

Copyright as an alternative means to protect product packaging, features and configurations.



Why consider copyright as a vehicle to protect product features and configurations and packaging, rather than trademark/trade dress?

- No requirement for use in commerce
- No requirement for secondary meaning
- Nothing precludes later claim of trademark/trade dress rights
- Length of copyright term is generally sufficient
- Potential for an award of statutory damages as well as fees

Issues to be considered in claiming copyright rights

- Who is the author for purpose of the copyright claim?
 - Copyright claimant may or may not be the same as the entity who can claim trademark rights
- Is the work in which copyright is claimed a derivative work or one otherwise potentially infringing rights of another?
 - Role of clip art
 - Stock photos
 - Works of “inspiration”

In looking at copyright protection for product design and configuration, and packaging there are three main areas of focus:

- **Originality**
- Whether there is a **merger of idea and expression** that defeats a copyright claim
- **Conceptual separability** of the expressive work from the utilization aspect of the product or package element in which copyright is claimed

Issues in determining if copyright rights are available

- Is the work original and creative?
 - n.b. the threshold for originality is low
- What is the idea, what is the expression?
 - Is there more than an idea which is not capable of being expressed in different ways
- Is there an artistic work that is conceptually separable from the useful article with which it is used?

Package designs may or may not be subject to copyright protection

- It depends on whether the package art incorporates a drawing or photograph or enough elements or the like which as a whole is original enough to support a copyright claim on its own
- Where the package design consists of ordinary shapes and frame and some text, none of which individually would support a copyright claim, it is necessary to establish that the selection and arrangements of such elements is creative enough to warrant protection (*see Star Athletica*)



- The wrapping paper design includes stars of five or six different sizes and in at least eight different colors; circles of four or five different sizes; and triangles of four or five different sizes. Some of the shapes are stretched horizontally, others vertically; one triangle sits at an angle that parallels no edge, while the others all have a side that parallels an edge. And the various shapes are all arranged in a pattern that appears random. In short, the wrapping paper design exhibits creative authorship.

- Packaging designs will be denied copyright protection if lacking sufficient authorship. See, e.g. the decision with respect to the LARABAR wrapper depicted below:



Limits on Copyright Protection for Package Design

- A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection.
- The work is a combination of words, simple shapes, and a set of basic color schemes. The applicant does not appear to dispute the Office's conclusion that none of the individual elements are eligible for copyright protection. Rather, General Mills argues that "the selection, coordination, and arrangement of the various design elements" are sufficiently creative.
- But the number of choices an author makes in combining simple shapes, fonts, and colors must be "sufficiently high" if that combination is going to weigh in favor of copyrightability. *Batiste v. Najm*, 28 F. Supp 3d 595, 603 (E.D. La. 2014). The work before the Board does not satisfy that threshold.

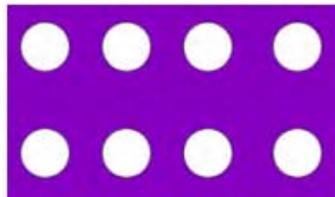
Limits on Copyright Protection for Package Design

- The question before the Board is whether the combination of elements results in a design that, on its face, is copyrightable even though the individual elements are not.
- An example from the Compendium of a wrapping paper design found eligible for registration "combines multiple types of geometric shapes in a variety of sizes and colors." Second Request at 2 – 3 (quoting COMPENDIUM (THIRD) Sec. 906.1). A depiction of the wrapping paper design follows:

Limits on Copyright Protection for Package Design

- It may be unique in the sense that LARABAR is the only package design that uses this exact layout, but the general arrangement is common and any creative contribution is de minimis.
- COMPENDIUM (THIRD) Sec. 310.1 (“The fact that a work may be novel, distinctive, innovative, or even unique is irrelevant to this analysis . . . Conversely, the fact that a work is new, innovative, or even unique does not necessarily mean that it contains a sufficient amount of creative expression to satisfy the originality requirement.”)

- Indeed, the better analogy for the Work from section 906.1 of the Compendium is the painting with a purple background and evenly spaced white circles, the combination of which “does not contain a sufficient amount of creative expression to warrant registration.” COMPENDIUM (THIRD) Sec. 906.1. A depiction of the painting follows:



- Packaging designs may more readily be protected as trade dress but note there the issue of whether the package elements are background design, mere or ornamentation, or actually function as signifiers of source.
- Compare the kind bar package and that of a Snickers Bar.

Originality:

The bar is low, but there is a bar

Universal Furniture Inc. v. Collezione Europa USA, 618 F.3d 417 (4th Cir. 2010)

While even aesthetically pleasing furniture design may not be subject to copyright protection, the

selection

coordination

adaptation

arrangement

of design elements resulted in a “unique” arrangement of elements that crossed the low threshold for originality

Copyright in Furniture Design

- The court found significant that the designer had developed the shape of the furniture before turning to the ornamentation, and that the role of many of the decorative elements (shells, leaves) was aesthetic, not utilitarian.

Copyright in Jewelry Design

- In the opinion of the Copyright Review Board, some combinations of common or standard design elements may be sufficiently creative in how they are juxtaposed or arranged to support a copyright
- Not every combination or arrangement meets this test. In the context of jewelry design, it appears that the more complicated the design, meaning the more elements contained in the overall work, the more likely the Copyright Office will register the work.

Copyright in Jewelry Design

- Whether elements are “complicated” enough or numerous enough or arbitrary enough a determination of sufficient seems to be an increasingly subjective standard.

Trifari, Krussman & Fishel, Inc. v Charel Co. 134 F. Supp 551 (SDNY 1955) addressed copyright protection for costume jewelry



Costume jewelry may express the artistic conception of its author no less than a painting or a statute . . . A necklace, like a circus poster or a book, is not to be denied the benefits of the Copyright Act because it may not attain the same recognition as is accorded the work of a renowned artist. So long as the material for which copyright is sought exhibits some degree of individuality so that the court is convinced that the author has created an original, tangible expression of an idea rather than a merely pleasing form dictated solely by functional considerations, copyright registration is available.

Merger:

The idea-expression dichotomy, and sufficient authorship/originality

The issue of whether there are so few ways to depict an object found in nature that according copyright protection in the depiction would impermissibly afford protection to the idea of the object has been resolved in different ways depending on:

- The degree of artistic work displayed, and
- The persuasiveness of the evidence made of record

Hart v. Dan Chase Taxidermy Supply Co.

The court did say that if “all realistic fish mannequins, no matter how artistic they might be, will necessarily be substantially similar,” then no fish mannequin can be copyrighted because the idea and expression have merged completely.



Copyright in product designs that mimic nature

- On remand, the district court rejected the plaintiff’s argument that there are an endless number of ways to express a lifelike fish and concluded that the only element of the fish mannequin not necessitated by the idea was the “cant or swish” of the tail; however, there was an extremely limited number of ways to design the tail.

Copyright in product designs that mimic nature

- The district court held that there are so few ways to express a realistic fish mannequin that the merger doctrine precluded copyright protection.

Prestige Floral v. California Artificial Flower Co. (S.D.N.Y. 1962)

The district court granted a preliminary injunction to a manufacturer of a “molded polyethylene flower in the form of a Charles lilac” to prevent a competing artificial flower manufacturer from producing a very similar product.



Copyright in product designs that mimic nature

- The court concluded that “though a flower . . . Is a creation of nature, likeness of it may be copyrighted.” The court stated that this result was especially proper here because creating the plastic lilac involved “numerous and detailed decisions as to proportion, form, contour, configuration, and conformation” and a “substantial degree of skill and independent judgment.”

Sunset Lamp Corp. v Alsy Corp. (S.D.N.Y. 1990)

Banana leaf design—sufficiently original?

- The court rejected the argument that sculpture that imitates nature is not copyrightable.
- The court held that design it surpassed the threshold requirement for originality.
 - It was more than an imitation of nature: the leaves were elongated, stylized, and “twist[ed] and intertwine[ed]” in an unnatural fashion.



Animal Fair, Inc. v. AMFESCO Industries, Inc.
(8th Cir. 1986)

The court found that a bear-shaped slipper intended to be worn at home was entitled to copyright protection.

It was not a “realistic representation of a bear’s paw.”

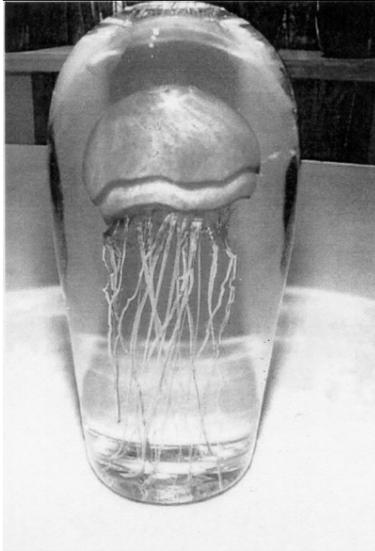
The court found that the “plaintiff [sought] only to protect what may be properly copyrighted under the law: the particular artistic expression embodied in its novelty slipper.”

Wildlife Exp. Corp. v. Carol Wright Sales, Inc., 18 F.3d 502, 507 n.3 (1994)

The distinction was drawn between the duffle bag itself, which is a ‘useful article,’ and the animal head and tail attached to the ends of the bag, which are artistic designs found to be entitled to copyright protection.

See 17 U.S.C. Sec. 102(a)(5).

Satava v. Lowry
(9th Cir. 2003)



Satava v. Lowry
(9th Cir. 2003)

The Ninth Circuit concluded that a glass-in-glass sculpture of lifelike jellyfish “possesse[d] a thin copyright that protects against only virtually identical copying.”

The defendant began creating glass-in-glass jellyfish sculptures after seeing a picture of plaintiff’s work, and his sculptures were remarkably similar.

Copyright in product designs that mimic nature

The plaintiff, however, was unable to prevent blatant copying. The court found that his sculpture consisted of “unprotectable ideas and standard elements,” and his selection and arrangement of the elements was not original.

The court reasoned that there was no protection for “the idea of producing a glass-in-glass jellyfish sculpture or to elements of expression that naturally follow from the idea of such a sculpture,” and the plaintiff could “not prevent others from copying aspects of his sculptures resulting from . . . jellyfish physiology,” such as tendril-like tentacles, rounded bells, or bright colors.

Beaudin v. Ben & Jerry's Homemade (2d Cir. 1996)

The Second Circuit found that the idea/expression distinction precluded the possibility of enforcing a registered copyright in the design of white hats with black spots, intended to evoke the appearance of Holstein cows:



Copyright in product designs that mimic nature

- Protecting Beaudin's particular renderings of black splotches on a white background against identical copying would run the risk of infringement liability for anyone else who happened to see one of his hand-painted articles, and, despite having no intent to replicate, in fact created a fabric design that was indistinguishable from the Beaudin "original."

Copyright in costume design

- In accordance with the copyright principles applying to useful articles, fanciful costumes will be registered if they contain separable pictorial or sculptural authorship. The separable authorship may be physically separable, meaning that the work of art can be physically removed from the costume, or conceptually separable, meaning that the pictorial or sculptural work is independently recognizable and capable of existence apart from the overall utilitarian shape of the useful article.

Copyright in costume design

The Copyright Office has taken the position in the registration context that “apparel” would receive no copyright protection beyond that already recognized in the case law: “[G]arment designs (excluding separately identifiable pictorial representations of designs impose upon the garment) will not be registered even if they contain ornamental features, or are intended to be used as historical or period dress.”

- While you can perceive of the stripes and chevrons that make up the design as a work of two-dimensional art separate from the useful article (the piece of clothing), it was not decided whether that separately imagined design could qualify as a protectable work. Was it sufficiently original? The settlement of the case meant the second issue was not decided.

Conceptual Separability, the Supreme Court, and copyright protection for product design and features

- *Mazer v. Stein*, 347 U.S. 201 (1954)
- *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205 (2000)
- *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017)

- According to the Copyright Office, “fanciful” costumes should be treated no differently from other “useful articles”:



- The Supreme Court, in its 1954 decision in *Mazer v. Stein*, held that a sculptural work in the shape of a dancer, designed to be used as a mass-produced lamp base, was copyrightable despite the “utilitarian” function to which it was dedicated.



- Post-1954, it might have seemed obvious that copyright could be a vehicle to protect product configurations that would not (yet) be recognized as protectable trade dress
- Decisions based on the statute precluding copyright protection for useful articles continued to block many efforts to seek relief from copying of product features and configurations on the basis of copyright
- That a work is embodied in a useful article will not bar copyright protection

- Simply because it is a commonplace fashion accessory, not an expression of ‘pure’ or ‘fine’ art does not preclude a finding that plaintiff’s copyrighted article is a work of art within the meaning and intent of the Act.

Samara Bros. v. Wal-Mart Stores, 165 F.3d 120, 132 (2d Cir. 1998), abrogated on other grounds, 529 U.S. 205 (2000)

- Before *Star Athletica* there was *Samara*. That decision is best known for its holding that product configuration can not be inherently distinctive.
- The Court of Appeals noted each of the challenged copyrights is registered with the U.S. Register of Copyrights. A certificate of registration “constitutes prima facie evidence of the validity of a copyright, 17 U.S.C. Sec. 410(c), though that presumption may be rebutted.
- In *Folio Impressions* this Court awarded protection to a design of a series of roses, a common shape, placed in straight lines on an ornate background and turned so that the roses faced in various directions. We first recognized protection for the rose design itself separate from its arrangement on the background. Although the rose is a common shape, we noted that because there was a valid registration, the rose had a “presumption of validity” and the defendants “offered no proof at trial to overcome this presumption.”

- We must find the Samara designs similarly original. Their registrations provide a presumption of validity which Wal-Mart has failed to overcome. Wal-Mart provided no evidence at trial challenging the validity of the copyright registrations. It failed to adduce evidence to show that the works were in “independently created by its author, and not copied from someone else’s work.”
- Ornamentation added to apparel is subject to copyright protection whether or not subject to trademark / trade dress protection.

. . . . copyrights depicting familiar objects, such as the hearts, daisies and strawberries in Samara’s copyrights, are entitled to very narrow protection. It is only the virtually identical copying, such as the copying in this case, which will result in a successful claim of infringement of familiar objects.

- That is, the designs applied to the product were conceptually separate from the apparel itself and subject to copyright protection.



Samara dress

Star Athletica and Conceptual Separability

The requirement of conceptual separability stems from the fact that copyright is not intended to protect useful articles. The ornamental aspect of useful articles is the province of design patents.

Star Athletica “revives” copyright as a basis for protecting product configuration, features and packaging—

- dispute between two manufacturers of cheerleader uniforms
- The accused copies countered by arguing that the designs could not be copyrights because they were not “separable” from the utilitarian purpose of the clothing.



- Under the Copyright Act, 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” and “[a]n article that is normally a part of a useful article is [also] considered a ‘useful article.’” 17 U.S.C. Sec. 101.
- Importantly, however, an artistic feature applied on or incorporated into a useful article may be eligible for copyright protection if it:
 - 1) Can be perceived as a two- or three-dimensional work of art separate from the useful article and
 - 2) Would qualify as a protectable pictorial, graphic, or sculptural work – either on its own or fixed in some other tangible medium of expression – if it were imagined separately from the useful article into which it is incorporated.”

See Star Athletica, 137 S. Ct. at 1007, 1016 (holding that two dimensional graphic designs on the surface of cheerleading uniforms satisfied this test and were, therefor, separable features).

Pursuant to *Star Athletica*—

1. Can the design feature be perceived as a two or three dimensional work of art separate from the useful article?
2. If so, would that feature qualify as a protectable work – on its own or in some other tangible medium of expression – if imagined separately from the useful article into which it is incorporated?

Copyright Office Review Board (CORB) After *Star Athletica*

- After *Star Athletica*, first CORB decision to cite the new test was in re Pizza Slice Pool Float (<https://www.copyright.gov/rulings-filings/review-board/docs/pizza-slice-pool-float.pdf>), decided in July 2017.
- The case involved the copyrightability of a rectangular inflatable pool float with a pepperoni pizza slice design. CORB affirmed the refusal to register on the grounds that the design was not sufficiently original, but noted in dicta that the two-dimensional pizza design, although unoriginal, was easily separable from the object's function under the *Star Athletica* test.

Light fixtures (CORB 7/27/17)



Because it is a light fixture, Swarovski acknowledges that the work (“Trilliane Strand”) is a useful article that cannot be protected by copyright. See 17 U.S.C. Sec. 101

In its correspondence with the Copyright Office, however, Swarovski states that it “does not claim copyright in the overall shape or industrial design of the Trilliane Strand . . . light fixture . . . but rather.” **the artistic expression reflected in the sculptural features of the work.**

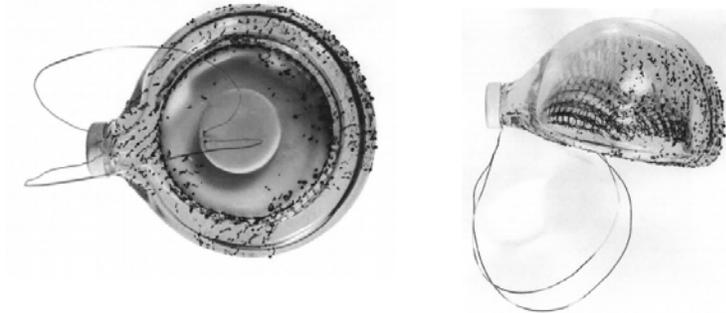


- The sculptural features Swarovski seeks to register are limited to the “crystal crown” and “curtain of crystal strands” specifically identified in its requests for reconsideration. First Request at 5-7; Second Request at 5-7, 8 (also describing these features as “the crystal collar and curtain of crystal strands,” which are “sculptural adornments that embellish the underlying shape of ‘ the light fixture).

- The Board finds that the work – limited to the exact combination of artistic features in the crystal crown and curtain of crystal strands in Trilliane Strand design number TR2413 – meets this test and therefore constitutes a separable artistic feature from the overall light fixture.
- The work’s three-dimensional design of numerous crystals of various shapes and sizes in an original arrangement is an artistic feature that can be perceived as a freestanding work of art that does not recreate the light fixture when imaginatively removed from the useful article. Additionally, the Board finds that the Work’s combination of different sized octagons and pendalogue in the crystal crown and curtain strand – as a whole– contains sufficient creative expression to be copyrightable under the threshold articulated in *Feist Publications, Inc. v. Rural Telephone Services Co.*, 499 U.S. 340, 363 (1991).

Light fixtures (Pendant Lamp) (CORB 4/4/18)

- The work’s three-dimensional design of metal mesh interspersed with crystals is an artistic feature that can be perceived as a freestanding work of art that does not recreate the lighting fixture when imaginatively removed from the useful article. Additionally, the Board finds that the Work’s intricate crystal and mesh design contains sufficient creative expression to be copyrightable under the threshold articulated in *Feist Publications, Inc. v. Rural telephone Services Co.*, 499 U.S. 340, 363 (1991).



- The Work is a glass sculpture in a shape resembling the face of a bisected globe, with a pattern of filaments imbedded in the glass; an internally-mounted LED is included to illuminate the globe and filaments.

- The Board finds that the Work's glass sculpture and imbedded filaments meet the test set forth in *Star Athletica* and therefore constitute artistic expression that is separable from the work's utilitarian function of illumination.
- The work's three-dimensional design for glass formed into a half globe and imbedded with filament wires can be perceived as a standalone work of art without the internally mounted LED that makes the Work a useful article. Additionally, and significantly, the Board finds that these separable elements contain sufficient creative expression to be copyrightable.

Wearing Apparel (Wonderer Kimono) (CORB 11/28/17)

The work, a kimono, includes a combination of preexisting lace patterns incorporated into the bottom half of the kimono as well as beige lace trim decorating its back and sleeves. The particular two-dimensional artistic features identified by Sisco for registration include the placement of vertical strips of lace, “the use of three different flower designs,” “the arrangement of one row of one flower design, followed by six rows of another flower design, all interspersed with a third, smaller flower design,” and “the inconsistency in the shape of the bottom trim of the kimono.”

Wearing Apparel (Wonderer Kimono) (CORB 11/28/17)

- It is well-established that “items of clothing are, as a general rule, uncopyrightable ‘useful articles.’” *Morris v. Buffalo Chips Bootery, Inc.*, 160 F.Supp.2d 701, 720 (S.D.N.Y. 2001). However, an artistic feature applied on or incorporated into a useful article may be eligible for copyright protection if it: “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work – either on its own or fixed in some other tangible medium of expression – if it were imagined separately from the useful article into which it is incorporated.” *Star Athletica*, 137 S. Ct. at 1007, 1016.

Wearing Apparel (Wonderer Kimono) (CORB 11/28/17)

- The overall presence and placement of several distinct, albeit preexisting design elements (namely, lace flower patterns placed in combination with circle and honeycomb lace patterns and vertical lace trim), taken as a whole, contains sufficient creative expression to be copyrightable under the threshold articulated in *Feist Publication, Inc. v Rural Telephone Services Co.*, 499 U.S. 340 363 (1991).

Wearing Apparel (Wonderer Kimono) (CORB 11/28/17)

- At the same time, the Board notes that the individual lace elements, namely, the band of beige lace trim, and three types of flower types and flower designs, are preexisting elements not individually protectable under copyright law. See Application (noting that lace elements were preexisting). Moreover, they appear to be standard elements. See *Express, LLC v. Fetish Group, Inc.*, 424 F.Supp.2d 1211, 1223-25).
- Accordingly, the Board concludes that the work possesses a small but sufficient amount of creativity beyond the combination of standard elements to establish thin copyright protection, but not enough creativity to qualify for broad protection. See, e.g., *id.* at 1223-27 (similar, evaluating three-flower lace embroidery pattern); *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) (describing level of creativity required when the expressive aspect of work consists of the combination of standard elements). “Thin” copyright protection affords the holder only protection against virtually identical copying. *Satava*, 323 F.3d at 811.

Floor Liner (CORB 4/19/18)

The Review Board of the United States Copyright Office (“Board”) on April 19, 2018 ruled on Quadratec, Inc.’s (“Quadratec”) second request for reconsideration of the Registration Program’s refusal to register a sculpture claim in the work titled “Floor Liner” (“work”). The work, a black floor liner, is a quadrilateral with raised edges and slight indentations, shaped to fit on the floor of a vehicle. The top surface of the work is embossed with a pattern of various raised, non-standard geometric shapes.



- Quadratec was found to be entitled to copyright registration for the “decorative raised pattern comprising various shapes and orientations” that “appears on the floor liner.”
- The Board finds that the work contains separable artistic features from the overall useful article. Specifically, the work’s raised, decorative pattern of various shapes can be identified as a two-dimensional work of art separate from the floor liner.



- Such features would qualify as a protectable pictorial, graphic, or sculptural work if imagined separately from the useful article; moreover, they do not replicate the floor liner itself or “an article that is normally a part of” a floor liner when so imaginatively removed. *Star Athletica*, 137 S.Ct. at 1012-14.

Risks in Seeking Registration and Being Denied

There is no ability to bring a claim in court absent either a registration or a refusal of registration.

The refusal of registration will weigh heavily in any litigation against the copyright claimant.

Note: a registration having once been issued may be revoked by the Copyright Office based on information which later comes to its attention