

Copyright—A Copyright Holder's Protection May Not, By Use of the Ordinary Observer Test, Be Extended to Cover Ideas. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971).

Plaintiff and defendants are engaged in the design and manufacture of jewelry. Rosenthal charged that the Kalpakians were infringing his copyright of a jewelry pin in the shape of a gold, jewel-encrusted bee. In settlement of that dispute, the parties entered into a consent decree which provided that the plaintiff's copyright was valid, that defendants had made a jeweled bee pin allegedly similar to plaintiff's, and that defendants were enjoined from infringing plaintiff's copyright. Rosenthal subsequently filed a motion in the Federal District Court for an order holding defendants in contempt of the decree. The motion was denied on the grounds that defendants did not infringe the plaintiff's copyright nor violate the consent decree. The court found that defendants had not copied plaintiff's design. The defendants' design was a product of an independent study of bees as natural creatures and was not substantially similar to plaintiff's design. Rosenthal maintained on appeal that his copyright protected him from the manufacture and sale by others of any object, which to the ordinary observer,¹ was similar in appearance to his jeweled bee pin. The appellate court rejected this contention and affirmed the holding of the district court.²

The significance of this decision lies in the fact that the court went beyond the affirmation of no copying to a determination that the plaintiff's copyright should not receive protection.³ The court noted that copyright registration does not give an exclusive right to an idea or

1. The ordinary observer test is commonly used to determine similarity in copyright infringement actions and was first stated in *Daly v. Palmer*, 6 F. Cas. 1132, 1138 (No. 3552) (C.C.S.D. N.Y. 1868). It was held that to determine similarity a court should see whether the works in question were ". . . recognized by the spectator, through any of the senses to which the representation is addressed, as conveying substantially the same impressions to, and exciting the same emotions in, the mind"

This test is used in the Second and Ninth Circuits. *See, e.g., Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315 (2d Cir. 1969); *Williams v. Kaag Mfgs., Inc.*, 338 F.2d 949 (9th Cir. 1964). Some writers feel that this test has almost uniform acceptance in the copyright field since the majority of infringement cases arise in these two circuits. Note, *Current Tests of Similarity In Infringement Proceedings*, 10 WM. & MARY L. REV. 186 (1964).

2. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 739 (9th Cir. 1971).

3. The court stated:

Although . . . evidence would support a finding that defendants' bees were their own work, rather than copied from plaintiff's, this resolution of the problem is not entirely satisfactory, particularly in view of the principle that copying need not be conscious, A finding that defendants copied plaintiff's pin in this sense, however, would not necessarily justify judgment against them.

Id. at 741.

conception, but rather, only to a particular expression of the idea.⁴ Reviewing the evidence presented,⁵ the court found that Rosenthal's idea of a jewel-encrusted bee and the expression of that idea were indistinguishable.⁶

In cases where an idea has only one expression, or at best a very limited number of expressions, the copyrighted expression has been given little or no protection lest the underlying idea also receive protection.⁷ For example, in *Baker v. Selden*⁸ the court denied copyright protection for an illustration of a new bookkeeping system. It held that where the idea cannot be used without employing the illustration, the illustration, as well as the idea, is non-protectible.⁹ Likewise, *Continental Casualty Co. v. Beardsley*¹⁰ held that a copyright covering forms used in an insurance policy could not protect the copyright holder against a use of the forms which was merely incidental to the use of the underlying idea.

The court of appeals pursued its examination of the reasons why Rosenthal's pin should not receive protection with an analysis of the extent of the copyright holder's monopoly.¹¹ This was a result of the court's concern for the preservation of the balance between competition and protection reflected in the patent and copyright laws.¹² The copyright laws are designed to promote competition among the public in the use of ideas. Thus an author cannot receive protection for a new idea because this would withdraw it from the public's use.¹³ A copyright protects only the author's particular original expression of the idea, not the idea itself.¹⁴ In contrast, a patent holder can receive protection for an idea. A patent excludes other persons from "making, using, or sell-

4. *Id.*

5. The court pointed to the testimony of the defendants' witnesses that the arrangement of jewels in the pin was dictated by its size and form. This refuted plaintiff's contention that the special arrangement was the pin's original expression. The court also noted that plaintiff's counsel could not think of an expression of a jeweled bee other than that used by the plaintiff. *Id.* at 740.

6. *Id.* at 742.

7. See *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967).

8. 101 U.S. 99 (1879).

9. *Id.* at 103.

10. 253 F.2d 702, 706 (2d Cir. 1958). The idea in this case was a type of insurance coverage.

11. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971).

12. *Id.*

13. *Eichel v. Marcin*, 241 F. 404, 410 (1913).

14. *Mazer v. Stein*, 347 U.S. 201, 217 (1953). This was a landmark decision in which the copyright holder was seeking protection against infringement for a statuette of a dancer which served as a lamp base. The court held for the plaintiff and thus established judicial authority for the copyrightability of works of artistic craftsmanship. M. NIMMER, *NIMMER ON COPYRIGHT* § 19.3, at 87 (1971).

ing" the patented invention.¹⁵ The patentee is thus effectively protected from competition and granted a monopoly in the use of his idea.¹⁶ Because of the effect on competition, the patent applicant must meet stiff criteria to secure protection,¹⁷ whereas the copyright applicant only has to meet minimal registration requirements.¹⁸ Thus, the court felt that if it allowed Rosenthal protection for his pin, he would, in effect, receive patent rights while only having to meet the minimal copyright registration requirements.¹⁹

To avoid overprotection for Rosenthal the court of appeals denied him the use of the ordinary observer test to establish infringement. Under that test Rosenthal's copyright would be infringed if, to the ordinary observer, the works were substantially similar. Because ideas may not be protected by copyright,²⁰ the first issue for the court is whether the work is an unprotectible idea or a protectible expression of that idea, not whether the works in question are similar. The ordinary observer test does not resolve that issue.

The *Rosenthal* court did not seem to be questioning the validity of the ordinary observer test but rather its proper use. The purpose of the ordinary observer test is to ascertain if the similarity between the works in question is substantial enough to constitute copying.²¹ It thus is properly used to determine similarity after the question of infringement has been reached.²² But it tends to complicate the difficulty of separating ideas and expression. Rather than allowing the trier of fact to dissect and examine the various elements of the work in question, this test forces him to judge protectibility solely on the basis of his overall impression of the work.²³ Viewing the total work may veil the overlap between ideas and their expression, especially in the area of applied arts.²⁴

15. Patent Act, 35 U.S.C. § 154 (1970). "Invention" consists of the conception of an idea. *Seymour v. Ford Motor Co.*, 44 F.2d 306, 308 (1930).

16. Pogue, *Borderland—Where Copyright and Design Patent Meet*, 52 MICH. L. REV. 33, 36 (1953).

17. A patent applicant must show a novelty in his invention, and the subject-matter of the invention must not be obvious to persons in the field in which the invention is to be applied. Patent Act, 35 U.S.C. §§ 102, 103 (1970).

18. The copyright applicant only has to publish his work with notice of copyright and deposit two copies with the Register of Copyrights. Copyright Act, 17 U.S.C. §§ 10, 13 (1970).

19. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 740 (9th Cir. 1971).

20. *Mazer v. Stein*, 347 U.S. 201 (1953).

21. M. NIMMER, *NIMMER ON COPYRIGHT* § 143.51, at 634 (1971).

22. Comment, *Copyright Protection for Mass-Produced Commercial Products: A Review of the Developments Following Mazer v. Stein*, 38 U. CHI. L. REV. 807 (1971).

23. *Id.* at 813.

24. This is a term for works of artistic craftsmanship which are defined in 37 C.F.R. § 202.10(a) (1959). "This class includes . . . works of artistic craftsmanship, . . . such as artistic jewelry, enamels, glassware, and tapestries"

By using the idea-expression dichotomy and first determining if the work of applied art is protectible, the court of appeals may have been questioning the soundness of the expansion of copyright in this area. After the decision in *Mazer v. Stein*²⁵ established authority for copyrighting works of applied art, the number of works in this area receiving copyright registration rapidly increased.²⁶ The scope of the works included in this increase was broad, ranging from designs printed on dress fabrics²⁷ to a three-dimensional plastic Santa Claus;²⁸ from dinnerware patterns²⁹ to artistic jewelry boxes.³⁰ Some authorities, however, questioned the extension of copyright protection into this area. Justice Douglas, dissenting in *Mazer v. Stein*,³¹ felt that works in this area were not "writings" as contemplated by the Constitution³² and thus should not be copyrighted. More recently, a commentator suggested that works in the applied arts area should not be copyrighted because there is a greater possibility for ideas to receive protection.³³

Prior to *Rosenthal*, the idea-expression distinction had not been used to deny protection to works in this area,³⁴ although it had been

25. 347 U.S. 201 (1953).

26. M. NIMMER, *NIMMER ON COPYRIGHT* § 19.3, at 87 (1971). Prior to *Mazer v. Stein*, 347 U.S. 201 (1953), Copyright Office Regulations had indicated that only works of fine art were to receive protection. *Id.*

27. *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F. Supp. 334 (S.D.N.Y. 1960).

28. *Doran v. Sunset House Distrib. Corp.*, 197 F. Supp. 940 (S.D. Cal. 1961).

29. *Syracuse China Corp. v. Stanley Roberts, Inc.*, 180 F. Supp. 527 (S.D.N.Y. 1960).

30. *Dan Kasoff, Inc. v. Gresco Jewelry Co.*, 204 F. Supp. 694 (S.D.N.Y. 1962).

31. 347 U.S. 201 (1953) (dissenting opinion).

32. U.S. CONST. art. I, § 8, states:

The Congress shall have Power To promote the Progress of Science and useful Arts, by securing for limited Times to authors and Inventors the exclusive Rights to their respective writings and Discoveries.

33. Comment, *Copyright Protection for Mass-Produced Commercial Products: A Review of the Developments Following Mazer v. Stein*, 38 U. CHI. L. REV. 807, 810 (1971). Solid, two- or three-dimensional works of art such as designs on fabrics or jewelry cannot be easily broken into their component parts so that they can be analyzed from an idea-expression standpoint.

34. However, some courts had denied protection on the ground that the object in question did not constitute a "work of art" as required by the copyright statute. Copyright Act, 17 U.S.C. § 5(g) (1970). Where copyrightability was denied on this basis, there was usually a finding that the work failed to meet one or more of three criteria: (1) the work lacked creativity, *Bailie v. Fisher*, 258 F.2d 425 (D.C. Cir. 1958); 37 C.F.R. § 202.10(b) (1959); (2) the work lacked originality in the sense that it was not the original product of the copyright holder, *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 782 (S.D.N.Y. 1968) (criteria is not expressly stated in the copyright statutes, but inferred by the courts); (3) the work's sole function was utility, *Vacheron & Constantin-LeCoultre Watches, Inc. v. Benrus Watch Co.*, 155 F. Supp. 932, 934 (S.D.N.Y. 1957); 37 C.F.R. § 202.10(c) (1959).

These requirements have not been a significant restraint on the expanding copyrightability of applied arts. The amount of creativity required to meet the criterion is minimal, M. NIMMER,

used frequently to bar protection in the area of writing copyright.³⁵ A possible explanation for the infrequent use of the idea-expression distinction in applied art cases is the extreme difficulty in its application.³⁶ In two recent applied art cases, for example, this distinction was presented, and yet neither court discussed the problem. In *Herbert Rosenthal Jewelry Corp. v. Grossbardt*,³⁷ the plaintiff was seeking protection under his copyright for a jewelry pin in the shape of a turtle. The defendants contended that their attorney had advised them that the plaintiff's work was a non-protectible idea and could be copied by anyone. Nevertheless, a preliminary injunction was issued prohibiting them from making or selling copies of plaintiff's pin;³⁸ the idea-expression aspect was not mentioned. In a Ninth Circuit infringement action³⁹ in 1970, even though the district court had felt that plaintiff was seeking protection for an idea in a part of his work, the court of appeals decided the case on the basis of copying without considering the question of protectibility.

The *Rosenthal* decision makes clear that the Ninth Circuit now regards the question of whether a work should receive copyright protection of fundamental importance in infringement actions. This decision evidences a change from the approach taken in some previous cases in which courts have treated only the infringement question without examining copyrightability.⁴⁰ This change may have been prompted by a concern that many ideas are presently receiving protection, thus upsetting the balance between competition and protection. If the Ninth Circuit's approach is followed, one can look for a closer examination of copyright protection for works of applied art, with some resulting check of the expansion of copyright in this area.

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NIMMER ON COPYRIGHT § 19.1, at 85 (1971), and originality has been held to mean no more than "a prohibition against actual copying," *Rushton v. Vitale*, 218 F.2d 434, 435 (2d Cir. 1955). The copyright regulation pertaining to utility is not often applicable since the design of few works of applied art is dictated by utility. Comment, *supra* note 22, at 812.

35. See *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967); *Crume v. Pacific Mut. Life Ins. Co.*, 140 F.2d 182 (7th Cir. 1944).

36. Comment, *supra* note 22, at 810.

37. 428 F.2d 551 (2d Cir. 1970).

38. *Id.* at 553.

39. *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970).

40. *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 428 F.2d 551 (2d Cir. 1970); *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970).