

## Applying *Star Athletica*'s Teachings in the Copyright Office

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Thank you for having me back today. Whenever I hear that Jane Ginsburg is traveling I get nervous because I know what is going to be coming up.<sup>1</sup> The Copyright Office does not have all the answers about where the lines are drawn between works of applied art and works of artistic craftsmanship. I don't think the decision and opinion in *Star Athletica* answered all of the questions that we had.<sup>2</sup> And in many ways it did not answer any of them, and in part made some of the issues more confusing. Because as Jane had said, the dress designs at issue were all filed with the Copyright Office as two-dimensional drawings. Some of them did depict the cheerleader outfit as well. But these were never being claimed as three-dimensional dress designs or anything else. The focus of these was on the applied art and not on the drawings of cheerleader uniforms.

Going back for a minute to prior to the *Star Athletica* decision, the Copyright Office's prior approach to separability was that the pictorial, graphic, or sculptural feature satisfies the conceptual separability requirement only if the artistic feature and the useful article could both exist side-by-side and be perceived as fully realized separate works; one an artistic work and the other as a useful article.<sup>3</sup> And to us this worked very well for quite some time, to look and see whether there was something that was fully separable as an artistic work—such as a pictorial work or sculptural features that would be separable—but still leaving the useful article intact.

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1. See Jane C. Ginsburg, *Copyright Protection for Applied Art and Works of Artistic Craftsmanship After Star Athletica*, 43 COLUM. J.L. & ARTS 423, 428 (2020) ("Anytime I go anywhere, I like to go to the local design museum and take pictures and then send them to Rob Kasunic, inquiring, "Would you register this?").

2. See *Star Athletica*, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017).

3. See 17 U.S.C. § 101 (2020) (defining "pictorial, graphic, and sculptural works" and indicating 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").

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What the *Star Athletica* decision puts into question, as a result of looking at the applied art on this dress design, is whether that two-dimensional artwork actually had a utilitarian function, in and of itself, that defined the clothing as specifically a cheerleader outfit. The Court, though quite inconsistent throughout the opinion, talks about the fact that there has to be some separation that occurs.<sup>4</sup> You have to be able to take the artistic features and separate them from the useful article. But at other points in the decision, the Court talks about how the useful article does not really have to remain *as* useful.<sup>5</sup> And, at least in one part, the Court seems to suggest it doesn't have to exist at all.<sup>6</sup>

That's the inconsistency which makes this all very difficult to apply. We have offered some language for incorporating the Court's test into the new *Compendium* test, which as you can see is exactly the same as the Court's test.<sup>7</sup> We do not disagree with the Supreme Court when there is a Supreme Court opinion. So, we have fully adopted the Supreme Court's two-part test. The problem is: How do we apply that test to all the different fact-specific situations that arise?

What I wanted to do is try and walk us through this—and this is where we may have disagreements, and we ourselves still may be thinking about where these lines are within the Office—and go through some different options. What are the choices when we have to consider registering pictorial, graphic, and sculptural (“PGS”) works? I will break it down into: (1) copyrightable PGS works that are not useful articles; (2) uncopyrightable PGS works; and (3) useful articles, either (a) with no separable PGS features (this would be the overall configuration of a useful article); (b) with separable PGS features, but not *copyrightable* separable features; or (c) with some separable PGS features that are copyrightable. Lastly, I will come back to (4) works of artistic craftsmanship.

### COPYRIGHTABLE PGS WORKS

As Jane said, under § 113(b) Magritte's *La trahison des images* is a pictorial work.<sup>8</sup> It is a two-dimensional illustration of a useful article. It does not give any further rights in the making of the useful article itself, but it is protectable as a pictorial work.

Sometimes in the Copyright Office's Visual Arts Division, when we receive applications to register pictorial works that depict useful articles, there will be

4. See *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1012 (2017) (“In sum, a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.”).

5. *Id.* at 1013 (“The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.”)

6. *Id.* at 1014 (“[T]he statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one.”).

7. See U.S. COPYRIGHT OFFICE, *COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES* § 924 (3d ed., rev. public drft. 2019).

8. See Ginsburg, *supra* note 1, at 424; 17 U.S.C. § 113(b) (2020).

concern in looking at the deposits that the applicant may actually be trying to register not the pictorial work, but actually the object the work is depicting. (Not just a picture of a glove, but how to make the glove, for instance.) I will say that, as we are looking at all of these works, it can be interesting how the work is titled for purposes of the copyright application. In cases where the title of the work is clearly a useful article, it is going to receive more scrutiny. Sometimes we might register the pictorial work, but actually annotate the certificate just to clarify that protection doesn't extend beyond the two-dimensional aspects. For example, these drawings of silverware, of this fork and spoon, would also be protectable as pictorial works.

Now, this one we could go back and forth about.<sup>9</sup> Looking at it, I could imagine that this is a Dalí-esque wine rack. But it also could be perceived simply as a sculptural work if you didn't know what its utility was. Again, this would be an interesting one—if we got it and the title was *Wine Rack*, we would treat this as a useful article and have to determine whether there were any separable sculptural features. If it was being dealt with as a useful article, I don't think we would see any separable elements. But not looking at this as a useful article, and simply as a sculptural work, this could be registered as a sculptural work.

I think the same would be true of this chair.<sup>10</sup> It does look very uncomfortable, so you wonder whether it would actually be very useful. Another question might be if this is something where the title might be a factor. If the title was *Model of a Chair* or *Depiction of a Chair*— [Ginsburg: The title is *Sculpture*.] Very good. Well, then I think we might ask about whether this is actually capable of supporting a person. We did have a case some time ago that dealt with an infant swing.<sup>11</sup> And when that went up to second appeal at the Copyright Review Board, one of the questions was whether this was a useful article. It looked like one, but the attorneys who had applied for registration said something like, “This is actually made of basswood, and if you put an infant in it the whole thing would fall apart.” And that would not be good. So we did end up registering it as a model, but we did add a § 113(b) annotation to that certificate so that it didn't give any protection to the actual making of that work. So something we might ask about here is whether this is capable of supporting a human, get a response in the record, and if it was simply a sculptural work or a depiction of a chair we would register it as such.

### UNCOPYRIGHTABLE PGS WORKS

We get all sorts of relatively simple pictorial colorblock designs with different colors, which we would not register. Another example: We actually intervened on a case many years ago dealing with a designer who had created a diamond ring that Tiffany's had then reproduced as their *Etoile* collection.<sup>12</sup> We had refused the original registration, thinking it was very aesthetically pleasing but too simple to be

9. See Ginsburg, *supra* note 1, at 428–29 n.31.

10. See *id.* at 424 n.10.

11. Letter from U.S. Copyright Office Review Board to William H. Oldach, Vorys, Sater, Seymour & Pease, LLP, June 21, 2013 (registering work titled *Open-Top Infant Swing, Versions II, III*).

12. See *Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482 (E.D. Pa. 2002).

sufficiently creative, with the symmetrically placed diamonds along a band. So that was something that was refused registration as a sculptural work.

## USEFUL ARTICLES

### 1. Useful Articles with No Separable PGS Features

This is when Jane will start to get annoyed. When a pair of Lindberg “Spirit Titanium” glasses was submitted for registration,<sup>13</sup> we found that to be a useful article with no separable features. I don’t think anything has changed under the *Star Athletica* decision that would change our decision to refuse that.

Another example is Gaetano Pesce’s “Donna” armchair.<sup>14</sup> Even if it was called a sculptural work, I think we would still see this as a chair. And as such, given the overall configuration of that, there is nothing that is separable. Except I guess that is where the question is left post-*Star Athletica*: What is this imagination test that we are left with? How much—if you imagine conceptually separating the artistic feature—can you imagine of what is left of the useful article? Our view is that there has to be—and in many places in the decision, it says—there has to be something separated from the useful article. And it may not have to be *as* useful as it was before the separation, but there still has to be that separation. So, in this case we would not see that as involving any separable authorship, but rather it would be an attempt to register the overall configuration. [*Ginsburg*: But if you did the reverse § 113(a) test,<sup>15</sup> you could say this is a female torso, a headless female torso. And you can imagine it as a pure work of sculpture, which you could then license as a chair. So, under that approach, maybe that is separable.] Right, and you had the example of the baseball mitt.<sup>16</sup> And if someone had created a soft sculpture of that mitt, and then it was later used by someone as the overall configuration of a chair, that would not deprive the copyright in the original sculptural work and would be something that would have to be licensed for inclusion within the chair. Anyway, we still have open questions, and because this comes up in such a variety of factual situations, we really have to keep thinking about this.

### 2. Useful Articles with Separable, But Uncopyrightable, PGS Features

One example is this side table.<sup>17</sup> Perhaps we could see those bottom rings as separable, although they probably do serve a functional purpose of holding the

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13. For examples of the Lindberg “Spirit Titanium” eyewear line, see *Spirit Titanium – Men*, LINDBERG, <https://perma.cc/8FTR-HYLM> (last visited Mar. 26, 2020).

14. See, e.g., “Donna” Armchair (UP5) with “Bambino” Stool (UP6), MUSEUM FÜR KUNST UND GEWERBE HAMBURG, <https://perma.cc/E5SS-GNSJ> (last visited Mar. 26, 2020).

15. See Jane C. Ginsburg, “Courts Have Twisted Themselves Into Knots”: *U.S. Copyright Protection for Applied Art*, 40 COLUM. J.L. & ARTS 1, 36–37 (2016) (proposing the “reverse § 113(a)” approach).

16. See *id.* at 41 (discussing the “Joe chair,” a children’s chair made to look like a baseball mitt).

17. For images of the table, see *Michelle Side Table*, LORIN MARSH, <https://perma.cc/ZS9L-MRL2> (last visited Mar. 27, 2020).

bottom of the legs. But even if we could see those rings as being something separable, that would not be sufficiently creative to be copyrightable.

Eyeglasses. We've received a number of different versions of this. We could see those eyes on the top as being separable from the eyeglasses and leaving the glasses intact. But those would not be deemed sufficiently creative.

Another example: test dummies for car crashes.<sup>18</sup> We could consider the Q on the clothing to be conceptually separable. I guess the clothing could even be separable, but it would still be a marginally useful article for the dummies. But then there is still nothing separately copyrightable.

### 3. Useful Articles with Separable, Copyrightable PGS Features

Now, here are some examples where there clearly is separable and copyrightable two-dimensional artwork. For example, the name of an arcade game, superimposed on a starburst on the side of the machine,<sup>19</sup> can easily be imagined as a PGS work on its own. And the starburst design is sufficiently creative.

The same is true with this cup.<sup>20</sup> The rendition of the name "Slushy Magic" serves no functional purpose, and there's enough creative authorship to register.

This next work, the outsole of a surfer-style shoe,<sup>21</sup> is a little trickier. Although shoes are useful articles, treads can be functional or they can be merely decorative. Here, we would view this tread as a decorative pattern of undulating lines identifiable as a two-dimensional PGS work separate from the shoe. And if we imagine this pattern separately from the shoe, the it is sufficiently creative to register.

Finally, while some may view this dollhouse as a toy, we consider it to be a useful article, as the handles at the top make it clear that it is a box used to transport the contents. The two-dimensional artwork contains sufficient creativity when imagined separately from the box, and it doesn't replicate the dollhouse itself, nor is it normally part of a dollhouse when it's imaginatively removed. However, there are no registrable three-dimensional elements. When the two-dimensional artwork is removed, we have a box with a handle.

## WORKS OF ARTISTIC CRAFTSMANSHIP

Finally, pictorial, graphic, and sculptural works include works of artistic craftsmanship. A work of artistic craftsmanship is a "work of art" that primarily serves a decorative or ornamental purpose, but "might also serve a useful purpose."<sup>22</sup>

18. For images of the crash-test dummies, see *Q-Series Infant to Child*, HUMANETICS, <https://perma.cc/96N5-9GZA> (last visited Mar. 27, 2020).

19. For images of the iCade arcade game and its starburst iconography, see Ross Catanzariti, *Ion Audio iCade Arcade Cabinet*, PCWORLD (Oct. 25, 2012), <https://perma.cc/G28H-DABX>.

20. For an image of the Slushy Magic cup, see *Slushy Magic Slush Cup*, AMAZON, <https://perma.cc/H98S-QVA7> (last visited Apr. 15, 2020).

21. For an image of the Swellular shoe tread, see Michael Eijansantos, *REEF Rover with Swellular Technology*, MY LIFE ON BOARD (Feb. 23, 2015), <https://perma.cc/U59S-RHFE>.

22. *Star Athletica L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1011 (2017) (interpreting U.S. Copyright Office regulation 37 C.F.R. § 202.8(a) (1948), governing "works of artistic craftsmanship");

Works of artistic craftsmanship are not useful articles, even though they may have some secondary or incidental useful purpose. In other words, they are PGS works minus any intrinsic, or primarily, utilitarian aspects. Examples of works that fit within this category include stained glass, tapestries, wallpaper, decorative bookends, paperweights, and piggybanks.

Like any other PGS work, a work of artistic craftsmanship may be protected if it contains copyrightable two- or three-dimensional authorship. In addition, the copyright law limits the scope of protection for these works by protecting the “form” but not “the mechanical or utilitarian aspects” of such works.<sup>23</sup>

In determining whether a work of artistic craftsmanship is sufficiently creative, we will consider the overall shape and configuration of the work, but not any of the mechanical or utilitarian aspects of the work. So, the test for evaluating a work of artistic craftsmanship is the mirror image of the test for evaluating the design of a useful article. Instead of separating an artistic feature from the utilitarian aspects of a useful article, we have to separate the mechanical or utilitarian aspects of a work of art.

Take this work, for example. While it can be used as a vase, it’s clear that it is a sculptural work that could be, but is not primarily, used as a vase. Once we separate out this secondary function, we can see that it is sufficiently creative to be a registered work of artistic craftsmanship.

Similarly, while this work can serve as a candleholder,<sup>24</sup> that purpose is incidental to its decorative, sculptural purpose; and once that incidental purpose is separated, there is sufficient sculptural authorship for registration. The same holds true for this fish sculpture.<sup>25</sup> Take away its secondary purpose as a vase, and a sufficiently creative sculpture remains.

Determining whether a work is a useful article or a work of artistic craftsmanship is a decision by the Office, not the applicant. The determination of whether a work is a work of artistic craftsmanship will be based solely on an objective examination of the work deposited and not on the intent of the creator or the primary markets for the work. When a registration is made on the basis of a work of artistic craftsmanship, the examiner may annotate the record to explicitly state this as the basis of registration. As such, the work will be deemed a work of art rather than a useful article subject to a separability analysis.

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Mazer v. Stein, 347 U.S. 201, 212, 214 (1954) (same).

23. 17 U.S.C. § 101 (2020) (defining “pictorial, graphic, and sculptural works”).

24. See Ginsburg, *supra* note 1, at 429–30 n.38.

25. See *id.* at 429–30 n.36.