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## Copyright Protection: A Dead Fish for Sculptors of Taxidermy Mannequins?

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# **COPYRIGHT PROTECTION: A DEAD FISH FOR SCULPTORS OF TAXIDERMY MANNEQUINS?**

## **INTRODUCTION**

The Copyright Act of 1976 protects the property rights of creators of “pictorial, graphic, and sculptural works.”<sup>1</sup> In recent years two cases have presented the federal courts with the issue of whether sculptors of taxidermy mannequins are entitled to protection for their creations under this statute. The question first arose before a United States district court in Virginia in *Superior Form Builders v. Dan Chase Taxidermy Supply Co.*<sup>2</sup> The court held that the mannequins were properly copyrightable as sculptural works, a decision which was affirmed on appeal.<sup>3</sup>

In the second case, *Hart v. Dan Chase Taxidermy Supply Co.*, a New York district court held that while full-body animal mannequins and head and shoulder mannequins were copyrightable, certain fish mannequins were barred from receiving copyright protection by the merger doctrine.<sup>4</sup> On appeal, the circuit court vacated and remanded the case, instructing the trial court not to consider the merger issue until it first heard evidence about whether the competitor’s mannequins were substantially similar to those already copyrighted.<sup>5</sup> The trial court, following the direc-

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<sup>1</sup> Copyright Act of 1976, 17 U.S.C. § 102(a)(5) (1994).

<sup>2</sup> *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 851 F. Supp. 222, 31 U.S.P.Q.2d (BNA) 1216 (E.D. Va. 1994). The mannequins at issue were two raccoons, a deer, and an otter.

<sup>3</sup> *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 37 U.S.P.Q.2d (BNA) 1571 (4th Cir. 1996).

<sup>4</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 884 F. Supp. 71, 35 U.S.P.Q.2d (BNA) 1846 (N.D.N.Y. 1995), *vacated*, 86 F.3d 320, 39 U.S.P.Q.2d (BNA) 1310 (2d Cir. 1996). Specifically, the protected mannequins included: a standing bear, leopard, female mountain lion, sheep, bobcat, coyote, buffalo/bison, black bear, woodchuck, raccoon, badger, elk, leaping deer, moose head, sheep head, deer head “sneak” position, deer head turning left, deer head turning toward shoulder, long-horn steer head, pronghorn antelope, deer head downward, and deer head. The unprotected mannequins were three bass forms, two trout forms, a crappie/perch form, and two bream/bluegill/sunfish forms. 884 F. Supp. at 76-77.

<sup>5</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 39 U.S.P.Q.2d (BNA) 1310 (2d Cir. 1996).

tions of the court of appeals on remand, still found that the fish mannequins were not entitled to copyright protection.<sup>6</sup> In both cases, the plaintiff alleged that the defendant was using plaintiff's mannequins to create its own forms.

In reaching their decisions, the courts which decided the *Superior Form Builders* and *Hart* cases dealt with three issues bearing on the ability to copyright taxidermy mannequins: originality, useful articles, and the merger doctrine. This Note first examines these three copyright issues and concludes that taxidermy mannequins are properly copyrightable. Assuming that copyright protection could be denied, however, another potential avenue of intellectual property protection for taxidermy mannequins, namely, design patents, will be analyzed.

## I. COPYRIGHT PROTECTION

### A. THE REQUIREMENT OF ORIGINALITY

Along with the quality of being fixed in a tangible medium of expression, originality is one of the two fundamental qualities an item must exhibit in order to receive copyright protection.<sup>7</sup> In fact, the United States Supreme Court has held that originality is not only a requirement of the Copyright Act but is a constitutionally mandated requirement.<sup>8</sup> At this point, one should note that the creativity required by copyright law is entirely distinct from

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<sup>6</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 967 F. Supp. 70, 44 U.S.P.Q.2d (BNA) 1214 (N.D.N.Y. 1997), *aff'd*, 152 F.3d 918, (2d Cir. 1998 (full opinion available at 1998 WL 398812)).

<sup>7</sup> 17 U.S.C. § 102 (1994).

<sup>8</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346, 18 U.S.P.Q.2d (BNA) 1275, 1277 (1991):

The source of Congress' power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution, which authorizes Congress to "secur[e] for limited Times to Authors . . . the exclusive right to their respective Writings." . . . [T]his Court defined the crucial terms "authors" and "writings." In so doing, the Court made it unmistakably clear that these terms presuppose a degree of originality.

(citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); *The Trade Mark Cases*, 100 U.S. 82 (1879)).

novelty, which is required to obtain a patent.<sup>9</sup> What does originality mean for purposes of copyright law? Courts have construed the word to have two distinct meanings.<sup>10</sup>

The first definition of the originality requirement simply requires that a work be independently created by the author, rather than copied from other works.<sup>11</sup> This element focuses on the actual creation of the work. For example, in *Hart*, originality was satisfied by the formation process because the sculptor independently created details in the mannequin such as gesture, pose, muscle structure, and skin wrinkles.<sup>12</sup>

The second meaning of originality looks at a work's inherent qualities and more specifically, what that work embodies in terms of original thought. This note will refer to the second element of originality as "substantive originality" because it focuses on the quality of a work rather than the process of its creation. Substantive originality has been subject to two dominant formulations.<sup>13</sup>

One formulation is the "modicum of creativity" test, which requires that a work exhibit at least some minimal degree of creativity.<sup>14</sup> Although this formulation may sound like the initial definition given for originality, it is distinct in that it focuses on the

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<sup>9</sup> MELVILLE B. NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHT § 2.01[A] (1998) ("Because originality is easier to establish than novelty, it follows that a copyright is less vulnerable to an attack on its validity than is a patent. Conversely, however, the scope of a copyright owner's protection is considerably more limited than that of a patent owner.").

<sup>10</sup> Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801, 805-06 (1993). An interesting note is that the phrase "original works of authorship" was intentionally left undefined in order to incorporate the standards which had developed in the common law. Notes of Committee on the Judiciary, H.R. REP. NO. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659.

<sup>11</sup> *Feist Publications, Inc.*, 499 U.S. at 345. There only appears to be one exception to this requirement. In the so-called "Hand of God" case, *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265, 123 U.S.P.Q. (BNA) 487 (S.D.N.Y. 1959), an exact scale artistic reproduction of a highly complicated statue made with great precision was deemed original as requiring "great skill and originality." *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 n.3, 189 U.S.P.Q. (BNA) 753, 756 n.3 (2d Cir. 1976).

<sup>12</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 884 F. Supp. 71, 77 (N.D.N.Y. 1995).

<sup>13</sup> VerSteeg, *supra* note 10, at 807.

<sup>14</sup> *Feist Publications, Inc.*, 499 U.S. at 345 (citing MELVILLE B. NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHT § 2.01[A]-[B] (1990)). The rules of the Copyright Office do not require a creativity element; the element has been entirely judicially created. Mitzi S. Phalen, Comment, *How Much is Enough? The Search for a Standard of Creativity in Works of Authorship Under Section 102(a) of the Copyright Act of 1976*, 68 NEB. L. REV. 835, 837 (1989).

inherent quality of the work itself, without consideration of the creator's efforts. While the first definition of originality would require that the creator actually exert a sufficient degree of creativity, the modicum of creativity test simply looks at whether a sufficient degree of creativity inheres from an objective standpoint in the work itself.

In *Feist Publications, Inc. v. Rural Telephone Service Co.*, the Court applied this standard and stated that "[t]here remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent."<sup>15</sup> At issue in *Feist* were rival telephone directories. The plaintiff, a telephone utility company, alleged that it was entitled to copyright protection for the list of names and numbers which comprised the directory and that the defendant had infringed these rights by publishing a similar directory. The Court denied copyright protection to the telephone directories at issue in that case, describing the works as mechanical, garden-variety, and typical.<sup>16</sup> Although the works in *Feist* failed the modicum of creativity test, by definition the test generally provides a low threshold<sup>17</sup> and in most cases will probably not bar copyright protection.

The second major formulation of substantive originality can be categorized as the "trivial/distinguishable variation" test. Under this standard, a work must exhibit a distinguishable variation, meaning that the author's contribution must be something which is not merely trivial—something recognizably his own.<sup>18</sup> This test recognizes that even a copy of something in the public domain will support a copyright if it is a distinguishable variation.<sup>19</sup> Like the modicum of creativity test, the threshold for copyright protection under this test is seemingly fairly low.<sup>20</sup>

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<sup>15</sup> *Feist Publications, Inc.*, 499 U.S. at 359.

<sup>16</sup> *Id.* at 362.

<sup>17</sup> The word modicum is defined as "a small portion" or "a limited quantity or amount." WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1452 (1966).

<sup>18</sup> *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03, 90 U.S.P.Q. (BNA) 153, 155-56 (2d Cir. 1951).

<sup>19</sup> *Kamar Int'l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1061, 216 U.S.P.Q. (BNA) 376, 378 (9th Cir. 1981).

<sup>20</sup> See, e.g., *id.* (holding that copyright protection was available to toy stuffed animals due to toy producer's variation of matter already in public domain); *C & F Enters., Inc. v. Barringtons, Inc.*, 43 U.S.P.Q.2d (BNA) 1607 (E.D. Va. 1997) (holding that needlepoint adaptations of existing works satisfied the originality requirement by simply translating the works into a different medium). But see *Entertainment Research Group, Inc. v. Genesis*

Any difference between the modicum of creativity test and the trivial/distinguishable variation standard appears to be slight. The modicum of creativity test is a quantitative standard—a court will look at the amount of creativity which exists in a work for which copyright protection is sought and make a finding as to whether that amount is sufficient. In contrast, the trivial/distinguishable variation standard is a qualitative test. A court will look at whether the inherent features of a work represent a distinguishable variation from similar works already in existence. Whether or not this apparent difference between quantity and quality actually has any practical significance is debatable. The question whether a variation is distinguishable, like the inquiry into the amount which constitutes a modicum of creativity, is unclear; so courts seemingly have quite a bit of discretion in applying either standard. Since a bright line rule does not exist, analogy to existing case law is perhaps the only way to determine whether or not a work can satisfy the originality requirement.

Having established the bases and formulations of the originality requirement, the next question to be addressed is whether the mannequins at issue in *Superior Form Builders* and *Hart* satisfy that requirement. The district court in *Superior Form Builders* did not deal with the issue directly, but the court of appeals held that the mannequins were original works for purposes of the Copyright Act.<sup>21</sup> Although the court explicitly adopted the modicum of creativity test elaborated in *Feist*, its decision would likely be correct under either of the prevailing standards of substantive originality.

First, under the modicum of creativity test, the mannequins do indeed possess the requisite amount of artistry. The way in which the court described the process of creating the mannequins indicates that each mannequin was bestowed with a significant degree of creativity by the mannequins' sculptors:

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Creative Group, Inc., 122 F.3d 1211, 1223, 43 U.S.P.Q.2d (BNA) 1705, 1714 (9th Cir. 1997) (holding that three dimensional inflatable costumes based on two-dimensional cartoon characters represent only a trivial variation).

<sup>21</sup> *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 493, 37 U.S.P.Q.2d (BNA) 1571, 1575 (4th Cir. 1996).

Knight creates the mannequins, using casts of actual animal carcasses as models. He begins by applying clay to an armature made of wood and actual animal bones and shaping the desired animal in a particular pose and with precise anatomical features. From the clay sculpture, he makes a fiberglass mold and uses it to produce polyurethane forms, i.e. the animal mannequins. The mannequins contain special receptacles for artificial eyes, "ear butts" for the proper placement of animal ears, and pre-molded features for the application of artificial teeth.<sup>22</sup>

Recall that the threshold for protection under the modicum of creativity standard is quite low. Thus, the amount of creativity used by sculptors of taxidermy mannequins is more than sufficient to bring their creations within the scope of the Copyright Act.

The holding in *Superior Form Builders* also accords with the trivial/distinguishable variation standard. Even though a taxidermy mannequin may be limited to a certain degree by the natural features of the animal on which it is based, an animal sculpture, even if realistic, is copyrightable as long as the work represents the author's creative effort.<sup>23</sup> Moreover, the fact that a sculpture is based on the same live animal on which others are based does not prevent the sculptor from receiving copyright protection for his own efforts: "Several sculptors may copy a deer, even the same deer, in creating a sculpture, and each may obtain copyright protection for his or her own expression of the original."<sup>24</sup> The sculptors of taxidermy mannequins in *Superior Form Builders* exercised a sufficient degree of creativity by choosing the pose of the mannequin, including muscular and skin detail, thus contributing a distinguishable variation to the actual animal on which their works were based. Therefore, the decision of the court that the mannequins met the originality requirement would be proper under the trivial/distinguishable variation test.

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<sup>22</sup> *Id.* at 491.

<sup>23</sup> *Kamar Int'l, Inc.*, 657 F.2d at 1061.

<sup>24</sup> *Superior Form Builders, Inc.*, 74 F.3d at 492 (citing *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 4 U.S.P.Q.2d (BNA) 1877 (9th Cir. 1987)).

None of the courts in *Hart* directly addressed the originality issue, because like in *Superior Form Builders*, it was not actually in controversy. The forms in *Hart* were similar to those in *Superior Form Builders*, however, so the reasoning of the Fourth Circuit would apply, and these mannequins would also satisfy the originality requirement under either the modicum of creativity or trivial/distinguishable variation standards.

## B. USEFUL ARTICLES

The second issue bearing on the availability of copyright protection for taxidermy mannequins is whether the mannequins are useful articles. The Copyright Act clearly mandates that copyright protection extends only to expression in the copyrighted work and not to any facts or useful aspects of the work.<sup>25</sup> The statute 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."<sup>26</sup> Moreover, a work of authorship which is embodied in a useful article will only be given protection by the Copyright Act if "[the] 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."<sup>27</sup> The requirement of independence of utilitarian and aesthetic features has produced two legal doctrines: physical separability and conceptual separability.

The seminal case dealing with the physical separability of expression and utility is *Mazer v. Stein*.<sup>28</sup> In *Mazer*, the United States Supreme Court held that statuettes decorating the base of a lamp were entitled to copyright protection because the figures, otherwise copyrightable, could be physically removed leaving all functional aspects of the lamp unaffected.<sup>29</sup> The Court premised this result on the policies underlying the Copyright Act and on the historical practice of the Copyright Office of issuing copyrights for

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<sup>25</sup> Terrence J. Carroll, *Protection for Typeface Designs: A Copyright Proposal*, 10 SANTA CLARA COMPUTER & HIGH TECH. L.J. 139, 149 (1994).

<sup>26</sup> 17 U.S.C. § 101 (1994).

<sup>27</sup> *Id.*

<sup>28</sup> *Mazer v. Stein*, 347 U.S. 201, 100 U.S.P.Q. (BNA) 325 (1954).

<sup>29</sup> *Id.* at 212-13.



items like those in *Mazer*.<sup>30</sup> The concept of physical separability presents a fairly straightforward test for determining whether a work is a useful article outside the scope of Copyright Act protection. If the functional and artistic features cannot be tangibly separated, copyright protection will not ensue.

The second major (and more modern) standard that has been applied to useful article questions is conceptual separability. The language of the copyright statute does not distinguish between physical and conceptual separability, but Congress decided to respond to the *Mazer* decision by clarifying its intentions.<sup>31</sup> Congress explicitly annotated the statute by stating that copyright protection will be given to an item whose artistic elements, “*physically or conceptually*, can be identified as separable from the utilitarian aspects of that article.”<sup>32</sup>

One of the most important cases to apply the conceptual separability test is *Kieselstein-Cord v. Accessories by Pearl, Inc.*, which dealt with the availability of copyright protection for ornamental belt buckles.<sup>33</sup> The Second Circuit Court of Appeals held that the buckles had a separate ornamental use and that the utilitarian function was “subsidiary” to the primary ornamental aspect, thus the buckles were properly copyrightable.<sup>34</sup> Even though the aesthetic and functional features of the belt buckles were physically inseparable, the buckles could be copyrighted because these features could conceivably be distinguished.

Within the category of conceptual separability, several modern tests have developed to determine whether ornamental and utilitarian features can indeed be separated. Two of these tests derive from *Carol Barnhart Inc. v. Economy Cover Corp.*, a case involving mannequins of human torsos used to display clothing.<sup>35</sup> The design of these mannequins was distinctively different from the

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<sup>30</sup> *Id.* at 211-12.

<sup>31</sup> Gary S. Raskin, Comment, *Copyright Protection for Useful Articles: Can the Design of an Object be Conceptually Separated from the Object's Function?*, 33 SANTA CLARA L. REV. 171, 178-79 (1993).

<sup>32</sup> *Id.* at 179 (quoting H.R. REP. NO. 94-1476 (1976), reprinted in 1976 U.S.C.C.A.N. 5659).

<sup>33</sup> *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 208 U.S.P.Q. (BNA) 1 (2d Cir. 1980).

<sup>34</sup> *Id.* at 993.

<sup>35</sup> *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 228 U.S.P.Q. (BNA) 385 (2d Cir. 1985).

traditional full-figured mannequins that were used at the time. The difficult issue in the case was that the design itself was the object for which copyright protection was being sought.<sup>36</sup> The court held that copyright protection was not available to the mannequins based on the useful articles doctrine.<sup>37</sup>

The court distinguished *Kieselstein-Cord* because in that case, the ornamental surfaces of the belt buckles were in no way required by their utilitarian functions, whereas the design of the mannequins in *Carol Barnhart* was entirely dictated by utility.<sup>38</sup> The fact that led the court to deny copyright protection for the mannequins was that the utilitarian and artistic aspects of the mannequins were “inextricably intertwined.”<sup>39</sup> The court suggested that perhaps a more appropriate line of protection for the mannequins’ sculptor to pursue would have been to obtain a design patent, an alternative form of protection which will be dealt with in detail later.

In dissent, Judge Newman proposed a “displacement test.” He asserted that the artistic features of a useful article are separable when the article stimulates in the ordinary observer a concept that is independent from the article’s utilitarian concept.<sup>40</sup> Thus, Judge Newman’s test is an entirely objective one, relying on the reaction of an ordinary observer to the work for which copyright protection is sought. According to Judge Newman, use of an ordinary observer standard is consistent with standards in other

<sup>36</sup> Raskin, *supra* note 31, at 189.

<sup>37</sup> *Carol Barnhart Inc.*, 773 F.2d at 418.

<sup>38</sup> The features of the mannequins were dictated solely by the utilitarian purpose of displaying clothing. *Id.* at 419.

<sup>39</sup> *Id.*

<sup>40</sup> Judge Newman provided the example of an artistically designed chair displayed in a museum:

The ordinary observer can be expected to apprehend the design of a chair whenever the object is viewed. He may, in addition, entertain the concept of a work of art, but, if this second concept is engendered in the observer’s mind simultaneously with the concept of the article’s utilitarian function, the requisite “separateness” does not exist. The test is not whether the observer fails to recognize the object as a chair but only whether the concept of the utilitarian function can be displaced in the mind by some other concept.

*Id.* at 422 (Newman, J. dissenting). In the case of taxidermy mannequins, however, the ordinary observer would probably fail to recognize the underlying mannequin and would see only the aesthetic elements of the animal, because most people probably do not have an understanding of exactly how the taxidermy process works.

areas of copyright law, such as “whether an allegedly infringing work bears a substantial similarity to a copyrighted work.”<sup>41</sup> Applying his standard to the mannequins in *Carol Barnhart*, Judge Newman argued:

[A reasonable observer of the mannequins] would be most unlikely even to entertain, from visual inspection alone, the concept of a mannequin with the utilitarian function of displaying a shirt or a blouse. The initial concept in the observer's mind, I believe, would be of an art object, an entirely understandable mental impression based on previous viewing of unclad torsos displayed as artistic sculptures.<sup>42</sup>

Thus, according to Judge Newman, the experience of the ordinary observer in viewing human torsos as art would qualify the mannequins for copyright protection.

Another standard has been proposed by Professor Nimmer. Nimmer argues that “conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.”<sup>43</sup> Nimmer's standard is like that proposed by Judge Newman in that it is largely objective, relying on whether a certain portion of the community would find a work marketable based exclusively on aesthetic features. Applying Nimmer's test to the articles at issue in *Carol Barnhart*, the question would be whether the torso mannequins would be marketable if they possessed no usefulness for the display of clothing. Because the mannequins are probably not marketable solely for their aesthetic qualities, they would be denied copyright protection under Nimmer's test. Nimmer points out, however, that his standard suffers from three primary weaknesses: it may tend to favor more conventional forms of art, may be difficult to prove, and may be too restrictive of copyright

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<sup>41</sup> *Carol Barnhart Inc.*, 773 F.2d at 422.

<sup>42</sup> *Id.* at 424.

<sup>43</sup> NIMMER & NIMMER, *supra* note 9, § 2.08[B][3]. Nimmer's test for conceptual separability is very similar to the matter of concern doctrine, which will be discussed later under the topic of design patents.

protection.<sup>44</sup>

The test for conceptual separability which has perhaps received the most attention in the federal courts is that initially proposed by Professor Denicola. The Denicola test inquires which aspects of the work are dictated by the functional constraints of the article and which aspects reflect the unconstrained perspective of the artist.<sup>45</sup> Denicola's standard was adopted by the court in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, which stated the test as follows: "[W]here design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists."<sup>46</sup> Thus, the Denicola test focuses on the relationship between the final work and the process by which it came to fruition, with emphasis on the exercise of discretion by the designer.<sup>47</sup>

*Brandir International* involved the issue of whether copyright protection was available for the design of a bicycle rack. The manufacturer of the racks argued that the design stemmed from wire sculptures that he had created as a means of personal expression.<sup>48</sup> The court rejected this argument, holding that although these original sculptures may have been copyrightable, the final product was not, because its function could not be distinguished from any artistic expression which the racks embodied.<sup>49</sup> In other words, by looking at the finished product, the court could not identify any artistic quality of the design that existed separately from function.

With the foregoing principles relating to useful articles as a basis for discussion, this Note now turns to the question of how the useful article issue was dealt with in the taxidermy mannequin cases. In *Superior Form Builders*, the district court did not utilize any of the common law tests relating to useful articles. Instead, the court looked solely at the language of the Copyright Act,

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<sup>44</sup> *Id.*

<sup>45</sup> Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 742 (1983).

<sup>46</sup> *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145, 5 U.S.P.Q.2d (BNA) 1089, 1092 (2d Cir. 1987).

<sup>47</sup> Raskin, *supra* note 31, at 193.

<sup>48</sup> *Brandir Int'l, Inc.*, 834 F.2d at 1146.

<sup>49</sup> *Id.* at 1147.

reasoning that since the usefulness of the taxidermy forms was their portrayal of the appearance of animals, the forms by definition were not useful articles.<sup>50</sup> On appeal, the issue was addressed in more detail. The circuit court explicitly followed the Denicola test as set out in *Brandir International* to reach the conclusion that the artistic elements of the mannequins were conceptually separable from their function.<sup>51</sup>

In *Hart*, the district court also utilized the Denicola test and concluded that the artistic and functional elements of the mannequins were separable and rejected the argument that copyright protection should be denied on useful article grounds.<sup>52</sup> On appeal, the court did not deal with the issue of separability but found that the mannequins were copyrightable based on reasoning similar to that used by the district court in *Superior Form Builders*.<sup>53</sup> Specifically, the court concluded that "the function of the . . . form is to portray its own appearance, and that fact is enough to bring it within the scope of the Copyright Act."<sup>54</sup>

Both *Hart* and *Superior Form Builders* distinguished the taxidermy mannequins from the human mannequins at issue in *Carol Barnhart*. In *Hart*, the defendant, Dan Chase Taxidermy Supply, based its useful article argument on *Carol Barnhart*. Chase argued that the fish mannequins at issue in *Hart* served the same purpose as the mannequins in *Carol Barnhart* and that in both cases, "the 'display' function dictates the shape of the mannequin."<sup>55</sup> The court distinguished the two cases, however, stating that while the torsos in *Carol Barnhart* were "little more than

<sup>50</sup> *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 851 F. Supp. 222, 223, 31 U.S.P.Q.2d (BNA) 1216, 1217 (E.D. Va. 1994). Useful articles under the Copyright Act are those having a utilitarian function that is "not merely to portray the appearance of the article. . . ." 17 U.S.C. § 101 (1994). See also *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 15 U.S.P.Q.2d (BNA) 1881 (3d Cir. 1990) (finding that a nose mask for people based on the appearance of an animal was copyrightable because its sole function was to portray the appearance of the article).

<sup>51</sup> *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 494, 37 U.S.P.Q.2d (BNA) 1571, 1575 (4th Cir. 1996).

<sup>52</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 884 F. Supp. 71, 74, 35 U.S.P.Q.2d (BNA) 1846, 1849 (N.D.N.Y. 1995), *vacated*, 86 F.3d 320, 39 U.S.P.Q.2d (BNA) 1310 (2d Cir. 1996).

<sup>53</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 323, 39 U.S.P.Q.2d (BNA) 1310, 1312 (2d Cir. 1996).

<sup>54</sup> *Id.*

<sup>55</sup> *Id.*

glorified coat-racks used to display clothing in stores," the "shape, volume, and movement of the animal" in *Hart* were "depicted by the underlying mannequin."<sup>56</sup> Thus, the court apparently recognized a significant amount of artistic expression in the taxidermy mannequins beyond any functional considerations, an acknowledgement which the *Carol Barnhart* majority was unwilling to make. Alternately stated, in terms of the standard used by the majority in *Carol Barnhart*, the aesthetic and utilitarian elements of the taxidermy forms were not inextricably intertwined.

In *Superior Form Builders*, *Carol Barnhart* was distinguished in a similar manner. The court reasoned that the utilitarian aspects of taxidermy mannequins exist only to represent the appearance of the animal, whereas the utility of the human mannequins in *Carol Barnhart* bore no relation to the appearance of the mannequin itself but was instead solely concerned with the display of clothing.<sup>57</sup> The issue may have been more complex had it been decided under Judge Newman's objective standard. Under Newman's test, the outcome would depend on whether the taxidermy mannequins stimulated a concept other than utility in an ordinary observer.<sup>58</sup> Specifically stated, the question would be whether an ordinary observer could mentally displace the utility of the taxidermy forms with some other concept relative to aesthetic quality. The taxidermy mannequins would likely pass this test, because an ordinary observer would either only recognize the nature of the portrayal of the animal (invoking the definition of the Copyright Act) or be able to distinguish that portrayal from the form's utility (satisfying conceptual separability). A possible outcome under the displacement test, however, could be that the forms would be seen as objects simply used to "stuff" animals with no other recognizable artistic qualities. If the displacement test were to become a majority rule, the question of whether taxidermy mannequins are useful articles could become muddled.

Nimmer's test could likewise make the issue more complicated. Recall that Nimmer's standard, also an objective one, asks whether

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<sup>56</sup> *Id.*

<sup>57</sup> *Superior Form Builders, Inc.*, 74 F.3d at 493-94.

<sup>58</sup> *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J. dissenting).

the item in question would be marketable to some segment of the community based on its non-utilitarian features.<sup>59</sup> The question thus becomes whether the taxidermy forms would be marketable if they were useless for mounting animal skins. This question could very well be answered in the negative. The taxidermy forms are simply skeletal structures made from wood, clay, and bone, and their aesthetic features may not sufficiently support their marketability. Such a finding would accord with Nimmer's own critique of his standard that it favors more conventional forms of art.<sup>60</sup> Because of such weaknesses, Nimmer's test will likely not obtain the frequency of usage that the Denicola test has obtained.

Sculptors of taxidermy forms can probably survive useful articles challenges for the moment, since the Denicola test (perhaps the most liberal of the conceptual separability tests) continues to be the most frequently applied standard. However, these sculptors still must circumvent a third possible obstacle to copyright protection: the merger doctrine.

### C. THE MERGER DOCTRINE

The third and final issue bearing on the availability of copyright protection for taxidermy mannequins is the merger doctrine. The merger doctrine holds that an "expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself."<sup>61</sup> In other words, when there are only a few ways of expressing an idea, the expression merges with the idea, making the expression non-copyrightable. This common law doctrine is intended to effectuate the mandate of the Copyright Act that copyright protection shall not extend to any idea.<sup>62</sup> In this way, the merger doctrine "prevent[s] an author from monopo-

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<sup>59</sup> NIMMER & NIMMER, *supra* note 9, § 2.08[B](3).

<sup>60</sup> *Supra* note 43 and accompanying text.

<sup>61</sup> *Kregos v. Associated Press*, 937 F.2d 700, 705, 19 U.S.P.Q.2d (BNA) 1161, 1164 (2d Cir. 1991).

<sup>62</sup> 17 U.S.C. § 102(b) (1994).

lizing an idea merely by copyrighting a few expressions of it.”<sup>63</sup>

Before looking at the substantive standards of the merger doctrine, a preliminary procedural issue must be examined. At what point during trial should the merger doctrine be considered? The courts have not reached a consensus as to when the merger doctrine should be applied during the course of copyright litigation. Some courts consider the merger doctrine as a defense to the infringement claim, while others treat merger as a fundamental matter bearing on whether the work is copyrightable at all.<sup>64</sup> Nimmer’s treatise regards application of the merger doctrine in the infringement defense context as the better view.<sup>65</sup>

The courts that decided the *Hart* case struggled with the choice of which standard to apply. The district court initially dealt with merger in the context of copyrightability.<sup>66</sup> However, the court of appeals vacated this decision and instructed the district court on remand to consider the merger doctrine as a defense to infringement.<sup>67</sup> The rationale for this decision will be discussed later.

Turning to the substance of the merger doctrine, no bright line rule seems to exist instructing how many forms of expression are enough to avoid a finding of merger between expression and idea. Thus, one must attempt to glean a standard from the case law. One of the more important cases which recently applied the merger doctrine is *Kregos v. Associated Press*. *Kregos* involved a baseball pitching form in which the author selected nine criteria for evaluating pitching performances.<sup>68</sup> The court applied the merger

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<sup>63</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 884 F. Supp. 71, 76, 35 U.S.P.Q.2d (BNA) 1846, 1850 (N.D.N.Y. 1995), *vacated*, 86 F.3d 320, 39 U.S.P.Q.2d (BNA) 1310 (2d Cir. 1996) (quoting *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1212, 229 U.S.P.Q. (BNA) 282, 284 (8th Cir. 1986)).

<sup>64</sup> *Hart*, 884 F. Supp. at 76.

<sup>65</sup> MELVILLE B. NIMMER & DAVID NIMMER, 4 NIMMER ON COPYRIGHT § 13.03[B][3] (1997) (arguing that “the inseparability of idea and expression [should be viewed] in the context of a particular dispute, rather than attempting to disqualify certain expressions from protection *per se*”).

<sup>66</sup> *Hart*, 884 F. Supp. at 76.

<sup>67</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 322-23, 39 U.S.P.Q.2d (BNA) 1310, 1312 (2d Cir. 1996).

<sup>68</sup> *Kregos v. Associated Press*, 937 F.2d 700, 702, 19 U.S.P.Q.2d (BNA) 1161, 1162 (2d Cir. 1991) (“The first category in *Kregos*’ 1983 form, performance during the entire season, comprises two items—won/lost record (1) and earned run average (2). The second category, performance during the entire season against the opposing team at the site of the game



doctrine in the context of infringement<sup>69</sup> and held that the pitching forms were protected and were not subject to the doctrine of merger.<sup>70</sup> The test to which the *Kregos* court put the pitching forms was stated as follows: “[I]f the idea is formulated at a level of abstraction above the particular selection of facts the compiler has made, then merger of idea and expression is not automatic.”<sup>71</sup> The court further refined this standard, stating, “[a]s long as selections of facts involve matters of taste and personal opinion, there is no serious risk that withholding the merger doctrine will extend protection to an idea.”<sup>72</sup> Because *Kregos* exercised a significant amount of discretion in choosing his nine specific criteria out of the vast number of possible statistics that could be used to evaluate pitchers, his work was protected. An important policy endorsed by the court in *Kregos* was that the merger doctrine should be applied with caution.<sup>73</sup>

In *Mason v. Montgomery Data, Inc.*, the court explicitly adopted a more policy-oriented approach, stating that the guiding consideration in drawing the line between idea and expression should be preservation of “the balance between competition and protection reflected in the patent and copyright laws.”<sup>74</sup> The court stated that the first step in the merger analysis is identifying the idea and that application of the merger doctrine will often depend on how this idea is defined.<sup>75</sup> The works at issue in *Mason* were maps of real estate parcels made by overlaying realty information on top of

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comprises three items—won/lost record (3), innings pitched (4), and earned run average (5). The third category, performance in the last three starts, comprises four items—won/lost record (6), innings pitched (7), earned run average (8), and men on base average (9). This last item is the average total of hits and walks given up by a pitcher per nine innings of pitching.”).

<sup>69</sup> *Id.* at 705.

<sup>70</sup> *Id.* at 707.

<sup>71</sup> *Id.* at 706.

<sup>72</sup> *Id.* at 707.

<sup>73</sup> *Kregos v. Associated Press*, 937 F.2d 700, 705, 19 U.S.P.Q.2d (BNA) 1161, 1163 (2d Cir. 1991) (“Determining when the idea and its expression have merged is a task requiring considerable care: if the merger doctrine is applied too readily, arguably available alternative forms of expression will be precluded; if applied too sparingly, protection will be accorded to ideas.”).

<sup>74</sup> *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 140, 23 U.S.P.Q.2d (BNA) 1676, 1681 (5th Cir. 1992) (quoting *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742, 170 U.S.P.Q. (BNA) 557, 559 (9th Cir. 1971)).

<sup>75</sup> *Mason*, 967 F.2d at 140.

existing topographical maps published by the United States Geological Survey.<sup>76</sup> The court held that because different map-makers with the same idea could reach different conclusions by relying on different sources, merger did not occur:

Although Mason sought to depict the information accurately, the conflicts among the sources and the limitations inherent in the process of representing reality in pictorial map form required him to make choices that resulted in independent expression. Extending protection to that expression will not grant Mason a monopoly over the idea, because other mapmakers can express the same idea differently.<sup>77</sup>

This holding accords with the holding of *Kregos*, again recognizing the author's discretion as a key component in determining whether a work is copyrightable.

The United States Court of Appeals for the First Circuit applied the merger doctrine in the infringement context, based on a substantial similarity test, and held that in order to determine whether there are various forms of expression available to an idea the court must look at the similarities between existing expressions.<sup>78</sup> If existing expression of an idea does not demonstrate a sufficient degree of variety, copyright protection will be denied.<sup>79</sup> Like Judge Newman's objective test for useful articles, this inquiry is based on whether similarity would be recognized by the ordinary observer.<sup>80</sup>

In *Concrete Machinery Co. v. Classic Lawn Ornaments, Inc.*, the court applied this standard to concrete lawn ornaments. The court held that there was no merger of expression and idea because the

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<sup>76</sup> *Id.* at 136.

<sup>77</sup> *Id.* at 140.

<sup>78</sup> *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 607, 6 U.S.P.Q.2d (BNA) 1357, 1363 (1st Cir. 1988).

<sup>79</sup> *Id.*

<sup>80</sup> *Id.* In an infringement suit, the plaintiff must "demonstrate that the works are substantially similar in both *idea* and *expression*." *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1507, 4 U.S.P.Q.2d (BNA) 1877, 1881 (9th Cir. 1987) (quoting *Frybarger v. International Bus. Machs. Corp.*, 812 F.2d 525, 529, 2 U.S.P.Q.2d (BNA) 1135, 1137-38 (9th Cir. 1987)).

different statues introduced at trial contained "a considerable amount of detail, representing one of several ways of expressing each underlying concept."<sup>81</sup> Thus, because the forms of expression presented as evidence to the court were sufficient in variety, the merger doctrine did not apply.

Turning to the taxidermy mannequin cases, recall that the merger doctrine was only prohibitive of copyright protection with respect to the forms used to mount fish in *Hart*. The merger doctrine never arose in *Superior Form Builders* because that case only involved forms of mammals. Either the defendant in that case did not argue the merger doctrine as a reason for invalidating *Superior Form Builders*' copyright, or the court simply did not feel that the merger doctrine was sufficiently at issue to warrant discussion in the opinion.

In *Hart*, however, the district court's determination regarding the initial issue of copyrightability was that there was "no meaningful detail in the mannequins that is not commanded by the idea of a realistic fish."<sup>82</sup> The court stated that the mannequins were no more than the body of a fish and that because of their lack of detail, only a limited amount of expression was present.<sup>83</sup>

The court of appeals remanded the case to the trial court, instructing the court to deal with the merger issue in the infringe-

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<sup>81</sup> *Concrete Mach. Co.*, 843 F.2d at 609. The court provided the following analysis, which is useful in the context of taxidermy mannequins:

As an example in the case before us, appellant has a copyright in the design of concrete "life size deer." The idea behind this particular expression can be briefly described as a "realistic-looking concrete deer." Appellant cannot prohibit others from appropriating this idea; it can, however, prohibit any actual copying of its own version of a "realistic-looking concrete deer." Yet, it has a problem of proof: because the statue is a detailed replica of a real deer, the deer, in essence, supplied most of the features which any subsequent artist can also take from the real deer. To prove copying then, Concrete must show *substantial* similarity, between works, in those features over which it exercised discretion while portraying a "realistic-looking concrete deer." These features include such aspects as pose, posture, and facial expression.

843 F.2d at 607.

<sup>82</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 884 F. Supp. 71, 76, 35 U.S.P.Q.2d (BNA) 1846, 1850 (N.D.N.Y. 1995), *vacated*, 86 F.3d 320, 39 U.S.P.Q.2d (BNA) 1310 (2d Cir. 1996).

<sup>83</sup> *Hart*, 884 F. Supp. at 77.

ment context based on a substantial similarity standard.<sup>84</sup> The rationale for this decision was that a court will normally have a more detailed and realistic basis for evaluating the relationship between idea and expression if it has all forms of expression before it.<sup>85</sup> On remand, the district court followed the circuit court's instructions and held that substantial similarity between all fish forms before the court justified imposition of the merger doctrine.<sup>86</sup> Because of limitations in expression, idea and expression merged, barring copyright protection.

Summarizing the availability of copyright protection for taxidermy forms in light of the applicable legal standards, all varieties of taxidermy mannequins seem to satisfy the originality requirement of the Copyright Act. Further, arguments that the mannequins are useful articles not entitled to copyright protection will probably not succeed, as long as certain minority standards for determining useful article cases do not rise to prominence. However, the merger doctrine may deny protection to certain animal forms. For example, forms which are not susceptible to a sufficient variety of expression, such as the fish mannequins that were denied protection in *Hart*, will not receive protection because such an award would be viewed as protection of an idea rather than expression. If copyright protection is not afforded, however, other existing intellectual property guarantees may apply.

## II. ALTERNATIVE FORMS OF PROTECTION

Assuming that copyright protection for taxidermy forms is barred either under one of the tests for conceptual separability of useful

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<sup>84</sup> *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 322, 39 U.S.P.Q.2d (BNA) 1310, 1312 (2d Cir. 1996).

<sup>85</sup> *Id.*

<sup>86</sup> The court found that:

[T]he majority of the expressive details of the mounted fish depend on the size and shape of the fishes' skull, the color and consistency of the scales, and the fins and tail, none of which relate to the internal fish mount. Thus, the only arguable expressive choices for the carvers that are visibly manifested in any significant way in the finished fish is the cant or "swish" of the tail.

*Hart v. Dan Chase Taxidermy Supply Co.*, 967 F. Supp. 70, 72-73, 44 U.S.P.Q.2d (BNA) 1214, 1217 (N.D.N.Y. 1997).

articles or under the merger doctrine, the sculptors of these mannequins may still be able to obtain protection for their creations. The most likely form of such protection is a design patent.<sup>87</sup>

A design patent is one of three types of patents (the others being utility and plant patents) available to creators or inventors.<sup>88</sup> The issues that determine whether particular subject matter is appropriate for a design patent are: "(1) whether the features sought to be protected are ornamental, as opposed to merely utilitarian or functional; and (2) whether those features are applied to, or embodied in, an article of manufacture."<sup>89</sup>

Before analyzing these requirements, however, it is useful to examine the process by which patents are obtained from the United States Patent and Trademark Office in order to determine whether design patents are really a feasible alternative to copyright. The creator who wishes to patent his creation must apply for a patent through a process known as "patent office prosecution."<sup>90</sup> If a patent is granted, the patent represents "a contract between an inventor and the United States government under which the government grants the inventor a limited monopoly, . . . [and in return] the inventor discloses the complete invention to the public in order to promote . . . progress."<sup>91</sup>

The advantage of obtaining a patent over obtaining a copyright

<sup>87</sup> 35 U.S.C. § 171 (1994). Note that copyright and patent protection are not mutually exclusive. A creator of an item may obtain simultaneous patent and copyright protection. *In re Yardley*, 493 F.2d 1389, 1394, 181 U.S.P.Q. (BNA) 331, 334-35 (C.C.P.A. 1974). However, the judiciary has been reluctant to afford copyright protection to articles possessing features rising to the level of industrial design. Mark A. LoBello, *The Dichotomy Between Artistic Expression and Industrial Design: To Protect or Not to Protect*, 13 WHITTIER L. REV. 107, 110 (1992).

<sup>88</sup> A utility patent is available for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. . . ." 35 U.S.C. § 101 (1994). A design patent is available for "any new, original and ornamental design for an article of manufacture. . . ." 35 U.S.C. § 171.

<sup>89</sup> Lance L. Vietzke, Note, *Software as the Article of Manufacture in Design Patents for Icons*, 21 AIPLA Q.J. 138, 140 (1993).

<sup>90</sup> An application must be submitted to the Patent and Trademark Office with the appropriate fees for review by a Patent Examiner. Stephen A. Church, Note, *The Weakening of the Presumption of Validity for Design Patents: Continued Confusion under the Functionality and Matter of Concern Doctrines*, 30 IND. L. REV. 499, 502-03 (1997).

<sup>91</sup> *Id.* (quoting RONALD B. HILDRETH, PATENT LAW: A PRACTITIONER'S GUIDE 30, 31 (2d ed. 1993)).

is the breadth of protection received. A patent grants an absolute monopoly for a specified period of time, and once obtained it prevents any form of copying. Design patents are “generally viewed as providing stronger protection than copyrights for the same features.”<sup>92</sup> To the contrary, under copyright law, a distinguishable variation to an existing work is enough to avoid infringement liability.

Design patents present several disadvantages, however. In addition to the greater expense which must be incurred to obtain a patent, the requirements for obtaining the patent are also higher. Namely, the creator seeking a design patent will be subject to the more stringent requirements of novelty and nonobviousness.<sup>93</sup> As mentioned earlier, novelty is a concept distinct from the originality requirement of copyright law.<sup>94</sup> Novelty entails either an individual, newly developed feature or a combination of elements not found in prior works.<sup>95</sup> Thus, for an item to be novel, it must have “[a] ‘new and original’ effect.”<sup>96</sup>

While novelty is a fairly straightforward prerequisite of patentability, the issue of nonobviousness is considerably more complex. According to the statute governing design patents, a patent may not be issued for an item based on an existing work “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”<sup>97</sup> Nonobviousness is distinct from novelty in that even if a person creates something entirely new and unique, patent protection will not be available if the creation would have been

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<sup>92</sup> Vietzke, *supra* note 89, at 144.

<sup>93</sup> *Id.*

<sup>94</sup> NIMMER & NIMMER, *supra* note 9.

<sup>95</sup> Bush Indus., Inc. v. O’Sullivan Indus., Inc., 772 F. Supp. 1442, 1452, 21 U.S.P.Q.2d (BNA) 1561, 1568 (D. Del. 1991).

<sup>96</sup> Valley Shoe Corp. v. Tober-Saifer Shoe Co., 25 F. Supp. 860, 861, 40 U.S.P.Q. (BNA) 531, 532 (E.D. Mo. 1938) (quoting Sodemann Heat & Power Co. v. Kauffman, 275 F. 593, 597 (8th Cir. 1921)).

<sup>97</sup> 35 U.S.C. § 103 (1994); *see also* Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. (BNA) 459, 467 (1966) (“[T]he scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art [must be] resolved.”).

obvious to another. While the meaning of nonobviousness is an established principle of law, a split exists in the federal circuits about how the nonobviousness standard should be applied.

The former Court of Customs and Patent Appeals (now the Court of Federal Claims) posits the view that under the statute, it is only necessary to "determine obviousness to the ordinary intelligent man."<sup>98</sup> Other circuits have disregarded this interpretation and required that nonobviousness be measured from the perspective of a designer having ordinary skill in the art.<sup>99</sup> Lower courts have had difficulty ascertaining a distinction between the practical effect of the two standards, but the second approach seems to be favored because it more closely approximates the actual language of the patent statute.<sup>100</sup>

The second approach also seems to be more strict, however, and may bar patent protection in a greater number of cases. The designs for which patent protection is sought are often fairly complex. In those situations, the design will almost always be nonobvious to a lay person. On the contrary, any obviousness will be more readily apparent to one skilled in the relevant field because such a person will have knowledge about matters such as the feasibility of various designs. A broader standard such as that used by the Court of Federal Claims and the Ninth Circuit may better serve the goal of the design patent statute, which is to encourage ornamental design.<sup>101</sup>

As stated earlier, the primary issues in evaluating the availability of design patent protection are whether the features sought to be protected are ornamental, and whether they are embodied in an article of manufacture. The article of manufacture requirement is not controversial in most cases. An article of manufacture is

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<sup>98</sup> Application of Laverne, 356 F.2d 1003, 1006, 148 U.S.P.Q. (BNA) 674, 677 (C.C.P.A. 1966). This test has also been adopted by the Ninth Circuit in *Schwinn Bicycle Co. v. Goodyear Tire & Rubber Co.*, 444 F.2d 295, 168 U.S.P.Q. (BNA) 258 (9th Cir. 1970).

<sup>99</sup> *Sidewinder Marine, Inc. v. Starbuck Kustom Boats & Prods., Inc.*, 418 F. Supp. 224, 228, 193 U.S.P.Q. (BNA) 777, 780 (D. Colo. 1976), *aff'd*, 597 F.2d 201, 202 U.S.P.Q. (BNA) 356 (10th Cir. 1979).

<sup>100</sup> *Sidewinder Marine, Inc.*, 418 F. Supp. at 229 (comparing the language of the second standard with that of 35 U.S.C. § 103 (1994)).

<sup>101</sup> Application of Honeywell, Inc., 497 F.2d 1344, 1348, 181 U.S.P.Q. (BNA) 821, 824 (C.C.P.A. 1974).

simply "anything made by man from raw materials."<sup>102</sup> In the taxidermy cases, the article of manufacture requirement is satisfied, because each mannequin is sculpted by an individual using raw materials such as wood, clay and bone.

With respect to the ornamental requirement for design patents, the courts have developed two standards that a design patent must satisfy in order to be considered ornamental and hence valid: "(1) the design must meet the doctrine of functionality requirements and (2) the design must be a 'matter of concern.'"<sup>103</sup>

The functionality requirement is very similar to the conceptual separability requirement for useful articles in the copyright context. Because design patents are only issued for ornamental features, if a design also contains functional elements, it will be patentable only if it has an appearance distinct from that dictated solely by functional considerations.<sup>104</sup> Alternately stated, if the design is *primarily ornamental*, even though it also serves a utilitarian purpose, the requirement of ornamentation is met.<sup>105</sup> The primarily ornamental standard serves the function of promoting the decorative arts, one of the purposes of the patent statute,<sup>106</sup> by protecting those portions of an otherwise functional item which are the product of the creator's artistic expression.

How does one determine, however, whether certain features of a design are functional or ornamental? The design of a useful article is deemed functional when "the appearance of the claimed design is 'dictated by' the use or purpose of the article."<sup>107</sup> If there are several ways to achieve the same function, a presumption arises that the design in the patent claim serves a primarily ornamental

<sup>102</sup> Vietzke, *supra* note 89 (citing *In re Hruby*, 373 F.2d 997, 1000, 153 U.S.P.Q. (BNA) 61, 65 (C.C.P.A. 1967)).

<sup>103</sup> Church, *supra* note 90, at 506.

<sup>104</sup> 35 U.S.C. § 171 (1994). Note, however, that the issue of functionality must be raised as an affirmative defense to a claim of infringement and must be proved by the party asserting the defense. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123, 25 U.S.P.Q.2d (BNA) 1913, 1917 (Fed. Cir. 1993).

<sup>105</sup> *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1460, 43 U.S.P.Q.2d (BNA) 1887, 1890 (Fed. Cir. 1997). Note that the inquiry into whether the design is primarily ornamental is quite similar to the inquiry made by the court in *Kieselstein-Cord*, namely, whether the functional aspects were subsidiary to the ornamental features. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993, 208 U.S.P.Q. (BNA) 1, 3 (2d Cir. 1980).

<sup>106</sup> *Tyco Indus., Inc. v. Tiny Love, Ltd.*, 914 F. Supp. 1068, 1076 (D.N.J. 1996).

<sup>107</sup> *L.A. Gear, Inc.*, 988 F.2d at 1123.



purpose.<sup>108</sup> The apparent logic behind this presumption is that if a creator has a choice of ways to fulfill a function, his/her decision must be based on a desire to express a certain ornamental design.

An example of how the doctrine of functionality can invalidate a design patent is *G.B. Lewis Co. v. Gould Products Inc.*<sup>109</sup> That case involved a rectangular open-topped plastic storage box with the walls offset to facilitate stacking. The court held that there was nothing in the box's design which was not dictated by "pure functionality."<sup>110</sup> Based on the holding of the *G.B. Lewis* case, the standard for separating function from ornamentation in the field of design patents appears to be quite similar to that used for useful articles in the copyright context, although the patent standard seems to be more strict. In the copyright context, even if an item's appearance was entirely or primarily dictated by functional concerns, copyright protection could still be obtained if an ordinary observer could conceptually separate the ornamental and utilitarian features.<sup>111</sup> The patent test is more subjective, looking to the motive behind the design. One case has simply held that whether an item is primarily functional is a matter of "[c]ommon sense."<sup>112</sup>

The second issue bearing on whether a design is sufficiently ornamental to obtain a patent is the matter of concern doctrine. The matter of concern doctrine is an attempt to define exactly when the appearance of an article of manufacture is ornamental.<sup>113</sup> The doctrine arose in *In re Koehring*, where the Court of Customs and Patent Appeals phrased the inquiry: "Is the ornamentation . . . a matter of concern to anybody, reasonably within the purview of

<sup>108</sup> *Tyco Indus., Inc.*, 914 F. Supp. at 1077.

<sup>109</sup> *G.B. Lewis Co. v. Gould Prods., Inc.*, 297 F. Supp. 690, 160 U.S.P.Q. (BNA) 311 (E.D.N.Y. 1968), *aff'd*, 436 F.2d 1176 (2d Cir. 1971). *See also* *A & H Mfg. Co. v. Contempo Card Co.*, 576 F. Supp. 894, 900, 221 U.S.P.Q. (BNA) 67, 71 (D.R.I. 1983) (holding that competitor's adaptation of plastic display cards used to hold jewelry in retail stores was not patentable, even though the prior versions were aesthetically unattractive, because the new configuration was primarily a response to problems of usage and thus the design was dictated by functional requirements).

<sup>110</sup> *G.B. Lewis Co.*, 297 F. Supp. at 695.

<sup>111</sup> *See* Part I.B.

<sup>112</sup> *Application of Carletti*, 328 F.2d 1020, 1021, 140 U.S.P.Q. (BNA) 653, 654 (C.C.P.A. 1964).

<sup>113</sup> *In re Koehring*, 37 F.2d 421, 423, 4 U.S.P.Q. (BNA) 169, 171 (C.C.P.A. 1930).

the act?"<sup>114</sup> The court stated the test in terms of "a matter of concern to anybody" to broaden the definition of what is ornamental, rejecting the prior approach that the requisite ornamentation for design patents was confined to the aesthetic or fine arts.<sup>115</sup>

An example of how the matter of concern doctrine operates is *Best Lock Corp. v. Ilco Unican Corp.*<sup>116</sup> At issue in that case were the design patents of blanks used to make keys. The court held that the design of these blanks was entirely determined by the need for lock control and maintenance of adequate security.<sup>117</sup> Moreover, the court found that the ornamental design of a key is not a matter of concern for any consumer, thus the patent was ruled invalid.<sup>118</sup> In other words, the ornamental features of a key would not be a factor in any person's decision whether to purchase that key.

In order for a design patent to be valid it must satisfy the requirements of both the functionality and matter of concern doctrines. Having established these bases for validity of a design patent, the next issue to be discussed is the standards that exist for determining infringement.

Infringement of a design patent is determined from the perspective of an ordinary observer, a standard introduced in *Gorham Co. v. White*, a landmark Supreme Court case dealing with the alleged infringement of a design patent for the handles of silverware.<sup>119</sup> The Court, applying this standard, held that an ordinary observer would indeed believe that the alleged infringer's design was the same as the patent holder's design, justifying a finding of infringement.<sup>120</sup> One author suggests the ordinary observer standard is preferable because it allows market value to be added to an article if manufacturers can use the appearance of a design to identify the source of goods.<sup>121</sup> In other words, a company can increase the

<sup>114</sup> *Id.*

<sup>115</sup> *Id.* at 422.

<sup>116</sup> *Best Lock Corp. v. Ilco Unican Corp.*, 896 F. Supp. 836, 36 U.S.P.Q.2d (BNA) 1527 (S.D. Ind. 1995), *aff'd*, 94 F.3d 1563, 40 U.S.P.Q.2d (BNA) 1048 (Fed. Cir. 1996).

<sup>117</sup> *Best Lock Corp.*, 896 F. Supp. at 843-44.

<sup>118</sup> *Id.*

<sup>119</sup> *Gorham Co. v. White*, 81 U.S. 511, 530 (1871).

<sup>120</sup> *Id.* at 531.

<sup>121</sup> In this sense, the protection is very much like that afforded by trademark law. Vietzke, *supra* note 89, at 143.

value of its product if it is given protection for a unique design that can readily be identified by consumers.

The ordinary observer test has been refined somewhat by the United States Court of Appeals for the Federal Circuit. That court has stated that “[f]or a design patent to be infringed, . . . no matter how similar two items look, ‘the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.’”<sup>122</sup> This standard for infringement is called the point of novelty approach. By formulating this approach, the Federal Circuit was merely trying to clarify what the Supreme Court had stated in *Gorham* by pointing out that “even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to . . . novelty.”<sup>123</sup> The court in *Litton Systems, Inc. v. Whirlpool Corp.* held that because the alleged infringer’s microwave oven did not possess certain features which made the patent-holder’s oven novel for the purposes of obtaining that patent, a finding of infringement was inappropriate.<sup>124</sup>

In a more recent case, however, the Federal Circuit has backed away from the point of novelty approach, holding that it is not really a distinctive standard for determining patent infringement.<sup>125</sup> The court stated that the determination of whether the accused device appropriates the novelty of the patented device is “irrelevant” and is a factor which would be considered anyway under the objective observer standard of *Gorham*.<sup>126</sup> Thus, the existence of the point of novelty approach as a standard distinct from the *Gorham* test may be in danger of extinction.

Having examined the basic requirements for the availability of patent protection and the standards for patent infringement, how would the taxidermy mannequin cases come out if the sculptors sought patent rather than copyright protection? In all likelihood,

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<sup>122</sup> *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444, 221 U.S.P.Q. (BNA) 97, 109 (Fed. Cir. 1984) (quoting *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396, 60 U.S.P.Q. (BNA) 434, 434-35 (8th Cir. 1944)).

<sup>123</sup> *Litton Sys., Inc.*, 728 F.2d at 1444.

<sup>124</sup> *Id.*

<sup>125</sup> *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 24 U.S.P.Q.2d (BNA) 1121 (Fed. Cir. 1992).

<sup>126</sup> *Id.* at 820 n.7.

the outcome would be the same. Recall that for a patent to issue, a design must be novel, meaning that it must contain elements of both newness and originality. Because each mannequin contains varied, distinct features with regard to muscle, skin and pose, the novelty requirement can probably be overcome. Further, because such discretion is exercised by the sculptor aside from functional concerns, the mannequins would likely be classified as ornamental for purposes of the patent statute. Finally, the aesthetic or design features of the taxidermy forms would be a matter of concern for a consumer, because appearance of the animal is *the* primary concern for consumers.

The greatest challenge to obtaining a design patent for taxidermy forms is the nonobviousness requirement. For a design to be patentable, it must be one that at the time of its creation was not obvious to a person with ordinary skill in the art. In the taxidermy mannequin cases, then, the question would be whether the particular design of a certain mannequin would be obvious to an ordinary sculptor of such mannequins. For example, would a sculptor of taxidermy forms find it obvious to create the form of a deer with its limbs and head in a certain position and its muscles flexed in a particular manner? The answer is not clear, and a court could deny patent protection on these grounds.

While sculptors of taxidermy mannequins do exercise discretion in choosing the form the animal will take, to a certain extent the realm of possible positions is finite. Thus, any form could be considered obvious. However, in any particular industry, the bounds of discretion will be limited by such considerations as feasibility and marketability. Because of this fact, courts should apply the nonobviousness requirement with greater deference to the patent-seeker. While the issue is certainly not conclusive, sculptors of taxidermy mannequins can likely fulfill the nonobviousness requirement and obtain patent protection for their designs.

### CONCLUSION

Although the issues may be closer than some of the opinions indicate, the cases dealing with the copyright protection of taxidermy mannequins have probably been properly decided. Those involved in the taxidermy industry must realize, however, that the

legal standards regarding the ability to copyright taxidermy mannequins are not truly settled. Different federal circuits apply different tests, which could have a significant bearing on the availability of protection. While the originality requirement can likely be uniformly met by sculptors of taxidermy forms, the same cannot be said with regard to the doctrines of useful articles and merger.

Whether the mannequins are categorized as useful articles may depend on whether they are subjected to an objective or subjective standard of conceptual separability. Under the objective test, the availability of copyright protection will depend on the ability of a reasonable person to distinguish between art and utility. However, this test itself contains an inherent degree of subjectivity, because the opinion of the so-called reasonable person often amounts to no more than the opinion of the court itself.

With regard to the merger doctrine, sculptors of taxidermy mannequins will have to acknowledge the limitations that the natural characteristics of animals place on them, and they may have to exercise an even greater deal of creativity in order to satisfy the substantial similarity test and avoid merger. This proposition is especially true for certain types of animals such as fish, where the available means of expression are necessarily more limited than they are for other animals.

If copyright protection does prove to be unattainable, sculptors may have to turn to alternate areas of intellectual property law to protect their creations. The most likely form of such protection is a design patent. Design patents apply to the ornamental qualities of manufactured articles. Taxidermy mannequins can fulfill both these requirements because they are manufactured from raw materials and are designed with distinct consideration of ornamentation rather than function. However, articles seeking design patent protection also must be novel and nonobvious. While the taxidermy mannequins can likely satisfy the novelty element, the nonobviousness requirement may prove more difficult to fulfill because of the finite number of choices a sculptor can make in designing a mannequin based on a real animal.

The design patent may not be a feasible alternative, however, for substantive reasons such as nonobviousness, and for practical reasons such as the greater cost and bureaucratic procedure of the

Patent and Trademark Office. Thus, copyright probably remains the best form of protection for sculptors of taxidermy mannequins. If so, sculptors should remain aware of the legal standards governing the availability of protection for their creations and should exercise as much creativity as possible in order to ensure that the requirements of the Copyright Act and its interpretive case law are fulfilled.

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