

3-1-1987

# Copyright Infringement: When is a Swimsuit not a Swimsuit?

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## Recommended Citation

David M. Cordrey, *Copyright Infringement: When is a Swimsuit not a Swimsuit?*, 7 Loy. L.A. Ent. L. Rev. 453 (1987).  
Available at: <http://digitalcommons.lmu.edu/elr/vol7/iss2/12>

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## COPYRIGHT INFRINGEMENT: WHEN IS A SWIMSUIT NOT A SWIMSUIT?

When is a swimsuit not a swimsuit? Answer - according to the court in *Poe v. Missing Persons*,<sup>1</sup> (“Poe”) it’s not a swimsuit when an artist creates merely an interpretation of a swimsuit. This decision of the Ninth Circuit Court of Appeals illustrates the conceptual difficulty in enforcing copyrights and characterizing works of applied art.<sup>2</sup> Gregory Poe, (“Poe”) an artist, filed an action for damages against the rock group Missing Persons claiming copyright infringement for a piece he described “as an artwork in the medium of soft sculpture.”<sup>3</sup> Entitled “Aquatint No. 5,” the work resembled a swimsuit and was worn by lead singer Dale Bozzio on the front cover of Missing Persons’ debut album.<sup>4</sup>

Initially, the United States District Court for the Central District of California granted Missing Persons’ motion for summary judgment. The Court of Appeals, reversing the order, remanded the case for trial because evidence revealed a disputed issue of material fact, namely whether Aquatint No. 5 was a utilitarian article of clothing or a work of art.<sup>5</sup>

A graduate of the California Institute of the Arts, Poe is an artist and clothing designer whose styles are recognized throughout the fashion world. He claimed that Aquatint No. 5 was created in 1978 as “an artist’s impression or rendering of an article of clothing. . . . It stands by itself as a work of conceptual art.”<sup>6</sup> Poe regarded the article as a work of art, and presented it at an art show sponsored by the Los Angeles Institute for Contemporary Art.

In 1979, a photographer named Carla Weber asked to borrow Poe’s work, reportedly for use in her portfolio, and photographed Dale Bozzio wearing it. Aquatint No. 5 was marked “Gregory Poe ©,” at the time it was photographed. This photograph, as Poe subsequently discovered,

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1. 745 F.2d 1238 (9th Cir. 1984).

2. Works of applied art “encompass all original pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection.” H.R. REP. NO. 1476, 94th Cong., 2d Sess. 4, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5668 (hereinafter cited as “H.R. REP. NO. 1476”).

3. 745 F.2d at 1239.

4. *Id.* at 1241.

5. *Id.* at 1239.

6. *Id.* at 1240. Indeed in his application for copyright, Poe declared the article to be a “three-dimensional work of art in primarily flexible clear-vinyl and covered rock media.” *Id.*

appeared on the front cover of the band's first album "Missing Persons."<sup>7</sup> Although the album cover credited Poe as the designer, he had not consented to Aquatint No. 5's use, and subsequently filed a copyright infringement action against Missing Persons.

### I. AQUATINT NO. 5: "WORK OF APPLIED ART" OR "USEFUL ARTICLE?"

The appellate court had only one question to answer in resolving this dispute. That question was whether Aquatint No. 5 was to be identified as either a copyrightable "work of applied art," or simply a "useful article."<sup>8</sup> This distinction has confused courts for over thirty years,<sup>9</sup> pro-

7. *Id.* at 1241.

8. The Copyright Act of 1976, 17 U.S.C. § 101 (1982) provides, in relevant part: § 101. Definitions

...  
"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art. . . . 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 . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

...  
A "useful article" is 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."

17 U.S.C. § 102 provides generally for copyright protection of "pictorial, graphic, and sculptural works."

9. An examination into how the courts and statutes have distinguished between "works of applied art" and "useful articles" is helpful at this point.

The current Copyright Act replaced the 1909 Act. In relevant part, 17 U.S.C. § 5(g) (1909), indicated that "[w]orks of art; models or designs for works of art" are eligible for copyright protection. This language is more fully elaborated in regulations drafted by the Register, codified in 37 C.F.R. § 202.10. For instance in 37 C.F.R. § 202.10(a) (1948), protection is provided for "works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned. . . ."

The Supreme Court in *Mazer v. Stein*, 347 U.S. 201 (1954), ratified § 202.10(a), when it upheld copyright protection for a statuette used as a lamp base. *Mazer* stood for the principle that commercial use does not disqualify an otherwise registrable work of art from copyright protection. Under *Mazer*, conceivably any useful article somewhat aesthetically pleasing in appearance, could be afforded copyright protection with respect to its form. For a lengthier discussion, see 1 M. NIMMER, NIMMER ON COPYRIGHT, § 208[B] 2-88 (1986).

As a result, ensuing decisions have upheld copyrights for a wide range of articles. See, e.g., *Scarves by Vera, Inc. v. United Merchants & Mfrs.*, 173 F. Supp. 625 (S.D.N.Y. 1959) (designs printed on scarves); and *Doran v. Sunset House Distrib. Corp.*, 197 F. Supp. 940 (S.D. Cal. 1961), *aff'd*, 304 F.2d 251 (9th Cir. 1962) (Christmas decorations).

As a result of *Mazer*, in 1959 the Copyright Office implemented the following Regulation: (c) If the *sole intrinsic function* of an article is its utility; the fact that it is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a

ducing differing standards on how these terms should be applied.<sup>10</sup> Under the present Copyright Regulation,<sup>11</sup> a work is a "useful article" and denied copyright if it has "an intrinsic utilitarian function." This is so regardless of whether the article has other functions which are not utilitarian.<sup>12</sup> Thus, copyright can be denied to an article if one, and only one, of its "intrinsic" functions has utility.<sup>13</sup>

The district court in *Poe*, then, had to be convinced that Aquatint No. 5 was a "work of applied art"<sup>14</sup> before copyright protection would be granted to its' sculptural features. In other words, protection would be

utilitarian article incorporates features, such as artistic sculpture. . . which can be identified *separately* and are capable of existing independently as a work of art, such features will be eligible for registration.

37 C.F.R. § 202.10(c) (1959) (emphasis added).

10. *Esquire v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), restricted the interpretation of § 202.10(c), while in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980), the court adopted a more expansive view.

*Esquire* denied copyright registration for a lighting fixture claimed to have a distinct shape. The court supported the principle that industrial designs are not eligible for copyright, noting repeated Congressional rejection of legislation facilitating such protection. The court used as support the House Report drawing the line between copyrightable works of applied art and uncopyrighted works of "industrial design," which states that, "although the shape of an industrial product may be aesthetically satisfying and valuable, the [House Copyright] Committee's intention is not to offer it copyright protection under the bill." H.R. REP. NO. 1476, *supra* note 2, at 5668.

The *Esquire* court treated the "physically or conceptually" statement in § 202.10(c) as an "isolated reference." *Esquire*, 591 F.2d at 803-04. The court considered the passage in its entirety and held that the overall design of a utilitarian object, even if determined by aesthetic as well as functional considerations, is not eligible for copyright. *Id.*

*Esquire* further restricted the "sole intrinsic function" phrase in the 1959 Regulation. The district court granted copyright protection since the lighting fixture's "sole intrinsic function" was not utility; it served a decorative purpose as well. On appeal, this was rejected on grounds that the Regulation would be rendered meaningless. *Id.* at 804. Otherwise, so long as the overall shape of a utilitarian article embodies dual intrinsic functions — aesthetic and utilitarian — then it could be copyrighted. As support, the court quoted the newly enacted Copyright Act of 1976 which denies copyright where "an" intrinsic function is utilitarian. *Id.* (citing 17 U.S.C. § 101 (1982)).

*Kieselstein*, on the other hand, granted copyright status to two belt buckles described as "sculptured designs cast in precious metals — decorative in nature and used as jewelry." *Kieselstein*, 632 F.2d at 990. The decision was based on the view that "separability" could occur either "physically or conceptually," quoting as support H.R. REP. NO. 1476, *supra* note 2, at 5668. The court saw in the belt buckles "conceptually separable sculptural elements" deemed sufficient to accord copyright status. *Kieselstein*, 632 F.2d at 997.

11. 17 U.S.C. § 101 (1982). *See supra* note 8. This is an almost verbatim repetition of the C.F.R. § 202.10(c), but with a significant difference. Under the 1959 Regulation, copyright protection is denied an aesthetically pleasing article only when its sole intrinsic function is utility.

12. *Id.*

13. *Id.*

14. The appellate court defined this as, "an original sculptural work." *Poe*, 745 F.2d at 1241.

granted in two particular instances: where no intrinsic useful purpose was found, or, where the "sculptural features. . . [were] capable of existing independently of, the utilitarian aspects of the article."<sup>15</sup> The district court granted Missing Persons' motion for summary judgment. It determined the article could be used as a swimsuit, which was an "intrinsic useful purpose" and "the functional aspects of the *swimsuit* are not independent of the alleged sculptural/artistic aspects of the suit."<sup>16</sup>

## II. USEFULNESS: A QUESTION OF LAW OR FACT?

The Ninth Circuit refused to uphold the summary judgment since a genuine issue of material fact existed regarding Aquatint No. 5's usefulness.<sup>17</sup> Upon reviewing the evidence, the court concluded that there was a "disputed issue of material fact as to whether. . . 'Aquatint No. 5' [wa]s a utilitarian article of clothing or a work of art."<sup>18</sup> As such, the summary judgment was denied as a matter of law, and the case was reversed and remanded.<sup>19</sup>

The appellate court reached this conclusion because it felt that Aquatint No. 5's utility had not been adequately proven by Missing Persons, noting that the only evidence of its use was the single occasion it was worn by Dale Bozzio for the photograph session.<sup>20</sup> On the other hand, the court found ample evidence that Aquatint No. 5 was a piece of artwork. This "critical factual question" as to the usefulness of the article was for the "trier of fact [to decide] after a trial on the merits."<sup>21</sup> Thus the court would not decide as a matter of law whether Aquatint No. 5 could be worn as an article of clothing for swimming or any other utilitarian purpose, since it was not legally trained to make such a determination by a simple visual examination.<sup>22</sup>

At this point the Ninth Circuit described a useful article. First it stated the Congressional definition of a useful article that appears in 17 U.S.C. section 101, which describes a useful article as, "an article having an intrinsic utilitarian function that is not merely to portray the appear-

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15. *Id.*

16. *Id.* (emphasis added).

17. *Id.*

18. *Id.* at 1239.

19. *Id.*

20. *Id.* at 1241.

21. *Id.* at 1242.

22. *Id.* See also *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations." *Id.* at 251.

ance of the article."<sup>23</sup>

The Ninth Circuit examined the evidence presented by the two sides at the motion for the summary judgment and found that Poe had tried to create a work of art portraying an article of clothing. Significantly, it could not find any evidence that Poe had created an article of clothing that could function as a swimsuit. Thus, although Aquatint No. 5 might look like a swimsuit, it was not proven to intrinsically function as one which, as the Ninth Circuit noted, is required by section 101.<sup>24</sup>

### III. THE COURT IS SYMPATHETIC TO POE

Though not obvious, the Ninth Circuit appeared to be sympathetic to Gregory Poe. While it reversed the district court decision on grounds that a disputed issue of material fact existed, the opinion encouraged a finding that Aquatint No. 5 was a sculptural work. First, the Ninth Circuit went to great lengths to describe Aquatint No. 5's appearance,<sup>25</sup> even though a photograph of the article accompanied the opinion. Second, no mention was made of a crucial finding of fact by the district court: that in 1982 the Copyright Office had refused to register the work after Poe had applied for copyright registration.<sup>26</sup> Third, the appellate court actually quoted the description of Aquatint No. 5 that appeared in Poe's copyright application, (a "three dimensional work of art in primarily flexible clear-vinyl and covered rock media").<sup>27</sup> Fourth, the court noted that Aquatint No. 5 appeared in an art show sponsored by the Los Angeles Institute for Contemporary Art.<sup>28</sup> Finally, a lengthy portion of Poe's testimony was reproduced in the opinion apparently to show the distinction between his visual art, and his fashion designs of articles of

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23. See *supra* note 8.

24. *Poe*, 745 F.2d at 1242.

25. *Id.* at 1241. Note the intentionally technical language that is used by the court:

One part consists of two pieces of clear plastic material cut in a figure 8 shape. The figure 8 portion is 18 inches in length. The smaller loop of the figure 8 is 6½ inches across. The larger loop is 7½ inches across. Within each loop is a sealed area in the shape of a triangle filled with what appears to be crushed rock in a distinct color. A 70-inch clear plastic tube has been inserted through the end of the smaller loop of the figure 8.

The other section connects two pieces of clear plastic which have been cut into an angular shape with eight sides, wider at the ends and tapering towards the center. It is 15½ inches long and 7½ inches wide at each end. Within this eight-sided piece of plastic are two sealed areas which also contain crushed rock in the same colors present in the figure 8 shaped portion. The center has a width of three inches. Looped into one end of this part is a 75-inch long clear plastic tube. Looped through the other end is a 72-inch long clear plastic tube. *Id.*

26. *Id.*

27. 745 F.2d at 1240.

28. *Id.*

clothing.<sup>29</sup>

The overall picture given was not one of usefulness, but of sculpture. The court seemed to exert its influence and judgment, by using select wording, to persuade the future lower court that Aquatint No. 5 was a sculptural work. It was as if the court gave the benefit of the doubt to Poe, despite the findings of the lower court.

Missing Persons argued that an article's usefulness is a question of law,<sup>30</sup> however, the Ninth Circuit decided that the authority presented did not require every factual dispute over usefulness to be resolved as a question of law.<sup>31</sup> Indeed, the *Poe* court stated that since Aquatint No. 5's usefulness was still in dispute after all the evidence was presented, the case could not be treated in the same manner as the cited authority.<sup>32</sup>

#### IV. HOW IS USEFULNESS TO BE SHOWN?

Missing Persons argued that Poe could not present any relevant evidence to the trier of fact on the question of usefulness.<sup>33</sup> Here again, the Ninth Circuit was not convinced, stating that Poe had four possible sources from which to present evidence. The first was expert testimony concerning the usefulness of the article and whether any apparent functional aspects could be separated from the artistic aspects.<sup>34</sup> The second was evidence of Poe's intent in designing the article to determine whether it possessed a utilitarian function.<sup>35</sup> The third was evidence as to the custom and usage within the artworld and clothing trade concerning such objects.<sup>36</sup> The last was evidence of an article's marketability as a work of art.<sup>37</sup>

29. *Id.*

30. *Id.* at 1242. Missing Persons relied on *Fabrica, Inc. v. El Dorado Corp.*, 697 F.2d 890 (9th Cir. 1983). *Fabrica* sought copyright protection for a unique and high quality carpet sample display folder. *El Dorado* argued not only was the folder a "useful article" as described in § 101, but it was "functional" and therefore not protected. The Ninth Circuit Court of Appeals granted *El Dorado's* motion for a directed verdict, and found the folder was useful. Distinguishing that case, the *Poe* court stated that a directed verdict was upheld in *El Dorado* because it was undisputed, that the articles' "usefulness in marketing (was) their only reason for existence." *Poe*, 745 F.2d at 1242.

31. *Poe*, 745 F.2d at 1242.

32. *Id.*

33. *Id.* at 1243.

34. *Id.* (citing *Trans-World Mfg. v. Nyman & Sons, Inc.*, 95 F.R.D. 95, 99 (D.Del. 1982)).

35. *Poe*, 745 F.2d at 1243 (citing *Norris Indus. v. Int'l Tel. & Tel.*, 696 F.2d 918, 922 (11th Cir. 1983)).

36. *Poe*, 745 F.2d at 1243 (citing *May v. Morganelli-Heumann & Assoc.*, 618 F.2d 1363, 1368 (9th Cir. 1980)).

37. *Poe*, 745 F.2d at 1243 (citing 1 M. NIMMER, NIMMER ON COPYRIGHT, § 2.08[B], at 2-96.2—2-96.3 (1984)).

This section of the opinion creates limitations. First, it is unclear whether these factors should be the only sources from which evidence of usefulness can be drawn, or whether courts can review other types of evidence. Second, although these sources of evidence may help the trier of fact to decide the action, there are plausible reasons, discussed below, why they should not be reviewed.

This aspect of the opinion is most disturbing because of the Ninth Circuit's deviation from earlier precedent discussing the manner in which an article's usefulness is ascertained. As noted earlier, courts have struggled for many years attempting to develop a distinction between "useful articles" and "works of applied art."<sup>38</sup> The problem is a difficult one. In this instance, the district court granted a summary judgment based on the judge's view that Aquatint No. 5 was a utilitarian article. The Ninth Circuit reversed the summary judgment, correctly recognizing the concern that a judge should not arbitrate national taste based solely on his view of art.<sup>39</sup> In cases such as the one here, a summary judgment is entirely inappropriate in view of Congress' dual concerns of protecting artist creativity and preventing registration of industrial designs.<sup>40</sup>

The first source of evidence suggested by the Ninth Circuit was evidence from expert testimony.<sup>41</sup> Such a standard may seem helpful, as neither the Constitution nor the Copyright Act authorizes the judiciary to arbitrate national taste. As noted earlier, the judiciary has no particular ability to assess the merits of one type of art compared to another, since arguably the copyright law's encouragement of creativity and originality might be stultified.<sup>42</sup> There are problems, however, with using expert testimony. The art world, by definition and form, contains much variety. Should an artist's creativity and originality be controlled by testimony from an expert trying to define whether a given article is a work of art? Further, what happens when new artforms develop, yet to be recognized by the art world?<sup>43</sup>

38. See *supra* note 9.

39. *Poe*, 745 F.2d at 1238.

40. H.R. REP. NO. 1476, *supra* note 2, at 5668.

41. *Poe*, 745 F.2d at 1243.

42. The argument has been made that the judiciary is not able to decide whether an object is an applied work of art. But while "works of applied art" is "a loose phrase whose parameter is hard to define; nevertheless. . . the mere fact that the phrase. . . admits of debate does not make it different from many statutes whose interpretation is every day regarded as reviewable by the courts." *Vacheron & Constantin-Le-Coultré Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 640 (2d Cir. 1958).

43. Mr. Justice Holmes stated in *Bleistein v. Donaldson*, 188 U.S. 239 (1903):

At 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



The second source suggested by the court was evidence of an artist's intent in designing the article.<sup>44</sup> In other areas of the law, courts have largely examined the parties' intent to resolve disputes. Once again, however, in this area, the examination of an artist's intent is a difficult standard to apply. Congress has specifically stated that for the purposes of registration, copyright protection should only be granted on the basis of originality and creativity,<sup>45</sup> not whether an artist intended to create a work of applied art.<sup>46</sup> Given the Ninth Circuit's standard, the door would be opened to large numbers of industrial products, such as screwdrivers with colored handles or elaborate televisions, based merely on an artist's conception of his work.<sup>47</sup>

Further, such a standard contradicts the language of the Code of Federal Regulations, which explicitly states, "[T]he registrability of a work of art is *not affected by the intention of the author as to the use of the work*, the number of copies reproduced or the fact that it appears on a textural material or textural product."<sup>48</sup> Additionally, looking at an artist's intent contradicts the Supreme Court decision in *Mazer*, which stated, "We find *nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration*. We do not read such a limitation into the copyright law."<sup>49</sup>

The third source suggested by the court was evidence of custom and usage within the art world.<sup>50</sup> This is just as troublesome as the other sources, since such evidence ignores the fact that an artform may be revolutionary or unrecognized within the community.<sup>51</sup> How a court can

which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya and the paintings of Manet would have been sure of protection when seen for the first time.

44. *Poe*, 745 F.2d at 1243.

45. See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 994 (2d Cir. 1980) ("[All works of art must meet] the basic requirements of originality and creativity. . .").

46. *Esquire v. Ringer*, 591 F.2d 796, 804 (D.C. Cir. 1978). "The overall design or configuration of a utilitarian object, *even if it is determined by aesthetic as well as functional considerations*, is not eligible for copyright." *Id.* (emphasis added).

47. *Id.* at 805. "Such an extension of the nondiscrimination principle would undermine other plainly legitimate goals of copyright law — in this case the congressional directive that copyright protection should not be afforded to industrial designs." *Id.*

48. 37 C.F.R. § 202.10(a) (emphasis added).

49. *Mazer v. Stein*, 347 U.S. 201, 218 (1954) (emphasis added).

50. *Poe*, 745 F.2d at 1243.

51. As Professor Nimmer has stated:

[If] a work might arguably be regarded as a work of art by any meaningful segment of the population, be they high-brow, low-brow, hippy, avant-guard, middle class-bourgeois, adult or juvenile then the work must be considered a work of art for copyright purposes.

accurately define "custom and usage" must be questioned. This court has given no guidelines. Indeed the task of defining custom and usage would probably perplex the most knowledgeable of art experts. Thus, it must be asked whether a court has the ability to judge effectively and objectively the difference between an artform that has been accepted as custom, and an artform that has yet to be recognized as custom.

The fourth source suggested by the court, was evidence of an article's marketability.<sup>52</sup> It has been articulated that an article can be registered where "there is any substantial likelihood that even if an article had no utilitarian use, it would still be marketable to some significant segment of the community simply because of its aesthetic qualities."<sup>53</sup> In other words, if Aquatint No. 5 had no use as a swimsuit, the trier of fact could be shown evidence that the article had retail value as a work of applied art. However, as pointed out by Professor Nimmer, adopting a "likelihood of marketability" standard is strange to copyright, being difficult to prove, and perhaps favoring more conventional forms of art.<sup>54</sup>

The Ninth Circuit is seeking to establish a practical standard to differentiate between a "useful article" and a "work of applied art." This is a laudable intention, yet such a simple four-part test is unworkable due to the complexities of "art." As recognized by Professor Nimmer, "[it] is apparent that no very precise standard can be evolved which will determine in advance with any certainty whether certain borderline objects will be regarded as works of art."<sup>55</sup> Further as stated in the Supreme Court decision in *Mazer*, "individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art."<sup>56</sup> By setting out four factors by which a court can evaluate an article's usefulness, the Ninth Circuit has attempted to define art — a task that is insurmountable for even the most knowledgeable of art experts. The court should have followed the approach used by *Mazer*, that is, examine the entire factual setting in order to decide the question of usefulness, without restricting the types of evidence to be examined. Unfortunately, the Ninth Circuit has effectively formulated a narrow conception of art.

A further problem is that the Ninth Circuit failed to examine the

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1 M. NIMMER, NIMMER ON COPYRIGHT, § 2.08[B], at 2-85 (1983).

52. *Poe*, 745 F.2d at 1243.

53. 1 M. NIMMER, *supra* note 51, at 2-96.2.

54. *Id.* at 2-96.3. Note that this type of evidence also is restricted by the language in *Mazer*, 347 U.S. at 218. "We find nothing in the copyright statute to support the argument that the . . . use in industry of an article eligible for copyright bars or invalidates its registration." *Id.*

55. 1 M. NIMMER, *supra* note 51, at 2-85.

56. *Mazer*, 347 U.S. at 214.

crucial differences between the opinions of *Esquire* and *Kieselstein*.<sup>57</sup> Both of these cases relied on the same Congressional House Report<sup>58</sup> which stated that an industrial product could not be protected unless some element, either conceptually or physically, could be identified as separable from the utilitarian aspects of the article.<sup>59</sup> Whereas *Esquire* stated that conceptual separability was insufficient, *Kieselstein* stated conceptual separability was sufficient by itself to accord copyright protection.<sup>60</sup> In this case, had the Ninth Circuit explicitly followed the *Kieselstein* approach, then arguably the case could have been decided merely by looking at conceptual elements such as an artist's intent. Had the court followed the *Esquire* approach, evidence of physical separability would have to be shown before registration could be granted. However, the court never even discussed this issue.

#### V. THE EFFECT OF THE DECISION FOR COPYRIGHTING WORKS OF APPLIED ART

The Ninth Circuit has attempted to provide future cases with a guideline on approaching the subject of usefulness. If there is a dispute regarding usefulness, then the question should go to the trier of fact. In the *Poe* court's view, a court is not qualified to make such a determination, unless evidence is presented from the four factors previously listed.

Not allowing summary judgments in cases such as this is a justifiable decision by the Ninth Circuit. As noted earlier, this area of the law has confused courts for over thirty years.<sup>61</sup> The concern that judges should not arbitrate national taste, logically leads to the conclusion that a dispute over an article's usefulness should be one for the trier of fact to decide. Given the nature of the subject, most cases related to applied works of art will inevitably contain a dispute as to the usefulness of the article. As a result, any party attempting to either prove or disprove an article's usefulness will be faced with a potentially lengthy suit. Yet this

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57. For a discussion of these cases *see supra* note 10.

58. H.R. REP. NO. 1476, *supra* note 2, at 5668.

59. *Id.*

60. The *Kieselstein* court gives an example of an aesthetic element that is conceptually separable. 632 F.2d at 993. The court states:

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.

*Id.*

61. *Esquire*, 591 F.2d at 803-04.

is a minor concern when compared to the dual interests of Congress in protecting an artist's creativity and preventing the registration of industrial products.

The court has set out four sources from which evidence can be brought to settle the issue of usefulness. Apart from the fact that precedent has never really attempted to set up a rigid test for usefulness, the four sources chosen lead to an artificial limitation in this area of copyright. For example, when an article is claimed to be an "applied work of art," a court will now have to look at a range of factors, from the intent of the artist to the article's marketability, in order to decide if it can be protected. Thus, it is conceivable that an article could be granted copyright protection merely based on the artist's state of mind, and so thwarting the purpose of the copyright regulation of denying registration to "useful products."<sup>62</sup> This is troublesome, especially since the Ninth Circuit does not discuss the dispute over "conceptual separability" that is articulated in *Kieselstein and Esquire*.

The Ninth Circuit should not have departed from the approach taken by earlier cases. The issue of an article's usefulness cannot be limited to evidence from the four sources suggested, but must be flexible due to the nature of an artistic work. Otherwise, not only courts, but also artists, art experts, industrial designers and art lovers, will be restricted to the Ninth Circuit's view of what constitutes usefulness.

*David M. Cordrey*

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62. See *supra* note 48.

