

# Supreme Court Expands Copyright Protection for Designs Originally Produced on Useful Articles

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On March 22, 2017, the Supreme Court (in a 6-2 decision) ruled that a stripes and chevron pattern on a cheerleading uniform may be eligible for copyright protection and that the separability test under 17 U.S.C. §101 did not require that the separated design have no functional purpose or that the underlying useful article maintain its full function without the design. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (U.S. Mar. 22, 2017). Today's ruling impacts parties that create products with design attributes, especially clothing, as well as those potentially faced with accusations of copyright infringement for designs on "useful" articles. Such parties will want to consider how today's ruling impacts their copyright filing practices and enforcement activities and defenses.

*Star Athletica* involved a copyright dispute brought by plaintiff Varsity Brands against defendant Star Athletica. Varsity Brands marketed and sold cheerleading uniforms and obtained five copyright registrations on the designs of these uniforms. It alleged Star Athletica infringed these copyrights with its competing cheerleading uniforms. The district court granted summary judgment for the defendants because it found that the designs did not qualify as protectable pictorial, graphic, or sculptural works under 17 U.S.C. §101. Under §101, if a design is originally incorporated onto a "useful article" it is only eligible for copyright protection if "such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." The district court found the stripes and chevron design served the "utilitarian" function of identifying the uniforms as cheerleading uniforms. In other words, if one removed the design, the left behind blank uniform would not be recognizable as a cheerleading uniform.

The Court of Appeals for the Sixth Circuit reversed, finding that the graphic designs were separately identifiable. In its opinion, one could have the copyrighted graphic designs on their own and 'side-by-side' with the blank cheerleading uniforms.

The majority of the Supreme Court agreed with the Sixth Circuit.

The first question the Supreme Court tackled was whether separability test of §101 applied. The majority found that it did. According to the majority, all designs that are originally embodied in useful articles will require the separability analysis of §101.

In this case, however, the design was originally produced as a sketch of a cheerleading uniform on paper. Thus, it was not necessarily originally embodied in a useful article, and the plaintiff filed these sketches with the Copyright Office. The United States argued that, therefore, the §101 separability test was not triggered. The original copyrights were not designs *of* useful articles, but rather copyrightable works *reproduced on* useful articles by the defendants (when they made the alleged infringing uniforms). The plaintiff's original copyright thus (according to the government) fell outside of §101 as it was originally produced on a tangible medium, not a useful article.

The majority of the Supreme Court refused to answer this question as the parties did not raise it, only the government. The Supreme Court assumed, therefore, that the original design was first embodied on a useful article, and thus §101 applied. However, Justice Ginsburg, in a concurring opinion, found that the designs themselves (as registered) did not fall under the separability test under §101. *Id.* at \*14. In the future, parties may be able to avoid the separability test all together if the original artwork is produced on paper (or some other tangible medium) and not on a useful article in the first instance.

The Supreme Court then turned to applying the separability test, enunciating the following two-part test under §101:

a feature incorporated into the design of a useful article is eligible for copyright protection only 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 fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated

*Id.* at \*4. The first step, according to the Court, should be dispensed with ease. "The decision maker need only be able to look at the useful article and spot some two-or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities" for the first step to be satisfied. *Id.* at \*7.

The real dispute, then, turned on the second issue: "whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article." *Id.* at \*8.

For this, the majority of the Supreme Court ruled that the underlying design, when visualized separately, did not need to be "purely artistic" (i.e. retain no functional aspect, such as the shape of a cheerleading uniform). The Supreme Court reasoned that requiring protection only for *solely* artistic features would read out "applied art" from the statute. See 17 U.S.C. §101 ("Pictorial, graphic, and sculptural works include two-dimensional and three-dimensional works of fine, graphic, and applied art.").



Further, the Supreme Court rejected the argument that the remaining article must retain its complete function. The remaining article would have been a plain white uniform without the aspects that identify it as a "cheerleading" uniform (i.e. the stripes and chevron pattern). However, under the Supreme Court's test, the functionality of the leftover article is no longer relevant. The focus of the separability inquiry should be "on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction." *Id.* at \*11. By this ruling, the Supreme Court abandoned the distinction some courts had applied based upon "physical" separability and "conceptual" separability.

Thus, even though a design may have utilitarian purposes, and even if the useful article loses those features when the design is conceptually removed, the design is still eligible for copyright protection. This decision expands copyright protection for designs that are primarily made for use on useful articles, such as clothing. Designs for these articles have historically missed the separability hurdle due to their primarily utilitarian functions, yet they may find an easier path to protection in the future due to *Star Athletica*.

If you have any questions regarding this alert, please contact your Lathrop Gage attorney or the attorneys listed above.