



ANNOUNCEMENT

from the Copyright Office, Library of Congress, Washington, D.C. 20559

NOTICE OF INQUIRY

REGISTRABILITY OF COSTUME DESIGNS

The following excerpt is taken from Volume 56, Number 85 of the Federal Register for Thursday, May 2, 1991 (p. 20241-20242)

LIBRARY OF CONGRESS

Copyright Office

[Docket No. RM 90-7]

Registrability of Costume Designs

AGENCY: Copyright Office, Library of Congress.

ACTION: Notice of inquiry.

SUMMARY: The Copyright Office issues this Notice of Inquiry to advise the public that the Copyright Office is reviewing its practices regarding the registrability of three-dimensional garment or costume designs and to invite public comment, views, and information that will assist the Copyright Office in examining the bases on which copyright protection may inhere in such works. Such an examination may lead to a revision of Copyright Office practices regarding the registration of the three-dimensional aspects costume designs.

DATES: Initial comments should be received on or before July 1, 1991. Reply comments should be received on or before July 31, 1991.

ADDRESSES: Interested persons should submit ten copies of their written comments to the Office of the General Counsel, Copyright Office, Library of Congress, Department 17, Washington, DC 20540. Comments delivered by hand should be submitted to the Office of the Register of Copyrights, Copyright Office, James Madison Memorial Building, room 407, First Street and Independence Avenue, SE., Washington, DC.

FOR FURTHER INFORMATION CONTACT: Dorothy Schrader, General Counsel,

Copyright Office, Library of Congress, Washington, DC 20540. Telephone: (202) 707-8380.

SUPPLEMENTARY INFORMATION:

1. Background

Registration may be obtained for original pictorial, graphic, and sculptural works. Copyright Act of 1976, title 17 U.S.C. 102(a)(5), 408. The category of pictorial, graphic, and sculptural works includes works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned. The designs of useful articles are considered protectible pictorial, graphic, or sculptural works only if, and only to the extent that, such designs incorporate pictorial, graphic, or sculptural features that can be identified separately from, and can exist independently of, the utilitarian aspects of the article. 17 U.S.C. 101 (definition of "pictorial, graphic, and sculptural works").

The Copyright Act defines a "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." An article that is normally a part of a useful article is also considered a "useful article." *Id.*

The House Judiciary Committee report accompanying the 1976 Copyright Act explained that through the above definitions of protected subject matter Congress sought to "draw as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design." H.R. REP. NO. 94-1476, 94th Cong. 2d Sess. 55 (1976). The report provided further guidance in a lengthy but invaluable passage:

A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, 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 separable 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 an article is determined by aesthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. *Id.*

(Emphasis added.)

The Copyright Office has generally refused to register claims to copyright in the three-dimensional aspects of clothing or costume design on the ground that articles of clothing and costumes are useful articles that ordinarily contain no artistic sculpture separable from their overall utilitarian shape. Two dimensional design applied to the surface of the clothing may be registered, but this claim to copyright is generally made by the fabric producer rather than the garment or costume designer. Moreover, this claim to copyright is ordinarily made when the two-dimensional design is applied to the

textile fabric and before the garment is cut from the fabric.

The 1976 House Report confirms that "ladies' dress" and other clothing cannot be protected by copyright merely on the ground that the appearance of the useful article is determined by esthetic¹ considerations. Over the last few years, however, the Office registered a few narrowly drawn claims² in certain three-dimensional fanciful or animal-shaped items that can be worn. Some of these claims have been the subject of litigation.

In *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*,³ the court decided that the costumes before it contained separable artistic authorship sufficient to support a copyright. At the same time, the court acknowledged that the primary purpose of masquerade costumes was to permit the wearer to "masquerade" and that the costumes "lie on the margin of utility."

Recently, the Second Circuit Court of Appeals affirmed on other grounds a district court that held that copyrightable design requires artistic authorship uninfluenced by functional² considerations. *Whimsicality, Inc. v. Rubie's Costumes Co., Inc.*³ The costumes were, according to this district court, "dominated by utilitarian concerns," with the result that there were no artistic elements apart from the utilitarian shape of the useful article.⁴

The Copyright Act of 1976 accords³ no copyright protection to the overall shape of designs if the article has "an utilitarian function that is not merely to portray the appearance of the article or to convey information."⁵ As confirmed

in the *Whimsicality* case, the relevant inquiry is whether there is an intrinsic useful purpose, not merely a possible⁴ incidental useful purpose.

Subsequently, the Third Circuit reverse a district court's finding that⁵ animal nose masks are uncopyrightable as useful articles.⁶ The court of appeals found, instead, that the masks were not useful articles because the only function was simply to portray their appearance. Therefore, the novelty masks were excluded from the statutory definition of useful articles. Similarly, the Eighth Circuit upheld copyright in animal bear claw slippers,⁷ and a district court in New York upheld copyright in animal shaped children's backpacks,⁸ before the *Whimsicality* case was decided.⁶

Although not a costume design case, the Second Circuit's decision in *Carol Barnhart Inc. v. Economy Cover Corp.*,⁹ represents an important interpretation of the separability test of the Copyright Act. The Carol Barnhart court denied⁷ copyright protection to life-size anatomically correct mannequins because the configurations were "inextricably intertwined with their function to display clothes, and thus the artistic features were inseparable from their utilitarian dimension."¹⁰

2. Policy Issues Relating to Registration of Costume Designs

In view of the recent case law affecting costume designs, the Copyright Office is reviewing its registration standards as applied to designs of garments and costumes. To maintain consistency with settled copyright principles, we will avoid adopting standards that take marketability, or aesthetic quality, into consideration.

To help us in developing our registration practices, the Office solicits general views about the correct interpretation of the Copyright Act in the case of three-dimensional design of garments and costumes. The Office specifically solicits the public's views and comments on the following:

1. Are all costumes useful articles? If not, which costumes are not useful articles and how can the Copyright Office distinguish between those that are and those that are not useful? Can the Copyright Office register masks of a fanciful character but not a full body costume of the same character? Does it matter if the costume is intended to be worn over clothing?

2. Can a line be drawn by the Copyright Office permitting registration of three-dimensional aspects of some costume designs, perhaps in the case of highly fanciful or animal-like designs, while denying registration of designs of clothing, theatrical costumes, and nonfanciful costumes?

3. If certain three-dimensional design elements of garments or costumes should be protected, what standards should be applied in determining the copyrightability of these elements. How should the Copyright Office apply the separability test of the definition of pictorial, graphic, or sculptural works in the case of garment or costume designs.

4. Does the intention of the artist or designer have any relevance in determining whether a costume contains aesthetic features separate from the functional purpose?

Dated: April 16, 1991.

Ralph Oman,
Register of Copyrights.

Approved by:

James H. Billington,
The Librarian of Congress.

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¹ *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, 912 F.2d 663 (3rd Cir. 1990).

² *Animal Fair, Inc. v. Amfesco Industries, Inc.*, 820 F. Supp. 175 (D. Minn. 1985), *aff'd mem.* 794 F.2d 678 (8th Cir. 1986).

³ *Act Young Imports, Inc. v. Band E Sales Co.*, 673 F. Supp. 672 (S.D.N.Y. 1987).

⁴ 773 F.2d 411 (2d Cir. 1985).

⁵ 733 F.2d at 413⁸

¹ No claim, for instance, can be made on the functional design of clothing.

² 806 F. Supp. 1348 (S.D. Cal. 1988).

³ 721 F. Supp. 1566 (E.D.N.Y. 1989), *aff'd*, 891 F.2d 452 (2d Cir. 1990).

⁴ 721 F. Supp. at 1574.

⁵ 17 U.S.C. 101 (definition of "useful article"); *Fabrica Inc. v. El Dorado Corp.*, 697 F.2d 890, 893 (9th Cir. 1983).

¹ Errors; lines should read:
"useful article is determined by a esthetic"

² "authorship uninfluenced by functional"

³ "The Copyright Act of 1976 accords"

⁴ "in the *Whimsicality* case, the relevant inquiry is whether there is an intrinsic useful purpose, not merely a possible"

⁵ "reversed a district court's finding that"

⁶ "the *Whimsicality* case was decided."

⁷ "Act. The *Carol Barnhart* court denied"

⁸ 10733 F.2d at 413"