

## Copyright Advisory

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# Copyright and Product Design: A Review of the “Useful Article” Doctrine

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As part of Mintz Levin’s continuing Intellectual Property series on the practical applications of copyright, trademark, and patent law, this article provides an overview of the copyrightability of certain objects that may not intuitively seem copyrightable, so-called “useful articles.” The following discussion may be particularly helpful for our clients in fashion, software, manufacturing, and industrial design.

A threshold requirement for a work to be “copyrightable” is that it must be an “original work of authorship,”<sup>1</sup> which is to say it must be original and creative. To be “original” and “creative” in the context of copyright law, a work must be independently created by the author (rather than copied from some other work). This is a relatively low standard to meet and is very easily applied to creative works of artistic expression such as musical compositions, motion pictures, photographs, and literary works. In those cases, the question of copyrightability is generally straightforward since these are works of pure artistic expression, valued primarily for their original creative or communicative content. The more difficult, and for certain businesses certainly the more valuable, question is when and to what extent is a work copyrightable when it is embodied in or intertwined with an object which itself is not intrinsically artistic or communicative? For example, how does an industrial or fashion designer make sure, when designing a new product, that he or she obtains the maximum amount of intellectual property protection possible on an economically efficient basis? What cost-effective modifications can be made during the design phase of a piece of business software or a new home appliance to help obtain copyright protection where it might not otherwise be obtainable? As the recession’s effects continue to linger, this concept takes on greater meaning as many businesses become more aggressive in copying a competitor’s goods. A small investment during the design phase of a new product, by adding the right artistic elements to the product, may result in enhanced intellectual property protection and may help dissuade copycat competitors.

## Artistic vs. Functional Designs

There is a dichotomy in copyright law between works that are purely original and purely artistic (and thus generally copyrightable), and those that may embody a pictorial, graphic, or sculptural element but are essentially utilitarian or functional in nature (and are not themselves copyrightable). The latter are referred to as “useful articles” and have been defined by statute as those goods “having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>2</sup> For example, while the design of a piece of luggage is purely functional (a useful article) and not copyrightable, the addition of certain ornamental, artistic elements to the design may make those parts of that luggage “artistic” and thus copyrightable. If enough of those ornamental elements are present, then the compilation of those extra elements may be copyrightable. If used properly, those copyrightable elements can distinguish the appearance of that luggage sufficiently so that a third party attempting to copy and sell its own version of the luggage may infringe upon the original designer’s copyright in the luggage.

The problem, of course, is determining when a design element on a useful article is “ornamental” (and potentially copyrightable) and when is it merely functional to and inherent in the article itself (and not copyrightable). To understand the proper analysis, a quick review of a recent decision in the Fourth Circuit involving a furniture designer and a competitor will help.<sup>3</sup> In that case, the copyright owner was a designer and importer of furniture for which it had obtained copyright registrations for the “decorative sculptural designs on [the] furniture.” These designs included decorative scrollwork, knobs, beading, carvings, *etc.*, which were engraved into the furniture but did NOT include the design of the underlying furniture itself. The infringer began selling its own furniture incorporating these exact designs (the furniture design as well as all the ornamental elements) and argued that since the ornamental elements were embodied in the furniture (a useful article) the copyrights were invalid and unenforceable. The standard used by the court to decide this issue involved an analysis of whether the ornamental elements of a useful article (whether pictorial, graphic, or sculptural) can be conceptualized as existing “independently” of the utilitarian functions of the underlying product.<sup>4</sup> The test is referred to as the “separability” test and generally requires a finding that the claimed ornamental elements exist *solely* as a result of artistic desires and are independent of the function of the product itself. This means that if the element fulfills the basic function of the object (*e.g.*, the shape of a chair), then no matter how aesthetically pleasing that element may be, it is not a separate ornamental artistic element and, thus, is not copyrightable.

Sophisticated designers have been able to build copyright protection into products that may not otherwise easily lend themselves to such protection (whether under copyright, design patent, unfair competition, or trademark/trade dress theories) by designing the product to include copyrightable ornamentation not necessary to the basic function of the object. For example, while the shape or form of a table lamp is not generally copyrightable, a lamp that incorporated a ceramic statuette as its base, not necessary to the function of the lamp, was found to be copyrightable. This added design element thus prevents unauthorized parties from making and selling copies of that lamp and, very likely, copies of the statue as well.<sup>5</sup> Conversely, in a case involving unauthorized copies of clothing mannequins, it was held that there were no “artistic or aesthetic features” that were “physically or conceptually separable from [the mannequins’] utilitarian dimension,” and thus the mannequins were not copyrightable.<sup>6</sup> In the furniture example above, the court held that because the ornamentation on the furniture was not as much for the utilitarian purposes inherent in a bed, a dresser, or a nightstand as much as for the aesthetic choices of the designer, those aesthetic elements were copyrightable and thus the defendant had infringed by copying the furniture.

## “Conceptual Separability” vs. “Physical Separability”

It is important to note that the idea of “conceptual separability” should be distinguished from and is not synonymous with “physical separability.” As in the furniture example, even though the artistic elements would be nonsensical if physically separated from the product (*e.g.*, they would be a meaningless collection of random decorative finials and wooden scrollwork), they can be separated conceptually from the basic function of the underlying article (*e.g.*, a bed). Thus, because they were not **essential** to the basic function of the bed, that was sufficient for them to be copyrightable. Similarly, physical separability can in some cases be sufficient (although not necessary) for copyrightability. To illustrate, the ceramic statuette embodied in the lamp discussed above could easily have been physically separated and used as a sculpture. Accordingly, even if the design of the underlying article itself is not copyrightable, and the ornamental aspects are not physically capable of being separated, as long as it can be conceptually separated, the design elements may still be protected by copyright from the underlying product.

## Creating Value in “Useful Articles”

Through creative planning and design, even a work not purely artistic in nature may be made more unique and protectable by including ornamental or artistic elements. This creates not only a barrier to competing goods but also constitutes a cost-effective way of adding value to and distinguishing what might otherwise be a fungible product in the market. Although copyright protection would only be available for the original ornamentation on or embodied in such an article and **not** for the functional design of the underlying article itself (in certain cases that underlying design might also qualify for design patent or trademark/trade dress protection), that protection alone

may enhance the desirability of the product to consumers, and thus add value to the copyright owner. For example, every year hundreds of fashion designers create thousands of new designs for everything from handbags to evening dresses to men's suits. Some of those designs are instantly copied by third parties since the designers cannot claim that the cut, style, or design of the underlying clothing is sufficiently nonfunctional to qualify for copyright protection (because the clothing designs themselves are useful articles).<sup>7</sup> However, in an effort to protect the value of their designs and investments, this industry has adapted to this limitation by claiming successfully that the designs printed **on** the fabric itself are subject to copyright protection. This gives the copyright fashion designer leverage to pursue copies of the designs on the basis that the design on the fabric itself infringes the designer's copyright. This theory is helpful even if the design on the fabric is not capable of functioning as a trademark on its own. By incorporating original patterns and designs on the goods themselves (e.g., the repeating pattern of the Louis Vuitton "LV" logo on handbags), some designers have been very successful in preventing unauthorized third party copies.<sup>8</sup>

Determining whether useful articles contain sufficient nonfunctional elements to qualify for copyright protection is a very fact-specific inquiry. This overview of the doctrine is not intended to be a complete recitation of its every nuance, but, rather, a chance to become familiar with another cost-effective way to "design in" intellectual property protection. Every situation should be evaluated based on its own facts and circumstances. Therefore, when contemplating business decisions involving any of the issues discussed herein, it is best to consult first with one of Mintz Levin's copyright specialists, listed in the link below.

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#### Endnotes

- <sup>1</sup> 17 U.S.C. §102[a].
- <sup>2</sup> 17 U.S.C. §101.
- <sup>3</sup> *Universal Furniture International Inc. v. Collezione Europa USA Inc.*, 4<sup>th</sup> Cir., No. 07-2180, August 20, 2010.
- <sup>4</sup> *Pivot Point Int'l, Inc. v. Charlene Prods.*, 372 F.3d 913 (7th Cir. 2004).
- <sup>5</sup> *Mazer v. Stein*, 347 U.S. 201 (1954).
- <sup>6</sup> *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir.1985).
- <sup>7</sup> This may be changing, however, as a Senate bill has just been introduced, entitled the Innovative Design Protection and Piracy Prevention Act, which, if eventually enacted, would offer certain additional protections to qualifying fashion designs.
- <sup>8</sup> This strategy should not be confused with those available to pursue counterfeiters who are attempting to pass off fake goods as the original. More directed and effective remedies are in place for such cases.

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