

Copyright Protection in the Furniture Industry

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Intellectual property ("IP") law offers the furniture designer the opportunity to carve out a unique niche in the marketplace. However, since the law protects non-functional design only, taking advantage of such legal protection requires conscious planning.

The purpose of this article is to provide the designer with some basic concepts to keep in mind during the design process should copyright protection be a goal. To make our discussion a bit easier to follow, we focus on a hypothetical design, titled "FH Design." FH Design is a bedroom dresser with an attached mirror, modeled in the epoch style with ornamental scrolls encircling the mirror, entwining leaf patterns edging the top of the dresser and drawer handles etched with floral motifs. The dresser section itself is unconventionally short, rising only three feet from the ground. The entirety of the dresser and mirror is painted with a forest green lacquer.

Copyright Concepts Important to the Design Process

Copyright protects "original works of authorship fixed in any tangible medium of expression, now known or later developed." The term "original" actually encompasses two different concepts, independent creation, meaning the work is the original work of the designer, and creativity. For copyright purposes, the degree of creativity necessary to qualify for protection is very low, having been described as "modest," "minimal," and "very slight." Despite this low threshold, standard or stock designs common to the furniture industry may not be protectable because they are neither independently created nor sufficiently creative. However, an *original combination* of such stock and/or public domain designs may be protected as a "compilation." A compilation copyright protects the original selection and arrangement of the elements contained in the work, but does not protect the individual elements themselves. In either case, the initial focus is on the concept of "originality." If a design is not at least somewhat original, it will not be protected.

Establishing the originality of a design is not the only barrier facing the furniture designer. Since furniture serves a primarily utilitarian function, the court will also question whether the design can be identified separately from, and is capable of existing independently of, the utilitarian (functional) aspects of the piece of furniture. To put it another way, does the design reflect the designer's artistic judgment exercised independently of functional influences? This concept, referred to as "conceptual separability," is often the most significant issue in copyright infringement actions involving furniture design. If design and utility are

inseparable, copyright protection is unavailable.

In the case of the FH Design, the focus must be on protecting the artistic elements of the design that are capable of existing separate and apart from the dresser itself. The designer might focus on establishing rights in a compilation of elements, including the ornamental scrolls encircling the mirror, the entwining leaf patterns edging the top of the dresser, and the drawer handles etched with floral motifs.

Recent Developments in Copyright Law Relating to Furniture Design

The rulings in some recent cases indicate that copyright protection for original arrangements of standard designs may be getting more difficult, requiring designers to approach the design process with a heightened sensitivity to the evolving state of copyright law. Many courts have shifted the focus of their analysis from the originality of the design to its utility. If a designer is required, as it has been held, to show two separate stages of design—e.g., first, shaping the skeleton of a dresser, and second, adorning it with ornamental designs—she may need to modify her approach to documenting the design process. For example, the designer may wish to keep records of the design process that document work on the utilitarian aspects of the piece separately from work on the ornamental/artistic embellishment features. Such an approach may enhance a designer's ability to later prove that a design is original from the standpoint of both creativity and independent creation.

Moreover, judges are increasingly hesitant to find protection for the rearrangement or reimagining of common or stock design elements, which could have negative implications to copyright protection within the furniture design industry. For example, a federal district court judge refused to grant copyright protection for a rug designer's creative arrangement of design elements of a well-known antique kilim rug design on the grounds that it was not sufficiently original. Considering the prevalence of reused and re-imagined design elements within the furniture industry, the rejection of standard, stock, or common elements, regardless of their creative arrangement, could have seriously negative implications to copyright protection within the industry.

Copyright Registration and Infringement Damages

All of the designer's work to create a copyrightable design can go to waste if she later ignores the nuts and bolts of registering and protecting that copyright. Early copyright registration with the United States Copyright Office is critical for several reasons.

First, a United States citizen cannot bring a legal action for copyright infringement without a copyright registration covering the infringed work. In most cases, an application alone will not do the trick, and the standard turnaround time between filing an application and receiving a registration certificate can be eight months or longer. While expedited registration is available in the face of an infringement situation, the cost is much greater. The regular cost to electronically register a claim to copyright is only \$35, whereas filing an expedited registration requires payment of the regular electronic filing fee of \$35 *plus* a special handling flat fee that is currently \$760.

Second, the Copyright Act of 1976 provides for alternative damages, known as "statutory damages." Statutory damages are only available if the copyright in question was registered prior to the commencement of the infringement. A copyright owner can elect to pursue statutory damages in lieu of actual damages and may choose to do so for one of several reasons. The most common reason for electing statutory damages is to avoid having to prove actual damages (i.e., actual lost sales or the infringer's profits), which can be quite difficult to establish. Moreover, statutory damages can be significant, ranging from \$750 to \$30,000 per infringed work. The court, in its discretion, can also award increased damages of up to \$150,000 per work where the infringement is found to be willful.

Of course, if actual damages are high and easy to prove, a successful plaintiff can always forgo statutory damages and elect to receive actual damages. For example, in an extraordinary damages award in February 2009, a North Carolina district court awarded the plaintiff all of the defendant's gross profits, totaling \$11,225,777.18, due to the fact that the defendant was unable or unwilling to produce any reliable method of deducting costs and the uncertain veracity of the defendant's reported quantity of infringing products sold.

Moreover, as long as the copyright registration is obtained prior to the occurrence of the act(s) of infringement, the successful plaintiff is entitled to recover its costs and reasonable attorneys' fees. Since the cost to pursue a copyright infringement action can be very high, this award of attorneys' fees may be significant to both the decision to pursue an action and the achievement of a favorable result.

Finally, the copyright holder can also seek preliminary and/or permanent injunctive relief to stop the infringing activity and, perhaps, obtain a court order to have the infringing products recalled and destroyed.

Practical Tips

In view of the legal landscape, here are a few practical tips on which the designer can focus:

1. While combinations of public domain elements may be protected, original designs are far more likely to receive favorable treatment in court;
2. Always keep in mind the concept of "conceptual separability" by focusing on nonfunctional artistic flourishes as distinct from utilitarian function. When in doubt, it might be better to work backwards from an artistic element that interferes with function as opposed to attempting to make the functional non-functional;
3. Keep a record of your sources of inspiration. These prior works may help in proving the originality of your own design;
4. Keep a record of your design development to show the creative process;
5. Maintain good financial records regarding the design process, manufacturing costs, and sales statistics. This will allow you to prove your damages and put you in the best position to choose between statutory or actual damages; and
6. Consider early registration of your copyrightable work to ensure the strongest protection for your design.

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