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ANNOUNCEMENT

from the Copyright Office, Library of Congress, Washington, D.C. 20559-6000

POLICY DECISION AND AMENDMENT OF REGULATIONS

REGISTRABILITY OF PICTORIAL, GRAPHIC, OR SCULPTURAL WORKS WHERE A DESIGN PATENT HAS BEEN ISSUED

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LIBRARY OF CONGRESS

Copyright Office

[Docket No. RM 95–3]

Registrability of Pictorial, Graphic, or Sculptural Works Where a Design Patent Has Been Issued

AGENCY: Copyright Office, Library of Congress.

ACTION: Policy decision and amendment of regulations.

SUMMARY: The Copyright Office of the Library of Congress issues this policy decision to clarify its practices and to amend the regulations regarding the registrability of claims to copyright in pictorial, graphic, and sculptural works for which a design patent has been issued. Under the current regulations, a copyright claim in a patented design, or in a scientific or technical drawing in an application of an issued patent is refused registration under the so-called "election doctrine." We believe there is no longer any legal justification for the continuation of this practice.

EFFECTIVE DATE: April 24, 1995.

FOR FURTHER INFORMATION CONTACT: Marilyn J. Kretsinger, Acting General Counsel, Copyright GC/I&R, P.O. Box 70400, Southwest Station, Washington, D.C. 20024. Telephone: (202) 707-8380. Telefax: (202) 707-8366.

SUPPLEMENTARY INFORMATION: Under the current Copyright Act, copyright is secured at the time of creation of the work without the necessity of any formalities, such as registration of an eligible unpublished work or publication with copyright notice, required under the 1909 Act. A patent, on the other hand, must be pursued through the process of examination in the Patent Office. The Commissioner of Patents actually determines the patentability of an invention or design and grants the patent.

The current regulations, 37 CFR 202.10(a) and (b), reflect the Copyright Office's policy of accepting the doctrine of "election of protection." For many years, the Copyright Office required claimants to elect between patent or copyright protection of useful pictorial, graphic, or sculptural expressions. The origin of this policy can be traced to a 1910 decision, *Louis de Jonge & Co.* v. *Breuker & Kessler Co.*, 182 F. 150 (C.C.S.E.D. Pa. 1910), aff'd, 191 F. 35 (3d Cir. 1911), *aff'd*, 235 U.S. 33 (1914), wherein the court held that a claimant could elect to secure protection under either patent or copyright but could not secure both. Similarly, in 1927, the D.C. Court of Appeals, in *In re Blood*, 23 F.2d 772 (D.C. Cir.1927) embraced the election doctrine.

The primary basis for the existing Copyright Office policy was the Second Circuit's decision in *Korzybski* v. *Underwood & Underwood, Inc.*, 36 F.2d 727 (2d Cir. 1929). The court ruled that "[a]n inventor who has applied for and obtained a patent cannot extend his monopoly by taking out a copyright." "The filing of the application for the patent • • • was a publication [and full disclosure of the invention] that entitled anyone to copy the drawings [representing the invention]." *Id.* at 729 (parenthetical added). However, in a landmark decision, *Mazer* v. *Stein*, 347 U.S. 201 (1954), the Supreme Court ruled that the same disclosure or publication might support a design patent and a copyright. "Neither the Copyright statute nor any other says that because a thing is patentable it may not be copyrighted." *Id.* at 217. The Court, however, expressly refused to entertain the issue of whether the grant of either monopoly precluded that of the other. A few years later, in *Vacheron & Constantin-LeCoultre Watches, Inc.* v. *Benrus Watch Co. Inc.*, 155 F. Supp. 932 (S.D.N.Y. 1957), *modified*, 260 F.2d 637 (2d Cir. 1958), the district court rejected arguments that seeking copyright protection precluded securing design patent protection. Indeed, the overlapping protection concerns two distinct statutory monopolies; and the doctrine of *Korzybski* "must rest upon the assumption that the owner of the statutory monopoly has some power to protect his 'work,' for otherwise any dedication would be without consideration." 260 F.2d at 642.

In 1968, the Copyright Office reviewed the election policy and reaffirmed its position on two grounds—public policy considerations and the publication with notice requirement. The public policy ground was based on the theory that it is an undue extension of the patent monopoly to allow, after the patent has expired, a copyright for the same design. If copyright protection were allowed to subsist, the public would be deprived from exploiting the work for the duration of the copyright. The second ground was a more practical one. The patent procedure required publication in the Official Gazette without notice of copyright. Since the 1909 Copyright Act required a notice of copyright on all published copies to secure and maintain copyright protection, this requirement foreclosed copyright protection for the patent drawings and placed the work in the public domain.

Prior to 1974, The United States Patent

and Trademark Office had an election policy similar to that of the Copyright Office. The Patent Office discontinued this requirement in view of the decision in *In re Yardley*, 493 F.2d 1389 (C.C.P.A. 1974), wherein the court stated that even though there is a definite overlap, "Congress has not provided that an author inventor must elect between securing a copyright or securing a design patent." *Id.* at 1394. "[T]he mere fact", said the court "that the copyright will persist beyond the term of any design patent which may be granted does not provide a sound basis for rejecting appellant's patent application." *Id.* at 1395. Reassessing its policy, the Copyright Office chose to follow Korzybski instead of Yardley, on the rationale that the latter case was limited to an interpretation of the design patent act while Korzybski interpreted the Copyright Act.

The Copyright Office regulations based on the election doctrine have been criticized. In his treatise on copyright, Nimmer observes:

> Without offering the rationale of publication or any other basis, Copyright Office Regulations under the 1909 Act simply provided that once a patent has been issued, copyright registration would be denied to a work of art and to a scientific or technical drawing. There appears to be no statutory or other justification for this position. It would seem on principle that if a work otherwise meets the requirements of copyrightability, it should not be denied such simply because the claimant happens to be entitled to supplementary protection under other legislation.[1]

We agree.

In consideration of the foregoing, the Copyright Office is issuing this Policy Decision and amending 37 CFR chapter II in the manner set forth below.

PART 202—[AMENDED]

1. The authority citation for part 202 continues to read as follows:

Authority: Section 702, 90 Stat. 2541, 17 U.S.C. 702.

2. In §202.10, paragraphs (a) and (b) are removed, the existing paragraph (c) is redesignated as paragraph (b), and a new paragraph (a) is added to read as follows:

§202.10 Pictorial, graphic, and sculptural works.

(a) In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form. The registrability of such a work is not affected by the intention of the author as to the use of the work or the number of copies reproduced. The availability of protection or grant of protection under the law for a utility or design patent will not affect the registrability of a claim in an original work of pictorial, graphic, or sculptural authorship.

Dated: March 14, 1995

Marybeth Peters
Register of Copyrights

Approved by:
James H. Billington
The Librarian of Congress

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[1] David Nimmer and Melville B. Nimmer, Nimmer on Copyright §2.19 (1994).