

SUPREME COURT'S *STAR ATHLETICA* DECISION ON USEFUL ARTICLES: HOW WE GOT THERE AND WHERE IT TAKES US

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*Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function.*¹

On March 22, 2017, the Supreme Court attempted to undo this knotty issue by affirming the Sixth Circuit in *Star Athletica, LLC v. Varsity Brands, Inc.*² It held that two-dimensional designs placed on cheerleader uniforms could be subject to copyright protection notwithstanding the utilitarian nature of the uniforms themselves, which are not otherwise subject to protection under the Copyright Act.

Varsity Brands owned more than 200 copyright registrations for two dimensional designs — consisting of various lines, chevrons, and colorful shapes — appearing on the surface of cheerleading uniforms that they designed, made, and sold. Star Athletica made competing uniforms that copied some of those designs, including these:



The issue presented to the Court was whether these designs were eligible for copyright protection independent of the uniforms on which they appeared, or were so intertwined with the uniforms as useful articles of apparel so as not to be separable. Under § 101 of the Copyright Act, “the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorpo-

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¹ Jane Ginsberg, *Courts Have Twisted Themselves into Knots: U.S. Copyright Protection for Applied Art*, 40 COLUM. J.L. & ARTS 1, 2 (2016).

² 137 S. Ct. 1002 (2017).

rates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”³

Historically, apparel designs — the cut and shape of a garment — have not been entitled to protection under U.S. copyright law because they are deemed useful articles. This is made clear by the Copyright Office *Compendium* (3d ed.), which provides: “Clothing such as shirts, dresses, pants, coats, shoes, and outerwear are not eligible for copyright protection because they are considered useful articles. This is because clothing provides utilitarian functions, such as warmth, protection, and modesty.”⁴ However, original designs imprinted or embedded on otherwise utilitarian objects may still be protected if they “are considered conceptually separable from the utilitarian aspects of garments, linens, furniture, or other useful articles [and] a fabric or textile design may be registered if the design contains a sufficient amount of creative expression.”⁵

Over fifty years ago, the Supreme Court grappled with a similar issue in *Mazer v. Stein*.⁶ There, a statuette in the form of a dancer that was used as the base of an otherwise utilitarian lamp was held to be protected because the sculptural design was separable and could physically exist separately from the lamp, which could still function as a utilitarian item without it.

In the Second Circuit’s landmark decision in *Kieselstein-Cord v. Accessories by Pearl, Inc.*,⁷ the court held that applied sculptural art designs on belt buckles were protectable, noting: “This case is on a razor’s edge of copyright law.” The Second Circuit grappled with the issue of determining when a pictorial, graphic, or sculptural feature can be identified separately from, and be capable of existing independently of, the utilitarian aspects of an article under the Copyright Act, noting that the legislative history indicated that such separability could occur either “physically or conceptually.” The primary ornamental aspects of the buckles were deemed to be “conceptually separable” from their underlying utilitarian function, and the buckles themselves constituted creative art.

³ Section 101 defines “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.”

⁴ U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.3(A) (3d ed. 2017) (Clothing Designs) [hereinafter COMPENDIUM 3D].

⁵ *Id.* § 924.3(A)(1) (Fabric and Textile Designs Embodied in Clothing or Other Useful Articles).

⁶ 347 U.S. 201 (1954).

⁷ 632 F.2d 989 (2d Cir. 1980).

Later cases relying on *Mazer* and *Kieselstein-Cord* went in different directions. In *Carol Barnhart, Inc. v. Economy Cover Corp.*,⁸ a divided Second Circuit panel held that life-sized, anatomically correct human torso forms were not non-copyrightable because the features claimed to be aesthetic were “inextricably intertwined with the utilitarian feature, the display of clothes.”⁹

In *Brandir International, Inc. v. Cascade Pacific Lumber Co.*,¹⁰ a “Ribbon Rack” bicycle rack made of bent tubing, originating from a wire sculpture, was held not to be copyrightable because “the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements.”¹¹ The court adopted a test based on conceptual separability, such that “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.”¹²

The Third Circuit upheld the copyrightability of masks designed with animal-shaped noses. It emphasized that: “Courts have twisted themselves in knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article’s utilitarian function.”¹³

In 2004, the Seventh Circuit held that bald female human head mannequins depicting facial features imitating the “hungry look” of high-fashion, runway models were protectable under the doctrine of conceptual separability because the artistic elements could be identified as “reflecting the designer’s artistic judgment exercised independently of functional influences.”¹⁴

⁸ 773 F.2d 411 (2d Cir.1985).

⁹ *Id.* at 419.

¹⁰ 834 F.2d 1142 (2d Cir. 1987).

¹¹ *Id.* at 1146-47.

¹² *Id.* at 1145.

¹³ *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 670 (3d Cir. 1990)

¹⁴ *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 931 (7th Cir. 2004) (citing *Brandir Int’l, Inc.*, 835 F.2d at 1145).

Mara



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The copyrightability of plush animal bodysuit Halloween costumes was upheld in *Chosun International, Inc. v. Chrisha Creations, Ltd.*¹⁵ (adopting the test for conceptual separability). However, spoon heart + arrow designs on cooking measuring spoons were *not* held protectable based on their being dictated by function.¹⁶

Stitching on the front and sides of a shoe, a strap with visible stitching, and a sole with a pattern of dots that wrapped around the shoe were held not to be copyrightable in *Eliya, Inc. v. Kohl's Department Stores*.¹⁷ The court found that because physical separation would affect the function of the shoe, the design features were not “conceptually separable” and there was no aesthetic decision-making that was independent of functional considerations.

More recently, two different wood designs have received protection, one in the form of table furniture engraved edging designs, *Universal Furniture International, Inc. v. Collezione Europa USA, Inc.*,¹⁸ and the other protecting wood grain designs of flooring tiles.¹⁹

¹⁵ 413 F.3d 324 (2d Cir. 2005).

¹⁶ *Bonazoli v. R.S.V.P. Int'l, Inc.*, 353 F. Supp. 2d 218 (D.R.I. 2005).

¹⁷ No. 06 Civ 195(GEL), 2006 WL 2645196 (S.D.N.Y. Sept. 13, 2006).

¹⁸ 618 F.3d 417 (4th Cir. 2010) (per curiam).

¹⁹ *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404 (11th Cir. 2015).

In the flooring case, the Seventh Circuit viewed the designs as both physically and conceptually severable from the flooring tiles to which they were applied. The flooring and designs were physically severable because evidence showed that otherwise identical flooring was sold that used décor paper with many different designs, and the interchangeability of the paper designs in the manufacturing process implied that the designs and flooring were physically separate objects.

Against this background, the Supreme Court in *Star Athletica* rejected the historical distinctions between “physical” and “conceptual” separability, finding that “physical” separability would require a useful article to remain useful after removal of the design features, whereas “separability does not require the underlying useful article to remain”²⁰ Instead, held the Court, the test is whether “an artistic feature of a design of a useful article . . . is eligible for copyright protection if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article, and (2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article.”²¹ This places the focus of the test on the “extracted” design features and “not on any aspects of the useful article that remain after the imaginary extraction.”²²

Star Athletica’s argument that the Copyright Act protects only “artistic features” that have no effect on a useful article’s utilitarian purpose, was also rejected by the Court because it would undermine protection for “applied art,” which, by definition, is artistic design applied to useful articles. The Court emphasized that an artistic feature, which in itself qualifies for copyright protection, does not lose that protection when it is created to be applied to a useful article.

However, the Court also acknowledged that the meaning of “existing independently” in this context was a difficult question that should be guided by whether a design feature is “able to exist as its own pictorial, graphic, or sculptural work . . . once it is imagined apart from the useful article,” thus implicating “conceptual” separateness.²³ “If the feature could not exist as a pictorial, graphic, or sculptural work on its own, it is simply one of the article’s utilitarian aspects. And to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot be a useful article or ‘[a]n article that is normally a part of a useful article’”²⁴ The Court also relied on *Mazer*, noting in that case it was irrelevant whether

²⁰ *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1014.

²¹ *Id.* at 1016.

²² *Id.* at 1013.

²³ *Id.* at 1010.

²⁴ *Id.* at 1005.

the lamp base statuette had been created initially as a freestanding sculpture or as a lamp base.

The Court had little problem (with Justice Breyer dissenting) applying its test to the surface designs of the cheerleader uniforms, finding that they were readily identifiable as having pictorial, graphic or sculptural qualities, and that if separated from the utilitarian uniforms and applied in another context — such as a “painter’s canvas” — they would constitute “two-dimensional. . . works of art” under § 101. Justice Thomas noted in his majority opinion that even if the design elements fit the “contours” of the uniforms, as argued by Justice Breyer, that is not a bar to copyrightability, because two-dimensional art often corresponds to the contours of its medium, such as a design etched or painted onto the surface of a guitar.

In a concurring opinion, Justice Ginsburg noted that Varsity Brands had used the same designs on other items of apparel, including tee-shirts and jackets. She said that it was not necessary to expound on the separability doctrine, because it was clear these designs were “themselves copyrightable pictorial or graphic works *reproduced* on useful articles.”²⁵

Justice Breyer, however, felt that the designs themselves were not eligible for copyright protection because they could not be perceived as two- or three-dimensional works of art apart from the uniforms. He would not extend protection to any design that would make the useful article non-functional if the design were removed from that article, or, if it would make it non-functional, could not be conceived of separately from the useful article without conjuring up the article itself. These concepts were rejected by the majority.

Just recently, citing *Star Athletica*, the Southern District denied a defendant summary judgment on the issue of copyrightability in a case involving an ornamental lighting set comprised of a series of molded, decorative tear shaped covered lights with a wire frame over the covers.²⁶ Illuminated by the Supreme Court’s guidance, the court found that the “Tear Drop Light Set contains artistic elements that ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’” Nevertheless, there remained issues of fact for trial respecting the originality of the design and ownership of a valid registration.

²⁵ *Id.* at 1018.

²⁶ *Jetmax, Ltd. v. Big Lots, Inc.*, No. 15-cv-9597 (KFB), 2017 WL 3726756 (S.D.N.Y. Aug. 28, 2017).



Despite historical significance as only the second Supreme Court decision to address useful article designs, *Star Athletica* is not a sea change in the law, but an important clarification that firmly rejects physical separability as a basis for copyright protection. The decision still leaves important questions to be decided on a case by case basis, including the core issue of originality of designs. In that context, what constitutes an independently protectable “pictorial, graphic and sculptural work” will continue to present challenges. As the level of originality required for copyright protection is “extremely low” and creativity only need be “minimal” under *Feist Publications, Inc. v. Rural Telephone Service Co.*,²⁷ the test could be very broadly applied, with judges reluctant to find a design subjectively not worthy of protection. Indeed, long ago the Supreme Court cautioned that “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.”²⁸

There is also a fine line between the designs imprinted on the *Star Athletica* uniforms and common chevrons, polka dots, checkerboards and houndstooth designs that are *not* entitled to protection in and of themselves under the Copyright Act.²⁹ However, a composite of common graphic shapes can be entitled to protection if sufficiently original, as found in *Star Athletica*. Indeed, the Copyright Office *Compendium* em-

²⁷ 499 U. S. 340 (1991).

²⁸ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

²⁹ COMPENDIUM 3D, *supra* note 4, § 313.4(J) (Familiar Symbols and Designs) (“Familiar symbols and designs are not copyrightable and cannot be registered with the U.S. Copyright Office Examples . . . include, without limitation: Common patterns, such as standard chevron, polka dot, checkerboard, or houndstooth designs.”).

phasizes: “While familiar symbols and designs cannot be registered by themselves, a work of authorship that incorporates one or more of these elements into a larger design may be registered if the work as a whole contains a sufficient amount of creative expression.”³⁰

³⁰ *Id.*