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

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1. Current statutory provisions described;

2. Issues raised;

3. Solutions proposed via amending title 17.

In *Baker v Selden,* 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. 99 at 105 (1879).

Yet copyright law today embraces many three-dimensional objects (from chairs to belt buckles) whose “object is use”.

Rather than barring copyright for everything that might be functional, the statute seems to grope for a compromise that will protect the public’s interest in copying unpatented inventions, yet preserve some pleasing designs for copyright … searching for a dividing line that will give keep free for patent the physical designs of utilitarian significance, while allowing copyright to other aesthetic designs.

An initial task is to define what 'functions' belong to copyright and which to patents.

What are appropriate functions for copyrighted works?

For texts to educate us, for movies to enthrall us, for music to make us dance.

No special scrutiny needed when *these* functions are served.

The statute does a nice job (at least for items whose creativity resides in shape and line) in defining what is a proper copyright function and, by implication, what is not.

17 USC Section 101 defines the term “useful article” this way:

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 informa-tion.** . . .

Example of transition from BAKER V SELDEN to 1976 Copyright Act:

Sparky the toy horse has his copyright challenged in 1924

The Second Circuit quotes from *Baker:* the crucial line is 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 object of Sparky's creation was "the production of amusement in contemplation."

In our terms,
Sparky was not a 'useful object'.

Are the **functions that copyrights can legitimately serve** limited to these:
"**to portray the appearance of the article or to convey information**" ?
— section 101

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. (For other works– musical works, for example– we'd describe the proper copyright functions a bit differently.)

Musical tones that release a telephone message machine or a vocalization that decodes an encrypted file or a musical score whose notes are so attractively arranged that the score is used as wallpaper…. These are music's "useful articles." No statute for them yet.

"Useful articles" get special scrutiny:

"**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**."**

(Emphases added, of course.)

Thus, useful articles are copyrightable only if they pass a new hurdle, usually called the **“separability”** test.

Example: 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, photographs, and drawings are not “useful works,” because they merely convey appearance or information.

Like Sparky the horse doll, they are not ‘useful works.’

They are all therefore PGS works copyrightable without reference to separability.

Ordinarily, the owner of copyright in a PGS work has rights to:

- control derivative works based on the copyrighted work (section 106(2)),
  and
- to control the sale (section 106(3)) and
- display (section 106(5)) of any derivative work made without her consent.

MIGHT THIS POSE A PROBLEM?

A machine built according to a copyrighted blueprint or drawing is plausibly a three-dimensional derivative work of the pictorial work.

By the simple act of drawing a picture of a new machine that's to be built, should the artist gain a PGS copyright that gives her as 'author' the exclusive right to **forbid others to make, sell, or display** the machine itself?

Parenthetical:
WHY CONTROL OVER **SALES AND DISPLAYS**?

Answer:
Neither the first sale doctrine nor the liberty of public display 'at the place where the copy is located' are available for objects that are unlawfully made. Section 109.

This degree of control would discourage many inventors from using the patent system

PATENT HAS CHARACTERISTICS THAT ARE PUBLICLY BENEFICIAL BUT COSTLY TO THE TYPICAL PATENT HOLDER

- short term
- pre-issuance review
- requirement of disclosure
- rigorous substantive criteria
- fairly narrow doctrine of equivalents
- willingness to grant patents in improvements made without the consent of the entity holding the patent in the improved invention.

Were copyright to substitute for patent, innovation might be discouraged.

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.

Most machines and other utilitarian objects can be drawn in a virtually infinite number of styles, and from a large number of different visual perspectives.

Merger is unlikely to help, at least as conventionally understood.

Need for COPYRIGHT to defer to PATENT, cont'd.

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 that are given to "the owner of copyright in **a work that portrays a useful article as such**"

Section 114(b) provides:

"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."

What were the pre-1978 cases referred to in section 114(b):

They basically held that copyright in **a drawing or other pictorial or sculptural work was *not infringed* by someone making a useful article from that PGS work. Such copying was permitted.**

The cases **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 plaintiff's copyrighted 2-dimensional drawing from which the useful invention was copied.

Congress put this privilege, somewhat tailored, 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. To recap:

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.'

b. Courts cannot agree on what separability means.

Regarding the wide margin of safety:

If our world possessed ‘perfect machinery of justice,’ then the separability test might bar more copyrights than would be required by the need for deferring to patent law. The ‘moat’ the separability test draws around patent law may be broader than it needs to be.

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. If a great many seemingly random variations are potentially useful to science, then maybe copyright should be barred in all of them.

Nevertheless, I understand the good-faith argument that ‘separability’ will likely bar protection for many attractive variations that offer no conceivable advantage over alternative designs other than aesthetics.

Various forms of U.S. law require something less than separability as pre-requisite for non-patent 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 not “functionally required.”

My replies:

a. **Asymmetric error costs require 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. **When a copyrights is erroneously granted i**n utilitarian advances, real dangers are posed to competition by copyright's multi-generational exclusive term length, automatic availability, broad scope, and limits on the ownership of unauthorized variations. **When a copyright is erroneously denied, a true advance can still seek shelter under patent law.**

   As a result, **error costs are not symmetrical.**

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.

Patent’s pro-competition policies care about safeguarding the liberty to copy nonpatented inventions.

The current copyright provision can do that, but it’s a verbal strain.

We should amend section 102, or the 101 definition of PGS works, to read as follows:

<u>Revision:</u>

Copyright is barred unless the "design of a useful article possesses **utilitarian aspects that are capable of existing independently** of those aspects of the article that serve purposes solely of information 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 of the copier's product."]**

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 paragraph of my new statute would restate the content of 114(b), but more explicitly; the second paragraph 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 in 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.

Consider that in deciding whether or not to grant copyright registration in an attractive teapot or chair, **the Copyright Office may not have much information** about what aspects of the design serve functions other than appearance.

It's precisely that kind of information deficit that makes a 'moat' or 'margin for error' advisable.

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

My proposed Section 130 (a) and (b) 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 Legislation for Design

- Computer Program Copyrights

RESTATING THE AMENDMENTS

AMENDMENT REGARDING EXCLUSIVE RIGHTS: 17 USC sec [130]

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 in 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.

Amendment regarding subject matter

For a redefinition of PGS works in sec 101:

Copyright is barred unless the design of a useful article possesses **utilitarian aspects that are capable of existing independently** of those aspects of the article that serve purposes solely of information 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.**

For a new definition in sec. 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.