

ALL FOR COPYRIGHT STAND UP AND HOLLER!
THREE CHEERS FOR *STAR ATHLETICA* AND THE
U.S. SUPREME COURT’S PERCEIVED AND
IMAGINED SEPARATELY TEST[♦]

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In March 2017 the United States Supreme Court held in *Star Athletica L.L.C. v. Varsity Brands Inc.* that an artistic feature incorporated into the design of a useful article could be protected by copyright when that feature could be perceived as a two- or three-dimensional work of art separate from the useful article, and imagined separately as a protectable pictorial, graphic, or sculptural work.¹ This

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¹ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct 1002 (2017).

two-part test replaces a variety of tests which courts and commentators proposed and applied during the last 40 years.² The *Star Athletica* decision is predicted to be a boon to the fashion and apparel industry, furniture designers, and manufacturers of other useful consumer products.³ Depending on how leniently or generously the new test is applied, it could result in an increase in the number of useful articles with artistic features which can be conceptually separated from the article's utilitarian features and protected by copyright.⁴

This article discusses the potential impact of the *Star Athletica* decision and the Court's new two-part test for separability. The first section summarizes how product shape and design are protected under our intellectual property laws, explains the preference for copyright, and sets forth federal policy allowing the public to copy products that our patent and copyright laws leave in the public domain.⁵ It next provides an overview of how copyright protection for the artistic features incorporated in useful articles evolved between the Supreme Court's 1954 decision in *Mazer v. Stein*⁶ and its decision in *Star Athletica*⁷ in

² Vicki Y. Nee, Susan Natland & Boris Zelkind, *The Top Hits: Fashion Cases with a Big Impact*, KNOBBE MARTENS (June 6, 2017) (noting that court decisions should lead to uniformity in this area of the law); *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484–85 (6th Cir. 2015) (summarizing nine approaches to separability).

³ See, e.g., Kevin Thompson, *A Multi-Layered Approach to Packaging Protection*, LADAS & PARRY (May 15, 2017), <https://ladas.com/education-center/6129-2/>; Ronald Mann, *Opinion analysis: Court uses cheerleader uniform case to validate broad copyright in industrial designs*, SCOTUSBLOG (Mar. 22, 2017), <http://www.scotusblog.com/2017/03/opinion-analysis-court-uses-cheerleader-uniform-case-validate-broad-copyright-industrial-designs/>; *Cheerleaders Cheer On Copyright Protection*, PENNINGTONS MANCHES LLP (May 10, 2017), <http://www.penningtons.co.uk/news-publications/latest-news/2017/cheerleaders-cheer-on-copyright-protection/>; *Copyright is "In Fashion" Following Supreme Court's Decision Upholding Protection for Cheerleading Uniform Design*, FOSTER SWIFT COLLINS & SMITH PC (June 1, 2017), <http://www.michiganitlaw.com/copyright-fashion-protecting-design/>; Vishwannath Mohan, *Star Athletica v. Varsity Brands: SCOTUS Cheers for Broader Copyright Protection*, 59 Orange County Law 36, 39–40 (2017); but see, Sherry Jeter, Mayer Brown LLP, *Supreme Court of the United States: Cheerleading Uniforms Can be Copyrightable: Star Athletica LLC v. Varsity Brands, Inc.*, AIPLA Newsstand, June 1, 2017 (opining that the ruling has not significantly changed the copyright landscape in the apparel industry).

⁴ See, e.g., Gene Quinn & Steve Brachman, *Copyrights at the Supreme Court: Star Athletica v. Varsity Brands*, IPWATCHDOG (Mar. 22, 2017), <http://www.ipwatchdog.com/2017/03/22/copyrights-supreme-court-star-athletica-v-varsity-brands/id=79767/>; Meaghan H. Kent & Taylor G. Sachs, *Copyright Office Accounts for Supreme Court's Star Athletica Decision*, VENABLE LLP (July 5, 2017), <https://www.lexology.com/library/detail.aspx?g=33ad26c2-701d-42c4-8006-dd988212d4e2> (discussing proposed changes in the Copyright Office's Compendium that "indicate consideration of the nuanced change, and potential expansion of copyrightability for design elements of useful articles"); Patrick K. McClay, *Has Copyright Protection Expanded for Useful Articles?*, BAKER BOTTS LLP (Nov. 2017), <http://www.bakerbotts.com/ideas/publications/2017/11/ip-report-p-mccloy> (discussing the impact of *Star Athletica* on a case involving a decorative ornamental light set).

⁵ Ralph Brown, *Design Protection: An Overview*, 34 UCLA L. Rev. 1341 (1987).

⁶ *Mazer et al. v. Stein et al.*, 347 U.S. 201 (1954).

⁷ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct 1002 (2017).

2017. After summarizing the majority, concurring, and dissenting opinions in *Star Athletica*, the article applies the new test in several difficult pre-*Star Athletica* cases in order to assess the decision's practical impact on a variety of useful articles.

This survey of the new test's application to pre-*Star Athletica* cases leads to the following conclusions and contentions. Although the Supreme Court's new test brings uniformity and often should be relatively easy to apply in connection with pictorial and graphic works applied on useful articles, the application of the new test to sculptural features incorporated into useful articles will remain challenging for counsel and courts. Infringement claims over useful articles that are similar to those at issue in the tough cases from the pre-*Star Athletica* era will remain difficult. Even though the overall shape of a useful article like a chair, toaster, food processor, car or bike rack can be expressed by an industrial designer in different ways, there should be no copyright protection for any of these articles unless they have a separable feature.⁸ The nation's legislative policy against protection for industrial design should bar copyright when an article's aesthetic elements are inextricably interwoven with its utilitarian aspects.⁹ The risk of applying the Supreme Court's new test too leniently or generously is the grant of copyright protection to an article's overall shape, and this extends the copyright monopoly to a useful article's functional or utilitarian features.

This article uses the terms 'leniently' and 'generously' interchangeably to describe a pro-copyright claimant approach to applying the new test and finding artistic features conceptually separable from a useful article's functional and utilitarian features; giving the designer the benefit of the doubt that features are separable and not inextricably interwoven with the article's overall shape. Extending copyright protection in this way could result in outcomes which would be contrary to Congress's steadfast refusal since 1914 to enact a general industrial design protection statute¹⁰ as well as the Supreme Court's statements about the importance of the competitive mandate and the public's right to copy that which our copyright and patent laws leave in the public domain.¹¹

⁸ Cf. Jane Ginsburg, "Courts Have Twisted Themselves into Knots": *U.S. Copyright Protection for Applied Art*, 40 COLUM. J. L. & ARTS 1, 2-3, 54 (2016).

⁹ *Esquire, Inc. v. Ringer*, 591 F.2d 796, 807 (D.C. Cir. 1978) (Leventhal, concurring).

¹⁰ CRAIG JOYCE, TYLER OCHOA, MICHAEL CARROLL, MARSHALL LEAFFER & PETER JASZI, COPYRIGHT LAW 198-99 (10th ed. 2016) (hereinafter Craig Joyce *et al.*); MARSHALL LEAFFER, UNDERSTANDING COPYRIGHT LAW 130 (6th ed. 2014) (noting that design protection legislation has been introduced regularly). Congress passed specialized design protection statutes for vessel hulls in 1998, 17 U.S.C. §§ 1301-32, and the shape of semi-conductor chips in 1984, 17 U.S.C. §§ 901-14; *Esquire, Inc.*, 591 F.2d at 800 n.12 (noting that approximately 70 design protection bills had been introduced in Congress since 1914).

¹¹ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989); *Compcorp v.*

I. PRODUCT SHAPE, THE COPYRIGHT PREFERENCE, AND THE COMPETITIVE MANDATE

In order to appreciate the potential impact of *Star Athletica* it is important to recognize that manufacturers want to protect the shapes and designs of their products, and prevent competitors from making and selling knock-offs.¹² As a consequence, there have been hotly contested lawsuits over protection for the designs and shapes of a wide range of products from cheerleading outfits and belt-buckles¹³ to bike racks and light fixtures,¹⁴ faucets, road signs and hubcaps,¹⁵ lamps and tables,¹⁶ and mannequins of heads, human torsos and animals.¹⁷ The bases for protecting product shape and design are found in several areas of intellectual property law including design patent,¹⁸ trademark and trade dress law,¹⁹ and copyright.²⁰ However, Congress has declined repeatedly to enact general protection for industrial design as found in other countries,²¹ and state law protection for product shape and design raises serious questions of federal preemption.²²

Due in part to the U.S. Supreme Court's 1954 decision in *Mazer v. Stein*, upholding copyright protection for statuettes of Balinese dancers

Day-Brite Lighting, Inc., 376 U.S. 234, 237 (1964).

¹² LEAFFER, *supra* note 10, at 121; Brown, *supra* note 5, at 1341–42.

¹³ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980).

¹⁴ *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987); *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978).

¹⁵ *Kohler Co. v. Moen, Inc.*, 12 F.3d 632 (7th Cir. 1993); *Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983); *Traffix Devices, Inc. v. Mktg. Displays Inc.*, 532 U.S. 23 (2001).

¹⁶ *Mazer v. Stein*, 347 U.S. 201 (1954); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Magnussen Furniture, Inc. v. Collezione Europa USA, Inc.*, 116 F.3d 472 (4th Cir. 1997).

¹⁷ *Pivot Point International, Inc. v. Charlene Products, Inc.*, 372 F.3d 913 (7th Cir. 2004); *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985); *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320 (2d Cir. 1996).

¹⁸ 35 U.S.C. § 171 (2015) (noting that a design patent may be obtained for “any new, original, and ornamental design for an article of manufacture”); *Egyptian Goddess Inc. v. Swisa Inc.*, 543 F.3d 665 (Fed. Cir. 2008).

¹⁹ *See, e.g., Kohler Co.*, 12 F.3d at 632; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000); *Traffix Devices, Inc.*, 532 U.S. at 23.

²⁰ 17 U.S.C. §§ 101, 102(a)(5) (defining pictorial, graphic and sculptural works); *see* Joshua Rudawitz & Patrick Concannon, *Fashion and Intellectual Property: Many Options to Protect Your Design, But No One-Stop Shop*, LEXOLOGY (May 30, 2017), <https://www.lexology.com/library/detail.aspx?g=f6ba8878-4226-45ea-be4a-097afacde69> (discussing copyright, trademark and design patent as options for protecting aspects of clothing).

²¹ *JOYCE ET AL.*, *supra* note 10, at 198–99; LEAFFER, *supra* note 10, at 130 (noting also that design protection legislation has been introduced regularly); *Esquire, Inc.*, 591 F.2d at 800 n.12 (noting that approximately 70 design bills had been introduced in Congress between 1914 and 1978).

²² *See, e.g., Sears, Roebuck & Co.*, 376 U.S. at 229; *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 167; *see also* LEAFFER, *supra* note 10, at 131–32; David Shipley, *Refusing to Rock the Boat: The Sears/Compco Preemption Doctrine Applied to Bonito Boats v. Thunder Craft*, 25 WAKE FOREST L. REV. 385 (1990).

used as lamp bases,²³ copyright has come to be regarded as preferable to design patent, trademark law and trade dress for protecting artistic features embodied in useful articles. The reasons for this preference also include the rigorous requirements for obtaining a design patent,²⁴ and the role of functionality as a limit on trademark and trade dress protection for product shape.²⁵ The *Star Athletica, L.L.C. v. Varsity Brands, Inc.* decision will likely strengthen this preference for the copyright option by announcing a simple two-step test for determining separability and copyrightability²⁶ that should result in uniformity, and also clarify what designers can protect.²⁷

However, the Court started its *Star Athletica* opinion by stating that “Congress has provided copyright protection for original works of art, *but not for industrial designs*. The line between art and industrial design, however, is often difficult to draw. This is particularly true when an industrial design incorporates artistic elements.”²⁸ Lurking behind this statement are the often confusing intersections of our copyright and patent laws with trademark, trade dress, anti-dilution law, and unfair competition doctrine in regard to how creators are afforded protection against copying and imitation. Also relevant is a series of U.S. Supreme Court decisions that “emphatically reject the use of [our trademark laws] to extend property-like protection beyond that afforded by copyright and patent law, confirm the primacy of the substantive restrictions on federal protection expressed in the Intellectual Property Clause, and bolster our nation’s historical competitive mandate by promoting competition.”²⁹ These decisions, including the *Sears* and *Compco* decisions from 1964 and *Bonito Boats* from 1989, have the effect of protecting the public domain from encroachment by making it difficult for businesses and others to claim ownership of words, colors, product shapes and designs, and other works of authorship in the public

²³ *Mazer v. Stein*, 347 U.S. 201 (1954); LEAFFER, *supra* note 10, at 121 (noting that the role of copyright in protecting artistic creations embodying utilitarian objects has generated controversy).

²⁴ LEAFFER, *supra* note 10, at 128–289 (discussing the time and expense of securing design patent protection and the fact that many patents are declared invalid).

²⁵ JOYCE *ET AL.*, *supra* note 10, at 198; LEAFFER, *supra* note 10, at 131; *Traffix Devices, Inc. v. Mktg. Displays Inc.*, 532 U.S. 23 (2001) (noting that the existence of an expired utility patent is strong evidence that the feature protection by the patent is functional and cannot be protected as trade dress); *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, No. ED CV14-01926 JAK (SPx), 2017 BL 267966, *10 (C.D. Cal. Aug. 1 2017) (noting that the jury had enough evidence to rule that Herman Miller’s Aeron chair’s features were functional and unprotectable, but that Miller’s Eames chair was protectable); *But see* Ginsburg, *supra* note 8, at 1–2 (noting that “Congress intended to impose a high threshold to the copyrightability of useful articles”).

²⁶ *Rudawitz & Concannon*, *supra* note 20, at 1 (stating that the Court’s simple test has clarified and expanded how copyright can protect designs quickly and inexpensively).

²⁷ *Knobbe Martens*, *supra* note 2, at 2.

²⁸ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1007 (2017) (emphasis added).

²⁹ David Shipley, *What Do Flexible Road Signs, Children’s Clothes and the Allied Campaign in Europe During WWII Have in Common? The Public Domain and the Supreme Court’s Intellectual Property Jurisprudence*, 13 U. BALT. INTELL. PROP. L.J. 57, 58 (2005).

domain.³⁰

Star Athletica must not be read in isolation from these decisions and the principles for which they stand. The Court has stated that “the [Intellectual Property] Clause contains both a grant of power and certain limitations on the exercise of that power,” and that it “reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition without any concomitant advance of ‘Progress of Science and useful Arts.’”³¹ Copying an unpatented improvement or using a public domain work of authorship is a privilege of our system of competitive enterprise, and any unprotected article, structure, product, story, work of art or design can be imitated or appropriated.³² In summary, in applying the two-step test from *Star Athletica* and trying to draw the line between a useful article’s protectable artistic features and that article’s unprotectable industrial design features which are functional or utilitarian, courts and counsel must not ignore fundamental policy embodied in the Intellectual Property Clause; the public has the right to copy whatever the patent and copyright laws leave in the public domain.³³ This policy is at risk if the *Star Athletica* two-part separability test is applied too leniently.³⁴

II. COPYRIGHT PROTECTION OF APPLIED ART FROM *MAZER* TO *STAR ATHLETICA*

In 1954 the U.S. Supreme Court upheld the use of copyright to protect artistic works embodied in useful articles in *Mazer v. Stein*.³⁵ The works at issue were statuettes of Balinese dancers used as lamp bases. The defendants had manufactured knock-offs, and argued that it was inappropriate to copyright a work of art intended to be mass produced as part of a useful article like a lamp base.³⁶ In ruling for the copyright claimant the Court endorsed the practice of the Copyright Office to allow the registration of articles like the statuettes ‘as works of the fine arts’ pursuant to a regulation which stated, “[t]his class includes

³⁰ *Id.*

³¹ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146.

³² *Cf. J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 953 (8th Cir. 1941); *see also Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938).

³³ *Cf. Compro Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237; *Shipley, supra* note 29, at 61.

³⁴ *See infra* text accompanying notes 191–215.

³⁵ *Mazer v. Stein*, 347 U.S. 201 (1954).

³⁶ *Id.* at 203–04 (noting that the defendant/petitioners asserted that the question was “can statuettes be protected in the United States by copyright when the copyright applicant intended primarily to use the statuettes in the form of lamp bases to be made and sold in quantity and carried the intentions into effect? Stripped down to its essentials, the question presented is: can a lamp manufacturer copyright his lamp bases?”); *id.* at 204–05 (noting that the Court rephrased this saying, saying that the case requires an answer as to “an artist’s right to copyright a work of art intended to be reproduced for lamp bases.”).

works of artistic craftsmanship, *in so far as their form but not their mechanical or utilitarian aspects are concerned*, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawing and sculptures³⁷

Neither the intended use of the statuettes as lamp stands nor the possibility of a design patent prevented copyright protection.³⁸ However, the plaintiff's copyright did not extend to the idea of using a statuette as a lamp base nor to the way the lamps worked; their mechanical or utilitarian aspects. Affording copyright protection to the idea of using a statuette as a lamp base, or to the lamps' unpatented utilitarian and functional features, would be anti-competitive.³⁹ In other words, the defendants could sculpt dancers to serve as lamp stands and configure the wiring and the shade like the plaintiff's lamps, but their dancers could not be substantially similar to the plaintiff's copyrightable dancers.

These fundamental principles were reflected in a regulation the Copyright Office promulgated several years after *Mazer v. Stein*⁴⁰ as well as in the comprehensive revision of the Copyright Act that Congress enacted in 1976. Section 102(a)(5) of the Act provides for the copyrightability of "pictorial, graphic, and sculptural works" which are defined as "two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints, and art reproductions, maps, globes, charts, diagrams, models, and technical drawings."⁴¹ Another provision of the Act, section 113(a), provides that "the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise."⁴² Accordingly, it is clear and consistent with *Mazer* that an artist's right to reproduce his or her pictorial, graphic, or sculptural work in copies includes reproducing it in or on a useful article. The Act's definition codifies another aspect of *Mazer* by stating that:

the design of a useful article . . . shall be considered a pictorial, graphic or sculptural work only if, and only to the extent that, such design incorporates pictorial,

³⁷ *Id.* at 212–13 (citing and quoting from 37 C.F.R., § 202.10 (1949)) (emphasis added).

³⁸ *Id.* at 218–19.

³⁹ LEAFFER, *supra* note 10, at 121–22.

⁴⁰ "If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration." 37 C.F.R. § 202.10(c) (1959).

⁴¹ 17 U.S.C. § 101 (2012).

⁴² 17 U.S.C. § 113(a) (2012).

graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.⁴³

In essence, useful articles as such are not protectable by copyright, but separable artistic features incorporated in or on useful articles might be copyrightable. The House Report accompanying the 1976 Act states that this statutory language was added in “an effort to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection.”⁴⁴ The report elaborated on this point by stating:

A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in [*Mazer v. Stein*], is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, *physically or conceptually*, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.⁴⁵

Notwithstanding the clarity of the Act and this legislative history, showing Congress’s desire to exclude industrial products from copyright protection even if they have aesthetically pleasing designs,⁴⁶ courts have had considerable difficulty drawing the line between the protectable artistic and unprotectable utilitarian features of useful articles. It is often hard to determine whether artistic features embodied in applied art and other utilitarian objects “can be identified separately from, and are capable of existing independently of the utilitarian aspects

⁴³ 17 U.S.C. § 101 (2012) (stating that a “useful article” is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article.’”).

⁴⁴ H.R. REP. NO. 94-1476, at 54 (1976); *see also* Ginsburg, *supra* note 8, at 8–11 (discussing the Copyright Office’s disfavor of copyright protection for industrial design generally during the period that the 1976 Act was being drafted.).

⁴⁵ H.R. REP. NO. 94-1476 at 55 (emphasis added). There was a serious attempt to enact general industrial design protection as a *sui generis* piece of legislation appended to the 1976 Act but the provisions were deleted from the statute that Congress enacted. JOYCE *ET AL.*, *supra* note 10, at 199.

⁴⁶ Ginsburg, *supra* note 8, at 10, 57.

of the article.”⁴⁷

A dizzying variety of tests and approaches to help courts draw this line have been announced starting with the D.C. Circuit in *Esquire v. Ringer* in 1978 which affirmed the Copyright Office’s denial of protection for a modern outdoor lighting fixture as a work of art.⁴⁸ Although the case arose under the 1909 Act, the court turned to the legislative history of 1976 Act to say that the House Report made clear that “the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright.”⁴⁹ Since the fixture lacked any features or embellishments which were separable from its overall configuration, there was nothing to protect by copyright.⁵⁰ It was not enough that a developer or builder might want to select this particular fixture over others for its parking lot and sidewalks because it was more aesthetically pleasing than other outdoor lights.⁵¹

Later developments showed that the physical separability of artistic features could not be the only test for determining copyrightability, and it became well accepted by courts and commentators “that the protection of the copyright statute also can be secured when a conceptual separability exists between the material sought to be copyrighted and the utilitarian design in which that material is incorporated.”⁵² According to the Copyright Office, conceptual separability “means that a feature of the useful article is clearly recognizable as a pictorial graphic, or sculptural work, notwithstanding the fact that it cannot be physically separated from the article by ordinary means.”⁵³ The agency’s examples of this include engraving on a vase, carving on the back of a chair and art printed on a t-shirt or wallpaper.⁵⁴ Notwithstanding this guidance, there was no agreement on how to determine whether artistic features were conceptually separable.⁵⁵

One court suggested that copyright protection was appropriate when the artistic features were primary and the utilitarian features were

⁴⁷ 17 U.S.C. § 101 (2012).

⁴⁸ *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978).

⁴⁹ *Id.* at 804.

⁵⁰ LEAFFER, *supra* note 10, at 124.

⁵¹ See H. R. Rep. No. 94-1476, at 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668, *supra* notes 44–45.

⁵² *Pivot Point International, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 922; *Varsity Brands, Inc. v. Star Athletica, LLC.*, 799 F.3d 468, 483.

⁵³ U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2[B] (3d ed. 2014).

⁵⁴ *Id.*

⁵⁵ See, e.g., *Pivot Point International, Inc.*, 372 F.3d at 922–30 (summarizing and discussing several different tests and how those tests were applied in particular cases); *Varsity Brands, Inc.*, 799 F.3d at 484–85 (discussing nine different tests).

subsidiary.⁵⁶ Another said that copyright should be available when the article “stimulates in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”⁵⁷ An influential treatise said that conceptual separability exists when the useful article “would still be marketable to some significant segment of the community simply because of its aesthetic qualities,”⁵⁸ while another commentator said that there is separability when artistic features “can stand alone as a work of art traditionally conceived, and . . . the useful article in which it is embodied would be equally useful without it.”⁵⁹ A fifth test was that separability exists when the artistic design was not significantly influenced by functional considerations,⁶⁰ and a sixth test, proposed by another commentator, was that artistic features are separable when they are not utilitarian.⁶¹ This is not an exhaustive list as evidenced by the Sixth Circuit’s summary of nine approaches to conceptual separability in its *Star Athletica* opinion.⁶²

The courts, in applying the various tests, upheld copyright protection for decorative belt buckles,⁶³ a life size mannequin head used by hair stylists,⁶⁴ animal mannequins used by taxidermists,⁶⁵ nose masks representing the snouts and beaks of pigs, parrots and other animals,⁶⁶ Halloween costumes,⁶⁷ laminated flooring with the digitally

⁵⁶ *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (discussing copyright protection for belt buckles).

⁵⁷ *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J. dissenting) (noting that the majority denied copyright protection for mannequins used for displaying clothing in department stores).

⁵⁸ Melville Nimmer & David Nimmer, 1 Nimmer on Copyright § 2.08[B][4], at 2A-101.

⁵⁹ PAUL GOLDSTEIN, COPYRIGHT § 2.5.3, at 2:67.

⁶⁰ *Brandir International, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, (2d Cir. 1987) (denying copyright protection to a bike rack). This is the test proposed by Professor Denicola in *Applied Art & Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983).

⁶¹ WILLIAM F. PATRY, COPYRIGHT LAW & PRACTICE 285 (1994).

⁶² *Varsity Brands, Inc. v. Star Athletica, LLC.*, 799 F.3d 468, 484–85; Karen Lim, *Supreme Court: New Copyright Eligibility Test For Clothing Designs and Other Useful Articles*, FROSS ZELNICK LEHRMAN & ZISSU P.C. (June 5, 2017), <http://www.frosszelnick.com/newsletterarticle/supreme-court-new-copyright-eligibility-test-clothing-designs-and-other-useful> (“By some counts, more than a dozen different and competing legal tests have been developed for determining whether the ‘separability’ requirement of section 101 is satisfied.”).

⁶³ *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993–94.

⁶⁴ *Pivot Point International, Inc. v. Charlene Products*, 372 F.3d 913, 932.

⁶⁵ *Superior Form Builders v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488 (4th Cir. 1996) (noting that an animal mannequin form is not a useful article because it portrays the appearance of an animal); *Hart v. Dan Chase Taxidermy Supply*, 86 F.3d 320 (2d Cir. 1996) (noting that a fish form is not a useful article because it portrays its own appearance and comes within the scope of the Copyright Act).

⁶⁶ *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, 912 F.2d 663 (3d Cir. 1990) (noting that nose masks are not useful articles, and are copyrightable as sculptural works).

⁶⁷ *Chosun Int’l Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005) (reversing lower court ruling that costumes could not be protected and remanding for a determination of separability).

manipulated appearance of aged wood planks,⁶⁸ and decorative elements of furniture designs.⁶⁹ At the same time, courts denied copyright protection for mannequin torsos used to display clothing,⁷⁰ a bike rack,⁷¹ costumes,⁷² the selection and arrangement of sequins and beads on a prom dress,⁷³ decorative elements of uniforms,⁷⁴ artistic aspects of measuring spoons,⁷⁵ the shape of a hookah water container,⁷⁶ and the design features of cast-iron tables.⁷⁷

The several tests as well as the varied results caused one judge to write that courts “have twisted themselves in knots trying to create a test 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.”⁷⁸ Another court stated that “the [conceptual separability] analysis often sounds more like metaphysics than law.”⁷⁹ Given the several tests and the varied results, the United States Supreme Court granted certiorari in *Star Athletica* to resolve “widespread disagreement over the proper test for implementing § 101’s separate-identification and independent existence requirements.”⁸⁰

III. STAR ATHLETICA V. VARSITY BRANDS

Varsity Brands designs, makes and sells cheerleading uniforms. They registered over 200 copyrights for two-dimensional designs consisting of chevrons, lines, curves, diagonals, coloring, stripes, and shapes that appeared on their uniforms and other garments. They sued Star Athletica, a competitor, for allegedly infringing the copyrights on five of the designs. The District Court granted summary judgment for Star Athletica, holding that the designs were not copyrightable because they served the utilitarian function of identifying the garments as cheerleading uniforms and they could not be physically or conceptually separated from the utilitarian function of the uniforms.⁸¹ The Sixth

⁶⁸ Home Legend, LLC v. Mannington, Mills, Inc., 784 F.3d 1404 (11th Cir. 2015).

⁶⁹ Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc., 618 F.3d 417 (4th Cir. 2010).

⁷⁰ Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985).

⁷¹ Brandir International Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1148–49.

⁷² Whimsicality, Inc. v. Rubie’s Costume Co., 891 F.2d 452, 454 (2d Cir. 1989) (noting costumes are wearing apparel and the Copyright Office rejects applications to register apparel).

⁷³ Jovani Fashion, Inc. v. Fiesta Fashions, 500 Fed. App’x 42 (2d Cir. 2012).

⁷⁴ Galiano v. Harrah’s Operating Co., 416 F.3d 411 (5th Cir. 2005).

⁷⁵ Bonazoli v. R.S.V.P., Intl, Inc., 353 F. Supp. 2d 218 (D.R.I. 2015).

⁷⁶ Inhale, Inc. v. Starbuzz Tobacco, Inc., 755 F.3d 1038 (9th Cir. 2014).

⁷⁷ Magnussen Furniture, Inc. v. Collezione Europa USA, Inc., 43 U.S.P.Q.2d (BNA) 1218 (4th Cir. 1997).

⁷⁸ Masquerade Novelty, Inc., v. Unique, 912 F.2d 663, 670 (3d Cir. 1990).

⁷⁹ *Bonazoli v. R.S.V.P., Int’l, Inc.*, 353 F. Supp. 2d at 224 (holding that artistic aspects of measuring spoons were not copyrightable).

⁸⁰ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1007 (2017).

⁸¹ *Id.* at 1007–08 (discussing *Varsity Brands, Inc. v. Star Athletica, LLC.*, 2014 WL 819422 (W.D. Tenn. 2014)); *Varsity Brands, Inc. v. Star Athletica, LLC.*, WL 819422 at *8–9 (noting that

Circuit reversed and remanded, saying that the Varsity Brands' graphic designs were separately identifiable from a blank, utilitarian, cheerleading uniform. The uniform's function was to cover the body, permit free movement, and wick moisture, and this function did not depend on the plaintiffs' designs.⁸² They could appear side by side with a uniform, and could be incorporated on different garments or framed as art.⁸³ A dissenting judge wrote that the uniform had the utilitarian function of identifying the wearer as a cheerleader, and that the designs were integral and inseparable from that function.⁸⁴ The U.S. Supreme Court affirmed with Justice Thomas writing the majority opinion.⁸⁵ Justice Ginsburg concurred in the judgment and Justice Breyer, joined by Justice Kennedy, wrote a dissenting opinion.

After stating why certiorari had been granted and announcing the new, two factor, perceived and separately imagined test, the Court summarized the proceedings below and quoted the Copyright Act's pertinent provisions on pictorial, graphic and sculptural works incorporated into useful articles.⁸⁶ It noted that the Act does not protect useful articles as such but only those features incorporated in the article "that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."⁸⁷ As applied to the designs at issue here, this meant that the Court's task was to "determine whether the arrangements of lines, chevrons, and colorful shapes appearing on the surface of respondents' [Varsity Brands'] cheerleading uniforms are eligible for copyright protection as separable features of the design of those cheerleading uniforms."⁸⁸

The Court said that a separability analysis was essential notwithstanding Varsity Brands' argument that their designs were two-dimensional works of graphic art appearing *on* useful articles and inherently separable.⁸⁹ The majority responded that this argument was

the trial court said that the designs were part and parcel of the uniform itself, and that the uniform lost its function without the designs. It became a blank canvas. Further noting that the designs on the uniforms had the utilitarian function of uniforms for cheerleading so as to 'clothe the body in a way that evokes the concept of cheerleading' and were therefore not copyrightable).

⁸² *Varsity Brands, Inc. v. Star Athletica, LLC.*, 799 F.3d 468, 490–92.

⁸³ *Star Athletica, L.L.C.*, 137 S.Ct. at 1008 (discussing *Varsity Brands, Inc.*, 799 F.3d at 491–92).

⁸⁴ *Id.* (discussing *Varsity Brands, Inc. v. Star Athletica, LLC.*, 799 F.3d at 495–96 (McKeague, J. dissenting)); see also Selected Annotated Cases, 64 J. Copyright Soc'y 73–74 (2017) (summarizing the lower court decisions); cf. Mann, *supra* note 3 (questioning whether a plain white cheerleader uniform is as useful as one with stripes and chevrons).

⁸⁵ *Star Athletica, L.L.C.*, 137 S.Ct. at 1007–08.

⁸⁶ *Id.* at 1008 (citing and quoting section 102(a)(5) and the definitions of useful article and pictorial, graphic and sculptural works in section 101).

⁸⁷ *Id.* (quoting from the Act's definition of pictorial, graphic and sculptural works in section 101).

⁸⁸ *Id.* at 1008–09.

⁸⁹ *Id.* at 1009 (emphasis added). In her concurring opinion, Justice Ginsburg also contended that a consideration of separability was unwarranted because the plaintiffs' designs were not designs of useful article but graphic works reproduced on useful articles. *Id.* at 1018 (Ginsburg J., concurring); see also Ginsburg, *supra* note 8, at 3.

inconsistent with the text of the Copyright Act which requires a separability analysis for any artistic features incorporated into the design of a useful article, and defines the pictorial, graphic and sculptural works category as including two-dimensional works of art. Thus, the design of a useful article “can include two-dimensional ‘pictorial’ and ‘graphic’ features, and separability analysis applies to those features just as it does to three-dimensional ‘sculptural’ features.”⁹⁰

The Court next discussed when a feature incorporated into a useful article “(1) ‘can be identified separately from,’ and (2) is ‘capable of existing independently of, the utilitarian aspects of the article.’”⁹¹ Looking again at the text of the statute the Court said the first requirement—separate identification of the useful article’s pictorial, graphic or sculptural features—is not onerous because 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.”⁹² The second requirement—that the feature is capable of existing independently of the article’s utilitarian aspects—is usually more difficult to satisfy because that decisionmaker “must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article.”⁹³ This means the feature has to be able to exist on its own once it is imagined apart from the useful article. If the feature cannot exist as a pictorial, graphic or sculptural work when separated from the useful article, then it is one of the article’s utilitarian features.⁹⁴

According to the Court, this interpretation is confirmed by the statute as a whole.⁹⁵ The ultimate separability question “is 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

⁹⁰ *Star Athletica, L.L.C.*, 137 S.Ct. at 1009 (rejecting the Government’s argument that a separability analysis was unnecessary because Varsity Brands had copyrighted the deposited drawings and photos and had simply reproduced those works on the surface of a useful article. The Court stated that generally it did not entertain arguments that were not raised below and that were not addressed by any party).

⁹¹ *Id.* at 1010 (stating that this is not a free-ranging search for the best copyright policy. Rather, it depends solely on the statute).

⁹² *Id.*

⁹³ *Id.*

⁹⁴ *Id.* (adding that in order to qualify as a pictorial, graphic, or sculptural work, the separable feature cannot itself be a useful article or “[a]n article that is normally part of a useful article” (which is itself considered a useful article)); *id.* (citing and quoting section 101. Similarly, a copyrightable scale replica of a useful article like a car model does not entitle that replica’s creator any rights in the useful article itself); *see also* Ronald Mann, *supra* note 3.

⁹⁵ *Star Athletica, L.L.C.*, 137 S.Ct. at 1010–11 (citing and discussing section 106(1), 113(a) and 101).

useful article before being applied to a useful article.”⁹⁶

The Court added that this interpretation was consistent with the history of the Copyright Act. It summarized *Mazer v. Stein*,⁹⁷ noted the enactment of regulations by the Copyright Office to implement *Mazer*, and explained the impact of *Mazer* and those regulations on the Copyright Act’s language governing protection for the design of useful articles.⁹⁸ “In sum, 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.”⁹⁹

The application of this test to the designs on the cheerleading uniforms was said to be straightforward.¹⁰⁰ If the stripes, chevrons and colors were separated from the uniform and applied to a painter’s canvas, they would qualify as two-dimensional works of art. Moreover, applying those designs to another medium would not, according to the Court, replicate the uniform itself.¹⁰¹ The majority was not troubled by Justice Breyer’s contention that the designs were not separable because placing them on a painter’s canvas would create a picture of a cheerleader uniform; he perceived the stripes, chevrons and colors, when extracted from the useful article, as still having the outline of a cheerleader outfit.¹⁰² The Court provided several examples of copyrightable two-dimensional pictorial and graphic works which track the shape or contour of the articles on which they are applied to counter Breyer’s contention, and said that “[f]ailing to protect that art would create an anomaly: It would extend protection to two-dimensional designs that cover a part of a useful article but would not protect the same design if it covered entire article.”¹⁰³

The majority also said that section 101 does not require the underlying useful article to remain as such once the design element has been imaginatively separated from the article; it “does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one.”¹⁰⁴ Therefore, the physical-conceptual distinction is unnecessary.¹⁰⁵ The focus is on the extracted feature, not on what remains of the useful article after the extraction.¹⁰⁶ Finally, the

⁹⁶ *Id.* at 1011.

⁹⁷ *Mazer v. Stein*, 347 U.S. 201 (1954).

⁹⁸ *Star Athletica, L.L.C.*, 137 S.Ct. at 1012.

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² *Id.* (citing and quoting from Breyer’s dissent).

¹⁰³ *Id.*

¹⁰⁴ *Star Athletica, L.L.C.*, 137 S.Ct. at 1014.

¹⁰⁵ *Id.*; see also Mohan, *supra* note 3, at 39 (distinguishing between physical and conceptual separability was explicitly abandoned by the Court).

¹⁰⁶ *Star Athletica, L.L.C.*, 137 S.Ct. at 1014; Lim, *supra* note 62.

Court emphasized that it had not addressed the originality of Varsity Brands' designs for purposes of copyright protection,¹⁰⁷ and it reiterated that even if the designs were copyrightable, Varsity Brands would not have the right to prohibit a competitor from making uniforms with the same cut, shape or dimensions as its uniforms because its copyrights extended only to those separable surface designs.¹⁰⁸

As noted earlier in this summary, Justice Ginsburg concurred in the judgement but not in the opinion. She contended that the majority's consideration of the separability test was unnecessary because Varsity Brands' designs were simply copyrightable pictorial or graphic works *reproduced on* useful articles.¹⁰⁹ The designs were standalone works that the plaintiff sketched on paper, registered with the Copyright Office as two dimensional designs, and then reproduced on the uniforms, T-shirts and jackets.¹¹⁰ "In short, Varsity's designs are not themselves useful articles . . ." but graphic works in which it enjoyed the exclusive right to reproduce on useful articles.¹¹¹

Justice Ginsburg's position finds support in the fact that copyright protection for fabric and textile designs is well established.¹¹² A designer's rights are infringed when his or her copyrightable plaid or paisley pattern is reproduced without permission on fabric that is made into any number of useful articles including shirts, dresses, sheets, drapes and wallpaper. A fashion designer who reproduces without permission a copyrighted painting by the Dutch artist Piet Mondrian on fabric that is made into a simple but colorful dress infringes Mondrian's copyright.¹¹³ In considering this kind of unauthorized reproductions of a textile or fabric design it is not necessary to determine whether the design is separable from the useful article be it clothing, drapes or wallpaper in order to find infringement of the two dimensional pictorial or graphic work. It is no different from reproducing the copyrightable image of Mickey Mouse on the front of a sweatshirt without Disney's permission; this is the unauthorized reproduction of a two-dimensional

¹⁰⁷ *Star Athletica, L.L.C.*, 137 S.Ct. at 1012 n.1.

¹⁰⁸ *Id.* at 1012.

¹⁰⁹ *Id.* at 1018 (Ginsburg J., concurring); *see also* Ginsburg, *supra* note 8, at 3.

¹¹⁰ *Star Athletica, L.L.C.*, 137 S.Ct. at 1018.

¹¹¹ *Id.* at 1019; *see also* 17 U.S.C. § 113(a).

¹¹² *See, e.g.*, *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960) (discussing the infringement of textile design); *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841 (9th Cir. 2012) (discussing the infringement of textile patterns); *Unicolors, Inc. v. Urban Outfitters, Inc.*, 2017 CCH Copyright Law Decision ¶ 31,078 (9th Cir. 2017) (discussing how Urban Outfitters infringed by developing a dress with a fabric design that was overwhelmingly similar to Unicolors' design); *Tufenkian Inport/Export Ventures Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127 (2d Cir. 2003) (discussing infringement of textile designs made into carpets); *see also* 17 U.S.C. §§ 102(a)(5) & 101 (defining pictorial, graphic and sculptural works).

¹¹³ *Cf.* Heilbrunn Timeline of Art History, Metropolitan Museum of Art, October 2006. (Fashion designer Yves Saint Laurent had a Mondrian collection in the fall of 1965. The collection featured blocks of primary color with black bordering, inspired by Mondrian).

pictorial or graphic work.¹¹⁴

As noted earlier, Varsity Brands made this argument, asserting that separability analysis was not implicated when the two-dimensional work was not itself the design of the useful article.¹¹⁵ The majority responded by saying this argument was inconsistent with the text of the definition of pictorial, graphic, sculptural works in section 101 that requires separability analysis for any pictorial, graphic, or sculptural features that are incorporated in the design of a useful article.¹¹⁶ The Court could have added that the Copyright Office's own examples of conceptually separable two-dimensional works include engraving on a vase, carving on the back of a chair and art printed on a t-shirt or wallpaper.¹¹⁷ In a nutshell, the majority held that separability analysis is necessary for pictorial and graphic works applied on useful articles as well as for sculptural features incorporated in useful articles.

Justice Breyer's dissent, joined by Justice Kennedy, did not disagree with the majority's test but contended that Varsity Brands' design features were not capable of existing independently of the utilitarian aspects of the cheerleader uniforms.¹¹⁸ He wrote that "[i]n many or most cases, to decide whether a design or artistic feature of a useful article is conceptually separate from the article itself, it is enough to imagine the feature on its own and ask, 'Have I created a picture of a (useful part of a) useful article?' If so, the design is not separable from the useful article. If not, it is."¹¹⁹ He then acknowledged that this simple question will not provide an answer in every case, and recognized that "virtually any industrial design can be thought of separately as a 'work of art.'"¹²⁰ After recognizing that Congress had repeatedly rejected design protection bills and left protection for dress designs largely unavailable,¹²¹ he explained that "the esthetic elements on which Varsity seeks protection exist only as part of the uniform design"¹²² and emphasized that one could not claim a copyright in a useful article "merely by creating a replica of that article in another medium."¹²³ In

¹¹⁴ *Star Athletica, L.L.C.*, 137 S.Ct. at 1018 n.3 (Ginsburg J., concurring); *id.* at 1030 (Breyer J., dissenting); see also Compendium III § 924.2[B] (providing examples of artistic works that conceptual separable "[a]rt printed on a t-shirt" or "[a] drawing on the surface of wallpaper.").

¹¹⁵ *Star Athletica, L.L.C.*, 137 S.Ct. at 1005 (citing and quoting from Respondents Brief); see also text and notes, *supra* notes 88–90.

¹¹⁶ *Star Athletica, L.L.C.*, 137 S.Ct. at 1009 (noting that the definition includes two dimensional works of art, and "thus provides that 'the design of a useful article' can include two dimensional 'pictorial' and 'graphic' features, and separability analysis applies to those features just as it does to three-dimensional 'sculptural' features.").

¹¹⁷ See COMPENDIUM *supra* note 53, at § 924.2(B).

¹¹⁸ *Star Athletica, L.L.C.*, 137 S.Ct. at 1030 (Breyer J., dissenting).

¹¹⁹ *Id.* at 1033.

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.* at 1033–34.

¹²³ *Id.* at 1035.

other words, granting copyright to Varsity Brands' designs gave them exclusive rights in the useful article—the uniform.

IV. THE IMPACT OF *STAR ATHLETICA*

This section first discusses the potential impact of the *Star Athletica* test by speculating how several challenging cases from the pre-*Star Athletica* era might be decided today. This summary is intended to show that the new test, when applied generously, could result in copyright protection in some cases where protection had been denied in the past.

A. *What if? The New Test as Applied to Clothing, Mannequins, Outdoor Light Fixture and Bike Racks*

1. Clothing and the Fashion Industry:

Historically, it has been difficult to copyright clothing designs¹²⁴ so the *Star Athletica* decision is predicted to have major implications for the fashion and apparel industry.¹²⁵ It is said to be a step forward for fashion designers,¹²⁶ and it provides incentives for the fashion industry to file more copyright registrations.¹²⁷ Moreover, it should create uniformity.¹²⁸ On the other hand, Justice Breyer raised concerns about extending protection to garments in disregard of Congress's refusal to afford such protection and he predicts that the decision will cause unforeseeable disruption in the fashion industry.¹²⁹

It is appropriate to ask whether any of these predictions might be correct and if the Court's relatively simple test will make much of a difference.¹³⁰ The majority said that the language of the Copyright Act supports conceptual separability,¹³¹ but it also made clear that the design of clothing, such as the blank cheerleading uniform, cannot be protected by copyright because those aspects of clothing are useful:

¹²⁴ *Star Athletica, L.L.C.*, 137 S.Ct. at 1033 (Breyer, J., dissenting); Statements by attorneys Joshua Rudawitz & Patrick Concannon, *supra* note 20.

¹²⁵ Statements by attorneys Kimberly Warshawsky and Lauren Emerson and Jed Wakefield, *supra* note 4; *but see* statement by attorney Sherry Jetter, *supra* note 3 (stating the ruling has not significantly changed the landscape).

¹²⁶ Statement by attorney John DeMatteo, *supra* note 4; Statement by attorney John Mashni, *supra* note 3 (the decision is a victory for the fashion design industry). *But see* statement by attorney Sherry Jetter, *supra* note 3 (the result will likely have little impact on the fashion industry).

¹²⁷ Mohan, *supra* note 3, at 39.

¹²⁸ Nee, Natland & Zelkind, *supra* note 2.

¹²⁹ *Star Athletica, L.L.C.*, 137 S.Ct. at 1034 (Breyer, J., dissenting) (noting higher prices and unforeseeable disruption in the industry).

¹³⁰ As summarized in, *supra* notes 123–128 the predictions are not uniform.

¹³¹ *Star Athletica, L.L.C.*, 137 S.Ct. at 1014.

Even if respondents [Varsity Brands] ultimately succeed in establishing a valid copyright in the *surface decorations* at issue here, respondents have 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.¹³²

Given this limiting statement, clothing designers have not really gained much additional protection due to *Star Athletica*. Copyright protection for textile and fabric designs as two dimensional pictorial and graphic works was well established long before *Star Athletica*.¹³³ The fabric or textile designer's copyright on a floral print design is infringed when that work is reproduced without the designer's permission as a blouse or a skirt, as wallpaper or the fabric covering a sofa, or drapes for the parlor. Just as Varsity Brands' two-dimensional surface designs were reproduced without permission on *Star Athletica*'s useful articles—the cheerleading uniforms, the floral print designer's copyright is infringed when his or her design is reproduced as fabric that is used to cover a variety of useful articles. After all, the ultimate separability question is whether the feature for which protection is claimed would have been eligible for copyright as a pictorial, graphic, or sculptural work had it originally been fixed in some medium other than a useful article before being applied to a useful article.¹³⁴

A variation on this is as follows: if you can imagine the textile design as an expressive piece of textile art that you could hang on your wall, then it is copyrightable.¹³⁵ In short, *Star Athletica* does not alter copyright protection for fabric and textile designs,¹³⁶ and the Court took pains to say that it was not extending protection to the functional aspects of fashion design such as the cut or venting of a garment.¹³⁷ It emphasized several times that Varsity Brands had no right to prohibit

¹³² *Id.* at 1006; *id.* at 1016 (noting that the Court repeated this point later in the opinion, stating that “our test does not render the shape, cut, and physical dimensions of the cheerleading uniforms eligible for copyright protection.”).

¹³³ See, e.g., *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960) (discussing infringement of textile design); *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841 (9th Cir. 2012) (discussing infringement of textile patterns); *Unicolors, Inc. v. Urban Outfitters, Inc.*, 2017 CCH Copyright Law Decision ¶ 31,078 (9th Cir. 2017) (stating that Urban Outfitters infringed by developing a dress with a fabric design that was overwhelmingly similar to Unicolors' design); *Tufenkian Import/Export Ventures Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127 (2d Cir. 2003) (discussing the infringement of textile designs made into carpets); see also 17 U.S.C. §§ 102(a)(5) & 101 (definition of pictorial, graphic and sculptural works).

¹³⁴ *Star Athletica, L.L.C.*, 137 S.Ct. at 1011; see also 17 U.S.C. § 113(a) (2012) (stating the right to reproduce a pictorial or graphic work in copies includes the right to reproduce the work in or on any article, useful or otherwise).

¹³⁵ Rudawitz & Concannon, *supra* note 20.

¹³⁶ See cases cited, *supra* note 133.

¹³⁷ Rudawitz & Concannon, *supra* note 20.

any person from making the useful article—the plain, unadorned cheerleading uniform.¹³⁸ The imagined blouse or dress after the conceptual extraction of the floral print or plaid textile design remains a plain, unadorned blouse or dress.¹³⁹ Moreover, there are well recognized but relatively plain, unadorned cheerleader outfits which function effectively without stripes and chevrons; e.g., the uniforms worn by Song Girls who cheer for the Trojans of the University of Southern California.

There are some clothing and apparel cases which might come out differently if litigated today after the Court's ringing endorsement of conceptual separability in *Star Athletica*. For instance, a court might now be more willing to protect the decorative elements on other uniforms as conceptually separable¹⁴⁰ just as appliques shaped like hearts, flowers and berries placed on seersucker children's rompers can be perceived separately from those simple garments and imagined separately as two-dimensional graphic works.¹⁴¹ Assuming sufficient originality for copyright protection, such appliques would be infringed by slavish copies applied on other garments as well as on a child's seersucker romper.¹⁴² Still, "basic design elements of apparel—such as neckline, sleeve style, skirt shape, hemline, or pocket style—are inseparable from the utilitarian aspects of clothing and are uncopyrightable no matter how original they may be."¹⁴³ However, it may still be difficult to perceive certain elements of a prom dress as being conceptually separable from the garment. Can decorative sequins and crystals on the bodice and the horizontal satin ruching at the waist really be perceived as works of art separate from the gown?¹⁴⁴

The amount of copyright litigation in the clothing and apparel industry may increase after *Star Athletica*¹⁴⁵ but it is doubtful that the Court's new test for determining the conceptual separability of artistic features incorporated on clothing is going to make much of a difference. Notwithstanding the dissent's contention that Varsity Brands' stripes and chevrons were not separable from the uniforms,¹⁴⁶ the placement of

¹³⁸ *Star Athletica, L.L.C.*, 137 S.Ct. at 1006, 1013.

¹³⁹ *Cf. id.* at 1032.

¹⁴⁰ *Cf. Galiano v. Harrah's Operating Co.*, 416 F.3d 411 (5th Cir. 2005) (noting that decorative elements were inseparable from the uniform because they could not be marketed separately).

¹⁴¹ *Cf. Wal-Mart Stores, Inc. v. Samara Brothers*, 529 U.S. 205 (2000) (noting that Samara's garments could not be protected as trade dress under section 43(a) of the Lanham Act without a showing of secondary meaning).

¹⁴² *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 132 (2d Cir. 1998) (holding that Samara's designs were sufficiently original to be protected by copyright, but that protection was thin and would be infringed only by virtual identical copying).

¹⁴³ JOYCE ET AL., *supra* note 10, at 188 n.4.

¹⁴⁴ *Cf. Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. Appx. 42, 44–45 (2d Cir. 2012) (noting that all of this does not invoke in the viewer a concept other than that of clothing).

¹⁴⁵ Mohan, *supra* note 3, at 39.

¹⁴⁶ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct 1002, 1030 (2017) (Breyer, J.,

most pictorial or graphic works on useful articles, like putting the image of Mickey Mouse on a sweatshirt or a colorful floral decal on the back of a kitchen chair, present relatively easy cases for doing a separability analysis compared to determining the copyrightability of sculptural features incorporated into a useful article like a lamp or a toaster.¹⁴⁷ Disputes over the unauthorized reproduction of a textile or fabric design to make clothing and drapes or cover furniture, and disputes over the unauthorized reproduction of copyrightable graphics and appliques on clothing, are not really affected by the new test and should come out the same way as before *Star Athletica*.

On the other hand, as illustrated by the disagreement between the *Star Athletica* majority and Justices Breyer and Kennedy over the separability of the plaintiffs' stripes, bars and chevrons, it seems likely that there will be disagreements about separability in analogous situations; where the plaintiff's design closely tracks the shape of the garment. The new test certainly provides clarity by eliminating the myriad of tests that courts and counsel had fought over for decades, but there is a good argument that "the protection of designs applied to apparel has neither been eroded nor enhanced; they are protected by copyright to the extent they would have been protected had they been fixed in a medium of expression other than a garment."¹⁴⁸

2. Mannequins and Conceptually Separable Artistic Features:

Some lawyers predict that *Star Athletica* will have a substantial impact outside of the fashion and clothing industries,¹⁴⁹ and analyzing how the new test might work in the *Pivot Point* and *Carol Barnhart* cases helps understand whether this prediction is well founded.¹⁵⁰ The useful articles in both cases were mannequins; the Seventh Circuit held that *Pivot Point*'s life size female mannequin head was copyrightable in a 2-1 decision while the Second Circuit held that *Barnhart*'s clothed and nude life-size male and female mannequin torsos were not protectable in a 2-1 decision. In my opinion, a court deciding *Pivot Point* today would reach the same result under the new perceived and imagined separately test. On the other hand, the application of this new test could result in findings of separability, copyrightability, and infringement in *Barnhart*.

The mannequin head in *Pivot Point*, named Mara, was designed to

dissenting).

¹⁴⁷ See text and notes, *supra* 108–117. Justice Ginsburg's argument about separability supports my contention that the hard pre-*Star Athletica* cases like *Carol Barnhart*, *Brandir* and *Pivot Point* will be just as difficult to decide utilizing the new test.

¹⁴⁸ Jetter, *supra* note 3.

¹⁴⁹ See, e.g., authorities cited in notes, *supra* notes 3–4.

¹⁵⁰ *Pivot Point International, Inc. v. Charlene Products, Inc.*, 372 F.3d 913 (7th Cir. 2004); *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985).

imitate the ‘hungry look’ of a high-fashion runway model. It was marketed as a premium item to cutting-edge hair-stylists and for use in hair design competitions.¹⁵¹ The defendant’s mannequin head, named Charlene, was remarkably similar, including a double hairline seen in the plaintiff’s first version. The trial court granted summary judgment for the defendant after concluding that plaintiff’s mannequin “could not be copyrighted, because ‘even though one can conceive of Mara as a sculpture displayed as art, it would not be equally useful if the features that Pivot Point wants to copyright were removed.’”¹⁵² The Seventh Circuit disagreed, saying that Mara’s face was copyrightable:

It certainly is not difficult to conceptualize a human face, independent of all of Mara’s specific facial features, i.e., the shape of the eye, the upturned nose, the angular cheek and jaw structure, that would serve the utilitarian functions of a hair stand and, if proven, of a makeup model. Indeed, one is not only able to conceive of a different face than that portrayed on the Mara mannequin, but one easily can conceive of another visage that portrays the ‘hungry look’ on a high fashion runway model.¹⁵³

This statement can be rephrased to be consistent with the *Star Athletica* test: the features of Mara’s face including the shape of her eyes, her upturned nose, her angular cheek and jaw line—those features that give her the ‘hungry look’ of a runway model—can be *perceived* as a three dimensional work of sculpture separate from an ovoid shaped head used as a hair stand and for hair styling that qualifies as a protectable sculptural work when it is *imagined separately* from that useful article.¹⁵⁴ Writing for the court, I would add the next two sentences for good measure:

Are we to deny copyright protection to a life-size bust by Rodin simply because the sculptor decided to have reproductions mass-produced for sale to haberdashers and other stores for the display of hats and neckties? *See* 17 U.S.C. § 113(a). Moreover, the defendants could have sculpted a mannequin head evoking the ‘hungry look’ without making a slavish copy of Mara; the plaintiff’s copyright, though thin, is not anorexic.

The second sentence is added to counter points raised in the *Pivot Point* dissent, emphasizing that copyright does not protect functional

¹⁵¹ *Pivot Point International, Inc.*, 372 F.3d at 915.

¹⁵² *Id.* at 917 (citing and quoting from 170 F. Supp. 2d 828, 833 (N.D. Ill. 2001)).

¹⁵³ *Id.* at 931 (adding that just as Mattel is entitled to copyright protection for the upturned nose, bow lips and widely spaced eyes of its iconic Barbie doll, so was the plaintiff Pivot Point entitled to copyright protection for its hungry look mannequin); *id.* at 929–30 (discussing and citing *Mattel, Inc. v. Goldberger Doll Manufacturing Co.*, 365 F.3d 133, 136 (2d Cir. 2004)).

¹⁵⁴ This is my paraphrase of the *Star Athletica* test.

products and fearing that the majority had granted copyright protection to the functional aspects of a useful article.¹⁵⁵ The defendant can make a life size mannequin head that has the hungry look of a runway model without making a slavish copy of the plaintiff's mannequin head. Moreover, the *Star Athletica* majority says the statute does not require the imagined remainder after the facial features are extracted—the ovoid with the dimensions of a human head—to be an equally useful mannequin head.¹⁵⁶

The mannequins in *Carol Barnhart* were four life-size human torsos, made of styrene. The male and female figures did not have necks, arms or backs, and were designed for displaying sweaters, blouses, and dress shirts in clothing stores. Two torsos were anatomically accurate nude male and female figures from roughly the navel to the just above the shoulder blades. The other torsos were clad in an open collar men's shirt and an open collar blouse. The plaintiff's styrene mannequin torsos were slavish copies.¹⁵⁷ The Second Circuit majority determined that the features claimed by the plaintiff to be aesthetic or artistic were inextricably intertwined with the utilitarian feature—the display of clothes—and thus not conceptually separable and copyrightable.¹⁵⁸ The dissent wrote that separateness “exists whenever the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously. . . . The test is not whether the observer fails to recognize the object as a [display mannequin] but only whether the concept of the utilitarian function can be displaced in the mind by some other concept. . . . The separate concept will be that of a work of art.”¹⁵⁹

I think *Carol Barnhart* might be decided differently after *Star Athletic*. Here is the key part of my majority opinion:

The features of Carol Barnhart's torsos, including the shapes and dimensions of their chests, breasts, stomachs and shoulders, both nude and wearing a simple open collar shirt or blouse, can be *perceived* as three-dimensional sculptural works separate from life size male and female mannequin torsos used for clothing displays. They qualify as protectable sculptural works when they *imagined separately* from those useful articles.¹⁶⁰

¹⁵⁵ *Pivot Point International, Inc.*, 372 F.3d at 933–34.

¹⁵⁶ *Cf. Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1006 (2017).

¹⁵⁷ *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 412–13 (2d Cir. 1985).

¹⁵⁸ *Id.* at 419.

¹⁵⁹ *Id.* at 422–23 (Newman J., dissenting).

¹⁶⁰ This is my paraphrase of the *Star Athletica* test. *See, e.g., Design Ideas, Ltd. v. Meijer, Inc.*, 2017 BL 210798 (C.D. Ill. 2017) (post-*Star Athletica* decision finding copyright protection for plastic clothespins adorned by bird silhouettes). *But see Zahourek Systems, Inc. v. Balanced Baby University LLC*, 2016 U.S. Dist. LEXIS 47165 (D. Colo. 2016) (noting that plaintiff's interactive learning toy that required the user to shape muscles of clay and attach them to a body was a useful

Here also, I would add the next three sentences for good measure:

Are we to deny copyright protection to a life size male statue by Michelangelo simply because he decides to have relatively inexpensive reproductions of David mass-produced for sale to high-end department stores for the display of men's clothing? *See* 17 U.S.C. § 113(a). Indeed, the defendants could have sculpted anatomically correct male and female mannequin torsos without make slavish copies of Barnhart's torsos—or Michelangelo's David for that matter; the plaintiff's copyright, though thin, is not anorexic. The defendant is free to copy the original (nude and clothed male and female torsos), but it cannot slavishly copy the copy (the plaintiff's renditions of those torsos).¹⁶¹

As noted earlier in connection with *Pivot Point* and the mannequin heads, according to the majority in *Star Athletica*, the Copyright Act does not require the imagined remainder—the torsos devoid of the anatomical features or the simple blouse/shirt—to be equally as useful as Barnhart's sculpted mannequin torsos.¹⁶²

3. Outdoor Lights and Bike Racks – Still Unprotectable!

In *Esquire, Inc. v. Ringer* and *Brandir International, Inc. v. Cascade Pacific Lumber Co.* the appellate courts denied copyright protection for a modern outdoor lighting fixture and a bicycle rack referred to as the ribbon rack.¹⁶³ I contend that these cases would come out the same way under the *Star Athletica* test because neither work has a feature which can be *perceived* as a two or three-dimensional works of art separate from the useful article, and which qualifies as protectable sculptural work if *imagined separately* from the useful article in which it is incorporated. There are no features in or on either article which can be extracted to stand alone as a pictorial, graphic or sculptural work. The shapes of both articles are inseparable from their utilitarian aspects.¹⁶⁴

Moreover, notwithstanding the Court's statement in *Star Athletica* that “the statute does not require the imagined remainder to be a fully functioning useful article at all,”¹⁶⁵ the opinion should not be pushed to hold that the overall shapes of these very attractive but functional articles are copyrightable sculptural works which happen to be used

article that was not infringed by defendant's display of these models in a magazine because no features of plaintiff's works were conceptually separable).

¹⁶¹ *See, e.g.*, *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903).

¹⁶² *Cf. Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1006 (2017).

¹⁶³ *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978). (reversing writ of mandamus issued by the District Court ordering the Register of Copyrights to register the design of the light fixture); *Brandir International, Inc. v. Cascade Pac. Lumber Co.*, 834 F. 2d 1142 (2d Cir. 1987) (affirming lower court decision that the bicycle rack design was not entitled to copyright protection).

¹⁶⁴ *Cf. Star Athletica, L.L.C.*, 137 S.Ct. at 1007.

¹⁶⁵ *Id.* at 1014.

primarily for lighting sidewalks and locking bicycles. There are no imagined remainders. The useful articles and the sculptural artistic works are the same—inextricably intertwined—because there are no extractable features. Affording protection to the overall shape of these aesthetically pleasing useful articles would protect industrial design contrary to legislative intent when Congress passed the Copyright Act of 1976.¹⁶⁶ The *Star Athletica* majority made clear that there has to be a feature which is able to exist on its own once it is imagined apart from the useful article. If the feature cannot exist as a pictorial, graphic or sculptural work when separated from the useful article, then it is one of the article's utilitarian features and is unprotectable.¹⁶⁷ If there is no separable artistic feature, then you have a useful article which cannot be protected by copyright.

The lighting fixtures in *Esquire* were stationary outdoor floodlights of contemporary design with elliptically shaped housings which the applicant sought to register as works of art.¹⁶⁸ The Register of Copyrights denied the applications, saying that the fixtures did not contain “elements, either alone or in combination, which are capable of independent existence as a copyrightable pictorial, graphic, or sculptural work apart from the utilitarian aspect.”¹⁶⁹ The District Court compelled the Copyright Office to issue the registrations because it determined that these fixtures were clearly works of art entitled to the same recognition afforded to traditional sculpture, and it was not appropriate to deny copyright protection to abstract modern art forms while affording protection to traditional works of art.¹⁷⁰

The Court of Appeals for the D.C. Circuit reversed after analyzing the relevant passages from the House Report accompanying the recently enacted Copyright Act of 1976. The court said those passages “indicate unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright.”¹⁷¹ Unlike the lamp base statuettes in *Mazer*, *Esquire*'s light fixtures had no features that were

¹⁶⁶ H. Rep. at 55; see also *Star Athletica, L.L.C.*, 137 S.Ct. at 1030 (Breyer, J., dissenting); Ginsburg, *supra* note 8, at 2.

¹⁶⁷ *Star Athletica, L.L.C.*, 137 S.Ct. at 1005 (adding that in order to qualify as a pictorial, graphic, or sculptural work, the separable feature cannot itself be a useful article); *id.* (citing and quoting section 101); *id.* at 1031 (stating that a copyrightable scale replica of a useful article like a car model does not entitle that replica's creator to any rights in the useful article itself).

¹⁶⁸ *Esquire, Inc. v. Ringer*, 591 F.2d at 798 (noting that the applications were filed pursuant to the 1909 Copyright Act which was still in effect. The works of art category was at 17 U.S.C. § 5(g)).

¹⁶⁹ *Id.* at 798–99 (quoting the Register's analysis from the Joint Appendix).

¹⁷⁰ *Id.* at 799 discussing 414 F. Supp 939 (D.D.C. 1976). The court was invoking the principle of aesthetic nondiscrimination which was announced by Justice Holmes in his influential *Bleistein* opinion, and reflected as well in the House Report's explanation of copyright's originality standard which connotes no standard of novelty or literary or aesthetic merit. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. at 251; H.R. Rep. No. 94-1476 at 51–52.

¹⁷¹ *Id.* at 804.

separable from their overall shape.¹⁷² The court also said that extending the nondiscrimination principle to justify copyright protection for these lights as abstract sculpture “would undermine other plainly legitimate goals of copyright law—in this case the congressional directive that copyright protection should not be afforded to industrial designs.”¹⁷³

The ribbon bicycle rack at issue in *Brandir* presents the same problem as the light fixture in *Esquire*: it is an attractive ‘sculptural’ work that functions effectively as a bike rack yet it has no conceptually separable artistic features.¹⁷⁴ The Court of Appeals noted that

while the rack may have been derived in part from one or more ‘works of art,’ it is in its final form essentially a product of industrial design. In creating the RIBBON Rack, the designer has clearly adapted the original aesthetic elements to accommodate a further utilitarian purpose. These altered design features of the RIBBON Rack, including the space saving, open design achieved by widening the upper loops to permit parking under as well as over the rack’s curves, the straightened vertical elements, that all in- and above-ground installation of the rack, the ability to fit all types of bicycles and mopeds, and the heavy-gauged tubular construction of rustproof galvanized steel, are all features that combine to make for a safe, secure and maintenance free system of parking bicycles and mopeds.¹⁷⁵

Here again, unless this bike rack can be regarded in its entirety as a sculptural work that happens to function effectively as a safe, secure and maintenance free system for parking bikes, it is exceedingly difficult to perceive it as having a separable artistic feature that qualifies as a sculptural work if it is imagined separately from the bike rack; it has no features which can be perceived or imagined separately. *Star Athletica* makes clear that copyrightability does not depend on how or why this bike rack was designed, nor does it depend on marketability; why a segment of the market is more interested in this design than other bike rack designs.¹⁷⁶ The ribbon rack lacks any feature that can be perceived as a separable work of art that qualifies on its own as a

¹⁷² *Id.* at 805.

¹⁷³ *Id.* Hindsight is always 20/20 and it is relevant to note that at oral argument *Esquire* argued unsuccessfully that it was seeking registration only for the housing of each fixture and not the design of the entire assembly. *Id.* at 806. Fast forward to the present—could this kind of conceptual separability argument have been successful today? Could the cowl of these lights—the elliptical housing—be perceived as a three dimensional work of art which would qualify as a copyrightable sculptural work if imagined separately from the overall fixture? In my opinion, reaching that conclusion also would be equivalent to affording copyright protection to industrial design.

¹⁷⁴ *Brandir Intern., Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1148–49 (1987).

¹⁷⁵ *Id.* at 1147.

¹⁷⁶ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1015 (2017).

protectable sculptural work.¹⁷⁷

This article's re-litigation of the *Esquire* and *Brandir* cases—applying the new *Star Athletica* test yet arriving at the same results as before; denying copyright protection—shows that the new test is not a panacea when the useful article at issue is closer to an unembellished work of industrial design than a piece of sculpture. The hard cases from the pre-*Star Athletica* era will be difficult cases today. The courts, in deciding such challenging and close cases, should pay heed to the following statement from Justice Breyer's dissent:

Indeed, great industrial design may well include design that is inseparable from the useful article—where, as Frank Lloyd Wright, put it, ‘form and function are one. . . . Where they are one, the designer may be able to obtain 15 years of protection though a design patent. . . . But, if they are one, Congress did not intend a century or more of copyright protection.’¹⁷⁸

In other words, copyright should be denied because otherwise the court would be extending protection impermissibly to industrial design. The new perceived and imagined separately test does not alter the fact that the Copyright Act and its legislative history still favors protection for separable design features while disfavoring protection for the overall shape of useful articles.¹⁷⁹ Although the originality standard for pictorial, graphic and sculptural works does not imply any criterion of artistic taste, aesthetic value or intrinsic quality,¹⁸⁰ copyright is not the appropriate basis for protecting the overall shape of products like toasters, food processors and automobiles. Until Congress enacts a general industrial design protection statute, absent a design patent or trade dress protection, the shapes and designs of most useful products are in the public domain.¹⁸¹ Notwithstanding the aesthetic nondiscrimination principle, competitors are free to copy the elegant designs at issue in *Esquire v. Ringer* and *Brandir* because copying is permitted unless the article is protected by copyright or a patent.¹⁸² The overriding policy is that our nation's intellectual property laws allow and encourage imitation in the interest of promoting competition.¹⁸³

B. *There will be an increase in the number of product shape copyright infringement claims after Star Athletica*

Writing for the majority Justice Thomas had no difficulty

¹⁷⁷ *Id.* at 1008.

¹⁷⁸ *Id.* at 1034 (Breyer, J. dissenting).

¹⁷⁹ *Cf.* Ginsburg, *supra* note 8, at 57.

¹⁸⁰ H. Rep. at 54.

¹⁸¹ *Id.* at 58.

¹⁸² Brown, *supra* note 5, at 1341.

¹⁸³ *Id.*

determining that Varsity Brands' surface design features (the chevrons, stripes, angles and lines) were conceptually separable from the cheerleader uniform's shape and style.¹⁸⁴ This accommodating approach to conceptual separability, coupled with copyright law's low originality threshold¹⁸⁵ and several other factors, could result in manufacturers becoming more aggressive in claiming copyright protection for artistic features in or on their useful articles. The other factors include my contention that some pre-*Star Athletica* decisions denying copyright protection might come out differently today as well as possible changes in Copyright Office internal practices regarding applied art that have been published in response to this decision.¹⁸⁶ One comment on a draft of these changes states that "the Copyright Office is expanding its consideration of useful articles and increasing registration. Indeed, . . . [the changes] indicate consideration of the nuanced change, and potential expansion of copyrightability for design elements of useful articles."¹⁸⁷ Hence, it is reasonable to predict that the *Star Athletica* decision may result in more copyright registrations for artistic features incorporated in and on product designs,¹⁸⁸ and embolden some companies to be more aggressive going after knock-offs for copyright infringement. The cost and difficulty for the alleged infringer to argue against both the conceptual separability of artistic features incorporated in or on the plaintiff's useful article and the originality (copyrightability) of those separable design features may result in some quick settlements for plaintiffs.¹⁸⁹

However, notwithstanding the potential for more copyright infringement actions, it will remain difficult for courts to determine whether artistic features incorporated in a useful article are conceptually separable even under the Supreme Court's new perceived and imagined separately test. The test works well for design features which are 'on' a useful article, but it is still hard to determine whether a sculptural feature incorporated 'in' applied art is conceptually separable.¹⁹⁰ Moreover, courts need to be careful in making the separability

¹⁸⁴ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1008 (2017) (reaching this conclusion even though the designs had a striking outline and resemblance to the underlying cheerleading uniforms; Rapcke, *supra* note 4.

¹⁸⁵ "[T]he originality requirement is not particularly stringent . . . Originality requires only that the author make the selection or arrangement independently . . . and that it display a minimal level of creativity." *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 358 (1991).

¹⁸⁶ See Venable analysis of changes in the Compendium, *supra* note 4.

¹⁸⁷ *Id.*

¹⁸⁸ Mashni, *supra* note 3; Mahon, *supra* note 3.

¹⁸⁹ Wakefield, *supra* note 4 (noting that the decision "injects uncertainty into the apparel industry, and will allow large apparel companies to leverage that uncertainty against low cost alternative providers, who often lack the resources to fight these cases.").

¹⁹⁰ *Cf. Ginsburg, supra* note 8, at 54, 57.

determination due the risk of extending protection to a product's utilitarian features. As discussed below, this risk is genuine.

C. The risk that copyright protection will be extended to utilitarian features

The threshold for determining the copyrightability of a graphic work is low,¹⁹¹ and the Court has said that almost any design is protectable if placed first on paper or canvas.¹⁹² Justice Thomas said applying the new perceived and imagined separately test was straightforward in *Star Athletica*. One can identify surface decorations on the uniforms as:

features having pictorial, graphic, or sculptural qualities . . . [and] if the arrangement of colors, shapes, stripes and chevrons . . . 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. And imaginatively removing the surface decorations from the uniform and applying them in another medium would not replicate the uniform itself.¹⁹³

However, the risk in any case like *Star Athletica*, as explained in Justice Breyer's dissent, is that extending copyright to those artistic features extends protection to the useful article itself when those features are not truly conceptually separable.¹⁹⁴ After all, "virtually any industrial design can be thought of separately as a 'work of art . . .'"¹⁹⁵ It is striking that the majority opinion acknowledged this possibility and did not seem concerned. "Were we to accept petitioner's argument that the only protectable features are those that play absolutely no role in an article's function, we would effectively abrogate the rule of *Mazer* and read 'applied art' out of the statute."¹⁹⁶ Moreover, "separability does not require the underlying useful article to remain . . ."¹⁹⁷ and the majority rejected "the view that a useful article must remain after the artistic feature has been imaginatively separated from the article . . ."¹⁹⁸ These statements are remarkable because Justice Thomas started his *Star Athletica* opinion by stating that Congress had not provided protection for industrial design, and acknowledged that the line between art and

¹⁹¹ See, e.g., *Ets-Hokin v. Skyy Spirits, Inc.* 323 F.3d 763 (9th Cir. 2003); *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

¹⁹² *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1012 (2017); Cf. *L.A. Printex Indus. Inc. v. Aeropostale, Inc.*, 676 F.3d 841 (9th Cir. 2012); *Home Legend, LLC v. Mannington Mills, Inc.* 784 F.3d 1404 (11th Cir. 2015); Mann, *supra* note 3.

¹⁹³ *Star Athletica, L.L.C.*, 137 S.Ct. at 1012.

¹⁹⁴ *Id.* at 1033 (Breyer, J. dissenting).

¹⁹⁵ *Id.*

¹⁹⁶ *Id.* at 1014.

¹⁹⁷ *Id.*

¹⁹⁸ *Id.*

design is hard to draw, especially when the industrial design incorporates artistic elements.¹⁹⁹

The last section of the Court's opinion responds to the defendant's contention that allowing the plaintiffs' surface decorations (the chevrons, stripes lines, curves and diagonals) to qualify as a work of authorship was inconsistent with Congress' intent to exclude industrial design from copyright protection as evidenced by its refusal to provide such protection in the Copyright Act of 1976 and by its later enactment of two statutes protecting the designs of boat hulls and semiconductor chips while again declining to enact a general design protection statute.²⁰⁰ According to the petitioners, this showed that Congress wants industrial design protection claims under the design patent statute.²⁰¹ The majority's response was to say that inaction by Congress ordinarily lacks persuasive significance, that design patent and copyright are not mutually exclusive, and that a presumption against copyright protection for certain features of industrial design undermines Congress' choice in enacting section 102(a)(5) and the accompanying definition of pictorial graphic and sculptural works in section 101.²⁰² Moreover, the Court emphasized that its new test does not make the shape, cut and dimensions of the cheerleader uniform copyrightable.²⁰³

The majority's dismissal of the petitioner's industrial design argument was cavalier in view of Congress' history of rejecting general industrial design protection bills²⁰⁴ and the Supreme Court's repeated statements in decisions involving efforts to protect product design under state law that everyone is free to copy that which copyright and patent law leave in the public domain.²⁰⁵ The opinion is silent on competition policy.²⁰⁶ Moreover, in responding to Star Athletica's argument that the cheerleader uniforms, devoid of chevrons and stripes as plain white outfits, were not useful, the Court said that this argument was misguided because it was based on the assumption that copyright protection is limited to features that are solely artistic.²⁰⁷ This is not the case according to the majority because "[t]he focus of the separability inquiry is on the extracted features and not on any aspects of the useful article remains after the extraction."²⁰⁸ The majority seems to be saying that the extension of copyright protection to applied art contemplates

¹⁹⁹ *Star Athletica, L.L.C.*, 137 S.Ct. at 1008.

²⁰⁰ *Id.* at 1015 (citing 17 U.S.C. §§ 901-14 (the semiconductor chip statute was enacted in 1984) and §§ 1301-1332 (the vessel hull design statute was passed in 1998)).

²⁰¹ *Star Athletica, L.L.C.*, 137 S.Ct. at 1015.

²⁰² *Id.*

²⁰³ *Id.*

²⁰⁴ *Id.* at 1034 (Breyer, J., dissenting); *see also* text and notes, *supra* notes 18-24.

²⁰⁵ *See* text and notes, *supra* notes 27-34.

²⁰⁶ Mann, *supra* note 3.

²⁰⁷ *Star Athletica, L.L.C.*, 137 S.Ct. at 1013.

²⁰⁸ *Id.* at 1013.

copyright protection for expression that is utilitarian to some degree.²⁰⁹

The majority made clear that copyright extends to pictorial, graphic and sculptural works whether as free-standing works of art or as features of useful articles. It emphasized that Varsity Brands' designs, assuming originality, were copyrightable as fixed in some tangible medium other than the cheerleader outfit, such as on a painter's canvas, and did not lose that status when applied to the useful article—the outfit. This works with cheerleader uniforms, but not so smoothly with other useful articles like a belt buckles, bike racks, furniture and mannequins. Should not the ultimate question be simply whether the useful article at issue is still useful without the artistic features?²¹⁰ Otherwise, copyright protection might be extended to an article's utilitarian features. However, the *Star Athletica* majority emphasized that the separability analysis is on the extracted features, and not on the useful article that remains after that conceptual (imaginary) extraction.²¹¹ Accordingly, there is a significant risk that some courts, when applying the new two-part test, will afford copyright protection to utilitarian features of useful articles that should be left in the public domain.

Consumers will suffer as a consequence of this expansive view of separability and hence copyrightability. Here is a mundane example involving car parts. A couple years ago I smashed the bumper and back left fender on my father-in-law's 1999 Ford Escort when I backed out of my garage, forgetting that this little Ford was parked the driveway. The cost of replacing this bumper was under my deductible but what if Ford could claim copyright protection for these car parts as separable sculptural features? As it was, my repair shop could get relatively inexpensive replacement parts which were exact copies of the more expensive, genuine but not copyrightable Ford replacement parts. I doubt there are any extractable copyrightable features on that bumper and fender but I think this hypothetical makes my point about the risk of not asking whether the article can function without the extracted features.²¹² It should come as no surprise that the automobile industry has pushed for a general design protection statute while insurers fight back, arguing that protection will drive up the cost of spare parts.²¹³

²⁰⁹ Mann, *supra* note 3. *See, e.g.*, *Jetmax Ltd v. Big Lots, Inc.*, 2017 Copyright Law Decisions ¶ 31,143 at 49,958–59 n.2 (S.D.N.Y. 2017)(decorative tear shaped covers in an ornamental light set held to be sculptural works capable of existing apart from the utilitarian aspect of the light set even though the covers reduced glare and have some useful function); McClay, *supra* note 4 (discussing the *Jetmax* decision).

²¹⁰ Mann, *supra* note 3.

²¹¹ *Star Athletica, L.L.C.*, 137 S.Ct. at 1013; Mann, *supra* note 3.

²¹² *See, e.g.*, Shipley, *supra* note 22, at 392–94; *Pivot Point International, Inc. v. Charlene Products*, 372 F.3d 913, 932; *Hart v. Dan Chase Taxidermy Supply*, 86 F.3d 320 (2d Cir. 1996).

²¹³ *JOYCE ET. AL*, *supra* note 10, at 199.

It is important for alleged infringers to remember that the two dissenting Justices, while agreeing with much of the Court's analysis, did not believe that Varsity Brands' designs were in fact separable from the uniforms. "A picture of the relevant design features, whether separately 'perceived' on paper or in the imagination, is a picture of, and thereby 'replicate[s],' the underlying useful article of which they are a part Hence, the design features that Varsity seeks to protect are not 'capable of existing independently o[f] the utilitarian aspects of the article.'"²¹⁴ If alleged infringers have the resources to fight back, they need to argue that the alleged artistic features are not standalone pictorial, graphic, or sculptural works. They need to assert that those features replicate the underlying useful article of which they are a part and that protecting those features by copyright wrongfully extends protection to functional and utilitarian features.²¹⁵ In essence, they need to show, as in the ribbon rack litigation, that the useful article at issue has no separable features whatsoever and can be freely copied. It is all going to come back to how the lower courts and counsel interpret and apply the Court's simple new test.

CONCLUSION

This article's discussion of the evolution of copyright protection for product shape and design and the *Star Athletica* decision as well as its survey of how several pre-*Star Athletica* cases might be decided today leads to the following conclusions and contentions. Although the Supreme Court's new two part test brings uniformity and should be relatively easy to apply in connection with pictorial and graphic works applied on useful articles, the application of the new test to sculptural features incorporated into useful articles will remain challenging for counsel and courts. Infringement claims over useful articles that are similar to those at issue in the tough cases from the pre-*Star Athletica* era will remain difficult. Even though the overall shape of a useful article like a chair, toaster, food processor, car or bike rack can be expressed by an industrial designer in several different ways, there should be no copyright protection for any of these articles unless they have a separable feature. The nation's legislative policy against protection for industrial design needs to be respected. This bars

²¹⁴ *Star Athletica, L.L.C.*, 137 S.Ct. at 1030–31 (Breyer, J. dissenting) (citing 17 U.S.C. § 101 (2012)).

²¹⁵ See, e.g., *Design Ideas, Ltd. v. Meijer, Inc.*, 2017 BL 210798 (C.D. Ill. 2017) (noting that plastic clothespins adorned with bird silhouettes were protectable sculptural works post-*Star Athletica*); *Hoberman Designs, Inc. v. Gloworks Imports, Inc.*, 2015 U.S. Dist. LEXIS 176117 (C.D. Cal 2015) (expanding and contracting geometric toys were at issue with court recognizing that the combination of unoriginal geometric shapes can be protected by copyright but that the scope of protection for the plaintiff's toys was limited by their mechanical and utilitarian aspects that allowed for expansion and contraction so summary judgment was granted for the defendant).

copyright when an article's aesthetic elements are inextricably interwoven with its utilitarian aspects. The risk of applying the Supreme Court's new test too generously is the grant of copyright protection to an article's overall shape and thereby extending the copyright monopoly to a useful article's functional or utilitarian features. Granting copyright protection in this way could result in outcomes which would be contrary to Congress's steadfast refusal since 1914 to enact a general industrial design protection statute as well the Supreme Court's statements about the importance of the competitive mandate and the public's right to copy that which our copyright and patent laws leave in the public domain.