

USEFUL ARTICLES IN COPYRIGHT: PROPOSED AMENDMENTS TO SECTION 101 and 114

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We will first look at current statutory provisions, then at the issues raised, then at my proposal for solutions via amending title 17.

What is a “useful article”? 17 USC Section 101:

A “useful article” is an article having an intrinsic utilitarian function that is **not merely to portray the appearance of the article or to convey information**. An article that is normally a part of a useful article is considered a “useful article”.

The origin of the definition probably lies with everyone’s favorite protean decision, *Baker v. Selden*, 101 U.S. 99 (1879).

For example, in 1924, the Second Circuit borrowed from *Baker* in upholding the copyright in ‘Sparky,’ a stuffed doll in the shape of a horse. The crucial distinction, which the court quoted from *Baker*, was the line between, on the one hand, “designs or pictorial illustrations addressed to the taste” whose “object [is] the production of **pleasure in their contemplation**,” and, on the other hand, “methods of useful art [that] have their final end in **application and use**. ”

The Second Circuit placed Sparky on the copyrightable side of the line. The court thought that the object of Sparky’s creation was “the production of amusement in contemplation.”

It is a short step from language like that, to an articulation that declares that **the only legitimate purposes of copyright** are to “**portray the appearance of the article or to convey information**”— and to distinguishing those purposes from purposes that lie within patent’s domain. End result: Purposes other than portraying appearance or information make a work into a ‘useful article’ (at least if the work’s creativity lies in its shape or visual aspects).

To what is the concept of ‘useful article’ relevant? Again, refer to section 101:

“Pictorial, graphic, and sculptural works” [“PGS works”} include two-dimensional and three-dimensional works of fine, graphic, and applied art 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.

(Emphases added, of course.)

Thus, useful articles are copyrightable only if they pass a **separability** test.

Beautifully designed teapots, chairs, or belt buckles serve purposes in addition to ‘pleasure in their contemplation’; they boil water, give us places to sit, and hold up pants. They must, therefore, be classed as ‘useful articles’, and must pass a separability test to have copyright.

Blueprints, non-functioning models, and drawings are not ‘useful works,’ because they merely convey appearance or information. They are therefore PGS works copyrightable without reference to separability.

Ordinarily, the owner of copyright in a PGS work has rights to control new works based on (derived from) the copyrighted work. Section 106(2). Similarly, the owner of copyright in a PGS work would ordinarily have the right to control the sale (section 106(3)) and display (section 106(5)) of any derivative work made without her consent.

If a full set of rights were given to the owners of copyright in PGS works, **then just by the simple act of drawing a picture of a new machine, or even photographing it**, the artist or photographer might gain a PGS copyright that gave her as ‘author’ the exclusive right to **forbid others to make, sell, or display** the machine itself.

After all, under ordinary principles, the machine copied from a drawing would be a substantially similar reproduction or derivative work of the drawing. And under section 109, neither the ‘first sale’ doctrine or the liberty of public display is available for object that are unlawfully made.

This obviously would discourage many inventors from using the patent system with its short term, pre-issuance review, requirement of disclosure, rigorous substantive criteria, and fairly narrow doctrine of equivalents. **Innovation might be discouraged**, especially given the contrast between patent’s willingness to give ‘improvement patents’ in unauthorized variants of patented inventions, on the one hand, and, on the other, copyright’s ambiguous but clearly less generous treatment of unauthorized derivative works under section 103(a).

Would this danger to the patent system be averted by the MERGER doctrine? Merger depends on there being few ways to express an idea or invention. Admittedly some drawings of useful articles might lose copyright because of ‘merger’ -- if the drawing was only one of several ways to depict an invention. However, most machines and other utilitarian devices can be drawn in a virtually infinite number of styles, and from a large number of different visual perspectives. Given the multiplicity of potential artistic renditions, therefore, “merger” alone would not often interfere with giving the owner of such PGS works power over utilitarian inventions.

Could fair use give relief (section 107), especially if broadened by reference to *Baker v. Selden*? **Conceivably** fair use might do the trick.

But Congress chose to shelter patent from such a copyright invasion more explicitly.

Section 114(b) provides a direct limitation on the exclusive rights given to “**the owner of copyright in a work that portrays a useful article as such**”:

Section 114(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.

The cases referred to in section 114(b) basically held that copyright in a drawing or other PGS work was not infringed by someone making a useful article from that PGS work.

The cases which constituted ‘the law . . . in effect on December 31, 1977’ **also** gave the makers of these useful articles the liberty to make drawings and photographs of them. Therefore, even a 2-dimensional rendition of the defendant’s useful article would not infringe the copyrighted drawing from which the useful invention was copied, so long as the useful invention pictured in the second rendition was actually made and sold. Congress put this privilege, somewhat narrowed, in section 114(c):

Section 114(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.

That is the basic outline.

- I. PGS works cannot contain “inseparable” components which serve purposes other than display or information.
- II. And even those PGS works which are copyrightable cannot be employed to restrain strangers from making, selling and advertising imitative useful articles.

Problems remain, notably **the definition of “separability”**. It has at least two controversial characteristics:

- a. Separability creates **a wide moat—a margin of safety**--around the prize of ‘ensuring the dominion of patent.’ Arguably a less wide moat—maybe something like “is the design feature functionally requires”—could be sufficient to safeguard patent law.
- b. **Courts can’t agree on what separability means.**

Regarding the wide margin of safety:

I admit that, conceivably, some useful articles which fail a separability test could receive copyright protection without unduly interfering with patent law. If our world possessed ‘perfect machinery of justice,’ then the separability test might indeed bar more copyrights than would be required by the need

for deferring to patent law. This can be questioned (given, for example, the *Vornado* court's broad willingness to consider all sorts of trivial differences as potentially valuable to industrial or scientific progress), but I understand the good-faith argument that 'separability' could bar protection for many aesthetically attractive variations that have no conceivable value.

I even admit that in our imperfect world, various forms of law require something less than separability as pre-requisite for nonpatent grants of exclusivity.

Examples: the Lanham Act declares that 'functional' features cannot become trademarks. A distinctive feature of a product can escape functionality—and achieve trademark status-- by the claimant showing something less than 'separability'.

Similarly as to copyright in architecture: Legislative history suggest that architectural structures (a category now distinct from PGS works) can be copyrighted so long as the features are 'functionally required.'

My replies:

- a. **WIDE MOAT.** Congress is wise to use a test, like 'separability', that embodies a margin of safety -- because we do **not** have perfect machineries of justice. Given real-world institutional limitations, the margin of safety

ensures that patent's dominion over mechanical inventions remains unimpaired by copyright.

b. **DEFINITIONAL PROBLEM.** It's true that courts can't agree on how to define "separability," and that the conflicting tests waste money and cause uncertainty. Separability would be much less difficult if the statutory test actually tracked the policy at issue. This is done fairly simply by reversing the two clauses of the current statute.

We now have this statutory rule in section 101:

Copyright is barred unless a "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.**"

The definition is flawed. It asks whether the art can 'exist independently'. Whether or not the art can exist independently does nothing to safeguard patent's dominion.

We should amend section 101 definition to read as follows:

Revised section 101. Copyright is barred unless the "design of a useful article possesses **utilitarian aspects that are capable**

of existing independently of the aspects of the article that serve purposes solely of informational or appearance. A design can be a protected as a PGS work solely as to those features which, if copying were barred, would not impair the public's ability to utilize the utilitarian aspects."

[An alternative to my second sentence that is worth considering: "...A design can be a protected as a PGS work solely as to those features which, if copied, would not improve the functionality of the utilitarian aspects."]

Continuation of revision to section 101: The utilitarian aspects of a useful article include any consumer or industry purpose unrelated to appearance and information, such as cost or ease of manufacturing the article; durability of the article; ease of using the article.

In addition, the current 114(b) should be replaced by a new, separate limit to copyright. The first portion of my new statute would restate the content of 114(b) but more explicitly; the second portion would go a bit further. This is what it would look like:

- (a) This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any rights with respect to the making, distribution, or display of that useful article
- (b) This title does not afford, to the owner of copyright in a useful article, any rights respect to the making, distribution, or display of such article, which would impair the public's ability to copy the utilitarian aspects of said article.

The proposed section might be **codified** at the end of chapter one of title 17, perhaps as 17 USC section 130. It would have more **visibility** there than in section 114.

These proposed limitations on a copyright owner's exclusive rights **complement the subject-matter limitation** of my revised PGS definition. They have an **institutional advantage** that a subject-matter limitation does not.

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Consider that in deciding whether or not to grant copyright in an attractive teapot or chair, **the Copyright Office may not have much information** about what aspects of the design are functional. It's precisely that kind of error that makes a 'moat' or 'margin for error' advisable.

As a result of such **institutional information deficits**, the Copyright Office might issue (presumptively valid) grants of copyright registrations that should indeed not have issued.

My proposed Section 130 would allow **someone with actual information about utility—namely, a defendant**—to make a showing that his or her functional copy should be free of liability whether or not the plaintiff's original is copyrighted.

My proposed new limitation in section 130 (b) also gives practical effect to *Baker v. Selden*'s puzzling stricture that **the same work might be copyrightable in some circumstances but not in others.**

In *Baker*, the Supreme Court told us that copyright obtains when a work's "object... is explanation" but not when its

"object... is use. **The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters patent.**" *Baker*, 101 U. S. at 105.

This directive is best implemented by means of a limitation on exclusive rights.

Two Post Scripts:

Sui Generis Design, and Computer Program Copyrights

- (1) I have **no strong objection to sui generis design** legislation, **so long as** it is non-cumulative, is available only upon registration, has a very short duration (e.g., 5 years), and does not extend to features dictated by function. Admittedly, I don't quite see the point of such protection, given the availability of design patent; moreover, once enacted the design protection might inappropriately expand. Nevertheless, a very limited design-protection statute need not cause a tragedy for competition in mechanical inventions.

But that concession underlines my primary point: it is simply too dangerous to allow generous protection for design via **copyright**. Copyright's multi-generational exclusive term length, automatic availability, broad scope, and limits on the ownership of unauthorized variations, all combine to pose real dangers to competition. As a result, **error costs are not symmetrical**. Errors in giving functional designs too much copyright protection are simply **more costly** than errors in giving too little.

- (2) You may ask whether I believe my approach should extend to **computer programs**. Computer programs bear close resemblance to my topic, as programs usually take

the form of functional literary works and/or functional visual designs.

My view is that programs need a **sui generis** regime; in the absence of that option, I would support strongly limiting copyright for computer programs. However, to discuss the computer-program issue would take us too far afield.