Patent and Copyright Interfaces

Tom Field

Baker v. Selden, 101 U.S. 99 (1879), apparently provided the first opportunity to distinguish patents and copyrights. The opinion states, 101 U.S. at 105: "The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other 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." It thereby lays the foundation for 17 U.S.C. § 102(b) — a provision that similarly attempts to exclude copyright protection for potentially patentable subject matter.

In the same vein, Mazer v. Stein, 347 U.S. 201 (1954), also registers well over 7 on IP Richter Scale. After offering several general distinctions between copyrights and patents, it says, 347 U.S. at 218: "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."

Mazer was the genesis of several provisions in the Copyright Act, particularly the definitions of "pictorial, graphic and sculptural works" and "useful article[s]" in § 101. But see also § 113, addressing infringement of qualifying works.

The current state of affairs is expressed most poignantly in Masquerade Novelty, Inc. v. Unique Industries, Inc., 912 F.2d 663, 670 (3d Cir. 1990): "Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function." To decide whether nose masks are copyrightable, Judge Stapleton turned to § 101's provision that useful articles have "an intrinsic function that is not merely to portray [their] appearance… or to convey information." Finding no such function, he upheld their copyrights.

Consider, too, Pivot Point Int'l, Inc. v. Charlene Products, Inc., 170 F.Supp.2d 828 (N.D. Ill. 2001), where Judge Easterbrook, sitting by designation, was the fifth judge assigned to the eleven-year-old suit alleging infringement of a mannequin. Its functions are described, 170 F.Supp.2d at 831, thus: "Students in beauty schools practice styling hair on Mara's head and may practice other skills by applying makeup to Mara's eyes, lips, and cheeks. The parties dispute which functions are primary. … But Pivot Point contends only that Mara's 'primary' use is hair styling; it does not deny that… the evidence would not permit a reasonable jury to conclude that Mara has *no* utilitarian value for makeup practice. (Pivot Point says that it 'generally' sells Mara with painted-on makeup, which reveals by negative implication that it *also* sells Mara without eye or cheek coloring, so that beauty-school students can add their own.)" [Emphasis in original.]

The sole-function limitation of the "useful article" definition is implicit in language italicized above, but, instead of fully exploring that, the opinion turns to the definition of "pictorial, graphic and sculptural works." Because the latter limits protection to "features that can be identified separately from, and are capable of existing independently of [their] utilitarian aspects" attention is given to separability. Only after that, is it said, 170 F.Supp.2d at 835, that "Mara is valued not for 'its own appearance' but for what it enables students to do and learn. Mara is a 'useful article' …."

After three more years, his colleagues reversed and remanded, 372 F.3d 913 (7th Cir. 2004). Although that opinion expresses doubt about whether Mara is a "useful article," it assumes as much, 372 F.3d at 920, and devotes a dozen pages to separability before ultimately concluding, 372 F.3d at 932: "[B]ecause Mara was the product of a creative process unfettered by functional concerns, its sculptural features 'can be identified separately from, and are capable of existing independently of,' its utilitarian aspects. It therefore meets the requirements for

conceptual separability and is subject to copyright protection."

Judge Easterbrook apparently accepted that a mannequin intended for hair styling practice is not utilitarian. If so, it is difficult to see how one intended for make-up practice differs. It is unfortunate that neither court gave more attention to functions inherently tied to appearance.

Why must courts in cases involving two- and three-dimensional models used by students tie themselves in knots? At bottom, how do they differ from dolls, generally regarded as copyrightable? Do dolls forfeit protection if their hair can be styled, makeup can be applied, or their mouths are configured to accept a bottle?

Vases, picture frames, and a host of other things could also be subjected to mind-numbing conceptual or physical separability analyses. As lucrative as this may be for a few attorneys, the public would be better served, and courts could save themselves a great deal of time and grief, if attention was turned to whether, in the final analysis, such products have *any* value apart from their appearance — an approach that seems wholly consistent with the Act's definition of "useful article."