

The Utility of a Bright-line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in *Leicester v. Warner Bros.*¹

John B. Fowles*

Lex non exacte definit, sed arbitrio boni viri permittit[?]²

I. INTRODUCTION: WISDOM AND OBJECTIVITY IN COPYRIGHT ADJUDICATION

Judges must be wise; they should consider the wide field of human experience available through their own particular circumstances when adjudicating. Luckily, then, in this “post-modernist, post-structuralist” period, a judge may “resourcefully and opportunistically borrow whatever tools might be available to solve particular problems at hand.”³ But does this also mean that judges should necessarily “be con-

* Associate, Snell & Wilmer, L.L.P.; B.A., Brigham Young University; M.St., University of Oxford; J.D., J. Reuben Clark Law School, Brigham Young University

¹ 232 F.3d 1212 (9th Cir. 2000).

² 4 WILLIAM BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND *217 (quoting Hugo Grotius (1583-1645) on equity) (“The law does not define exactly, but leaves something to the discretion of a just and wise judge.” Translation of <http://www.la.utexas.edu/research/poltheory/blackstone/cle.int.s02.html>. Last visited March 22, 2004.).

³ Sanford Levinson & J.M. Balkin, *Law, Music, and Other Performing Arts*, 139 U. PA. L. REV. 1597, 1604 (1991); see also Wendell L. Griffen, *The Role and Influence of Religious Value in Judicial Decisionmaking: A Normative Perspective*, 81 MARQ. L. REV. 513, 518 (1997) (“Judges must be open-minded to all sources of truth if we are to be competent deliberators of the value-laden issues brought for our decision. We are free to hear the voices of religious values, mathematical principles, classical literature, popular music, and quotations by Sherlock Holmes in our effort to understand the issues we must consider. This is another way of saying that judges are free to hear the voices of William Shakespeare, Sir Arthur Conan Doyle, John Locke, Robert Browning, Johann Wolfgang von Goethe, Oliver Wendell Holmes, Moses, Jesus, Sojourner Truth, Frederick Douglass, and Martin Luther King, Jr., without embarrassment or hesitation as we deliberate.”).

scious of aesthetics when deciding copyright cases,”⁴ as intuitive as such a proposition might seem? Truly, copyright cases turn on the originality of expression in an ostensible work of art. But reliance on aesthetic understanding—or lack of it—in deciding some copyright cases could also lead judges to sink deeper into a “quagmire of conceptual separability”⁵ in their efforts to protect pictorial, graphic, or structural works of art (PGS works) that have been incorporated into works of architecture. The court in *Leicester v. Warner Bros.* correctly recognized Congress’s intention in the Architectural Works Copyright Protection Act of 1990⁶ (AWCPA) to avoid this morass of conceptual separability and its intrinsic aesthetic controversy—which arise from the lack of architectural substance in the Copyright Act of 1976—by enforcing a bright-line rule that spares judges from entering this common-law quagmire in the first place.

The undeniable reality that “copyright law simply requires aesthetic choices”⁷ speaks against an objective approach to copyright adjudication. Personal bias colors the individual’s perception of every situation. In fact, precisely the same post-modernist, post-structuralist environment that generally allows a *bricoleur*⁸ judge in the courtroom also necessarily prevents objectivity in today’s permanently fragmented society.⁹ Part II of this Article emphasizes the aesthetic difficulties inherent in a copyright jurisprudence that claims objectivity, discussing in detail the esoteric nature of the conceptual separability test(s) for divorcing a PGS work from the useful article—such as a work of architecture—of which it may be a part. Part III highlights Congress’s hope to replace this conceptual separability “conundrum”¹⁰ with a bright line

⁴ Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247 (1998) (suggesting that judges need “an overall understanding of art to make intelligent decisions” about copyright cases before them).

⁵ *Leicester.*, 232 F.3d at 1223 (Tashima, J., concurring).

⁶ Pub. L. No. 101-650, 701, 703 (codified in 17 U.S.C. §§ 101(5), 102(a)(8), 120 2004).

⁷ Yen, *supra* note 4, at 251.

⁸ Levinson & Balkin, *supra* note 3, at 1604-05 (discussing Claude Levi-Strauss’s views on interpretation).

⁹ STEPHEN BUNGAY, *BEAUTY AND TRUTH: A STUDY OF HEGEL’S AESTHETICS* 163 (1984) (Oxford Univ. Press) (“As modern society is complex and heterogeneous, it is not clear on what ethical principles it is based, or even if it is based on any at all that are accepted by all its citizens, rather than just a particular group.”). Hegel makes this ethical concern central to his assessment of aesthetics: the epic hero in literature is no longer possible, as exemplified by Goethe’s medieval knight Götz von Berlichingen or Cervantes’s Don Quixote, who personify a past order no longer compatible with—and frankly laughable compared to—“modern” society. GEORG WILHELM FRIEDRICH HEGEL, *Vorlesungen über die Ästhetik II*, in 13 *WERKE* 256-57 (Eva Moldenhauer and Karl Markus Michel, eds., 1970) (1830).

¹⁰ H.R. REP. NO. 101-735, at 20–21 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6950–51 (explaining that a “principal reason” for the AWCPA amendment to the Copyright Act of

rule in conjunction with the copyright protection extended to architectural works under the 1990 law. Part IV relates this statutory history to the facts of *Leicester* and applauds the *Leicester* court's careful and accurate construction of the AWCPA. Proceeding in this way, the Ninth Circuit adhered strictly to the legislative intent of eliminating conceptual separability from architectural copyright. The development of a bright-line rule in this copyright context is not without its advantages and disadvantages for architects and artists, as duly noted in Part IV. But Part V concludes that despite imperfections in the statute, the *Leicester* court's strict construction of the AWCPA's bright-line rule has saved judges from aesthetic controversy and conceptual separability in cases regarding the copyright of PGS works attached to architectural works.

II. AESTHETIC VS. USEFUL ARTICLES—OR USEFUL AESTHETIC ARTICLES?

A. *Embarking on Aesthetic Objectivity*

Although learned jurists, most common-law judges do not have a Ph.D. in aesthetics, philosophy, or literature. And yet, “the aesthetic nature of copyright reasoning would have to be characterized as profound because it constitutes a version of the most sophisticated aesthetic debates our culture knows.”¹¹ The conflation of these two premises leads to a prescriptive conclusion: judges *should not* rely on their own aesthetic tastes or understanding in copyright adjudication; or formulated positively, aesthetics *should be* immaterial in copyright jurisprudence.

Admittedly, judges in early copyright cases took for granted that they had to make aesthetic choices in enforcing copyright protection. For example, in *Burrow-Giles Lithographic Co. v. Sarony*,¹² the Supreme Court found that a photograph of Oscar Wilde fulfilled the originality requirement of copyright protection¹³ because it was “useful,

1976 adding architecture as a new category of protected subject matter was to free the courts from the “separability conundrum presented by the useful articles doctrine.”).

¹¹ Yen, *supra* note 4, at 252. Professor Yen's frank and skillful assessment of the role of aesthetics' inevitability in copyright adjudication in his seminal article on *Copyright Opinions and Aesthetic Theory* informs this investigation of the Ninth Circuit's holding in *Leicester v. Warner Bros.* and the AWCPA's bright-line rule generally.

¹² 111 U.S. 53 (1884).

¹³ *Id.* at 59 (holding that the author must prove “the existence of those facts of originality, of intellectual production, of thought, and conception on the part of the author” when suing for violation of copyright). Congress reiterated the dispositive role of originality in copyright in the 1976 amendments to the Copyright Act: “The two fundamental criteria of copyright protection—originality and fixation in tangible form—are restated in the first sentence of

new, harmonious, characteristic, and graceful.”¹⁴ Essentially, the *Burrow-Giles* Court performed an aesthetic valuation to determine copyrightability. Perhaps the possibility of a Burkean¹⁵ or Kantian¹⁶ regime of objective aesthetics—as opposed to the current insistence on aesthetic objectivity¹⁷—still persisted in copyright jurisprudence at the end of the nineteenth century. But by the beginning of the twentieth century, courts distanced themselves from the appearance of aesthetic subjectivity in their copyright adjudications, as reasoned by Justice Holmes in *Bleistein v. Donaldson Lithographic Co.*¹⁸ Finding circus advertisements copyrightable even though they had not been traditionally identified with the fine arts—or in other words, they had not been *officially* viewed as aesthetically beautiful—Justice Holmes enshrined a mandate of aesthetic objectivity for judges in copyright cases: “It would

this cornerstone provision [17 U.S.C. § 102 (1976)].” H.R. REP. NO. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664.

¹⁴ *Burrow-Giles*, 111 U.S. at 59.

¹⁵ EDMUND BURKE, *A PHILOSOPHICAL ENQUIRY INTO THE ORIGINS OF OUR IDEAS OF THE SUBLIME AND BEAUTIFUL* (James T. Boulton ed., University of Notre Dame Press 1968) (1757) (arguing for the existence of an objective aesthetic ideal that affects the mind from without). In his *Enquiry* Burke theorizes:

Beauty is a thing much too affecting not to depend upon some positive qualities. And, since it is no creation of our reason, since it strikes us without any reference to use, and even where no use at all can be discerned, since the order and method of nature is generally very different from our measures and proportions, we must conclude that beauty is, for the greater part, some quality in bodies, acting mechanically upon the human mind by the intervention of the senses.

Id. pt. 3 § 12, at 112. In discussing this process, Burke summarizes the objective characteristics of this aesthetic ideal:

On the whole, the qualities of beauty, as they are merely sensible qualities, are the following. First, to be comparatively small. Secondly, to be smooth. Thirdly, to have a variety in the direction of the parts; but fourthly, to have those parts not angular, but melted as it were into each other. Fifthly, to be of a delicate frame, without any remarkable appearance of strength. Sixthly, to have its colours clear and bright; but not very strong and glaring. Seventhly, or if it should have any glaring colour, to have it diversified with others. These are, I believe, the properties on which beauty depends; properties that operate by nature, and are less liable to be altered by caprice, or confounded by a diversity of tastes, than any others.

Id. § 18, at 117. Twentieth-century, post-Hegelian aesthetic theory has no room for such universality. *See* BUNGAY, *supra* note 9, at 163.

¹⁶ *See generally* IMMANUEL KANT, *THE CRITIQUE OF JUDGMENT* (1790).

¹⁷ There is a semantic distinction between an objective aesthetics and aesthetic objectivity. The former refers to the Burkean or Kantian projects, largely discredited in a multi-cultural, pluralistic world in which diversity is of paramount importance. The latter—*aesthetic objectivity*—refers to the avoidance of subjective aesthetic tastes in making determinations, which, like an objective aesthetics, actually does not exist. *See supra* text accompanying notes 7–9. Despite the impossibility of such aesthetic objectivity, courts still strive for it in the balancing they must do in copyright adjudication. *See infra* text accompanying notes 18–32.

¹⁸ 188 U.S. 239 (1903).

be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”¹⁹ This determination is rooted in the policy considerations behind copyright protection.

Copyright law revolves around the central policy debate between protecting authors’ rights to intellectual property and users’ rights. In truth, copyright facilitates both:

After more than two hundred years, copyright law in the United States has not moved one degree from its central purpose: to promote the nation’s culture and learning by encouraging authorship of original literary and artistic works. From the start, copyright has promised authors and their publishers protection for the product of their labors, and at the same time has ensured them the freedom they need to borrow from the works of authors who precede them.²⁰

Indeed, copyright in the United States has followed a path that protects authors’ rights in their creations for the purpose of enabling public use of the works. “The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”²¹ This justifies the “limited statutory monopoly”²² granted by the Copyright Act of 1909 in *Twentieth Century Music*.

Congress’s decision to protect authors’ rights in original works only during the time period specified in the Copyright Act²³ produced this limited statutory monopoly. Essentially, in 1834, the Supreme Court in *Wheaton v. Peters* determined that in passing the Copyright Act of 1790, Congress had *created* a right in authors to their works,

¹⁹ *Id.* at 251-52. Justice Holmes goes on here to clarify the policy behind this mandate of objectivity:

At one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they commanded the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt.

In this vein, Professor Yen notes that “the inherent ambiguity of aesthetics is considered incompatible with the supposedly objective rules and principles that govern judicial opinions” in copyright adjudication. Yen, *supra* note 4, at 248.

²⁰ 1 PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK, AND RELATED STATE DOCTRINES: CASES AND MATERIALS ON THE LAW OF INTELLECTUAL PROPERTY liii (2d ed. Supp. 2001).

²¹ *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

²² *Id.*

²³ The Copyright Act of 1790 protected author’s works for fourteen years after publication. Copyright Act, Ch.15, § 1, 1 Stat. 124 (1790).

“instead of sanctioning an existing right. . . .”²⁴ Thus, utilitarianism supports U.S. copyright theory rather than an approach emphasizing the natural rights of the author in his or her work.²⁵ By choosing this philosophy in the debate between protecting authors’ rights and users’ rights, the *Wheaton* Court followed the dissent in the seminal case construing the first statutory copyright law, the English Statute of Anne.²⁶ In one of the earliest Anglo-American copyright cases, Judge Yates dissented in the 1769 case of *Millar v. Taylor*, reasoning that

[t]he labours of an author have certainly a right to a reward: but it does not from thence follow, that his reward is to be infinite, and never to have an end. Here, it is ascertained. The Legislature have fixed the extent of his property: they have allowed him twenty-eight years; and have expressly declared, he shall have it no longer. Have the Legislature been guilty of injustice? Little cause has an author to complain of injustice, after he has enjoyed a monopoly for twenty-eight years, and the manuscript still remains his own property.²⁷

Informed by this dissenting opinion, the *Wheaton* Court cemented the U.S. congressional copyright posture favoring the economic rights of the author as limited by the statutory time period.

This focus on the economic rights of the author during the statutory time period renders Justice Holmes’s objectivity mandate in *Bleistein* particularly cogent for protecting these rights. Not only does this theory of copyright tend to result in “ranking aspects of human activity,” because it is “society’s way of stating how it values certain contributions by its citizens,”²⁸ but also through it, “[t]he possibility of censorship arises because copyright does not protect all works. . . .”²⁹ Therefore, this utilitarian approach can lead to government censorship, despite Justice Holmes’s warning. This happens because “when courts interpret the contours of copyrightable subject matter, they single out

²⁴ 33 U.S. (8 Pet.) 591, 661 (1834). In support, the Court reasoned as follows:

That congress, in passing the act of 1790, did not legislate in reference to existing rights, appears clear, from the provision that the author, &c. [sic] “shall have the sole right and liberty of printing,” &c. [sic]. Now if this exclusive right existed at common law, and congress were about to adopt legislative provisions for its protection, would they have used this language? Could they have deemed it necessary to vest a right already vested. [sic] Such a presumption is refuted by the words above quoted, and their force is not lessened by any other part of the act.

²⁵ See GOLDSTEIN, *supra* note 20, § 1.13.2.3 (“Natural rights theory extends copyright protection automatically—as a matter of right—to every new form of literary and artistic work and against every new use that is made of these works.”).

²⁶ 8 Ann. c. 19 (1710) (Eng).

²⁷ *Millar v. Taylor*, 98 Eng. Rep. 201, 232 (K.B. 1769) (Yates, J., dissenting).

²⁸ Melissa M. Mathis, Note, *Function, Nonfunction, and Monumental Works of Architecture: An Interpretive Lens in Copyright Law*, 22 CARDOZO L. REV. 595, 600 (2001).

²⁹ Yen, *supra* note 4, at 248.

certain works for a special economic subsidy”; that is, “people whose aesthetic sensibilities differ from the aesthetic sensibilities of judges might have difficulty finding or creating art that they [the judges] prefer.”³⁰ Realization of this possibility influenced Justice Holmes’s statement in *Bleistein*, illustrated with reference to Goya and Manet,³¹ and refocused courts’ attention toward applying the law blindly—or objectively. This understanding also led to the belief that “[i]f judges avoid considering aesthetics in copyright cases, aesthetic censorship seems logically impossible.”³² Unfortunately the solution is not that easy due to the impossibility of objectivity in aesthetic reasoning.

Although impossible, judges still do their best to achieve objectivity in copyright reasoning. Nevertheless, this effort is a process of self-denial because “the distinction between aesthetic reasoning and legal reasoning is illusory.”³³ Moreover,

[j]udges seem quite conscious of the dangers identified with aesthetic reasoning and therefore use legal reasoning to derive their conclusions. Nevertheless, the analytical premises of copyright opinions are practically identical to those of major aesthetic theories. Copyright law develops as judges change the premises governing interpretation of the law. . . . The new premises seemingly eliminate the controversy by directing judicial attention away from the aesthetically troubling determinations existing precedent requires. . . . It is simply a matter of time until the unanticipated nuances of future cases draw the courts back into aesthetic controversy.³⁴

Admittedly, this process appears complex and counterintuitive at first. But it shows that even insisting upon aesthetic objectivity in copyright adjudication does not avoid the problem of *de facto* judicial subsidization³⁵ of certain works of art over others. Rather, it merely covers overt judicial aesthetic subsidization—as was possible before *Bleistein*—with legal reasoning that may appear objective, but which actually still effects judicial bias from a subconscious level, “because copyright law simply requires aesthetic choices.”³⁶ Therefore, despite

³⁰ *Id.* at 249.

³¹ *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239, 251-52 (1903).

³² *Yen*, *supra* note 4, at 249.

³³ *Id.* at 249.

³⁴ *Id.* at 250.

³⁵ *See id.* at 248–49; *see also supra* text accompanying note 30.

³⁶ *Id.* at 250. Although indeed complex, this process is quite natural because it is a means of avoiding the problem that exacerbates the problem:

Judges [in copyright cases] do not overrule existing precedent when they adopt new analytical perspectives. Analytically inconsistent cases therefore exist simultaneously as “good law.” This means that the precedent which governs new cases may be inconsistent, and that the outcome of a case could depend on the precedent a judge chooses to apply. To the extent that these inconsistencies parallel differences in aesthetic theories, the judi-

the appearance of objectivity, at least in copyright cases, the maxim *lex non exacte definit, sed arbitrio boni viri permittit*³⁷ can become dangerous. Justice Holmes acknowledged this notion in *Bleistein* by demanding objectivity in copyright adjudication. No matter how “good” the individual’s “judgment” is in such cases, the analytical framework chosen from which to apply legal principles to the facts of the given case will already entail an unconscious aesthetic determination that could result in subsidizing one form of aesthetic value over another. But the courts should not therefore shrink from copyright decisions; rather, a legislative bright-line rule can spare them from this danger.

B. *Drifting to PGS Separability*

Copyright protection enjoys Constitutional status. The Constitution invests Congress with the power “[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.”³⁸ But the way that Congress has subsequently chosen to secure authors’ rights in their own “writings” has put courts “adrift on the murky sea of common law”³⁹ regarding aesthetically pleasing, but useful, articles.

1. Separate but not equal: aesthetics and utility in PGS works.

In truth, Congress has not so much put judges adrift on a murky sea of common law as bogged them down in a “quagmire of conceptual separability”⁴⁰ through additions and amendments over the last 200 years to the 1790 Copyright Act.⁴¹ Although the aesthetic element in

cial selection of controlling precedent in a given case effectively becomes a choice among competing aesthetic theories. In short, judges necessarily show a preference for certain aesthetic perspectives when they decide cases because copyright law simply requires aesthetic choices.

³⁷ See BLACKSTONE *supra* note 2.

³⁸ U.S. CONST. art. I, § 8, cl. 8.

³⁹ *Columbia Hyundai, Inc. v. Carll Hyundai, Inc.*, 484 S.E.2d 468, 470 (S.C. 1997) (employing the common-law-as-murky-sea metaphor in the context of contract law).

⁴⁰ *Leicester v. Warner Bros.*, 232 F.3d 1212, 1223 (9th Cir. 2000) (Tashima, J., concurring).

⁴¹ Act of May 31, 1790, ch. 15, 1 Stat. 124 (proclaiming that the “author or authors of any map, chart, book, or books. . . being a citizen or resident of the United States. . . shall have the sole right and liberty of printing, reprinting, publishing, and vending [the same] for the like term of fourteen years from the recording of the title thereof in the clerk’s office, as aforesaid”). True, with the passage of time, American copyright law has evolved to protect more forms of artistic creations under the constitutional mandate to protect “writings,” slowly keeping pace with “international expectations.” Clark T. Thiel, *The Architectural Works Copyright Protection Gesture of 1990, Or, “Hey, That Looks Like My Building!”*, 7 DEPAUL-LCA J. ART & ENT. 1, 35 (1996), but this development has also steadily brought the courts into closer proximity with the eventual conundrum of conceptual separability. The Court in

copyright cases complicated the slow expansion of copyright protection before the twentieth century, it was not until the Copyright Act of 1909 mentioned “works of art; models or designs for works of art”⁴² as copyrightable subject matter that a new confusion in copyright law arose through the distinction between fine arts and industrial arts. Sixty-six years of differentiating between these two types of creations through administrative statements and common-law solutions⁴³ led Congress to enact the Copyright Act of 1976,⁴⁴ which statutorily expanded copyright protection to pictorial, graphic, or structural works of art (“PGS works”),⁴⁵ detailing how they relate to “useful articles.”⁴⁶ But in defining PGS works, Congress clouded the waters with the words “identified separately”:

[PGS works] shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or 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.⁴⁷

True, Congress was merely hoping “to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted

Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 57-58 (1884) (holding a photograph to be a protected “writing” in the constitutional sense) begins to relate this development, listing two amendments to the Copyright Act; first, in 1802 to add etchings and engravings of an artist’s own work to the list of protected works, Act of Apr.29, 1802, Ch.36, §2, 2 Stat. 171; and second, again in 1831 to protect musical compositions and to extend the duration of copyright protection from fourteen to twenty-eight years, Act of Feb. 3, 1831, ch. 16, 4 Stat. 436. Three further expansions preceded the 1990 AWCPA amendments to the Copyright Act: first, the Copyright Act of 1870 granted protection to paintings, drawings, chromos, statues, statuaries, and “of models or designs intended to be perfected as works of the fine arts. . . .” Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (repealed 1916); second, the Copyright Act of 1909 added works of art and designs for works of art, Act of March 4, 1909, ch. 320, § 5(g), 35 Stat. 1075, 1077 (codified as 17 U.S.C. §§ 1-216 (1976)); and finally the Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as 17 U.S.C. §§ 101-810 (1976)), further broadened copyright protection of works of art, by “expand[ing] from an enumerated list to a general principle,” Todd Hixon, *The Architectural Works Copyright Protection Act of 1990: At Odds with the Traditional Limitations of American Copyright Law*, 37 ARIZ. L. REV. 629, 640 n.97 (1995).

⁴² Copyright Act, Ch. 320, § 5(g), 35 Stat. 1075, 1077 (1909).

⁴³ See, e.g., *Mazer v. Stein*, 347 U.S. 201 (1954).

⁴⁴ Copyright Act of 1976, Pub. L. No. 94-553 (codified as 17 U.S.C. §§ 101-810 (1976)).

⁴⁵ 17 U.S.C. § 102(a)(5) (2004).

⁴⁶ The Copyright Act of 1976 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.” 17 U.S.C. § 101 (2004).

⁴⁷ *Id.* (emphasis added).

works of industrial design,”⁴⁸ which may qualify for patent or trademark protection, while at the same time reassuring that “the definition of ‘pictorial, graphic, and sculptural works’ carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic quality.”⁴⁹ Indeed, the House Report attempts to insulate this process of separation from the invasion of judicial aesthetic bias by explaining that

although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an . . . industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from ‘the utilitarian aspects of the article’ does not depend upon the nature of its design—that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable.⁵⁰

But Congress’s goal of drawing a clear line between useful, utilitarian, or industrial articles and their inherently aesthetic qualities—or their “attached” PGS works in the case of architectural works—in the hope of creating an objective “test of separability” only partially succeeded. That is, in many courts, this congressional goal resulted in a relatively straightforward test of “physical separability”⁵¹; however, in others it spawned numerous common-law tests of “conceptual separability” instead.

2. Prelude to a storm: Early conceptual separability

Aesthetic controversy lurks in the multiplicity of conceptual separability tests that have surfaced to determine whether an aesthetic element of a useful article can gain copyright protection. Congress may have intended to razorblade a distinction between a useful article and its aesthetic features with its 1976 “test of separability” and its explanatory invitation to a physical or conceptual separability analysis; but the Second Circuit aptly noted in *Kieselstein-Cord v. Accessories by Pearl*,⁵²

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

⁴⁹ H.R. REP. NO. 94-1476, at 54 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5667.

⁵⁰ H.R. REP. NO. 94-1476, at 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668 (emphasis added).

⁵¹ GOLDSTEIN, *supra* note 20, § 2.5.3, at 2:64 (“Courts hold that a pictorial, graphic or sculptural feature incorporated in the design of a useful article is physically separated from the article without impairing the article’s utility and if, once separated, it can stand alone as a work of art traditionally conceived.”) Goldstein points out that the Copyright Office approaches these cases from this narrow construction of a combination of the “test of separability” and the House Report’s elaboration on it. *Id.* at 2:63.

⁵² *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989 (2d Cir. 1980).

an early conceptual separability case, that this distinction actually located such situations “on a razor’s edge of copyright law”⁵³ instead.

In *Kieselstein-Cord*, copyright protection was sought for decorative belt buckles boasting sculptural designs. Apparently, the high-priced belt buckles were used principally for decoration and some had even been accepted by the Metropolitan Museum of Art for its permanent collection.⁵⁴ The Second Circuit employed a primary/subsidiary test for conceptual separability, finding that the items’ *primary* aesthetic function was conceptually separable from their potential use as belt buckles, or their “*subsidiary* utilitarian function.”⁵⁵ This espousal of a primary/subsidiary approach played an important role when, five years later, the Second Circuit revisited copyrightable (or not) aesthetics in useful articles in *Barnhart v. Econ. Cover Corp.*,⁵⁶ forcing to the surface the aesthetic controversy beneath this area of copyright adjudication by identifying a “bottomless pit” of “vague test[s].”⁵⁷

C. *Sinking in Conceptual Subjectivity*

1. Lucky number seven: Aesthetic controversy in common-law conceptual separability

Numerous common-law conceptual separability tests followed Congress’s 1976 additions to the Copyright Act. Specifically, the new definition of a PGS work in § 101 of the Act and the House Report explaining § 101’s “identified separately” language both attempted to create a clear standard without providing sufficient guidance in how to apply it.⁵⁸

a. *Newman’s five: a morass of conceptual separability.* In *Barnhart v. Econ. Cover Corp.*, the court denied copyright protection to aesthetically pleasing mannequin torsos used for modeling clothes, despite the plaintiff’s argument that the mannequins could be—and had been—used sans clothing as window decorations because of their design.⁵⁹ The

⁵³ *Id.* at 990. And often, despite admirable efforts at objective analysis in copyright cases dealing with useful articles, an *argumentum ad iudicium* reveals the judge’s aesthetic opinion as an important factor. See also *supra* text accompanying notes 29–36 (discussing the illusory distinction between legal and aesthetic reasoning).

⁵⁴ *Kieselstein-Cord*, 632 F.2d at 991.

⁵⁵ *Id.* at 993 (emphasis added).

⁵⁶ *Barnhart v. Econ. Cover Corp.*, 773 F.2d 411 (2d Cir. 1985).

⁵⁷ *Id.* at 419 (noting that the dissent’s approach to conceptual separability and the list of other possible tests “only serves to underscore the bottomless pit that would be created by such a vague test.”) See *infra* Part II.C.1.a for an analysis of *Barnhart*.

⁵⁸ *Barnhart*, 773 F.2d at 420 (Newman, J., dissenting).

⁵⁹ *Id.* at 418. This posture has been curiously labeled as “a general retreat on the part of the Second Circuit regarding conceptual separability.” Michael A. Solomon, *The Copyright*

court reasoned that conceptual separability demanded that the articles be just as useful when fully divorced from any aesthetic elements; the mannequins here ceased to perform their function altogether when conceptually separated from their aesthetic—and even traditional—art form of the human torso.⁶⁰ Judge Newman dissented in *Barnhart* on the grounds that the majority had either misunderstood the “esoteric

of Useful Articles: ‘Conceptual’ Retreat in the Second Circuit, 52 BROOK. L. REV. 713, 729 (1986). True, the outcome in *Barnhart* was opposite of *Kieselstein-Cord*, but not necessarily because the *Barnhart* court “retreated” from the primary/subsidiary approach in *Kieselstein-Cord*. In short, Solomon argues that when the *Barnhart* court stated that “[n]or do we agree that copyrightability here is dictated by our decision in *Kieselstein-Cord*,” *Barnhart*, 773 F.2d at 418, the Second Circuit “distinguished” *Kieselstein-Cord* in the precedential sense. Solomon, *supra* at 728. Solomon acknowledges that the court referenced the *Kieselstein-Cord* test in the context of the *Barnhart* forms, *id.*, but he implies that this was merely lip-service to precedent, inexplicably concluding instead that “[t]he court seems to have relied on its own subjective belief that the forms could not be considered art,” and that it “appears to have ignored the precedential force of *Kieselstein-Cord* entirely.” *Id.* at 729. Solomon justifies this statement by magnifying the similarities between the *Kieselstein-Cord* dissent and the *Barnhart* majority. *Id.* at 730.

But a close reading of *Barnhart* suggests that the court did follow *Kieselstein-Cord* by applying the primary/subsidiary test. What “distinguished” *Barnhart* from *Kieselstein-Cord*, then, was not a *Barnhart* retreat from conceptual separability precedent, but rather that the useful article in *Barnhart*—the mannequins—failed the same primary/subsidiary test that the belt buckles in *Kieselstein-Cord* had passed:

What distinguishes those buckles from the *Barnhart* forms is that the ornamented surfaces of the buckles were not in any respect required by their utilitarian functions; the artistic and aesthetic features could thus be conceived of as having been added to, or superimposed upon, an otherwise utilitarian article. The unique artistic design was wholly unnecessary to performance of the utilitarian function. In the case of the *Barnhart* forms, on the other hand, the features claimed to be aesthetic or artistic, e.g., the life-size configuration of the breasts and the width of the shoulders, are inextricably intertwined with the utilitarian feature, the display of clothes.

Barnhart, 773 F.2d at 419. Far from retreating from conceptual separability, the *Barnhart* holding represents applied conceptual separability. The purpose of conceptual separability tests is to screen out from copyright protection any useful article that has no aesthetic element that can exist separately from the article’s utilitarian function. Closely read, when the *Barnhart* court stated that the holding in *Kieselstein-Cord* five years earlier need not “dictate” its decision in *Barnhart*, it meant that just because the belt buckles passed the test does not mean that the torsos must pass that test as well.

It may be true that after five years the court was willing to apply this primary/subsidiary test more narrowly than in *Kieselstein-Cord*, which had been “the most expansive interpretation of the statutory provisions regarding useful articles to date.” Solomon, *supra* at 720-21. And it is certainly true that to some extent the Second Circuit “relied on its own subjective belief that the forms could not be considered art,” *id.* at 729, because “no aesthetic perspective can be neutral and all-encompassing,” and therefore, “aesthetic bias becomes inherent in copyright decisionmaking because an aesthetic perspective must necessarily be chosen.” Yen, *supra* note 4, at 251. But this does not necessarily also mean that the court excluded established *Kieselstein-Cord* precedent in relying on this subjective aesthetic bias. Indeed, the impossibility of such objectivity is the focus of this Article.

⁶⁰ *Barnhart*, 773 F.2d at 419.

issue of conceptual separability” or applied the wrong standard.⁶¹ In defining conceptual separability as “esoteric,” the dissent implied that this concept is “communicated to, or intelligible by, the initiated exclusively.”⁶² Apparently the majority was uninitiated, so the dissent proceeded to survey five—of the presumably infinite (read “bottomless pit”⁶³)—“esoteric” standards.⁶⁴

Judge Newman admits that the “identified separately” language of § 101 of the Copyright Act of 1976 established an “elusive standard”⁶⁵ for deciding the copyrightability of useful articles. This ambiguity necessitated the proliferation of the conceptual separability tests which Judge Newman surveys in his dissent: (1) a *primary/secondary test*, (2) a *primary/subsidiary test*, (3) a *marketability test*, (4) a *sufficient aesthetic appeal test*, and (5) Judge Newman’s own *temporal displacement test*. First, in the primary/secondary test “an article used primarily to serve its utilitarian function might be regarded as lacking ‘conceptually separable’ design elements even though those design elements rendered it usable secondarily solely as an artistic work.”⁶⁶ Judge Newman found that this test potentially endangered the rights of a theoretical minority in cases where “the designs of works of art . . . are also used by a majority as useful articles.”⁶⁷

Second, the primary/subsidiary test hails from *Kieselstein-Cord*, “uphold[ing] the copyright whenever the decorative or aesthetically pleasing aspect of the article can be said to be ‘primary’ and the utilita-

⁶¹ *Id.* at 419 (Newman, J., dissenting).

⁶² OXFORD ENGLISH DICTIONARY (2d ed. 1989). Intimating that only a select initiated few have access to the key to these copyright cases infringes the policy behind copyright law: to promote the creation of art by securing the economic rights of artists to their works. See Michael W. Shiver Jr., Comment, *Objective Limitations or, How the Vigorous Application of “Strong Form” Idea/Expression Dichotomy Theory in Copyright Preliminary Injunction Hearings Might Just Save the First Amendment*, 9 UCLA ENT. L. REV. 361, 373 (2002) (discussing the “impetus theory” behind the constitutional promotion of arts and sciences).

⁶³ *Barnhart*, 773 F.2d at 419 n.5.

⁶⁴ *Id.* at 422-24 (Newman, J., dissenting) (listing and then rejecting four possible conceptual separability tests in favor of a fifth approach which he suggested); see also 1 GOLDSTEIN, COPYRIGHT, *supra* note 20, § 2.5.3.1, at 2:65 (summarizing these five conceptual separability options).

⁶⁵ *Barnhart*, 773 F.2d at 420 (Newman, J., dissenting).

⁶⁶ *Id.* at 421 (Newman, J., dissenting).

⁶⁷ *Id.* (Newman, J., dissenting). And if the object is solely a useful article, then it cannot enjoy copyright protection. Cf. 37 C.F.R. § 202.10(c) (1959) (revoked 1978) (“If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art.”). The new definitions in § 101 of the Copyright Act of 1976 for ‘useful article’ and PGS works were essentially “adaptations of 37 C.F.R. § 202.10(a) and § 202.10 (c) (1959).” Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT Soc’y U.S.A. 339, 350 (1990).

rian function can be said to be ‘subsidiary.’”⁶⁸ But this test was also unsatisfactory for Judge Newman because “it offers little guidance to the trier of fact, or the judge endeavoring to determine whether a triable issue of fact exists, as to what is being measured by the classifications ‘primary’ and ‘subsidiary.’”⁶⁹ Arguably, and the point is contentious,⁷⁰ the majority in *Barnhart* applied this test in denying protection to the *Barnhart* forms; a close reading of the case suggests not that the *Barnhart* court retreated from conceptual separability in denying protection to these forms but rather that the forms themselves failed this test as applied.⁷¹ The forms’ artistic design—the proportions of the torso—were necessary to the performance of the utilitarian function, as opposed to the belt buckles in *Kieselstein-Cord*, whose “artistic design was wholly unnecessary to performance of the utilitarian function.”⁷² Furthermore, by stating that the forms’ aesthetic features “are inextricably intertwined with the utilitarian feature,” the majority may be attempting to respond to the dissent’s condemnation of the lack of guidance in the primary/subsidiary test, rather than coining an altogether new test.⁷³

Third, Judge Newman evaluates Professor Nimmer’s marketability test. “Conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be

⁶⁸ *Barnhart*, 773 F.2d at 421 (Newman, J., dissenting).

⁶⁹ *Id.* (Newman, J., dissenting).

⁷⁰ Not only is it argued that the *Barnhart* decision was a retreat from conceptual separability as framed in *Kieselstein-Cord*, see Solomon, *supra* note 59, but also—in seizing upon the “inextricably intertwined” language of the majority opinion in distinguishing the *Barnhart* forms from the *Kieselstein-Cord* buckles that merited copyright protection—that the *Barnhart* majority framed its own *inextricably intertwined test*, a test which “borders on the ludicrous.” Richard G. Frenkel, Note and Comment, *Intellectual Property in the Balance: Proposals for Improving Design Protection in the Post-TRIPs Era*, 32 LOY. L.A. L. REV. 531, 548 (1999) (arguing for a new category of industrial design protection).

⁷¹ See *supra* note 59 for a discussion of the denial of copyrightability to the *Barnhart* forms under the primary/subsidiary test from *Kieselstein-Cord* and a refutation of Solomon’s theory that *Barnhart* constituted a “retreat” from conceptual separability.

⁷² *Barnhart*, 773 F.2d at 419.

⁷³ *Id.* The fact that this clarification of the *Kieselstein-Cord* primary/subsidiary test may well be stricter than the application of the test in *Kieselstein-Cord* because “[a]ny artistic features that are necessary to and inextricably intertwined with the object’s utilitarian function will almost inevitably physically inseparable,” Perlmutter, *supra* note 67, at 362, does not necessarily elevate it to the status of a new test. Indeed, under the clarified primary/subsidiary test applied in *Barnhart*, the court expressly shows that the *Kieselstein-Cord* buckles would still be copyrightable because “the ornamented surfaces of the buckles were not in any respect required by their utilitarian functions” and were thus “superimposed upon” the utilitarian article, *Barnhart*, 773 F.2d at 419, i.e., the buckles were not inextricably intertwined like the *Barnhart* forms, and they were therefore conceptually separable. This casts doubt on Perlmutter’s assertion, since the aesthetic features of the buckles were not physically separable, and yet still conceptually separable in the majority’s view.

marketable to some significant segment of the community simply because of its aesthetic qualities.”⁷⁴ In effect, this would subsidize artists of “popular art,” as Nimmer understood.⁷⁵ But Judge Newman dismisses this approach, explaining that “various sculpted forms would be recognized as works of art by many, even though those willing to purchase them for display in their homes might be few in number and not a ‘significant segment of the community.’”⁷⁶

Fourth, the aesthetic appeal test finds that “‘conceptual separability’ exists whenever the design of a form has sufficient aesthetic appeal to be appreciated for its artistic qualities.”⁷⁷ Although Judge Newman squarely opposes this test on the grounds that Congress has unequivocally rejected such an aesthetic approach,⁷⁸ one understanding of his own temporal displacement test closely resembles it.

Fifth, Judge Newman rejected all of the foregoing tests in favor of his own temporal displacement test. Deriving this test “from the word ‘conceptual,’” Judge Newman posits that

[f]or the design features to be ‘conceptually separate’ from the utilitarian aspects of the useful article that embodies the design, the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function. The test turns on what may reasonably be understood to be occurring in the mind of the beholder or, as some might say, in the ‘mind’s eye’ of the beholder.⁷⁹

The deliberation proceeds in the mind of the “ordinary, reasonable observer”⁸⁰; the “separateness” occurs when in this mind of the hypothetical beholder the “design creates . . . two different concepts that are not inevitably entertained simultaneously.”⁸¹ Judge Newman acknowledges that this test can be applied in at least two ways and rejects the first, which very closely resembles the aesthetic appeal test.⁸² Instead,

⁷⁴ *Barnhart*, 773 F.2d at 421 (Newman, J., dissenting) (quoting 1 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 2.08[B] at 2-96.2 (1985)).

⁷⁵ See 1 NIMMER ON COPYRIGHT, *supra* note 74, § 2.08[B], at 2-96.3.

⁷⁶ *Barnhart*, 773 F.2d at 422 (Newman, J., dissenting).

⁷⁷ *Id.* (Newman, J., dissenting)

⁷⁸ *Id.* “The House Report makes clear that, if the artistic features cannot be identified separately, the work is not copyrightable even though such features are ‘aesthetically satisfying and valuable.’” *Id.* (quoting H.R. REP. NO. 94-1476, at 55 (1976)).

⁷⁹ *Id.* (Newman, J., dissenting).

⁸⁰ *Id.* (Newman, J., dissenting).

⁸¹ *Id.* (Newman, J., dissenting).

⁸² *Id.* at 423. Judge Newman hopes this test will preserve the line “Congress has sought to maintain” between aesthetic and useful articles; therefore, he discourages the approach that resembles the aesthetic appeal test:

Some might think that the requisite separability of concepts exists whenever the design of a form engenders in the mind of the ordinary observer any concept that is distinct

he hopes that in applying the test, a court would “insist that a concept, such as that of a work of art, is ‘separate’ from the concept of an article’s utilitarian function only when the non-utilitarian concept can be entertained in the mind of the ordinary observer without at the same time contemplating the utilitarian function.”⁸³ The result is a “temporal sense of separateness” that protects truly separable aesthetic creations while disallowing copyrightability for “every design that can be appreciated as a work of art.”⁸⁴

Commendably, Judge Newman does not ignore one of this test’s main weaknesses: the aesthetic input required of the judges in such cases. This aesthetic element plagues not just Newman’s test; it interferes with the whole field of conceptual separability. Newman concedes,

[i]n endeavoring to draw the line between the design of an aesthetically pleasing useful article, which is not copyrightable, and the copyrightable design of a useful article that engenders a concept separate from the concept of its utilitarian function, courts will inevitably be drawn into some minimal inquiry as to the nature of art. The need for inquiry is regrettable, since courts must not become the arbiters of taste in any art or any other aspect of aesthetics.⁸⁵

In light of this disclaimer, it is surprising that Judge Newman would advocate his temporal displacement test over the majority’s primary/subsidiary test. Apparently, he did so in an effort to afford more protection than available under the majority’s more conservative application of the primary/subsidiary test. But the majority felt that Judge Newman went too far: “the difficulty with [Judge Newman’s temporal displacement test] is that it uses as its yardstick a standard so ethereal as to amount to a ‘non-test’ that would be extremely difficult, if not impossible, to administer or apply.”⁸⁶ The majority also found that the “illusory nature of the standard suggested by Judge Newman” would defeat the purpose of conceptual separability by affording protection to almost any industrial design, because “almost any utilitarian article may be viewed by some separately as art, depending on how it is dis-

from the concept of the form’s utilitarian function. . . . That approach, I fear, would subvert the Congressional effort to deny copyright protection to designs of useful articles that are aesthetically pleasing. The impression of an aesthetically pleasing design would be characterized by many as the impression of a work of art, thereby blurring the line Congress has sought to maintain.

See also *infra* Part II C 1 c. discussing Professor Perlmutter’s *duality test*, which substantially consists of this first approach to Judge Newman’s temporal displacement test.

⁸³ *Barnhart*, 773 F.2d at 423 (Newman, J., dissenting).

⁸⁴ *Id.* (Newman, J., dissenting).

⁸⁵ *Id.* (Newman, J., dissenting).

⁸⁶ *Id.* at 419 n.5 (majority opinion).

played.”⁸⁷ In short, the majority accuses Judge Newman’s test of too much latitude and Judge Newman contends that the majority’s test is too restrictive.

b. *Denicola’s spectrum of conceptual separability*. To Judge Newman’s list of five conceptual separability tests in his *Barnhart* dissent, the Second Circuit in *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*⁸⁸ added a sixth variety that can be termed *Denicola’s spectrum*.⁸⁹ Succinctly stated, Denicola’s spectrum is “a sliding scale between art and utility; the more a work is influenced by utilitarian considerations, the less it can be copyrighted.”⁹⁰ Quoting at length from Professor Denicola’s article, the Second Circuit gave a more verbose formulation of the test arising from Denicola’s spectrum: “if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”⁹¹ Professor Denicola explains that

[a]nalysis of the relationship between form and function is not new to copyright law. In an effort to avoid monopolization of functional attributes, the law has long denied protection in instances in which utilitarian requirements dictated a particular form. The relationship between form and function, however, is seldom so direct. Typically, a variety of forms will be compatible with functional objectives. The choice is thus constrained rather than dictated. The separability test, devised to exclude industrial design from the scope of copyright, suggests that even this weaker relationship between form and function is sufficient to preclude protection.⁹²

In other words, this approach as initially envisioned by Professor Denicola in 1983 might not have settled the dispute in *Barnhart* after

⁸⁷ *Id.*

⁸⁸ 834 F.2d 1142, 1145 (2d Cir. 1987) (enthusiastically considering Denicola’s spectrum as a solution, stating that “[p]erhaps the differences between the majority and the dissent in *Carol Barnhart* might have been resolved had they had before them the Denicola article.”).

⁸⁹ My term. See generally Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983) (refuting the idea in the legislative history of the Copyright Act of 1976 that there is any “clear line” at all in these cases, but rather a spectrum upon which “copyrightability ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations. Only such a direct assessment of the nature of the claimant’s contribution can implement the congressional decision to exclude the general realm of industrial design, while preserving exclusive rights in ‘applied art.’”).

⁹⁰ Frenkel, *supra* note 70, at 550.

⁹¹ *Brandir Int’l*, 834 F.2d at 1145.

⁹² Denicola, *supra* note 89, at 741-42.

all, since its restrictive nature may render it closer in spirit to the *Barnhart* majority's "inextricably intertwined" application of the primary/subsidiary test⁹³ than to Judge Newman's more expansive temporal displacement test.

Even if Denicola's spectrum as formulated in the *Brandir Int'l* test would have solved the dispute between the majority and the dissent in *Barnhart*, it still fails to extract judges from what makes conceptual separability the aesthetic quagmire that it is. That is, the *Brandir Int'l* test "is itself conceptually difficult to apply—the test requires judicial analysis of artistic judgment."⁹⁴ Once again, such precedent could "embroil the courts in aesthetic controversy,"⁹⁵ an aspect of copyright law from which courts have tried to distance themselves since Justice Holmes discommended aesthetic subjectivity in copyright adjudication in 1903.⁹⁶ At one extreme, the *Brandir Int'l* approach of measuring the aesthetic elements' participation in the utilitarian function can even "undermine the entire copyright scheme by declaring all artistic and creative work utilitarian."⁹⁷ However, the *Whimsicality* outcome showed that the opposite can be true as well, depending on the judge's aesthetic insights.⁹⁸ Unfortunately, then, this test likewise adds little in the way of consis-

⁹³ Indeed, although appearing to adopt a new test, the majority in *Brandir Int'l* willingly adopted Professor Denicola's spectrum test because it found that "the approach is consistent with the holdings of our previous cases [*Kieselstein-Cord* and *Barnhart*]." 834 F.2d at 1145.

⁹⁴ Frenkel, *supra* note 70, at 554. Frenkel poignantly addresses two examples of where this aesthetic subjectivity has led to a split in subsequent caselaw. See *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (applying the *Brandir Int'l* test to Halloween costumes and finding clothing uncopyrightable on the grounds that its aesthetic and utilitarian functions merge, and that clothes are inherently useful articles and not copyrightable); cf. *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1353 (S.D. Cal. 1988) (quoting same passage in *Brandir Int'l* but holding that Halloween costumes were "not, however, designed to optimize their function as clothing," and thus copyrightable on the grounds that their function did not merge with their form to the extent that would invalidate copyright). These cases exemplify the dangers of reliance on aesthetic subjectivity in copyright law: In one jurisdiction, the courts effectively subsidized artists creating Halloween costumes while in another, the courts denied the subsidy, see Yen, *supra* note 4, at 248 (explaining how courts subsidize artistic creation through copyright law), and all with an arbitrary air although under the same federal statutory language.

⁹⁵ Yen, *supra* note 4, at 250.

⁹⁶ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.").

⁹⁷ Peter K. Schalestock, Comment, *Forms of Redress for Design Piracy: How Victims Can Use Existing Copyright Law*, 21 SEATTLE U. L. REV. 113, 127 (1997) (arguing that the *Brandir Int'l* test as applied in *Whimsicality* should be rejected much like the aesthetic functionality doctrine has been in trademark and trade dress law).

⁹⁸ See *supra* note 94 for a discussion of *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989).

tency of application or predictability in the field of conceptual separability.

c. *The Perlmutter duality test.* After disposing of several of the above tests by highlighting their “fundamental flaws,”⁹⁹ Professor Perlmutter proposes a *duality test*—an “adaptation of Judge Newman’s test”—for applying conceptual separability based on “duality rather than displacement.”¹⁰⁰ Essentially, this seventh test is the rejected first of two possible applications of Judge Newman’s temporal displacement test, the aesthetic appeal test¹⁰¹:

This adaptation would preserve the core of [Judge Newman’s] test—the emphasis on the ordinary observer’s ability to perceive the object as a work of art. It would drop, however, the ‘either/or’ aspect—the additional requirement that this perception be capable of completely displacing the perception of usefulness. Instead, it would be sufficient if the observer could perceive the article as having both functions, whether simultaneously or one at a time.¹⁰²

In proposing this test, Professor Perlmutter must confront not only the *Barnhart* majority’s concerns that now speak even more strongly to her version of Judge Newman’s “non-test” than they did to his “ethereal standard”¹⁰³ itself, but also Judge Newman’s own justifications for rejecting this expression of his temporal displacement test.¹⁰⁴

Professor Perlmutter touts her test’s heightened practicability over the displacement test and its conformity to congressional intent, “ruling out protection where observers see no more than an aesthetically pleasing useful article.”¹⁰⁵ But she struggles to address satisfactorily the *Barnhart* majority’s main concern with Judge Newman’s test, which was itself more restrictive than her test. “While it is possible that a particu-

⁹⁹ Perlmutter, *supra* note 67, at 372-78 (striking down (1) the Denicola/*Brandir* approach because its “emphasis on process is contrary to the language of the Copyright Act” and inconsistent with the spirit of *Mazer*, and (2) Newman’s displacement test because although the test “has many advantages over the Denicola/*Brandir* approach,” it is “more complex than necessary”).

¹⁰⁰ *Id.* at 377 (internal quotation marks omitted).

¹⁰¹ See text accompanying notes 79–87, *supra* Part II.C.1.a, for a discussion of Judge Newman’s proposed test, the two possible applications of it, and Judge Newman’s rejection of the first application which closely resembles Perlmutter’s duality test.

¹⁰² Perlmutter, *supra* note 67, at 377.

¹⁰³ *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 n.5 (2d Cir. 1985) (“The difficulty with [Judge Newman’s] proposal is that it uses as its yardstick a standard so ethereal as to amount to a ‘non-test’ that would be extremely difficult, if not impossible, to administer or apply.”).

¹⁰⁴ See text accompanying notes 79–87 for a discussion of Judge Newman’s justifications for rejecting this possible application of his temporal displacement test.

¹⁰⁵ Perlmutter, *supra* note 67, at 378.

larly suggestive context could influence the result, leading to the majority's criticism in *Carol Barnhart* that "[a]lmost any utilitarian article may be viewed by some separately as art, depending on how it is displayed,' such a context should not be conclusive."¹⁰⁶ Professor Perlmutter's solution is a thus a skepticism towards context, requiring courts to examine the object as it would be seen "by a reasonable person outside of the extraordinary [artistic/aesthetic] context"¹⁰⁷; but once again, this lands courts in a "regrettable" aesthetic position where they will "inevitably be drawn into some minimal inquiry as to the nature of art,"¹⁰⁸ which led Judge Newman to discourage this application of his test. Nevertheless, Professor Perlmutter's test is thoughtful and certainly workable—with the understanding that it will not spare judges an ultimately dispositive recourse to aesthetic subjectivity to decide these cases.

2. For a perfect ten: The Copyright Office alerts Congress to numerous tests.

In a study commissioned by the congressional Subcommittee on Courts, Intellectual Property and the Administration of Justice, the Copyright Office primed Congress for needed changes in the Copyright Act of 1976 to include architectural works while circumventing the esoteric conceptual separability tests.¹⁰⁹ In underscoring the confusion surrounding copyrighting PGS works doubling as useful articles, the report listed four different conceptual separability tests: Newman's "temporal displacement" test and three others.

a. *The "Copyright Office" test.* First, the Copyright Office outlined its own practice in applying the conceptual separability test. Under this view, the PGS work must be physically inseparable but still recognizable as a PGS work in its own right. This constitutes a conservative interpretation of the "identified separately" language in the 1976 Act. That is, the PGS work benefits from the designation of conceptually separable if "the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at 379.

¹⁰⁸ *Barnhart*, 773 F.2d at 423 (Newman, J., dissenting).

¹⁰⁹ U.S. COPYRIGHT OFFICE, LIBRARY OF CONGRESS, THE REPORT OF THE REGISTER OF COPYRIGHTS ON WORKS OF ARCHITECTURE 223-26 (1989) (providing Congress with four "Alternative Legislative Solutions"—ranging from creating a new subject matter category for works of architecture to doing nothing and allowing the courts to develop new legal theories of protection—based on the analysis in the preceding sections of the Copyright Office study).

useful article.”¹¹⁰ In essence, two separate entities must occupy the same space in order for the Copyright Office to allow registration for PGS works attached to a useful article under the mechanism of conceptual separability. “The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work, and the other a useful article.”¹¹¹ Absent this capacity for conceptual separation, the useful article absorbs the purported PGS work, no matter how artistic. The judge must decide whether the PGS work can be divorced from the useful article in this way on the basis of aesthetic judgment.

b. *The “Wright test.”* After describing Newman’s test, the Registrar of the Copyright Office proceeds to detail a test suggested to it by the Frank Lloyd Wright Foundation. In the “Wright test,” the Foundation posits that “the test of conceptual separability should turn on whether or not ‘the ordinary observer understands the work as having a conceptually dual function—that of a work of art and that of a useful article.’”¹¹² More inclusive than the Copyright Office’s own stricter approach, the Wright test seeks to allow “sculptural elements embodied in works of architecture” to be “registrable if the conceptually separable sculptural elements otherwise meet the originality requirements.”¹¹³ Thus, the “ordinary observer” in judge’s robes may perceive “the existence of separable elements,” without requiring them “to exist ‘side by side and be perceived as fully realized, separate works—one an artistic work, the other a useful article.’”¹¹⁴ Not only would this approach expand protection to many PGS works previously excluded as conceptually inseparable from a useful article, but it would invoke the judge’s aesthetic determination as a matter of law and thus contribute to an undesirable—even though unwilling—*de facto* subsidy for certain works.

c. *The “two step” test.* Finally, the fourth test presented by the Copyright Office for Congress’s consideration in amending the Copyright Act of 1976 employs two questions to ascertain conceptual separability. The vaguest test so far, this test again relies on the judge’s aesthetic opinion in the form of the ordinary observer:

¹¹⁰ *Id.* at xviii.

¹¹¹ *Id.*

¹¹² *Id.* at xix-xx.

¹¹³ *Id.* at xx.

¹¹⁴ *Id.* (distinguishing Judge Newman’s test in *Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (Newman, J., dissenting)).

(1) Can an ordinary observer conceive the presence of artistic features in a structure such as the Guggenheim Museum? (2) If so, are those features dictated by the Guggenheim's function as a museum? If not, then the artistic features are conceptually separable and thus protectible [sic] under this theory. This approach would find that the Guggenheim readily meets this standard.¹¹⁵

It is hard to imagine what building with any type of ornamentation would fail this test and thus forego protection for perceived PGS works attached to the structure.

3. Ten is a crowd

This type of ambiguity in the interpretation of the statute—the necessity of at least ten different, even contradictory, tests to give effect to the statutory language—exemplifies the need for reform. Specifically, judges could easily drown in this excess of tests; merely choosing one testifies to the judge's aesthetic predilection,¹¹⁶ and the resultant decision on whether to allow protection for the attached PGS work in question must in the end arise from the aesthetic taste of the judge.

Approaching the proposed amendments to the Copyright Act of 1976—for the purpose of bringing the U.S. in line with international copyright practice—Congress took note in 1990 of the aesthetic problems of the conceptual separability tests. Congress hoped to replace this conceptual separability conundrum with a bright line rule in conjunction with the new copyright protection extended to architectural works under the 1990 law, as required in order to comply with the broader international approach to structural copyright. The statutory history of the 1990 Act shows that Congress achieved this aim; but it was up to the court in *Leicester* to validate and solidify it through careful and accurate construction of the Act.

III. ARCHITECTURE IN COPYRIGHT LAW

A. *The Awaited Birth of a Bright-line Rule in the AWCPA*

Architecture ranks high on aesthetes' lists of art. "I call architecture frozen music," noted the lawyer-poet Goethe in 1827.¹¹⁷ The phi-

¹¹⁵ *Id.* at xx.

¹¹⁶ See Yen, *supra* note 4, at 249 (illustrating that the "distinction between aesthetic reasoning and legal reasoning [in choosing the analytical approach to take] is illusory").

¹¹⁷ CONVERSATIONS WITH ECKERMANN, BEING APPRECIATIONS AND CRITICISMS ON MANY SUBJECTS BY JOHANN WOLFGANG VON GOETHE 114 (preface by Eckermann, intro. and trans. by Wallace Wood, 1901) (1827). Although Goethe considered jurisprudence to be "among his least talents," Eberhard Schmidhäuser, *Goethes Denken über Recht und Staat—aus der Sicht von Gestern und Heute*, in 116 GOETHE-JAHRBUCH 178, 179 (1999), Goethe

losopher of aesthetics Hegel labeled architecture as the “first of the arts.”¹¹⁸ And in 1886, on the heels of the German Publishers’ Association’s 1882 proposal for the formation of an international copyright union, The Berne Convention for the Protection of Literary and Artistic Works broadly extended protection to “every production whatsoever in the literary, scientific, or artistic domain which can be published by any mode of impression or reproduction,”¹¹⁹ including “plans, sketches, and plastic works relative to architecture.”¹²⁰ Ten countries

studied and then practiced law in pre-copyright Germany, writing poems and storm-and-stress literature—such as the 1774 European bestseller *The Sorrows of Young Werther*—on the side until the propitious day in 1775 when the Duke Karl August invited him to resettle to Weimar under the official sponsorship of the small principality. Such sponsorship was the preferred solution for talented artists—whether musicians, poets, painters, or even architects, such as Berlin’s Karl Friedrich Schinkel—in the absence of copyright laws enabling an artist to live by his or her work. This sponsorship was Goethe’s good fortune; Friedrich Schiller, Goethe’s contemporary and “intellectual opposite,” GOETHE, *Glückliches Ereignis*, in 10 JOHANN WOLFGANG VON GOETHE WERKE 538, 540 (Hamburg Edition, DTV, 1998) (1817) (relating autobiographically that his philosophical and artistic perspective and methods separated him from Schiller “by more than the diameter of the earth” even though the two worked closely together in their literary endeavors) who famously penned the *Ode to Joy* (1785) and *William Tell* (1801), did not fare so well in earning a living by his art. FRIEDRICH CHRISTIAN SCHILLER, *Letter to C.G. Körner, 09 March 1789*, in DER BRIEFWECHSEL ZWISCHEN SCHILLER UND GOETHE 9 (Ed. Emil Staiger, Insel 1966) (lamenting his own more difficult circumstances after meeting Goethe for the first time and revealing his initial profound dislike for Goethe’s methods—and perhaps jealousy of the artistic freedom that Goethe’s sponsorship by the court allowed him). Lack of copyright protection for Schiller’s works almost ruined him at first; the constant necessity of making ends meet plagued him throughout his life, T.J. REED, SCHILLER 36 (1984), influenced him to turn from his literature for an entire decade while he taught as professor of history at the University of Jena and studied Kantian philosophy, LESLEY SHARPE, FRIEDRICH SCHILLER: DRAMA, THOUGHT, AND POLITICS 96-108 (1991), and perhaps contributed to his early death in 1805 at age 46. Similar concerns for the economic rights of architects e.g. in their monumental works have been raised following enactment and as a result of the AWCPA. Mathis, *supra* note 28, at 602.

¹¹⁸ GEORG WILHELM FRIEDRICH HEGEL, *Vorlesungen über die Ästhetik II*, in 14 WERKE 266 (Eva Moldenhauer and Karl Markus Michel, eds., 1970) (1830).

¹¹⁹ PAUL GOLDSTEIN, INTERNATIONAL COPYRIGHT. PRINCIPLES, LAW, AND PRACTICE 21 (2001) (quoting THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS, Sept. 9, 1886, art. IV).

¹²⁰ Natalie Wargo, *Copyright Protection for Architecture and the Berne Convention*, 65 N.Y.U. L. REV. 403, 409 (1990) (quoting The Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, art. IV). Obviously, this language did not yet provide express protection for works of architecture themselves. But in 1887, the *Association littéraire et artistique internationale* (ALAI)—founded in 1878 and presided over by the famed romanticist author Victor Hugo, STEPHEN P. LADAS, 1 THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 71-83 (1938) (providing general background for the ALAI)—“announced that works of architecture must enjoy the same protection as works of literature and fine arts,” Wargo, *supra* at 410 n. 31, spearheading a movement to include architectural works as part of the protected subject matter. Since some countries at this time, such as France, Belgium, Spain, Italy, and Switzerland, already implicitly extended protection to architectural works as artistic works, *id.* at 409 n. 28, this movement largely focused

signed the treaty at the time; some of these countries' vast colonial holdings gave the treaty's coverage global proportions.¹²¹ The Paris Text of 1971 is the current text of the Berne Convention and now expressly includes architectural works in its protected subject matter.¹²² But European conceptions of artists' moral rights—as opposed to the American adherence to economic rights in copyright—together with the Convention's prohibition of formalities in obtaining protection for creative works¹²³ long repelled the United States from signing.¹²⁴ Finally, a century later, after America had dominated the world export of

on convincing skeptical countries such as Britain, Germany, and Norway that the proposed amendment would not encompass “even the most mundane or common structures,” *id.* at 411. At the Paris Conference in 1896, following a decade of debate on the status of architectural works after the Berne Convention, delegates committed to expanding the subject matter protection to architectural works identified what they saw as a “loophole” in the protection afforded to architectural works under the 1886 Berne Convention: the language essentially “afforded protection against two-dimensional reproductions of an architect’s plans but did not prohibit construction of a building from those plans” and that “works of architecture created without blueprints received no protection at all.” *Id.* By the 1908 Berlin Revision Conference, the skeptical countries, with the exception of Norway, had been convinced by the other delegates and lobbying architects to expand the protection officially, defining “works of architecture” as protected works. *Id.* at 412-13. It is interesting to note that the Berne Convention’s position in 1886 towards protection of architectural works, with its attendant “loopholes,” foreshadows the asymmetrical status quo of copyright protection for architectural works in the United State until 1990.

¹²¹ GOLDSTEIN, *INTERNATIONAL COPYRIGHT*, *supra* note 119, at 19-20 (2001) (quoting SAM RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886-1986*, 79 (1987) (“Despite this relatively limited membership [ten original signers], the geographical sweep of the new Union [of countries affording such protection] was considerable when account is taken of the colonial possessions of France, Germany, Italy, Belgium, Spain, and the UK.”)). Significantly, the United States finally decided to sign on to this treaty 103 years later. *Id.* at 20 n. 39.

¹²² The Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, art. 2(1) 828 U.N.T.S. 221 (Paris Text 1971) (as amended Oct. 2, 1979) (hereinafter “the Berne Convention”) (including as protected subject matter “works of drawing, painting, architecture, sculpture, engraving and lithography . . . illustrations, maps, plans, sketches, and three-dimensional works relative to geography, topography, architecture or science”).

¹²³ *Id.* art. 5(2); *cf.* Copyright Act 1909, ch. 320, §§ 10, 14, 24, *repealed by* Copyright Act of 1976, Pub. L. No. 94-533, §§ 401-412, *amended by* Architectural Works Copyright Protection Act of 1990, Pub. L. No. 101-650, 701, 703, 104 (codified in 17 U.S.C. §§ 101(5), 102(a)(8), 120) (2000) (laying out formal requirements for obtaining copyright protection: notice, registration, renewal, and deposit of copies). Interestingly, the prohibition of these formalities was first introduced into the Berlin Text of the Berne Convention in 1908, one year before the United States revised its own copyright laws to require these formalities. GOLDSTEIN, *INTERNATIONAL COPYRIGHT*, *supra* note 119, at 21.

¹²⁴ Wargo, *supra* note 120, at 444. Also, contributing significantly to U.S. delay in joining the Berne Convention was the availability of “backdoor” access to the heightened level of protection offered by the doctrine of moral rights in the Berne Convention. Leonard D. DuBoff et al., *Out of UNESCO and Into Berne: Has United States Participation in the Berne Convention for International Copyright Protection Become Essential?*, 4 *CARDOZO ARTS & ENT. L.J.* 203, 211 (1985) (“Some of the pressure for United States adherence to the Berne Convention was relieved by the so-called ‘backdoor approach’ whereby a simultaneous pub-

copyrighted works since the end of World War I,¹²⁵ the United States decided to join the Berne Convention Union¹²⁶ to protect its interests as the top copyright exporter.¹²⁷

Thus was born the AWCPA: membership in the Berne Convention demanded inclusion of architectural works as protected copyright subject matter. On the strategy of a “minimalist approach” then,¹²⁸ the AWCPA extends copyright protection to architectural works. But in reality, the AWCPA does more than this alone—structurally it reexamines the relationship between architectural works and attached PGS works,¹²⁹ but not without side effects.¹³⁰ As a result, an apparent loss of

lication of a United States copyrighted work in a Berne signatory country, such as Canada, provided protection for that work in all of the member states of the Berne Convention.”).

¹²⁵ *The Berne Convention: Hearings on S. 1301 and S. 1971 Before the S. Subcomm. On Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary*, 100th Cong. 142-43 (1988) (statement of Ralph Oman, Register of Copyrights).

¹²⁶ The Berne Convention Implementation Act of 1988, P.L. 100-568, 102 Stat. 2853 (codified at 17 U.S.C. § 101 (2004)). However, Congress failed to give adequate attention to at least one area in which United States copyright protection failed to meet the Berne Convention requirements: architectural works. Because the Berne Convention requires that member nations extend full copyright protection to architectural works, Congress requested that the Copyright Office determine whether the existing copyright law adequately protected architectural works to minimally meet the Berne Convention’s requirements.

Thiel, *supra* note 41, at 17–18. This necessitated the AWCPA.

¹²⁷ ROBERT A. GORMAN & JANE C. GINSBURG, COPYRIGHT FOR THE NINETIES 874 (4th ed. 1993) (noting the massive losses resulting from large scale international piracy of U.S. exported copyright works).

¹²⁸ Thiel, *supra* note 41, at 17 & n. 113.

¹²⁹ According to the useful article doctrine, an inhabitable building was a utilitarian article and thus not copyrightable under the Copyright Act of 1976. *Cf.* H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668; see *infra* Part III.B.1 for a discussion of how the useful article doctrine applied to architectural works before 1990. However, under the Copyright Act of 1976, “selected works of architecture—those containing elements physically or conceptually separable from their utilitarian function—would be protected to the extent of their separability.” H.R. REP. NO. 101-735, at 11 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6942. In other words, if a utilitarian, i.e. nonmonumental, work of architecture contained attached PGS works that could pass one of the many conceptual separability tests that sprang up after the Copyright Act of 1976, then those attached PGS works might be copyrightable even though the overall building was not copyrightable as a useful article. After the AWCPA, which extends copyright protection to architectural works for the first time, “it [was] unclear whether copyright law offers copyright protection for purely aesthetic features incorporated in architectural structures as sculptural works,” that is, as PGS works subject to the conceptual separability tests. Thiel, *supra* note 41, at 34. This uncertainty stemmed from vagueness in the statute. Thus, as of 1996, “it remain[ed] to be seen . . . whether sculptural components of an architectural work [were] protected as visual arts or as architectural works” because no court had addressed the issue in a written opinion as of that time. Thiel, *supra* note 41, at 25 & n.164. In *Leicester v. Warner Bros.*, 232 F.3d 1212 (9th Cir. 2000), the Ninth Circuit weighed in on the issue, holding that attached PGS works now share the copyright protection of the building to which they are attached. See *infra* Part IV for an evaluation of the *Leicester* holding.

rights by authors of attached PGS works has since been decried¹³¹; there have been fears that monumental works of architecture, previously fully protected by the nature of their nonfunctionality, might lose this status if now redefined as works of architecture under the AWCPA,¹³² and the AWCPA has been deemed flawed for allegedly depriving architects of a significant market interest in their works.¹³³ But the AWCPA has also since been lucidly construed¹³⁴ to effectuate Congress's initiative—in the form of a bright line rule—both to extend protection to architectural works and to extract judges from the quagmire of conceptual separability¹³⁵ surrounding the copyrightability of PGS works, or the “aesthetic controversy” in which “existing precedent embroils the courts”¹³⁶ in supposedly objective copyright adjudication.

¹³⁰ For example, “language in the legislative history of the AWCPA, perhaps faulty, perhaps gratuitous, appeared to change the categorization of monuments from sculptural works to architectural works,” a reclassification which “results in a reduced level of protection” for the authors of nonfunctional, purely monumental works of architecture. Mathis *supra* note 28, at 598–99. This reduced protection is a result of the limitations in the AWCPA for the copyright of architectural works. See *infra* Part III.C.2 for a discussion of the AWCPA's pictorial representation limitation in the copyright of architectural works. Also, due to the fact that attached PGS works receive the same copyright protection as the architectural work itself under the AWCPA, which is subject to some limitations, authors of PGS works who previously stood to obtain full copyright protection of their works if they could surmount one of the conceptual separability tests now find their works subject to the same limitation of protection as the underlying architectural work. Jay Orlandi, Comment, *Gargoyles in Gotham: A Sculpture Incorporated Into an Architectural Work Should Retain Independent Copyright Protection*, 29 Sw. U. L. REV. 617, 629 (2000).

¹³¹ See generally Orlandi, *supra* note 130 (writing with the Ninth Circuit as an audience, advocating reversal of the district court's decision in *Leicester v. Warner Bros.*, 47 U.S.P.Q.2d 1501, 1998 WL 34016724, at *8 (C.D. Cal. May 29, 1998) on the basis that the AWCPA's new configuration should not abridge preexisting copyright protection for PGS works incorporated into an architectural work).

¹³² Mathis, *supra* note 28, at 598–99 (approving of inclusion of architectural works as protected subject matter but wary of the implications of AWCPA's language for the separate category of monuments).

¹³³ Thiel, *supra* note 41, at 35 (arguing that the AWCPA's pictorial representation exemption should be eliminated because it “arbitrarily restricts the architect's right to control derivative works”).

¹³⁴ In *Leicester v. Warner Bros.*, 232 F.3d 1212 (9th Cir. 2000).

¹³⁵ See *supra* Part II.C for an investigation of the different conceptual separability tests used in copyright adjudication about PGS works constituting this quagmire.

¹³⁶ Yen, *supra* note 4, at 250.

B. *Architectural Copyrightability in America Before 1990*

1. Functionality: the destroyer of copyrightability in architectural works

Before the AWCPA created a “general functionality exception”¹³⁷ in 1990 for architectural works in order to comply with the requirements of the Berne Convention, architectural works were subject to the same idea-expression dichotomy that rendered utilitarian articles uncopyrightable. Hailing from *Baker v. Selden*,¹³⁸ the idea-expression dichotomy provides that copyright protects only an author’s expression and not the useful idea being expressed. In *Baker*, this meant that although a book describing a new book-keeping system might be copyrightable, anyone could freely make use of the system itself described in the book because this was a useful *idea* and not a copyrightable original *expression*.¹³⁹ Congress codified this fundamental of American copyright law in the Copyright Act of 1976.¹⁴⁰ As a natural application of the *Baker* idea-expression posture, architectural plans were the architect’s “writings” and thus benefited from copyright protection as PGS works.¹⁴¹ But absent a provision specifically treating architectural works, the structures themselves defaulted to the category of PGS works and became subject to the “useful articles limitation,”¹⁴² as codified in § 101 of the Copyright Act of 1976. The useful articles doctrine denied protection to articles “having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey

¹³⁷ 1 GOLDSTEIN, COPYRIGHT, *supra* note 20, § 2.15.1 at 2:185.

¹³⁸ 101 U.S. 99 (1880).

¹³⁹ *Id.* at 104. Extending copyright protection past the expression of the idea to the useful idea itself, thus precluding others’ application and use of the idea would violate public policy:

[T]he teachings of science and the rules and methods of useful art have their final end in application and use; and this application and use are what the public derive from the publication of a book which teaches them. But as embodied and taught in a literary composition or book, their essence consists only in their statement. This alone is what is secured by the copyright. The use by another of *the same methods of statement*, whether in words or illustrations, in a book published for teaching the art, would undoubtedly be an infringement of the copyright.

Id. at 104 (emphasis added).

¹⁴⁰ 17 U.S.C. § 102(b) (2005) (providing that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work”).

¹⁴¹ *Imperial Homes Corp. v. Lamont*, 458 F.2d 895, 897 (5th Cir. 1972) (“[T]he architect who originates a set of blueprints for a dwelling is as much an author for copyright purposes as the writer who creates an original novel or the dramatist who pens a new play.”); *see also* David E. Shipley, *Copyright Protection for Architectural Works*, 37 S.C. L. REV. 393, 396-399 (1986) (outlining the state of copyrightability of architectural plans as of 1986).

¹⁴² NIMMER ON COPYRIGHT, *supra* note 74, § 2.08[D][2][b], at 2-125.

information,”¹⁴³ on the basis of the idea-expression dichotomy. Therefore, before the AWCPA removed architectural works from joint consideration with PGS works, copying an architect’s blueprints constituted a copyright infringement but no copyright provision precluded someone from simply using the plans themselves to construct an identical replica.¹⁴⁴ The court in *Demetriades v. Kaufmann* confirmed this result finding “consistent with *Baker* . . . that although an owner of copyrighted architectural plans is granted the right to prevent the unauthorized copying of those plans, that individual, without benefit of a design patent, does not obtain a protectable interest in the useful article depicted by those plans.”¹⁴⁵ Thus, before the 1990 enactment of the AWCPA, functionality in architectural works—any aspect that made the structure a “useful article,” such as e.g. inhabitability—automatically excluded architectural works from protection under the useful article doctrine.

2. The nonfunctionality exception and conceptual separability in architectural works

However, *nonfunctional* works of architecture constituted an exception to the general rule that functionality precluded copyrightability in architectural works. Nonfunctional architectural works were copyrightable as sculpture under the definition of PGS works in the Copyright Act of 1976: “[p]urely nonfunctional or monumental structures would be subject to full copyright protection under the bill and the same would be true of artistic sculpture or decorative ornamentation or embellishment added to a structure.”¹⁴⁶ But the latter—“artistic sculpture or decorative ornamentation or embellishment added to a structure”—would have to survive the conceptual separability tests spawned

¹⁴³ 17 U.S.C. § 101 (2005).

¹⁴⁴ *Imperial Homes*, 458 F.2d at 899 (“[N]o copyrighted architectural plans . . . may clothe their author with the exclusive right to reproduce the dwelling pictured.”).

¹⁴⁵ 680 F. Supp. 658, 664 (S.D.N.Y. 1988); see also *DeSilva Constr. Corp. v. Herrald*, 213 F. Supp. 184, 195 (D.C. Fla. 1962) (showing the long-term consistency of this approach based on *Baker*—despite “continuing statutory silence [as of 1986],” Shipley, *supra* note 141, at 395, in the United States Code about whether architectural works impliedly qualify for protection as PGS works—when combined with *Demetriades* by holding that “[t]he [implied] protection extended by Congress to the proprietor of a copyright in architectural plans does not encompass the protection of the buildings or structures themselves, but it is limited only to the plans.”). Furthermore, even though Congress did not explicitly write the protection of architectural plans into the 1976 Copyright Act, the Act’s legislative history reveals that they took this assumption for granted: “An architect’s plans and drawings would, of course, be protected by copyright” H.R. REP. NO. 94-1476, at 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668.

¹⁴⁶ H.R. REP. NO. 94-1476, at 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668.

by the 1976 Act's "identified separately" language.¹⁴⁷ By contrast, purely monumental works of architecture avoided the separability tests altogether precisely because of their nonfunctionality. That is, before the AWCPA of 1990, sculpture or embellishment that attached to a functional work of architecture might have been copyrightable if it survived one of the numerous separability tests used to determine whether it could exist either physically or conceptually separately from the useful article, which is in this case a work of architecture, whereas the non-functional work of architecture is not a useful article and thus merits copyright as an expression by its own right. The AWCPA of 1990 changed this regime by offering even functional works of architecture copyright protection in their own right.

C. *Filling the Void with the Architectural Works Copyright Protection Act of 1990*

In 1990, in fulfillment of its obligations under the recently passed Berne Convention Implementation Act of 1988, Congress amended the Copyright Act of 1976 to extend copyright protection to architectural works. In doing so, Congress introduced a bright-line rule to determine the copyrightability of architectural works for the express purpose of avoiding the complications of the separability tests.¹⁴⁸ This approach spares judges from deciding whether the structure at issue merits protection or not under the conceptual separability tests—based on the aesthetic judgments that unavoidably inhere in those tests—while at the same time fulfilling their *Bleistein* obligation of aesthetic objectivity in copyright adjudication.

1. The additions: first time protections for architectural works (§§ 101, 102(a)(8))

In order to extend copyright protection to architectural works, Congress made two additions to the text of the Copyright Act of 1976 as codified in Title 17 in the United States Code. First, in § 101, Congress defined "architectural work" as

¹⁴⁷ See *supra* Part II.C for a discussion of ten of the numerous conceptual separability tests used to determine the extent to which an aesthetic article can exist separately from a useful article to which it is attached in order to determine whether the incorporated aesthetic article merits protection.

¹⁴⁸ H.R. REP. NO. 101-735, at 20 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6951 ("There is considerable scholarly and judicial disagreement over how to apply the separability test, and the principal reason for not treating architectural works as pictorial, graphic, or sculptural works is to avoid entangling architectural works in this disagreement.").

the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.¹⁴⁹

Including architectural plans or drawings in this definition meant that such plans and drawings now enjoy dual protection.¹⁵⁰ That is, even before the AWCPA included plans and drawings in the definition of protected architectural works, the Copyright Office and various courts had already extended them protection as PGS works—even though they were not expressly mentioned in any earlier copyright law.¹⁵¹ Congress acknowledged that it intended this effect in wording the definition of “architectural works” in this way: “An individual creating an architectural work by depicting that work in plans or drawing will have two separate copyrights, one in the architectural work . . . , the other in the plans or drawings Either or both of these copyrights may be infringed and eligible separately for damages.”¹⁵² Thus, the plans and drawings are protected both as PGS works under the existing § 102(a)(5) and also as architectural works under the new § 102(a)(8).

The second addition, then, that the AWCPA made to the Copyright Act of 1976 was the insertion of language into § 102 incorporating architectural works into the subject matter of copyright. Specifically, § 102(a)(8) adds “architectural works” to the enumerated list of “original works of authorship fixed in any tangible medium or expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”¹⁵³ With this addition, functional works of architecture attained copyright protection for the first time.

2. The exceptions: § 120(a), (b)

Although the AWCPA extended copyright protection to architectural works for the first time, it did not do so without some limitations that other copyrightable subject matter does not face. Because public works of art such as architecture serve an undeniable public function, Congress felt constrained to provide for a certain amount of public use

¹⁴⁹ 17 U.S.C. § 101 (2005).

¹⁵⁰ Raphael Winick, Note, *Copyright Protection for Architecture After the Architectural Works Copyright Protection Act of 1990*, 41 DUKE L.J. 1598, 1614–15 (1992).

¹⁵¹ Raleigh W. Newsam II, *Architecture and Copyright: An Analytical Framework for Separating the Poetic from the Prosaic*, 41 COPYRIGHT L. SYMP. (ASCAP) 251, 253–54 (1993).

¹⁵² H.R. REP. NO. 101-735, at 19 (1990), reprinted in 1990 U.S.C.A.N. 6935, 6950.

¹⁵³ 17 U.S.C. § 102(a)(8) (2005).

of the architectural work by adding a “pictorial representations” limitation to the copyrightability of architectural works.¹⁵⁴ Furthermore, considering practical issues attendant to the ownership of architectural works—aside from owning the copyright to the architectural works—Congress enacted an “alterations to and destruction of buildings” limitation to the AWCPA.¹⁵⁵

The pictorial representations limitation of the AWCPA gives architectural works less protection than other copyrighted works under the Copyright Act. Congress found that “[a]rchitecture is a public art form and is enjoyed as such. Millions of people visit our cities every year and take back home photographs, posters, and other pictorial representations of prominent works of architecture as a memory of their trip.”¹⁵⁶ Thus, Congress provided in the AWCPA that “[t]he copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.”¹⁵⁷ That is, if an architectural structure is ordinarily visible from a public space, the copyright holder cannot prevent such pictorial representations from being made of it on public policy grounds. In this sense, then, artists whose works are protected under the AWCPA with its pictorial representations limitation receive less protection than if their works were considered PGS works that are not subject to this limitation.¹⁵⁸ Of course, “authors” of functional works of architecture had no claim to copyright protection at all before the AWCPA.

In addition to providing for a certain extent of public use of architectural works, Congress limited the AWCPA in the interest of preventing the ossification of the building market. Specifically, the AWCPA provides that “the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building.”¹⁵⁹ The legislative history reveals that Congress felt that this provision was uncontroversial, necessary, and justifiable under existing copyright practice.¹⁶⁰ Thus, despite concerns about the welfare of monuments if

¹⁵⁴ 17 U.S.C. § 120(a) (2005).

¹⁵⁵ 17 U.S.C. § 120(b) (2005).

¹⁵⁶ H.R. REP. NO. 101-735, at 22 (1990), reprinted in 1990 U.S.C.C.A.N. 6935, 6953.

¹⁵⁷ 17 U.S.C. § 120(a) (2005).

¹⁵⁸ See generally Orlandi, *supra* note 130.

¹⁵⁹ 17 U.S.C. § 120(b) (2005).

¹⁶⁰ H.R. REP. NO. 101-735, at 22 n.51 (1990), reprinted in 1990 U.S.C.C.A.N. 6935, 6953.

they now fall under the AWCPA rather than the § 102(a)(5) provisions for PGS works as nonfunctional works of architecture,¹⁶¹ the § 120(b) limitation for alteration to or destruction of buildings that now merit copyright protection under § 102(a)(8) allows owners to move forward with their market-oriented plans unencumbered by an artist's copyright.

3. Implications of the AWCPA of 1990

a. *Creating a bright-line rule for the protection of architectural works.* The AWCPA extended copyright protection to architectural works on the basis of a bright-line determination specifically meant to avoid the numerous conceptual separability tests. Congress seems to have realized the false dichotomy embodied in expecting judges “[t]o understand the conceptual art-architecture distinction,” or requiring them “to recognize that there must be some line separating art from architecture.”¹⁶² In doing so, Congress acknowledged that avoidance of conceptual separability largely motivated their legislative creation of § 102(8)(a): “the principal reason for not treating architectural works as pictorial, graphic, or sculptural works is to avoid entangling architectural works in this [scholarly and judicial] disagreement [over how to apply the separability tests].”¹⁶³ Instead, Congress “envisioned” implementing this bright-line rule absent aesthetic determination.¹⁶⁴ Essentially, architectural works are subject to the basic copyrightability test of originality of expression¹⁶⁵ without regard to the “separability conundrum”¹⁶⁶ surrounding the copyrightability of PGS works that are also useful articles.

b. *Subsuming attached PGS works.* The bright-line rule for protecting architectural works under the AWCPA also extends to PGS works attached to a building found to be copyrightable under that bright-line rule. Whereas before the AWCPA such attached PGS works might warrant protection separately from a functional—and thus un-

¹⁶¹ See Mathis, *supra* note 28, at 611–24 for a discussion of the controversy that the AWCPA has engendered because it seems to remove monumental or nonfunctional works of architecture from the § 102(a)(5) PGS works regime and place them under the new § 102(a)(8) regime of architectural works.

¹⁶² Orlandi, *supra* note 130, at 621 (advocating the identification of such a line between art and architecture in proposing a new six-factor test to accompany the numerous existing separability tests, but specifically in determinations about the copyrightability of PGS works attached to works of architecture).

¹⁶³ H.R. REP. NO. 101-735, at 20 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6951.

¹⁶⁴ *Id.* See also Newsam, *supra* note 151, at 255–56.

¹⁶⁵ Newsam, *supra* note 151, at 255–56.

¹⁶⁶ H.R. REP. NO. 101-735, at 21 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6952.

copyrightable¹⁶⁷—work of architecture if the PGS work passed one of the numerous conceptual separability tests, the attached PGS work now gains protection based on the bright-line test for the building to which it is attached.¹⁶⁸ Thus, authors of PGS works attached to copyrighted buildings cannot seek separate copyright protection for their works.¹⁶⁹ Although this might indeed occur to the detriment of authors of attached PGS works viewed in the most negative light, it also promotes a greater good by introducing a bright-line rule that spares judges the aesthetic subsidization that results from their choice of one of the many conceptual separability tests in adjudicating about attached PGS works.¹⁷⁰ Furthermore, viewed more positively, rather than depriving authors of economic rights, this actually strengthens authors' bargaining power in contracting for the job in the first place.¹⁷¹

IV. *LEICESTER V. WARNER BROS.* AND THE BRIGHT LINE IN THE AWCPA

Although Congress created a bright-line rule for use in the copyrightability of architectural works, the language of the statute demonstrated an ambiguity that might have landed attached PGS works back in the conceptual separability quagmire. That is, an attached PGS work might have been considered in its own right under § 102(a)(5) rather than as part of the copyright of the architectural work, now protected under § 102(a)(8), to which it was attached. But in *Leicester v. Warner Bros.*,¹⁷² the Ninth Circuit lucidly interpreted the AWCPA's bright-line rule, giving effect to the legislative intent behind the Act in doing so.

A. *Ensuring Realization of Legislative Intent in Leicester*

The Ninth Circuit held the AWCPA's bright line in *Leicester* by rejecting arguments that the structure at issue was conceptually separable and thus did not fall into the § 120(a) pictorial representation limi-

¹⁶⁷ See *supra* text accompanying notes 137–145.

¹⁶⁸ *Leicester v. Warner Bros.*, 232 F.3d 1212, 1219 (9th Cir. 2000).

¹⁶⁹ H.R. REP. NO. 101-735, at 19 n.41 (1990), reprinted in 1990 U.S.C.C.A.N. 6935, 6950 (“The Subcommittee was aware that certain works of authorship which may separately qualify for protection as pictorial, graphic, or sculptural works may be permanently embodied in architectural works. Stained glass windows are one such example. Election is inappropriate in any case where the copyright owner of a pictorial, graphic, or sculptural work embodied in an architectural work is different from the copyright owner of the architectural work.”).

¹⁷⁰ See Yen, *supra* note 4, at 250.

¹⁷¹ See *Leicester*, 232 F.3d at 1224 n.4 (Tashima, J., concurring).

¹⁷² 232 F.3d 1212 (2000).

tation of architectural work copyrightability.¹⁷³ Hence the court did not base its decision on conceptual separability, a quagmire previously unentered by the Ninth Circuit.¹⁷⁴ Essentially, the court resisted the temptation to employ the conceptual separability test(s) to reach results that the equities might have seemed to demand on a superficial level, choosing instead to apply the law as written in the statute, any imperfections in the language notwithstanding.

1. Revisiting the relationship between architecture and attached PGS works in *Leicester*

Before 1990, a PGS work attached to a functional architectural work, which would not be copyrightable as a useful article, might have been eligible for copyright protection subject to passing one of the conceptual separability tests. Under the doctrine of conceptual separability, “an element of expression that is related to a useful object may be deemed conceptually separable (and thus, independently protectable) if it can stand on its own as a work of art traditionally conceived.”¹⁷⁵ But following the AWCPA, attached PGS works no longer face separate treatment from the architectural works to which they are attached if they constitute an “integrated part”¹⁷⁶ of the whole, as held by the *Leicester* court.

a. *Of Batman and Zanja Madre*. In *Leicester*, artist Andrew Leicester sued Warner Bros. for breach of copyright after the studio filmed part of his artistic creation known as *Zanja Madre* as background for a couple of scenes in the 1994 movie *Batman Forever*.¹⁷⁷ Specifically, both the four streetwall towers of *Zanja Madre*—which contributed to the overall structure of the 801 Tower in downtown Los Angeles—and the 801 Tower itself, served in the film as the Second Bank of Gotham, “where nefarious deeds occur before Batman comes to the rescue.”¹⁷⁸ In 1989, Leicester had been commissioned by the de-

¹⁷³ See *id.* at 1219.

¹⁷⁴ *Id.* at 1222 (Tashima, J., concurring) (“[T]his circuit has never addressed the conceptual separability doctrine and there is no uniform standard elsewhere.”).

¹⁷⁵ David A. Roberts, *There Goes My Baby: Buildings as Intellectual Property Under the Architectural Works Copyright Protection Act*, 21-SPG CONSTR. L. 22, 25 (2001). Of course, that is just a simple statement of the conceptual separability doctrine. In truth, the “identified separately” language added to § 101 by the Copyright Act of 1976 in providing protection for PGS works has given rise to a number of different tests for determining whether the aesthetic element is separable from the useful element in a PGS work. See *supra* Part II.C for a discussion of ten of these tests.

¹⁷⁶ *Leicester*, 232 F.3d at 1215.

¹⁷⁷ *Id.* at 1213.

¹⁷⁸ *Id.* at 1215.

veloper to contribute a work of public art to the architectural work of John Hayes in constructing the 801 Tower and the surrounding property because the Los Angeles Community Redevelopment Authority (“CRA”) expected the developer to “make a percent for art expenditure or to pay CRA to construct public art in connection with the development.”¹⁷⁹ The CRA required the artistic development to complete the project area, since “the 801 Tower would not occupy the entire lot,”¹⁸⁰ and expected the “building facade and entrance to the courtyard [of the Zanja Madre work of public art] to share common artistic and architectural elements.”¹⁸¹ This was significant because both Leicester and Hayes “worked together to this end” with Leicester producing three plans, the first two of which were rejected by the CRA and the developer respectively.¹⁸² When Leicester’s third plan¹⁸³ was approved by both the developer and the CRA, Leicester “executed a written contract acknowledging that Zanja Madre was a product of the collaborative design efforts of the artist and architect”¹⁸⁴ and giving the developer “a perpetual irrevocable license to make reproductions of Zanja Madre.”¹⁸⁵ As required by the CRA and the developer, Leicester’s work of art shared design elements with the 801 Tower; par-

¹⁷⁹ *Id.* at 1214.

¹⁸⁰ *Id.*

¹⁸¹ *Id.*

¹⁸² *Id.*

¹⁸³ *Id.* This 1991 plan outlined the “Zanja Madre” that Leicester finally created, which “tell[s] an allegorical story of the history of Los Angeles”:

In the courtyard proper, there is a fountain consisting of a rock split by an arrowhead from which water flows through a channel representing the “Mother Ditch,” or Zanja Madre, which brought water to Los Angeles in its early history. Also inside the perimeter of the courtyard are two sets of two towers representing the city—two building towers and two towers with drill bits on top. The fountain area and garden, which has benches for public use, represents a mountainous area around Los Angeles that is a source of the city’s water.

Id. In addition to these historical elements, the work included five more towers and gates on the streetside wall of the Zanja Madre courtyard adjacent to Figueroa Street:

Of the five towers comprising the streetwall, the two closest to the building (the “smoke towers”) are topped by a brass metalwork design illustrating smoke flattening out under an inversion layer. The two tallest towers (the “lantern towers”) have a lantern topped with grillwork. The lanterns are at the same height and recall those affixed to the building; the tower bases likewise recall the pilasters of the building. The lantern towers are lit at night (like the lanterns on the building). The grillwork assembly consists of concentric rings that symbolize 1930s-era radio waves and modern telecommunications signals. Between the two lantern towers is a fifth, shorter tower which is capped by a vampire figure and to which the main gates are attached. When closed, the gates represent a vampire bat derived from William Mulholland’s statement that Los Angeles is a “water vampire.”

Id.

¹⁸⁴ *Id.*

¹⁸⁵ *Id.* at 1215.

ticularly the streetwall portion of Leicester's work on Figueroa Street constituted a visible continuation of the overall design of the tower.¹⁸⁶

Warner Bros. approached the developer for permission to use the 801 Tower in *Batman Forever* in 1994.¹⁸⁷ Although the parties did not discuss Zanja Madre specifically, "the parties understood that Warner Bros. would film the property line along Figueroa."¹⁸⁸ In the end, "[t]he 801 Tower and the two lantern towers and two smoke towers in the [Figueroa] streetwall appear briefly as background in a few scenes in the movie."¹⁸⁹ After Warner Bros. filmed these portions of Zanja Madre, Leicester registered it as a PGS work under § 102(5)(a) and sued Warner Bros. for violation of his copyright.¹⁹⁰

b. *Batman undeterred: Affirming the district court in Leicester.* The District Court for the Central District of California rejected Leicester's arguments in his claim that Warner Bros. violated his copyright of Zanja Madre. Part of the district court's approach consisted of using a two-step incorporation or "integrated concept"¹⁹¹ test to determine whether an attached PGS work should be considered part of the architectural work for purposes of the AWCPA. First, the district court found that "the two lantern towers and the two smoke towers have functional aspects designed to be part of the building plan and from their appearance are designed to match up with the architecture of the building."¹⁹² Then, the court found that "the artistic work at the tops are incorporated into the tower structure and design, and are therefore an integrated part of the 'architectural work.'"¹⁹³ Thus, because the artistic work was (1) a functional, and (2) an integral part of the architectural work, the AWCPA protected it together with the architectural work as an integrated whole, thus subjecting the attached PGS works to the pictorial representation limitation of the AWCPA.¹⁹⁴

On appeal, the Ninth Circuit affirmed the district court's approach. The court found that the 801 Tower's streetwall was "plainly covered"¹⁹⁵ by the AWCPA. That is, Leicester's artistic work at issue—the Figueroa streetwall and the lantern and smoke towers—was "part of

¹⁸⁶ *Id.* at 1214. See *supra* note 183 for the court's description of the gesamtwerk.

¹⁸⁷ *Id.* at 1215.

¹⁸⁸ *Id.*

¹⁸⁹ *Id.* ("The balance of Zanja Madre—the vampire tower and the courtyard portion—do not appear in the film.")

¹⁹⁰ *Id.*

¹⁹¹ *Id.* at 1217.

¹⁹² *Id.* at 1215.

¹⁹³ *Id.*

¹⁹⁴ *Id.*

¹⁹⁵ *Id.* at 1218.

the 801 Tower as a whole. . . . an integrated concept”¹⁹⁶ because “[t]he streetwall was not a creative aspect of Leicester’s work; it was an architectural element mandated by the CRA.”¹⁹⁷ Furthermore, “the streetwall matches the building and gives the impression that the building continues to the end of the property line. The streetwall towers are designed to appear as part of the building.”¹⁹⁸ Thus, the court held that “because the streetwall towers are part of the architectural work,”¹⁹⁹ based on the district court’s “integrated concept”²⁰⁰ test for arriving at the AWCPA’s bright-line copyright protection, they are covered together with the § 102(a)(8) architectural works, subject to the pictorial representation limitation of § 120(a).²⁰¹

Unfortunately, rather than more directly addressing the implications of the AWCPA bright-line rule for the numerous conceptual separability tests, the court focused its attention on the logic behind the § 120(a) exception. The court found that Leicester had no infringement action for Warner Bros.’s pictorial representation of his artistic work since it was “part of the design plan of the building”²⁰² and that if Leicester could sue for infringement anyway, then “§ 120(a)’s exemption for pictorial representations would make no sense.”²⁰³ In short, “it would be counterintuitive to suppose that Congress meant to restrict pictorial copying to some, but not all of, a unitary architectural work.”²⁰⁴ The court, however, affirmed the district court’s rejection of Leicester’s arguments that the AWCPA did not change the protection an attached PGS work could have acquired under the conceptual separability test(s) of the 1976 Copyright Act. In disagreeing with Leicester that the district court had erred in any respect,²⁰⁵ the Ninth Circuit thus affirmed the district court’s holding that

the intent of Congress [in passing the AWCPA] was to substitute the new protection afforded architectural works [§ 102(a)(8) coupled with the § 120(a) pictorial representation limitation] for the previous protection sometimes provided under the conceptual separability test for non-utilitarian sculptures (such as gargoyles and stained glass windows) incorporated into a work of architecture.²⁰⁶

¹⁹⁶ *Id.* at 1217.

¹⁹⁷ *Id.* at 1218.

¹⁹⁸ *Id.*

¹⁹⁹ *Id.* at 1219.

²⁰⁰ *Id.* at 1217.

²⁰¹ *Id.* at 1219.

²⁰² *Id.* at 1217.

²⁰³ *Id.* at 1219.

²⁰⁴ *Id.* at 1220.

²⁰⁵ *Id.* at 1214.

²⁰⁶ *Id.* at 1215.

In this way, then, the *Leicester* court shored up architectural works from falling into the conceptual separability conundrum presented by the useful articles doctrine. But the court's defense of the AWCPA's bright line was not as pronounced as it might have been, as Judge Tashima pointed out in his concurring opinion.

c. No Riddle(r) about conceptual separability: the clarifying concurrence. The *Leicester* concurrence throws the AWCPA's bright-line rule into stark relief, pointedly discarding the conceptual separability test for works of architecture or their attached PGS works. True, the *Leicester* court showed admirable constraint in construing the AWCPA in accordance with its congressional intent, rather than venturing into the equities for a judge-made solution.²⁰⁷ But despite affirming the district court's rejection of conceptual separability for architectural works, the *Leicester* court nevertheless indulged in a tangential conceptual separability analysis, almost as an afterthought. In a one-paragraph conceptual separability evaluation, the court found that Leicester's works were not conceptually separable precisely because "of the functional and architectural vocabulary of the building,"²⁰⁸ an apparent reference to the district court's "integrated concept" test. Because of the confusion that this unnecessary tangent could engender, the *Leicester* concurrence focused specifically on conceptual separability after the AWCPA.

In concurring in the decision, Judge Tashima clarified the position of the district court and sided more closely with it than even the court had done. "I disagree only with [the court's] conclusion that the district court found that the streetwall towers were *not* 'conceptually separate' from the building."²⁰⁹ That is, Judge Tashima correctly noted that "the district court found it unnecessary to decide whether the streetwall towers were conceptually separable because it concluded as a matter of law that 'the enactment of Section 120(a) had the effect of limiting the conceptual separability concept to situations not involving architectural works.'"²¹⁰ In a rigorous analysis of the AWCPA, its legislative history, and its internal logic, Judge Tashima found that "the legislative history supports the position that functional PGS works embedded in a building are no longer eligible for conceptual separability treatment."²¹¹ In this scrutiny of the AWCPA, Judge Tashima followed the court in not-

²⁰⁷ Compare *supra* Part II.C for an analysis of the proliferation of conceptual separability tests proceeding from the bench pursuant to ambiguities in the statutory language of the Copyright Act of 1976 in adding PGS works as a protected category.

²⁰⁸ *Leicester*, 232 F.3d at 1219.

²⁰⁹ *Id.* at 1220–21 (Tashima, J., concurring).

²¹⁰ *Id.* at 1221.

²¹¹ *Id.* at 1222–23.

ing the inconsistency of conceptual separability and the pictorial representation limitation.²¹²

Finally, Judge Tashima concluded his concurrence by highlighting the bright line in the AWCPA much more clearly than the court had done. Specifically, under the AWCPA “all protectable elements of an architectural work are protected exclusively under § 102(a)(8) so that there is no need to determine whether any part of the work may be considered a conceptually separable PGS work.”²¹³ Even though “Congress was not as clear as it could have been in enacting the AWCPA,”²¹⁴ Judge Tashima reinforced the judicial role of “constru[ing] the Act so as to effectuate congressional intent, as evidenced by the legislative history and common sense.”²¹⁵ Thus, Judge Tashima observed that under the AWCPA, “§ 102(a)(8) now provides the *sole source of copyright protection* for functional PGS works embodied in an architectural work.”²¹⁶ This interpretation “gives meaning and substance to the pictorial representation exemption Congress enacted in § 120(a).”²¹⁷ Ironically, however, as the dissent pointed out, ambiguity in both the statute and the legislative history opened the door for conceptual separability to enter the architectural works context, the exact result that Congress meant to avoid in the AWCPA.²¹⁸

d. *Dissenting discontent: A Two-face approach to architectural PGS works?* In his *Leicester* dissent, Judge Fisher stressed that an author of an attached PGS work should be able to elect the preferred protection, either under § 102(a)(5) or § 102(a)(8). The result of this would naturally be that “if the streetwall towers were conceptually separable from the 801 Tower, it should receive protection as a sculptural work pursuant to Section 102(5) [sic] of the Copyright Act”²¹⁹ because § 102(a)(5) for PGS works is not subject to the pictorial representation limitation as are architectural works. Judge Fisher based his views largely on a

²¹² *Id.* at 1223 (“[P]roviding full § 102(a)(5) protection to a PGS work embodied as a functional element in an architectural work would eviscerate the pictorial representation exception because one could not photograph, draw, paint, etc. (subject to the fair use doctrine) any building that had such a PGS work embodied in it.”).

²¹³ *Id.* at 1224.

²¹⁴ *Id.*

²¹⁵ *Id.*

²¹⁶ *Id.* (emphasis added).

²¹⁷ *Id.*

²¹⁸ See H.R. REP. NO. 101-735, at 20 (1990), reprinted in 1990 U.S.C.C.A.N. 6935, 6951.

²¹⁹ Alicia Morris Groos, *Development in U.S. Copyright Law 2000-2001: From Revising the Old South to Redefining the Digital Millennium*, 10 TEX. INTELL. PROP. L.J. 111, 165 (2001).

“cryptic and ambiguous”²²⁰ footnote in the legislative history’s discussion of election of remedies. First, Congress had clarified that “[a]n individual creating an architectural work by depicting that work in plans or drawing will have two separate copyrights, one in the architectural work . . . the other in the plans or drawings Either or both of these copyrights may be infringed and eligible separately for damages.”²²¹ The legislative history appended this explanation with Footnote 41:

[C]ertain works of authorship which may separately qualify for protection as pictorial, graphic, or sculptural works may be permanently embodied in architectural works. Stained glass windows are one such example. Election is inappropriate in any case where the copyright owner of a pictorial, graphic, or sculptural work embodied in an architectural work is different from the copyright owner of the architectural work.²²²

Judge Fisher understood this as possibly meaning that § 102(a)(5) would cover both copyright holders in such a case, rendering election inappropriate.²²³ But Judge Tashima cogently responded that “Congress meant that election is inappropriate because both copyright holders are limited to § 102(a)(8) protection, given the inapplicability of the conceptual separability doctrine.”²²⁴ Only this latter interpretation of Footnote 41 is consistent both with the pictorial representation limitation, as Judge Tashima noted,²²⁵ and with the legislative history’s direct expression of the desire to avoid conceptual separability in this context.²²⁶

2. Successful banishment of conceptual separability?

The district court in *Leicester* banished conceptual separability more clearly in accordance with the legislative intent behind the AWCPA than did the Ninth Circuit on appeal. When Leicester argued in the district court that the 1990 amendments were not meant to take rights away from authors of attached PGS works who could obtain protection under the Copyright Act of 1976 if their works were conceptually separable from an uncopyrightable architectural work,²²⁷ the

²²⁰ *Leicester*, 232 F.3d at 1229 (Fisher, J., dissenting).

²²¹ H.R. REP. NO. 101-735, at 19 (1990), reprinted in 1990 U.S.C.C.A.N. 6935, 6950.

²²² *Id.* at 19 n.41.

²²³ *Leicester*, 232 F.3d at 1230 (Fisher, J., dissenting).

²²⁴ *Id.* at 1223 (Tashima, J., concurring).

²²⁵ *Id.*

²²⁶ H.R. REP. NO. 101-735, at 20 (1990), reprinted in 1990 U.S.C.C.A.N. 6935, 6951 (expressing the desire to spare judges the conceptual separability conundrum when adjudicating about the copyrightability of architectural works).

²²⁷ *Leicester v. Warner Bros.*, 47 U.S.P.Q.2d 1501, 1998 WL 34016724, at *8 (C.D. Cal. May 29, 1998).

district court specifically found that “the intent of Congress was to substitute the new protection afforded architectural works for the previous protection sometimes provided under the conceptual separability test.”²²⁸ It is true that the Ninth Circuit affirmed the district court on this point.²²⁹ But in its otherwise conscientious decision, the *Leicester* court dismissed Leicester’s argument that the artistic work was conceptually separable from the 801 Tower by carelessly engaging in a superficial conceptual separability analysis,²³⁰ rather than by declaring that it did not matter whether it were conceptually separable or not under the new bright-line rule. By resisting this temptation, the *Leicester* court could have closed the door more cleanly on conceptual separability, which it had already done elsewhere in the decision.²³¹ However, the *Leicester* concurrence directly addressed any lingering ambiguity left by the court’s decision about whether the conceptual separability tests have any place under the AWCPA: “all protectable elements of an architectural work [including attached PGS works] are protected exclusively under § 102(a)(8),”²³² which is subject to the pictorial representation limitation.²³³ Thus, both the court and the concurrence in *Leicester* implemented the AWCPA’s bright-line rule based on the statute and its legislative history.

B. *Implications of the Bright-line Rule in the AWCPA*

The AWCPA’s bright-line rule granting attached PGS works protection together with the underlying architectural work affects architects, artists, and judges in different ways. Because artists now share copyright protection for an “integrated concept”²³⁴ with the architect, artists will need to approach such projects with an awareness of the higher bargaining power the AWCPA gives them. Furthermore, this bright-line rule, as recognized and applied in *Leicester*,²³⁵ simplifies an absurdly complex matrix of conceptual separability tests for the benefit of judges, who cannot avoid subjectivity in aesthetic determinations, their best efforts to the contrary notwithstanding.²³⁶

²²⁸ *Id.*

²²⁹ *Leicester*, 232 F.3d at 1214.

²³⁰ *Id.* at 1219 n.3.

²³¹ *See, e.g., id.* at 1214–15.

²³² *Leicester*, 232 F.3d at 1224 (Tashima, J., concurring).

²³³ *See supra* text accompanying notes 207–218 for an analysis of the concurring opinion in *Leicester*.

²³⁴ *Leicester*, 232 F.3d at 1217.

²³⁵ *See supra* Part IV.A.

²³⁶ *See Yen, supra* note 4, at 250.

1. More bargaining power for contracting artists of PGS works

Artists of attached PGS works now find themselves in a different position vis-à-vis architects or developers than they were before 1990. In truth, these artists have lost a measure of the separate protection they could have expected for their works that were conceptually separable from utilitarian works of architecture.²³⁷ But this does not mean that they are in a worse position. That is, as the *Leicester* concurrence noted, the “effect” of this limitation on the separate protectability of an attached PGS work “can be minimized through contract” because “an artist whose work will be incorporated into a building may demand more compensation to give up his copyright or, alternatively, the architect and artist may register a single copyright as joint authors of the entire work.”²³⁸ In other words, this new regime under the AWCPA puts artists into a better bargaining position to protect themselves through thoughtful contracting from the outset. Because they cannot protect their work separately from the architectural work after *Leicester*, they now bring more clout to the bargaining table. This new approach at least boasts more certainty of protection than did the old method of registering a work under the PGS provision of § 102(a)(5) and then, when trying to enforce that protection, hoping that a judge would be aesthetically amenable to the idea that the work is indeed conceptually separable.

2. Saving the judges and avoiding aesthetic controversy

By sincerely searching out Congress’s intent in passing the AWCPA, which admittedly could have been more clearly written, the *Leicester* court effectuated the reason behind protecting architectural works and their attached PGS works together under the new § 102(a)(8). As noted in the legislative history, “the principal reason for not treating architectural works as [PGS] works” was “to avoid entangling architectural works in [the] disagreement”²³⁹ between courts as to the application of conceptual separability. This desire may have been a recognition of the fact that the maxim of equity *lex non exacte definit, sed arbitrio boni viri permittit*²⁴⁰ is inimical to the aesthetic objectivity required of judges in copyright adjudication.²⁴¹ Or it may have simply

²³⁷ See Orlandi, *supra* note 130, at 619.

²³⁸ *Leicester*, 232 F.3d at 1224 n.4 (Tashima, J., concurring).

²³⁹ H.R. REP. NO. 101-735, at 20 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6951.

²⁴⁰ See BLACKSTONE *supra* note 2.

²⁴¹ See *supra* text accompanying notes 18–37 for a discussion of *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239 (1903) and Justice Holmes’s demand for aesthetic objectivity—still adhered to at least in form more than 100 years later—in copyright adjudication.

been a congressional desire to learn from the mistakes of the Copyright Act of 1976, which created an inadequately defined separability test that necessarily gave rise to as many as ten, possibly more, judge-made conceptual separability tests.²⁴² Either way, after the AWCPA—through the *Leicester* court’s lucid statutory construction based on the legislative intent—judges are now “free to decide the issue [of protectability] upon the facts presented, free of the separability conundrum presented by the useful articles doctrine applicable for PGS works”²⁴³ under the Copyright Act of 1976. Thus, the AWCPA’s bright-line rule saves judges from sinking into the quagmire of conceptual separability and wallowing in the masked aesthetic subjectivity that abounds there.

V. CONCLUSION: THE LANGUAGE OF THE LEGISLATION—“PERHAPS FAULTY, PERHAPS GRATUITOUS”

Despite imperfections in the statutory language, the court in *Leicester* correctly implemented Congress’s legislative intent in passing the AWCPA. By creating a bright-line rule, Congress spared future judges considering the copyrightability of PGS works attached to architectural works from choosing between numerous conceptual separability balancing tests and the resulting aesthetic judgments that contradict essential policy behind copyright law in their determinations. The impossibility of true objectivity in matters of aesthetic judgment necessitated Congress’s action in formulating a bright-line rule for application in these types of cases. In this way, Congress eliminated the risk that judges would provide *de facto* governmental subsidies for certain attached PGS works while denying them to others merely on the basis of subjective taste.

Language in the statute regarding the pictorial representation exception and the misinterpreted dual coverage for attached PGS may indeed have been “perhaps faulty, perhaps gratuitous,”²⁴⁴ but if so, then Congress itself is more institutionally suited to make appropriate changes. Courts should not attempt to amend an ambiguous statute through adjudication, particularly in an area as value-sensitive as copyright law.²⁴⁵ In copyright law, where judges “must realize that their personal perspectives and experiences are deeply implicated in their

²⁴² See *supra* Part II.C.

²⁴³ H.R. REP. NO. 101-735, at 21 (1990), reprinted in 1990 U.S.C.C.A.N. 6935, 6952.

²⁴⁴ Mathis, *supra* note 28, at 598.

²⁴⁵ Compare Orlandi, *supra* note 130, at 644–52 (disregarding the legislative intent behind the AWCPA in suggesting a six-factor test to fix apparent inequities in the AWCPA’s bright-line rule).

adjudication,”²⁴⁶ judges should give strict effect to the legislative intent behind a statute such as the AWCPA when ambiguity exists in “faulty” or “gratuitous” statutory language. By giving the congressional intent behind the AWCPA’s bright-line rule the effect of *stare decisis*, the *Leicester* court admirably fulfilled this strict role.

²⁴⁶ Yen, *supra* note 4, at 251 n.15.