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Articles

**THE DUBIOUS LEGAL RATIONALE FOR DENYING COPYRIGHT TO FASHION**

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**I. Introduction**

The Copyright Office’s view, and the conventional wisdom, has long been that clothing design is uncopyrightable.<sup>1</sup> Accordingly, the creative segment of the fashion industry has long pressed for an amendment to the Copyright Act or for sui generis protection.<sup>2</sup> The latest bill, the Innovative Design Protection and Piracy Prevention Act, is modest enough to stand a fighting chance at passage.<sup>3</sup> Its \*90 protection is short: 3 years,<sup>4</sup> as opposed to the regular copyright term of life of the author plus 70 years.<sup>5</sup> Its protection is also thin: to infringe P’s clothing design, D’s clothing design must be “substantially identical,” meaning “so similar in appearance as to be likely to be mistaken for” P’s clothing design.<sup>6</sup> In other words, D’s design must be a near counterfeit, not merely “substantially similar” to a portion of P’s design.<sup>7</sup>

Opponents of the bill might want to reconsider. The official rationale for denying copyright to clothing, that a garment is a “useful article” whose aesthetic features are inseparable from its utilitarian function,<sup>8</sup> is unsound and thus may give way in time, especially if the bill fails. That is, if the bill fails, and if clothing designers appeal registration denials by the Copyright Office or file declaratory judgments to compel the Office to stop classifying clothing as per se uncopyrightable, and if the designers ask the appellate courts to squarely confront the issue on its substantive merits, the courts may eventually hold that fanciful clothing is protectable under regular copyright.

If 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.<sup>9</sup> The compelling policy reason is that clothing design needs protection more than in the

past, because clothing designs can now be copied so easily that the copies sometimes hit the shelves before the originals.<sup>10</sup>

## **\*91 II. Signs That the Uncopyrightability of Clothing Rests on Shaky Ground**

Fanciful clothing is protected in Europe and Japan.<sup>11</sup> Why is the United States an exception? The official U.S. rationale for denying copyright to clothing is that a garment is a “useful article” whose aesthetic features are inseparable from its utilitarian function.<sup>12</sup> Apparently, this rationale applies even if the utilitarian function is subsidiary or even mere pretext. Presumably, for example, the Copyright Office would rely on this rationale to reject registration of lingerie, ties, and warm weather scarves.

Meanwhile, copyright clearly protects other types of works--such as computer code, blueprints, and technical manuals--that seem wholly utilitarian and devoid of aesthetic features. Why does copyright protect works that seem wholly utilitarian and devoid of aesthetic features, while refusing to protect fanciful clothing on the ground that its aesthetic features are inseparable from its subsidiary utilitarian function? And why is copyright more willing to protect fanciful costumes<sup>13</sup> that serve the same subsidiary utilitarian function that fanciful clothing serves?<sup>14</sup> Why are the aesthetic features of fanciful costumes more likely to be deemed separable?

Also puzzling is that the uncopyrightability of clothing is largely inconsistent with its protectability under design patent. It has long been said that clothing is \*92 protectable under design patent.<sup>15</sup> Yet a work that is able to satisfy the standards for protection under design patent--new, non-obvious, original, ornamental,<sup>16</sup> and non-functional<sup>17</sup>-- would seem to be even more able to satisfy the somewhat lower standard for protection under copyright.

Another curiosity is that there is some sloppiness in citations to authority for the proposition that clothing is uncopyrightable. An older case cited for the proposition is *Fashion Originators Guild of America v. Federal Trade Commission*.<sup>18</sup> In this case, P never tried to register its dress designs because P knew the Copyright Office would reject them.<sup>19</sup> The legal question was whether P had surrendered common law property rights in the designs when P published them; P argued that publication should not be deemed a surrender given that P could not register them with the Copyright Office.<sup>20</sup>

Judge Hand held that “regardless of whether the Guild’s designs could be registered or not, ‘publication’ of them was a surrender of all its ‘common-law property’ in them.”<sup>21</sup> He also remarked that “[1] until the copyright law is changed, or [2] until the Copyright Office can be induced to register such designs as copyrightable under the existing statute,” designs fall into the public domain when published.<sup>22</sup> To cite this case as support for the proposition that clothing is uncopyrightable is not only to cite dicta but also to latch onto dicta [1] while ignoring dicta [2].

Another case cited for the proposition that clothing is uncopyrightable is *Whimsicality, Inc. v. Rubie’s Costume Co, Inc.*<sup>23</sup> P registered its costume designs \*93 as “soft sculptures,” apparently because P knew the Office would be more likely to reject them were they designated as costumes.<sup>24</sup> The court in *Whimsicality* held that P had misled the Office and declined “to reach the issue of copyrightability, since proper registration is a prerequisite to an action for infringement.”<sup>25</sup> In passing, however, the court cited to *Fashion Originators* for the proposition that clothing is uncopyrightable and remarked that clothing is “particularly unlikely to meet” the separability test because the decorative elements of clothing are “intrinsic to the decorative function of the clothing.”<sup>26</sup>

That remark is dicta.<sup>27</sup> In any event, separability from “decorative function” is not the correct standard. Apparently, the *Whimsicality* court equates decorative function with utilitarian function.<sup>28</sup> Equating them cannot be right because, if decorative function equals utilitarian function, and if decorative elements are intrinsic to decorative/utilitarian function, then no decorative elements of any useful article could ever be protected. Yet they are. For instance, the decorative elements of the sinuous belt buckle in *Kieselstein-Cord v. Accessories by Pearl, Inc.* were protected even though those elements are intrinsically inseparable from the buckle’s decorative function.<sup>29</sup>

## **III. Only Through Caprice Can the Useful Article Doctrine Bar Copyright for Fanciful Clothing**

In an attempt to codify the useful article doctrine,<sup>30</sup> the 1976 Act defines a “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>31</sup> Thereafter, “useful article” appears only in the Act’s definition of pictorial, graphic and sculptural (PGS) works, which states that the design of a

useful article is protectable “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>32</sup> This is \*94 the so-called separability requirement.

The Copyright Office denies registration to clothing on the grounds that it is a useful article and a PGS work and that it fails the separability requirement.<sup>33</sup> A literal interpretation of the separability requirement is improper,<sup>34</sup> indeed unworkable. Accordingly, the separability requirement has spawned widespread confusion<sup>35</sup> and ten or so different tests.<sup>36</sup> Notably, most of these tests do not directly address the question of whether the work’s expressive features are separately identifiable and capable of existing independently.<sup>37</sup>

The separability requirement should be interpreted to serve the original purpose of the useful article doctrine. So interpreted, it becomes clear, as explained later in Part III(B), that separability itself is irrelevant, that separability is really \*95 shorthand for replaceability, and that some articles of fanciful clothing pass the requirement with flying colors.

### **A. Why the Act Discriminates Against Useful Articles**

What motivated the drafters of the 1976 Act to impose scrutiny on the subclass of works called useful articles? The short answer is that these works are often highly constrained. Consider some examples of useful articles that have been registered with the Copyright Office: belt buckles, bike racks, mannequins, flying toys, ashtrays, lamps, lighting fixtures, furniture, dinnerware, salt and pepper shakers, candle holders, book ends, clocks, door knockers, inkstands, chandeliers, piggy banks, sundials, and fish bowls.<sup>38</sup> Note that each of these works is three-dimensional and that each achieves a mechanical function. Such works are often highly constrained by the mechanical principles necessary to achieve the function.<sup>39</sup> Most fish bowls, for instance, are designed to contain water and fish and include little design extraneous to achieving that function.

The term “utilitarian,” as used in the definition of useful articles and PGS works, essentially means “mechanical.” It does not mean having utility. Every type of copyrightable work has utility. The entertainment, diversion, and enlightenment provided by movies, music, and books are utilities. Moreover, some works that fall outside either the PGS category or the definition of a useful article seem wholly utilitarian in the lay sense of “utilitarian.” Consider computer code<sup>40</sup> and technical manuals, which fall into the literary work category. Or, consider blueprints and maps, which merely convey information and thus do not qualify as useful articles under the Act’s definition of useful articles.

Why did the drafters artificially define a useful article so that a work does not qualify as a useful article if it merely conveys information or portrays its own appearance? They were trying to draw a line between constrained and unconstrained works. A work that merely conveys information or portrays its own appearance is often relatively unconstrained. There tend to be many alternative ways to convey information about and portray the appearance of any given thing, and there are also many different things in the world to convey information about and portray.

### **B. Separability Is Irrelevant**

What were the drafters trying to get at with the separability requirement? \*96 They were trying to draw another line between constrained and unconstrained works. The problem is that separability is a metaphor. Replaceability would have been a better choice. Specifically, it would have been better if the Act stated that protection extends only to those three-dimensional features of the work that can be replaced with different three-dimensional features without undermining the work’s mechanical function. When a work is heavily constrained throughout, there are few viable alternatives to its features and it is thus hard to imagine replacing its features with different features. For example, it is hard to imagine replacing the three-dimensional features of a bowling ball and still end up with a useable bowling ball. In contrast, we can imagine replacing some of the three-dimensional features of an embellished, sinuous belt buckle<sup>41</sup> and still end up with a useable belt buckle. Likewise, we can imagine replacing some of the three-dimensional features of a very distinctive mannequin head<sup>42</sup> and still end up with a useable mannequin head.

When talking loosely, we might say that while the features of the bowling ball are inseparable from its function, the expressive features of the belt buckle and the mannequin head are separable from their functions. Yet, that kind of talk is misleading because to separate expressive features is to remove them, and to remove them is to destroy them whenever they are even partially integrated into the work’s structure, which they usually are. Also, to remove them--without replacing

them--is to undermine the work's mechanical function whenever, again, they are even partially integrated into the work's structure.

What, for example, are we left with if we simply remove the sinuous contours of the buckle protected in *Kieselstein*? The court rejected D's argument that the buckle's expressive features were inseparable from its utilitarian function.<sup>43</sup> Yet, photographs of P's buckle<sup>44</sup> indicate that its sinuous contours are integrated with its main structure. How can we isolate and remove the sinuous contours and imagine them existing independently of the work? And if we remove them without replacing them with other contours, how can we avoid destroying the buckle's buckling function?

Likewise, what are we left with if we simply remove the distinctive features of the mannequin head protected in *Pivot Point v. Charlene*?<sup>45</sup> The head, created by an artist, was used by beauty schools to teach make-up application.<sup>46</sup> It had a lean, angular look with an upturned nose and almond-shaped eyes; it also had an inadvertent double hairline.<sup>47</sup> The court rejected D's argument that the head's **\*97** distinctive features were inseparable from its utilitarian function as a teaching prop. Yet, it is hard to imagine isolating and removing those features (e.g., the upturned-ness of the nose or the double-ness of the hairline) and even harder to imagine them existing independently. And if we remove them without replacing them, we are left with a useless "egg on a stick."<sup>48</sup>

Notably, the court in *Pivot Point* emphasized that a variety of mannequin heads could serve as props for teaching make-up application.<sup>49</sup> The number of viable alternatives--in a word, replaceability--is a key theme that pops up frequently not only in cases involving three-dimensional works that may be constrained by mechanical principles,<sup>50</sup> but also in cases involving works that may be constrained by other things.<sup>51</sup> Ultimately, there is nothing special about the useful article doctrine, properly understood. It serves the same basic purpose that the other limiting doctrines serve.<sup>52</sup> Indeed, it is likely that at bottom there is only one limiting doctrine, and that the plurality we see is simply a reflection of the labels we assign to the various types of situations in which the one limiting doctrine kicks in.

### **\*98 C. Extra Discrimination Against Clothing**

Clothing is three-dimensional, which raises a red flag that it could be constrained by mechanical principles. It is in fact constrained by mechanical principles insofar as it must suit the body. Yet that constraint is not enough to render all clothing too constrained for copyright. A highly fanciful garment has numerous viable alternatives and very replaceable features. One need only go to Google Images and type "unique clothing" or "unique fashion" to see the extreme diversity.

In any event, highly fanciful garments are much less constrained than many works already protected under copyright. Though some variety of mannequin heads, for instance, could serve as props for make-up application, the majority will for business and pedagogical reasons resemble youngish females of the majority race with features that are symmetrical and roughly average in their proportions. To be sure, there is space within this majority for some distinguishable alternatives, but the number and range of alternatives available in that space pale next to clothing.

Some other examples of three-dimensional works that seem more constrained than fanciful clothing but that have been held protected or protectable include Barbie dolls,<sup>53</sup> realistic taxidermy mannequins,<sup>54</sup> a toy flying saucer,<sup>55</sup> a model airplane,<sup>56</sup> sling-launched flying toys,<sup>57</sup> and a pin that resembles a real bee.<sup>58</sup> Aren't these works more constrained, less expressive, less artistic and less creative than a large fraction of the garments that appear on the catwalks and in the windows of Soho shops?

*Galiano v. Harrah's Operating Company*<sup>59</sup> appears to be the only case in which a U.S. appellate court attempted to squarely tackle the substantive issue of clothing's copyrightability. The court adopted a demanding test. Specifically, the court adopted a "likelihood-of-marketability standard for garment design only,"<sup>60</sup> which is satisfied only if the artistic qualities of P's garment design are so paramount that the design is marketable as an artistic work independent of its **\*99** utilitarian use.<sup>61</sup> Having adopted this standard, the court held P's "very creative"<sup>62</sup> casino uniforms uncopyrightable because P had not shown that they were marketable as artistic works independent of their use as wearable uniforms.<sup>63</sup> Were this standard followed by other circuits, almost no clothing would be copyrightable.

Why did the *Galiano* court adopt such a high standard and apply it only to clothing? Why treat clothing so differently?

### **D. Possible Reasons for the Extra Discrimination Against Clothing**

One proposed rationale for denying protection to clothing is that protection would actually hurt the fashion industry. Kal Raustiala and Christopher Sprigman argue that piracy accelerates fashion trends and thereby fuels status-seeking arms races among consumers that continually spur demand for new designs--the "piracy paradox."<sup>64</sup> Given that the piracy paradox is counter-intuitive and that it is belied by the fact that clothing is protected in other developed countries, it is unlikely to actually account for the longstanding absence of protection for clothing in the U.S. In any event, the piracy paradox is normatively weak because it ignores the welfare of fashion consumers. That is, even if Raustiala and Sprigman are right that piracy helps the fashion industry (which is questionable), it does so at the expense of consumers because, overall, status-seeking arms races tend to be bad for those engaged in them.<sup>65</sup>

Inertia is an alternative reason for the lack of protection. The Copyright Office's position on clothing emerged when copyright protected fewer types of works.<sup>66</sup> If most clothing then was more about practical function (durability and suitability to natural climate) than about individual expression, it would have seemed more reasonable then to regard clothing as too uncreative for copyright. **\*100** Perhaps also it was not so clearly in U.S. interests to protect clothing if the claims are true that the U.S. then was more a haven for piracy of European designs than a producer of original designs.<sup>67</sup>

Fear of unmeritorious lawsuits is another likely reason.<sup>68</sup> This fear stems in part from the concern that many registered clothing designs would themselves be copies (conscious and unconscious) of pre-existing designs.<sup>69</sup> This concern rests, I think, on the widespread belief that copyright has no novelty requirement. If P's work need not be novel, then D cannot beat P's suit merely by pointing out that the design predates P. How would D prove that P copied the prior design?

Though valid, this concern seems largely unwarranted in light of the experience of countries that protect clothing.<sup>70</sup> In any event, in practice copyright has a de facto, probabilistic novelty requirement in that courts end up applying the originality requirement, the limiting doctrines, and the infringement standard to limit protection only to those works unconstrained enough that they are very likely to be novel.<sup>71</sup> Hence, if P's clothing design lacks novelty, the court is very likely to find some way to avoid awarding damages against D.

Fear of unmeritorious lawsuits also stems in part from concern that many defendants accused of copying would be innocent of it.<sup>72</sup> A premise behind this concern is that copyright protects works that could be independently created by others. In practice, however, the originality requirement, the limiting doctrines, and the infringement standard also limit protection only to those works that are **\*101** unconstrained enough that they are unlikely to be independently created.<sup>73</sup> That is, if P's clothing design seems like a work that someone else could independently create, the court is likely to find some way to avoid awarding damages against D. In any event, D may be able to prove a defense of independent creation.

#### IV. Conclusion

The drafters of the 1976 Act botched their attempt to codify the useful article doctrine. Separability is irrelevant. What matters is whether the work has unconstrained features. Many PGS works that qualify as useful articles are heavily constrained by mechanical principles. Fanciful clothing is not. Indeed, it seems to be the least constrained type of useful article; yet, in the U.S. it is treated as if it were the most constrained. What best accounts for the double standard against clothing is unclear. But a double standard this glaring is likely to wither in time, especially if technology continues to make it easier to copy clothing designs quickly enough that designers cannot recover their investment before their designs go out of style.

#### Footnotes

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<sup>1</sup> See United States Copyright Office, Rules and Regulations for the Registration of Claims to Copyright 12(g) (1917), available at <https://play.google.com/store/books/?id=jsMHScI7REcC> (listing "garments" among works that should not be registered); Registrability of Costume Designs, 56 Fed. Reg. 56,530 (Nov. 5, 1991) (codified at 37 C.F.R. §202.3) [hereinafter Costume Designs] ("Garment designs... will not be registered even if they contain ornamental features....").

- <sup>2</sup> The first major attempt was the design bill of 1914, also called the Kahn Bill. See Susan Scafidi, Intellectual Property and Fashion Design, in 1 Intellectual Property and Information Wealth 115, 118-21 (Peter K. Yu ed., 2006), available at [www.counterfeitchic.com/Images/IP\\_and\\_Fashion\\_Design\\_chapter\\_scan.pdf](http://www.counterfeitchic.com/Images/IP_and_Fashion_Design_chapter_scan.pdf) (summarizing history of fashion industry efforts to obtain protection for fashion design).
- <sup>3</sup> In December 2010, the Senate version, S. 3728, was approved unanimously by the Senate Judiciary Committee. In August 2011, the House version, H.R. 2511, was referred to the House Subcommittee on Intellectual Property Competition and the Internet. See generally Aya Eguchi, Curtailing Copycat Couture: The Merits of the Innovative Design Protection and Piracy Prevention Act and a Licensing Scheme for the Fashion Industry, 97 Cornell L. Rev. 131 (2011) (arguing for passage of the bill).
- <sup>4</sup> Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. §2(d)(a)(2) (2011), available at <http://thomas.loc.gov/cgi-bin/query/z?c112:H.R.2511>.
- <sup>5</sup> 17 U.S.C. §302 (2006).
- <sup>6</sup> H.R. 2511, §2(a)(10).
- <sup>7</sup> To qualify for protection, P’s clothing design must not only be original but also “provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs.” Id. §2(a)(7)(B)(ii). The conventional wisdom is that this hurdle is much higher than the hurdle for regular copyright. See, e.g., Kal Raustiala & Chris Sprigman, Copyrighting Fashion: Who Gains?, Freakonomics (Aug. 30, 2010, 12:25 PM), <http://freakonomics.blogs.nytimes.com/2010/08/30/copyrighting-fashion-who-gains/> (claiming the bill would affect only an insignificant portion of unique designs and thus have little impact on the fashion industry). I think that the bill would affect only a minority of clothing designs, but I disagree that the hurdle for protection under the bill is significantly higher than the hurdle for protection under regular copyright. See generally Samson Vermont, The Sine Qua Non of Copyright Is Uniqueness, Not Originality, 20 Tex. Intell. Prop. L.J. 328 (2012) (arguing that copyright protects a work only if it is unique, distinguishable, and non-trivial, and also that as used in copyright “utilitarian” is shorthand for non-unique).
- <sup>8</sup> See Costume Designs, supra note 1, at 1 (stating that Copyright Office has generally refused to register garments because they are useful articles that ordinarily contain no artistic authorship separable from their overall utilitarian shape).
- <sup>9</sup> But cf. J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc., 534 U.S. 124, 143-44 (2001) (holding that enactment of Plant Patent Act and Plant Variety Protection Act do not preempt availability of protection of plant invention under utility Patent Act).
- <sup>10</sup> See Scafidi, supra note 2, at 125 (claiming that today, knock-offs can be distributed even more quickly than the originals).
- <sup>11</sup> See, e.g., Intellectual Property Code art. L112-2(14) (Fr.), available at [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=180336](http://www.wipo.int/wipolex/en/text.jsp?file_id=180336) (listing “dress and articles of fashion” as copyrightable subject matter); Copyright, Designs, and Patents Act, 1988, c. 48, §§213, 216, 269 (U.K.), available at <http://www.legislation.gov.uk/ukpga/1988/48/part/III/chapter/I> (establishing protection for fashion designs); Council Regulation 6/2002, tit. II, art. 11-12, 2002 O.J. (L 3) 1 (EC) (providing for 3 years of protection for unregistered fashion designs and up to 25 years of protection for registered fashion designs); Section 5. Trademark and Design Protection Systems, Investing in Japan, Jetro [https://www.jetro.go.jp/en/invest/setting\\_up/laws/section5/page7.html](https://www.jetro.go.jp/en/invest/setting_up/laws/section5/page7.html) (last visited July 15, 2012) (providing protection for the “form, pattern, or color of an object or a combination of these”).
- <sup>12</sup> See Costume Designs, supra note 1, at 1 (noting that while an industrial product might be aesthetically valuable, it is not the intention of Congress to give it copyright protection).
- <sup>13</sup> See Chosun Int’l, Inc. v. Chrisha Creations, Ltd., 413 F.3d 324, 329-30 (2d Cir. 2005) (finding that a fact issue existed as to whether Halloween costumes were protectable); Masquerade Novelty, Inc. v. Unique Indus., Inc., 912 F.2d 663, 671 (3d Cir. 1990) (holding costume masks protectable); Nat’l Theme Prods. v. Jerry B. Beck, Inc., 696 F. Supp. 1348, 1356 (S.D. Cal. 1988) (holding masquerade costumes protectable); Animal Fair v. Amfesco Indus., 620 F. Supp. 175, 191 (D. Minn. 1985) (granting a preliminary injunction to give copyright protection to a slipper in shape of bear paw copyrightable), aff’d mem., 794 F.2d 678 (8th

Cir. 1986); *Costume Designs*, supra note 1, at 2 (stating that clothing will not be registered; costumes, though likewise useful articles, will be registered upon a finding that they have separable aesthetic features.).

14 Cf. *Costume Designs*, supra note 1, at 2 (“Costumes serve a dual purpose of clothing the body and portraying their appearance.”).

15 See *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 189 (S.D.N.Y. 1934) (quoting the Register of Patents as stating that “[t]he right to make and sell an artistically designed garment may under proper circumstances be obtained by a design patent issued from the Patent Office but not by copyright”); *Kemp & Beatley, Inc. v. Hirsch*, 34 F.2d 291, 292 (E.D.N.Y. 1929) (remarking that novel dress patterns are protectable under design patent).

16 See 35 U.S.C. §171 (2006) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” (emphasis added)).

17 See, e.g., *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 238 (Fed. Cir. 1986) (holding that a design cannot be protected under design patent if it is “primarily functional rather than ornamental” or if it is “dictated by functional considerations”).

18 114 F.2d 80 (2d Cir. 1940) (Hand, J.), aff’d, 312 U.S. 457 (1941). See also *Whimsicality, Inc. v. Rubie’s Costume Co, Inc.*, 891 F.2d 452, 455 (2d Cir. 1989) (citing *Fashion Originators* for the proposition that “[w]e have long held that clothes, as useful articles, are not copyrightable”).

19 See *Fashion Originators*, 114 F.2d at 82-83 (implying in the discussion of common law property rights that the designs are unregistered).

20 Id.

21 Id. at 84.

22 Id.

23 891 F.2d at 455. See also *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 547 (S.D.N.Y. 2011) (holding that P’s prom dress was not copyrightable and citing to *Whimsicality* support the general proposition that dress designs “are not typically copyrightable”). The *Jovani* court also cited to *Folio Impressions Inc. v. Byer California*, 937 F.2d 759, 763 (2d Cir. 1991). *Jovani*, 808 F. Supp. 2d at 547. But *Folio*, which concerned fabric design, cites to the dicta in *Whimsicality* in its own dicta. *Folio*, 937 F.2d at 763.

24 See *Whimsicality*, 891 F.2d at 454 n.3 (noting that costumes were regularly rejected by the Copyright Office) Yet, the Office will register some costumes. See *Costume Designs*, supra note 1, at 2 (allowing the registration of costume masks, after meeting the conceptual separability test).

25 *Whimsicality*, 891 F.2d at 453.

26 Id. at 455.

27 See *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 419 n.17 (5th Cir. 2005) (noting that statement in *Whimsicality* that clothing is uncopyrightable is dicta).

28 See *Jovani*, 808 F. Supp. 2d at 542 (finding that the aesthetic features of P’s prom dress were inseparable from its utilitarian

function).

29 632 F.2d 989, 990 (2d Cir. 1980).

30 See H.R. Rep. No. 94-1476, at 54-55 (1976) (discussing the need for clarification in the statute).

31 17 USC §101 (2006).

32 Id.

33 Costume Designs, *supra* note 1, at 2.

34 Cf. *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 421 n.26 (5th Cir. 2005) (“[A]ll of the lawmaking with respect to PGS works is interstitial, and most of it strikes us as freewheeling.”); *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 921 (7th Cir. 2004) (“[T]he circuits that have addressed [this question] have recognized that the wording of the statute does not supply categorical direction, but rather requires the Copyright Office and the courts ‘to continue their efforts to distinguish applied art and industrial design.’” (internal citations omitted)).

35 See Roger E. Schechter & John R. Thomas, *Principles of Copyright Law* 76 (2010) (“[C]ourts and commentators have struggled to define this notion of conceptual separability and it is our sad duty to report that the law is in disarray.”); Matthew C. Broaddus, *Designers Should Strive to Create “Useless” Products: Using the “Useful Article” Doctrine to Avoid Separability Analysis*, 51 S. Tex. L. Rev. 493, 509 (2009) (“The vast array of confusing and potentially conflicting tests for conceptual separability is troublesome on many levels.”).

36 See, e.g., *Pivot Point*, 372 F.3d at 929-931 (purporting to adopt Denicola test but looking to availability of alternative designs that could serve the same utilitarian function as P's design); *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985) (stating that the test for separability is whether the aesthetic features are required by the utilitarian features); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (stating that the test for separability is whether artistic features are “primary” and utilitarian features “subsidiary”); 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* §2.08[B][3] (Matthew Bender, Rev. Ed. 2004) (stating that the test for separability is whether design would still be marketable to some significant segment of community simply because of its aesthetic qualities even if it served no utilitarian function); 1 Paul Goldstein, *Goldstein on Copyright* §2.5.3 (3d ed. 2005) (stating that the test for separability is whether design “can stand on its own as a work of art traditionally conceived, and if the useful article in which it is embodied would be equally useful without it”); William F. Patry, *Copyright Law and Practice* 285 (1994) (stating that the test is whether alternative design choice was available); Thomas M. Byron, *As Long as There's Another Way: Pivot Point v. Charlene Products as an Accidental Template for a Creativity-Driven Useful Articles Analysis*, 49 *IDEA* 147, 170-71 (2009) (stating that the test is whether alternatives were available at time P created the work); Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 *Minn. L. Rev.* 707, 741 (1983) (stating that the test for separability is whether design has features that reflect “artistic expression uninhibited by functional considerations”); Barton R. Keyes, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 *Ohio St. L.J.* 109, 141-42 (2008) (proposing a two-factor balancing test in which courts balance the degree to which the designer's subjective process is motivated by aesthetic concerns and the degree to which the design is objectively dictated by its utilitarian function).

37 See *supra* text accompanying note 36.

38 See *Mazer v. Stein*, 347 U.S. 201, 221 (1954) (reciting a list of registered useful articles).

39 Cf. Maurice A. Weikart, *Design Piracy*, 19 *Ind. L.J.* 235, 240 (1944) (“What is functional...in general has been held to mean parts that are actually necessary for the mechanical operation of the thing, as distinguished from mere ornamentation.”).



40 See H.R. Rep. No. 94-1476, at 54 (1976) (stating that “[t]he term ‘literary works’...includes...computer programs”).

41 See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 990 (2d Cir. 1980) (holding buckle protected).

42 See *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 932 (7th Cir. 2004) (holding mannequin head protected).

43 *Kieselstein-Cord*, 632 F.2d at 993.

44 *Id.* at 995 (displaying photographs of the Winchester and Vaquero buckles).

45 *Pivot Point*, 372 F.3d at 915.

46 *Id.*

47 *Id.*

48 *Id.* at 932-33 (Kanne, J., dissenting).

49 See *id.* at 931-32 (“It certainly is not difficult to conceptualize a human face, independent of all of Mara’s specific facial features...that would serve the utilitarian functions of a hair stand ....”); *Byron*, supra note 36, at 189 (discussing the courts suggestion of another possible mannequin look).

50 See, e.g., *Lanard Toys Ltd. v. Novelty, Inc.*, 375 Fed. App’x 705, 710-11 (9th Cir. 2010) (stating that P’s designer testified he “could have designed it in ‘a million’ other ways”); *Mattel, Inc. v. Goldberger Doll Mfg. Co.*, 365 F.3d 133 (2d Cir. 2004) (stating that dolls can be made in many ways that differ from Barbie); *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 321-23 (2d Cir. 1996) (stating that for taxidermy, the universe of possible expressions can be broad enough to sustain copyright protection, because even realistic animal mannequins can vary sufficiently in artistic details such as pose, attitude, and appearance).

51 See, e.g., *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983) (stating that P’s operating system is not directed to an idea as other expressions could implement it); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967) (stating that P’s straightforward instructions for a box-top sweepstakes were unprotectable given the limited number of ways to express the instructions in a straightforward manner). See also *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1236 (3d Cir. 1986) (involving software); *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926) (involving a play); *Compaq Computer Corp. v. Procom Tech., Inc.*, 908 F. Supp. 1409, 1423 (S.D. Tex. 1995) (involving a method for predicting failure of disk drives).

52 See *Vermont*, supra note 7, at 349-62 (arguing that limiting doctrines, originality requirement and infringement standard limit protection to unique material). Consider the great overlap among the limiting doctrines. For example, the well-known case of *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987), involving the now ubiquitous wave-shaped bike rack, seems to implicate not only the useful article doctrine but also the idea-expression dichotomy, the merger doctrine, and the rule of 37 C.F.R. §202.1(a) against copyright for familiar designs.

53 *Mattel*, 365 F.3d at 136-37.

54 *Hart*, 86 F.3d at 321; *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 491 (4th Cir. 1996).

- 55 Spinmaster, Ltd. v. Overbreak LLC, 404 F. Supp. 2d 1097, 1104 (N.D. Ill. 2005) (holding that motor and main propeller of toy flying saucer were uncopyrightable, but hub, blades, outer ring, separate controller and base station were copyrightable).
- 56 Gay Toys, Inc. v. Buddy L Corp., 703 F.2d 970, 973 (6th Cir. 1983).
- 57 Lanard Toys Ltd. v. Novelty, Inc., 375 Fed. Appx. 705, 711 (9th Cir. 2010).
- 58 Herbert Rosenthal Jewelry Corp. v. Grossbardt, 164 U.S.P.Q. 602, 604 (S.D.N.Y. 1970). See also Mag Jewelry Co. v. Cherokee, Inc., 496 F.3d 108, 111, 114 (1st Cir. 2007) (holding that the validity of copyright for pendant uncontested despite its simple design, which consisted of four crystal stones in the shape of an angel with a metal ring for a halo).
- 59 416 F.3d 411 (5th Cir. 2005).
- 60 Id. at 421.
- 61 Id. at 415, 421-22.
- 62 Id. at 414.
- 63 Id. at 415, 421-22.
- 64 See Kal Raustiala & Christopher Sprigman, The Piracy Paradox: Innovation and Intellectual Property in Fashion Design, 92 Va. L. Rev. 1687, 1718-23 (2006); Letter from Professor Kal Raustiala and Professor Christopher Sprigman to the Committee on the Judiciary, U.S. House of Representatives, Subcommittee on Intellectual Property, Competition and the Internet (July 13, 2011), available at <http://judiciary.house.gov/hearings/pdf/Sprigman07152011.pdf>.
- 65 Cf. C. Scott Hemphill & Jeannie Suk, The Law, Culture, and Economics of Fashion, 61 Stan. L. Rev. 1147, 1180-84 (2009) (arguing that the piracy paradox is one-dimensional because it is predicated only on the status-conferring aspect of fashion and ignores its expressive aspect).
- 66 The Copyright Act of 1870 §86 defined copyrightable subject matter as: “any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts.” 16 Stat. 198 (codified as amended in scattered sections of 17 U.S.C.). See also J. L. Mott Iron Works v. Clow, 82 F. 316, 318-19 (7th Cir. 1897) (stating that a trade catalogue comprised of illustrations of bathtubs and the like was mere advertisement lacking the artistic merit necessary for copyright).
- 67 See Scafidi, *supra* note 2, at 118 (stating that the United States was a haven for design pirates).
- 68 Cf. Allison A. Nieder, Taking the Design Piracy Debate to the Financial Industry, Cal. Apparel News, Oct. 29-Nov. 4, 2010, at 1, 8, available at [http://www.apparelnews.net/uploads/PrintIssues/file\\_path/171\\_CAN102910\\_lettersize\\_A.pdf](http://www.apparelnews.net/uploads/PrintIssues/file_path/171_CAN102910_lettersize_A.pdf) (quoting Kevin Sullivan, Executive Vice President at Wells Fargo: “[IP protection for clothing design] would likely lead to a host of unintended consequences for the industry, not the least of which would be an increase in legal costs faced by apparel manufacturers.”).
- 69 See *id.* (quoting Kevin Sullivan, Executive Vice President at Wells Fargo: “[I]t is very difficult to prove the originality of a given design in the apparel industry.”); Weikart, *supra* note 39, at 248, 256 (identifying the absence of a search by the Copyright Office to ensure originality as basis for opposition to protection for clothing design).

70 Cf. Letter from Professors Raustiala & Sprigman, *supra* note 64, at 9 (arguing against passage of fashion bill but acknowledging that there are very few lawsuits in Europe over copying of fashion design).

71 Vermont, *supra* note 7, at 349-62. Cf. *Bucklew v. Hawkins, Ash, Baptie & Co., LLP*, 329 F.3d 923, 929 (7th Cir. 2003) (stating that there is no originality present unless the work is distinguishable from prior work); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 492 (2d Cir. 1970) (en banc) (“To extend copyrightability to miniscule variations [of public domain work] would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work.”); Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 *Duke L. J.* 683, 707 (2003) (discussing evidentiary benefits of the requirement that work be distinguishable from prior work).

72 See, e.g., *Weikart*, *supra* note 39, at 256 (stating that absent search by the Copyright Office to ensure originality, there is a risk that the alleged copy will turn out not to be a copy).

73 Vermont, *supra* note 7, at 349-62. Cf. *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 708-09 (2d Cir. 1992) (asserting that because efficient structure may be independently created, efficient structure should be filtered out during infringement analysis); Michael Steven Green, *Two Fallacies About Copyrighting Factual Compilations*, in *Intellectual Property Protection of Fact-Based Works: Copyright and Its Alternatives* 109, 122-26 (Robert F. Brauneis ed., 2009) (requiring that work be distinguishable from prior work helps avoid protection for works that could be independently created).