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Copyright Protection for Useful Articles after *Star Athletica*

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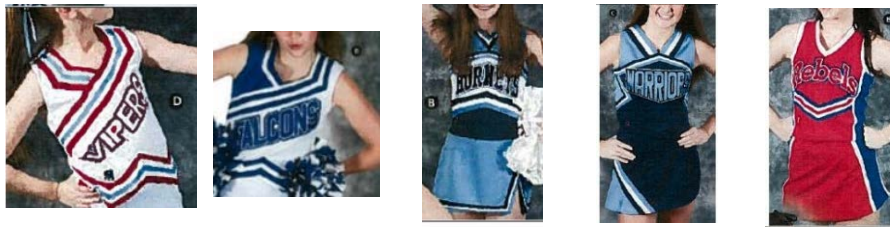
Technical Minds. Legal Muscle.

Overview of *Star Athletica v. Varsity Brands, Inc.* (Supreme Court 2017)

- Varsity Brands accused Star Athletica of copyright infringement for making and selling cheerleading uniforms incorporating Varsity Brands' two-dimensional designs consisting of lines, chevrons, and colorful shapes

Registered Designs:

Accused Designs:



Overview of *Star Athletica v. Varsity Brands, Inc.*

- DC: Summary Judgment for Star Athletica; the designs are not copyrightable subject matter
  - not conceptually separable from their function of "cloth[ing] the body in a way that evokes the concept of cheerleading."
- 6th Circuit: Reversed based on its new conceptual separability test.
  - "The arrangement of stripes, chevrons, zigzags, and color-blocking" can be identified and could be separated from the function of "cover[ing] the body, wick[ing] away moisture, and withstand[ing] … athletic movement."

Overview of *Star Athletica v. Varsity Brands, Inc.*

- USC: What is the proper test to determine a design's separability from the function of article incorporating the design?
  - Rejected the various tests in existence
    - Physical separability - physically separating the design from the useful article does not destroy the article's useful features (Copyright Office)
    - Conceptual separability – more than 9 different tests followed by the Copyright Office and the Circuits
  - Expressly abandoned the distinction between "physical" and "conceptual" separability

Separability Test under *Star Athletica v. Varsity Brands, Inc.* (Supreme Court 2017)

An artistic feature of the design of a useful article is eligible for copyright protection 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 imagined separately from the useful article

Separability Test applied to Varsity Brands' designs

(1) "[O]ne can identify the decorations as features having pictorial, graphic, or sculptural qualities."

(2) "[I]f the arrangement of colors, shapes, stripes, and chevrons were … applied in another medium—for example, on a painter's canvas, they would qualify as 'two-dimensional … works of … art ."

Judicial Decisions

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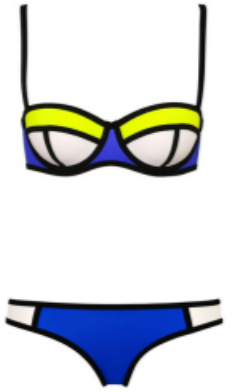
Bikini trim in *Triangl Group Ltd. v. Jiangmen City Xinhui District Lingzhi Garment Company* (S.D.N.Y. 2017)

"[The] designs are copyrightable because the decorative black trim and T-shape are physically separable and demonstrable as works of art."

Triangl's "Milly – St Tropez Sun" Bikini

Triangl's "Poppy – Blue Crush" Bikini



Tear Drop Light Set in Jetmax Ltd. v. Big Lots, Inc. (S.D.N.Y. 2017)

(1) The Light Set has “three-dimensional decorative covers that have sculptural qualities.”

(2) “The decorative covers are sculptural works that [can] exist apart from … [the light set’s function of] … light[ing] a room.”

Clothespin in *Design Ideas, Ltd. v. Meijer, Inc*. (C.D. Ill. 2017)

(1) The bird portion "can be perceived as a three-dimensional work of art separate from the useful article."

(2) "The bird portion would qualify as a protectable sculptural work on its own if it were imagined separately from the useful article …"

Costume in *Silvertop Assocs., Inc. v. Kangaroo Mfg., Inc.* (D.N.J. 2018)

(1) The costume has many features having "a pictorial, graphic, or sculptural quality," including its "overall length"; "shape" ("curvature"); "bright shade of a golden yellow" and "jet black" ends; "parallel lines"; "soft, smooth, almost shiny look"; and "the location of the head and arm cutouts."

(2) "[I]f these features were separated from the costume and applied on a painter's canvas, it would qualify as a two-dimensional work of art in a way that would not replicate the costume itself."

Copyright Office Review Board (CORB) Decisions

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Portions of a Robotic Arm (CORB 2017)

"The Board has serious doubts that … the plastic [circular] caps and the T-shaped piece … could be visualized as works of authorship separate and independent from the work's utility."

- "[T]he feature cannot itself be a useful article or '[a]n article that is normally a part of a useful article.'" *Star Athletica* at 7.

Pattern on Floor Liner (CORB 2018)

(1) “[T]he raised, decorative pattern of various shapes can be identified as a two-dimensional work of art separate from the floor liner.”

(2) “Such features would qualify as a protectable pictorial, graphic, or sculptural work if imagined separately from the useful article.”

“Moreover, they do not replicate the floor liner itself or ‘an article that is normally a part of’ a floor liner when so imaginatively removed.”

Takeaways

- "Artistic features" are copyrightable – but what is "artistic"?
  - clothing surface ornamentation, but not "shape, cut, and dimensions"
  - not a shovel

- Law is still developing, but consider copyright protection for
  - Surface pattern/ornamentation that would not qualify for TM protection (merely ornamental/aesthetically functional); light fixtures

- Artistic element need not be designed free from utility considerations; the useful article need not be useful once the artistic element is removed

- Be mindful of originality requirement