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## Design Rights

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This chapter deals with IP protections for the designs of three-dimensional objects. The fundamental conceptual challenge such objects present is that they can be both useful and beautiful, and the bodies of IP law we have studied so far tend to insist either that they only protect the useful aspects or only that they don't protect the useful aspects. Thus, the doctrinal challenge in each IP area is how to draw the line between the utilitarian/functional/useful/applied aspects of an object's design and everything else.

The problem of classifying objects as "useful" or "beautiful" extends far beyond intellectual property law. For example, the United States does not impose import tariffs on "works of art, collectors' pieces and antiques."<sup>1</sup> But this does not include objects "capable of any functional use."<sup>2</sup> Thus, bronze tables, chairs, and other furniture created by Diego and Albert Giacometti in the 1930s were subject to tariff, even though they were being imported to be auctioned by Sotheby's in 1999.<sup>3</sup>

### A Utility Patent

There are no per se rules preventing the issuance of utility patents on three-dimensional designs; they are just not usually an effective tool for protecting design as such. One problem is utility: if the design's only improvement over the prior art is that it looks better, this might not qualify even under the permissive *Juicy Whip, Inc. v. Orange Bang, Inc.* standard. Another is claim drafting: to twist the phrase, writing about design is like dancing about architecture. Indefiniteness and enablement are likely to hem in the applicant's ability to capture the design in words. So while utility patents are well adapted to capturing the functional aspects of a design, they are so awkward as to be useless at capturing everything else.

### B Copyright

One could imagine drawing a distinction between fine art (like paintings and novels) and non-art (like boats and tools). But *Bleistein v. Donaldson Lithographing Co.* dooms any such inquiry into the quality of the artistry

1. Harmonized Tariff Schedule of the United States ch. 97.
2. U.S. Customs & Border Prot., Internal Advice Letter HQ 963158 (Jan. 14, 2000).
3. *Id.* See generally Brian Soucek, *Aesthetic Judgments in Law*, 69 ALA. L. REV. 381 (2017) (from which this example is taken).

in a work. In the 1954 case of *Mazer v. Stein*, the Supreme Court held that a lamp base in the form of a dancer was a "work of art," i.e., within one of the copyrightable classes of works under the 1909 Copyright Act.<sup>4</sup> Justice Reed's opinion for the Court explained:

Petitioners question the validity of a copyright of a work of art for "mass" production. . . . Their position is that a copyright does not cover industrial reproduction of the protected article.

It is not the right to copyright an article that could have utility that petitioners oppose. Their brief accepts the copyrightability of the great carved golden saltcellar of Cellini but adds:

If, however, Cellini designed and manufactured this item in quantity so that the general public could have salt cellars, then an entirely different conclusion would be reached. In such case, the salt cellar becomes an article of manufacture having utility in addition to its ornamental value and would therefore have to be protected by design patent.

. . . It is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts. Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. 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.

We hold that the [design] 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.<sup>5</sup>

The rationale was straightforwardly utilitarian: "encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors . . . . Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered."<sup>6</sup> In concurrence, Justice Douglas expressed some hesitation about opening the door to kitsch:

The Copyright Office has supplied us with a long list of such articles which have been copyrighted – statuettes, book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays. Perhaps these are all "writings" in the constitutional sense. But to me, at least, they are not obviously so.<sup>7</sup>

4. *Mazer v. Stein*, 347 U.S. 201 (1954).



Lamp base



Salt cellar by Benvenuto Cellini. Worth an estimated \$60 million, it was stolen in 2003 from the Kunsthistorisches Museum in Vienna and recovered in 2006 after the thief was identified.

5. *Id.*

6. *Id.*

7. *Id.* (Douglas, J., concurring).

## 1 Useful Articles

In the 1976 Act, Congress tried to draw a line between aesthetics and utility by denying copyright to *useful articles*, i.e. “[articles] having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>8</sup> In particular, Congress carved them out from the definition of copyrightable pictorial, graphic, and sculptural (PGS) works:

8. 17 U.S.C. § 101.

“Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.<sup>9</sup>

9. 17 U.S.C. § 101.

Unpacking this:

- Non-PGS works, like songs (musical works) and novels (literary works), are copyrightable.
- PGS works that are *not* useful articles, like monumental equestrian statues and oil paintings, are copyrightable.
- PGS works that *are* useful articles but in which the useful aspects are separable from the the aesthetic aspects, like the hood ornament (aesthetic) on a car (useful), are copyrightable.
- PGS works that are useful articles and in which the useful aspects are *not* separable from the the aesthetic aspects are uncopyrightable.

The House Report on the 1976 Act explains in more detail:

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 article 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.<sup>10</sup>

The courts struggled for decades with how to implement the useful-article rule, coming up with a variety of approaches. So-called "physical separability," as in the hood-ornament case, was relatively easy when an aesthetic portion of the object could be physically removed from the useful portion, without damaging either aesthetics or functionality. It was also easy enough to find that surface decorations were almost always separable, since an object's functionality was typically not dependent on its paint scheme. Indeed, pictorial and graphic works were almost never useful articles in the first place. Thus, the hard questions generally arose only for sculptural works and only for cases where the object's three-dimensional shape was both aesthetic and functional.

In one influential case, *Brandir Intern., Inc. v. Cascade Pacific Lumber Co.*, the Second Circuit used a test for such "conceptual separability" that looked to the designer's creative process.<sup>11</sup> A useful article is conceptually separable, and hence copyrightable, "where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences."<sup>12</sup> Under this test, a steel bicycle rack was an unseparable uncopyrightable useful article.:

[I]t is not enough that . . . the rack may stimulate in the mind of the reasonable observer a concept separate from the bicycle rack concept. While the RIBBON Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices. Indeed, the visually pleasing proportions and symmetry of the rack represent design changes made in response to functional concerns.<sup>13</sup>

Other circuits adopted their own tests, some of which looked more to the response of an observer.

10. H.R. Rep No. 94-1476, 1976 U.S.C.C.A.N. 5659.

11. *Brandir Intern., Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

12. *Id.* at 1145.



RIBBON bicycle rack

13. *Id.* at 1147.

In 2017, however, the Supreme Court took a useful-article case and blew away essentially all existing caselaw on useful articles. I doubt my ability to summarize *Star Athletica, LLC v. Varsity Brands, Inc.* accurately, so I am simply going to quote it at length:

**Star Athletica, LLC v. Varsity Brands, Inc.**  
137 S.Ct. 1002 (2017)

Respondents Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc., design, make, and sell cheerleading uniforms. Respondents have obtained or acquired more than 200 U.S. copyright registrations for two-dimensional designs appearing on the surface of their uniforms and other garments. These designs are primarily combinations, positionings, and arrangements of elements that include chevrons, lines, curves, stripes, angles, diagonals, inverted chevrons, coloring, and shapes.

Petitioner Star Athletica, L.L.C., also markets and sells cheerleading uniforms. Respondents sued petitioner for infringing their copyrights in the five designs.

II

The Copyright Act establishes a special rule for copyrighting a pictorial, graphic, or sculptural work incorporated into a “useful article,” which is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” The statute does not protect useful articles as such. Rather, “the design of a useful article” is “considered a pictorial, graphical, 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.”

Courts, the Copyright Office, and commentators have described the analysis undertaken to determine whether a feature can be separately identified from, and exist independently of, a useful article as “separability.” In this case, our task is to determine whether the arrangements of lines, chevrons, and colorful shapes appearing on the surface of respondents’ cheerleading uniforms are eligible for copyright protection as separable features of the design of those cheerleading uniforms.

A

As an initial matter, we must address whether separability analysis is necessary in this case.

Respondents contend that the surface decorations in this case are “two-dimensional graphic designs that appear on useful articles,” but are not themselves designs of useful articles. Consequently, the surface decorations are protected two-dimensional works of graphic art without regard to any separability analysis under. Under this theory, two-dimensional artistic features on the surface of useful articles are “inher-



Varsity uniform design

ently separable.”

This argument is inconsistent with the text of § 101. The statute requires separability analysis for any “pictorial, graphic, or sculptural features” incorporated into the “design of a useful article.”<sup>14</sup> And the statute expressly defines “[p]ictorial, graphical, and sculptural works” to include “two-dimensional ... works of ... art.” The statute thus provides that the “design of a useful article” can include two-dimensional “pictorial” and “graphic” features, and separability analysis applies to those features just as it does to three-dimensional “sculptural” features.

14. Can you imagine a two-dimensional “pictorial” or “graphic” feature that is *not* separable under the test the court announces in the next section?

### B

We must now decide when a feature incorporated into a useful article “can be identified separately from” and is “capable of existing independently of” “the utilitarian aspects” of the article.

The statute provides that a “pictorial, graphic, or sculptural featur[e]” incorporated into the “design of a useful article” is eligible for copyright protection if it (1) “can be identified separately from,” and (2) is “capable of existing independently of, the utilitarian aspects of the article.” § 101. The first requirement – separate identification – is not onerous. The decisionmaker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.

The independent-existence requirement is ordinarily more difficult to satisfy. The decisionmaker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article. In other words, the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in § 101 once it is imagined apart from the useful article. If the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.

Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or “[a]n article that is normally a part of a useful article” (which is itself considered a useful article). Nor could someone claim a copyright in a useful article merely by creating a replica of that article in some other medium – for example, a cardboard model of a car. Although the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.

### C

In sum, a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.

Applying this test to the surface decorations on the cheerleading uniforms is straightforward. First, one can identify the decorations as

features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium – for example, on a painter’s canvas – they would qualify as “two-dimensional ... works of ... art.” And imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself. Indeed, respondents have applied the designs in this case to other media of expression – different types of clothing – without replicating the uniform. The decorations are therefore separable from the uniforms and eligible for copyright protection.

The dissent argues that the designs are not separable because imaginatively removing them from the uniforms and placing them in some other medium of expression – a canvas, for example – would create “pictures of cheerleader uniforms.” Petitioner similarly argues that the decorations cannot be copyrighted because, even when extracted from the useful article, they retain the outline of a cheerleading uniform.

This is not a bar to copyright. Just as two-dimensional fine art corresponds to the shape of the canvas on which it is painted, two-dimensional applied art correlates to the contours of the article on which it is applied. A fresco painted on a wall, ceiling panel, or dome would not lose copyright protection, for example, simply because it was designed to track the dimensions of the surface on which it was painted. Or consider, for example, a design etched or painted on the surface of a guitar. If that entire design is imaginatively removed from the guitar’s surface and placed on an album cover, it would still resemble the shape of a guitar. But the image on the cover does not “replicate” the guitar as a useful article. Rather, the design is a two-dimensional work of art that corresponds to the shape of the useful article to which it was applied. The statute protects that work of art whether it is first drawn on the album cover and then applied to the guitar’s surface, or vice versa. Failing to protect that art would create an anomaly: It would extend protection to two-dimensional designs that cover a part of a useful article but would not protect the same design if it covered the entire article. The statute does not support that distinction, nor can it be reconciled with the dissent’s recognition that “artwork printed on a t-shirt” could be protected.

To be clear, the only feature of the cheerleading uniform eligible for a copyright in this case is the two-dimensional work of art fixed in the tangible medium of the uniform fabric. Even if respondents ultimately succeed in establishing a valid copyright in the surface decorations at issue here, respondents have no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear. They may prohibit only the reproduction of the surface designs in any tangible medium of expression – a uniform or otherwise.

Petitioner and the Government raise several objections to the approach we announce today. None is meritorious.

1

Petitioner first argues that our reading of the statute is missing an important step. It contends that a feature may exist independently only if it can stand alone as a copyrightable work and if the useful article from which it was extracted would remain equally useful. In other words, copyright extends only to “solely artistic” features of useful articles. According to petitioner, if a feature of a useful article “advance[s] the utility of the article,” then it is categorically beyond the scope of copyright. The designs here are not protected, it argues, because they are necessary to two of the uniforms’ “inherent, essential, or natural functions” – identifying the wearer as a cheerleader and enhancing the wearer’s physical appearance. Because the uniforms would not be equally useful without the designs, petitioner contends that the designs are inseparable from the “utilitarian aspects” of the uniform.

The debate over the relative utility of a plain white cheerleading uniform is unnecessary. The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.

Of course, because the removed feature may not be a useful article – as it would then not qualify as a pictorial, graphic, or sculptural work – there necessarily would be some aspects of the original useful article “left behind” if the feature were conceptually removed. But the statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one. Indeed, such a requirement would deprive the Mazer statuette of protection had it been created first as a lamp base rather than as a statuette. Without the base, the “lamp” would be just a shade, bulb, and wires. The statute does not require that we imagine a nonartistic replacement for the removed feature to determine whether that feature is capable of an independent existence.

Because we reject the view that a useful article must remain after the artistic feature has been imaginatively separated from the article, we necessarily abandon the distinction between “physical” and “conceptual” separability, which some courts and commentators have adopted based on the Copyright Act’s legislative history. According to this view, a feature is physically separable from the underlying useful article if it can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact. Conceptual separability applies if the feature physically could not be removed from the useful article by ordinary means.

The statutory text indicates that separability is a conceptual undertaking. Because separability does not require the underlying useful ar-

ticle to remain, the physical-conceptual distinction is unnecessary.

2

Petitioner next argues that we should incorporate two “objective” components, into our test to provide guidance to the lower courts: (1) “whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influence,” and (2) whether “there is a substantial likelihood that the pictorial, graphic, or sculptural feature would still be marketable to some significant segment of the community without its utilitarian function.”

We reject this argument because neither consideration is grounded in the text of the statute. The first would require the decisionmaker to consider evidence of the creator’s design methods, purposes, and reasons. The statute’s text makes clear, however, that our inquiry is limited to how the article and feature are perceived, not how or why they were designed.

The same is true of marketability. Nothing in the statute suggests that copyrightability depends on market surveys. Moreover, asking whether some segment of the market would be interested in a given work threatens to prize popular art over other forms, or to substitute judicial aesthetic preferences for the policy choices embodied in the Copyright Act. *See Bleistein*.

### III

We hold that an artistic feature of the design of a useful article is eligible for copyright protection if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article. Because the designs on the surface of respondents’ cheer-leading uniforms in this case satisfy these requirements, the judgment of the Court of Appeals is affirmed.

Justice Ginsburg, concurring in the judgment

I concur in the Court’s judgment but not in its opinion. Unlike the majority, I would not take up in this case the separability test appropriate under 17 U.S.C. § 101.1 Consideration of that test is unwarranted because the designs at issue are not designs of useful articles. Instead, the designs are themselves copyrightable pictorial or graphic works reproduced on useful articles.

Justice Breyer, dissenting

I agree with much in the Court’s opinion. But I do not agree that the designs that Varsity Brands, Inc., submitted to the Copyright Office are eligible for copyright protection.

### I

An example will help. Imagine a lamp. with a circular marble base, a vertical 10–inch tall brass rod (containing wires) inserted off center on



Cat lamp

the base, a light bulb fixture emerging from the top of the brass rod, and a lampshade sitting on top. In front of the brass rod a porcelain Siamese cat sits on the base facing outward. Obviously, the Siamese cat is physically separate from the lamp, as it could be easily removed while leaving both cat and lamp intact. And, assuming it otherwise qualifies, the designed cat is eligible for copyright protection.

Now suppose there is no long brass rod; instead the cat sits in the middle of the base and the wires run up through the cat to the bulbs. The cat is not physically separate from the lamp, as the reality of the lamp's construction is such that an effort to physically separate the cat and lamp will destroy both cat and lamp. The two are integrated into a single functional object, like the similar configuration of the ballet dancer statuettes that formed the lamp bases at issue in *Mazer*. But we can easily imagine the cat on its own, as did Congress when conceptualizing the ballet dancer. In doing so, we do not create a mental picture of a lamp (or, in the Court's words, a "replica" of the lamp), which is a useful article. We simply perceive the cat separately, as a small cat figurine that could be a copyrightable design work standing alone that does not replicate the lamp. Hence the cat is conceptually separate from the utilitarian article that is the lamp.

By way of contrast, Van Gogh's painting of a pair of old shoes, though beautifully executed and copyrightable as a painting, would not qualify for a shoe design copyright. Courts have similarly denied copyright protection to objects that begin as three-dimensional designs, such as measuring spoons shaped like heart-tipped arrows, candleholders shaped like sailboats, and wire spokes on a wheel cover. None of these designs could qualify for copyright protection that would prevent others from selling spoons, candleholders, or wheel covers with the same design. Why not? Because in each case the design is not separable from the utilitarian aspects of the object to which it relates. The designs cannot be physically separated because they themselves make up the shape of the spoon, candleholders, or wheel covers of which they are a part. And spoons, candleholders, and wheel covers are useful objects, as are the old shoes depicted in Van Gogh's painting. More importantly, one cannot easily imagine or otherwise conceptualize the design of the spoons or the candleholders or the shoes without that picture, or image, or replica being a picture of spoons, or candleholders, or wheel covers, or shoes. The designs necessarily bring along the underlying utilitarian object. Hence each design is not conceptually separable from the physical useful object.

In many or most cases, to decide whether a design or artistic feature of a useful article is conceptually separate from the article itself, it is enough to imagine the feature on its own and ask, "Have I created a picture of a (useful part of a) useful article?" If so, the design is not separable from the useful article. If not, it is.



Cat lamp



Vincent Van Gogh, "Shoes"

To ask this kind of simple question – does the design picture the useful article? – will not provide an answer in every case, for there will be cases where it is difficult to say whether a picture of the design is, or is not, also a picture of the useful article. But the question will avoid courts focusing primarily upon what I believe is an unhelpful feature of the inquiry, namely, whether the design can be imagined as a “two- or three-dimensional work of art.” That is because virtually any industrial design can be thought of separately as a “work of art”: Just imagine a frame surrounding the design, or its being placed in a gallery. Consider Marcel Duchamp’s “readymades” series, the functional mass-produced objects he designated as art. What is there in the world that, viewed through an esthetic lens, cannot be seen as a good, bad, or indifferent work of art? What design features could not be imaginatively reproduced on a painter’s canvas? Indeed, great industrial design may well include design that is inseparable from the useful article – where, as Frank Lloyd Wright put it, “form and function are one.”

#### IV

If we ask the “separateness” question correctly, the answer here is not difficult to find. Can the design features in Varsity’s pictures exist separately from the utilitarian aspects of a dress? Can we extract those features as copyrightable design works standing alone, without bringing along, via picture or design, the dresses of which they constitute a part? They certainly look like cheerleader uniforms. That is to say, they look like pictures of cheerleader uniforms, just like Van Gogh’s old shoes look like shoes. I do not see how one could see them otherwise.

Were I to accept the majority’s invitation to “imaginatively remov[e]” the chevrons and stripes as they are arranged on the neckline, waistline, sleeves, and skirt of each uniform, and apply them on a “painter’s canvas,” that painting would be of a cheerleader’s dress. The esthetic elements on which Varsity seeks protection exist only as part of the uniform design – there is nothing to separate out but for dress-shaped lines that replicate the cut and style of the uniforms. Hence, each design is not physically separate, nor is it conceptually separate, from the useful article it depicts, namely, a cheerleader’s dress. They cannot be copyrighted.

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A few questions remain. What about works that *depict* useful articles, like a photograph of a wrench or engineering diagrams for an engine? And what about works that are *applied* to useful articles, like a portrait printed on the top of a birthday cake? Section 113 of the Copyright Act, which deals with such questions, is among the densest and most obscure parts of the entire Act:

- (a) Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right



Marcel Duchamp, “In Advance of the Broken Arm”

to reproduce the work in or on any kind of article, whether useful or otherwise.

- (b) This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.
- (c) In the case of a work lawfully reproduced in useful articles that have been offered for sale or other distribution to the public, copyright does not include any right to prevent the making, distribution, or display of pictures or photographs of such articles in connection with advertisements or commentaries related to the distribution or display of such articles, or in connection with news reports. ...<sup>15</sup>

15. 17 U.S.C. § 113

The Register of Copyrights explained the intent of the section in a report published during the long drafting process for what became the 1976 Act:

We believe that, where the copyrighted work is used as a design or decoration of a useful article, it should continue, as under the present law, to be protected by copyright if the owner wishes. However, where the "work of art" actually portrays the useful article as such – as in a drawing, scale model, advertising sketch, or photograph of the article – existing court decisions indicate that copyright in the "work of art" does not protect against manufacture of the useful article portrayed. We agree with these decisions and the distinctions made in them.

Some examples will illustrate these points.

- (3) Since the protection available to a copyrighted pictorial, graphic, or sculptural work is not affected by use of the work as a design or decoration of a useful article, the following works would continue to be accorded full protection under the copyright statute:<sup>16</sup>
  - A copyrighted painting reproduced on textile fabrics;
  - A copyrighted cartoon drawing or photograph reproduced on fabrics or in the form of toys or dolls;
  - A copyrighted drawing of a chair reproduced on a lampshade;
  - A copyrighted sculptured figure used as a lamp base.
- (4) Under distinctions indicated in existing court decisions, that the copyright in a work portraying a useful

16. The present § 113 may be inartfully worded, but do you see how it adopts the Register's recommendations?

article as such would not protect against manufacture of that article, copyright protection would not extend to the following cases:

- A copyrighted drawing of a chair, used to manufacture chairs of that design;
- A copyrighted scale model of an automobile, used to manufacture automobiles of that design;
- A copyrighted technical drawing showing the construction of a machine, used to manufacture the machine;
- A copyrighted picture of a dress, used to manufacture the dress.<sup>17</sup>

## C Trademark

Trademark protects designs under the general heading of *trade dress*, using the same general distinctiveness analysis as it does for word marks and logos. Trade dress is “[t]he design of elements that constitute the appearance or image of goods or services as presented to prospective purchasers, including the design of packaging, labels, containers, displays, decor, or the design of a product, a product feature, or a combination of product features.”<sup>18</sup> While discrete trademarks can appear in many of these places – e.g., on a product’s package or in the front window of a store – trade dress refers to the entire combination of these elements. Thus, trade *dress* is a more diffuse category than trade *mark*. Trade dress is not federally registrable except to the extent that specific discrete elements can be identified and claimed as trademarks. But because section 43(a) permits a federal suit for unregistered marks, it can also be used to sue for trade dress infringement.

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, the Supreme Court held that trade dress is protectable on essentially the same terms as trademarks.<sup>19</sup> A Mexican restaurant, Taco Cabana, sued another Mexican restaurant, Two Pesos, for allegedly imitating its trade dress consisting of:

a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.<sup>20</sup>

Two Pesos argued that trade dress should be protectable only on proof of secondary meaning – in effect, that it is always descriptive as a matter of law – but the Court rejected this view. The Lanham Act does not make a distinction between trademarks and trade dress, and the Court was unwilling to create one. Some commentators were critical of the

17. Report of the Register of Copyrights on the General Revision of the Copyright Law (1961)

18. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16 (1995).

19. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).



Taco Cabana exterior

20. *Id.* at 765.

decision, but even if you do not think that the jury was right to find that this particular Mexican restaurant's decor was distinctive, it is hard to argue that trade dress in general can never be inherently distinctive.

The trade dress of a product *package* is essentially unconstrained: the seller can decorate it with almost any combination of graphical elements they want. Competing sellers can decorate their packaging differently. But product *design* is constrained by other factors. One is *functionality*: many products do something, and consumers buy them, at least in part, for what they do. The seller is not free to slap any trade dress it wants on the product to indicate that it is the source: doing so could undermine the facts that make the product desirable to consumers in the first place. And even more importantly, neither can the seller's competitors: if they want to offer their own products that appeal to consumers for the same non-trademark reasons, they will need to copy those features. Thus, just as *Baker v. Selden* and the useful-article doctrine limit the scope of copyright in product features, so to does functionality limit the scope of trademark rights.

Beyond that, there is a more fundamental issue with product-design trade dress. Product design is most often important to people not because it tells them who made the product, but because it *is* the product. Are you buying that T-shirt with a wicked awesome picture of a lion on it arms because the lion tells you that it comes from Shirt Off Your Back, the world's foremost purveyor of high-quality torso-wear – or because *you want to wear a shirt with a wicked awesome picture of a lion on it*? As in our discussion of BOSTON STRONG T-shirts (failure to function) and BRUINS T-shirts (false endorsement under section 43(a)), there is a serious question as to whether consumers will perceive product design features as being trademarks at all. Indeed, because this question is so fundamental, we take it up first.

## 1 Distinctiveness

In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, the Supreme Court held that product-design trade dress is protectable only on a showing of secondary meaning.<sup>21</sup> That is, the design of a product lacks inherent distinctiveness as a matter of law. If you like, you can think of this rule as saying that all product designs are descriptive for themselves.

The case itself involved children's clothing. Samara Brothers sold "a line of spring/summer one-piece seersucker outfits decorated with appliques of hearts, flowers, fruits, and the like."<sup>22</sup> Wal-Mart had one of its suppliers create a line of children's outfits based on Samara's line, on which Wal-Mart made \$1.15 million in profits.

Drawing on *Qualitex Co. v. Jacobson Products Co.*, where the Court held that the color of a product – a dry-cleaning pad – was protectable but not inherently distinctive, the court held that a similar rule applied to all product designs. Justice Scalia's opinion for the Court was clear and memorable in explaining why:

The attribution of inherent distinctiveness to certain cate-

21. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

22. *Id.*



Samara Brothers dress

gories of word marks and product packaging derives from the fact that the very purpose of attaching a particular word to a product, or encasing it in a distinctive packaging, is most often to identify the source of the product. Although the words and packaging can serve subsidiary functions – a suggestive word mark (such as “Tide” for laundry detergent), for instance, may invoke positive connotations in the consumer’s mind, and a garish form of packaging (such as Tide’s squat, brightly decorated plastic bottles for its liquid laundry detergent) may attract an otherwise indifferent consumer’s attention on a crowded store shelf – their predominant function remains source identification. Consumers are therefore predisposed to regard those symbols as indication of the producer, which is why such symbols almost automatically tell a customer that they refer to a brand, and immediately signal a brand or a product source. And where it is not reasonable to assume consumer predisposition to take an affixed word or packaging as indication of source – where, for example, the affixed word is descriptive of the product (“Tasty” bread) or of a geographic origin (“Georgia” peaches) – inherent distinctiveness will not be found. . . .

In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs – such as a cocktail shaker shaped like a penguin – is intended not to identify the source, but to render the product itself more useful or more appealing.

Remember: descriptiveness can be overcome on a showing of secondary meaning. If consumers actually perceive the fuzzy bear on a Samara Brothers dress as a designation of source, or the penguin-shaped cocktail maker as an indication of who made it, then it has acquired distinctiveness and is protectable.

## 2 Ornamentality

Just as some trademarks are potentially distinctive but not actually used as a mark – the failure-to-function doctrine applied in *In re Schmidt* to BOSTON STRONG T-shirts – some product design trade dress is not even used in a way that designates source. In such a case, the design is said to be *ornamental* and it does not create trademark rights. As the TTAB explained:

When evaluating a mark that appears to be ornamental, the size, location, dominance, and significance of the alleged mark as applied to the goods are all relevant factors in determining the commercial impression of the applied-for mark.

With respect to clothing, consumers may recognize small designs or discrete wording as trademarks, rather than



Tide bottle



Penguin-shaped cocktail shaker

as merely ornamental features, when located, for example, on the pocket or breast area of a shirt. Consumers may not, however, perceive larger designs or slogans as trademarks when such matter is prominently displayed across the front or back of a t-shirt. . . .

In this case, the submitted specimen shows the applied-for mark, “BOSTON STRONG”, located directly on applicant’s t-shirt goods in large lettering across the upper portion of one specimen and at the top and bottom of the second specimen, where ornamental elements often appear. Furthermore, the mark is displayed in a relatively large size on the clothing such that it dominates the overall appearance of the goods. Lastly, the applied-for mark is a slogan that, as provided in the failure to function refusal above, has no particular trademark significance.

Therefore, consumers would view the applied-for mark as a decorative or ornamental feature of the goods, rather than as a trademark to indicate the source of applicant’s goods and to distinguish them from others.<sup>23</sup>

Does this make sense? The *larger* the alleged mark, the *weaker* its trademark significance? (Hint: yes.)

### 3 Functionality

Section 2(e)(5) of the Lanham Act denies registration to any mark that “comprises any matter that, as a whole, is functional.”<sup>24</sup> This rule is most important for trade dress, and section 43(a) adds that in any suit for infringement of unregistered trade dress, the plaintiff “has the burden of proving that the matter sought to be protected is not functional.”<sup>25</sup> But what makes a mark “functional” for trademark purposes?

According to the Supreme Court, a product feature is functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” or it is one the “exclusive use of which would put competitors at a significant nonreputation-related disadvantage.”<sup>26</sup> Consider *Traffix Devices, Inc. v. Marketing Displays, Inc.*:

Temporary road signs with warnings like “Road Work Ahead” or “Left Shoulder Closed” must withstand strong gusts of wind. An inventor named Robert Sarkisian obtained two utility patents<sup>27</sup> for a mechanism built upon two springs (the dual-spring design) to keep these and other outdoor signs upright despite adverse wind conditions. The holder of the now-expired Sarkisian patents, respondent Marketing Displays, Inc. (MDI), established a successful business in the manufacture and sale of sign stands incorporating the patented feature. MDI’s stands for road signs were recognizable to buyers and users (it says) because the dual-spring design was visible near the base of the sign.<sup>28</sup>

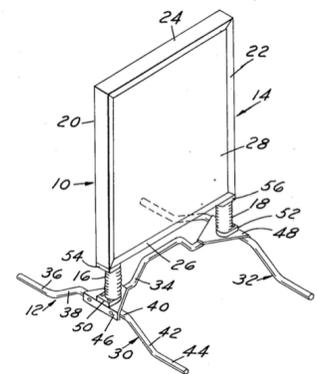
23. *In re Schmidt*, App. No. 85910031 (USPTO Office Action July 12, 2013).

24. Lanham Act § 2(e)(5)

25. Lanham act § 43(a)(3)

26. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

27. Nos. 3,646,696 and 3,662,482



Patented dual-spring design

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

MDI sold its stands under the trademark WINDMASTER. After the patents expired, a competitor, Traffix, reverse engineered MDI's dual-spring sign stands and sold its own under the mark WINDBUSTER. During the term of the patents, of course, they prevented Traffix from imitating the design of MDI's stands. But after their expiration, they provided "strong evidence that the features therein claimed are functional."<sup>29</sup> Indeed, they claimed the very feature of the stands – the dual-spring design – that MDI now claimed was a trademark. Justice Kennedy's opinion for the Court offered the following explanation of how the design, as described in the patent, affected both the quality and the cost of the stands:

The dual-spring design serves the important purpose of keeping the sign upright even in heavy wind conditions; and, as confirmed by the statements in the expired patents, it does so in a unique and useful manner. As the specification of one of the patents recites, prior art "devices, in practice, will topple under the force of a strong wind." The dual-spring design allows sign stands to resist toppling in strong winds. Using a dual-spring design rather than a single spring achieves important operational advantages. For example, the specifications of the patents note that the "use of a pair of springs as opposed to the use of a single spring to support the frame structure prevents canting or twisting of the sign around a vertical axis," and that, if not prevented, twisting "may cause damage to the spring structure and may result in tipping of the device." In the course of patent prosecution, it was said that "the use of a pair of spring connections as opposed to a single spring connection forms an important part of this combination" because it "forc[es] the sign frame to tip along the longitudinal axis of the elongated ground-engaging members." The dual-spring design affects the cost of the device as well; it was acknowledged that the device "could use three springs but this would unnecessarily increase the cost of the device."<sup>30</sup>

Note that the patents here were just evidence of functionality. Traffix could have shown all of these attributes directly, by describing the advantages of using two springs rather than one. MDI's expired utility patents were merely particularly compelling statements of these advantages, ones that MDI could not now deny. It was hoist on its own petard.

Importantly, once functionality was established that was the end of the matter. Functionality is not descriptiveness; it cannot be refused by a showing of secondary meaning. There is no need to inquire into how useful the feature is or what alternatives are available:

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



Traffix "Little Buster" sign with dual-spring base

29. *Id.*

30. *Id.*

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.

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. The dual-spring design assures the user the device will work. If buyers are assured the product serves its purpose by seeing the operative mechanism that in itself serves an important market need. It would be at cross-purposes to those objectives, and something of a paradox, were we to require the manufacturer to conceal the very item the user seeks.<sup>31</sup>

#### 4 Aesthetic Functionality

Most functional products are functional because they *do* something. MDI's dual-spring design was functional because it could stay upright in heavy winds. But some products have function that can only be carried out if they *look* a particular way. Thus, a subtle but important species of functionality is *aesthetic functionality*. As with ordinary functionality, the question is whether giving exclusive rights over the feature would put competitors at a significant non-reputation related disadvantage.

Consider two cases involving the color black. In *Brunswick Corp. v. British Seagull Ltd.*, the applicant tried to register the color black as used on outboard motors for boats.<sup>32</sup> The Federal Circuit held that there was a "competitive need" for other engine makers to be able to paint their own motors black:

The color black does not make the engines function better as engines. The paint on the external surface of an engine does not affect its mechanical purpose. Rather, the color black exhibits both color compatibility with a wide variety of boat colors and ability to make objects appear smaller.

And in *In re Florists' Transworld Delivery Inc.* The flower company FTD applied to register a mark for "flowers and live cut floral arrangements" that consisted of:

the color black as applied to a substantial portion of the outside surface of a box which serves as a container or packaging for the goods and in part forms a background to design and literal elements applied thereto.<sup>33</sup>

The TTAB held that this too was functional. Numerous florist websites referred to the importance of the color of flowers in a bouquet and its

31. *Id.*

32. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994).

33. *In re Florists' Transworld Delivery Inc.*, 106 U.S.P.Q.2d 1 (TTAB 2013).



Proposed mark



Specimen of use

packaging, e.g. red roses in a white box. Numerous websites also stated that black in connection with flowers connotes elegance or luxury.

In addition, the evidence reflects that black has significance on somber occasions such as in the context of death. . . . Black is the traditional sign of mourning; it is common knowledge that black clothing is traditionally worn at funerals. Flowers and floral displays play an important role in the context of funerals and mourning; flowers are ubiquitous at funerals and it is also common knowledge that flowers are commonly presented as an expression of condolence. With regard to floral packaging, black is an appropriate color for floral packaging, and is used as floral packaging in bereavement bouquets.<sup>34</sup>

Thus, competitors needed to be able to offer flowers in black boxes to "to offer flowers for bereavement purposes, Halloween or to imbue an element of elegance or luxury to their presentations through packaging therefor."<sup>35</sup> There was no legitimate trademark reason to allow FTD to monopolize the use of these signifiers simply because it was the first to put flowers in a black box and dream of keeping everyone else from doing the same.<sup>36</sup>

On the other hand, consider *Maker's Mark Distillery, Inc. v. Diageo North America, Inc.*, where a red dripping wax seal for liquor bottles was *not* aesthetically functional.<sup>37</sup> The plaintiff was Maker's Mark, which has sold bourbon in bottles with a red wax seal since 1958, and has held a trademark registration since 1985 for a "wax-like coating covering the cap of the bottle and trickling down the neck of the bottle in a freeform irregular pattern."<sup>38</sup> In the mid-1990s, Jose Cuervo created a 200th-anniversary tequila named Reserva de la Familia. It initially had a non-dripping red wax seal, but during the course of production it was altered because an executive "thought the uncut seal, with its drips, created a unique and artisanal look."

Cuervo argued that the dripping seal was aesthetically functional,<sup>39</sup> but the court disagreed:

None of Cuervo's witnesses convinced the Court that it would be difficult or costly for competitors to design around the red dripping wax trademark. Furthermore, red wax is not the only pleasing color of wax that competitors may employ on their product, nor does it put competitors at a significant non-reputation related disadvantage to be prevented from using red dripping wax. There are other ways of making a bottle look artisanal or unique. Therefore, the doctrine of aesthetic functionality is inapplicable here.<sup>40</sup>

## Problems

### Eames Chair

34. *Id.*

35. *Id.*

36. "The color is functional because it indicates the flavor of the ice cream, for example, pink signifies strawberry, white signifies vanilla, brown signifies chocolate, etc." *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197 (11th Cir. 2004). Is that right?

37. *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 703 F. Supp. 2d 671 (W.D Ky. 2010).

38. Note that the registration does not mention the color red. But during the course of the litigation, Maker's Mark narrowed its argument to assert protection only for a red dripping wax seal



Maker's Mark

This is the Eames Lounge Chair by Charles and Ray Eames. Is its design protectable?

### Pez Dispenser

Make yourself familiar, if you are not already, with PEZ dispensers. To what extent can Patrafico AG (the PEZ corporate parent) obtain intellectual-property protection in the appearance of PEZ dispensers? Can it protect the spring-loaded flip-top design? The number of candies in a pack? The fluted front and footed base of a dispenser? Does it matter what heads the PEZ dispensers have? Against what products and uses will these rights be effective?

### Model Car

You represent Schafer Software, creator of the hit *Out of Control* series of racing video games. Sterling normally pays car companies licensing fees to include their cars in the *Out of Control* games as part of the licensing agreement. Negotiations with Corley Motors have broken down over Corley's excessive licensing fee demands for its Corley Polecat – ten times higher than any other company is demanding per vehicle.

Marketing is desperate to include the Polecat in *Out of Control 2017* and has asked the development team to think of ways to include the Polecat without Corley's cooperation. They have suggested two ways of doing so. First, they could rent a Polecat and scan it with a high-resolution laser scanner that would generate an extremely detailed three-dimensional model. Second, it appears that digital copies of Corley's engineering diagrams for the Polecat have leaked onto car-enthusiast websites, where they have been available for months (with Corley's tacit acquiescence, it appears). The diagrams contain extremely detailed specifications for every part in the Polecat, as well as renderings showing a fully assembled Polecat from numerous angles. The developers believe that although both approaches would require significant work by Corley's 3D modeling artists, either approach would work for generating the files they would need to put the Polecat in *Out of Control 2017*.

Should Schafer proceed, and if so, how?



Cuervo Reserva

39. What about the argument that a wax seal is (utilitarian) functional because it protects the bottle and its cork from air, moisture, and contamination?
40. *Maker's Mark Distillery*, 703 F. Supp. 2d 671.



Eames Lounge Chair

