

Courts Clarify Copyright And Trademark Rights In Furniture Cases

Furniture World
October 5, 2010



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Furniture designers interested in protecting their intellectual property rights should be aware of two recent federal appeals court decisions that clarify the scope of protection that may be available. In one, the court granted copyright protection to the ornamental designs adorning two popular furniture lines. In the other, the court refused protection under trademark law for a functional feature of a chair design, while leaving open the possibility that such protection is available in appropriate circumstances.

Copyright

In late August 2010, the U.S. Court of Appeals for the Fourth Circuit affirmed a judgment of more than \$11 million in favor of Universal Furniture International and against Collezione Europa USA, in a copyright infringement case involving Universal's Grand Inheritance Collection (GIC) and English Manor Collection (EMC). The decision provides useful guidance for designers hoping to obtain protection under U.S. copyright laws. Readers unfamiliar with the basic tenets of copyright law as applied to utilitarian articles may wish to read our earlier article entitled "Copyright Protection in the Furniture Industry", available at <http://bit.ly/a0dgME>. For the moment, recall that when it comes to useful articles, protection is only available for original designs that are conceptually separable from the function of the useful article.

The court first focused on the originality of Universal's designs. The GIC and EMC collections are highly ornate collections adorned with three-dimensional designs of shells, ancthus leaves, columns, finials, rosettes and other carvings. The designer, Steven Russell of the Norman Heckler design firm, consulted various source materials, modified them, and created something that he deemed to be both aesthetically pleasing and "offering modernized interpretations of historical pieces of furniture." An expert witness hired by Universal opined that Russell collected and sorted, synthesized, and, in some cases, made artistic leaps to join vastly different periods together, all in a manner requiring a great deal of training, experience, and artistry. The court accepted this testimony as proof that Russell had done more than simply copy public domain designs. He succeeded in modifying and arranging the decorative elements in unique ways that more than sufficed to satisfy the low threshold for originality required for copyright protection.

Key to this successful result was the manner in which Universal described its "copyrighted work" in the copyright application. Rather than using a generic description like "furniture line," Universal focused on the aesthetic features and described the work as "decorative sculptural designs on furniture; adaptation of preexisting decorative designs; compilation of decorative designs on suites of furniture."

Having found sufficient originality, the court then focused on the conceptual separability of the aesthetic design from the utilitarian furniture pieces. This concept, which "often sounds more like metaphysics than law," arises from Section 101 of the Copyright Act, which states that "the design of a useful article . . . shall be considered . . . a sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." The conceptual separability test is conjunctive, requiring the court to find both that the design elements are capable of separate identification and that they are capable of existing independently of the utilitarian aspects of the furniture.

Since the industrial design of a piece of furniture is not copyrightable, regardless of how aesthetically pleasing it may be, Universal sought to protect ornamentation applied to an industrial design that added nothing to its function. The court likened this to an ornamental belt buckle where the design displayed on the buckle is unnecessary to the function of the belt. In this case, Universal's furniture served as a vehicle for the display of Russell's designs, which were superfluous, non-functional adornments. They were not included to enhance the function of the furniture but simply to "give it a pretty face." In other words, the designs were capable of separate identification.

If you haven't yet seen the metaphysical, imagine the designs described earlier existing independently of the furniture on which they are applied. Therein lays the uncertainty created by the requirement that the designs be capable of independent existence. Fortunately, the court chose not to view the test so literally, noting that "the test is conceptual separability, not physical separability." It is enough that the designs can be identified separately from the utilitarian article--that "they can be conceived of as having been added to, or superimposed upon, an otherwise utilitarian article." As a result, the judgment awarding Universal over \$11 million in damages was affirmed. This case stands as a stark reminder of the considerations that must factor in the design process if copyright protection is a goal, and the importance not only of registering copyrights, but also ensuring that those registrations cover matter that can be protected.

Trademark/Trade Dress

A particular aspect of a product design, or even the configuration of the product itself, may be protected as a trademark or trade dress. And while patent and copyright protection is finite, trademark and trade dress protection can last for as long as a product is sold. Also in August 2010, the Seventh Circuit Court of Appeals entertained an attempt by Greenwich Industries, L.P., d/b/a Clarin, to enforce a trademark registration for the "X-frame" design visible on the side of its folding chairs. Clarin's registration was ruled invalid, but the court made some important points for furniture designers to consider in marketing their products if trade dress protection is a goal.



Trademarks function as indications of the origin of products or services with which they are used. Trade dress, a subset of trademarks, covers such things as packaging and product design. As with copyright law, trademark law does not protect purely functional elements of a design. Since virtually all products perform some utilitarian function, courts do not presume that product

designs function as a trademarks. Instead, protection is only available for designs that acquire secondary meaning. Secondary meaning develops over time as consumers come to view the design not as merely an aesthetic feature, but as an indication that the product comes from a single source. Perhaps the most famous example of trade dress that acquired secondary meaning is the iconic Coca-Cola bottle. While such an association may develop over time as a result of substantial sales and public recognition, the designer can be proactive in engendering secondary meaning by highlighting the source-indicating function of the design in her marketing and advertising.

Clarín did everything wrong in trying to establish that the X-frame design was nonfunctional and had, in fact, acquired secondary meaning. The court looked at the chair and found that it was designed to be a better chair and not a better way of identifying the source of the chair. Each of the chair's features was chosen for a utilitarian purpose (e.g., to make it a stronger but lighter chair). The court mused that if Clarín's chair had, for example, a cutout in the backrest or a distinctive pattern, those features may have been protectable. Sadly, the X-frame chair lacked any distinctive, non-functional features and its trademark registration was held invalid. It did not help matters that the chair was covered by four utility patents. Aspects of a furniture design that are covered by utility patents are presumptively considered functional, meaning the elements are ineligible for trademark protection.

Clarín's case may have been hopeless, but by implementing an appropriate marketing strategy from the start, other designers may succeed in obtaining trademark or trade dress protection for elements of furniture design. Advertising and promotional content can either make or break the case for secondary meaning and, thus, trade dress protection. Materials touting the product design's utilitarian advantages will likely be viewed as evidence that the design is purely functional and unprotectable. However, marketing and 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. For example, a furniture designer may promote its new furniture line with advertisements encouraging the public to "look for" a specific feature. This is a highly technical area of law and a designer who is interested in trademark or trade dress protection should consult with intellectual property counsel as early in the design process as possible.