

**Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (1980)**

OAKES, J.

This case is on a razor's edge of copyright law. It involves belt buckles, utilitarian objects which as such are not copyrightable. But these are not ordinary buckles; they are sculptured designs cast in precious metals-decorative in nature and used as jewelry is, principally for ornamentation. We say "on a razor's edge" because the case requires us to draw a fine line under applicable copyright law and regulations. Drawing the line in favor of the appellant designer, we uphold the copyrights granted to him by the Copyright Office and reverse the district court's grant of summary judgment, in favor of the appellee, the copier of appellant's designs.

**FACTS**

Appellant Barry Kieselstein-Cord designs, manufactures exclusively by handcraftsmanship, and sells fashion accessories. To produce the two buckles in issue here, the "Winchester" and the "Vaquero," he worked from original renderings which he had conceived and sketched. He then carved by hand a waxen prototype of each of the works from which molds were made for casting the objects in gold and silver. Difficult to describe, the buckles are solid sculptured designs, in the words of district court Judge Goettel, "with rounded corners, a sculpted surface, a rectangular cut-out at one end for the belt attachment," and "several surface levels." The Vaquero gives the appearance of two curved grooves running diagonally across one corner of a modified rectangle and a third groove running across the opposite corner. On the Winchester buckle two parallel grooves cut horizontally across the center of a more tapered form, making a curving ridge which is completed by the tongue of the buckle. A smaller single curved groove flows diagonally across the corner above the tongue.

The Vaquero buckle, created in 1978, was part of a series of works that the designer testified was inspired by a book on design of the art nouveau school and the subsequent viewing of related architecture on a trip to Spain. The buckle was registered with the Copyright Office by appellant's counsel on March 3, 1980, with a publication date of June 1, 1978, as "jewelry," although the appellant's contribution was listed on the certificate as "original sculpture and design." Explaining why he named the earlier buckle design "Winchester," the designer said that he saw "in (his) mind's eye a correlation between the art nouveau period and the butt of an antique Winchester rifle" and then "pulled these elements together graphically." The registration, which is recorded on a form used for works of art, or models or designs for works of art, specifically describes the nature of the work as "sculpture."

The Winchester buckle in particular has had great success in the marketplace: more than 4,000 belts with Winchester buckles were sold from 1976 to early 1980, and in 1979 sales of the belts amounted to 95% of appellant's more than \$ 300,000 in jewelry sales. A small women's size in silver

with “double truncated triangle belt loops” sold, at the time this lawsuit commenced, at wholesale for \$ 147.50 and a larger silver version for men sold at wholesale with loops for \$ 662 and without loops for \$ 465. Lighter-weight men’s versions in silver wholesaled for \$ 450 and \$ 295, with and without loops respectively. The gold versions sold at wholesale from \$ 1,200 to \$ 6,000. A shortened version of the belt with the small Winchester buckle is sometimes worn around the neck or elsewhere on the body rather than around the waist. Sales of both buckles were made primarily in high fashion stores and jewelry stores, bringing recognition to appellant as a “designer.” This recognition included a 1979 Coty American Fashion Critics’ Award for his work in jewelry design as well as election in 1978 to the Council of Fashion Designers of America. Both the Winchester and the Vaquero buckles, donated by appellant after this lawsuit was commenced, have been accepted by the Metropolitan Museum of Art for its permanent collection.

As the court below found, appellee’s buckles “appear to be line-for-line copies but are made of common metal rather than” precious metal. Appellee admitted to copying the Vaquero and selling its imitations, and to selling copies of the Winchester. Indeed some of the order blanks of appellee’s customers specifically referred to “Barry K Copy,” “BK copy,” and even “Barry Kieselstein Knock-off.” Thus the only legal questions for the court below were whether the articles may be protected under the copyright statutes and, if so, whether the copyrights were adequate under the laws. Having found that the copyrights were invalid—the Winchester under the Copyright Act of 1909, and the Vaquero under the 1976 Act because they “fail(ed) to satisfy the test of separability and independent existence of the artistic features, which is required under both statutes,” Judge Goettel did not go on to make a conclusive determination on the further question whether the notice requirements of the acts had been met by appellant. Instead, he found that the Winchester buckle “probably” satisfies the 1909 Act notice requirements, and he reserved the question whether, with respect to the Vaquero buckle, appellant met the notice requirements of the 1976 Act by way of a saving clause that preserves a copyright despite publication without adequate notice. We therefore only reach the question whether the buckles may be copyrighted.

## DISCUSSION

We commence our discussion by noting that no claim has been made that the appellant’s work here in question lacks originality or creativity, elements necessary for copyrighting works of art. The thrust of appellee’s argument, as well as of the court’s decision below, is that appellant’s buckles are not copyrightable because they are “useful articles” with no “pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects” of the buckles. The 1976 copyright statute does not provide for the copyrighting of useful articles except to the extent that their designs incorporate artistic features that can be identified separately from the functional elements of the articles. With respect to this question, the law adopts the language of the

longstanding Copyright Office regulations. The regulations in turn were adopted in the mid-1950's, under the 1909 Act, in an effort to implement the Supreme Court's decision in *Mazer v. Stein*. The Court in *Mazer*, it will be recalled, upheld the validity of copyrights obtained for statuettes of male and female dancing figures despite the fact that they were intended for use and used as bases for table lamps, with electric wiring, sockets, and lampshades attached. *Mazer* itself followed a "contemporaneous and long-continued construction" by the Copyright Office of the 1870 and 1874 Acts as well as of the 1909 Act, under which the case was decided. As Professor Nimmer points out, however, the Copyright Office's regulations in the mid-1950's that purported to "implement" this decision actually limited the Court's apparent open-ended extension of copyright protection to all aesthetically pleasing useful articles.

Ultimately, as Professor Nimmer concludes, none of the authorities-the *Mazer* opinion, the old regulations, or the statute-offer any "ready answer to the line-drawing problem inherent in delineating the extent of copyright protection available for works of applied art." Congress in the 1976 Act may have somewhat narrowed the sweep of the former regulations by defining a "useful article" as one with "an intrinsic utilitarian function," instead of one, in the words of the old regulations, with utility as its "sole intrinsic function."

We are left nevertheless with the problem of determining when a pictorial, graphic, or sculptural feature "can be identified separately from, and (is) capable of existing independently of, the utilitarian aspects of the article." This problem is particularly difficult because, according to the legislative history explored by the court below, such separability may occur either "physically or conceptually." As the late Judge Harold Leventhal observed in his concurrence in *Esquire, Inc. v. Ringer*, legislative policy supports the Copyright Office's "effort to distinguish between the instances where the aesthetic element is conceptually severable and the instances where the aesthetic element is inextricably interwoven with the utilitarian aspect of the article." Examples of conceptual separateness as an artistic notion may be found in many museums today and even in the great outdoors. Professor Nimmer cites Christo's "Running Fence" as an example of today's "conceptual art": it "did not contain sculptural features that were physically separable from the utilitarian aspects of the fence, but the whole point of the work was that the artistic aspects of the work were conceptually separable."

Appellee argues that the belt buckles are merely useful objects, which include decorative features that serve an aesthetic as well as a utilitarian purpose. And the copyright laws, appellee points out, were never intended to nor would the Constitution permit them to protect monopolies on useful articles. But appellee goes too far by further arguing that "copyrightability cannot adhere in the 'conceptual' separation of an artistic element." This assertion flies in the face of the legislative intent as expressed in the House Report, which specifically refers to elements that "physically or conceptually, can be identified as separable from the utilitarian aspects of" a useful article.

We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist. The primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function. This conclusion is not at variance with the expressed congressional intent to distinguish copyrightable applied art and uncopyrightable industrial design. Pieces of applied art, these buckles may be considered jewelry, the form of which is subject to copyright protection.

Appellant's designs are not, as the appellee suggests in an affidavit, mere variations of "the well-known western buckle." As both the expert witnesses for appellant testified and the Copyright Office's action implied, the buckles rise to the level of creative art. Indeed, body ornamentation has been an art form since the earliest days, as anyone who has seen the Tutankhamen or Scythian gold exhibits at the Metropolitan Museum will readily attest. The basic requirements of originality and creativity, which the two buckles satisfy and which all works of art must meet to be copyrighted, would take the vast majority of belt buckles wholly out of copyrightability. The Copyright Office continually engages in the drawing of lines between that which may be and that which may not be copyrighted. It will, so long as the statute remains in its present form, always be necessary to determine whether in a given case there is a physically or conceptually separable artistic sculpture or carving capable of existing independently as a work of art.

We reverse the grant of summary judgment to the appellee and remand the case for consideration of whether appellant has satisfied the copyright notice requirements.

**Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (1985)**

MANSFIELD, J.

Carol Barnhart Inc. ("Barnhart"), which sells display forms to department stores, distributors, and small retail stores, appeals from a judgment of the Eastern District of New York, Leonard D. Wexler, *Judge*, granting a motion for summary judgment made by defendant Economy Cover Corporation ("Economy"), which sells a wide variety of display products primarily to jobbers and distributors. Barnhart's complaint alleges that Economy has infringed its copyright and engaged in unfair competition by offering for sale display forms copied from four original "sculptural forms" to which Barnhart holds the copyright. Judge Wexler granted Economy's motion for summary judgment on the ground that plaintiff's mannequins of partial human torsos used to display articles of clothing are utilitarian articles not containing separable works of art, and thus are not copyrightable. We affirm.

The bones of contention are four human torso forms designed by Barnhart, each of which is life-size, without neck, arms, or a back, and made of expandable white styrene. Plaintiff's president created

the forms in 1982 by using clay, buttons, and fabric to develop an initial mold, which she then used to build an aluminum mold into which the poly-styrene is poured to manufacture the sculptural display form. There are two male and two female upper torsos. One each of the male and female torsos is unclad for the purpose of displaying shirts and sweaters, while the other two are sculpted with shirts for displaying sweaters and jackets. All the forms, which are otherwise life-like and anatomically accurate, have hollow backs designed to hold excess fabric when the garment is fitted onto the form. Barnhart's advertising stresses the forms' uses to display items such as sweaters, blouses, and dress shirts, and states that they come "packaged in UPS-size boxes for easy shipping and [are] sold in multiples of twelve."

Plaintiff created the first of the forms, Men's Shirt, shortly after its founding in March, 1982, and by the end of July it had attracted \$18,000 worth of orders. By December 1982, plaintiff had designed all four forms, and during the first morning of the twice-yearly trade show sponsored by the National Association of the Display Industry ("NADI"), customers had placed \$35,000 in orders for the forms. Plaintiff's president maintains that the favorable response from visual merchandisers, Barnhart's primary customers, "convinced me that my forms were being purchased not only for their function but for their artistically sculptured features."

Economy, which sells its wide range of products primarily to jobbers, distributors, and national chain stores, not to retail stores, first learned in early 1983 that Barnhart was selling its display forms directly to retailers. After observing that no copyright notice appeared either on Barnhart's forms or in its promotional literature, Economy contracted to have produced for it four forms which it has conceded, for purposes of its summary judgment motion, were "copied from Barnhart's display forms" and are "substantially similar to Barnhart's display forms." Economy began marketing its product, "Easy Pin Shell Forms," in September 1983. Later in the same month, Barnhart wrote to NADI to complain that Economy was selling exact duplicates of Barnhart's sculptural forms at a lower price and asked it to stop the duplication and underselling. Economy responded with a letter from its counsel dated October 17, 1983 to the Chairman of NADI's Ethics Committee stating that Economy was not guilty of any "underhanded" business practices since Barnhart's forms were not protected by "patent, copyright, trademark, or otherwise."

On the same date (October 17, 1983) Barnhart applied for copyright registration for a number of products, including the four forms at issue here. It identified each of the forms as "sculpture" and sought expedited examination of its applications because of the possibility of litigation over copyright infringement. Copyright registration was granted the same day. Then, on October 18, Barnhart informed Economy that its Easy Pin Shell Forms violated Barnhart's rights and demanded that it discontinue its advertising and sale of the forms. In November 1983, more than 18 months after selling its first form, Barnhart advised its customers that copyright notice had "inadvertently [been] omitted" from the

display forms previously distributed and enclosed adhesive stickers bearing a copyright notice, which it asked the customers to affix to unmarked products in inventory.

Barnhart filed this suit in December 1983. Count I charges Economy with violating Barnhart's rights under the Copyright Act by copying and selling Barnhart's four display forms. Count II alleges that Economy has engaged in unfair competition under the common law of the State of New York. The complaint seeks an adjudication that Economy has infringed Barnhart's copyrights, a preliminary and permanent injunction against Economy's producing, advertising, or selling its forms, damages (consequential, statutory, and punitive), and attorney's fees. Economy moved for summary judgment on the issue of the copyrightability of Barnhart's display forms (and the issue of statutory damages and attorney's fees).

After a hearing on February 3, 1984, Judge Wexler issued an order and opinion on September 12, 1984 granting defendant's motion for summary judgment on the issue of copyrightability. The district court rejected plaintiff's arguments that the issue of copyrightability was an improper subject for summary judgment and that the Copyright Office's issuance of certificates of registration for Barnhart's four forms created an insurmountable presumption of the validity of the copyrights. On the central issue of copyrightability, it reviewed the statutory language, legislative history, and recent case authority, concluding that they all speak with "a single voice," i.e., that a useful article may be copyrighted only to the extent that "there is a physically or conceptually separable work of art embellishing it. . . ." Applying this test, the district court determined that since the Barnhart forms possessed no aesthetic features that could exist, either physically or conceptually, separate from the forms as utilitarian articles, they were not copyrightable.

On March 6, 1985, Judge Wexler denied Barnhart's motion for reargument. The present appeal followed.

## DISCUSSION

Appellant's threshold argument, that the district court erred in ignoring the statutory presumption of validity accorded to a certificate of copyright registration and to the line-drawing expertise of the Copyright Office, can be disposed of briefly. With respect to the prima facie validity of Copyright Office determinations, 17 U.S.C. § 410(c) states:

"In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court."

However, “a certificate of registration creates no irrebuttable presumption of copyright validity.” Extending a presumption of validity to a certificate of copyright registration

“merely orders the burdens of proof. The plaintiff should not ordinarily be forced in the first instance to prove all of the multitude of facts that underline the validity of the copyright unless the defendant, by effectively challenging them, shifts the burden of doing so to the plaintiff.”

Judge Wexler properly exercised the discretion conferred on him by 17 U.S.C. § 410(c). Once defendant’s response to plaintiff’s claim put in issue whether the four Barnhart forms were copyrightable, he correctly reasoned that the “mute testimony” of the forms put him in as good a position as the Copyright Office to decide the issue. While the expertise of the Copyright Office is in “interpretation of the law and its application to the facts presented by the copyright application,” it is permissible for the district court itself to consider how the copyright law applies to the articles under consideration.

Since the four Barnhart forms are concededly useful articles, the crucial issue in determining their copyrightability is whether they possess artistic or aesthetic features that are physically or conceptually separable from their utilitarian dimension. A “useful article” is defined in 17 U.S.C. § 101 as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” Although 17 U.S.C. § 102(a)(5) extends copyright protection to “pictorial, graphic, and sculptural works,” the definition of “pictorial, graphic, and sculptural works” 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.”

To interpret the scope and applicability of this language, and the extent to which it may protect useful articles such as the four Barnhart forms, we must turn to the legislative history of the 1976 Copyright Act, which is informative.

Congress, acting under the authority of Art. I, § 8, cl. 8 of the Constitution, extended copyright protection to three-dimensional works of art in the Copyright Act of 1870, which 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 . . . .”

The Supreme Court upheld an expansive reading of “authors” and “writings” in *Burrow-Giles Lithographic Co. v. Sarony*, rejecting the claim that Congress lacked the constitutional authority to extend copyright protection to photographs and negatives thereof. The Court further contributed to the liberalization of copyright law in *Bleistein v. Donaldson Lithographing Co.*, in which it held that chromo-lithographs used on a circus poster were not barred from protection under the copyright laws. In *Bleistein*, Justice Holmes stated his famous “anti-discrimination” principle:

“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.”

The Copyright Act of 1909 expanded the scope of the copyright statute to protect not only traditional fine arts, but also “works of art; models or designs for works of art.” However, this language was narrowly interpreted by Copyright Office regulations issued in 1910, which stated in part:

“*Works of art.* -- This term includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture).”

“Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.”

The prospects for a work of applied art obtaining a copyright were enhanced in December 1948, when the Copyright Office changed the definition of a “work of art” in its Regulation § 202.8:

“*Works of art (Class G)* -- (a) *In General* This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture.”



While this regulation seemed to expand coverage for works of applied art, it did not explicitly extend copyright protection to industrial design objects.

The next significant historical step was taken not by Congress but by the Supreme Court in its 1954 decision in *Mazer v. Stein*, where it upheld § 202.8 as a proper standard for determining when a work of applied art is entitled to copyright protection, in the context of deciding whether lamps which used statuettes of male and female dancing figures made of semivitreous china as bases were copyrightable. The narrow question faced was whether the addition of the lamp attachments deprived the statuettes of the copyright protection to which they were separately entitled. The Court answered that question in the negative, holding that an ornamental design does not necessarily cease to be artistic when embodied in a useful article and may therefore be entitled to copyright protection.

The Copyright Office implemented *Mazer v. Stein* by promulgating new regulations interpreting § 5(g) of the 1909 Act, which stated in part:

“(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.”

In an effort to provide some form of protection to “three-dimensional designs of utilitarian articles as such,” a number of separate design bills were introduced into Congress. Finally, Title II of a bill passed by the Senate in 1975, S. 22 (The Design Protection Act of 1975), proposed to offer legal protection to the creators of ornamental designs of useful articles. It defined “pictorial, graphic, and sculptural works” to “include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, plans, diagrams, and models.”

The House, however, responded by passing a strikingly different version. To the text passed by the Senate it added the following:

“Such works shall include works of artistic craftsmanship 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.”

Both of the added clauses were from work of the Copyright Office: the first from its 1948 Regulation § 202.8, approved by the Supreme Court in *Mazer v. Stein*; the second from its post-Mazer § 202.10(c). The bill as finally enacted omitted entirely the proposed Title II.

The legislative history thus confirms that, while copyright protection has increasingly been extended to cover articles having a utilitarian dimension, Congress has explicitly refused copyright protection for works of applied art or industrial design which have aesthetic or artistic features that cannot be identified separately from the useful article. Such works are not copyrightable regardless of the fact that they may be “aesthetically satisfying and valuable.”

Applying these principles, we are persuaded that since the aesthetic and artistic features of the Barnhart forms are inseparable from the forms’ use as utilitarian articles the forms are not copyrightable. Appellant emphasizes that clay sculpting, often used in traditional sculpture, was used in making the molds for the forms. It also stresses that the forms have been responded to as sculptural forms, and have been used for purposes other than modeling clothes, e.g., as decorating props and signs without any clothing or accessories. While this may indicate that the forms are “aesthetically satisfying and valuable,” it is insufficient to show that the forms possess aesthetic or artistic features that are physically or conceptually separable from the forms’ use as utilitarian objects to display clothes. On the contrary, to the extent the forms possess aesthetically pleasing features, even when these features are considered in the aggregate, they cannot be conceptualized as existing independently of their utilitarian function.

Appellant seeks to rebut this conclusion by arguing that the four forms represent a concrete expression of a particular idea, e.g., the idea of a woman’s blouse, and that the form involved, a human torso, is traditionally copyrightable. Appellant suggests that since the Barnhart forms fall within the traditional category of sculpture of the human body, they should be subjected to a lower level of scrutiny in determining its copyrightability. We disagree. We find no support in the statutory language or legislative history for the claim that merely because a utilitarian article falls within a traditional art form it is entitled to a lower level of scrutiny in determining its copyrightability. Recognition of such a claim would in any event conflict with the anti-discrimination principle Justice Holmes enunciated in *Bleistein v. Donaldson Lithographing Co.*

Nor do we agree that copyrightability here is dictated by our decision in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, a case we described as being “on a razor’s edge of copyright law.” There we were called on to determine whether two belt buckles bearing sculptured designs cast in precious metals and principally used for decoration were copyrightable. Various versions of these buckles in silver and gold sold wholesale at prices ranging from \$147.50 to \$6,000 and were offered by high fashion and

jewelry stores. Some had also been accepted by the Metropolitan Museum of Art for its permanent collection.

In concluding that the two buckles were copyrightable we relied on the fact that “the primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function.” A glance at the pictures of the two buckles, coupled with the description in the text, confirms their highly ornamental dimensions and separability. What distinguishes those buckles from the Barnhart forms is that the ornamented surfaces of the buckles were not in any respect required by their utilitarian functions; the artistic and aesthetic features could thus be conceived of as having been added to, or superimposed upon, an otherwise utilitarian article. The unique artistic design was wholly unnecessary to performance of the utilitarian function. In the case of the Barnhart forms, on the other hand, the features claimed to be aesthetic or artistic, e.g., the life-size configuration of the breasts and the width of the shoulders, are inextricably intertwined with the utilitarian feature, the display of clothes. Whereas a model of a human torso, in order to serve its utilitarian function, must have some configuration of the chest and some width of shoulders, a belt buckle can serve its function satisfactorily without any ornamentation of the type that renders the *Kieselstein-Cord* buckles distinctive.

The judgment of the district court is affirmed.

NEWMAN, J., dissenting.

This case concerns the interesting though esoteric issue of “conceptual separability” under the Copyright Act of 1976. Because I believe the majority has either misunderstood the nature of this issue or applied an incorrect standard in resolving the issue in this case, I respectfully dissent from the judgment affirming the District Court’s grant of summary judgment for the defendant. I would grant summary judgment to the plaintiff as to two of the objects in question and remand for trial of disputed issues of fact as to the other two objects in question.

The ultimate issue in this case is whether four objects are eligible for copyright protection. The objects are molded forms of styrene. Each is a life-size, three-dimensional representation of the front of the human chest. Two are chests of males, and two are chests of females. For each gender, one form represents a nude chest, and one form represents a chest clad with a shirt or a blouse.

Section 102(a)(5) of the Act extends copyright protection to “sculptural works,” which are defined to include “three-dimensional works of fine, graphic, and applied art” and “works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned.” The definition of “sculptural works” contains a special limiting provision for “useful articles”:

the design of a useful article, as defined in this section, shall be considered a . . . sculptural work only if, and only to the extent that, such design incorporates . . . sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

Each of the four forms in this case is indisputably a “useful article” as that term is defined in section 101 of the Act, since each has the “intrinsic utilitarian function” of serving as a means of displaying clothing and accessories to customers of retail stores. Thus, the issue becomes whether the designs of these useful articles have “sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects” of the forms.

This elusive standard was somewhat clarified by the House Report accompanying the bill that became the 1976 Act. The Report states that the article must contain “some element that, *physically or conceptually*, can be identified as separable from the utilitarian aspects of that article.” In this Circuit it is settled, and the majority does not dispute, that “conceptual separability” is distinct from “physical separability” and, when present, entitles the creator of a useful article to a copyright on its design.

What must be carefully considered is the meaning and application of the principle of “conceptual separability.” Initially, it may be helpful to make the obvious point that this principle must mean something other than “physical separability.” That latter principle is illustrated by the numerous familiar examples of useful objects ornamented by a drawing, a carving, a sculpted figure, or any other decorative embellishment that could physically appear apart from the useful article. Professor Nimmer offers the example of the sculptured jaguar that adorns the hood of and provides the name for the well-known British automobile. With all of the utilitarian elements of the automobile physically removed, the concept, indeed the embodiment, of the artistic creation of the jaguar would remain. Since “conceptual separability” is not the same as “physical separability,” it should also be obvious that a design feature can be “conceptually separable” from the utilitarian aspect of a useful article even if it cannot be separated physically.

There are several possible ways in which “conceptual separability” might be understood. One concerns usage. An article used primarily to serve its utilitarian function might be regarded as lacking “conceptually separable” design elements even though those design elements rendered it usable secondarily solely as an artistic work. There is danger in this approach in that it would deny copyright protection to designs of works of art displayed by a minority because they are also used by a majority as useful articles. The copyrightable design of a life-size sculpture of the human body should not lose its copyright protection simply because mannequin manufacturers copy it, replicate it in cheap materials, and sell it in large quantities to department stores to display clothing.

A somewhat related approach, suggested by a sentence in Judge Oakes' opinion in *Kieselstein-Cord*, is to uphold the copyright whenever the decorative or aesthetically pleasing aspect of the article can be said to be "primary" and the utilitarian function can be said to be "secondary." This approach apparently does not focus on frequency of utilitarian and non-utilitarian usage since the belt buckles in that case were frequently used to fasten belts and less frequently used as pieces of ornamental jewelry displayed at various locations other than the waist. The difficulty with this approach is that it offers little guidance to the trier of fact, or the judge endeavoring to determine whether a triable issue of fact exists, as to what is being measured by the classifications "primary" and "secondary."

Another approach, also related to the first, is suggested by Professor Nimmer, who argues that "conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities." This "market" approach risks allowing a copyright only to designs of forms within the domain of popular art, a hazard Professor Nimmer acknowledges. However, various sculpted forms would be recognized as works of art by many, even though those willing to purchase them for display in their homes might be few in number and not a "significant segment of the community."

Some might suggest that "conceptual separability" exists whenever the design of a form has sufficient aesthetic appeal to be appreciated for its artistic qualities. That approach has plainly been rejected by Congress. The House Report makes clear that, if the artistic features cannot be identified separately, the work is not copyrightable even though such features are "aesthetically satisfying and valuable." A chair may be so artistically designed as to merit display in a museum, but that fact alone cannot satisfy the test of "conceptual separateness." The viewer in the museum sees and apprehends a well-designed chair, not a work of art with a design that is conceptually separate from the functional purposes of an object on which people sit.

How, then, is "conceptual separateness" to be determined? In my view, the answer derives from the word "conceptual." For the design features to be "conceptually separate" from the utilitarian aspects of the useful article that embodies the design, the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function. The test turns on what may reasonably be understood to be occurring in the mind of the beholder or, as some might say, in the "mind's eye" of the beholder. This formulation requires consideration of who the beholder is and when a concept may be considered "separate."

I think the relevant beholder must be that most useful legal personage -- the ordinary, reasonable observer. This is the same person the law enlists to decide other conceptual issues in copyright law, such as whether an allegedly infringing work bears a substantial similarity to a copyrighted work. Of course, the ordinary observer does not actually decide the issue; the trier of fact

determines the issue in light of the impressions reasonably expected to be made upon the hypothetical ordinary observer. And, as with other issues decided by reference to the reactions of an ordinary observer, a particular case may present undisputed facts from which a reasonable trier could reach only one conclusion, in which event the side favored by that conclusion is entitled to prevail as a matter of law and have summary judgment entered in its favor.

The “separateness” of the utilitarian and non-utilitarian concepts engendered by an article’s design is itself a perplexing concept. I think the requisite “separateness” exists whenever the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously. Again, the example of the artistically designed chair displayed in a museum may be helpful. The ordinary observer can be expected to apprehend the design of a chair whenever the object is viewed. He may, in addition, entertain the concept of a work of art, but, if this second concept is engendered in the observer’s mind simultaneously with the concept of the article’s utilitarian function, the requisite “separateness” does not exist. The test is not whether the observer fails to recognize the object as a chair but only whether the concept of the utilitarian function can be displaced in the mind by some other concept. That does not occur, at least for the ordinary observer, when viewing even the most artistically designed chair. It may occur, however, when viewing some other object if the utilitarian function of the object is not perceived at all; it may also occur, even when the utilitarian function is perceived by observation, perhaps aided by explanation, if the concept of the utilitarian function can be displaced in the observer’s mind while he entertains the separate concept of some non-utilitarian function. The separate concept will normally be that of a work of art.

Some might think that the requisite separability of concepts exists whenever the design of a form engenders in the mind of the ordinary observer any concept that is distinct from the concept of the form’s utilitarian function. Under this approach, the design of an artistically designed chair would receive copyright protection if the ordinary observer viewing it would entertain the concept of a work of art in addition to the concept of a chair. That approach, I fear, would subvert the Congressional effort to deny copyright protection to designs of useful articles that are aesthetically pleasing. The impression of an aesthetically pleasing design would be characterized by many as the impression of a work of art, thereby blurring the line Congress has sought to maintain. I believe we would be more faithful to the Congressional scheme if we insisted that a concept, such as that of a work of art, is “separate” from the concept of an article’s utilitarian function only when the non-utilitarian concept can be entertained in the mind of the ordinary observer without at the same time contemplating the utilitarian function. This temporal sense of separateness permits the designs of some useful articles to enjoy copyright protection, as provided by the 1976 Act, but avoids according protection to every design that can be appreciated as a work of art, a result Congress rejected. The utilitarian function is not truly a separate

concept for purposes of “conceptual separateness” unless the design engenders a non-utilitarian concept without at the same time engendering the concept of a utilitarian function.

In endeavoring to draw the line between the design of an aesthetically pleasing useful article, which is not copyrightable, and the copyrightable design of a useful article that engenders a concept separate from the concept of its utilitarian function, courts will inevitably be drawn into some minimal inquiry as to the nature of art. The need for the inquiry is regrettable, since courts must not become the arbiters of taste in art or any other aspect of aesthetics. However, as long as “conceptual separability” determines whether the design of a useful article is copyrightable, some threshold assessment of art is inevitable since the separate concept that will satisfy the test of “conceptual separability” will often be the concept of a work of art. Of course, courts must not assess the *quality* of art, but a determination of whether a design engenders the concept of a work of art, separate from the concept of an article’s utilitarian function, necessarily requires some consideration of whether the object *is* a work of art.

Both the trier determining the factual issue of “conceptual separability” and the judge deciding whether the undisputed facts permit a reasonable trier to reach only one conclusion on the issue are entitled to consider whatever evidence might be helpful on the issue, in addition to the visual impressions gained from the article in question. Thus, the fact that an object has been displayed or used apart from its utilitarian function, the extent of such display or use, and whether such display or use resulted from purchases would all be relevant in determining whether the design of the object engenders a separable concept of a work of art. In addition, expert opinion and survey evidence ought generally to be received. The issue need not turn on the immediate reaction of the ordinary observer but on whether visual inspection of the article and consideration of all pertinent evidence would engender in the observer’s mind a separate non-utilitarian concept that can displace, at least temporarily, the utilitarian concept.

This approach seems consistent with and may even explain the few cases to have considered the issue, although the language in all of the decisions may not be entirely reconcilable. In *Kieselstein-Cord*, we upheld the copyrightability of the artistic design of two belt buckles. This holding was based upon a conclusion that the design of the buckles was conceptually separate from the utilitarian function of fastening a belt. That view, in turn, was based in part on the undisputed fact that consumers with some frequency wore the buckles as ornamental jewelry at locations other than the waist. The Court apparently concluded that the buckles had created in the minds of those consumers a conception of the design as ornamental jewelry separate from the functional aspect of a belt buckle. Expert testimony supported the view that the buckles “rise to the level of creative art.” The case was characterized by Judge Oakes as “on a razor’s edge of copyright law,” as indeed it was; some might have thought that even though some consumers wore the buckle as ornamental jewelry, they still thought of the article as a belt buckle, albeit one so artistically designed as to be appropriate for wearing elsewhere than at the

waist. Whether the concept in the mind of the ordinary observer was of a piece of ornamental jewelry, separate from the concept of a belt buckle, or only the concept of a belt buckle that could be used either to fasten a belt or decorate clothing at any location was undoubtedly a close question.

In *Trans-World Manufacturing Corp.*, the interesting design of a display case for eyeglasses was deemed to create for the trier of fact a fair question as to whether a concept separable from the utilitarian function existed. By contrast, the designs of the wheel cover in *Norris Industries v. I.T. & T.*, and the outdoor lighting fixture in *Esquire, Inc. v. Ringer* were each deemed, as a matter of law, to engender no concept that was separable from the utilitarian function of each article. It evidently was thought that an ordinary observer viewing the articles would have in mind no conception separate from that of a wheel cover (*Norris*) or a lighting fixture (*Esquire*).

Our case involving the four styrene chest forms seems to me a much easier case than *Kieselstein-Cord*. An ordinary observer, indeed, an ordinary reader of this opinion who views the two unclothed forms depicted in figures 1 and 2 below, would be most unlikely even to entertain, from visual inspection alone, the concept of a mannequin with the utilitarian function of displaying a shirt or a blouse. The initial concept in the observer's mind, I believe, would be of an art object, an entirely understandable mental impression based on previous viewing of unclad torsos displayed as artistic sculptures. Even after learning that these two forms are used to display clothing in retail stores, the only reasonable conclusion that an ordinary viewer would reach is that the forms have both a utilitarian function and an entirely separate function of serving as a work of art. I am confident that the ordinary observer could reasonably conclude only that these two forms are not simply mannequins that happen to have sufficient aesthetic appeal to qualify as works of art, but that the conception in the mind is that of a work of art *in addition to and capable of being entertained separately from* the concept of a mannequin, if the latter concept is entertained at all. As appellant contends, with pardonable hyperbole, the design of Michaelangelo's "David" would not cease to be copyrightable simply because cheap copies of it were used by a retail store to display clothing.

This is not to suggest that the design of every form intended for use as a mannequin automatically qualifies for copyright protection whenever it is deemed to have artistic merit. Many mannequins, perhaps most, by virtue of the combination of the material used, the angular configuration of the limbs, the facial features, and the representation of hair create the visual impression that they are mannequins and not anything else. The fact that in some instances a mannequin of that sort is displayed in a store as an eye-catching item apart from its function of enhancing the appearance of clothes, in a living room as a conversation piece, or even in a museum as an interesting example of contemporary industrial design does not mean that it engenders a concept separate from the concept of a mannequin. The two forms depicted in figures 1 and 2, however, if perceived as mannequins at all, clearly engender



an entirely separable concept of an art object, one that can be entertained in the mind without simultaneously perceiving the forms as mannequins at all.

The majority appears to resist this conclusion for two reasons. First, the majority asserts that the appellant is seeking application of a lower level of scrutiny on the issue of copyrightability because the forms depict a portion of the human body. I do not find this argument anywhere in the appellant's briefs. In any event, I agree with the majority that no lower level of scrutiny is appropriate. But to reject a lower level is not to explain why appellant does not prevail under the normal level. Second, the majority contends that the design features of the forms are "inextricably intertwined" with their utilitarian function. This intertwining is said to result from the fact that a form must have "some configuration of the chest and some width of shoulders" in order to serve its utilitarian function. With deference, I believe this approach misapplies, if it does not ignore, the principle of "conceptual separability." Of course, the design features of these forms render them suitable for their utilitarian function. But that fact only creates the issue of "conceptual separability"; it does not resolve it. The question to be decided is whether the design features of these forms create in the mind of an ordinary viewer a concept that is entirely separable from the utilitarian function. Unlike a form that always creates in the observer's mind the concept of a mannequin, each of these unclothed forms creates the separate concept of an object of art -- not just an aesthetically pleasing mannequin, but an object of art that in the mind's eye can be appreciated as something other than a mannequin.

Of course, appellant's entitlement to a copyright on the design of the unclothed forms would give it only limited, though apparently valuable, protection. The copyright would not bar imitators from designing human chests. It would only bar them from copying the precise design embodied in appellant's forms.

As for the two forms, depicted in figures 3 and 4 below, of chests clothed with a shirt or a blouse, I am uncertain what concept or concepts would be engendered in the mind of an ordinary observer.

I think it is likely that these forms too would engender the separately entertained concept of an art object whether or not they also engendered the concept of a mannequin. But this is not the only conclusion a reasonable trier could reach as to the perception of an ordinary observer. That observer might always perceive them as mannequins or perhaps as devices advertising for sale the particular style of shirt or blouse sculpted on each form. I think a reasonable trier could conclude either way on the issue of "conceptual separability" as to the clothed forms. That issue is therefore not amenable to summary judgment and should, in my view, be remanded for trial. In any event, I do not agree that the only reasonable conclusion a trier of fact could reach is that the clothed forms create no concept separable from the concept of their utilitarian function.

**Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (1987)**

OAKES, J.

In passing the Copyright Act of 1976 Congress attempted to distinguish between protectable “works of applied art” and “industrial designs not subject to copyright protection.” The courts, however, have had difficulty framing tests by which the fine line establishing what is and what is not copyrightable can be drawn. Once again we are called upon to draw such a line, this time in a case involving the “RIBBON Rack,” a bicycle rack made of bent tubing that is said to have originated from a wire sculpture. (A photograph of the rack is contained in the appendix to this opinion.) We are also called upon to determine whether there is any trademark protection available to the manufacturer of the bicycle rack, appellant Brandir International, Inc. The Register of Copyright, named as a third-party defendant under the statute, but electing not to appear, denied copyrightability. In the subsequent suit brought in the United States District Court for the Southern District of New York, Charles S. Haight, Jr., Judge, the district court granted summary judgment on both the copyright and trademark claims to defendant Cascade Pacific Lumber Co., d/b/a Columbia Cascade Co., manufacturer of a similar bicycle rack. We affirm as to the copyright claim, but reverse and remand as to the trademark claim.

Against the history of copyright protection well set out in the majority opinion in *Carol Barnhart Inc. v. Economy Cover Corp.* and in Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 709–17 (1983), Congress adopted the Copyright Act of 1976. The “works of art” classification of the Copyright Act of 1909 was omitted and replaced by reference to “pictorial, graphic, and sculptural works.” According to the House Report, the new category was intended to supply “as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.” The statutory definition of “pictorial, graphic, and sculptural works” states that “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.” The legislative history added gloss on the criteria of separate identity and independent existence in saying:

On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.

As courts and commentators have come to realize, however, the line Congress attempted to draw between copyrightable art and noncopyrightable design “was neither clear nor new.” One aspect of the distinction that has drawn considerable attention is the reference in the House Report to “physically *or conceptually*” (emphasis added) separable elements. The District of Columbia Circuit in *Esquire, Inc. v. Ringer* called this an “isolated reference” and gave it no significance. Professor Nimmer, however, seemed to favor the observations of Judge Harold Leventhal in his concurrence in *Esquire*, who stated that “the overall legislative policy . . . sustains the Copyright Office in its effort to distinguish between the instances where the aesthetic element is conceptually severable and the instances where the aesthetic element is inextricably interwoven with the utilitarian aspect of the article.” Looking to the section 101 definition of works of artistic craftsmanship requiring that artistic features be “capable of existing independently of the utilitarian aspects,” Professor Nimmer queries whether that requires *physical* as distinguished from *conceptual* separability, but answers his query by saying “there is reason to conclude that it does not.” In any event, in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, this court accepted the idea that copyrightability can adhere in the “conceptual” separation of an artistic element. Indeed, the court went on to find such conceptual separation in reference to ornate belt buckles that could be and were worn separately as jewelry. *Kieselstein-Cord* was followed in *Norris Industries, Inc. v. International Telephone & Telegraph Corp.*, although there the court upheld the Register’s refusal to register automobile wire wheel covers, finding no “conceptually separable” work of art.

In *Carol Barnhart Inc. v. Economy Cover Corp.*, a divided panel of this circuit affirmed a district court grant of summary judgment of noncopyrightability of four life-sized, anatomically correct human torso forms. *Carol Barnhart* distinguished *Kieselstein-Cord*, but it surely did not overrule it. The distinction made was that the ornamented surfaces of the *Kieselstein-Cord* belt buckles “were not in any respect required by their utilitarian functions,” but the features claimed to be aesthetic or artistic in the *Carol Barnhart* forms were “inextricably intertwined with the utilitarian feature, the display of clothes.” As Judge Newman’s dissent made clear, the *Carol Barnhart* majority did not dispute “that ‘conceptual separability’ is distinct from ‘physical separability’ and, when present, entitles the creator of a useful article to a copyright on its design.”

“Conceptual separability” is thus alive and well, at least in this circuit. The problem, however, is determining exactly what it is and how it is to be applied. Judge Newman’s illuminating discussion in dissent in *Carol Barnhart* proposed a test that aesthetic features are conceptually separable if “the article . . . stimulate[s] in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.” This approach has received favorable endorsement by at least one commentator, W. Patry, *Latman’s The Copyright Law* 43–45 (6th ed. 1986), who calls Judge Newman’s test the “temporal displacement” test. It is to be distinguished from other possible ways in which conceptual separability can be tested, including whether the primary use is as a utilitarian article as

opposed to an artistic work, whether the aesthetic aspects of the work can be said to be “primary,” and whether the article is marketable as art, none of which is very satisfactory. But Judge Newman’s test was rejected outright by the majority as “a standard so ethereal as to amount to a ‘nontest’ that would be extremely difficult, if not impossible, to administer or apply.”

Perhaps the differences between the majority and the dissent in *Carol Barnhart* might have been resolved had they had before them the Denicola article on *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*. There, Professor Denicola points out that although the Copyright Act of 1976 was an effort “to draw as clear a line as possible,” in truth “there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.” Denicola argues that “the statutory directive requires a distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear.” He views the statutory limitation of copyrightability as “an attempt to identify elements whose form and appearance reflect the unconstrained perspective of the artist,” such features not being the product of industrial design. “Copyrightability, therefore, should turn on the relationship between the proffered work and the process of industrial design.” He suggests that “the dominant characteristic of industrial design is the influence of nonaesthetic, utilitarian concerns” and hence concludes that copyrightability “ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations.” To state the Denicola test in the language of conceptual separability, if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.

We believe that Professor Denicola’s approach provides the best test for conceptual separability and, accordingly, adopt it here for several reasons. First, the approach is consistent with the holdings of our previous cases. In *Kieselstein-Cord*, for example, the artistic aspects of the belt buckles reflected purely aesthetic choices, independent of the buckles’ function, while in *Carol Barnhart* the distinctive features of the torsos -- the accurate anatomical design and the sculpted shirts and collars -- showed clearly the influence of functional concerns. Though the torsos bore artistic features, it was evident that the designer incorporated those features to further the usefulness of the torsos as mannequins. Second, the test’s emphasis on the influence of utilitarian concerns in the design process may help, as Denicola notes, to “alleviate the de facto discrimination against nonrepresentational art that has regrettably accompanied much of the current analysis.” Finally, and perhaps most importantly, we think Denicola’s test will not be too difficult to administer in practice. The work itself will continue to give “mute testimony” of its origins. In addition, the parties will be required to present evidence relating to the

design process and the nature of the work, with the trier of fact making the determination whether the aesthetic design elements are significantly influenced by functional considerations.

Turning now to the facts of this case, we note first that Brandir contends, and its chief owner David Levine testified, that the original design of the RIBBON Rack stemmed from wire sculptures that Levine had created, each formed from one continuous undulating piece of wire. These sculptures were, he said, created and displayed in his home as a means of personal expression, but apparently were never sold or displayed elsewhere. He also created a wire sculpture in the shape of a bicycle and states that he did not give any thought to the utilitarian application of any of his sculptures until he accidentally juxtaposed the bicycle sculpture with one of the self-standing wire sculptures. It was not until November 1978 that Levine seriously began pursuing the utilitarian application of his sculptures, when a friend, G. Duff Bailey, a bicycle buff and author of numerous articles about urban cycling, was at Levine's home and informed him that the sculptures would make excellent bicycle racks, permitting bicycles to be parked under the overloops as well as on top of the underloops. Following this meeting, Levine met several times with Bailey and others, completing the designs for the RIBBON Rack by the use of a vacuum cleaner hose, and submitting his drawings to a fabricator complete with dimensions. The Brandir RIBBON Rack began being nationally advertised and promoted for sale in September 1979.

In November 1982 Levine discovered that another company, Cascade Pacific Lumber Co., was selling a similar product. Thereafter, beginning in December 1982, a copyright notice was placed on all RIBBON Racks before shipment and on December 10, 1982, five copyright applications for registration were submitted to the Copyright Office. The Copyright Office refused registration by letter, stating that the RIBBON Rack did not contain any element that was "capable of independent existence as a copyrightable pictorial, graphic or sculptural work apart from the shape of the useful article." An appeal to the Copyright Office was denied by letter dated March 23, 1983, refusing registration on the above ground and alternatively on the ground that the design lacked originality, consisting of "nothing more than a familiar public domain symbol." In February 1984, after the denial of the second appeal of the examiner's decision, Brandir sent letters to customers enclosing copyright notices to be placed on racks sold prior to December 1982.

Between September 1979 and August 1982 Brandir spent some \$ 38,500 for advertising and promoting the RIBBON Rack, including some 85,000 pieces of promotional literature to architects and landscape architects. Additionally, since October 1982 Brandir has spent some \$ 66,000, including full-, half-, and quarter-page advertisements in architectural magazines such as *Landscape Architecture*, *Progressive Architecture*, and *Architectural Record*, indeed winning an advertising award from *Progressive Architecture* in January 1983. The RIBBON Rack has been featured in *Popular Science*, *Art and Architecture*, and *Design 384* magazines, and it won an Industrial Designers Society of America design award in the spring of 1980. In the spring of 1984 the RIBBON Rack was selected from 200

designs to be included among 77 of the designs exhibited at the Katonah Gallery in an exhibition entitled "The Product of Design: An Exploration of the Industrial Design Process," an exhibition that was written up in the *New York Times*.

Sales of the RIBBON Rack from September 1979 through January 1985 were in excess of \$ 1,367,000. Prior to the time Cascade Pacific began offering for sale its bicycle rack in August 1982, Brandir's sales were \$ 436,000. The price of the RIBBON Rack ranges from \$ 395 up to \$ 2,025 for a stainless steel model and generally depends on the size of the rack, one of the most popular being the RB-7, selling for \$ 485.

Applying Professor Denicola's test to the RIBBON Rack, we find that the rack is not copyrightable. It seems clear that the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements. This is true even though the sculptures which inspired the RIBBON Rack may well have been -- the issue of originality aside -- copyrightable.

Brandir argues correctly that a copyrighted work of art does not lose its protected status merely because it subsequently is put to a functional use. The Supreme Court so held in *Mazer v. Stein*, and Congress specifically intended to accept and codify *Mazer* in section 101 of the Copyright Act of 1976. The district court thus erred in ruling that, whatever the RIBBON Rack's origins, Brandir's commercialization of the rack disposed of the issue of its copyrightability.

Had Brandir merely adopted one of the existing sculptures as a bicycle rack, neither the application to a utilitarian end nor commercialization of that use would have caused the object to forfeit its copyrighted status. Comparison of the RIBBON Rack with the earlier sculptures, however, reveals that while the rack may have been derived in part from one of more "works of art," it is in its final form essentially a product of industrial design. In creating the RIBBON Rack, the designer has clearly adapted the original aesthetic elements to accommodate and further a utilitarian purpose. These altered design features of the RIBBON Rack, including the spacesaving, open design achieved by widening the upper loops to permit parking under as well as over the rack's curves, the straightened vertical elements that allow in- and above-ground installation of the rack, the ability to fit all types of bicycles and mopeds, and the heavy-gauged tubular construction of rustproof galvanized steel, are all features that combine to make for a safe, secure, and maintenance-free system of parking bicycles and mopeds. Its undulating shape is said in *Progressive Architecture*, January 1982, to permit double the storage of conventional bicycle racks. Moreover, the rack is manufactured from 2 3/8-inch standard steam pipe that is bent into form, the six-inch radius of the bends evidently resulting from bending the pipe according to a standard formula that yields bends having a radius equal to three times the nominal internal diameter of the pipe.

Brandir argues that its RIBBON Rack can and should be characterized as a sculptural work of art within the minimalist art movement. Minimalist sculpture's most outstanding feature is said to be its clarity and simplicity, in that it often takes the form of geometric shapes, lines, and forms that are pure and free of ornamentation and void of association. As Brandir's expert put it, "The meaning is to be found in, within, around and outside the work of art, allowing the artistic sensation to be experienced as well as intellectualized." People who use Foley Square in New York City see in the form of minimalist art the "Tilted Arc," which is on the plaza at 26 Federal Plaza. Numerous museums have had exhibitions of such art, and the school of minimalist art has many admirers.

It is unnecessary to determine whether to the art would the RIBBON Rack properly would be considered an example of minimalist sculpture. The result under the copyright statute is not changed. Using the test we have adopted, it is not enough that, to paraphrase Judge Newman, the rack may stimulate in the mind of the reasonable observer a concept separate from the bicycle rack concept. While the RIBBON Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices. Indeed, the visually pleasing proportions and symmetry of the rack represent design changes made in response to functional concerns. Judging from the awards the rack has received, it would seem in fact that Brandir has achieved with the RIBBON Rack the highest goal of modern industrial design, that is, the harmonious fusion of function and aesthetics. Thus there remains no artistic element of the RIBBON Rack that can be identified as separate and "capable of existing independently of, the utilitarian aspects of the article." Accordingly, we must affirm on the copyright claim.

As to whether the configuration of Brandir's bicycle rack can be protected under either section 43(a) of the Lanham Act or New York State unfair competition law, we are reminded that the design of a product itself may function as its packaging or protectable trade dress. The district court dismissed Brandir's claims, saying that its analysis of the copyright issue was sufficient to dispose of the Lanham Act and common law claims. The court stated "the design feature of the Ribbon Racks is clearly dictated by the function to be performed, namely, holding up bicycles. If the steam pipes were not bent into the design, but instead remained flat, the bicycles would not stand up, they would fall down." But as Judge Newman noted in his dissent in *Carol Barnhart*, the principle of conceptual separability of functional design elements in copyright law is different from the somewhat similar principle of functionality as developed in trademark law. For trademark purposes, he pointed out, a design feature "has been said to be functional if it is 'essential to the use or purpose of the article' or 'affects the cost or quality of the article.'"

Here, the district court limited its inquiry to determining whether portions of the RIBBON Rack performed the function of a bicycle rack. But the fact that a design feature performs a function does not

make it essential to the performance of that function; it is instead the absence of alternative constructions performing the same function that renders the feature functional. Thus, the true test of functionality is not whether the feature in question performs a function, but whether the feature “is dictated by the functions to be performed,” as evidenced by available alternative constructions. There are numerous alternative bicycle rack constructions. The nature, price, and utility of these constructions are material issues of fact not suitable for determination by summary judgment. For example, while it is true that the materials used by Brandir are standard-size pipes, we have no way of knowing whether the particular size and weight of the pipes used is the best, the most economical, or the only available size and weight pipe in the marketplace. We would rather think the opposite might be the case. So, too, with the dimension of the bends being dictated by a standard formula corresponding to the pipe size; it could be that there are many standard radii and that the particular radius of Brandir’s RIBBON Rack actually required new tooling. This issue of functionality on remand should be viewed in terms of bicycle racks generally and not one-piece undulating bicycle racks specifically. We reverse and remand as to the trademark and unfair competition claims.