

Copyright protection for designs of useful articles

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Copyright protection for certain elements of useful articles can be obtained under the Copyright Act. For example, the US Court of Appeals for the Sixth Circuit recently held in *Varsity Brands v Star Athletica* that the graphic designs and features on cheerleading uniforms were protected. However, the scope of protection depends on the details of each case, as the copyrightable elements must be separable and capable of existing independently of the utilitarian aspects of the useful article in question.

The act provides protection for pictorial, graphic and sculptural works which 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". It further 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."

A 'useful article' is defined as one having an "intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information". Under this definition, a lamp is a useful article, whereas a painting is not.

Separability exists when elements are either physically or conceptually separable from the article on which they appear. The Copyright Office uses the following standard to determine whether physical separability exists:

"The physical separability test derives from the principle that a copyrightable work which is later incorporated into a useful article retains its copyright protection. Examples of works meeting the physical separability test include a sculptured lamp base of a Balinese dancer, or a pencil sharpener shaped like an antique car. However, since the overall shape of a useful article is not copyrightable, the test of physical separability is not met by the mere fact that the housing of a useful article is detachable from the working parts of the article. The Copyright Office determines conceptual separability under the following standard:

Conceptual separability means that the pictorial, graphic or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work independent of the useful article, i.e., the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works – one an artistic work and the other a useful article."

Courts and scholars have devised a variety of approaches for determining when the artistic and utilitarian aspects of useful articles are conceptually separable, including whether:

- the artistic features are "primary" and the utilitarian features "subsidiary";
- the artistic features are marketable separate and apart from the useful article;
- the article causes the viewer to imagine a concept that is separate from the concept evoked by its utilitarian function; and
- the artistic design was not significantly influenced by functional considerations.

Under the above tests, courts have found certain sculptural elements of mannequins used by cosmetology students, belt buckles and furniture conceptually separable from the products' useful functions and therefore copyrightable, but have also determined that the design elements of a bike rack were not conceptually separable because they were driven by utilitarian pressures – "the form and function were inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices".

The separability of dress and other clothing designs has generated considerable litigation. Designs of clothing



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(ie, the shape, style, cut and dimensions of these items) have generally been considered by the courts not to be physically or conceptually separable from the utilitarian aspects of the clothing. A recent court decision held that the "shapes of the neckline (v-neck, square-neck, crew-neck), sleeves (short, long, puffy), or pockets (patch, welt, jetted) – these are the components of a design that are inextricably connected with the utilitarian aspects of clothing". The foregoing are considered to be unprotectable designs of clothing. On the other hand, certain designs on clothing may be protected (eg, the arrangement of stripes, chevrons, color blocks and zigzags on cheerleading uniforms – as found in *Varsity Brands* – a Halloween costume, a multicoloured striped sweater with puffy leaf appliques, a sweater which has a squirrel and leaves applied onto its multi-panelled front, the design of a rose repeated in horizontal rows on the surface of fabric and a variety of graphic designs placed on clothing or fabric).

As the case law demonstrates, while the scope of coverage is very fact specific, copyright protection may be obtained for some design elements on a useful article. Designers and manufacturers should carefully review their utilitarian product offerings to determine whether copyright protection should be sought.

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