

# Supreme Court Seeks to Clarify Copyrightability of Design Features on Useful Articles in Cheerleading Uniform Case

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On March 22, 2017, in a 6-2 decision in *Star Athletica, L.L.C. v. Varsity Brands, Inc., et al.*, 580 U.S. \_\_\_, the U.S. Supreme Court held that a design feature incorporated into a useful article may obtain copyright protection if that feature: (1) can be perceived as a two-dimensional or three-dimensional work of art separate from the useful article; and (2) would qualify as a protectable pictorial, graphic, or sculptural work (either on its own or fixed in another medium of expression) if it were imagined separately from the useful article into which it is incorporated. In so ruling, the Court sought to provide additional guidance with respect to the doctrine of “separability” that courts have struggled to interpret and apply over the past several decades.

## Background

As a general matter, U.S. copyright law protects creative expression and not purely functional or utilitarian items. This distinction, however, can be difficult to apply when considering functional items that also feature or incorporate design elements. When confronting these items, courts seek to determine which design elements, if any, are copyrightable, and how, if at all, those elements can be considered separately from the items in which they are incorporated.

The Copyright Act expressly addresses this issue in connection with “useful articles,” which are defined as items “having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” 17 U.S.C. § 101. Specifically, designs of “useful articles” are only copyrightable if and to the extent that they “incorporate[ ] pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” *Id.* This notion of disaggregating a copyrightable design from a functional item has been referred to as “separability,” and courts have crafted several different — and not altogether consistent — tests to determine whether a design truly can be “identified separately” or “exist independently” of utilitarian elements.

The issue in *Star Athletica* was whether the respondent owned valid copyrights in the “combinations, positionings, and arrangements of elements” in cheerleading uniforms, such as chevrons, curves, stripes, coloring and shapes. The U.S. District Court for the Western District of Tennessee had concluded that the respondent’s designs did not qualify for copyright protection because they served the function of identifying the garments as cheerleading uniforms, and thus the designs were impossible to separate from the utilitarian function of the uniform. 2014 WL 819422 (W.D. Tenn. Mar. 1, 2014). The U.S. Court of Appeals for the Sixth Circuit reversed (with a dissent) on the grounds that the designs were both separately identifiable and capable of existing independently. 799 F.3d 468 (6th Cir. 2015).

## Decision

In the majority opinion, authored by Justice Clarence Thomas on behalf of five justices, the Court first turned to the language of Section 101 of the Copyright Act itself to expound on the meaning of the two separability requirements with respect to useful articles. The Court concluded, with little explanation, that the requirement that a design “can be identified separately from” utilitarian aspects is “not onerous,” and that a “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 properties.” The Court devoted slightly more — but still quite little — ink to the requirement

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that a design be “capable of existing independently,” concluding that a design feature must be able to exist as its own pictorial, graphic, or sculptural work “once it is imagined apart from the useful article.” The Court re-emphasized, however, that a design feature itself cannot constitute a useful article and still obtain copyright protection.

The majority then explained that its interpretation of Section 101 was consistent with both the Copyright Act “as a whole” and the history of the statute. For example, Section 113(a) of the Copyright Act — which clarifies that the right to reproduce a copyrighted work in copies includes the right to do so “in or on any kind of article, whether useful or otherwise” — suggested that the “ultimate separability question” is whether a design feature “would have been eligible for copyright protection ... had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article.” The Court further explained that its holding was in line with its prior jurisprudence and prior Copyright Office regulations that predated the current Copyright Act.

Having stated the separability test, the Court found its application to the cheerleader uniform designs “straightforward”: The surface decorations on the uniforms are identifiable as having “pictorial, graphic, or sculptural qualities,” and the arrangements would qualify as two-dimensional works of art if separated from the uniform and applied in another medium. Accordingly, the decorations were found separable from the uniforms and eligible for copyright protection. The Court, however, expressly disclaimed any conclusion regarding whether the decorations were sufficiently original to qualify for copyright protection and further clarified that even if the decorations were copyrighted, the owner could not use such copyright to prohibit manufacture of any “cheerleading uniform of identical shape, cut, and dimensions.”

Finally, the majority rejected three arguments raised by the petitioner. First, the Court did not accept the premise that a design feature may exist independently only if the useful article from which it was extracted would remain equally useful without that design feature. Second, the Court found no basis in the text of the Copyright Act for the petitioner’s position that the separability test should consider “objective” components such as whether a design element can be identified as reflecting purely artistic judgment apart from functionality concerns, and whether a design feature would still be marketable without its utilitarian

function. Third, the Court disagreed with the petitioner that Congress’ refusal to include a statutory provision permitting limited protection of industrial designs had any relevance or persuasive value.

## Concurrence and Dissent

In her concurrence, Justice Ruth Bader Ginsburg explained that she did not join the majority’s opinion because she did not believe it was appropriate to take up the issue of the separability test in the context of this case. In Justice Ginsburg’s view, the separability test was not applicable because the designs on the cheerleader outfits were not designs “of useful articles” but rather were pre-existing copyrightable pictorial or graphic works that were subsequently “reproduced on useful articles.” Since an owner of a copyright in a pre-existing pictorial, graphic, or sculptural work may exclude others from reproducing works on useful articles, Justice Ginsburg’s view was that there was no need to engage in the separability inquiry here.

Justice Stephen G. Breyer, joined by Justice Anthony M. Kennedy, dissented on the basis that, even applying the majority’s test, the designs at issue could not be perceived as works of art separate from the useful article. Providing a lengthy and academic analysis of separability issues and the facts of the current case, as well as pointing to images of cheerleader uniforms submitted by the respondent to the Copyright Office, Justice Breyer concluded that the design features being protected were necessarily part of the cheerleader outfits and could not exist independently of utilitarian aspects.

## Conclusion

The Supreme Court’s new test for determining whether a design feature incorporated into a useful article can be independently copyrightable will necessarily eliminate many approaches to separability, but, as the dissent demonstrates, there still may be difficulties and disagreements in its proper application. Indeed, the concurrence suggests that the separability test should not have been applied at all to the circumstances of the case. It remains to be seen whether the majority’s new test (1) does substantially more than offer a slight rewording of the statutory language in Section 101, and (2) will have any systematic impact on the likelihood that a design element in a useful article will or will not be found separable and thus copyrightable.