



## ARE Copyright Law Alert: Supreme Court Clarifies Standard of “Separability” for Copyright Protection for Features Incorporated into Design of Useful Article

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On March 22, 2017, the Supreme Court of the United States issued its decision in *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, affirming the decision of the United States Court of Appeals for the Sixth Circuit which held that graphic designs appearing on cheerleading uniforms were copyrightable. Slip op. at 2-3. The Court provided long sought after clarification as to what constitutes “separability” in the context of clothing, holding that an artistic feature incorporated into the design of clothing “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.”

Slip op. at 17.

The Copyright Act provides protection for “original works of authorship fixed in any tangible medium of expression,” including “pictorial, graphic, and sculptural works.” 17 U.S.C. § 102(a)(5). However, useful articles are not entitled to copyright protection. Accordingly, the Copyright Act provides that “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.**” 17 U.S.C. § 101 (emphasis added). The emphasized language is the crux of the current dispute, and where categories of goods have long been found to include “separable” and thus, copyrightable designs (such as lamps, belt buckles, and jewelry), clothing has generally been immune.

Here, Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc. (collectively, “Varsity Brands”) filed suit against Star Athletica, LLC (“Star Athletica”) asserting copyright infringement of five, two-dimensional designs



such as chevrons that are sewn onto the surface of cheerleading uniforms. In response, Star Athletica argued that the designs did not qualify as protectable pictorial, graphic, or sculptural works. The District Court for the Western District of Tennessee agreed and entered summary judgment for Star Athletica on the ground that “it is not possible to physically or conceptually sever Varsity’s designs from the utilitarian function of the resulting cheerleading uniforms.” *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 U.S. Dist. LEXIS 26279, at \*26 (W.D. Tenn. Mar. 1, 2014).

In reviewing the district court’s decision, the United States Court of Appeals for the Sixth Circuit reversed and concluded that the graphic features of Varsity Brand’s designs are copyrightable subject matter. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 492 (6th Cir. 2015). The Court of Appeals held that “the Copyright Act protects the ‘pictorial, graphic, or sculptural features’ of a design of a useful article **even if those features cannot be removed physically from the useful article, as long as they are conceptually separable from the utilitarian aspects of the article.**” *Id.* at 483 (emphasis added). The Court of Appeals rejected the argument that Varsity Brand’s designs were “inextricable intertwined with the utilitarian aspects of a cheerleading function.” *Id.* at 490. Rather, “the arrangement of stripes, chevrons, color blocks, and zigzags are ‘wholly unnecessary to the performance of’ the garment’s ability to cover the body, permit free movement, and wick moisture.” *Id.* at 492.

In affirming the Court of Appeals decision, the Supreme Court looked to the history and text of the Copyright Act which indicates that the exclusive right of a copyright owner to reproduce copyrighted work “includes the right to reproduce the [copyrighted] work in or on any kind of article, whether useful or otherwise.” Slip op. at 8. Thus, the Supreme Court considered the mirror image of this language in Section 101 to clearly extend copyright protection to pictorial, graphic, and sculptural works regardless of whether they were created as features of useful articles. *Id.* Thus, “a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial graphic, or sculptural work either on its own or when fixed in some other tangible medium.” *Id.*

The Supreme Court (per Justice Thomas) found that the application of this rule to Varsity Brand’s designs was “straightforward” since they have “pictorial, graphic, or sculptural qualities” and if separated from the cheerleading uniforms would qualify for copyright protection as a two-dimensional work of art. *Id.* at 10-11. The Supreme Court rejected the argument that an artistic feature may exist independently only if the useful article from which it was extracted would remain equally useful. *Id.* at 12-15. Likewise the Supreme Court rejected Star Athletica’s argument that its test should incorporate two objective components such as “whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influence,” and whether the design feature “would still be marketable to some significant segment of the community without its



utilitarian function.” *Id.* at 15-16. Finally, the Supreme Court rejected the argument that allowing “surface decorations to qualify as a ‘work of authorship’ is inconsistent with Congress’ intent to entirely exclude industrial design from copyright.” *Id.* at 16-17.

In her concurrence, Justice Ginsburg explained that consideration of the separability test was unwarranted since the designs at issue are not designs of useful articles, but rather are copyrightable pictorial or graphic works themselves which are reproduced on useful articles. Conc. op. at 1.

Justice Breyer, joined by Justice Kennedy, dissented on the basis that Varsity Brand’s designs do not meet the majority’s test for copyrightability since they could not exist independently of the utilitarian aspects of the cheerleading uniform. Dissent op. at 1.

We will continue to monitor the courts for the latest applications of the Supreme Court’s new two-part test for determining whether an artistic feature incorporated into the design of a useful article is eligible for copyright protection: “(1) can it be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would it 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.” Slip op. at 17.

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