

Copyright & Trademark: Design Law Fundamentals

Prof. Andrew Gilden

Willamette University College of Law

Applied Art (Copyright) v Industrial Design (Design Patent)



Copyright: Design of “Useful Articles”

Copyright Act, Section 101.

“[T]he design of a useful article ... 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....

Star Athletica v. Varsity Brands (2017)



- (1) Pictorial, graphic, or sculptural feature can be perceived separate from the useful article; AND
- (2) Would qualify as protectable PGS work either on its own or in some other medium if imagined separately

“Correlates to the contours of the article on which it is applied”



Silvertop Associates Inc. v. Kangaroo Manufacturing Inc. (3d Cir. 2019)



- Step 1: Useful article?
 - “[A] costume may serve, aside from its appearance, to clothe the wearer”
- Step 2: Sculptural features identifiable separate from utilitarian features?
 - “Those sculptural features include the banana’s combination of colors, lines, shape, and length. They do not include the cutout holes for the wearer’s arms, legs, and face; the holes’ dimensions; or the holes’ locations on the costume, because those features are utilitarian.”
- Step 3: Imagine separately as protectable work?
 - “[O]ne can still imagine the banana apart from the costume as an original sculpture.”

Trademark Law:
Designs must be Distinctive and Non-Functional



Trademark: Distinctiveness

Wal-Mart Stores v. Samara Bros. (2000)



- “Design . . . is not inherently distinctive.”
- “Almost invariably, even the most unusual of product designs . . . is intended not to identify the source, but to render the product itself more useful or more appealing.”
- [The purpose of] word marks and product packaging . . . is most often to identify the source of the product.”

Trademark: Functionality

- *Qualitex*:

- “This Court consequently has explained that, ‘[i]n general terms, a product feature is functional,’ and cannot serve as a trademark, ‘if it is **essential to the use or purpose of the article** or if it **affects the cost or quality** of the article,’ that is, if exclusive use of the feature would put competitors at a **significant non-reputation-related disadvantage.**” (citing *Inwood*)

- *TrafFix v. MDI*:

- In cases of aesthetic functionality, “it is proper to inquire into a ‘significant non-reputation-related disadvantage’”

