15 U.S.C. § 1125(a)(3) (2012) ("In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.").

171. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001).

172. 15 U.S.C. § 1125(c). This is so if the trade dress proponent seeks to register the mark or decides to bring a suit for infringement of an unregistered mark.

173. *Qualitex*, 514 U.S. at 164–65 (citations omitted).

den of proof on the proponent of protection makes clear that the default is one of no protection; close cases fall clearly on the side of no protection.

In *TrafFix v. MDI*, the Supreme Court resolved a circuit split concerning the details and application of trademark's functionality doctrine.¹⁷⁴ *TrafFix* was a trade dress dispute revolving around the design of traffic signs. TrafFix Devices copied MDI's design after the patents on the design expired. TrafFix's actions therefore did not constitute patent infringement, but MDI sued for, among other things, trade dress infringement.¹⁷⁵

Emphasizing the "not trademark" default rule of the functionality doctrine, the Supreme Court disposed of MDI's arguments easily.¹⁷⁶ The burden placed on the proponent, along with the existence of the expired utility patent, made it very difficult for MDI to prevail.¹⁷⁷ As the Court explained, "MDI did not, and cannot, carry the burden of overcoming the strong evidentiary inference of functionality based on the disclosure of the dual-spring design in the claims of the expired patents."¹⁷⁸ While relying on the existence of the expired patents, the Supreme Court also made it very clear that the burden rests on the party seeking trademark protection in all instances and that MDI would have failed to meet that burden even in the absence of an expired patent.¹⁷⁹

2. "Functionality" for Copyright Law

The Copyright Act does not contain a provision similar to that in the Lanham Act, but the statute clearly indicates that useful articles will not receive copyright protection and that even the aesthetic—that is, non-useful—aspects of those articles will not

174. *TrafFix*, 532 U.S. at 28 (describing the circuit split as involving the question of "whether the existence of an expired utility patent forecloses the possibility of the patentee's claiming trade dress protection in the product's design").

175. *Id.* at 26.

176. *Id.* at 29–30.

177. *Id.* ("If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection.")

178. *Id.* at 30.

179. *Id.* at 32 ("[E]ven if there has been no previous utility patent the party asserting trade dress has the burden to establish the nonfunctionality of alleged trade dress features. MDI could not meet this burden.")

be protected unless they can be identified separately.¹⁸⁰ While this is not explicit burden-shifting language, it does appear to require that the copyright proponent identify those non-useful aspects of a work in order to receive copyright protection.

Consistent with the trademark approach, courts in copyright cases should make explicit that they treat this language as creating a default in favor of non-protection and requiring proof otherwise to overcome the presumption.¹⁸¹ The copyright plaintiff should bear this burden despite having already obtained a certificate of registration from the Copyright Office.¹⁸²

There are differences between trademark and copyright law that must be addressed in considering whether trademark's functionality doctrine could be adopted in copyright cases. First, a trademark owner may sue on an unregistered trademark or trade dress, but a copyright owner must first register before commencing a lawsuit.¹⁸³ Second, the registration process in the Copyright Office is not particularly robust. The Copyright Office does not spend a great deal of its time or resources examining copyright registrations.¹⁸⁴ The Patent & Trademark Office ("USPTO"), on the other hand, does a somewhat more searching examination of trademark applications and a relatively rigorous review of patent applications.¹⁸⁵ In other words, the requirement that the copyright plaintiff have obtained registration is quite a minor hurdle. One conclusion to be drawn from this is that the Copyright Office is

180. 17 U.S.C. § 101 (2012). The definition of "pictorial, graphic, and sculptural works" provides that the design of a useful article "shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.*

181. Alternatively, Congress could amend the Copyright Act to make this default clear. This is less likely to occur than judicial interpretation to the same end, however.

182. *Id.* § 411(a) ("[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title").

183. Compare 15 U.S.C. § 1125(a)(3) (2012) (allowing for lawsuits based on unregistered trademark or trade dress), with 17 U.S.C. § 411(a) (requiring registration for suit to lie).

184. See, e.g., Thomas G. Field, Jr., *Judicial Review of Copyright Examination*, 44 IDEA 479, 484 (2004) (footnote omitted) (noting that "examination is permitted, and applications to register are sometimes refused; historically, however, few works have received attention beyond the formalities").

185. See Bruce Day & Mike Martinez, *The Roots of Intellectual Property: Trade Secrets, Patents, Trademarks and Copyrights*, 62 J. KAN. B.A. 30, 33 (1993) (detailing the rigorous nature of patent review).

unlikely to vigorously screen out industrial designs that ought not be protected by copyright law. Under both trademark and copyright law, however, registration is *prima facie* evidence of validity.¹⁸⁶ While the USPTO is given substantial deference in its determinations, it would be justifiable to refuse to give the Copyright Office the same level of deference.

Keeping this in mind, in cases in which the defendant raises the useful article doctrine as a defense, the courts ought to require the plaintiff to prove that the work is not useful. Under the assumption that neither the copyright proponent nor the Copyright Office has expended resources on this question at the registration stage, it is reasonable to require the showing in the trial court.¹⁸⁷ Applying this simple presumption might, by itself, resolve a vast number of the difficult cases, at least to the extent that it would deter litigation and perhaps even some copyright registrations. This burden-shifting would create a new default rule, and on their own, default rules can make a big difference in behavior.¹⁸⁸ Moreover, this particular default rule flows clearly from and reflects the policy purpose of ensuring that useful articles are excluded from copyright protection, and it acknowledges that it is better to err on the side of under-protection in order to achieve this goal.

B. *The Copyright Proponent's Burden*

Placing the burden explicitly on the copyright proponent and requiring clear evidence that the items sought to be protected are *not* useful is the most significant part of this proposal. There are a variety of possibilities regarding the details of what the copyright proponent must demonstrate in order to overcome the presumption and obtain copyright protection. This section describes two alternatives and explains how they would apply in several of the leading cases.

186. 15 U.S.C. § 1115(a) (2012); 17 U.S.C. § 410(c) (2012).

187. This certainly makes more sense and is more efficient than trying to change the Copyright Office procedure. To require the showing by copyright proponents at the registration stage would impose a great deal of cost on the office and on copyright owners. Much of that would likely be unnecessary expense as, presumably, many of the copyright owners will never bring suit on their works.

188. For a general discussion, see Cass R. Sunstein, *Empirically Informed Regulation*, 78 U. CHI. L. REV. 1349 (2011).

1. Physical Separability

One possibility that is quite responsive to both the policy concerns and to predictability and consistency concerns is to provide that in the case of a useful article, the copyright owner may only get protection for the aesthetic elements of a work if those elements are physically separable from the useful elements.¹⁸⁹ To be absolutely clear, under this approach, the courts would simply abandon their efforts to define and determine "conceptual separability." This is indeed a broad-brush approach: some original, expressive works that would in every other respect qualify for copyright protection would surely be excluded from the copyright realm. On the other hand, this approach would virtually guarantee that no useful works would receive copyright protection and it is likely to provide a sufficiently clear rule such that industrial designers would be disinclined to seek copyright protection for works that exist at the boundary of copyright law.

A bright-line rule that protects only physically-separable aesthetic elements of useful articles takes seriously the notion that useful articles should not be protected by copyright law but belong instead in the patent realm. Under this approach, useful or functional elements of useful articles are extremely unlikely to receive copyright protection. Indeed, the rule errs the other way, likely excluding from copyright protection expressive elements of works that are not functional. If the channeling function of the useful article doctrine is considered paramount, then the overprotective effect of the bright-line rule is appropriate.¹⁹⁰ This rule is also easy to apply, provides relatively predictable results, and reduces the necessity of courts making artistic or aesthetic judgments.

Some courts employ language that appears to push in the direction of this sort of clear-cut approach, but none has gone quite

189. Right after the passage of the 1976 Act, the D.C. Circuit proposed this approach. See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 803-04 (D.C. Cir. 1978) (calling the reference to conceptual separability an "isolated reference" and requiring physical separability for protection). However, courts considering the issue later nearly uniformly rejected the idea. See, e.g., *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987) (allowing for a showing of physical or conceptual separability). In addition, Michael Lynch proposed an approach based on physical separability alone, but the courts have yet to take up his suggestion. See Lynch, *supra* note 15, at 662.

190. Professor Denicola references this approach and dismisses it as insufficiently protective of aesthetic, original expression. See Denicola, *supra* note 16, at 730.

so far, perhaps because it is not entirely consistent with the statutory language and the legislative history.¹⁹¹ In *Pivot Point*, for example, the Seventh Circuit reads the statutory definition of pictorial, graphic, and sculptural works to provide “a single, integrated standard to determine when there is sufficient separateness between the utilitarian and artistic aspects of a work to justify copyright protection.”¹⁹² The court goes on, though, to reject a test limited to a physical separability inquiry, asserting that it is not helpful in the context of two-dimensional works.¹⁹³ In *Brandir*, the court cited *Nimmer* and similarly concluded that works could be protected if the aesthetic elements were either physically or conceptually separable.¹⁹⁴ “‘Conceptual separability’ is thus alive and well, at least in this circuit.”¹⁹⁵ Courts have adhered to the notion of conceptual separability—which is the piece of the useful article doctrine that has provoked so much difficulty—because that language comes out of the legislative history¹⁹⁶ and also perhaps out of a concern for excluding otherwise copyrightable works from protection.

While the legislative history is, of course, significant, it certainly carries less weight than the language of the statute, which does not mention the phrase “conceptual separability.” The statute does not mention physical separability either. Instead, the definition of a “pictorial, graphic, or sculptural work” states:

191. See, e.g., *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985). But cf. *Esquire*, 591 F.2d at 803–04 (applying a physical separability standard).

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

193. *Id.* at 922 (stating that “[w]hen a three-dimensional article is the focus of the inquiry, reliance on physical separability can no doubt be a helpful tool in ascertaining whether the artistic material in question can be separated from the industrial design,” but indicating that “such an approach really is not of much use when the item in question is two-dimensional”); see also *Denicola*, *supra* note 16, at 744–75. Two-dimensional works are, however, less likely to be “useful articles” subject to any kind of separability analysis. Nearly all of the problematic cases seem to arise with respect to “sculptural” works. See, e.g., *Vermont*, *supra* note 143, at 95 (cataloging a variety of seemingly useful three-dimensional items that have been registered with the Copyright Office and concluding that it is whether items are “constrained” rather than whether they are “separable” that should be the decisive factor).

194. *Brandir*, 834 F.2d at 1144 (“Looking to the section 101 definition of works of artistic craftsmanship requiring that artistic features be ‘capable of existing independently of the utilitarian aspects,’ Professor *Nimmer* queries whether that requires *physical* as distinguished from *conceptual* separability, but answers his query by saying ‘[t]here is reason to conclude that it does not.’”) (citing 1 NIMMER ON COPYRIGHT § 2.08[B] at 2-96.1 (1986)).

195. *Id.*

196. Notably, however, it is not in the statute. See 17 U.S.C. § 101 (2012).

[T]he design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be *identified separately from, and are capable of existing independently of*, the utilitarian aspects of the article.¹⁹⁷

There is nothing in the language of the statute that compels consideration of conceptual separability. Indeed, it is possible to interpret the language as involving a physical separability test and no more.

To be sure, such an approach is not mandated by the statute, but its clarity and ease of application, as well as its effectiveness at channeling works away from copyright mean that it has much to recommend it. Applying the default rule and the physical separability test to the facts in a few of the leading cases demonstrates the workability and appeal of the approach.

In the *Brandir* case involving the “ribbon” bicycle rack, application of the bright-line rule would be straightforward.¹⁹⁸ The ribbon rack certainly has aesthetic appeal and artistic elements, but those elements cannot be physically separated from the useful aspects of the bicycle rack. Thus the ribbon rack would receive no copyright protection.

Kieselstein-Cord, another casebook staple, is a case that should have been much easier than it was, and it would be straightforward under the bright-line test proposed here.¹⁹⁹ The Second Circuit went through a rather complicated discussion of conceptual separability to reach the conclusion that the aesthetic elements were indeed separable and thus predictable.²⁰⁰ These contortions were likely unnecessary. Although it is difficult to find good photographs or other representations of the specific belt buckle at issue in the case, it appears that the functional belt-buckle aspects of work were very likely physically separable from the expressive elements of *Kieselstein-Cord*’s work.²⁰¹ As with the Mickey Mouse telephone, one can imagine using some kind of tool to remove the belt buckle clasp, leaving a completely useless, though aestheti-

197. *Id.* (emphasis added).

198. *Brandir*, 834 F.2d at 1143.

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

200. *See id.* at 993.

201. *See* COPYRIGHT IN A GLOBAL INFORMATION ECONOMY, <http://www.coolcopyright.com/cases/chp4/kieselsteinpearl.htm> (last visited Dec. 6, 2013).

cally appealing, piece of metal. Thus under any approach, this ought to have been an easy case and the plaintiff ought to have prevailed (on the protectability question, at least; infringement is another matter).

The mannequin case, *Carol Barnhart*, presents a slightly different question. In that case, the court held that there was neither physical nor conceptual separability.²⁰² It is possible to conceive of the human-like shaping as *physically* separable from the mannequin forms. That is, one could take a file and scrape off the slight indentations that hint at human anatomy and leave the forms still functional for displaying items of clothing. On the other hand, the best approach for the courts to take in this kind of case—and there have been a number of mannequin cases that seem to present great difficulties²⁰³—is to take the burden of proof seriously and simply require a strong showing by the plaintiff that the aesthetic elements it seeks to protect are physically separable from the useful aspects. If that is not demonstrated, in the close cases, the courts should err on the side of “not copyright,” thus ensuring that useful items do not receive the protection of copyright.

As should be apparent from these examples, the presumption of “not copyright,” along with the physical separability test, operates as a rather blunt channeling tool. This strong default is appropriate if one assumes that *over*protection is more of a problem than *under*protection. There are a number of reasons to believe that this is the case. First, the legislative history of the useful article doctrine provisions in the Copyright Act indicates that useful articles are not to receive copyright protection. Second, the useful article doctrine is meant to act as a channeling rule, and the channeling function of the rule is best served by a bright-line rule.

One objection to this proposed test will be that the better and more effective the industrial design, the more likely it is that the aesthetic and functional elements will merge, becoming intertwined and interdependent. This is almost certainly true. Apple’s

202. *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985).

203. See, e.g., *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 321 (2d Cir. 1996) (fish mannequins); *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 491 (4th Cir. 1996) (animal mannequins); *Carol Barnhart*, 773 F.2d at 412 (human torso mannequins).

iPhone is likely one such example, and the Ribbon bicycle rack is another. The very best industrial design will seamlessly integrate form and function. But the merger of the useful and the beautiful will not stand in the way of patent protection, if that is otherwise available.²⁰⁴ To hold otherwise is to allow copyright law to regularly protect useful articles. Indeed, the *Brandir* case provides the perfect example of an item of industrial design that perhaps might have attained patent protection.²⁰⁵ Regardless, a robust useful article doctrine will regularly perform the channeling function that occurred only with great difficulty in the *Brandir* case. On balance, it is likely a good thing—a boon for the public interest—to allow free copying of a new and useful design that does not meet the requirements of patentability. If it is believed that some additional incentive is necessary for industrial designers, such protection would be better provided through a sui generis scheme of protection. Copyright is simply not the right home for industrial design.

2. Adapting Trademark's Functionality Doctrine for Copyright Law

An alternative to the rather blunt approach proposed above is to adopt the details of trademark's functionality test, along with its burden-shifting. In *TrafFix v. MDI*, the Supreme Court made quite clear that it was willing to sacrifice some degree of accuracy, and some level of protection, in order to cleanly channel functional items to the patent realm.²⁰⁶ While the physical separability test described above would certainly achieve this same result, so might trademark's functionality test.²⁰⁷

As described above, the Supreme Court in *TrafFix v. MDI* pointedly referenced the Lanham Act's burden-shifting approach

204. Mark McKenna and Katherine Strandburg have proposed that it is the design patent system that ought to protect works that integrate form and function. See McKenna & Strandburg, *supra* note 20, at 43–45.

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

206. See *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34–35 (2001).

207. Another alternative would be to apply a version of patent law's utility doctrine. See 35 U.S.C. § 101 (2006) (requiring that an invention be new, useful, and nonobvious). In patent law, this functions as a low hurdle. If an item is "totally incapable of achieving a useful result," a patent will be denied. *Brooktree Corp. v. Advanced Micro Devices*, 977 F.2d 1555, 1571 (Fed. Cir. 1992). Borrowing from this doctrine, copyright law could require the copyright proponent to demonstrate this its article (or the aspects of the article it seeks to protect with copyright) is "totally incapable of achieving a useful result." *Id.*

and held that MDI was not entitled to trade dress protection for the dual-spring design of its traffic signs.²⁰⁸ In reaching this conclusion, the Court applied the test that it had developed through a series of cases: a product feature is functional—and therefore cannot be trademarked—“[1] if it is essential to the use or purpose of the article or [2] if it affects the cost or quality of the article.”²⁰⁹ The Court clarified that if a product feature is functional under either of these formulations, any further inquiry is unnecessary.²¹⁰ Moreover, functionality will bar trade dress protection even when the design or product feature would otherwise be protected.²¹¹ In other words, for example, Traffix would have prevailed even if MDI had been able to demonstrate that the dual-spring design was source-identifying and that secondary meaning had developed. Functionality trumps any countervailing trademark concerns or policy.²¹²

It is with some hesitation that this article proposes the migration of trademark’s functionality doctrine to copyright law. The doctrine—and in particular the Court’s test described here—have been roundly criticized by scholars.²¹³ It has, however, been adopted and applied by the federal courts, who have gained expe-

208. See *supra* notes 176–79 and accompanying text.

209. *Traffix*, 532 U.S. at 32 (internal quotation marks omitted) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

210. *Id.* at 33 (“Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, esthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.”). In other words, some product features may be deemed functional even if they are not functional under the traditional formulation, but a feature that is functional under one of the two prongs is functional regardless of other potential tests or inquiries.

211. It bears mentioning that the functionality doctrine need only be applied to “trade dress” and not to trademarks used on goods or service marks. Similarly, the useful article doctrine applies only to pictorial, graphic, and sculptural works. In other words, in both trademark and copyright, Congress has expressed an intent to exclude items of industrial design. The utility/functionality limitation does not generally apply to a whole variety of works protected by copyright law and by trademark law. This helps to clarify that works at the boundary of copyright or trademark law may present some unique issues for the broader IP regime.

212. Mark McKenna has described functionality as the only true trademark “defense” because of this way in which it negates a trademark proponent’s claims. See McKenna, *supra* note 73, at 823–24, 857. Of course, not all courts actually treat it this way. See, e.g., *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 224–25, 228 (2d Cir. 2012) (determining that functionality is to be assessed after deciding whether the mark “merits protection” and concluding that since the mark merited protection only as modified, functionality did not need to be assessed).

213. See, e.g., McKenna, *supra* note 73, at 824.

rience with the rule. While this is certainly not sufficient by itself to justify the adoption of the doctrine into copyright law, there are practical and theoretical reasons to apply a test that (1) already has the Supreme Court's imprimatur and (2) serves the same purpose in trademark law that the useful article doctrine is meant to serve in copyright law.²¹⁴ This second point is crucial. Trademark's functionality doctrine looks primarily not at trademark law issues (source identification, consumer behavior, etc.) but at a patent law question. As suggested above, the useful article doctrine in copyright law is not really about copyright law, but all of the tests that have been so far employed focus on copyright law, on what is aesthetic or expression or art and so on. A test that hones in not on what might be protected, but instead on what ought *not* be protected better captures the purpose of the doctrine.

It is in this way that trademark's functionality doctrine would be an improvement over any of the current variations of the useful article doctrine and the tests for conceptual separability. The functionality test asks whether a product feature is "essential" to the use or purpose of the item.²¹⁵ If it is, then it may not receive trade dress protection. Alternatively, the test asks whether the product feature affects the cost or quality of the article.²¹⁶ If so, again, the item will not receive trade dress protection. Both of these inquiries seek to ferret out the useful aspects of items, leaving them in the public domain unless they qualify for patent protection. This focus on the channeling function, even if it fails to create a perfect test, at least directs practitioners and courts toward the underlying policy purpose.

A copyright functionality test would place the burden on the proponent, requiring proof that the aspects sought to be protected are not functional—or useful—by demonstrating that they are not essential to the item's operation and do not affect the cost or qual-

214. Courts and practitioners have struggled in particular with the concept of "aesthetic functionality," and an alternative test has developed over time. It seems unlikely, however, that it would be necessary to import aesthetic functionality into copyright law as the point of aesthetic functionality is to preclude trademark protection for items that are not mechanically useful but nonetheless serve important (usually competition-related) purposes. There is simply less need for this in copyright law, as it is not directed so clearly toward consumers and the marketplace.

215. See *TrafFix*, 532 U.S. at 32 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

216. *Id.*

ity of the item.²¹⁷ This approach addresses directly the policy goal of confining protection for useful articles to the patent realm, though it is certainly less predictable and more difficult to apply than the bright-line rule of the physical separability approach. Nonetheless, it may be the more pragmatic option as it is the test already adopted by the Court to achieve a purpose similar to that required in the copyright context. Doing so would have many salutary effects: it is a rule that flows directly from federal intellectual property policy; it is a rule that draws a much clearer line between copyright and patent law; it is likely to be more predictable than the current tests; and it avoids the need for courts to make artistic judgments and for parties to manipulate the evidence to suit their ends. In addition, and perhaps most importantly in terms of practicability, it is a test that has been sanctioned by the Supreme Court and applied by the lower courts.²¹⁸ And while it is true that it sacrifices accuracy, this precise sacrifice has been acknowledged and endorsed by the Court. Just as there will be some source-identifying product designs that do not receive trademark protection, there will be some fixed, original, expressive works that do not receive copyright protection. This would go a long way toward ensuring that useful or functional items are excluded from copyright protection.

It is helpful to think about the rule in operation. With respect to *Brandir*, the bicycle rack incorporates both useful and aesthetic elements, and *Brandir* bears the burden of identifying the elements it seeks to protect and showing that those elements are neither essential to the use or purpose of work nor that they affect the cost or quality. In that case, this would be quite a heavy burden indeed. It is apparent that the Ribbon rack incorporates aesthetic elements, but it is very difficult to *identify* either the aesthetic or the useful elements in any effective way, and they certainly are not physically separable. Moreover, even if that were possible as a rhetorical or semantic matter, *Brandir* would face an uphill battle to demonstrate that the design features it sought to protect with copyright law do not affect the quality of the article. As was discussed in the case, the shape and size of the

217. *Id.* at 35 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)) ("Whether a utility patent has expired or there has been no utility patent at all, a product design which has a particular appearance may be functional because it is 'essential to the use or purpose of the article' or 'affects the cost or quality of the article.'").

218. *See, e.g., id.* at 32.

curving rails are exactly what make it work as a bike rack.²¹⁹ Thus, the design features certainly "affect the cost or quality." Although *Brandir* might argue that the particular size and shape of the curving rails are not "essential," the Supreme Court has held that competitive necessity is not the appropriate test.²²⁰ That is, there is no need to "design around" a competitor's product, nor does the defendant have to demonstrate that there is no other way to design the useful article.²²¹ Merely because there are other possible ways to design a bike rack does not mean that *Brandir* should receive protection for its particular configuration.

In *Kieselstein-Cord*, the case concerning the belt buckle, the dispute should have been easier to resolve.²²² In that case, *Kieselstein-Cord* could have "identified separately" the aesthetic and functional elements of the belt buckles. Doing so would have resulted in protection for the curved design. As becomes clear with this case, the requirement that the non-useful aspects of the work be identified by the copyright proponent becomes something akin to a physical separability test. That is as it should be, and those cases are the easy ones.

It is when physical separability is not possible that the courts have struggled. The approach proposed here is hardly a panacea in those cases, but shifting the burden to the copyright proponent and making clear that the default is one of no protection ought to take the pressure off the difficult cases. In other words, this approach frankly acknowledges that "getting it right" is less important than other countervailing concerns. The first alternative proposed above takes this tack most explicitly but the trademark functionality test is likely to serve this purpose as well.

219. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987).

220. *TrafFix*, 532 U.S. at 33-34 (citation omitted) ("There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.").

221. *Id.* at 34 ("Because the dual-spring design is functional, it is unnecessary for competitors to explore designs to hide the springs, say, by using a box or framework to cover them, as suggested by the Court of Appeals.").

222. *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980).

The mannequin cases, *Carol Barnhart* and *Pivot Point*, present one of the most vexing scenarios.²²³ In *Carol Barnhart*, which involved human torso forms used for displaying clothing, the functionality test would ask the copyright proponent to demonstrate that the aspects of the work sought to be protected (presumably the shaping creating the form of a button-down shirt and the shaping that indicates a human chest) are not “essential” to the use or operation of the item and that they do not affect the cost or quality of the torso forms.²²⁴ It would be quite difficult for the owner to convincingly demonstrate both of these. In order to display, for example, a shirt, a tie, and a sweater on a mannequin, it is at least very helpful, if not essential, to have the shape of a human form and it certainly makes the mannequin work better *as a mannequin*. A torso meant to display women’s shirts displays those shirts more effectively if the mannequin has a shape that is similar to a human female shape. Likewise in *Pivot Point*, the mannequin head works better as a tool for stylists because it mimics the human form.²²⁵ In both cases, the plaintiff would have quite a difficult time overcoming the burden of proof to demonstrate non-usefulness (or functionality). In neither case should the mannequin be protected by copyright law.

This approach does, admittedly, run contrary to some significant copyright principles. Namely, the notion that for most ideas there can be a wide variety of expression such that the expression is protectable without hurting either competition or innovation. As with the functionality doctrine in trademark law, however, the useful article doctrine can be seen as serving purposes important enough to overcome these objections. The useful article doctrine should, as with trademark functionality, trump other copyright concerns. In other words, even if a pictorial, graphic, or sculptural work is fixed, original expression, it ought not receive copyright protection if it is a useful article. As described above, this is for patent law reasons. In addition, it operates only with respect to

223. *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004); *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985); *see also* *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., Inc.*, 74 F.3d 488 (4th Cir. 1996); *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320 (2d Cir. 1996) (addressing the differences and similarities of taxidermy and mannequins as copyrightable sculptural works).

224. *Carol Barnhart*, 773 F.2d at 412. For an image of the human torso forms at issue, *see* COPYRIGHT IN A GLOBAL INFORMATION ECONOMY, <http://www.coolcopyright.com/cases/chp4/barnharteconomy.htm> (last visited Dec. 6, 2013).

225. *Pivot Point*, 372 F.3d at 931.

pictorial, graphic, and sculptural works, so that it is an exception or carve-out that is unlikely to lead to a slippery slope.²²⁶

CONCLUSION

The approach proposed here will admittedly result in the exclusion from copyright protection of original expression that would in every other respect qualify. But this is as it should be. Rather than contorting the statute or the reasoning to ferret out every original, aesthetic aspect of a work, copyright law ought to frankly acknowledge that it cannot get it right every time and that the policy concerns animating the useful article doctrine, which stretch beyond copyright to the broader intellectual property system, trump the narrower copyright concerns.

226. Of course there will always be issues at the margins. Disputes might arise over whether a work is a "pictorial, graphic, or sculptural work" or a "literary work." Designers might well seek to characterize their works as literary works to avoid the scrutiny of the useful article doctrine.