

Conceptual Separability and the Copyright/Patent Boundary

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The Problem

“Useful articles” are not protected by copyright,
but what if the useful elements are intertwined
with the protectable aesthetic elements?

easy cases are easy

Books and paintings and music are not
“useful articles.”

some cases are a little difficult

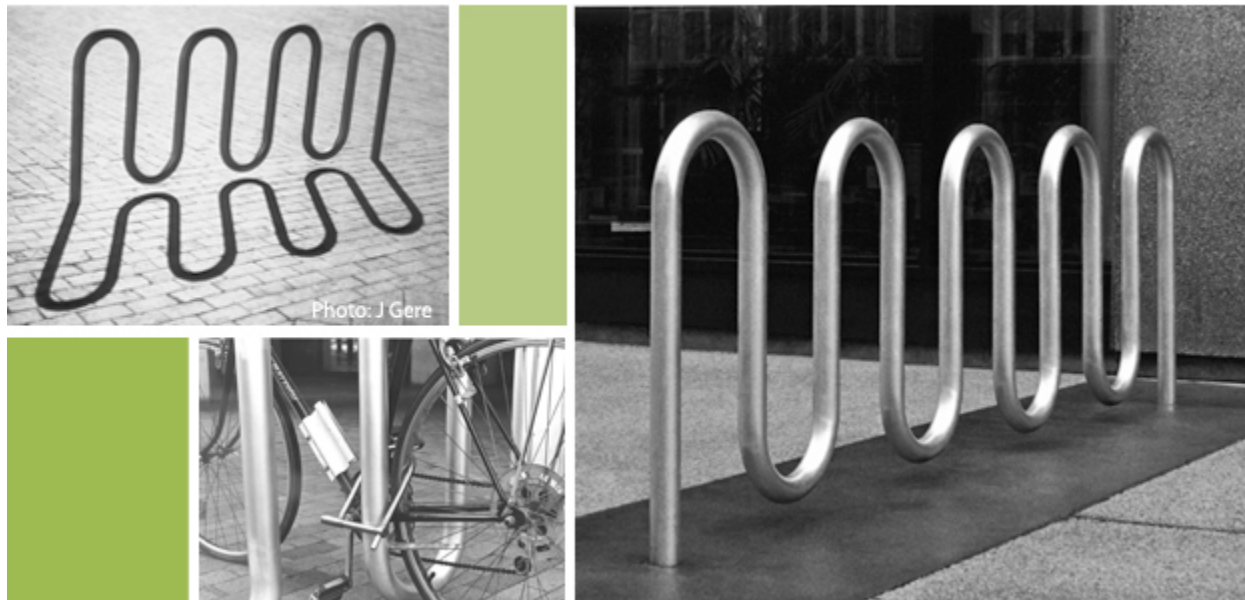


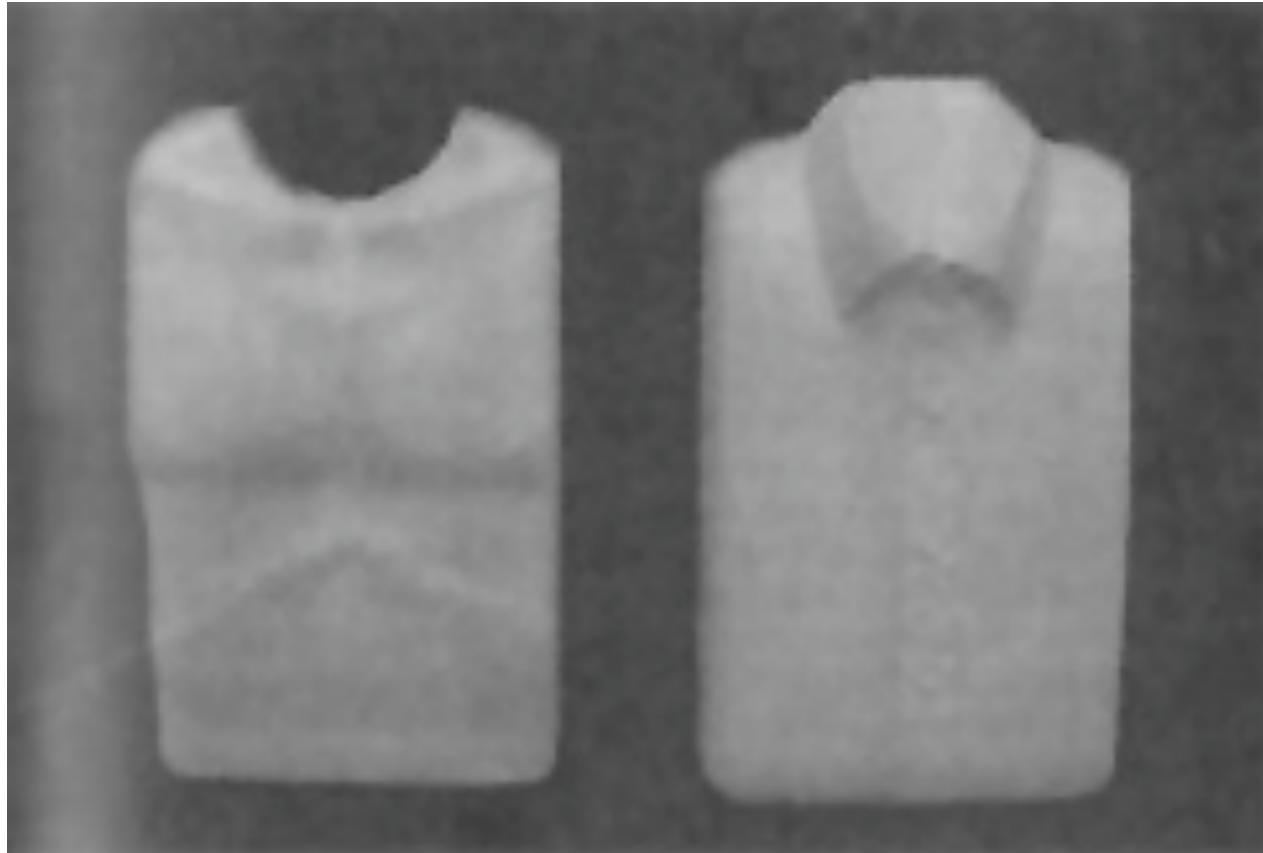
. . . but not that difficult

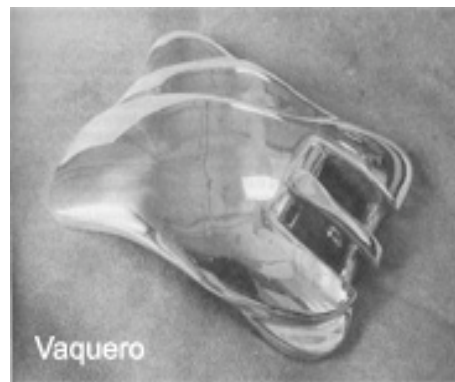
If the useful elements are physically separable from the aesthetic elements, the useful parts are not protectable by copyright but the aesthetic elements are.

Mickey, yes. Telephone, no.

the hard cases are really hard



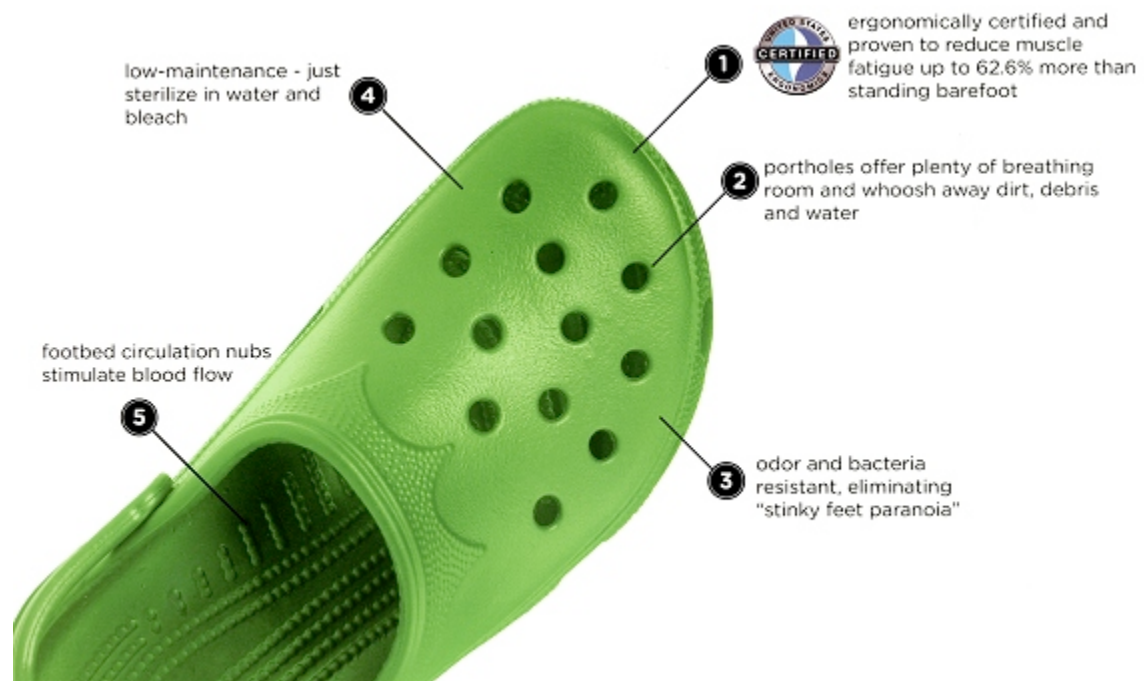




Vaquero



Winchester





“conceptual separability”

Congress has indicated that the aesthetic elements of useful articles should be protected if they are *physically* separable (easy) OR *conceptually* separable. Not so easy.

lots of tests; lots of problems with the tests

- not responsive to reasons for/policy behind the useful article doctrine
- subject to post hoc manipulation by parties (e.g., “I meant to design a beautiful object.”)
- allow or require artistic judgments by courts (e.g., “is this art?”)
- unpredictable

The solution

Borrow trademark's “functionality” doctrine:

Functional aspects of a product design may not receive trademark protection.

TrafFix v. MDI



Trademark's functionality doctrine

- Proponent bears (heavy) burden of proving non-functionality
- Must demonstrate that product feature it seeks to protect is (1) not essential to the use or purpose of the item AND (2) that it does not affect the cost or quality of the item.

Copyright's new useful article doctrine

In the difficult cases, the proponent bears the heavy burden of proving that the elements it seeks to protect with copyright are not useful in that they:

(1) are not essential to the use or purpose of the item; AND

(2) do not affect the cost or quality of the item.

improvement over all of the existing tests

- responds to the goals/policies of the useful article doctrine
- does not allow for manipulation by the parties
- does not require courts to make artistic judgments
- more predictable

downsides/problems

- more predictable because copyright owners will lose much more often . . .
- but the Court said this was ok in the trademark context . . .
- but are there differences between copyright and trademark that alter calculus?