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Star Athletica, LLC v. Varsity Brands, Inc.

137 S. Ct. 1002 (2017)

CHRISTOPHER OGBUEHI*

BACKGROUND

Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc. (“Respondents”) are designers, manufacturers, and sellers of cheerleading uniforms. They have over 200 copyright registrations for two-dimensional designs that have appeared on their uniforms. Star Athletica, LLC, (“Petitioner”) also markets uniforms. Respondents filed suit against petitioner alleging copyright infringement with respect to five designs.

PROCEDURAL HISTORY

The District Court held that the designs were not protectable and issued summary judgement in favor of Star Athletica. They reasoned the designs served a useful function: they helped to identify “the garments as ‘cheerleading uniforms’”¹ and thus could not be separated—either in a physical or conceptual sense—from the uniforms they were on. The Court of Appeals for the Sixth Circuit reversed this decision and held that the designs could in fact be identified separately from the uniforms and the designs could exist independently of the uniforms such that they could be placed onto other garments or surfaces.

ISSUE

The issue was whether the designs and arrangements on Varsity’s cheerleading uniforms are eligible for copyright protection as a separate feature from the uniforms themselves in line with the exception to useful articles as contained in §101 of the Copyright Act of 1976.

DECISION

The Court of Appeals of the Sixth Circuit’s decision was affirmed. The Supreme Court held that the designs could be perceived separately as a two- or three-dimensional works of art and could be protected separately as a

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1. Star Athletica, LLC v. Varsity Brands, Inc., 137 S. Ct. 1002, 1008 (2017).

pictorial, graphic, or sculptural work aside from the useful article it was incorporated onto.

REASONING

The majority began by laying down basic rules and definitions: a “useful article,” is defined in §101 of the Copyright Act as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”² They also restated that useful articles are not protected under the statute, but their designs are if the design works contain elements that are otherwise protectable as pictorial, graphic, or sculptural works and if those works can exist and be identified separately from the useful or utilitarian parts of the article.

Respondents argued that the separability analysis was unnecessary under the circumstances, because the designs or surface decorations in question were not the useful article’s design but rather designs on it. This meant the designs were simply protected as two- or three-dimensional works of art. The Court rejected this because it ran contrary to §101’s wording and held the analysis is required where “‘pictorial, graphic, or sculptural features’ [are] ‘incorporated into the design of a useful article.’”³ The Court then employed the dictionary meaning of “design” as “‘the combination’ of ‘details’ or ‘features’ that ‘go to make up’ the useful article.”⁴

The United States, as *amicus curiae*, advanced a related argument. They argued that as part of their copyright registration, Respondents tendered drawings and photographs of the designs, in themselves copyrightable, and that Varsity simply reproduced their copyrighted material onto a useful article. The Court sidestepped that argument, because neither party brought it forward.

The Court proceeded to do an ordinary analysis of the relevant portion of statutory text. The Court surmised that to be eligible for copyright protection, a pictorial, graphic, or sculptural feature incorporated into the design of a useful article must be: (1) separately identifiable from the article; and (2) capable of existing independently of utilitarian aspects of said article.⁵ To fulfil the first requirement, the Court held that the decision maker, looking at the useful article, needs to “spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.”⁶ For the second requirement, the Court said element(s) passing the first requirement must then be able to exist separately from the utilitarian aspects of the useful article. Failure to meet this second requirement simply makes the element one of the utilitarian aspects of the article. The Court then clarified that if a feature itself is a useful article or part of a useful article,

2. *Id.* (citing 17 U.S.C. §101).

3. *Id.* at 1009.

4. *Id.*

5. *Id.* at 1010.

6. *Id.*

then it cannot be considered as a pictorial, graphic, or sculptural work. Also, no party can claim copyright in a useful article simply by replicating it in another medium (like a photograph) even though said replica might actually be eligible for copyright.

Next, the Court approached the statute holistically. §106 gives an author the exclusive right to make copies of his copyrighted work, and §113(a) allows this copying in or on any article—useful or not. Combined with the wording in §101, the Court said the statute clearly meant to protect “pictorial, graphic, and sculptural works regardless of whether they were created as freestanding art or as features of useful articles.”⁷

The most important question then was whether the part of the useful article that copyright protection was sought would have been copyrightable as a pictorial, graphic, or sculptural work if it had initially been fixed in a medium other than a useful article. To buttress the point, the Court referred to *Mazer v. Stein*, 347 U.S. 201 (1954). In *Mazer*, a statuette that depicted a dancer was copyrighted, but part of the original intent was to also use the statuette as a lamp base complete with the necessary paraphernalia and electrical fittings. It was sold both as a statuette and as a lamp base. It was copied by Stein, who argued that copyright could not attach in an object made to be a lamp base. The Court then not only upheld the copyright there, they also held that the original purpose for which the object was created was irrelevant. In fact, the ruling in *Mazer* was the precursor to the separability test as it is currently known and defined in the Copyright Act §101.

The Court then applied the test as enumerated. It held that the decorations in question were quite easily identifiable as having pictorial, graphic, or sculptural qualities. Secondly, it held that if the designs were removed from the uniform and put on another medium—like on a painter’s canvas—the designs would not replicate the uniform and would be eligible for copyright. The designs were thus held eligible for copyright protection.

The dissent and petitioner put forward two similar arguments, which the majority addressed: that the designs, when taken off and put on another medium, would retain the outline of cheerleading uniforms or simply be an image of one. In response, the majority said that this fact did not act as a bar to copyright because two-dimensional art, whether painted on a wall or a guitar, had to take the form of the surface it was put on, but did not necessarily replicate that item as a useful article.⁸

The Court then addressed a few objections that both the government and petitioner raised as to its reasoning. Petitioner argued any artistic element that enhanced a useful article’s utility was not copyrightable. The designs in question, they argued, helped identify whoever had them on as a cheerleader and enhance their appearance. The Government argued the uniforms would not be as useful without the designs. The Court stated the test did not involve an assessment of the state of the useful article without

7. *Id.* at 1011.

8. *Id.* at 1012.

the artistic element; it was simply a test of the artistic piece in isolation. Following from there, the Court rejected the distinction between “physical” and “conceptual” separability which some courts and commentators have adopted based on the Copyright Act’s legislative history. The statute’s wording only envisaged a conceptual separability because “separability does not require the underlying useful article to remain, [so] the physical-conceptual distinction is unnecessary.”⁹

Petitioner also argued that the Court should give credence to how much functionality played a part in the designer’s artistic decisions and whether the art had any market value independent of the useful article. Both arguments were rejected as not being backed by the exact words in the statute. The statute did not give any instruction to delve into the designer’s rationale, and a reliance on market value would introduce an unwanted bias for popular art. Petitioner’s final argument was that Congress, in refusing to allow copyright protection for industrial design, signified an intention to exclude surface decoration as well. This showed Congress’s desire for those and other industrial designs to be lodged as design patents. The Court’s reply was that congressional inactivity was not persuasive and that “design patents and copyright were not mutually exclusive.”¹⁰

CONCURRENCE

Justice Ginsburg delivered a concurring judgment with decidedly less frills. The Justice reasoned the separability test was unnecessary to this case “because the designs at issue are not designs of useful articles.”¹¹ In Justice Ginsburg’s opinion, the designs qualified as pictorial work, capable of receiving copyright protection, that were simply placed upon useful articles. Varsity first sketched the designs on paper and sought copyright not for the uniforms but for their sketches, allowing the exclusive reproductive rights of their designs on any type of article.

DISSENT

Justice Breyer delivered the dissenting opinion and was joined by Justice Kennedy. In their dissent, they agreed with the Court’s test but disagreed with their application and, hence, the decision. They opined that the designs submitted to the Copyright Office were pictures of cheerleader uniforms and that those simply replicated useful articles but in another medium. This meant that the designs were unable to exist separate from the more utilitarian features of the useful article. They leaned instead towards both a physical and conceptual test of separability. They argued that the designs could not pass a conceptual separability test because they found it difficult to conceive the designs as having any other aesthetic purpose than

9. *Id.* at 1014.

10. *Id.* at 1015.

11. *Id.* at 1019 (Ginsburg, J., concurring).

being part of cheerleader uniforms. They believed that the majority, in simply asking whether the relevant design could be conceived as a two- or three-dimensional works of art, employed the wrong question. They felt just about any industrial design could then be conceived of separately as a work of art.

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