Copyright Protection of Works of Applied Art: Rethinking Conceptual Separability and Aesthetic Requirement for Copyrightability

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Abstract: Copyright protection of works of applied art encounters the following difficulties: first, to set up the threshold for examining aesthetic value of a work of applied art, since examination of aesthetic value is subjective and varies among different judges; second, to determine whether the functional part should be separated from the aesthetic value, as it is important to analyze various approaches adopted by different courts and suggest a feasible and consistent way to resolve the separability issue; third, to decide substantial similarity as a matter of copyright infringement, as comparison between the original and the alleged infringing products will cover both their aesthetic and functional parts and it is important to decide the substantial similarity of which part results in copyright infringement.

In light of the difficulties, this article attempts to suggest a four-step test to better determine copyrightability of works of applied art by examining intrinsic utilitarian function, aesthetic feature based on the merger doctrine, originality threshold, and functionality of the aesthetic feature.

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I. Introduction

Copyright systems cover various kinds of works under protection, including literary works, musical works, artistic works, phonographic works, etc. Under the many kinds of works, copyrightability of works of applied art or useful articles is an on-going issue for judges, practitioners and scholars to ponder, as works of applied art have both utilitarian functions and aesthetic features. On the one hand, copyright protection should be extended to the aesthetic features so as to achieve the purpose of establishing copyright systems for stimulating creations. On the other hand, works of applied art are mass-produced for the public's normal use in everyday life. Over protection of works of applied art that prevents any third party from imitating the functional aspects will impede the development of industrial design and competition. Therefore, it is important to develop an appropriate approach to examine copyrightability of works of applied art, taking the balance of interests into considerations.

Courts among various jurisdictions have endeavored to figure out the standard for copyright protection of works of applied art. The United States courts have developed the physical and conceptual separability doctrine, while the German and Chinese courts incline to view the functional and aesthetic aspects of an article as a whole and require high or average artistic value. The precedents in the three jurisdictions reflect some typical standards for determining copyrightabilty for works of applied art. However, these standards are never perfect. Flaws still exist in these standards when judges try to make an objective and fair decision. In light of the unresolved matter, this article will attempt to propose a revised approach for determining copyrightability of works of applied art based on analysis of American, German and Chinese laws and precedents.

The second part of this article will examine the development of the physical and conceptual separability doctrine for determining copyrightability of works of applied art in the United States. The third part will discuss standards to grant copyright protection to works of applied art in the German and Chinese courts. Based on the analysis of the previous two parts, the fourth part will attempt to propose a four-step test to examine copyrightability, which will avoid the flaws shown in the American, German and Chinese practices, and achieve the balance of stimulating both creation and industrial manufacture. Further, this part will adopt the four-step test to address copyrightability of costumes, one of the difficult issues in copyright protection of works of applied art.

II. The Separability Doctrine in the United States

The revision process of the United States Copyright Act and the development of cases witnessed the birth of various doctrines and standards to weigh copyrightability of works of applied art. In *Mazer v. Stein*[1] decided by the Supreme Court of the United States in 1954, the respondents, Steins et al., created a series of original sculptures of dancing human figures as the bases of lamps. The petitioner, Mazer et al.,

[1] 347 U.S. 201 (1954).

copies the sculptures and also sold lamps that embodied the dancing figures based on the argument that the sculptures should not be protected by copyright as part of the lamp bases. The Supreme Court ruled that the sculptures to serve as lamp bases are eligible subject matters under copyright protection and are subsequently registrable as works of art. Inspired by the *Mazer* decision, the Copyright Office adopted the prototype of separability doctrine to decide copyright protection for works of applied art by issuing a regulation that provides:

> [I]f the shape of utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.[2]

The precise wording of the Copyright Office Regulation was challenged by a later case, *Esquire, Inc. v. Ringer*[3] in 1978. The facts in *Esquire* were similar to those in *Mazer*, where Esquire also incorporated artistic designs for its lighting fixtures. The district court ruled in favor of Esquire, however, the Court of Appeals reversed. According to the Court of Appeals, the Copyright Office Regulation did not allow simply granting copyright protection to shape or design of utilitarian articles, as long as they were original or creative.[4] Although the Court of Appeals did not address the differences between *Esquire* and *Mazer*, the major problem may be that Esquire created the artistic designs as the inseparable part of the lamp housing, while the sculptures produced by Stein in *Mazer* could be physically separable from the lamp base.

The Court of Appeals in *Esquire* referred to the wording of the 1976 Copyright Act. Under the 1976 Act, a broad range of works are copyrightable, including literary works; musical works; dramatic works; pantomimes and choreographic works; pictorial, graphic and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works.[5] The artistic features embodied in works of applied art, if copyrightable, are deemed as pictorial, graphic and sculptural ("PGS") works under the categorization of the 1976 Act. The 1976 Act defines PGS works as:

> Works including "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, 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".[6]

The 1976 Act does not adopt the term "works of applied art" to refer to utilitarian articles with artistic features, but rather uses the term "useful articles". Under the same section with the definition of PGS works, a useful article is defined as "an article having an intrinsic utilitarian function that is not merely to portray the

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[2] 37 C.F.R. § 202.109(c) (1959).
[3] 591 F.2d 796 (D.C. Cir. 1978).
[4] *Id*.
[5] 17 U.S.C. 102(a) (1976).
[6] 17 U.S.C. 101 (1976).

appearance of the article or to convey information".[7]

The wording of the definition for PGS works only points out that the PGS features should be identified separately from the utilitarian aspects of an article in order to be protected by copyright. Although the 1976 Act does not directly contain wording concerning physical and conceptual separability, such concept was covered by the House Report of 1976 as the Act's legislative history:

> Although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, *physically or conceptually*, can be identified as separate from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design – that is, even if the appearance of the article is determined by aesthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful articles as such are copyrightable.

The dual separability concept was first reflected in the landmark case *Kieselstein-Cord v. Accessories by Pearl, Inc.*[8] In *Kieselstein-Cord*, the plaintiff designed belt buckles with decorative models and gained a commercial success by selling the buckles in precious metals. The defendant exactly copied the plaintiff's buckles, but sold them in cheap material. When deciding whether the buckles were copyrightable or not, the district court ruled in favor of the defendant, finding that the decorative designs did not physically separable from the functional aspects of the buckles. The Court of Appeals reversed, noting that as pointed out by the House Report of 1976, separability can be either physical or conceptual. In the viewpoint of the Court of Appeals, consumers wore these buckles as ornamentation. The primary ornamental aspects of these buckles are conceptually separable from their subsidiary utilitarian function.[9]

Following *Kieselstein-Cord*, courts and scholars in the United States have raised up various approaches to determine copyrightability of useful articles, which are noteworthy and shed light on the proposal for the new approach.

A. Primary/Subsidiary Test

The "primary/subsidiary" test was developed by the Second Circuit Court of Appeals in *Kieselstein-Cord*. When examining that the ornamental part of the buckles was conceptual separable from the functional part, the court viewed the ornamental part as the primary element and the functional part as the subsidiary aspect by reasoning that: "We see in appellant's belt buckles conceptually separable sculptural elements…. The primary ornamental aspect of the Vaquero and Winchester[10] buckles is conceptually separable from their subsidiary utilitarian function".[11]

Although judges may use the "primary/subsidiary" test to weigh the aesthetic

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[7] *Id*.
[8] 632 F.2d 989 (2d Cir. 1980).
[9] *Id*. at 993.
[10] "Vaquero" and "Winchester" are names of the buckle models.
[11] 632 F.2d 989 (2d Cir. 1980), at 993.

feature against the functional aspect so as to figure out the more important part, such test was questioned as how the classifications of "primary" and "secondary" could be measured. As Judge Jon Newman opined in *Carol Barnhart Inc. v. Economy Cover Corp.*,[12] the test "offers little guidance to the trier of fact, or the judge endeavoring to determine whether a triable issue of fact exists, as to what is being measured by the classifications 'primary' and 'secondary'".[13]

B. Temporal Displacement Test

The "temporal displacement" test was proposed by Judge Newman in his dissenting opinion in *Carol Barnhart.* In *Carol Barnhart*, the useful articles at issue were four partial human torsos used to display clothes. The four human torsos were designed in life-sized forms and made out of white styrene. The plaintiff believed that the four human torsos were artistic sculptures which should be protected by copyright and sued the defendant for copying the plaintiff's human torso forms. The district court ruled against the plaintiff, opining that the human torsos did not satisfy the separability standard. The Second Circuit Court of Appeals affirmed, because "the aesthetic and artistic features of the Barnhart forms are inseparable from the forms' use as utilitarian articles".[14] Different from the buckles in *Kieselstein-Cord*, in which "the artistic and aesthetic features could thus be conceived of as having been added to, or superimposed upon, an otherwise utilitarian article",[15] the facts in *Carol Barnhart* were not enough to show that the human torsos had aesthetic features physically or conceptually separable from the utilitarian function to display clothes.

After reviewing several tests for determining conceptual separability, Judge Newman gave his dissenting opinion, proposing that the artistic feature of a useful article should be presented in the mind of a beholder. According to Judge Newman, "for the design features to be 'conceptually separate' from the utilitarian aspects of the useful article that embodies the design, the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function".[16] Judge Newman further explained the "beholder" as "the ordinary, reasonable observer"[17] used in other areas of laws.

The ordinary and reasonable beholder test seems to be a neutral and objective application in most areas of laws. However, it is not appropriate to be used in copyright regime where the examination of artistic features is always subjective and varies among different people. Further, judges have never been trained of aesthetics. Their subjective aesthetic tastes in copyright reasoning would increase the risks of misgauging designers' creativity and innovation. As Justice Holmes reasoned in *Bleistein v. Donaldson Lithographc Co.*,[18] "it would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits".[19] Such consideration was explained by Professor Alfred Yen: "the inherent ambiguity of

[12] 733 F.2d 411 (2nd Cir. 1985).
[13] *Id*. at 421.
[14] *Id*. at 418.
[15] *Id*. at 419.
[16] *Id*. at 422.
[17] *Id*. at 422.
[18] 188 U.S. 239 (1903).
[19] Id. at 251-252.

aesthetics is considered incompatible with the supposedly objective rules and principles that govern judicial opinions".[20]

In addition, Judge Newman's explanation of separability as having the beholder not perceive the aesthetic and functional concepts simultaneously makes things more complex than necessary.[21] In Judge Newman's concept, the beholder must at a moment, no matter temporarily or lasting for a period of time, view the article as exclusively artistic work. However, "exclusivity is neither realistic nor required by the statute".[22]

C. Design Process Approach

The design process approach was at first proposed by Professor Robert Denicola in his article published in 1983[23] and later adopted by the Second Circuit Court of Appeals to judge copyrightability of a stylistic bicycle rack design in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*[24] In the design process approach, Denicola touched upon the creator's state of mind in the process of accomplishing the creation. It is important to examine the creator's considerations in both aesthetic and functional aspects. If the aesthetic consideration exists independently from the functional judgment, conceptual separability is deemed to be satisfied. By applying Denicola's approach, the Second Circuit reasoned that "[c]opyrightability… should turn on the relationship between the proffered work and the process of industrial design… where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists".[25] At the end of the reasoning, the Second Circuit found that the bicycle rack at issue was not copyrightable, as "the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements".[26]

Although the court believed that focus on the design process and both aesthetic and functional considerations would avoid potential risks aroused by judges' subjective determination of art and lack of aesthetics knowledge, the design process approach still embodies loopholes that cannot totally avoid subjective judgment. First, when looking to the creator's state of mind and design process, the burden to prove that the aesthetic consideration exists independently from the functional judgment will fall on the creator. However, in order to show the design's copyrightability and win the case, creators' may always be able to submit evidence to prove their independent aesthetic considerations. Second, when designing a work of applied art, the designer will take the aesthetic and functional aspects into consideration at the same time. Even for the designer himself/herself, it will be hard to distinguish the aesthetic consideration from the functional judgment at one time. The functional consideration will influence the aesthetic feature, or vice versa. Third, as Judge Winter dissented in

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[20] Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247 (1998).
[21] Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y U.S.A. 339 (1989-1990).
[22] *Id*. at 377.
[23] Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983).
[24] 834 F.2d 1142 (2nd Cir. 1987).
[25] *Id*. at 1145.
[26] *Id*. at 1146-1147.

Brandir, the design process approach would diminish "the statutory concept of 'conceptual separability' to the vanishing point",[27] as emphasis too much on design process would make determination of copyrightability turn on largely fortuitous circumstances.[28]

D. Marketability Test

The marketability test was originally addressed in the premier treatise on copyright, *Nimmer on Copyright*,[29] in which Professors Nimmer provide that "conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian function it would still be marketable to some significant segment of the community simply because of its aesthetic qualities".[30] The marketability test was later adopted by the Fifth Circuit Court of Appeals in *Galiano v. Harrah's Operating Co., Inc.*,[31] where the casino uniforms at issue failed to satisfy the marketability standard, as these uniforms were not marketable except for their intended functions as casino uniforms.

The major problem of the marketability test is that such a test precludes copyright protection to works of applied art which have separable aesthetic features but resemble unmarketable non-mainstream art. The potential preclusion will influence designers' creations to conform to the mainstream artistic value rather than show their own aesthetic idea. Further, the marketability test will narrow down judges' discretion to view artistic features by leading courts' focus to the evidence of sale and market share. As the marketability will be influenced by geographic factors, different communities may develop various standards to examine marketability. Such various standards will be disadvantageous for courts to achieve consistent decisions.

E. Traditional Aesthetic Appeal Test

The traditional aesthetic appeal test was offered by Professor Paul Goldstein in his publication in 1989.[32] According to Goldstein, "a pictorial, graphic, or sculptural feature incorporated in the design of a useful article is conceptually separable if it can stand on its own as a work of art traditionally conceived, and if the useful article in which it is embodied would be equally useful without it".[33] This test is similar to Judge Newman's "temporal displacement" test, as both tests require the judgment of aesthetic feature from the observers' points of view. In such a similar sense, the traditional aesthetic appeal test also embodies the problems in the temporal displacement test, especially both requiring subjective determination of art from judges who are untrained for aesthetics.

Additionally, the traditional aesthetic appeal test was rejected by the Seventh Circuit Court of Appeals in *Pivot Point International, Inc. v. Charlene Products, Inc.* in 2004.[34] In *Pivot Point*, the PGS work at issue was a mannequin of a female head

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[27] *Id*. at 1151.

[28] Barton R. Keys, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L. J. 109 (2008).

[29] Darren Hudson Hick, *Conceptual Problems of Conceptual Separability and the Non-usefulness of the Useful Articles Distinction*, 57 J. COPYRIGHT SOC'Y U.S.A. 37 (2009-2010).

[30] 1 Melvile B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT § 2.08[B][3] (2009).

[31] 416 F.3d 411 (5th Cir. 2005).

[32] Paul Goldstein, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE § 2.5.3 (1989).

[33] *Id*. at 109.

[34] 372 F.3d 913 (7th Cir. 2004).

that depicted a runway model's hungry look and was sold in various versions with altering types and length of hair, skin and makeup.[35] The district adopted Goldstein's test to determine conceptual separability, but the Court of Appeals rejected based on the ground that the test was very similar to physical separability. It, thus, will preclude copyright protection to PGS works in which the aesthetical feature cannot be physically separated from the functional aspect.

F. Conclusion: American Conceptually Separability

The United States has well developed doctrines and standards for physical and conceptual separability to determine copyrightability of useful articles through academic research and judicial practice. The separability doctrine, especially the conceptual separability, sheds light on the judgment of aesthetic feature and makes aesthetic feature distinguishable from functional aspect.

The conceptual separability doctrine is advantageous compared to the physical separability. The major reason is that not all copyrightable works of applied art contain independent aesthetical features which are physically separated from functional parts. Mere focus on physical separability will exclude a large number of works of applied art which are eligible for copyright protection. Further, the physical separability embodies intrinsic doctrinal conflicts. If a certain part in a useful article is designed artistically and can be physically separated from the rest part, the certain artistic part can be deemed as a work of fine art under the copyright protection. Why do we bother to protect the whole article as a work of applied art and extend the copyright protection to the independent functional part? On the contrary, conceptual separability acknowledges entangling of aesthetic and functional parts of a useful article and resembles its special characteristics, namely, merging both art and functions. More importantly, conceptual separability provides a general guide for granting copyright protection to those useful articles in which the aesthetic part can be deemed conceptually separable from the functionality.

However, conceptual separability is not easy to master. Otherwise, the United States courts will not develop or adopt various approaches to tackle with the issue. The existence of various approaches has aroused several problems. First, different courts inclined to adopt their own approaches to make decisions, which resulted in inconsistent judgments and unpredictable copyrightability of useful articles. Second, each approach owns its limitations. Neither of them was fully acceptable by the courts. To sum up, the major considerations that spur practitioners and scholars to amend these approaches are: (1) determination of art will be subjective and vary among different viewers; (2) determination of aesthetic feature of a useful article based on the creator's state of mind and the creation process will take side with the creator and impede competition; (3) decision of the primary and secondary roles of the aesthetic and functional parts of an article is not feasible; and (4) relying on marketability to determine copyrightability will only protect mainstream art, thus, excluding unmarketable art.

The recent judgments concerning copyrightability of useful articles did not jump out of the existing conceptual separability doctrine and still followed the ways that courts have formerly stepped on. In *Ochre LLC v. Rockwell Architecture, Planning*

[35] *Supra* note 28.

and Design, P.C., et al.,[36] in order to determine whether the light fixtures at issue were copyrightable, the Second Circuit Court of Appeals first looked at the light fixtures' "intrinsic utilitarian function of providing light to a room"[37] which made the light fixtures be qualified as useful articles. The Second Circuit then cited a number of precedents to explain that the general shape of a lamp was not copyrightable, "because its overall shape contributes to its ability to illuminate the reaches of a room".[38]

In *Home Legend, LLC. v. Mannington Mills, Inc. and Power Dekor Group Co., Ltd.*,[39] the article at issue was "Mannington's décor paper design… which is a huge digital photograph depicting fifteen stained and apparently time-worn maple planks".[40] Following the physical and conceptually separability doctrine, the district court found the design not copyrightable, as it was "a functional component of the flooring itself".[41] The design was "simply not separable from the functional element of the flooring and… would not be marketable if it were separated from the functional elements of the flooring".[42] The Eleventh Circuit Court of Appeals reversed, holding that the design was physically and conceptually separable from the flooring. The design was physically separable, because the identical flooring could use different designs.[43] The interchangeability of the design and flooring implied that the two things were physically separable objects. The design was conceptually separable from the flooring, as the design might be applied to "wallpaper or as the veneer of a picture frame".[44]

III. The High or Average Aesthetic Requirement in Germany and China

The copyright practice in Germany and China does not develop separability doctrine as in the United States. Instead, the German and Chinese courts under some circumstances adopt higher aesthetic requirement to grant copyright protection to works of applied art than that for works of fine art.

The German Law on Copyright and Neighboring Rights[45] categorizes works of applied art under the class of works of fine art.[46] The Chinese Copyright Law does not clearly include works of applied art in the list of protectable works. However, as a member country of the Berne Convention for the Protection of Literary and Artistic Works which includes works of applied art as protectable literary and artistic works,[47] the Chinese Regulations for Implementing International Copyright Treaties have provided protection for foreign works of applied art with the term of protection for 25

[36] 530 Fed. Appx. 19 (2nd Cir. 2013).
[37] *Id*. at 19.
[38] Chosum International, Inc. v. Chrisha Creations, Ltd., 413 F.3d 324, at 328 (2nd Cir. 2005).
[39] 784 F.3d 1404 (11th Cir. 2015).
[40] *Id*. at 1406.
[41] *Id*. at 1408.
[42] *Id*. at 1408.
[43] *Id*.
[44] *Id*. at 1412.
[45] German Law on Copyright and Neighboring Rights has been amended several times. The lasts version in English is the 1998 Amendment.
[46] Article 2 of the German Law on Copyright and Neighboring Rights provides: "works of fine art, including works of architecture and of applied art and plans for such works".
[47] The Berne Convention for the Protection of Literary and Artistic Works, Art 2(1).

years from the completion of the works.[48] The Regulations further explain that the provision for protection of foreign works of applied art does not apply to works of fine art. Under such explanation, the Chinese Regulations divide works of fine art and works of applied art into separate categories. However, the courts in China do not embrace the division made by the Regulations and generally uphold that works of applied art are eligible to be protected as works of fine art.

Different from the United States courts, the German and Chinese courts incline to view works of applied art as merger of aesthetic features and utilitarian functions, and adopt high or average aesthetic standard to determine copyrightability of works of applied art.

A. Merger of Aesthetic and Functional Aspects

The German courts do not require that the aesthetic feature of a work of applied art shall be physically or conceptually separable from the functional part. As long as a work satisfies the threshold of originality in copyright protection, such work should be copyrightable. Before the German Federal Court of Justice issued the "Birthday Train" landmark judgment in 2013, the requirement for the aesthetic feature in works of applied art is higher than that for works of ordinary fine art. For example, if a picture is used on a badge, the aesthetic feature of the badge shall be more artistic and distinctive than the picture itself.

The Chinese Regulations for Implementing International Copyright Treaties specifically point out that artistic works that apply to industrial products should not be deemed as works of applied art.[49] In other words, the Chinese Regulations do not recognize physical separability of aesthetic features and functional aspect. If the aesthetic feature can be physically separable from the function, such aesthetic feature shall not be protected as works of applied art. Works of applied art only include those articles that well merge aesthetic features and functional parts. According to the legislative explanations concerning the Chinese Copyright Law provided by the Chinese National People's Congress, carved vase should be deemed as a work of applied art, as the artistic design is not separable from the functional element; while wallpaper with printed pattern is not a work of applied art, as pattern can be physically separated from the wallpaper and such separation will not influence the functionality of the wallpaper.[50]

B. High or Average Aesthetic Requirement

Before the "Birthday Train" case, German courts adopted the doctrine of levels[51] to set up the threshold of originality with respect to various kinds of works. The doctrine of levels divides the threshold of originality into three degrees: the average level of designer skill as the first degree; the exceeding average level of designer skill as the second degree; and the substantially exceeding average level of designer skill as the third degree.[52] The first-degree originality is applicable to ordinary works of

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[48] The Chinese Regulations for Implementing International Copyright Treaties, Art 6.

[49] *Id*. 2nd Para.

[50] Explanations of the Chinese Copyright Law, available at http://www.npc.gov.cn/npc/flsyywd/minshang/2002-07/15/content_297588.htm (visited on Nov. 28, 2015).

[51] Doctrine of levels is named "Stufentheorie" in German.

[52] Christian Donle, Anke Nordemann-Schiffel, and Jan Bernd Nordemann, *The Interplay between Design and Copyright Protection for Industrial Products*, available at http://aippi.org/wp-content/uploads/committees/231/GR231germany_en.pdf (visited on Nov. 29, 2015).

fine art. Works of fine art are under the so-called "small coin"[53] theory for obtaining copyright protection. In other words, a work demonstrating a minimal level of creativity will be copyrightable as work of fine art, such as a simple drawing or a plain design. However, for industrial products to be protected as works of applied art, the second- and third-level originality is applicable. Under such circumstances, utensils are copyrightable only in cases "where there is a considerable exceeding of the average degree of the design skill".[54] The reason for high level of originality is due to the existing eligible design right for works of applied art. Therefore, copyright systems require a higher originality requirement for works of applied art to be distinguishable from the design right. The more complex and creative of the work, the wider scope of copyright protection will be available. The copyrightable industrial products that were contained in the German cases include beer cup with football design,[55] stretch ring, figure toy, Le Borbusier-Möbel furniture,[56] fireplace, vase lamp, etc.

Although Chinese courts do not develop doctrine of levels as German courts did, Chinese courts have rendered a couple of typical decisions on industrial products that should be protected as works of applied art and those not copyrightable. These decisions show the opinions of the Chinese courts on the aesthetic requirement. In *OKBaby, Ltd. v. Cixi Jiabao Child Product Ltd.*,[57] the court found the child toilet potty with animal images copyrightable, as the toilet potty was of aesthetic value, artistic and original. In *Blumberg Industries, Inc. v. Zhongshan Juguang Lamp Ltd.*,[58] the court granted copyright protection to the plaintiff's lamp, as the lamp was designed with decorative flower pattern and in colors, and thus satisfied the originality of works of fine art. In *Chaozhou Gelante Clothes Ltd. v. Haichang Ltd.*,[59] the appellant court considered the ceramic products of Haichang Ltd. as copyrightable works of applied art, as the ceramic products were different from traditional chinaware and from those unique characteristics of previous chinaware, and thus were within the protectable scope of works of fine art. In *MEGA Brand, Inc. v. Shantou Shunsheng Toy Industrial Ltd.*,[60] the court held that the toy of dump wagon design at issue was copyrightable. Although the defendant, who copied the plaintiff's design, argued that the toy wagon focused on the practical function and did not significantly differentiate from the wagon in reality, the court opined that the toy wagon could not avoid adopting the practical function of a wagon and was designed in a concise and colorful way to entertain children. According to the court's point of view, the toy wagon reached the artistic value required by works of applied art.

On the contrary, in *Ailumu International Inc. v. Huizhou Xinlida Electronic Tools Ltd.*,[61] the court held that works of applied art were not expressly protected under the Chinese Copyright Law, unless they had achieved a high enough level of artistic value as works of fine art. Those products with low aesthetic elements or lack of artistic

[53] "Small coin" theory is named "Kleine Münze" in German, which means "work of minimal creativity".
[54] *Supra* note 52.
[55] OLG Köln GRUR-RR 2010, 139 – Weißbierglas mit Fußballkugel.
[56] BGH GRUR 1987, 903,904 et seq. – Le Corbusier-Möbel.
[57] Beijing Second Intermediate People's Court, No. 12293 (2008).
[58] Beijing Second Intermediate People's Court, No. 17315 (2006).
[59] Jiangxi High People's Court, No. 19 (2007).
[60] Shantou Intermediate People's Court, No. 107 (2012).
[61] Guangdong High People's Court, No. 45 (2006).

feature shall be excluded from copyright protection. As for the plastic cutter at issue, since it did not induce people to feel its artistic value, but merely emphasized on practical function, the court rejected to grant copyright protection to such an industrial product. In *Inter Ikea Systems B.V. v. Taizhou Zhongtian Plastic Ltd.*,[62] the court held that artistic attributes to the child furniture at issue did not achieve the aesthetic requirement to be protected as works of fine art, as the furniture mainly demonstrated the external appearance of child's chair and stool.

Although the Chinese courts do not expressly rule that copyright protection for works of applied art requires higher aesthetic elements than that for works of ordinary fine art, a quite number of the Chinese courts do state in their judgment that the products should achieve a high enough level of artistic value to be protected under the Copyright Law as works of fine art, because in judicial practice the Chinese courts placed works of applied art into the category of works of fine art.

C. Recent Development of Aesthetic Requirement in German Courts: Birthday Train Case

In the "Birthday Train" landmark case decided by the German Federal Court of Justice, the copyrightability at issues was "a wooden train consisting of several wagons onto which numbers and candles can be placed".[63] Following the doctrine of levels and previous precedents, the lower courts held that the "Birthday Train" was not eligible for copyright protection as an exceeding level of originality was required for protecting industrial products as works of applied art.[64]

The German Federal Court of Justice reversed, abandoning the high level of originality requirement in the previous practice and holding that "the 2004 amendments to German design law have established the protection of designs as an independent intellectual property rights and therefore detached design law from copyright law".[65] Since the design law no longer requires originality for designs "but individual character in the design differing it from the existing design corpus",[66] the German Federal Court of Justice ruled that design protection and copyright protection could be mutually applicable to works of applied art and special preconditions were no longer required for copyrightability of works of applied art. Finally, the Federal Court of Justice concluded that for copyright protection of works of applied art, "a degree of creativity which allows, from the view of a public open to art and sufficiently skilled in ideas of art, to be called an 'artistic' performance" would be required.[67]

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[62] Shanghai Second Intermediate People's Court, No. 187 (2008).

[63] *German Federal Court of Justice Expands Copyright Protection of Works of Applied Art*, available at http://www.bakermckenzie.com/files/Publication/605dab6d-023a-4209-9238-17b5c9e75249/Presentation/PublicationAttachment/70db4a80-e96a-4072-8c25-1cda5a11d564/AL_GermanyIP_EN_Mar2014.pdf (visited on Nov. 29, 2015).

[64] *Id*.

[65] *Id*.

[66] Florian Traub, *Graphics and Designs Gain Improved Copyright Protection in Germany in "Birthday Train" Case*, available at http://www.iptechblog.com/2013/12/graphics-and-designs-gain-improved-copyright-protection-in-germany/ (visited on Nov. 29, 2015).

[67] Henning Hartwig, *German Federal Supreme Court: Relationship between National Copyright Law and National and/or European Design Law*, available at http://cn.lexology.com/library/detail.aspx?g=347fb9e3-0348-4af9-b7cf-ed1d7449dbf0 (visited on Nov. 29, 2015).

D. Conclusion: the High or Average Artistic Originality Requirement in Germany and China

The German and Chinese courts are used to adopt the artistic value and originality requirement for works of fine art as reference to determine copyrightability of works of applied art. Such practice is understandable, as works of applied art are categorized under the class of works of fine art in the German Law on Copyright and Neighboring Rights, and are deemed by the Chinese courts as works of fine art in rendering decisions. Acting as a watershed, the "Birthday Train" decision made by the German Federal Court of Justice divides the examination standard for copyrightability of works of applied art into surmounting artistic level and average level of creativity. The Chinese courts do not expressly classify the standard for determining originality for works of applied art. However, certain courts in China do mention in their judgments that works of applied art shall achieve a high enough level of artistic value as works of fine art to be protected under the Copyright Law.

Although the high or average artistic requirement with reference to copyright protection for works of fine art in Germany and China avoids application of the complex conceptual separability tests in the United States, the artistic requirement, no matter surmounting or average, still embodies shortcomings that have not been well resolved by the German and Chinese courts. First, artistic feature and originality are two different concepts. A work is original if it is created by the designer him/herself and does not copy any previous creations. The designer has endeavored to create such a work with modicum of creativity. Differently, artistic feature is the expression of an article's external appearance which can arouse viewers' aesthetic feeling. Therefore, originality and artistic feature should be examined in two steps rather than touched upon at the same time. Second, it is impossible to set up a fixed standard to examine the artistic feature, as determination of artistic value is subjective and vary among in different eyes. Since the judgment is subjective, judges or ordinary observers cannot accurately sense out neither the average level nor the surmounting level of artistic creations. Under such circumstance, it will be meaningless to classify artistic originality into different levels, as no consistent standard can be established for judging the average level of artistic originality. Finally, the Chinese courts do not clarify who will be the judgers to decide the artistic feature in works of applied art. The cases indicate that similar to the German court, the artistic value in Chinese works applied art, is decided by the judges themselves as ordinary observers or from the perspective of ordinary reasonable persons. Under special circumstance, the Chinese court invited art experts to weigh the artistic value in a viewpoint of an artistically skilled person.[68] However, as judges either in Germany or China are not well trained in art and aesthetics, letting judges be the judgers for artistic value in works of applied art will make decisions inconsistent and unpredictable.

IV. Proposed Four-Step Test for Determining Copyrightability of Works of Applied Art

In light of the dilemma in determination of copyrightability of works of applied art in the United States, Germany and China, this article intends to propose a four-step test to examine copyrightability so as to avoid the existing problems and help increase

[68] Hu Sansan v. Qiu Haisuo and National Art Museum of China, Beijing High People's Court, No. 18 (2001).

the expectancy of the judgment. The proposed test will borrow the advantages in the current practice of the three jurisdictions, and avoid falling within the potential loopholes. That said, the proposed test is by no means perfect, but attempts to offer creators, judges and the public users a feasible approach to weigh copyrightability of a design.

The first step is to examine whether the design has utilitarian functions so as to fall within the scope of useful articles. If an article has utilitarian functions, the second step is to examine whether there is aesthetic feature in the article. The examination of artistic feature will be based on the idea and expression dichotomy and merger doctrine. If both utilitarian function and aesthetic feature are satisfied, the third step is to analyze whether the work satisfy the originality threshold for copyright protection. If originality is satisfied, the final step will focus on the functionality of the aesthetic feature. Although the fourth step to a certain degree is similar to the second step, duplicated examination of the aesthetic feature will guarantee that copyright protection will not extend to the functional part of a design and thus impede competition.

In analysis of the application of the four-step test, this article will use following designs in the afore-discussed cases as examples: the buckles in *Kieselstein-Cord*, the human torsos in *Carol Barnhart*, the birthday train in the German court decision, and the child furniture decided by the Chinese Shanghai Second Intermediate People's Court. Finally, this part will use the four-step test to discuss copyrightability of a special kind of works of applied art: costume.

A. First Step: Utilitarian Function

In order to fall within the scope of works of applied art, an article should first have utilitarian function. Section 101 of the United States Copyright Act of 1976 clearly defines "useful articles" as "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information". Such clear definition can be borrowed by the first step test for examining utilitarian function. In other words, an article should have intrinsic utilitarian function other than show its appearance to be qualified as having utilitarian function.

For example, buckles have intrinsic utilitarian functions to tighten pants other than show themselves as metal decoration. Human torsos have intrinsic utilitarian function to demonstrate clothes rather than being sculptures. Although some scholars have argued that Michelangelo's *David* can also be regarded as a useful life-sized mannequin,[69] *David* is not intrinsically suitable for displaying clothes due to its stance and body movements.

Birthday train as a child's toy has functions to entertain children and enlighten their intelligence. However, such functions shall not be deemed as intrinsic utilitarian function other than show its appearance, as the function to entertain and enlighten children is originated from demonstration of the toy train's appearance. However, a toy with enough artistic feature and originality may be protected as a work of fine art instead of as a work of applied art.

Child's furniture as discussed by the Chinese court is colorful chair and stool.

[69] Gary S. Raskin, *Copyright Protection for Useful Articles: Can the Design of An Object Be Conceptually Separated from the Object's Function?*, 33 SANTA CLARA L. REV. 171 (1993).

The intrinsic utilitarian function of chair and stool is for children to sit and have a rest. Such functions do not arise from showing the external appearance of the chair and stool. In light of the first step analysis, buckles, human torsos and child's furniture shall be deemed as having utilitarian functions; while birthday train as child's toy does not have utilitarian function, and thus shall be protected as work of fine art if other preconditions are satisfied.

B. Second Step: Aesthetic Feature

In order to avoid subjective judgment of art, this article suggests that examination of aesthetic feature should be based on the idea and expression dichotomy and merger doctrine. Namely, a useful article is considered to have aesthetic feature only if the expression of the article is not necessitated by the idea to create such a form. That is, "when an idea necessitates a certain form of expression… the idea and expression are said to merge, resulting in denial of copyright protection for that expression".[70]

Taking the buckles, human torsos and child's furniture that pass the first-step test for example, the idea of creating buckles is for tightening pants. However, Kieselstein-Cord's buckles are decorated with artistic designs that are not expression resulted from the idea. The idea of designing human torsos is for displaying clothes. Since the expression of Carol Barnhart's torsos is necessitated by the idea and reflects the idea without substantial variations, the expression and the idea for creating the torsos have merged, thus, denying the existence of artistic feature in the torsos. Creation of child's chair and stool aims to let children take a seat. Although the forms of the chair and stool at issue do not substantially differentiate from ordinary chairs and stools and are necessitated by the idea of creation, the various colors brushed on the chair and stool are not necessitated expressions limited by the idea. In a conclusion, the buckles and child's furniture satisfy the second-step test; while the human torsos fail.

C. Third Step: Originality

When an article contains both utilitarian function and aesthetic feature, such article will be examined by the third-step test. In order to be protected by copyright laws, a work of applied art should achieve the originality threshold. Section 102 of the United States Copyright Act of 1976 provides that "copyright protection subsists… in original works of authorship fixed in any tangible medium of expression". The German Federal Court of Justice requires "a degree of creativity"[71] to provide copyright protection to a work. The Chinese courts mentioned that copyright protection should reach the basic level of creativity required by the protection of works.[72] Originality only requires an author's independent creation without copying any previous works. The work only needs to possess "some creative spark, no matter how crude, humble or obvious".[73]

Taking the buckles and child's furniture that have fulfilled the first two steps test for example, the buckles were designed by Kieselstein-Cord from "original renderings

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[70] *Id*. at 205.
[71] *Supra* note 67.
[72] *Supra* note 60.
[73] Feist Publications v. Rural Telephone Service Corporation, Inc., 499 U.S. 340 (1991), at 345.

he had conceived and sketched… the buckles each contained rounded corners, sculpted surfaces, several surface levels, and rectangular cut-outs at one end for the belt attachment".[74] The buckles satisfy the originality threshold for copyright protection. On the contrary, the child's chair and stool in the Chinese case belong to rather simple designs which do not substantially differentiate from ordinary chairs and stools. The colors on the child's chair and stool are also simple, which do not distinguish the creations from any previous designs. Therefore, the child's chair and stool fail the originality requirement.

D. Fourth Step: Functionality of Aesthetic Feature

If a design has achieved the above three steps test, the design has almost reached a degree for which copyright protection may be granted. However, in order to avoid extended protection to the functional part which will impede future industrial production, the proposed test includes the fourth step to determine copyright infringement that should be prevented. The fourth step will examine whether functionality of the aesthetic feature of a work of applied art mainly assists to achieve the work's intrinsic utilitarian functions in addition to its functionality of decoration.

For example, if the artistic design of the Kieselstein-Cord buckles mainly assists to tighten pants, copying of the forms of the Kieselstein-Cord buckles shall not be ceased, as imitation of technical and functional improvement shall be encouraged to increase competition and heighten social efficiency. Such functional improvement is more appropriate to be protected by industrial design right instead of copyright. That said, since the artistic design of the Kieselstein-Cord buckles does not mainly assist to achieve the intrinsic functions of the buckles, copying of the design should thus be prohibited.

E. A Special Kind: Costume

Costume is a special kind of designs compared with buckles, torsos, furniture, bicycle rack, etc., as the latter only have single utilitarian function while costume contains two separate utilitarian functions, namely, warming and decorating human body. More importantly, there will be many products generated from the procedure of designing and producing costumes. Costume designs may be protected as graphic works; costume renderings and patterns on costume may be protected as works of fine art if they reach the originality standard of protection. If patterns on costume can be protected as works of fine art, does it mean that the costume as a whole can be protected as a work of applied art? The answer to this question may be no.

In *Poe v. Missing Persons*,[75] the Ninth Circuit Court of Appeals inclined to grant copyright protection to a swimsuit, although it did not decide ultimately whether the swimsuit was copyrightable. According to the court, the swimsuit was constructed of clear plastic and crushed rock, which was impractical for clothing or swimming, or any other utilitarian purposes. The court more deemed it as a work of art other than a useful article. In *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*,[76] the court rendered copyright protection to the costumes, as "the designs and forms had little to

[74] *Supra* note 28.
[75] 745 F.2d 1238 (9th Cir. 1984).
[76] 696 F.Supp. 1348 (S.D. Cal 1988).

do with their suitability as wearing apparel".[77] In *Chosum International, Inc. v. Chrisha Creations*,[78] the Second Circuit Court of Appeals did not agree that all costumes were automatically considered as works of applied art. In *Galiano*, the Fifth Circuit Court of Appeals adopted the marketability test to reject copyrightability of the casino costumes, as these uniforms were not marketable except for their intended functions as casino uniforms.

In *Hu Sansan v. Qiu Haisuo and National Art Museum of China*,[79] the copyrightability at issue was Qiu Haisuo's design of a series of costumes in the name of "Story of Spring". The court viewed that the costumes adopted various design factors, such as modelling, colors, material and crafts, from which ordinary observers could sense out modern artistic feeling combining both Chinese and Western cultures. The costumes were thus copyrightable under the Chinese Copyright Law. On the contrary, in *Shanghai Jinhe Protective Products, Ltd., et al. v. Shanghai Zhengbo Clothing Ltd., et al.*,[80] despite that the plaintiffs claimed the overall appearance of the protective coveralls reflected aesthetic value, the court decided that the alleged aesthetic value was also inevitable utilitarian function. Since the aesthetic feature and the utilitarian function were integral and inseparable, the coveralls were merely industrial products other than works of applied art.

In light of the above-mentioned American and Chinese cases, this article intends to use the four-step test to analyze ordinary wearing apparels and fashionable costumes. With respect to the ordinary apparels to pass the first step of the test, intrinsic utilitarian functions of the apparels should not merely portray their appearance or to convey information. As aforementioned, ordinary apparels have two intrinsic functions: warming and decorating human body. The warming function is achieved by material and texture of the apparels; while the decorating function is achieved by aesthetic designs on the clothes. The two functions are achieved through separate ways and are not intertwined. As for the part concerning artistic design, the decorating function merely portrays the designs' appearance and conveys information shown in the designs. Therefore, ordinary apparels do not pass the first-step test and shall not be deemed as useful articles in the concept of copyright protection. The designs on clothes, if satisfying the artistic and originality threshold, may be protected as works of fine art.

With respect to fashionable costumes as always displayed in fashion shows, although they are displayed by models, most of them are unsuitable for people to wear comfortably and are unable to warm human body. The only intrinsic utilitarian function of fashionable costumes is for decoration and display of art. Such utilitarian function merely portrays the appearance of the costumes. Hence, fashionable costumes should not be deemed as works of applied art either. Instead, they shall be considered as art itself and be protected as works of fine art under the copyright protection systems.

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[77] *Id*. *Also see* Azita Mirzaian, *The Utility of Prettiness: Copyright Protection for Mardi Gras Indian Suits in the Era of the Useful Article Analysis*, 59 J. COPYRIGHT SOC'Y U.S.A. 747 (2011-2012).
[78] *Supra* note 38.
[79] *Supra* note 68.
[80] Shanghai Pudong New District Court, No. 53 (2005).

V. Conclusion

Determining copyrightability of works of applied art is not an easy task. Despite of the consistent characteristics of works of applied art, different jurisdictions have developed various approaches to tackle with the issue, among which the American physical and conceptual separability and the German and Chinese high or average aesthetic requirement are typical ways. However, neither of these approaches is perfect for resolving the issue. Each approach has its potential loopholes.

This article attempts to suggest a four-step test to better determine copyrightability of works of applied art by examining intrinsic utilitarian function, aesthetic feature based on the idea and expression dichotomy and merger doctrine, originality threshold and functionality of the aesthetic feature of a design step by step. Such a new approach aims to avoid subjective judgment of art by ordinary observers and strike a balance between protecting creation and promoting competition.