

Star Athletica v. Varsity: Ceci N'est Pas Une ... Useful Article

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Every so often, in the annals of contemporary copyright law, it is refreshing to encounter a decision that does not contain the terms “fair use” or “Digital Millennium Copyright Act,” and to spend some time thinking about the actual intellectual property that copyright is supposed to protect — or not. Does copyright extend to an artistically crafted pipe, or only a picture of the pipe?

Last week, the U.S. Supreme Court gave us just such an opportunity, issuing its much-anticipated (at least among copyright devotees) opinion in *Star Athletica LLC v. Varsity Brands Inc.*, concerning the protectability of cheerleader uniform designs. In the interest of full disclosure, I note that in my former role as general counsel of the U.S. Copyright Office, I assisted with the government’s amicus effort in support of the office’s views — an exercise that led to my personal acquisition of a pair of midcentury Balinese dancer lamps (but more on that later).



Jacqueline C.
Charlesworth

If you are at all familiar with the *Star Athletica* case, you likely know that the court was not considering the garment design (i.e., cut and shape) of cheerleader uniforms, but rather two-dimensional designs appearing on the uniforms. More specifically, Varsity Brands created multicolored designs consisting of chevrons, stripes, shapes and lines, registered them with the Copyright Office as two-dimensional artwork, and applied them to outfits it purveys to cheerleading teams. Its competitor, *Star Athletica*, allegedly copied Varsity’s designs, and Varsity sued. *Star* defended largely on the ground that Varsity’s designs were utilitarian in nature and thus unprotectable under copyright law.

In enacting the 1976 Copyright Act, Congress affirmed the principle that useful articles are not entitled to copyright protection and, in so doing, ratified the views of the Copyright Office in response to the Supreme Court’s 1954 decision in *Mazer v. Stein*. In *Mazer*, the court held that the mere fact that a statuette of a dancing figure was intended for use as a lamp base — that is, as part of a utilitarian article — did not disqualify it from copyright protection. Accordingly, consistent with the office’s approach, Section 101 of the 1976 Act provides that the design of a useful article is protectable “only to the extent that [it] incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”

In construing this language, courts, not surprisingly, have turned to the legislative history of the act, in which the lawmakers elaborated that “[u]nless 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.” Over the years, judicial efforts to apply the statutory text and

legislative gloss to real-world examples of artfully designed hubcaps, bike racks and mannequin heads have yielded a tangled and confusing branch of copyright law known as the separability doctrine. As the Ninth Circuit — quoting the Third Circuit — lamented in a recent case in which it was called upon to evaluate the protectability of a hookah water container (held not protectable, because the decorative shape of the container cannot be separated from its liquid-holding function), this is an area of law where courts have “twisted themselves into knots.”

The concept of physical separability referenced in the legislative history may seem not so difficult, for it asks the observer a relatively simple question about a tangible object: Is it possible to take the artsy thing off the utilitarian thing? A classic illustration of a physically separable feature cited in the “Compendium of U.S. Copyright Office Practices” is an automobile hood ornament. But this is an easy example, because presumably you are still left with a working car after you remove the ornament, albeit one bereft of some decoration. But what of the lamps in Mazer? Take away the statuette and there is nothing to hold up the socket, bulb, and shade. (It was my quest to confirm the actual construction of the Mazer lamps that led to my online discovery of the male-female Balinese dancer pair, as a result of which I can report that the sockets are affixed to the dancers’ heads with the wiring running through a hollow tube in their bodies and then out through a hole in the base.) Does it matter for purposes of copyright law that you don’t have a working lamp when the artistic element is taken away?

And then there is the second type of separability mentioned in the legislative history, conceptual separability, a great white whale of copyright law. In considering conceptual separability, the observer is asked whether an artistic feature that is impossible to remove from a utilitarian article — such as a carving on the back of a chair or etching on the surface of a vase — is, at least in the mind’s eye, an independent work of art. Many pages of the Federal Reporter, not to mention treatises and academic journals, have been devoted to how best to approach that inquiry.

In *Star Athletica*, the trial court granted summary judgment to Star on the theory that the Varsity designs were not protectable because a cheerleading uniform is not a cheerleading uniform “without team colors, stripes, chevrons and similar designs.” In other words, in the eyes of the district court, Varsity’s designs were not separable from the function of the uniforms. On appeal, the Sixth Circuit disagreed with the essentialist approach of the district court. Drawing upon the Copyright Office compendium and the multiplicity of separability standards across the circuits, the appeals court constructed its own multifactor test, under which it determined the Varsity designs to be protectable. Because the designs did not enhance the functionality of the uniforms “qua clothing” — that is, did not serve to “cover the body, permit free movement, [or] wick moisture” — the circuit court viewed them as separable. An all-white uniform could perform these tasks just as well.

Enter the justices of the Supreme Court, who may have seen the cheerleading case as an opportunity to clean up the messy area of separability. Before the court, Star continued to press the point that the Varsity designs were functional, averring at oral argument that the lines, stripes and “waist-narrowing Vs” make cheerleaders appear “taller and slimmer.” (Although the uniforms may have evolved since my high school days, apparently social biases around cheerleaders have not.) Of course, virtually any decoration on a garment — fringe, flowers or polka dots — was arguably put there in an effort to enhance the wearer’s appearance. Taken to its logical conclusion, then, Star’s position would seem to preclude protection for fabric designs in general, which no one (not even Star) claims are not copyrightable.

Though some observers were surprised that the court took a case involving 2-D design — which many understand to be conceptually separable as a matter of course — the court lived up to its seeming

purpose of unifying the law. Justice Clarence Thomas’s majority opinion (joined by Chief Justice John Roberts and Justices Samuel Alito, Sonia Sotomayor and Elena Kagan) swept away the welter of competing separability tests and replaced them with a new standard tied more closely to the statutory language of Section 101: “[A] feature incorporated into the design of a useful article is eligible for copyright protection ... if the feature (1) can be perceived as a two-or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic or sculptural work — either on its own or fixed in some other tangible medium of expression — if it were imagined separately from the useful article into which it is incorporated.”

Significantly, the majority opinion seems to cast aside the legislative history discussed above, by “abandon[ing] the distinction between ‘physical’ and ‘conceptual’ separability.” According to Justice Thomas, the statutory language itself tells us that separability analysis “is a conceptual undertaking.” The observer of a useful article with potentially protectable design is thus called upon to engage in an “imaginary extraction” of the article’s artistic features — to think of them either as standing alone or transposed into another medium — and then consider whether the result qualifies as a work of art (which work itself cannot be useful). If it does, the artistic features are separable and eligible for copyright protection. Happily, in framing the test as it did, the majority definitively answered the lamp question posed above: it matters not if you no longer have a working lamp after the imaginary extraction is complete. Mazer did not lose any luster.

Justice Ginsburg, though concurring in the judgment, would not have reached the thorny question of separability in this case. To her, the designs at issue are simply standalone 2-D artwork, registered by Varsity with the Copyright Office as such, and applied by Varsity to cheerleading uniforms. If others acting without authorization reproduce the artwork on garments, they are infringing the copyright in the artwork. Case closed.

But in a dissenting opinion, Justice Stephen Breyer, joined by Justice Anthony Kennedy, saw things quite differently. He could not conceptualize the Varsity designs — which conform to the shape of the uniforms to which they are applied — as 2-D artwork separate from underlying garment. To him, the artistic elements of Varsity’s designs “exist only as part of the uniform designs.” Thus, the technique of imaginary extraction failed him, notwithstanding the majority’s helpful hypothetical: imagine a design in the shape of the surface of a guitar, which could be applied to an album cover, or, alternatively, the guitar itself. As the majority simply and convincingly explained, the image remains a 2-D work of art regardless of the object to which it is applied.

Nonetheless, Justice Breyer, in pointing to the aesthetic qualities of virtually any industrial design, alludes to a much more challenging question, which is how the majority test will be applied in the case of 3-D design. The majority was not compelled to address the nuances of 3-D analysis on the facts of *Star Athletica*. But take the example of the hookah water container mentioned above. The shape of the container is artistic, but also defines the liquid-holding vessel: Could the artistic shape be “imaginatively extracted” into a different medium under the new test? The above-cited legislative history and pre-*Star* edition of the Copyright Office compendium say that the shape of such a vessel is not protectable, but issues like these will surely resurface under the court’s restated approach.

And then there is the still deeper question implicated by the court’s new rubric — also touched upon by Justice Breyer — of what should be considered a “work of art” for purposes of identifying potentially copyrightable elements. But the court did not attempt to answer that question, and neither will I.

—By Jacqueline C. Charlesworth, Covington & Burling LLP

Jacqueline Charlesworth is of counsel in Covington & Burling's New York office. She served as general counsel and associate register of copyrights for the U.S. Copyright Office from 2013 to 2016.

DISCLOSURE: In her former role in the Copyright Office, Jacqueline Charlesworth took part in deliberations relating to the Star Athletica case.

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