

ALERTS

Copyright Rah-Rah: High Court Issues Decision In *Star Athletica V. Varsity Brands*

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On March 22, the U.S. Supreme Court decided *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, a case involving the copyrightability of designs on articles of clothing. The court held that:

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.

The articles at issue were cheerleading uniforms, and the designs at issue were “combinations, positionings, and arrangements of elements” that include “chevrons . . . , lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring, and shapes.” Two representative examples of the uniforms and designs at issue are shown below:



The U.S. District Court for the Western District of Tennessee had entered summary judgment in favor of *Star Athletica*, the accused infringer, holding that the designs were not entitled to copyright protection because they could not be separated from the utilitarian function of the uniforms. The U.S. Supreme Court affirmed the U.S. Court of Appeals for the Sixth Circuit’s reversal, finding that the artistic features of the designs on the uniforms satisfied both prongs of its test.

Case law from the lower courts had created a pretzel of different, and

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sometimes irreconcilable, tests for drawing the line between the expressive (protected) and functional (unprotected) aspects of useful objects. The parties' positions in the case mirrored the courts' state of confusion. Star Athletica argued that copyright protection excludes garments unless the design feature is entirely and physically separable from the useful functions of the garment. Because the principal design features of Varsity Brands' uniforms are essential to the use of the article as a cheerleading uniform, they are not separable from the uniform and therefore cannot receive copyright protection. Varsity Brands, on the other hand, argued that a work is separable if it can exist in a tangible medium other than the uniform. Because the designs on its uniforms can exist on (for example) a piece of paper or a piece of fabric, the designs are protectable.

The Supreme Court agreed with Varsity Brands. The court relied heavily on the plain text of the Copyright Act, which provides that a "pictorial, graphic, or sculptural featur[e]" incorporated into the "design of a useful article" is eligible for copyright protection if it (1) "can be identified separately from," and (2) is "capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. §101.

The court made quick work of the first requirement: "The decisionmaker 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."

The second requirement – of independent existence – was more difficult but the court settled on the following:

The decisionmaker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article. . . . In other words, the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in §101 once it is imagined apart from the useful article.

The court's analysis of the two requirements nets out to this:

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.

Timing does not matter; that is, it does not matter whether the design was freestanding art that was later applied to a useful article, or whether the design was intended at the outset for use on a useful article and then later argued to be freestanding art.

The court found that applying these principles to the surface decorations on Varsity Brands' cheerleading uniforms was "straightforward," explaining:

First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and

applied in another medium—for example, on a painter’s canvas—they would qualify as “two-dimensional . . . works of . . . art,” §101. . . . The decorations are therefore separable from the uniforms and eligible for copyright protection.

The court went out of its way to explain the limits of its holding, as not to give potential litigants hope that copyright can be used to protect the underlying article itself.

To be clear, the only feature of the cheerleading uniform eligible for a copyright in this case is the two-dimensional work of art fixed in the tangible medium of the uniform fabric. . . . [Varsity Brands has] no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear. They may prohibit only the reproduction of the surface designs in any tangible medium of expression—a uniform or otherwise.

In a footnote, the court addressed the dissent’s criticism that the majority’s decision would lead to the copyrighting of shovels. The majority’s response states categorically that a shovel cannot be copyrighted. But, “if the shovel included any artistic features that could be perceived as art apart from the shovel, and which would qualify as protectable pictorial, graphic, or sculptural works on their own or in another medium, they . . . could be copyrighted. But a shovel as a shovel cannot.”

The court also explained that what remains of the useful article after the design has been separated is irrelevant:

The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.

The court also addressed a debate among the lower courts, some of which found that physical separability was required whereas others found that conceptual separability was enough. The court sided with the latter view: “separability is a conceptual undertaking. Because separability does not require the underlying useful article to remain, the physical-conceptual distinction is unnecessary.”

Justice Clarence Thomas wrote the majority opinion. Justice Ruth Bader Ginsburg filed an opinion concurring in the judgment. Justice Stephen Breyer filed a dissenting opinion, in which Justice Anthony Kennedy joined.

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