

## Drawing the Line between Copyright and Industrial Design Protection

Where the line between art, which is protected by copyright, and industrial designs should be drawn is difficult to determine. A recent [decision](#) of the Supreme Court of the United States adds to the discussion.

### The Facts

Varsity Brands, Inc. designs, makes and sells cheerleading uniforms. They own more than 200 U.S. copyright registrations for the two-dimensional designs that appear on the surface of their uniforms and other garments. The designs are primarily composed of combinations and arrangements of elements that included chevrons, lines, curves, stripes, angles, diagonals, inverted chevrons, coloring and shapes. The designs in issue are reproduced below:



Design 299A



Design 299B



Design 074



Design 078



Design 0815

### The Copyright Act

In the U.S. the *Copyright Act* contains a special rule relating to the copyright subsisting in a pictorial, graphic or sculptural work incorporated into a “useful article”. 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. The design of a useful article is protected by copyright only if, and only to the extent that, the design 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.

## **Separability**

In the U.S. the analysis to determine if a feature can be separately identified from and exists independently of a useful article is referred to as “separability”. The courts below disagreed on whether the design of the cheerleading uniforms was eligible for copyright protection as separable features of the uniforms.

The court broke down the rule into two steps. A design of a useful article is eligible for copyright protection, if it (1) “can be identified separately from” and (2) is “capable of existing independently of the utilitarian aspects of the article”. The first requirement – separate identification - was not onerous to apply and satisfied. The independent-existence requirement is normally more difficult to satisfy. To be protected, the feature must be able to exist as its own pictorial, graphic or sculptural work once it is imagined apart from the useful article. To qualify as a pictorial, graphic or sculptural work on its own, the feature cannot itself be a useful article.

A regulation had been enacted to assist in applying the rule. The regulation provides that if the sole intrinsic function of an article is its utility, that the article is unique and attractively shaped will not qualify it for copyright protection. 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, the features are eligible for protection.

## **Applying the Rule**

Applying the rule and the analytical approach described above to the cheerleading uniforms, the majority of the court concluded that the designs satisfied the two elements of the rule. The designs included features having pictorial, graphic or sculptural quantities. In addition, if the presentations of the designs were separated from the

uniform they would qualify as two-dimensional works of art under the U.S. *Copyright Act*. In fact, Varsity Brands had applied the designs to the different clothing without replicating the uniform.

The majority of the court found that the test was satisfied and dismissed the appeal. However, two justices of the court dissented. The dissenting judges said that the designs could not be perceived as works of art separate from the useful article because the artistic arrangement of the two-dimensional design elements followed the shapes or pattern of the cheerleader uniform. The designs could not be extracted from the two-dimensional design of the dresses as a whole.

It has been suggested that this decision is important for clothing designers in the U.S. because it offers potential protection for the non-utilitarian design aspect of clothing, even when the designer included those elements as part of a utilitarian article.

### **The Canadian Position**

Unfortunately for clothing designers, the *Canadian Copyright Act* is not as helpful. The *Canadian Act* provides that where copyright subsists in a design applied to a useful article or in an artistic work from which the design is derived and with the authority of the copyright owner, the article is reproduced in a quantity of more than fifty, it is not infringement of the copyright or the moral rights for anyone to reproduce the design of the article or design not differing substantially from the design by making the article or making a drawing or other reproduction in any material form of the article.

A “useful article” means an article that has a utilitarian function and “utilitarian function”, regarding an article, means a function other than merely serving as a substrate or carrier for artistic or literary matter”. These provisions apply to designs created after June 8, 1988. In addition, there are exemptions for certain artistic works from the

limitation but they would not apply in this case.

Since the cheerleader uniforms have a function other than merely serving as a substrate or carrier for artistic matter, the result would be the opposite of that reached in the U.S. and no copyright protection would be available.

### **Comment**

U.S. copyright owners have potentially broader rights than do owners of copyright in Canada on this point. In addition, the problem is made worse by protection in Canada being lost relatively quickly absent applying for protection under the *Industrial Design Act*. Unlike the European Union, there is no common law design right to provide protection in the absence of a registration.

It is difficult to determine whether an article is useful or merely serves as a substrate or carrier for artistic or a literary matter. For example, a tie pin or cuff links may be useful jewelry since they hold clothing together, while a brooch or an earring may be purely ornamental and not useful .

Nothing in the Canadian *Act* prevents the owner of the design from obtaining protection under the *Industrial Design Act*. However, expenses are associated with obtaining such protection that do not exist for copyright works and there is a one year bar after which registration is not possible.

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*These comments are of a general nature and not intended to provide legal advice as*

*individual situations will differ and should be discussed with a lawyer.*