



ideas on intellectual property law

april/may 2005

in this issue

**Art and usefulness collide in
a mannequin copyright case**

**Likelihood of confusion
is confusing**

Trademark defendant can use protected mark

What is a “printed publication”?

Early slide presentations bar patent application



ROUTE TO

STURM
& FIX LLP

WASHINGTON, DC
DAVENPORT, IA
DES MOINES, IA
OMAHA, NE

Art and usefulness collide in a mannequin copyright case

Artistic creations are copyrightable, but useful articles aren't. Industrial objects are often designed to look beautiful but are protected by a design patent rather than a copyright. For example, you can't copyright an automobile as a sculptural work — no matter how artistically designed it is — because it's a useful article.

But some useful articles incorporate artistic touches that are entitled to copyright protection if they can be identified separately from — and are capable of existing independently of — the object's utilitarian aspects. Thus, a “flying lady” sculpture is entitled to copyright, even when used as a hood ornament attached to a Rolls-Royce automobile. But how do you draw the elusive line between a useful article and its artistic embellishments?

IT'S ALL IN YOUR HEAD

In a recent case, Leo Passage founded a company called Pivot Point, which develops and markets educational techniques and tools for the hair-design industry. In the mid-1980s, Passage wanted to develop a mannequin that would imitate the

look of high fashion runway models. He believed he could market the mannequin to hairstylists. Passage then worked with an artist named Horst

A representation of the human form would normally qualify as a sculpture.

Heerlein to create an original sculpture of a female human head. Although Passage discussed his vision with Heerlein, he didn't give Heerlein any specific functional dimensional requirements. From Passage's description, Heerlein created a sculpture of a female human head named Mara, which Pivot Point then used as the basis for a line of commercial mannequins. Another company then copied the Mara mannequins and sold them in competition with Pivot Point. A copyright infringement suit followed.

SCULPTURE VS. INDUSTRIAL DESIGN

When an artistic object is put to commercial use, how have courts traditionally differentiated between copyrightable art and industrial design? In the famous *Mazer v. Stein* case, a sculptor created a statuette that was used as a lamp base. The U.S. Supreme Court held that the statuette was copyrightable as any sculptural work would be, even though it was incorporated into a useful article — the lamp.

A representation of the human form would normally qualify as a sculpture. But in *Carol Barnhart Inc v. Economy Cover Corp.*, the Second Circuit held that copyright protection wasn't available for mannequins used for clothing display. The court found that Congress explicitly refused copyright protection for works of applied art or industrial design that have aesthetic or artistic features that



Dissent: Existence — not creation — matters

One of the three judges in *Pivot Point International Inc. v. Charlene Products Inc.* dissented. He disapproved of the majority’s “process-oriented approach” because the copyright statute looks to the useful article as it exists — not to its process of creation. The judge found it irrelevant to inquire into the origins.

In addition, the dissenting judge reasoned that using the process approach still led to the conclusion that the mannequin was functional and not artistic. The judge believed it was undeniable that, from the beginning, Pivot Point intended Mara to serve a functional purpose and commissioned her creation to fulfill that purpose, not to create a work of art for aesthetic beauty.

aren’t identified separately from the useful article. These works aren’t copyrightable regardless of the fact that they may be aesthetically satisfying.

The Second Circuit again denied copyright protection in *Brandir International, Inc. v. Cascade Pacific Lumber Co.* This case involved an abstract sculpture formed of wire bent into an undulating shape. The artist worked with Brandir engineers to modify the sculpture to function as a bicycle rack, which Brandir marketed. When they sued a competitor for selling a similar bicycle rack, the court found the rack was in its final form essentially a product of industrial design.

MANNEQUINS AND TAXIDERMY

Two taxidermy mannequin cases followed. *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., Inc.* involved an animal mannequin intended to be covered by an animal skin. The court ruled in favor of copyright protection, saying that the mannequin was the creative key to the ultimate animal display.

The mannequin, even though covered with a skin, wasn’t invisible but conspicuous in the final display. The mannequin didn’t lose its expressive aspects when covered with a skin. Thus, the mannequin’s utilitarian aspects existed merely to portray the

animal’s appearance. The animal’s body expression given by the mannequin was thus protectable under the Copyright Act. The mannequin’s usefulness was its portrayal of the animal’s appearance.

And in *Hart v. Dan Chase Taxidermy Supply Co.*, the Second Circuit found that *Barnhart* didn’t mandate a finding that fish mannequins were useful articles undeserving of copyright protection. In *Barnhart*, torsos were designed to present clothing, not their own forms. In taxidermy, by contrast, mannequins were designed to present the fish as a whole. People looked for more than a fish skin — they looked for a complete fish. The skin admittedly conveyed the superficial characteristics of the fish, such as its color and texture. But the underlying mannequin depicted the shape, volume and movement of the animal.

Whether the fish was shown as resting, jumping or wiggling its tail was dictated by the mannequin and by its particular form, not by the skin.

In short, the fish mannequin was designed to be looked at. That the fish mannequin was meant to be viewed clothed by a fish skin, rather than naked and on its own, made no difference. The function of the fish form was to portray its own appearance, and that fact is enough to bring it within the scope of the Copyright Act.



COPYRIGHT BY PROCESS

Based on those earlier cases, is Mara eligible for copyright protection as a sculpture or ineligible as a useful article? The defendant urged that Mara wasn't copyrightable, because she was sold for her utility in displaying wigs and for training student hairstylists and makeup artists.

But the court held that Mara was copyrightable. It took what it called a process-oriented approach — focusing on the process of creating the object to determine whether it's entitled to copyright protection. The court said that an object is copyrightable if “the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences.”

Mara met this test because Passage didn't provide Heerlein with specific dimensions or measurements. In fact, there was no evidence that Heerlein's

artistic judgment was constrained by functional considerations. Passage didn't require, for example, that the sculpture's eyes be a certain width to accommodate standard-sized eyelashes, that the brow be arched at a certain angle to facilitate make-up application or that the sculpture as a whole not exceed certain dimensional limits to fit within Pivot Point's existing packaging system. The existence of such requirements would weigh against a determination that Mara was purely the product of an artistic effort. By contrast, after Passage met with Heerlein to discuss Passage's idea for a model, Heerlein had *carte blanche* to implement that vision as he saw fit.

THE WINNER BY A HEAD

By a vote of two to one, the court declared Mara a work of art, not merely a tool of industry. Whether the elusive line between art and usefulness is any clearer is another question. 💡

4

Likelihood of confusion is confusing

Trademark defendant can use protected mark

Ask for an explanation of trademark infringement and someone may say it happens when the defendant uses a mark similar to the plaintiff's mark on goods or services similar to the plaintiff's goods or services, resulting in trade identity confusion. But what if the defendant has a right to use the mark?

LIGHTS ON

When JSC began manufacturing light bulbs in Russia, it adopted the trademark “Svetlana” from the Russian word “Svet,” meaning “light.” By 1929, light-bulb manufacturing evolved into vacuum-tube manufacturing, and JSC became the largest power-tube manufacturer in Russia.

In 1992, JSC entered into a joint venture agreement with Svetlana Electron Distributors (SED) to bring Russian power grid tube technology to the West. JSC manufactured the vacuum tubes,

while SED had the exclusive right to distribute them in the United States. SED invested significant sums in developing a market for these tubes in America. The tubes sold by the joint venture were marked with a stylized “S” and the words “Svetlana Electron Devices.”

In 2000, the JSC and SED joint venture dissolved, and JSC entered into an agreement with PM of America, Inc. (PMA) to distribute its tubes in the United States. SED's successor currently distributes



tubes under the “Svetlana” mark that are manufactured in Russia but doesn’t sell tubes manufactured by JSC, the original “Svetlana” producer.

THE LIGHTS FLICKER

In 2001, JSC and PMA filed a trademark infringement action against SED and its successor in the United States. In 2003, the parties signed a settlement agreement containing the following terms:

1. SED’s successor would have the exclusive right to use the Svetlana mark in the United States and Canada,
2. JSC would use another mark in those countries, and
3. SED’s successor would release the customers of JSC and PMA from any infringement claims arising out of the use of the Svetlana mark in connection with the sale of JSC inventory purchased before March 4, 2003.

PMA then sent a letter to its customers that informed them that tubes formerly branded Svetlana would now be sold under a Winged-C logo and under a new brand name, “SED St. Petersburg, Russia.”

One of PMA’s customers — CE Distribution LLC — maintained a Web site that listed the products sold by CE. It includes a page that lists several brands of vacuum tubes, including both Svetlana and Winged-C. Clicking on “Svetlana” brings the user to a list of tubes manufactured by JSC that were purchased by CE before Jan. 15, 2003 — and were therefore legal under the settlement agreement. The Web page also contained a detailed explanation of the Svetlana trademark history, concluding with the following statement: “...if you want the tubes that you’ve come to know in the past as ‘Svetlana,’ the only way to be sure you’re getting that tube is to look for the [Winged-C] mark.”

THE LIGHT STAYS ON

In August 2003, SED’s successor filed a lawsuit against CE for trademark infringement and unfair competition based on CE’s use of “Svetlana” on its Web site. The court, however, granted CE summary

judgment. The court found that “Svetlana” was primarily associated with JSC’s factory in St. Petersburg, not with SED or its successor. Even accepting the argument that SED was singularly responsible for the introduction of JSC’s products to American consumers, SED repeatedly informed consumers in its own literature that the tubes were manufactured at a St. Petersburg factory called Svetlana.

SED’s successor offered no proof suggesting that CE created any confusion. To the extent that the mark appeared on CE’s Web site at all, it was to allay confusion. The Web page accurately informed consumers who might previously have had a preference for vacuum tubes made by the Svetlana factory in St. Petersburg that they could continue



to purchase those tubes but the tubes now bore the Winged-C logo. The court found that the use of the Svetlana mark truthfully and accurately recounted the historical events that resulted in the designation change.

COURT SEES THE LIGHT

In this case, a defendant was found to have a limited right to use a competitor’s trademark in commerce. So, if you explain infringement in terms of the similarity between trademarks, remember to say, “On the other hand...” 

What is a “printed publication”?

Early slide presentations bar patent application

By statute, a patent cannot be granted if the application’s effective filing date is more than a year after the invention has been disclosed in a “printed publication.” The inventors of a cholesterol-lowering cereal were denied a patent in a recent case because the court found that the presentation of slide shows constituted a printed publication. So why did the court come to this conclusion?

THE DISPLAYS IN QUESTION

The inventors created a slide presentation and showed it twice. Fourteen slides explaining the invention were printed, pasted onto poster boards and displayed continuously for two and a half days at one meeting. The other presentation was the same, but lasted for less than a day. Neither presentation included a disclaimer or notice to the intended audience prohibiting note-taking or copying.

The inventors argued that the slide displays weren’t “printed publications” because no copies were distributed to the audience. In addition, there was no evidence the displays were photographed, and they weren’t catalogued or indexed in any library or database.

ORAL VS. SLIDE PRESENTATIONS

An entirely oral presentation at a scientific conference that includes neither slides nor copies of the presentation is clearly not a printed publication. But what if the speaker adds a transient display of slides to the presentation? The slides are, in some sense, “printed” material, but would a transient display amount to “publication”? Some years ago a court held that a slide projection at a lecture that was limited in duration, and that couldn’t disclose the invention to the extent necessary to enable a person of ordinary skill in

the art to make or use the invention, wasn’t a publication within the patent statute’s meaning.

DISTRIBUTING COPIES

What if the speaker gives the audience copies of the material? In another case, a paper was delivered orally at a scientific conference to an audience of 500. Some copies of the paper were given to audience members. The court held that there had been a printed publication — even though the number of papers distributed may not have been greater than six. So apparently it’s sufficient to constitute a publication if some audience members take printed material away, even if the number of copies isn’t large.

That case expanded the concept of printing to encompass a process that isn’t designed for large volume production. You don’t need a printing press, or even a duplicating machine; a device that produces one copy at a time, such as a personal computer printer, or even a typewriter, seems to suffice.

INDEXING MATERIAL AND PUBLIC ACCESSIBILITY

What if the printed material isn’t given away but is merely made available for viewing by the public? Another case involved college students’ presentations of undergraduate theses to four faculty members. The college’s main library later catalogued the theses in an index made up of cards containing only a student’s name and thesis title. The index was searchable only by student name, not by thesis title. The court held that because the theses were presented to only a handful of faculty members and weren’t catalogued or



indexed in a meaningful way, they weren't publicly accessible.

The ultimate test is whether the printed material is made accessible to the relevant public.

But in another case, a student thesis was filed and properly indexed in a university library. That court held that the thesis did count as a printed publication because it was locatable from the index. It has even been held that an Australian patent application — that was never printed on paper or distributed — qualified as a printed publication. Why? Because it was available in microfilm form at the Australian Patent Office, and the office kept records making the microfilm accessible to the public.

ACCESSIBLE TO RELEVANT PUBLIC

In the case of the cholesterol-lowering invention, the audience wasn't given copies of the slide presentation. The slides weren't indexed or available from any library or database. Thus none of the criteria of the preceding cases seemed to be met.

But the court broke new ground. It said that the ultimate test isn't distribution or indexing of library databases, but whether the printed material is made accessible to the relevant public. Distribution of copies and indexing in libraries or databases are merely some of the ways materials are made accessible. The court said the slide presentations in this case demonstrate yet another way of making printed material accessible to the public: a nontransient, unrestricted display of hard copy.

But not all such displays qualify. The relevant factors in determining accessibility are:

- ① The length of time the display is exhibited,
- ① The target audience's expertise,

- ① The existence of reasonable expectations that the material displayed won't be copied, and
- ① The simplicity or ease with which the material displayed can be copied.

In this particular case, the court found these factors weighed against the inventors. The inventors presented the display in such a way that copying of the information it contained would have been a relatively simple undertaking for the audience members — particularly given the amount of time they had to do it and the lack of any restrictions on their copying of the information.



VIEWING LEADS TO PATENT DENIAL

So the court denied the patent application. The morals to this story? First, be careful what you disclose and how you disclose it. And second, file your patent application as soon as possible. 💡

STURM & FIX LLP

www.hsllp.com

SUITE 304
101 WEST SECOND STREET
DAVENPORT, IOWA 52801-1813
TELEPHONE (563) 323-9731
TELEFAX (563) 323-9709



John E. Cepican

SUITE 1213
206 SIXTH AVENUE
DES MOINES, IOWA 50309-4076
TELEPHONE (515) 288-9589
TELEFAX (515) 288-4860



Michael O. Sturm

SUITE 257
4089 S. 84TH STREET
OMAHA, NEBRASKA 68127-1701
TELEPHONE (402) 398-9000
TELEFAX (402) 398-9005



Richard L. Fix

PARTNERS