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SCOTUS Determines That Decorations on Cheerleading Uniforms Are Conceptually Separable From Uniforms and Eligible For Copyright Protection

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On March 22, 2017, the Supreme Court of the United States issued a 6-2 ruling in *Star Athletica, L.L.C. v. Varsity Brands, Inc., et al.*, holding the decorative elements on Varsity Brands' cheerleading uniforms were conceptually separable two-dimensional graphic works, and therefore eligible for copyright protection.

In so holding, the Court affirmed the Court of Appeals for the Sixth Circuit's finding that the decorations could be "identified separately" and were "capable of existing independently" of the cheerleading uniforms, and thus protectable under Section 101 of the Copyright Act.

By way of background, Varsity Brands, Inc., et al., design, manufacture, and sell cheerleading uniforms, and own over 200 U.S. copyright registrations for various two-dimensional decorations that appear on the surface of their uniforms (e.g. "chevrons...curves, stripes...coloring, and shapes"). Varsity Brands sued Star Athletica, L.L.C., a rival cheerleading uniform manufacturer and retailer, for infringing five of their registered copyrights. Star Athletica relied on the commonly held proposition that apparel is usually outside the scope of the Copyright Act, which bars protection for "useful articles", and argued that the Varsity Brands design patterns were useful as applied to cheerleading uniforms. While the District Court granted Star Athletica summary judgment, the Sixth Circuit reversed in favor of Varsity Brands, and the Supreme Court affirmed.

The Supreme Court majority found the holdings in *Mazer v. Stein*, 347 U.S. 201 (1954)[\[1\]](#) and the "mirror image" protections offered under the Copyright Act's Sections 101 and 113(a) [\[2\]](#) instructive in its application of a separability analysis to Varsity Brands' uniforms' decorative elements. The Supreme Court reasoned if "a design would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article." As a result, the Court held that a feature of the design of a useful article is eligible for copyright if: (1) when identified and imagined apart from the useful article (2) it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.

The Court's application of this test led it to conclude that: (1) Varsity Brands' decorations were identifiable as features having pictorial, graphic, or sculptural qualities; and (2) the ability to separate Varsity Brands' decorations from the surface of its uniforms and apply them to another medium (e.g. a painter's canvas) qualify the decorations as a "two dimensional work of art," as defined by Section 101. The Court determined further that "imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself." The Court thus concluded "the decorations [were] therefore separable from the uniforms and eligible for copyright protection." Justice Breyer, in dissent, expressed his views to the contrary, arguing the decorations were "not separable because imaginatively removing them from the uniforms and placing them in some other

medium...would create ‘pictures of cheerleader uniforms.’”^[3]

The Court’s holding summarily rejected the notion that “a useful article must remain after [an] artistic feature has been imaginatively separated from the article,” effectively abandoning the distinction between “physical” and “conceptual” separability previously adopted by some courts. The Court also rejected consideration of additional factors, such as the marketability of the decorative element or the author’s intent in creating the decoration.

The Court’s ruling in *Star Athletica* clarified the boundaries of copyright protection for decorative elements applied to utilitarian articles.

^[1] *Mazer v. Stein*, in which a statuette intended as a lamp base was found copyrightable, held that (1) respondents held a copyright in the statuette despite its use as a lamp base, and (2) whether the statuette was initially created as a freestanding sculpture or as a lamp base was irrelevant to the copyright inquiry. 201 U.S. at 214; 218-19.

^[2] The Court found Section 101 of the Copyright Act to be “in essence, the mirror image of Section 113(a),” reasoning “whereas Section 113(a) protects a work...first fixed in some tangible medium other than a useful article and subsequently applied to a useful article, Section 101 protects art first fixed in the medium of a useful article.”

^[3] Justice Ginsberg, in concurrence with the judgment, disagreed with the majority’s opinion, stating the majority’s separability test under Section 101 was “unwarranted” because the decorations at issue are not, themselves, useful articles, but are instead “copyrightable pictorial or graphic works *reproduced* on useful articles.”

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