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Give Me a ©!: U.S. Supreme Court Set to Determine the Proper Test for the Separability of Design Features from Useful Articles under §101 of the Copyright Act

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For nearly a century, U.S. federal courts have struggled with the "metaphysical quandary" involved in determining whether and when certain design features associated with otherwise useful articles are conceptually separable, and thus protectable, under §101 of the Copyright Act. *17 U.S.C. § 101*. Next term, in *Star Athletica, L.L.C. v. Varsity Brands, Inc. et. al. ("Star Athletica")*, the U.S. Supreme Court will finally take up this important issue, weighing in on the proper test to be applied by the lower courts in answering what is arguably one of "the single most vexing, unresolved question[s] in all of copyright": What is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act? No. 15-866 (6th Cir., 799 F.3d 468; 578 U.S. ___, cert. granted May 2, 2016).

Such a test will affect the protection of copyrighted designs in the fashion, footwear, costume, furniture, 3-D printing and many other industries. As a result, *Star Athletica* has captured the attention of the mainstream media and more than a dozen academic, industry, intellectual property and public interest groups and associations. Seven Amici Curiae Briefs were recently filed with the Court – each discussing different implications of the Court's holding as well as the sufficiency of the test for conceptual separability applied by the Sixth Circuit.

Are the designs that appear on cheerleading uniforms conceptually separable or inherently functional?

Star Athletica and Varsity Brands each manufacture and sell cheerleading uniforms and warmup suits. After an initial rejection, Varsity Brands successfully registered numerous copyrights with the U.S. Copyright Office for several of its designs including the color combinations, chevrons, stripes and other ornamentation appearing on the apparel it manufactures and sells. In 2010, Varsity filed suit against its competitor, Star Athletica, alleging copyright infringement of its designs. The district court found for Star, holding that "the colors-and-designs component of a cheerleading uniform cannot be conceptually separated from the utilitarian object itself." *Varsity Brands, Inc. et. al. v. Star Athletica, LLC*, Case No. 10-2508, 2014 WL 819422 (M.D. Tenn. 2010). In short, the court reasoned that "a cheerleading uniform loses its utilitarian function as a cheerleading uniform when it lacks all design and is merely a blank canvas." *Id*.

On appeal, the Sixth Circuit fashioned a tenth version of the separability analysis taking into account five factors distilled from the case law and tests for conceptual separability used by other federal Circuit Courts of Appeals. *Star Athletica, LLC v. Varsity Brands, Inc., et al.*, 799 F.3d 468 (6th Cir. 2015). Under its analysis, in a split decision, the Sixth Circuit reversed, finding that Varsity's designs were, in

fact, separable from the apparel on which they appeared and thus subject to copyright protection. Star moved for a rehearing en banc which was denied pending its Petition for Writ of Certiorari to the U.S. Supreme Court – now granted.

The Doctrine of Conceptual Separability

It is well established that "useful articles" such as chairs, machinery and garments are generally not eligible for protection under the U.S. Copyright Act. However, in the 1976 revision of the Copyright Act, section 101 added what is now known as the doctrine of conceptual separability. *See Mazer v. Stein*, 347 U.S. 201 (1954); *see also* 17 U.S.C. §§ 101, 113. That is, copyright protection may extend to a component part or feature of a useful article where it is a "pictorial, graphic, or sculptural work" that can be "identified separately from, and . . . exist[] independently of, the utilitarian aspects of the article." *Id*. To use the petitioner's example, think "The Spirit of Ecstasy" hood ornament on a Rolls-Royce automobile. The iconic Rolls-Royce ornament – a sculpture – is clearly conceptually separable and able to exist independently from the utility of the automobile on which it is fastened.

The separability analysis, however, becomes far more difficult and abstract when a court is called upon to determine whether and to what extent a component feature of a useful article is separable where the feature could fairly be considered utilitarian, ornamental or both – depending upon the specific analysis applied. And therein lies the problem at issue in *Star Athletica* – there has been no consensus among the federal Circuit Courts of Appeals as to the proper test to be applied in making such determinations. Instead, as the Third Circuit has commented, courts "have twisted themselves into knots trying to create [various] test[s] 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" *Masquerade Novelty, Inc. v. Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990).

Courts remain confounded by the abstractions and nuance inherent in such analyses – having fashioned no less than ten widely divergent tests for determining conceptual separability across the federal Circuit Courts of Appeals. In sum, as Judge McKeague noted in his dissent, without much-needed clarification in this area "courts will continue to struggle and the business world will continue to be handicapped by the uncertainty of the law." *Star Athletica, LLC, 799 F.3d at 496-497 citing Fashion Originators Guild of Am. v. Fed. Trade Comm'n*, 114 F.2d 80, 81 (2d Cir.1940) (Hand, J.). Having granted Star Athletica's petition, the Supreme Court is now poised to hear argument and, hopefully, provide clarity in the form of a controlling standard by which the separability of features from useful articles will be tested in the courts below.

The Potential Implications And Likely Outcome In Star Athletica

Given that the test for conceptual separability applies equally to any pictorial, graphic, or sculptural work that is a conceptually separable feature or component of a useful article, the legal and practical implications of the Supreme Court's holding in *Star Athletica* could be extensive. The petitioner and various amici have advanced a plethora of potential implications should the Court affirm the Sixth Circuit's holding. These potential repercussions range from constitutional concerns to the chilling effect such a holding could have on creativity, innovation and competition in a diversity of marketplaces including the fashion, costuming, 3-D printing and furniture design industries.

While the Court's holding could alter the balance between copyright and patent protections and affect a sea change, such an extreme outcome is not likely. While it is, of course, impossible to predict the Court's treatment of this issue, the Court has historically taken a more tempered approach grounded in statutory construction and Congressional intent. If the same holds true here, the Court is more likely to craft an objective, fact-based, test for conceptual separability that provides for narrow protection under section 101 of the Copyright Act – and only then for clearly separable nonfunctional features of useful articles that can be identified and isolated without resort to the metaphysical analyses courts have engaged in for decades.

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