

Management Alert



“GIVE ME A ... ©?” – Cheerleading Uniforms, Fashion Design and Copyright Law

By Edward F. Maluf

The old adage may hold that imitation is the sincerest form of flattery, but fashion designers are understandably dismayed when perfect replicas of their creative apparel are sold at deep discounts to lower-end markets soon after the originals first appear on the racks of high-end stores or celebrities walking the red carpet. Unsurprisingly, designers and their counsel think long and hard about how best to protect these designs from this kind of copying, including through registered trademarks (such as trade dress), design patents and copyrights. But legal protections against infringing conduct can be difficult to sustain because clothing is a useful item that we all need. No one should get an exclusive on shirts, pants and other garments. But designers might be able to obtain intellectual property protection for the creative elements reflected in the *design* of these garments.

In the world of copyright, the challenge in determining whether an article of clothing deserves legal protection against infringement lies in the distinction between the particular design of the garment, and the purpose of the garment itself, if one can be found. Or put as a question, can you *separate* the creative features of an item from its utilitarian aspects? If not, a finding of infringement is not possible even if copying occurred, because the copied design was not copyrightable to begin with. But just how to go about answering that seemingly straightforward question has vexed lawyers, Congress (which has unsuccessfully tried many times to amend the Copyright Act to give statutory protection over novel fashion designs) and the federal courts.

The Sixth Circuit took this issue on for the first time in connection with several copyright-registered cheerleader uniform designs in the case *Varsity Brands, Inc., et al. v. Star Athletica, LLC*. Varsity, the plaintiff, designs, markets and sells cheerleading apparel and accessories. Its in-house designers sketch concepts that Varsity uses to produce cheerleaders' uniforms. Star, the defendant, also markets and sells various sports uniforms, including cheerleading attire.

In mid-August, the three-judge panel reversed the District Court by a 2-1 vote. The lower court had determined that the designs themselves were not copyrightable because it could not distinguish between the creative aspects of the uniforms and the purpose of the uniform itself. So if the designs were not copyrightable, then there could be no infringement and Varsity's case was dismissed. The sole dissenting judge from the Sixth Circuit panel agreed with the lower court. This means that of the four federal judges who reviewed this case on the same law and facts, two (appellate judges) could separate the creative and utilitarian elements (and held in favor of copyrightability), while the other two could not. Such is the perplexing state of the law.

Varsity claims that Star's cheerleading uniforms infringed its registered copyrights. Because the Sixth Circuit reversed the District Court's findings, Varsity will now have a chance to press its case, hoping for a finding of infringement. To prevail, Varsity needs to show (1) its ownership of valid copyrights in the designs, and (2) Star's copying of protectable elements contained in the designs. The first part of this test determines, among other things, copyrightability of the subject matter and originality of the works. Varsity's sketches in this case received federal copyright registrations for "two-dimensional artwork." Registrations are not, in and of themselves, proof of copyrightability. Registrations can be challenged, invalidated or cancelled.

To demonstrate copyrightability, Varsity needed to show that the clothing designs are non-functional or at least that they contain design elements that are *separable* from the utilitarian traits of the garment. The general "separability test" sounds simple enough: is the design in question that of a "useful article that incorporates pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspect of the useful article." But, as already noted, applying the test is a challenge to any judge.

The lower court applied its understanding of the separability test, and concluded that the particular elements of the copyrighted graphic designs were not physically or conceptually *separable* from the utilitarian function of a cheerleading uniform. Specifically, "the colors, stripes, chevrons, and similar designs" make the garment "recognizable as a cheerleading uniform" that identifies the team to which its wearer belongs, and therefore are *inseparable* from the utilitarian aspect of the garment. Put another way, "the aesthetic features of a cheerleading uniform *merge* with the functional purpose of the [cheerleading] uniform." So, if they merge and cannot be *separated*, then the designs are deemed solely that of a useful item, and cannot be considered copyrightable. The District Court stopped its analysis there and dismissed the case. Whether Varsity's designs were original, or whether Star copied Varsity's designs, were immaterial to the question of infringement if the designs themselves are not copyrightable.

Varsity appealed to the Sixth Circuit. The two majority opinion judges on the panel admitted that, when it comes to determining "separability," "courts have struggled mightily to formulate [such] a test ..." To prove its point, the court listed *no fewer than nine* different approaches to "separability" used by the different federal circuit courts around the country. And after having discussed each of them to varying degrees, it then came up with its own "hybrid approach," which asks the following five questions:

1. Is the design a pictorial, graphic or sculptural work?
2. If so, is it a design of a useful article?
3. If so, what are the utilitarian aspects of the useful article? (The Court gives an example of a chair, which is a useful article which serves the utilitarian purpose of providing a place for a person to sit.)
4. Can someone viewing the design "identify pictorial, graphic or sculptural features ... separately from the ... utilitarian aspects" identified in response to question 3?
5. If so, can the pictorial, graphic or sculptural features identified in response to question 4 "exist independently of the utilitarian aspects" identified in response to question 3?

Applying its own hybrid test here, the court provided the following responses:

Question 1: Yes, Varsity's designs reflect two-dimensional works of graphic art.

Question 2: Yes, these designs of cheerleading uniforms and sportswear have an "intrinsic utilitarian function."

Question 3: The "intrinsic utilitarian function" of these uniforms is to "cover the body, wick away moisture, and withstand the rigors of athletic movements."

Question 4: Yes, the arrangement of stripes, chevrons, zigzags and color-blocks all constitute graphic features of the copyrighted designs that can be identified.

Question 5: Yes, these graphic features can exist independently of the cheerleading uniforms functional aspects. For example, the graphic designs can exist on the cheerleading uniform, but also on the “surface” of any number of other garments, such as t-shirts, warm-up jackets, etc. Moreover, the designs on the surface of the garment, including the actual arrangement of their individual features, do not affect their functionality as a cheerleading uniform.

When all was said and done, the Sixth Circuit found that the graphic features of the cheerleading designs are “more like fabric design” (the design imprinted on a fabric which is used to create a garment) than dress design (the shape, style, cut and size for converting the fabric into a finished garment). And because the Copyright Act protects fabric designs, and not dress designs, the Sixth Circuit found that Varsity had established the copyrightability of its designs and could continue to pursue its case. The Court’s language is noteworthy because it implies a scale between fashion design on one end and dress design on the other, rather than a design being simply one or the other. So if a design is “more like” one than the other, then it will be treated as if it were entirely that type of design, and its copyrightability determined accordingly.

In some ways, this possibility makes assessing copyrightability even more difficult, as degrees of emphasis one way or the other can determine a party’s rights. The dissenting judge on the panel seemed to agree, writing that “either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design.”

Where does that leave the fashion designer? As unsettled as the law might seem, there still remain certain best practices that can help avoid trouble or create a supporting framework in the event existing rights should be vindicated.

For example, designers should work with intellectual property counsel to build a protocol for determining whether copyright, trademark or patent registration might be a suitable form of federal protection for their creations, and if so, seek to obtain those registrations.

In addition, designers might consider using image search technology to see whether their most important works are appearing in on-line retail sites. If a design is being used without license or other permission, intellectual property counsel can help determine the available options.

Also, designers should undertake the appropriate copyright, trademark and patent searches to see if their works might infringe on an already existing work. This can be difficult to do, and is not a 100% guarantee of capturing everything out there, but can be very useful in avoiding infringement accusations.

In the meantime, it seems unlikely Congress will succeed in clarifying the law, and it might be left to the Supreme Court to set the standard analytical tests all courts must use to determine copyrightability. This may take a couple of more years at least, but it might lead to greater predictability when it comes to determining parties’ rights and liabilities.

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