

One Minute Memo®



Star Athletica v. Varsity Brands, Inc. Copyright Case

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The following alert is directed to those clients in the fashion and design industries that manufacture or otherwise produce useful items (e.g., clothing, furniture, bottles, etc.) with unique design features that they would like to protect.

Seyfarth Synopsis: On March 22, 2017, the United States Supreme Court issued its opinion in the *Star Athletica v. Varsity Brands, Inc.* case, affirming and holding 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.” The Court held that the test was satisfied in this case, which involved geometric shapes on cheerleader uniforms.

The recently issued Supreme Court decision in *Star Athletica, LLC v. Varsity Brands, Inc.* came after being closely watched for several years. What intrigued many about the case was that it left open the opportunity for broader protection of designs of useful articles, such as appliques on clothing, furniture, perfume bottles, among many other things. It also gave the Supreme Court the opportunity to bring some harmony among the various federal courts to the practical standards they are to apply, and perhaps some greater predictability in the outcome of infringement cases involving useful items.

The useful articles at issue in *Star* were cheerleader uniforms made and sold by Varsity Brands, Inc. The uniforms featured design elements (for which Varsity obtained copyright registrations) consisting of various geometric shapes like chevrons and stripes; such shapes by themselves do not ordinarily constitute copyrightable subject matter.

While Congress has afforded (limited) protection to such designs, where protection for the designs begins and ends has been entrenched in muddy waters for decades, in part due to incongruous judicial interpretations of the “separability test,” (i.e., whether elements of an item are “separable” from the useful article itself, and thus, protectable). Various Courts of Appeals have adopted their own iteration of the separability test. The Sixth Circuit, from which the *Star* case arose, created its own multi-factor separability test to assess whether the geometric designs on the uniforms were protectable. It held in the affirmative. However, while the Supreme Court affirmed, it did so by creating its own separability test.

In his five-member majority opinion, Justice Thomas resolved this matter in favor of Varsity on the basis of an express reading of Section 101 of the Copyright Act, and consideration of the Court’s prior decisions. The Court’s test to determine copyrightability for an artistic element of a useful article is: “if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article [the “separate-identification” element] and (2) would qualify as a protectable

pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article [the “independent-existence requirement”].” Without determining whether the separated, non-utilitarian portion of the item is in fact copyrightable and therefore protected as an artistic work, the majority found that the uniform designs passed the test. But, the Court said, Varsity cannot stop others from making cheerleading uniforms in the same cut or shape.

Even getting past the first prong of the test will be challenging, as Justice Breyer’s dissent (joined by Justice Kennedy) already demonstrates. Where the majority found that the artistic element can be perceived separately, the dissent sees no such artistic element in the uniform. It argues that the decorations are ineligible for copyright protection because, when imaginatively extracted, they form a picture of a cheerleading uniform. The majority, however, took issue with the dissent’s assessment, explaining that the artistic design may take the shape of whatever canvas on which it is placed.

Referring to the surface of a canvas rather than its shape, Justice Ginsburg, in her concurring opinion, determined that the Court’s test is not even relevant here. In her view, Varsity wins because the “designs at issue are not designs of useful articles ... [but rather] ... copyrightable pictorial or graphic works reproduced on useful articles.” Thus, by her measure, the useful article is a blank canvas on which the artistic elements are applied and therefore copyrightable.

Just as the history of this case demonstrates the inherent subjectivity in determining whether a useful article can be copyrightable, where four federal judges at the District and Circuit Courts split 2-2 on copyrightability, yesterday’s three opinions from the eight-member Court make clear that subjectivity in determining copyrightability of useful articles remains a significant factor in any infringement analysis. This outcome demonstrates a lost opportunity by the Court to set an analytical standard that would increase the likelihood of predictable outcomes rather than keep such determinations in the realm of the subjective.

From a practical perspective, this case potentially muddies the copyright landscape even more than before, and may be viewed as opening the door to designers and others to become a bit more aggressive in seeking and enforcing copyright registrations, even for designs that may not immediately seem copyrightable (like designs consisting primarily of geometric designs). Eventually, over time as litigations are filed and courts apply their own varied and diverse interpretations of the Court’s test in *Star*, designers may be reined in on the basis of judicial precedent from the lower courts.

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