

NOTES

Bring It On: *Star Athletica, L.L.C. v. Varsity Brands, Inc.* Redefines Separability One Uniform Design at a Time

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I. OVERVIEW

Star Athletica, L.L.C. (Star) and Varsity Brands, Inc. (Varsity) are both in the business of designing and marketing cheerleading uniforms.¹ Varsity had acquired copyright protection for several of its two-dimensional uniform designs.² Star advertised cheerleading uniforms with designs on its uniform that appeared similar to Varsity’s two-dimensional designs.³ Varsity filed suit with competing uniform manufacturer Star on the grounds that Star infringed on five of its copyright protected designs.⁴

Varsity first filed suit alleging copyright infringement with the United States District Court for the Western District of Tennessee.⁵ The District Court entered summary judgment in favor of Star claiming that the designs were not protectable pictorial, graphic, or sculptural (PGS) works as defined under 17 U.S.C. § 102.⁶ Varsity appealed to the Court of Appeals for the Sixth Circuit.⁷ The Sixth Circuit reversed summary judgment in favor of Varsity, holding that the designs could be separated from the cheerleading uniform as two-dimensional works, and therefore the designs qualify as copyrightable material.⁸ Star appealed to the United States Supreme Court claiming that the features were not separable.⁹ The United States Supreme Court *held* that if a design can be perceived separately from a useful article and also exist independently as

1. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007-08 (2017).
2. *Id.* at 1007. The designs included “combinations, positionings, and arrangements of elements” as well as “chevrons . . . lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring and shapes.” *Id.*
3. *See* *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 474 (6th Cir. 2015).
4. *See Star*, 137 S. Ct. at 1007.
5. *Id.*
6. 17 U.S.C. § 102 (2012); *see Star*, 137 S. Ct. at 1007-08.
7. *Star*, 137 S. Ct. at 1008.
8. *Id.*
9. *Id.* at 1007.

a pictorial, graphic, or sculptural work then the design is eligible for copyright protection. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).

II. BACKGROUND

Congress enacted the Copyright Act to uphold its constitutional power of “promot[ing] the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings.”¹⁰ In copyright infringement claims, courts attempt to define the boundaries of the Copyright Act by interpreting the statute and understanding Congress’s goals in enacting it.¹¹ This interpretation has provided an efficient roadmap in resolving claims concerning designs incorporated within useful articles.¹² When addressing issues of this kind, a court will consider three things.¹³ First, a court will determine whether the owner has a valid copyright in the PGS work.¹⁴ The court will then determine whether the work is a feature of a useful article as well as the utilitarian aspects of that article.¹⁵ Finally, a court will apply a separability analysis to determine whether the PGS work can be physically and conceptually separated from the useful article.¹⁶

In order to have a valid copyright as a PGS work, the subject matter must be an “original work of authorship.”¹⁷ Once the court determines that a work is original, it will then analyze whether the original work is a PGS work, which “include[s] two-dimensional and three-dimensional works of fine, graphic and applied art.”¹⁸ Originality is measured by the level of creativity a designer or “author” has brought to a design or feature.¹⁹ There is a low standard for the amount of creativity required for a work to be considered original.²⁰ Essentially, the work must be independently created by an individual rather than copied or replicated

10. U.S. CONST. art. I, § 8, cl. 8; see Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541 (1976).

11. See *Mazer v. Stein*, 347 U.S. 201, 218 (1954).

12. See 17 U.S.C. § 102 (2012).

13. See *Feist Publ’n Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991); see also *Mazer*, 347 U.S. at 217-18.

14. See *Feist*, 499 U.S. at 345; see also *Mazer*, 347 U.S. at 217-18.

15. See 17 U.S.C. § 102; see *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 487 (6th Cir. 2015).

16. 17 U.S.C. § 102; see *Varsity*, 799 F.3d at 487.

17. 17 U.S.C. § 102; see *Feist*, 499 U.S. at 345.

18. 17 U.S.C. §§ 101, 102; see *Varsity*, 799 F.3d at 491.

19. See U.S. CONST. art. I, § 8, cl. 8; *Feist*, 499 U.S. at 345.

20. See, e.g., *Feist*, 499 U.S. at 345.

from another work.²¹ For example, the Fourth Circuit held that a designer who modified furniture to incorporate elements of historical furniture pieces had a successful copyright because the modified furniture designs demonstrated the designer's personal "take" on the historical pieces.²² In comparison, designs that replicate everyday images would not be considered a valid copyright because the designer merely copied the everyday image into the design rather than modified or reinvented it with personal expression.²³ Originality encourages industry competition and is essential to the growth of arts and sciences.²⁴

If the work is a valid copyright, the court will then determine whether that work is a feature of a useful article.²⁵ Only features of a useful article may be eligible for copyright protection, but not the useful article itself.²⁶ Therefore, a PGS work incorporated "into" a useful article qualifies for copyright protection if the PGS design "can be identified separately from, and [is] capable of existing independently of, the utilitarian aspects of the article."²⁷ When interpreting the "separate identification" requirement under § 101, courts first consider what the useful article is and then the useful article's utilitarian aspects.²⁸ A useful article is "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."²⁹ For example, in *Norris Industries, Inc. v. International Telephone & Telegraph Corp.*, the court addressed whether a wheel cover that simulated a wire wheel acted as a useful article or a feature of a useful article.³⁰ The court found that the wheel cover was not a feature of

21. *See, e.g., id.*

22. *See* *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 430-31 (4th Cir. 2010); *see also* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903) ("The copy is the personal reaction of an individual upon nature. Personality always contains something unique.").

23. *See* *Design Ideas, Ltd. v. Yankee Candle Co.*, 889 F. Supp. 2d 1119, 1123 (C.D. Ill. 2012) (holding that a glass sailboat light holder does not qualify as copyrightable material because it replicates a sail, which is considered everyday imagery); *see also* *Home Legend, L.L.C. v. Mannington Mills, Inc.*, 784 F.3d 1404, 1409-11 (11th Cir. 2015) (holding that laminate flooring that has been painted to look like Maple wood is protectable under the Copyright Act as an original design because, even though the artist attempted to replicate the texture of wood, he added his own personal design elements to the work).

24. *See* U.S. CONST. art. I, § 8, cl. 8.

25. *See* 17 U.S.C. § 101 (2012).

26. *Id.*

27. *Id.*; *see* *Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983).

28. 17 U.S.C. § 101; *see* *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 487 (6th Cir. 2015).

29. 17 U.S.C. § 101.

30. *See* *Norris*, 696 F.2d at 922.

a useful article but rather the useful article itself because it served a utilitarian function by providing protection to different elements of a wheel.³¹ The court held that because of the wheel cover's utilitarian aspects it did not qualify for copyright protection separate from the wheel.³²

While a useful article does not qualify for copyright protection, courts have found that a PGS work that is used as a useful article may qualify for protection.³³ For instance, in the case *Mazer v. Stein*, a copyright protected statuette was mass produced as a lamp base.³⁴ The issue was whether the statue was a work of art or whether it was a useful article because of the artist's intent to use the statue as a lamp base.³⁵ The petitioners argued that because the statue was being used as a lamp base it did not qualify for copyright protection as a work of art.³⁶ In response, the Court found that regardless of the intended use of the statue, it was not wired to be used as a lamp; therefore, the statuette acted as a decorative feature not a utilitarian feature of the lamp.³⁷ Courts have further addressed the distinction between a useful article and the features of a useful article by using the "separability analysis."³⁸

The separability analysis provides courts with the ability to properly address copyright issues concerning PGS works incorporated into useful articles.³⁹ Once a court has identified the useful article, it then determines whether the design can be physically and/or conceptually separated from the utilitarian aspects of the useful article.⁴⁰ Courts have struggled with finding a singular approach when applying the analysis; instead they apply hybrids of different separability approaches to "designs of a useful article" copyright issues, ultimately including elements of both physical and conceptual separation.⁴¹

Physical separability occurs when the PGS work is "physically separated from the article by ordinary means while leaving the utilitarian

31. *See id.*

32. *See id.*; 17 U.S.C. § 101.

33. *See Mazer v. Stein*, 347 U.S. 201, 218-19 (1954); *see also* *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2nd Cir. 1987).

34. *See Mazer*, 347 U.S. at 218-19.

35. *See generally id.*

36. *See id.* at 218.

37. *See id.* at 218-19; *see also Norris*, 696 F.2d at 922-23.

38. *See Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 481-82 (6th Cir. 2015); *see also Mazer*, 347 U.S. at 218-19.

39. *See* 17 U.S.C. § 101 (2012); *Varsity*, 799 F.3d at 481-82.

40. 17 U.S.C. § 101; *see Varsity*, 799 F.3d at 481.

41. 17 U.S.C. § 101; *see Varsity*, 799 F.3d at 484-87.

aspects of the article completely intact.”⁴² In *Home Legend, LLC v. Mannington Mills, Inc.*, the Eleventh Circuit applied the separability test to determine whether décor paper that covered laminate floors qualified for copyright protection independent from the floors.⁴³ The court found that the paper was a valid copyright because the designer could sell identical flooring with different paper on top of it; thus, the paper could be physically separated from the floor without affecting the floor’s overall use.⁴⁴ However, some courts have struggled with applying the physical separability test.⁴⁵ For example, in *Bonazoli v. R.S.V.P. International, Inc.*, the court applied the test to determine whether a heart-and-arrow shaped tip of a measuring spoon could be protected as a PGS work.⁴⁶ The court found that if the tip was physically separated from the spoon, the separation would remove the essential elements of the spoon.⁴⁷ Therefore, the court held that the heart-and-arrow shaped tip could not be protected as its own PGS work because the removal of the tip would not leave the spoon’s utilitarian aspects intact.⁴⁸

In comparison, conceptual separability occurs when one looks at a useful article and can clearly identify the PGS work.⁴⁹ One should be able to identify the work separately from the utilitarian aspects of the useful article.⁵⁰ A good example of applying the conceptual separability test is demonstrated in the case *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, in which the Second Circuit considered whether a sculpture that was used as a bicycle rack had copyright protection as a PGS work.⁵¹ The court attempted to conceptually separate the sculpture from the bicycle rack by analyzing what made the sculpture a PGS work.⁵² It found that the sculpture could not be protected as a separate PGS work because “the form of the rack [was] influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot

42. See *Varsity*, 799 F.3d at 482 (citation omitted).

43. See *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404, 1413 (11th Cir. 2015).

44. See *id.*

45. See generally *Bonazoli v. R.S.V.P. Int’l, Inc.*, 353 F. Supp. 2d 218, 218 (D. R.I. 2005).

46. *Id.*

47. *Id.*

48. See *id.*; *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 482 (6th Cir. 2015).

49. *Varsity*, 799 F.3d at 483-84.

50. 17 U.S.C. § 101 (2012); see also *Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010).

51. See *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2nd Cir. 1987).

52. *Id.*

be said to be conceptually separable from the utilitarian elements.”⁵³ In comparison, different design elements that adorn a piece of furniture can be clearly identified separate from a piece of furniture’s essential use.⁵⁴ For example, conceptually separating a carving or painting on a table from the table itself would not affect the table’s overall function as a hard surface.⁵⁵

Legislative history has demonstrated that there are multiple ways to apply the separability analysis to copyright issues regarding “designs of a useful article.”⁵⁶ Despite the multiple approaches to the separability question, courts have made it clear that not only must the useful article retain its utilitarian aspect, but the design or feature must also qualify as a copyrightable PGS work.⁵⁷ Additionally, because of the important distinction made in § 101, courts have found that there should be a singular approach to address these copyright issues.⁵⁸

III. THE COURT’S DECISION

In the noted case, the United States Supreme Court initiated a single interpretation and approach to addressing the separate identification requirement introduced in 17 U.S.C. § 101.⁵⁹ The Court relied on statutory interpretation of the Copyright Act to resolve any discrepancies.⁶⁰ The Court first found that the arrangement of lines and chevrons were considered PGS works under § 102 because they can be viewed as a two-dimensional works of art separate from a useful article.⁶¹ The Court then found that the design on the cheerleading uniform qualified “as a protectable pictorial, graphic, or sculptural work” because it could be “imagined separately from the useful article into which it [was] incorporated.”⁶² The Court found that it was not necessary for a court to determine whether the design in question is physically or conceptually separable from the useful article because the statute clearly

53. *Id.*

54. *See Universal Furniture*, 618 F.3d at 434.

55. *Id.*

56. 17 U.S.C. § 101; *see Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 484-85, 487 (6th Cir. 2015).

57. 17 U.S.C. § 101; *see generally Varsity*, 799 F.3d at 484-85, 487.

58. *See generally Mazer v. Stein*, 347 U.S. 201, 219-20 (1954) (Douglas, J., concurring).

59. 17 U.S.C. § 101; *see Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1006 (2017).

60. *Star*, 137 S. Ct. at 1010 (citing *Mazer*, 347 U.S. at 214).

61. 17 U.S.C. §§ 101, 102; *see Star*, 137 S. Ct. at 1007.

62. 17 U.S.C. § 101; *Star*, 137 S. Ct. at 1007.

states that the design just needs to be “perceived” as separate from the useful article.⁶³

The Court first found that the separability analysis is necessary in this case.⁶⁴ Under § 101 a design of a useful article includes both two- and three-dimensional designs.⁶⁵ However, the respondents attempted to persuade the Court that the separability analysis was not necessary because the term “designs” stated in § 101 only applied to three-dimensional designs rather than two-dimensional designs.⁶⁶ The Court rejected this argument by finding that the analysis did apply because the statutory language of § 101 does not imply that only three-dimensional designs of a useful article are protected but rather the “design of a useful article can include two-dimensional ‘pictorial’ and ‘graphic’ features” like the graphics on the uniforms.⁶⁷

Once the Court confirmed that the separability analysis was necessary, the Court then identified two requirements under § 101: the separate identification requirement and the independent-existence requirement.⁶⁸ The first requirement, separate identification, is satisfied when an individual can look at a useful article and identify features that have elements of a PGS work.⁶⁹ The second requirement, independent-existence, is satisfied when “the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article.”⁷⁰ The Court reasoned that “[i]f [a] feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.”⁷¹

The Court then addressed the purpose of § 101 and its relation to 17 U.S.C. § 113.⁷² Section 113 examines the exclusive rights of a PGS work.⁷³ Specifically, § 113(a) addresses “works of authorship first fixed in some tangible medium other than a useful article.”⁷⁴ The Court found that both § 101 and § 113(a) apply to PGS works “regardless of whether

63. 17 U.S.C. § 102; *Star*, 137 S. Ct. at 1002.

64. *See Star*, 137 S. Ct. at 1009.

65. 17 U.S.C. § 101; *Star*, 137 S. Ct. at 1009.

66. *See Star*, 137 S. Ct. at 1009.

67. 17 U.S.C. § 102; *Star*, 137 S. Ct. at 1010.

68. 17 U.S.C. § 102; *Star*, 137 S. Ct. at 1010.

69. *Star*, 137 S. Ct. at 1010.

70. *See id.*

71. *Id.*

72. *See Star*, 137 S. Ct. at 1010-11.

73. 17 U.S.C. § 113; *see also Star*, 137 S. Ct. at 1011.

74. *Star*, 137 S. Ct. at 1011; *see* 17 U.S.C. § 113(a).

they were created as freestanding art or as features of useful articles.”⁷⁵ In further analyzing this concept, the Court clarified that regardless of the intent of the design, the design qualifies for copyright protection because it can exist as an independent PGS work as well as when it is attached to a useful article.⁷⁶ The Court confirmed that a two-dimensional design incorporated into a useful article must be imagined separately from the useful article to accurately determine whether it can be protected.⁷⁷

The concurring opinion by Justice Ginsberg supported the judgment by the majority but not the opinion.⁷⁸ Ginsberg suggested distinguishing between *designs on* useful articles and *designs of* useful articles.⁷⁹ Her reasoning is based on the knowledge that Varsity applies its designs to clothing other than cheerleading uniforms; therefore, she argued that the separability analysis is not necessary in this case because the designs are already protected by copyrights, and Varsity is simply reproducing the designs on different articles of clothing.⁸⁰ Therefore, the arrangement of lines and chevrons are independent PGS works and should not be viewed as part of a useful article.⁸¹

In contrast, two justices disagreed with the majority opinion by claiming Varsity’s designs cannot be separated from the cheerleading uniforms.⁸² The dissent argued that a design of a useful article must be analyzed using two exercises “one physical and one mental.”⁸³ First, if the feature can be physically removed from the useful article and leave the article’s essential elements intact, then the feature can be copyrighted.⁸⁴ Here, the dissent claimed the designs cannot be physically separated from the cheerleading uniform because even if the designs were separated they would still retain the shape of the uniform.⁸⁵ The dissent also found that the designs cannot be conceptually separated from the uniforms because like physical separability, if the lines and chevrons

75. *See, e.g., Star*, 137 S. Ct. at 1011.

76. *Id.* at 1011 (citing *Mazer v. Stein*, 347 U.S. 201 (1954), in which the statuettes qualified as copyrightable material regardless of whether the owner intended for the statuettes to be used as a lamp or as a work of art).

77. *Id.* at 1012.

78. *Id.* at 1018.

79. *Id.*

80. *Id.*

81. *Id.*

82. *Id.* at 1030-31 (Breyer, J., dissenting) (“The designs cannot ‘be perceived as . . . two- or three-dimensional work[s] of art separate from the useful article.’” *Id.* at 1030 (quoting *id.* at 1007 (majority opinion))).

83. *Id.* at 1031.

84. *Id.*

85. *See id.* at 1032-33.

were imagined separate from the uniform, “[t]he designs [would] necessarily bring along the underlying utilitarian object.”⁸⁶

The dissent further compared the issue in this case to Congress’s overall approach to the fashion industry.⁸⁷ It found that Congress has not provided copyright protection to the fashion industry because doing so would inhibit creativity among designers and would be difficult to monitor.⁸⁸ However, despite the lack of copyright protection in the industry, the dissent argued that “designers have [still] contributed immeasurably to artistic and personal expression through clothing.”⁸⁹ In the noted case, the dissent used the fashion industry comparison to reiterate the idea that the “perception” test may resolve an immediate issue but it may prevent future growth in an industry, thereby, negatively subverting the goal of the Constitution.⁹⁰

IV. ANALYSIS

The Supreme Court’s holding in *Star Athletica* may create future issues that could weaken the constitutional foundation of the Copyright Act. The Act is meant to protect original, tangible designs so as to encourage competition and creativity.⁹¹ The Court’s holding could result in a large number of non-copyrightable registrations, create bias in future court decisions, as well as invalidate and question past rulings.

First, the Court’s ruling reintroduces personal opinions into the analysis of protectable work. In *Mazer*, the Court wanted to expand the meaning of “works of art” in the Copyright Act because it recognized that people have different interpretations of what is considered art.⁹² While the Act has changed and become more specific so as to prevent that bias, the Court’s ruling in *Star Athletica* may be considered as reintroducing bias with consideration to two-dimensional designs applied in a tangible medium of expression.⁹³ For example, the Court held that a person must imagine the two- or three-dimensional design as independent of the useful article;⁹⁴ however, the imagination involved in determining whether a two-dimensional design can exist as an independent pictorial, graphic, or sculptural work depends solely on what

86. *Id.* at 1033.

87. *Id.* at 1035.

88. *See id.*

89. *Id.*

90. *Id.* at 1036; *see also* U.S. CONST. art. I, § 8, cl. 8.

91. U.S. CONST. art. I, § 8, cl. 8.

92. *Mazer v. Stein*, 347 U.S. 201, 214 (1954).

93. 17 U.S.C. § 101 (2012).

94. *Star*, 137 S. Ct. at 1012.

an individual may interpret as a graphic or pictorial work of art.⁹⁵ Lines and shapes that have been placed on an alternative medium, like a desk, may not be viewed as a graphic work of art but rather scraps of fabric.⁹⁶

Additionally, the Court reiterates the holding in *Mazer*, in which the Supreme Court found that it is unnecessary to analyze the intent of a designer when considering whether an item qualifies for copyright protection.⁹⁷ Intent of an author is warranted in some cases because it provides courts with the understanding of how a certain design or feature can further promote competition in the arts and sciences.⁹⁸ In the noted case, the designers created the graphics specifically for uniforms and other articles of clothing; the designers were not producing designs for a painting, for example.⁹⁹ Their intent was for the designs and colors to represent a team or school.¹⁰⁰ Therefore, an intent analysis provides further support that a design may not be an independent pictorial, graphic, or sculptural work but rather a crucial component of a useful article.¹⁰¹

The Court's holding in the noted case may create further issues in the future. If lines and chevrons are considered copyrightable elements, then it could negatively affect the mass production of uniforms in general by creating a monopoly and stiling competition. Additionally, there is a lack of creativity and originality involved with rearranging lines and chevrons, because it is essentially just a reorganization of lines, shapes, and colors, which could be thought of by any reasonable person.¹⁰² Therefore, the Court's holding may not successfully resolve future claims of copyright infringement.¹⁰³

Kaitlin Chandler*

95. *Id.*

96. *See generally id.* at 1010.

97. *Id.* at 1014.

98. *See* U.S. CONST. art. I, § 8, cl. 8.

99. *See Star*, 137 S. Ct. at 1012.

100. *See* *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 475 (6th Cir. 2015).

101. *See generally id.*

102. *See Mazer v. Stein*, 347 U.S. 201, 214 (1954).

103. 17 U.S.C. § 101 (2012).

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