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Something for Designers to (Maybe) Cheer About: *Star Athletica v. Varsity Brands*

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

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Background

Historically, fashion designers, as well as other designers whose creative efforts are incorporated into useful/functional articles like clothing, shoes, and furniture, have struggled successfully to assert copyright protection for their works. Because copyright protections under the Copyright Act extend only to those elements of a useful article that “can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article,” courts have had trouble identifying the line between the usefulness of clothing and various design elements that have been claimed to be separate from the function of the clothing itself.

For example, a federal district court in New York rejected a copyright claim in a prom dress because the elements of the dress design claimed “[are] plainly usable only as a component of a dress, or, at best, a similar item of clothing such as a skirt or blouse.” *Jovani Fashion Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 550 (S.D.N.Y. 2011).

Visual Comparison of Fiesta Fashions Style with Jovani Style



On the other hand, the Second Circuit found that designers had a protectable copyright interest in various sweater designs that included graphic depictions of leaves, squirrels, and other autumnal imagery, shown below, because the appliques were sufficiently separable from the functional utility of the sweaters themselves. *Knitwaves, Inc. v. Lollytogs, Ltd. (Inc.)*, 71 F.3d 996 (2d Cir. 1995).



EX. 3: KNITWAVES' SQUIRREL SWEATER



EX. 5: LOLLYTOGS' LEAF SWEATER



EX. 6: LOLLYTOGS' SQUIRREL SWEATER

As these two cases suggest, courts have wrestled with the highly abstract and amorphous question of separability, and developed a variety of tests to aid in the analysis. Some have required actual, physical separability. Others have looked at what remained after the claimed elements are removed, to ascertain whether anything useful was left behind. Still others have taken the marketability of the separated elements as aesthetic works into consideration or looked for evidence of the designers' artistic decisions with respect to these separate design elements to determine whether the designs were sufficiently separable from the utilitarian function of the object.

The Supreme Court's decision last month in *Star Athletica* attempts to clarify the proper approach to what has been called a "metaphysical quandary" by many courts. Not only does it resolve the dispute among circuits as to what should be considered in a separability analysis, it also opens the door to additional protections for fashion designs by recognizing that the two-dimensional arrangement of colors and symbols (in this case, stripes, chevrons, and color patterns) can be separated from the three dimensional article to which these designs are applied and therefore may be protectable under the Copyright Act. It is important to emphasize, however, that the Supreme Court expressly refrained from ruling on whether or not the designs in this case are sufficiently *original* to qualify for copyright protection. That question will be taken up by the lower court on remand.

Nonetheless, this ruling may well prompt a more aggressive approach to copyright protection and enforcement by those who might previously have been reluctant to do so.

The Dispute

Varsity Brands, Inc. ("Varsity Brands") the owner of more than 200 copyright registrations for various two-dimensional designs appearing on cheerleading uniforms, sued one of its competitors, Star Athletica, LLC ("Star Athletica"), for copyright infringement, based on Star Athletica's sale of uniforms featuring similar designs. The Varsity Brands designs are depicted below:



The district court granted Star Athletica's motion for summary judgment, based on Star Athletica's arguments that the designs could not be conceptually or physically separated from the useful purpose of the uniforms themselves and therefore were not properly protectable under the Copyright Act. The court emphasized that, in the case of cheerleading uniforms, the design of the uniforms "has merged with the utilitarian function that they serve." More

specifically, the court found the claimed elements inseparable from the cheerleading uniforms because the uniforms lost their utilitarian function when the colors, designs and other claimed elements are removed.

On appeal, the Sixth Circuit reversed, finding that the designs and graphics could be separated from the uniforms themselves and therefore qualified for protection under Section 101 of the Copyright Act. The Sixth Circuit noted the cheerleader designs “are more like fabric design than dress design” and rejected the lower court’s determination that the utilitarian purpose of the uniform is to identify the wearer as a cheerleader and a member of a cheerleading team. The appellate court held that the utilitarian purpose of the uniform is “to cover the body, wick away moisture, and withstand the rigors of athletic movement.” With this understanding, the designs affixed onto the uniforms were separable from the utilitarian purpose of the uniforms themselves.

In a 6-2 decision, the Supreme Court held that “a feature incorporated into the design of a useful article is eligible for copyright protection only 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.” In other words, “use your imagination.” If one can visualize/imagine the claimed features of a useful article as a separate work separate from the useful article, and this imagined work would qualify as a pictorial, graphic, or sculptural work, then the separability test has been met and the claimed elements are eligible for copyright protection, if—and this is a crucial “if”—they contain sufficient originality.

Taking the uniforms at issue through this thought experiment, the majority found that the decorations can be identified as having “pictorial, graphic, or sculptural qualities” and that those elements when applied to a painter’s canvas, would “qualify” as two-dimensional works of art, noting that the application of these decorations to a canvas would not result in the replication of the uniforms. A rendering of one such imaginative application is below.



The finding of separability here does not equate to a finding of protectability. The Court expressly refrained from ruling on whether the designs in question were sufficiently original to qualify for copyright protection. Thus, successfully qualifying as a separable work does not necessarily mean the resulting work is sufficiently original to merit copyright protection. That is a separate consideration that remains unanswered in this case.

Authored by Justice Breyer, the dissent insisted that the separability exercise results merely in an imagined painting of a “cheerleader’s dress,” because in taking the design elements that include the cut of the uniform and the arrangement of these elements on the uniform one must necessarily “bring along the underlying utilitarian object.”

In a concurring opinion, Justice Ginsberg proposed a much simpler solution than the one adopted by the majority. In reviewing the copyright applications, she noted that Varsity Brands has claimed copyright protection for the stand-alone graphic works submitted to the Copyright Office (*i.e.*, the sketches and designs) and such works may gain copyright protections accordingly, “including the exclusive right to reproduce the designs on useful articles.”

Conclusion

The impact of this decision remains to be seen. There is no question the Court has provided a new framework for determining separability, which may result in an uptick of designers seeking to protect the graphic patterns on their creations. But it remains an open question what types of arrangement and patterns will be considered sufficiently original to merit protection.

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