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**COMMENT: SHOULD FURNITURE BECOME FASHION-  
FORWARD? APPLYING FASHION'S COPYRIGHT  
PROPOSALS TO THE FURNITURE INDUSTRY**

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ABSTRACT

*Copycat furniture companies, which produce custom furniture “knockoffs” based on the designs of other furniture companies, are seeing growing success in the United States due to the lack of intellectual property protection for useful articles like furniture. In an industry already battered by offshore manufacturing and the depressed economy, the prevalence of copycat products further affects the sales of producers of original furniture designs. In order to preserve the incentive in the furniture industry to invest in creating original designs and protect against copycats, reform is needed.*

*As a functional article, furniture is rarely protected by intellectual property laws. Current copyright law only protects useful articles to the extent that the article’s ornamental aspects are separable from the article’s functional aspects. The various tests for conceptual separability are ambiguous and results are difficult to predict. Design patents similarly only protect new and ornamental designs where the ornamental aspect is not primarily dictated by function. The significant backlog in the Patent and Trademark Office is also a deterrent to applying for this form of protection. Trademarks and trade dress also rarely protect furniture because only a handful of designs serve as source identifiers for furniture manufacturers.*

*The fashion industry’s proposals for copyright reform may be the answer to the furniture industry’s woes. Fashion designers share furniture designers’ frustrations with current intellectual property law and have pushed for a number of reforms over the past decade to protect new and original fashion designs. The most recent bill, The Innovative Design Protection and Piracy Prevention Act, would have amended the Copyright Act to specifically protect the appearance of an article of apparel as well as its ornamentation for a three-year period. While opponents of the bill cited the strength of the fashion*

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*industry in spite of copycats, the same argument does not hold in the struggling furniture industry.*

*Recent proposals from the fashion industry could be adapted to the furniture industry to help close the industry's gap in intellectual property protection and preserve the incentive for the furniture industry to invest in creating original designs. In order to revitalize the furniture industry and protect its original and innovative designs, the furniture industry should push for their own reforms and become fashion-forward.*

## I. INTRODUCTION

Twice a year, over 85,000 people pour into High Point, North Carolina, to attend the largest furniture trade show in the world.<sup>1</sup> Buyers and designers return year after year to catch a glimpse of the latest designs and innovations in furniture from over 2,000 exhibitors.<sup>2</sup> Imagine walking around the exhibit halls and spotting a chair that looks familiar. You take a closer look and realize the chair is actually your design. However, the chair is not in your booth, and your labels have been removed. Unfortunately, this is an all too common occurrence in the furniture industry. For an industry that is already in trouble due to offshore manufacturing, copycat producers could prove devastating. Intellectual property protection is the key element in curbing copycats and protecting the creation of innovative designs within the furniture industry.

Furniture has long been an example of a functional object.<sup>3</sup> Due to its primarily functional nature, intellectual property protection is often difficult, if not impossible, to obtain for furniture pieces.<sup>4</sup> Yet, furniture design can be innovative and artistic. Copycat furniture companies, which create custom furniture based on designs from Pottery Barn, Ethan Allen, Room & Board, and other popular retailers and designers, are seeing growing success due to the lack of copyright protection in the US.<sup>5</sup> These companies produce furniture knockoffs at significantly lower prices than the original designers and make this “custom furniture” available to price-conscious consumers. In an already economically challenging time, this process of copying further affects traditional furniture designers’ sales. For example, Williams-Sonoma, Inc., owner of retail furniture stores like Pottery Barn, reported a 17.5% decline in revenue from January 2008 to January 2010.<sup>6</sup> Additionally, Ethan Allen Interiors Inc.’s design center revenues fell 40% from June 2008 to June 2010.<sup>7</sup>

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<sup>1</sup> *Market Facts*, HIGH POINT MARKET, [http://www.highpointmarket.org/abt\\_facts.aspx](http://www.highpointmarket.org/abt_facts.aspx) (last visited Mar. 9, 2011).

<sup>2</sup> *Id.*

<sup>3</sup> See *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 213 (2000) (noting the inherent functionality of product designs where the design serves to “render the product itself more useful or more appealing”); Amir Efrati, *Business Plans That Rest on Imitation*, WALL ST. J. (Aug. 26, 2010), <http://online.wsj.com/article/SB10001424052748703846604575447781590965788.html> (“Most everything about an item of furniture is functional.”).

<sup>4</sup> See Efrati, *supra* note 3.

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

With incoming orders 20 to 40 percent below normal levels, the furniture industry in the United States is in trouble.<sup>8</sup> In order to increase demand, furniture companies must market innovative designs. Copycat furniture companies hinder innovation by taking business from companies who invest in new designs. The process of copying “only serves to confuse the consumer and lead to a sameness of design offerings.”<sup>9</sup> Protecting original designs is crucial for a company’s survival in an industry as competitive as the furniture industry because “design copying and infringement are almost epidemic in the furniture industry.”<sup>10</sup> A key question to ask is: what can be done to protect and promote this \$140 billion industry in the United States?<sup>11</sup>

#### A. *The Furniture Industry’s Response to Copycats*

Some furniture companies are taking action against copycats to protect their innovative designs under existing copyright law. In 2009, Wynwood Furniture settled a copyright and trade dress infringement lawsuit against Endura, Inc.<sup>12</sup> The furniture collections involved in the suit featured “pronounced carvings and shapely wrought iron” among other distinct features.<sup>13</sup> Joseph Hill, President and Chief Operating Officer of Wynwood Furniture, stated, “[w]e will continue to take aggressive action where necessary to protect ourselves and our dealers.”<sup>14</sup> Additionally, in August of 2010, the Fourth Circuit Court of Appeals affirmed a finding of copyright infringement for Universal

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<sup>8</sup> Anderson Bauman Tourtellot Vos & Co., *The American Furniture Industry: What Will It Take to Survive?*, KNORR MKTG. at 2 (Sept. 2009), <http://www.knorrmarketing.com/American-Furniture-Industry-Survival-ABTV-rpt.pdf> [hereinafter ABTV].

<sup>9</sup> *Id.* at 6.

<sup>10</sup> George Gottlieb, *Protection of Furniture Designs*, FURNITURE DESIGN & MFG., June 1996, available at [http://www.grr.com/download/publications/final\\_articles/gg-copyr-trd-drs-ptent-cons.pdf](http://www.grr.com/download/publications/final_articles/gg-copyr-trd-drs-ptent-cons.pdf)

<sup>11</sup> U.S. DEP’T OF COMMERCE, BUREAU OF ECON. ANALYSIS, NAT’L INCOME & PRODUCTS ACCOUNTS TABLE, <http://www.bea.gov/national/nipaweb/TableView.asp?SelectedTable=70&Freq=Year&FirstYear=2008&LastYear=2009> (noting that U.S. furnishings and durable household equipment sales totaled \$139.1 Billion in 2009) (last revised Aug. 5, 2010).

<sup>12</sup> *Wynwood Furniture Reports Settlement of Copyright Lawsuit*, FURNITURE WORLD MAG., Jan. 30, 2009, available at <http://www.furninfo.com/absolutenm/templates/News.asp?articleid=9841>.

<sup>13</sup> *Cordoba – Antiguo Blanco: Overview*, WYNWOOD FURNITURE, <http://www.wynwoodfurniture.com/ViewCollection.aspx?id=d2ec1a4e-363d-4a74-a6a5-9b124e4bf184> (last visited Nov. 19, 2010).

<sup>14</sup> *Wynwood Furniture*, *supra* note 12.

Furniture, Inc., which originally filed suit against Collezione Europa USA in 2004.<sup>15</sup> The court held Universal's "highly ornate collections of furniture adorned with three-dimensional shells, acanthus leaves, columns, finials, rosettes, and other carvings" warranted copyright protection and were not just functional designs.<sup>16</sup> Universal Furniture was awarded more than \$11 million in damages and Collezione filed for bankruptcy.<sup>17</sup>

Despite these success stories, the vast majority of furniture is not protected by copyright or other intellectual property protections such as design patents, trademarks, or trade dress due to the furniture's functional nature.<sup>18</sup> Copyright protection is only allowed for useful articles like furniture when the artistic or ornamental aspects are physically or conceptually separable from the functional aspects of the article.<sup>19</sup> Even with Universal Furniture's success, most furniture designs would have difficulty passing this test for separability, and different circuits utilize numerous tests. Design patents pose a similar issue as copyrights; they only protect new and ornamental designs where the ornamental aspect of the design is not "primarily dictated by functional considerations."<sup>20</sup> The current backlog in the United States Patent and Trademark Office is also a deterrent to relying on patents for protection.<sup>21</sup> Further, trademarks and trade dress, while often a good option for fashion designers, do not adequately protect furniture due to the fact that only a handful of recognizable brands exist in the retail furniture industry.<sup>22</sup>

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<sup>15</sup> Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc., 618 F.3d 417, 424 (4th Cir. 2010).

<sup>16</sup> *Id.* at 434.

<sup>17</sup> *Id.* at 427.

<sup>18</sup> See *infra* Part II–III; 17 U.S.C. § 1302(4) (2010) (excluding designs "dictated solely by a utilitarian function" from copyright protection); 35 U.S.C. §§ 101–03 (2010) (requiring patents for new and useful compositions to be non-obvious); 15 U.S.C. § 1125 (2010) (granting trademark protection for words, names, symbols or devices to distinguish one article from another by a different manufacturer).

<sup>19</sup> 17 U.S.C. § 102 (2010) (copyright protection is available to useful articles only to the extent that pictorial, graphic, or sculptural works can be identified separately from the utilitarian aspects of the article).

<sup>20</sup> Lawrence R. Robins & Katherine Staba, *What You Need To Know About Design Patents in the Furniture Industry*, FURNITURE WORLD MAG., April 9, 2010, available at

<http://www.furninfo.com/absolutenm/templates/News.asp?articleid=11343>.

<sup>21</sup> See *Patent Application Backlog*, U. S. PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/dashboards/patents/main.dashxml> (Patent backlog of 715,461 pending applications as of February, 2011) (last visited Mar. 3, 2011).

<sup>22</sup> Jack B. Hicks, *Furniture Copying: Will it Ever End?*, 8 IP LINKS 1, 3 (N.C. Bar Ass'n, Cary, N.C.) (Jan. 1997), available at [http://www.wcsr.com/resources/pdfs/furniture\\_blog082610.pdf](http://www.wcsr.com/resources/pdfs/furniture_blog082610.pdf).

Jack Hicks, an intellectual property attorney, stated: “[i]ntellectual property laws exist in large part to reward companies who take a risk with new designs . . . [a]nd when you do hit a home run, it rewards them by giving them exclusivity.”<sup>23</sup> However, the paths to obtaining legal rewards are difficult to navigate. The requirements are often vague and the tests are not uniformly applied. Only unique, ornate designs, such as those in *Universal Furniture*, have any hope of protection. The furniture industry, however, is not alone in its predicament with intellectual property protection. The fashion industry bears striking similarities to the furniture industry, and fashion designers have organized to propose a solution: a new form of copyright protection specific to fashion design.

### *B. The Fashion Industry’s Proposals for Copyright Reform*

Like furniture, the fashion industry also has a rising number of copycat producers. Due to fashion’s status as a “useful article,” copyright protection is rarely available.<sup>24</sup> Fashion is a \$322 billion dollar industry and copycat retailers are seeing growing success.<sup>25</sup> Many designers choose to protect their designs with logos, which are protected under trademark law. However, small and unknown designers “usually don’t have the logos on handbags and accessories that enable the big-name designers to enjoy the protection of existing trademark law.”<sup>26</sup> Similar to the furniture industry, which displays new designs at annual furniture markets in High Point, Chicago, and Las Vegas, the fashion industry displays collections on New York runways about six months before the designs appear on the market.<sup>27</sup> This allows ample time for copycats to develop and market cheaper

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<sup>23</sup> Marc Barnes, *Fighting Knockoff Designs*, CASUAL LIVING (Feb. 1, 2010), available at [http://www.casualiving.com/article/465593-Fighting\\_knockoff\\_designs.php](http://www.casualiving.com/article/465593-Fighting_knockoff_designs.php).

<sup>24</sup> See 17 U.S.C. § 1302, *supra* note 18.

<sup>25</sup> BUREAU OF ECON. ANALYSIS, *supra* note 11 (U.S. clothing and footwear sales totaled \$322.2 billion in 2009).

<sup>26</sup> C. Scott Hemphill & Jeannie Suk, *Designers Seek Protection From Fashion Copycats*, ABC NEWS (May 13, 2009), <http://abcnews.go.com/Business/Economy/story?id=7571146&page=1>.

<sup>27</sup> Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1693 (2006) (“Major fashion design firms . . . produce new apparel designs continually, but market their design output via collections introduced seasonally in a series of runway shows.” Shows typically occur in February and September in New York City.).

alternatives. Billions of dollars are lost in the fashion industry each year to copycats.<sup>28</sup>

The fashion industry has pushed for a number of reforms to copyright law over the past decade in an effort to protect new and original fashion designs.<sup>29</sup> The most recent bill, The Innovative Design Protection and Piracy Prevention Act (S. 3728), was introduced on August 5, 2010 by Senator Charles Schumer (D-NY).<sup>30</sup> Although the bill was ultimately unsuccessful, the Schumer bill limited copyright protection for fashion designs to three years and adopted a “substantially identical” test to find infringement of protected designs.<sup>31</sup>

S. 3728 would have amended Chapter 13 of the Copyright Act, which provides copyright protection to a “designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public . . . .”<sup>32</sup> Currently, the term “useful articles” only applies to vessel hull or deck designs.<sup>33</sup> The design owner “has the exclusive right to (1) make, have made, or import, for sale or for use in trade, any useful article embodying that design; and (2) sell or distribute for sale or for use in trade any useful article embodying that design.”<sup>34</sup> The Schumer bill would have extended this protection to fashion by amending the definition of “useful articles” to include fashion design and apparel.<sup>35</sup> New York’s Council of Fashion Designers of America (CFDA), the American Apparel & Footwear Association (AAFA), and several well-known designers supported this legislation.<sup>36</sup>

Many in the fashion industry, however, have been vocal about their opposition to these proposed revisions, arguing the industry is

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<sup>28</sup> See Press Release, Senator Charles E. Schumer, *Schumer Reveals: Gaping Hole in Piracy Law Allows Cheap Chinese Imports to Flood NYC Market—Costs New York Fashion Houses and Overall Economy Millions, Threatens Thousands of Jobs* (Aug. 8, 2007), [http://schumer.senate.gov/new\\_website/record.cfm?id=289812](http://schumer.senate.gov/new_website/record.cfm?id=289812) (explaining that New York City alone loses over \$1 billion in tax revenue yearly due to illegal counterfeiting).

<sup>29</sup> See H.R. 5055, 109th Cong. (2006); S. 1957, 110th Cong. (2007); H.R. 2196, 111th Cong. (2009).

<sup>30</sup> S. 3728, 111th Cong. (2010); see also H.R. 2196, 111th Cong. (2009).

<sup>31</sup> S. 3728, 111th Cong. (2010).

<sup>32</sup> 17 U.S.C. § 1301(a)(1) (2010).

<sup>33</sup> 17 U.S.C. § 1301(b)(2) (2010).

<sup>34</sup> 17 U.S.C. § 1308 (2010).

<sup>35</sup> H.R. 2196, 111th Cong. (2009).

<sup>36</sup> Cathy Horyn, *Schumer Bill Seeks to Protect Fashion Design*, ON THE RUNWAY (Aug. 5, 2010, 10:43 PM), <http://runway.blogs.nytimes.com/2010/08/05/schumer-bill-seeks-to-protect-fashion-design/>.

better served by allowing copycats to continue.<sup>37</sup> Their main argument is that copycats feed the design cycle and actually encourage more innovation. Two law professors, Kal Raustiala (University of California, Los Angeles) and Christopher Sprigman (University of Virginia), explain that “copies, by diffusing the original design to the mass of consumers, leads [sic] early adopters to seek out new designs in order to stay ahead, or on top, of the fashion cycle.”<sup>38</sup> This argument has been heavily criticized. Law professors C. Scott Hemphill (Columbia University) and Jeannie Suk (Harvard University) argue that while “‘borrowing’ is common in fashion, and might be valuable to fashion innovation, [this] does not itself provide support for the permissibility of close copying in fashion design.”<sup>39</sup> Hemphill and Suk believe that original designs should be protected from “close copies” which do nothing to further innovation.<sup>40</sup>

Could furniture benefit from the type of reform proposed by the fashion industry? In Parts II and III of this Article, I explore the deficiencies in intellectual property protection as applied to furniture through copyright, patent, and trade dress law. In Part IV, I explore the applicability of the fashion industry’s copyright reform proposals to the furniture industry and discuss the possibility of furniture becoming fashion-forward.

## II. THE CHALLENGE OF COPYRIGHT PROTECTION FOR USEFUL ARTICLES

Copyright protection stems from Article I, Section 8 of the United States Constitution which empowers Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>41</sup> In this section, I discuss the limited copyright protection available for useful articles that has grown from the Constitutional mandate to “promote the Progress of Science and the useful Arts.” I then outline the various tests for conceptual separability that useful articles must pass to gain protection for their artistic aspects. Finally, I focus on a process-oriented test for

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<sup>37</sup> See Johanna Blakley, *Ready to Share Fashion and the Ownership of Creativity*, THE NORMAN LEAR CENTER, <http://www.learcenter.org/html/projects/?cm=ccc/fashion> (last visited Nov. 19, 2010).

<sup>38</sup> Raustiala & Sprigman, *supra* note 27, at 1723 n.71.

<sup>39</sup> C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1153 (2009).

<sup>40</sup> *Id.*

<sup>41</sup> U.S. CONST. art. I, § 8, cl. 8.

conceptual separability that the Fourth Circuit utilizes to protect furniture designs.

*A. The Limits of Copyright Protection for Useful Articles*

The Copyright Act of 1976 (“the Act”), which grants protection for the life of the author plus seventy years, protects “original works of authorship fixed in any tangible medium of expression” including “pictorial, graphic, and sculptural works,” but does not protect useful articles’ utilitarian aspects.<sup>42</sup> The Act 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>43</sup> Useful articles, such as furniture or apparel, are included as pictorial, graphic, or sculptural works only to the extent that the pictorial, graphic, or sculptural features “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”<sup>44</sup>

This exception for useful articles was included in the Copyright Act following the Supreme Court’s holding in *Mazer v. Stein*, a 1954 case involving copyright protection of china statuettes that formed part of the bases of table lamps.<sup>45</sup> Even though the lamps were utilitarian objects, the Court held that the statuettes were original, tangible expressions of the author’s ideas that warranted copyright protection.<sup>46</sup> In codifying the holding from *Mazer*, Congress developed a separability test that useful articles must pass in order to gain copyright protection.<sup>47</sup> The separability test includes both physical and conceptual separability.<sup>48</sup> Physical separability, such as the ability of the *Mazer* statuettes to be separated from the lamp without affecting its functionality, generally poses less of a challenge to courts than the difficult and ambiguous test of conceptual separability.<sup>49</sup>

If the article passes the separability test, copyright protection only covers the pictorial, graphic, or sculptural element, such as the

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<sup>42</sup> 17 U.S.C. §§ 102, 302 (2006).

<sup>43</sup> 17 U.S.C. § 101 (2006).

<sup>44</sup> 17 U.S.C. § 102.

<sup>45</sup> 347 U.S. 201 (1954).

<sup>46</sup> *Id.* at 214.

<sup>47</sup> 17 U.S.C. § 102.

<sup>48</sup> H.R. REP. NO. 94-1476, at 54–55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668.

<sup>49</sup> See *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 670 (3d Cir. 1990) (“Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article’s utilitarian function.”).

statuette, and not the article's functional component, the lamp.<sup>50</sup> In drafting the Copyright Act, the House Report specifically notes this point in the context of furniture:

[O]nly elements . . . which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.<sup>51</sup>

Furniture and other useful articles, therefore, must first pass the test for physical or conceptual separability, and even then, only certain elements of the useful article will be protected by copyright. In the next section, I explore the various tests for conceptual separability and then analyze the potential of the process-oriented test to provide protection for furniture designs.

### *B. The Various Tests for Conceptual Separability*

Courts have adopted various tests for conceptual separability since *Mazer* and the Copyright Act of 1976.<sup>52</sup> Unfortunately, many of these tests are vague and lead to unpredictable results. In this section, I outline the tests for conceptual separability courts have applied to useful articles and highlight some of the inconsistencies among their applications.

The Second Circuit adopted a primary/subsidiary test in *Kieselstein-Cord* in 1980, which involved two belt buckles that were "decorative in nature and used as jewelry."<sup>53</sup> The court held that the belt buckles warranted copyright protection because "[t]he *primary* ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their *subsidiary* utilitarian function."<sup>54</sup> Paul Goldstein commented on the ornamental design of the belt

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<sup>50</sup> H.R. Rep. No. 94-1476, *supra* note 48, at 54.

<sup>51</sup> *Id.* at 55.

<sup>52</sup> John B. Fowles, *The Utility of a Bright-Line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in Leicester v. Warner Bros.*, 12 UCLA ENT. L. REV. 301, 322 (2005) (noting that there are at least ten tests for conceptual separability).

<sup>53</sup> *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 990 (2d Cir. 1980).

<sup>54</sup> *Id.* at 993 (emphasis added).

buckles, stating, "purchasers of artistically designed useful articles typically have two motives: to use the article and to enjoy its design. A consumer who pays \$662 for an ornamental belt buckle clearly wants something that will do more than hold up his pants."<sup>55</sup> The concept of conceptual separability allows for a broader range of items, such as ornamental belt buckles, to fall under the normally non-functional nature of copyrightable items.

Another useful article was the subject of litigation in the Second Circuit in 1985: four human torsos designed by Carol Barnhardt, Inc. for mannequin displays.<sup>56</sup> This time the court denied copyright protection, stating, "the features claimed to be aesthetic or artistic . . . are inextricably intertwined with the utilitarian feature, the display of clothes."<sup>57</sup> The court held copyrightability "should turn on [the object's] ordinary use as viewed by the average observer."<sup>58</sup> A later Second Circuit case stated that *Barnhardt* was irreconcilable with *Kieselstein-Cord* and that *Barnhardt* applied a test of physical, not conceptual, separability.<sup>59</sup> Judge Newman, in his dissent in *Barnhardt*, advocated for a "mind of the beholder" test, stating that conceptual separability depends on what occurs in the ordinary observer's mind.<sup>60</sup> The majority attacked Newman's test as one that "underscore[s] the bottomless pit that would be created by such a vague test."<sup>61</sup>

The *Barnhardt* court also considered the NIMMER "market approach".<sup>62</sup> NIMMER states that conceptual separability exists when a useful article "would still be marketable to some significant segment of the community simply because of its aesthetic qualities."<sup>63</sup> The Second Circuit rejected this approach, citing the admitted risk of

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<sup>55</sup> Orit Fischman Afori, *The Role of the Non-Functionality Requirement in Design Law*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 847, 853 n.31, 865 n.105 (2010) (citing PAUL GOLDSTEIN, COPYRIGHT, PRINCIPLES, LAW AND PRACTICE § 2.5.3(b)–(c) (Little, Brown & Co. 1989)).

<sup>56</sup> *Carol Barnhardt, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 412 (1985).

<sup>57</sup> *Id.* at 419.

<sup>58</sup> *Id.* at n.5.

<sup>59</sup> *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1151 (1987) (Winter, J., concurring in part and dissenting in part).

<sup>60</sup> *Barnhardt*, 773 F.2d at 422 (Newman, J., dissenting). Newman's test is commonly referred to as the "temporal displacement" test, e.g., *Brandir*, 834 F.2d at 1144.

<sup>61</sup> *Id.* at 419 n.5.

<sup>62</sup> *Id.* at 421–22.

<sup>63</sup> 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08 [B][3], at 2-101 (2007).

“allowing a copyright only to designs of forms within the domain of popular art . . . .”<sup>64</sup>

In 1987, the Second Circuit analyzed yet another test for conceptual separability, Professor Denicola’s spectrum test, in *Brandir International v. Cascade Pacific Lumber Co.* This case involved a bike rack, called the “RIBBON Rack.”<sup>65</sup> The RIBBON Rack functioned as a bike rack, but was uniquely designed based on a wire sculpture.<sup>66</sup> Professor Denicola explained his test descriptively: “there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.”<sup>67</sup> According to Denicola, copyright protection “should turn on the relationship between the proffered work and the process of industrial design,” and this process should determine the extent of functional considerations.<sup>68</sup> Where aesthetic and functional aspects are merged, conceptual separability does not exist.<sup>69</sup> Alternatively, “where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”<sup>70</sup>

The designer of the RIBBON Rack discovered the idea for the bike rack after juxtaposing a wire bicycle sculpture with another self-standing wire sculpture that he had “created and displayed in his home as a means of personal expression.”<sup>71</sup> Despite an offer to use the RIBBON Rack solely as an environmental sculpture and expert testimony regarding the artistic qualities of the bike rack, it was not protectable by copyright.<sup>72</sup> The court stated, “while the rack may have been derived in part from one of more ‘works of art,’ it is in its final form essentially a product of industrial design” heavily influenced by “utilitarian pressures.”<sup>73</sup>

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<sup>64</sup> *Barnhardt*, 773 F.2d at 422.

<sup>65</sup> *Brandir*, 834 F.2d at 1143.

<sup>66</sup> *Id.* at 1143.

<sup>67</sup> Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983).

<sup>68</sup> *Brandir*, 834 F.2d at 1145 (quoting Denicola, *supra* note 67, at 741).

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

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

<sup>71</sup> *Id.* at 1146.

<sup>72</sup> *See id.* at 1152 (Winter, J., concurring in part and dissenting in part).

<sup>73</sup> *Id.* at 1147. The court noted the changes the designer made to the original sculpture in order to make it function better as a bike rack, such as widening the curves to accommodate bike parking above and below the rack’s curves. This suggests the bike rack as a utilitarian design may have fit better in the realm of patent, rather than copyright law.

The popular process-oriented approach based on *Brandir* is articulated by the Seventh Circuit in *Pivot Point*, a case involving copyright protection for four mannequin heads for use in the hair design and make-up industries.<sup>74</sup> *Pivot Point*'s founder, Leo Passage, worked with a German artist to create a sculpture of a female head and then developed features to create a "hungry look" based on the looks of high-fashion runway models.<sup>75</sup> The designer had "carte blanche" to create Passage's vision and "was [not] constrained by functional considerations" such as making the eyes a certain width or arching the brow to better accommodate make-up artists who may use the mannequin.<sup>76</sup> The Seventh Circuit held that the mannequin "was the product of a creative process unfettered by functional concerns, [and] its sculptural features 'can be identified separately from, and are capable of existing independently of,' its utilitarian aspects."<sup>77</sup> Therefore, the requirements for conceptual separability were met.

The various tests for conceptual separability make copyright protection for useful articles a mysterious quest. The popular process-oriented approach to conceptual separability, however, may provide a more predictable approach. In the next section, I explore this test in the context of a Fourth Circuit case, which utilized the process-oriented approach to protect certain elements of furniture designs.

*C. Universal Furniture v. Collezione Europa USA: The Stage is Set for Protection of Furniture Design*

The furniture industry and industrial designers may find some hope in the process-oriented approach to conceptual separability. In a 2010 furniture case, *Universal Furniture v. Collezione Europa USA*, the Fourth Circuit adopted the process-oriented approach from *Pivot Point*.<sup>78</sup> Utilizing this test, the court found that the furniture's decorative elements warranted copyright protection.<sup>79</sup>

Two furniture lines from Universal Furniture, the Grand Inheritance Collection (GIC) and the English Manner Collection (EMC), were "adorned with three-dimensional shells, acanthus leaves, columns, finials, rosettes, and other carvings."<sup>80</sup> Citing the statuettes

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<sup>74</sup> See *Pivot Point Int'l, Inc., v. Charlene Prods., Inc.*, 372 F.3d 913, 930 (7th Cir. 2004).

<sup>75</sup> *Id.* at 915.

<sup>76</sup> *Id.* at 931–32.

<sup>77</sup> *Id.* at 932.

<sup>78</sup> See *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010).

<sup>79</sup> *Id.* at 435.

<sup>80</sup> *Id.* at 434.

on the lamp base in *Mazer* and the ornamental belt buckles in *Kieselstein-Cord*, the court labeled the furniture designs as “superfluous nonfunctional adornments for which the shape of the furniture (which is not copyrightable) serves as the vehicle.”<sup>81</sup> The court held that these decorative elements were conceptually separable from the furniture’s “utilitarian aspects.”<sup>82</sup>

The process-oriented approach to conceptual separability allowed the court to focus on the design process of the furniture lines, which was well documented in this case. Steven Russell, designer of Universal’s GIC and EMC lines, “developed the shape of the furniture before turning to ornamentation” and his design process reflected that the ornamentation was more of an aesthetic choice versus a functional choice.<sup>83</sup> Russell’s objective in applying the shells, leaves, rosettes, and other carvings did not improve the furniture’s utility but served to “give [the pieces] a pretty face.”<sup>84</sup>

However, the district court noted that Mr. Russell’s deposition testimony revealed that “some of Mr. Russell’s design decisions were tempered by the need to create a functional piece of furniture” such as Mr. Russell’s agreement that he would not locate a carving in a position that would prevent a drawer from opening.<sup>85</sup> Nevertheless, the Fourth Circuit upheld the district court’s decision that the decorative elements were copyrightable, concluding that the form of the furniture was not “‘inextricably intertwined’ with the function of furniture.”<sup>86</sup> The court emphasized that only the decorative elements were protected, not the entire piece of furniture.<sup>87</sup>

This focus on the design process may allow prudent designers to obtain copyright protection for the artistic elements of a functional piece. But many, if not most, industrial designs like the RIBBON Rack will still be unable to obtain copyright protection. In the RIBBON Rack case, the design process actually hurt the case for copyright protection because the designer changed the original sculptural design so the design would function better as a bike rack.<sup>88</sup>

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<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> *Id.*

<sup>85</sup> *Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc.*, No.

1:04CV00977, 2007 WL 1232075, at \*3 (M.D.N.C. Apr. 26, 2007).

<sup>86</sup> *Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 435 (4th Cir. 2010).

(citing *Carol Barnhardt, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (1985)).

<sup>87</sup> *Id.*

<sup>88</sup> *See Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (1987).

The designer widened the loops to allow bike parking above and below the curves, and changed the end posts to allow in- and above-ground installation of the bike rack.<sup>89</sup> The court stated, “[h]ad Brandir merely adopted one of the existing sculptures as a bicycle rack, neither the application to a utilitarian end nor commercialization of that use would have caused the object to forfeit its copyrighted status.”<sup>90</sup>

Designers relying on the process-oriented test should be aware of the results of cases such as *Universal Furniture* and *Brandir* to better predict the copyrightability of their designs. Circuits applying the same test can differ in results. The RIBBON Rack was deemed utilitarian even though it began purely as a decorative sculpture whereas the decorative elements on Universal’s furniture lines were protected despite the fact that the designer was constrained by functional considerations, such as ensuring the drawers still opened.

Even though the process-oriented approach to conceptual separability is gaining popularity, numerous other tests exist and have been used in various circuits. In the context of furniture, it seems that only the most ornate designs, such as in *Universal Furniture*, gain copyright protection. The goal of intellectual property protection is “[t]o promote the Progress of Science and useful Arts . . . .”<sup>91</sup> If copyright law aims to promote “progress,” should the design process matter more than the end result?

The current tests utilized by courts in deciding these questions of copyrightability often turn on the difficult and ambiguous question of where utility ends and design begins. The furniture industry in particular will benefit from a clearer solution to determining the copyrightability of useful articles. A clearer solution would promote progress and innovation in furniture design, and protect those designs from copycat products.

### III. THE FAILURE OF PATENT AND TRADEMARK PROTECTION

Patents and trade dress, two other forms of intellectual property protection, similarly fail to provide adequate protection for furniture designs. In this section, I provide a brief overview of each type of protection and analyze the insufficiencies when applied to furniture designs.

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<sup>89</sup> *Id.*

<sup>90</sup> *Id.*

<sup>91</sup> U.S. CONST. art. I, § 8, cl. 8.

### A. Patents

Furniture designers often turn to the patent system to protect their work, especially when an article is not sufficiently artistic to qualify for copyright protection. Two types of patents may provide protection: utility patents and design patents.<sup>92</sup> Generally, “a 'utility patent' protects the way an article is used and works (35 U.S.C. § 101), while a 'design patent' protects the way an article looks (35 U.S.C. § 171).”<sup>93</sup>

Utility patents generally include new and non-obvious “processes, machines, manufactures and compositions of matter,” and offer an owner twenty years of protection from the patent-filing date.<sup>94</sup> Design patents cover “new, original, unobvious, and ornamental designs for articles of manufacture” and offer fourteen years of protection from the patent-grant date.<sup>95</sup> Many furniture designs are borrowed from traditional styles, which could present a problem in meeting the “new” requirement for both types of patents. It is not impossible, however, since “improvements that significantly alter a product’s appearance, increase its comfort, adapt it for mass production, or alter aspects of the style to fit modern homes, may still be patented.”<sup>96</sup> Once an article has qualified as new and original for a design patent, it must also qualify as ornamental, meaning “a design must present a pleasing aesthetic appearance and must not be dictated solely by functional considerations.”<sup>97</sup> One test for ornamentality questions “whether the design’s appearance is *primarily dictated by functional considerations*.”<sup>98</sup> Furniture will likely run into similar problems with functionality that it does under the conceptual separability test.

The patenting process itself is another significant obstacle to protecting furniture designs. The United States Patent and Trademark Office has developed a system to predict patent output based on historical data, called the Patent Pendency Model (PPM).<sup>99</sup> As of

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<sup>92</sup> See 1 DONALD S. CHISUM, CHISUM ON PATENTS § 1.01 (2010).

<sup>93</sup> *Id.* at § 23.01.

<sup>94</sup> *Id.* at §§ 1.01, 23.01.

<sup>95</sup> See 35 U.S.C. § 120 (2010) (explaining that later filed patent have the same effect as if filed on the date of earlier application.); 35 U.S.C. § 173 (2010) (“Patents for designs shall be granted the term of fourteen years from the date of grant.”)

<sup>96</sup> Hicks, *supra* note 22, at 5.

<sup>97</sup> CHISUM, *supra* note 91, at § 23.01.

<sup>98</sup> Robins & Staba, *supra* note 20 (emphasis added).

<sup>99</sup> United States Patent and Trademark Office, Patent Pendency Model, [http://www.uspto.gov/patents/stats/patent\\_pend\\_model.jsp](http://www.uspto.gov/patents/stats/patent_pend_model.jsp) (last visited October 17, 2010).

February 2011, the patent backlog was 715,461 pending applications and the average number of months from the application date to the date a First Office Action notice is mailed was 24.5 months.<sup>100</sup> The label of “patent pending” in a furniture catalog will likely serve as a deterrent to copycats until the application moves through the patent process.<sup>101</sup> However, just like the lack of uniformity among the numerous copyright tests, the patent system’s inefficiencies also pose real problems to legally protecting furniture.

### *B. Trademarks and Trade Dress*

Just like the problems protecting furniture designs under the copyrighting and patenting systems, problems also exist for furniture designs in obtaining trademark and trade dress protection. Trademarks are “any word, name, symbol, or device” used by or intended to be used by a person “to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods . . . .”<sup>102</sup> Trade dress, a subset of trademarks, generally refers to “non-verbal source identifiers” like the symbols and devices in the definition of trademarks; the Supreme Court analyzes both trademark and trade dress in the same manner.<sup>103</sup>

Trademarks and trade dress are not strong protections for furniture, due in part to the fact that only a handful of recognizable brands exist in the retail furniture industry.<sup>104</sup> The key elements in a trademark or trade dress case are to show (1) the distinctiveness of an article, either through inherent characteristics or through secondary meaning, and (2) that a likelihood of confusion exists between the plaintiff’s and defendant’s articles.<sup>105</sup> The functional nature of furniture again poses a problem with trademark protection. The non-verbal source identifiers should also be non-functional elements, as a recent case illustrated.

In August 2010, the Seventh Circuit Court of Appeals provided some guidance to furniture designers in cases involving trade dress. Here, Greenwich Industries attempted to enforce a trademark registration for the “X-frame” design visible on the side of its folding

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<sup>100</sup> United States Patent and Trademark Office, Patents Dashboard, *supra* note 21.

<sup>101</sup> Hicks, *supra* note 22, at 6..

<sup>102</sup> 15 U.S.C. § 1127 (2010).

<sup>103</sup> 1 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 2A.01 (2010) [hereinafter GILSON].

<sup>104</sup> *Id.*

<sup>105</sup> Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763, 769 (1992).

chairs, which it claimed was a distinctive feature of the chair.<sup>106</sup> The Seventh Circuit refused to protect the X-frame chair, affirming the district court's holding that the "design is functional as a unit, and that every important aspect of it is independently functional."<sup>107</sup> Because no non-functional aspect of the design existed to make the chair's appearance distinctive, trademark laws provided no protection.<sup>108</sup>

One possible solution is that furniture companies who wish to obtain trademark or trade dress protection should consider a marketing strategy aimed at an identifying feature.<sup>109</sup> For example, "advertising that highlights the design as an indicia of source and not merely a desirable design element can be highly effective in establishing protectable trade dress."<sup>110</sup>

Out of all the choices for intellectual property protection, the fashion industry most utilizes trademarks.<sup>111</sup> The designer or retailer's name is often visible on an item of clothing, a handbag, a pair of sunglasses, or even a pair of shoes. Sometimes the mark is incorporated into the design of the article as seen in Burberry's famous plaid design, which is a registered trademark.<sup>112</sup> In the cases of logos or brand names, only the logo or name is protected by trademark, not the article.<sup>113</sup> The remainder of the article must meet the requirement for distinctiveness, which requires a showing that the article is not functional.<sup>114</sup> Most articles of clothing will not pass this test necessary for full protection.<sup>115</sup>

Furthermore, since "many designs are copied in a relatively short span of time, the general public may identify a distinctive trend in fashion designs but will not likely associate that trend with one

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<sup>106</sup> See *Specialized Seating, Inc. v. Greenwich Indus. L.P.*, 616 F.3d 722, 723–24 (7th Cir. 2010).

<sup>107</sup> *Id.* at 727.

<sup>108</sup> See *id.*

<sup>109</sup> Lawrence R. Robins & Katherine Staba, *Courts Clarify Copyright and Trademark Rights In Furniture Cases*, FURNITURE WORLD MAG., October 5, 2010, available at <http://www.furninfo.com/absolutenm/templates/News.asp?articleid=11999>.

<sup>110</sup> *Id.*

<sup>111</sup> Lisa J. Hedrick, *Tearing Fashion Design Protection Apart at the Seams*, 65 WASH. & LEE L. REV. 215, 226 (2008).

<sup>112</sup> See CHECK LINING DESIGN, Registration No. 1,241,222 (providing Burberry's registration information).

<sup>113</sup> See 15 U.S.C. § 1127 (2006).

<sup>114</sup> 15 U.S.C. § 1125(a)(3) (the burden is on the producer to show that the allegedly infringing feature is not functional).

<sup>115</sup> A notable exception is Christian Louboutin's shoes, which feature shiny, red soles. The red soles became his signature mark and were granted trademark protection. MISCELLANEOUS DESIGN, Registration No. 3,376,197.

particular designer.”<sup>116</sup> While the fashion industry may find some protection through trademark laws, this solution will not protect the entire article of clothing. Thus, the protection for functional articles like fashion and furniture is lacking.

#### **IV. SHOULD THE FURNITURE INDUSTRY BECOME FASHION-FORWARD?**

Due to the similarities in the furniture and fashion industries, recent proposals to reform intellectual property in the fashion industry may provide helpful insights into strengthening intellectual property protection in the furniture industry. For example, both fashion and furniture have seasonal design cycles. Articles on display at fashion shows and furniture markets give copycat retailers an opportunity to preview these designs and manufacture lower cost, and often lower quality, versions of the latest designs. Copycats generate billions of dollars from these industries and rob the original designers of their creations.<sup>117</sup> Given the highly functional nature of both fashion apparel and furniture, current intellectual property laws such as copyrights, patents, and trademarks offer little to no protection. Only a decorative belt buckle that can also be worn as jewelry or a highly ornate chest of drawers will pass the test for non-functionality. Fashion designers have worked on various proposals over the past decade and the proposed legislation may work well for the furniture industry.

##### *A. How the Fashion Industry’s Proposals for Copyright Reform Might Apply to the Furniture Industry*

The most recent proposal to reform intellectual property in the fashion industry, the Innovative Design Protection and Piracy Prevention Act (“S. 3728”), would have amended Chapter 13 of the Copyright Act to specifically protect the appearance of an article of apparel as well as its ornamentation for a three-year period.<sup>118</sup> The proposal defined apparel broadly to include clothing (including undergarments, outerwear, gloves, footwear, and headgear), handbags, purses, wallets, duffel bags, suitcases, tote bags, belts, and eyeglass

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<sup>116</sup> Hedrick, *supra* note 111, at 226–27 (2008).

<sup>117</sup> See Press Release, Senator Charles E. Schumer, *supra* note 28.

<sup>118</sup> S. 3728, 111th Cong. § 2(a)(2)(B), §2(d)(2) (2010) (appending to the statute section (7)(A)). S. 3827 passed the Judiciary Committee and was placed on the Senate Legislative Calendar for a full vote. It did not pass during the 111th Congress, but may be re-introduced in subsequent Congresses.

frames.<sup>119</sup> H.R. 2196, an earlier version of S. 3728, was introduced in the House of Representatives in April of 2009 but stalled in the House Committee on the Judiciary. H.R. 2196 indicated that a “fashion design”: “(A) is the appearance as a whole of an article of apparel, including its ornamentation; and (B) includes original elements of the article of apparel or the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel.”<sup>120</sup> In addition to this definition, S. 3728 required that the elements be the result of a designer’s own creative endeavor and provide a unique, distinguishable, non-trivial, and non-utilitarian variation over prior designs for similar types of articles.<sup>121</sup>

If the furniture industry were to adopt a similar proposal to S. 3728, the design process would be extremely important, just as it is under the process-oriented test for conceptual separability.<sup>122</sup> S. 3728 did not elaborate on what constitutes a “non-utilitarian variation over prior designs for similar types of articles,” but one may envision, in a furniture context, that significant changes to the shape and length of bedposts or the curvature of a wing-back chair may qualify.<sup>123</sup> A longer bedpost or change in shape would not likely affect the utility of the piece of furniture. If non-utilitarian variations are interpreted to mean ornamentation, however, then the furniture industry might as well continue to take its chances on obtaining protection under conceptual separability because the fashion industry’s proposal would still require separation of the functional and ornamental features.

This addition of non-utilitarian variations to S. 3728 reflected a compromise between the various sides of the fashion copyright debate. Furniture proponents may be able to adopt a more relaxed standard like the one in H.R. 2196, which protected both original and non-original aspects as incorporated in the whole article of apparel.<sup>124</sup> H.R. 2196 did not include S. 3728’s requirement for a “unique, distinguishable, non-trivial, and non-utilitarian variation over prior

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<sup>119</sup> S. 3728 at §2(a)(2)(B) (appending to the statute sections (9)(A)–(C)).

<sup>120</sup> H.R. 2196, 111th Cong. § 2(a)(2)(B) (2009).

<sup>121</sup> S. 3728 at § 2(a)(2)(B)(appending to the statute section (7)(B)).

<sup>122</sup> See David Jacoby & Judith S. Roth, *Finally, A Fair Shake For Fashion Design?*, LAW360 (Schiff Hardin LLP), Sept. 10, 2010, available at <http://www.schiffhardin.com/binary/jacoby-roth-law360-091010.pdf> (“The new Senate bill places a significant proof burden on designers seeking to establish infringement.”).

<sup>123</sup> S. 3728 at §2(a)(2)(B) (appending to the statute section (7)(B)(ii) without elaboration).

<sup>124</sup> H.R. 2196 at §2(a)(2)(B); see Subsection B, *infra*, regarding why the furniture industry may be able to lobby for stronger protections than the fashion industry.

designs for similar types of articles.<sup>125</sup> This more relaxed standard in H.R. 2196 would avoid any questions on separating the functional and ornamental features since it would protect all aspects of the article as a whole. In considering a similar reform proposal, the furniture industry may seek to define non-utilitarian variations or lobby for the more relaxed standard in H.R. 2196. The furniture industry would also need to define “furniture.” This definition may include home and office furnishings (including sofas, chairs, tables, beds, chests, armoires, shelves, desks, consoles, and cabinets), draperies, rugs, mirrors, and lamps.

The infringement standard is also important. H.R. 2196 contained a less strict infringement standard than S. 3728. H.R. 2196 stated that the party asserting infringement must show that the allegedly infringing design is substantially similar.<sup>126</sup> Under current copyright law, unless the plaintiff possesses direct evidence of defendant’s copying, “it may create a presumption of copying by indirect evidence establishing that the defendant had access to the copyrighted work and that the defendant’s work is ‘substantially similar’ to the protected material.”<sup>127</sup> In *Universal Furniture*, Universal’s expert testified that the “collections shared a ‘great collection of ornamental detail, principally in the form of relief carvings’ and were ‘similar in terms of placement, selection, arrangement, and most certainly execution.’”<sup>128</sup> Despite changes Collezione made to some of the ornamental designs and placements of the designs, the court held that the designs were substantially similar.<sup>129</sup> S. 3728 reflected a compromise with opponents of reform and includes a stricter “substantially identical” standard.<sup>130</sup>

Overall, the concepts of H.R. 2196 and S. 3728 would help close the gap in copyright protection for the furniture industry. A three-year protection term would promote innovation and complement the furniture industry’s annual design cycle. Immediate protection for designs would eliminate administrative burdens. Most importantly, providing explicit protection for furniture designs would eliminate the ambiguous and inconsistent application of the conceptual separability test. Furniture designs could gain protection even if they do not boast highly ornate embellishments.

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<sup>125</sup> S. 3728, at §2(a)(2)(B).

<sup>126</sup> H.R. 2196, at §2(e)(2) (appending to the statute section (e)(3)).

<sup>127</sup> *Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 435 (4th Cir. 2010).

<sup>128</sup> *Id.* at 436.

<sup>129</sup> *See id.*

<sup>130</sup> S. 3728, at §2(e)(3)(A).

*B. A Broken Industry: Why Furniture Needs Fashion*

While the fashion industry is persistent in its pursuit of additional copyright protection, some in the industry strongly oppose the idea. However, the reasons for opposition may not be as strong when applied to the furniture industry.

The *Washington Post* questioned the fashion industry's push for reform, stating, "perhaps the strongest argument is that America's apparel industry isn't broken—so why try and fix it?"<sup>131</sup> Many proponents of reform cite the protections that the European Union offers fashion design.<sup>132</sup> Steven Kold, director of the Council of Fashion Designers of America, and one of the strongest supporters of S. 3728 has stated, "America is the world leader in fashion . . . and yet it is basically the only industrialized country that does not include protection for fashion design."<sup>133</sup> Yet, if America's fashion industry is doing so well, why change intellectual property laws to "mimic our lagging competitors?"<sup>134</sup>

This argument may hold merit in the fashion context. However, America's furniture industry is in trouble. Unlike fashion, where copycats can make designs trendy and actually increase the original design's value, cheaper furniture copycats leave the original design with no value. For example, consider *Marie Claire* magazine's regular column called "Splurge vs. Steal," where "[a] \$195 Lilly Pulitzer halter top is compared with a \$15.00 version by Newport News."<sup>135</sup> While the Lilly Pulitzer top "usually looks more tasteful or well-made," some shoppers may opt for the cheaper version.<sup>136</sup> However, many shoppers will still pay top dollar for the Lilly Pulitzer design. Will shoppers in furniture pay top dollar for upscale furniture designs if less expensive versions are available?

Even wealthy shoppers may look to copycat furniture producers for savings. Sara Morishige Williams, the wife of the co-founder of Twitter.com, a popular social networking website, has

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<sup>131</sup> Ezra Klein, *In Copycats vs. Copyright, the Knock-Off Wins*, WASH. POST, Aug. 22, 2010, available at [http://www.washingtonpost.com/wp-dyn/content/article/2010/08/20/AR2010082006330.html?wprss=rss\\_business](http://www.washingtonpost.com/wp-dyn/content/article/2010/08/20/AR2010082006330.html?wprss=rss_business).

<sup>132</sup> See *Eldred v. Ashcroft*, 537 U.S. 186, 198 (2003) (noting that global harmonization of copyright law has practical benefits).

<sup>133</sup> Klein, *supra* note 131.

<sup>134</sup> *Id.*

<sup>135</sup> Christine Cox & Jennifer Jenkins, *Between the Seams, A Fertile Commons: An Overview of the Relationship Between Fashion and Intellectual Property*, THE NORMAN LEAR CENTER, at 4 (Jan. 29, 2005), available at <http://www.learcenter.org/pdf/RTSJenkinsCox.pdf>.

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

ordered “about 20 chairs and 26 sofa pieces based on designs from upscale retailers B&B Italia and Design Within Reach, among others” at a total cost of about \$40,000 from Furniture Envy, a “custom” furniture producer.<sup>137</sup> If Ms. Williams purchased the lowest priced sofa pieces and chairs from Design Within Reach, she would have spent an additional \$30,000, for a total order of at least \$70,000.<sup>138</sup> Where is the incentive to invest in innovation, when copycat producers immediately undercut designers of original articles? An intellectual property attorney discussing this issue, argued that “[i]n tough economic times, companies cannot afford to take the risk in developing a new design and seeing if it will sell . . . . The lower cost, safer alternative is to instead knock off a bestseller.”<sup>139</sup>

One option for the furniture industry is of course to do nothing and rely on ornate furniture designs to pass the conceptual separability test for copyright protection and on “patent pending” warnings to deter copycats. Perhaps the new “custom” furniture companies will create enough jobs to compensate for the ones lost in the traditional furniture design industry. But with furniture manufacturing already moving offshore, design innovation needs to be protected in the United States. A September 2009 report by Anderson Bauman Tourtellot Vos (ABTV), a turnaround management firm headquartered in Greensboro, North Carolina, states that “[m]arketing [h]olds the [h]ope for [r]evival” of the furniture industry.<sup>140</sup> ABTV recommends that “[f]urniture executives would do well to study the fashion industry, and to learn why women will pay \$500 for a plain black dress when quite similar garments are to be had for \$100 or even \$50.”<sup>141</sup> Some furniture companies may be able to create strong brands to drive this type of sale. However, branding did not win Sara Morishige Williams’ business when the same furniture could be custom-copied at a fraction of the price.

While branding and marketing are certainly great strategies, these efforts will go nowhere unless the furniture company has an innovative product to market. Custom furniture makers are certainly seeing success marketing their ability to make exact replicas of high-end designers at reduced prices. Furniture would do well to study the fashion industry, but not in terms of branding. Instead, furniture

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<sup>137</sup> Efrati, *supra* note 3.

<sup>138</sup> See DESIGN WITHIN REACH, [www.dwr.com](http://www.dwr.com) (last visited November 19, 2010) (Sofa sectional pieces listed for \$2,500 each and chairs range from about \$250 to over \$11,500).

<sup>139</sup> Barnes, *supra* note 23.

<sup>140</sup> ABTV, *supra* note 8, at 15.

<sup>141</sup> *Id.*

should study the fashion industry's intellectual property reform proposals.

Recall that the goal of copyright protection in the United States is “[t]o promote the Progress of Science and useful Arts . . . .”<sup>142</sup> Congress needs to meet their Constitutional mandate to promote innovation in the furniture industry. Furniture designers who invest time, effort, and creativity to produce original designs are not being adequately protected under the current copyright laws. Furniture needs to become fashion-forward to ensure that buyers from around the world will still travel to High Point, Chicago, and Las Vegas, to see and purchase the newest innovative designs. It is essential that Congress preserves and promotes the incentive within the furniture industry to create these designs.

## V. CONCLUSION

The furniture industry, like the fashion industry, has a growing number of copycat producers, due in part to the difficulty in obtaining intellectual property protection. Due to its functional nature, the vast majority of furniture is not protected by copyright or other intellectual property protections such as design patents, trademarks, or trade dress.<sup>143</sup> Copyright protection is available to useful articles only to the extent that the article's ornamental aspects are separable from its functional aspects.<sup>144</sup> The separability test is often unpredictable and different circuits utilize numerous tests.

Design patents pose a similar issue as copyrights; they only protect new and ornamental designs where the ornamental aspect of the design is not “primarily dictated by functional considerations.”<sup>145</sup> The current backlog in the United States Patent and Trademark Office is also a deterrent to relying on patents for protection.<sup>146</sup> Trademarks and trade dress, while often a good option for the fashion industry, do not adequately protect the furniture industry due to the fact that only a handful of designs serve as source identifiers for furniture manufacturers.<sup>147</sup>

The fashion industry's proposals for copyright reform provide helpful insights into strengthening intellectual property protection in

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<sup>142</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>143</sup> See 17 U.S.C. § 1302(4); 35 U.S.C. §§ 101–03; 15 U.S.C. § 1127.

<sup>144</sup> See 17 U.S.C. § 102 (2010).

<sup>145</sup> Robins & Staba, *supra* note 20.

<sup>146</sup> See United States Patent and Trademark Office, Patents Dashboard, *supra* note 21.

<sup>147</sup> See Hicks, *supra* note 22.

the furniture industry. Recent proposals to Congress, such as H.R. 2196 and S. 3728, could be adapted to the furniture industry to help close the industry's gap in intellectual property protection and preserve the incentive for the furniture industry to invest in creating original designs. In order to revitalize the furniture industry and protect its original and innovative designs, the furniture industry should become fashion-forward.

