



ANNOUNCEMENT

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

POLICY DECISION

REGISTRABILITY OF COSTUME DESIGNS

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LIBRARY OF CONGRESS

Copyright Office

[Docket No. RM 91-5A]

Registrability of Costume Designs

AGENCY: Copyright Office, Library of Congress.

ACTION: Policy Decision.

SUMMARY: The Copyright Office of the Library of Congress issues this Policy Decision clarifying its practices regarding the registrability of masks and costume designs. Under the adopted practices, masks will be registrable on the basis of pictorial and/or sculptural authorship. Costumes will be treated as useful articles, and will be registrable only upon a finding of separable artistic authorship.

FOR FURTHER INFORMATION CONTACT: Dorothy Schrader, General Counsel, U.S. Copyright Office, Library of Congress, Washington, DC 20559; (202) 707-8380.

SUPPLEMENTARY INFORMATION:

1. Background

Works subject to copyright protection may secure copyright registration in the Copyright Office. Copyright Act of 1976, title 17, U.S.C. sections 508-412. Determining the registrability of masks and costumes requires the application of the definitions of "pictorial, graphic, and sculptural works" and "useful article," as set out in section 101 of title 17. These definitions are as follows:

"Pictorial, graphic, and sculptural works" includes two-dimensional and three-dimensional works of fine, graphic and applied art, photographs, prints and art reproductions, maps, globes, charts,

diagrams, models, and technical drawings, including architectural plans. Such works shall include 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.

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. An article that is normally a part of a useful article is considered a "useful article."

The House Judiciary Committee Report accompanying the 1976 Copyright Act explained that through the above definitions 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. 1478, 94th Cong. 2d Sess. 55 [1976]. The report provided further guidance as follows:

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 esthetic (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 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 authorship separable from their overall utilitarian shape. A 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 aesthetic considerations. Over the last few years, however, the Office registered a few narrowly drawn claims¹ in certain three-dimensional fanciful or animal-shaped items that can be worn. Some of these claims have been the subject of litigation.

2. Litigation

In general, cases have not treated masks as useful articles, and, as a result,

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

¹ Error; line should read:
"title 17, U.S.C. sections 408-412."

² Error; line should read:
"A two-dimensional painting, drawing, or"

copyrightability can be supported by a mere finding of pictorial or sculptural authorship. Costumes, on the other hand, have been treated as useful articles, necessitating a finding of separable pictorial or sculptural authorship in order to support copyright protection.

In one of the leading cases on masks, *Masquerade Novelty v. Unique Industries*, 912 F.2d 663 (3rd Cir. 1990), the court held animal masks were not useful articles because "nose masks have no utility that does not derive from their appearance." The masks were configured to resemble the nose of a pig, elephant, and parrot, and were found to be copyrightable. In *Pasillas v. McDonald's Corp.*, 927 F.2d 400 (9th Cir. 1991), copyright in a Halloween mask depicting a man in the moon was conceded to be valid, but summary judgment was granted in favor of the defendant due to lack of substantial similarity.

While the cases consistently treat costumes as useful articles, the applicable standards for determining separability are unclear. In *Animal Fair Inc. v. Amfesco Industries, Inc.*, 620 F.Supp. 175 (D.C. Minn. 1985), *aff'd mem.*, 794 F.2d 878 (8th Cir. 1986), the district court upheld copyright in a slipper depicting a bear's foot. While treating the slipper as a useful article, the court concluded the whole shape and design were recognizable as a fanciful artistic rendition of a bear's paw. The Eighth Circuit affirmed without written opinion.

The test of conceptual separability was raised in *Act Young Imports, Inc. v. B & E Sales Co., Inc.*, 673 F. Supp. 672 (S.D.N.Y. 1987), in a case involving children's backpacks. In that case the court upheld copyright in animal shaped backpacks because the animal image was separate from the useful function of the packs.

In *National Theme Productions Inc. v. Jerry B. Beck Inc.*, 696 F. Supp 1348 (S.D. Cal. 1988), a district court held that while masquerade costumes were useful articles, the costumes involved in the case successfully met the conceptual separability test. The works in issue were elaborate costumes depicting independently recognizable images and were registered by the Copyright Office.

In the complex case of *Whimsicality, Inc. v. Rubie's Costumes Co. Inc.*, 891 F.2d 452 (2nd Cir. 1989), the Second Circuit denied a copyright action alleging infringement of six costumes on the grounds that the claims had been misrepresented to the Copyright Office. The costumes had been registered as "soft sculptures" and the applications did not disclose that the works were

costumes. Under the unique facts of the case, the plaintiff was denied relief.

3. Notice of Inquiry

Due to the uncertainty regarding the registrability of masks and costume designs, the Copyright Office published a notice of inquiry on May 2, 1991. 56 FR 20241 (1991) concerning registration of costume designs. The notice summarized the applicable copyright principles in the area, including the case law. The notice further raised eight specific questions on which comment was sought.

The notice generated twelve comments. Some of the comments came from the garment industry, and those comments generally sought an expansion of the protection available to wearing apparel. Other comments came from the costume industry, and those comments were generally mixed as to whether or not the availability of copyright should be expanded. The remainder came from the bar and academic communities.

Of the comments which were received, most took the position that so-called fanciful costumes should be registered, while ordinary wearing apparel should be rejected. However, none of the comments taking such a position set out workable guidelines for separating fanciful costumes from wearing apparel. A differing view was expressed by one law firm, which took the position that all costumes were useful articles without any separate artistic authorship.

4. Summary of Policies Adopted

The examining practices with respect to masks will not treat masks as useful articles, but will instead determine registrability on the existence of minimum pictorial and/or sculptural authorship. Garment designs (excluding separately identifiable pictorial representations of designs imposed upon the garment) will not be registered even if they contain ornamental features, or are intended to be used as historical or period dress. Fanciful costumes will be treated as useful articles, and will be registered only upon a finding of separately identifiable pictorial and/or sculptural authorship.

5. Examining Practices With Respect to Masks

Current examining practices base registration of masks on the existence of minimum pictorial and/or sculptural authorship. Since masks generally portray their own appearance, this subject matter appears to fall outside of³ the definition of "useful article" in

section 101 of title 17. Both the case law and comment letters appear to agree with this position.

Although a mask alone is not considered a useful article, a legitimate question arises regarding registration practices in instances where a copyrightable mask is combined and sold as a unit with an otherwise uncopyrightable costume. In such circumstances, the Copyright Office will register the "work" on the basis of the copyrightable authorship in the mask. This approach appears to be consistent with *Mazer v. Stein*, 347 U.S. 201 (1954), holding that a copyrightable work of art does not lose its copyrightability upon incorporation into a useful article. Again, only the separable artistic features, in this case the mask, would be subject to copyright protection.

6. Examining Practices With Respect to Garment Designs

A few of the comment letters were from the garment industry urging a broader availability of copyright protection for garment designs. On this point the copyright law is reasonably clear. Garments are useful articles, and the designs of such garments are generally outside of the copyright law. Parties who wish to modify this position must address their concerns to the Congress, since establishment of such protection must have Congressional authorization.

The general policy of nonregistrability of garment designs will be applied not only to ordinary wearing apparel, but also to period and historical dress, and uniforms. Wearing apparel incorporated into theatrical productions will likewise be treated under the standards applying to garment designs in general.

7. Examining Practices With Respect to Fanciful Costumes

For purposes of copyright registration, fanciful costumes will be treated as useful articles. Costumes serve a dual purpose of clothing the body and portraying their appearance. Since clothing the body serves as a useful function, costumes fall within the literal definition of useful article. In addition, the case law consistently treats costumes as useful articles, and a Copyright Office decision to differ substantially from these court decisions would appear difficult to justify.

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

³Error; line should read:
"subject matter appears to fall outside of"

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. The standards for determining separability are set forth in section 505 of Compendium II of Copyright Office Practices.

8. Registration is Mandated Where Any Portion of a Work Contains Copyrightable Authorship

In examining claims to copyright, the Copyright Office is required to make a registration if any portion of a work can reasonably be construed as containing copyrightable authorship. Such a registration, should not be treated as

extending protection to uncopyrightable elements. For example, if an uncopyrightable costume is sold in packaging material which contains a pictorial illustration, the "work" would be registrable on the basis of the pictorial illustration.

In examining applications for registration, the Copyright Office will generally limit the claim if the application specifically asserts protection in an uncopyrightable element. In most cases, however, there is no correspondence detailing the basis of the registration.

It is hoped that this policy decision will clarify the policies of the Copyright Office with respect to masks and costumes and will discourage the

drawing of misleading conclusions regarding registrations which are made for parts of costumes. Costumes, by their very nature, exist at the boundary between works of imagination and works of utility. Portions of some costumes will be registrable under the separability test, and others will be unregistrable in all respects.

Dated: October 29, 1991.

Ralph Oman,
Register of Copyrights.

Approved:

James H. Billington,
The Librarian of Congress.

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