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**Conceptual Separability in *Star Athletica, L.L.C. v. Varsity Brands, Inc. et al:*
“Designs” of Useful Articles as (Non)Copyrightable Subject Matter?**

SUMMARY: 1. Introduction - 2. Law - 3. *Varsity* Facts and Procedural Posture - 4. Future Issues -
5. Conclusion

1. Introduction

On October 31, 2016 the United States Supreme Court heard oral argument in *Star Athletica, L.L.C. v. Varsity Brands Inc.*¹ (*Varsity*). Situated squarely within the U.S. intellectual property law of copyright, the core issue at the center of the case is: what is a cheerleading uniform?²

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Figure 1 Designs of Varsity Cheerleading Uniforms Registered with the Copyright Office and at issue in the case

Depending on how the Court answers this question, certain parts of cheerleading uniforms which Varsity Brands, Inc. (“Varsity”) designed and registered with the U.S. Copyright Office may or may not be protected by copyright, and therefore other brands, such as Star Athletica (“Star”), may be allowed to or prohibited from making substantially similar cheerleading uniforms. While at first glance the case might seem surreal to some, it addresses extremely important issues for those in the fashion industry and professionals and scholars active in this area of intellectual property law.

¹ For a timeline of the case and relevant documents filed for its Supreme Court appeal see *Star Athletica, LLC. v. Varsity Brands, Inc.*, SCOTUSBlog: Supreme Court of the United States Blog, <http://www.scotusblog.com/case-files/cases/star-athletica-llc-v-varsity-brands-inc/> (last accessed December 4, 2016). Oral argument can be heard at *Oral Argument, Varsity v. Star Athletica*, Docket No. 15-866, October 31, 2016, https://www.supremecourt.gov/oral_arguments/audio/2016/15-866. The case is generally referred to as *Varsity* in the rest of the paper, with a description in the text as to whether the case is at the District, Appeals, or Supreme Court.

² For a characterization of the issue as such see the Sixth Circuit Court of Appeals decision in the case, *Varsity Brands et al v. Star Athletica*, No. 14-527, slip. op at 2 (6th Cir., August 19, 2015) (majority opinion, “Are cheerleading uniforms truly cheerleading uniforms without the stripes, chevrons, zigzags and color blocks?”). This seems to be a narrower characterization of the issue than that crafted at the Supreme Court level, where the issue was framed as the “appropriate test to determine when a feature of a useful article is protectable under §101 of the Copyright Act.” See Brief for Petition for a Writ of Certiorari at i, *Star Athletica, L.L.C. v. Varsity Brands, Inc. et al*, No. 15-866 (2016).

First, the law regulating conceptual separability in copyright, or the test by which the design of a useful object may be considered a copyrightable pictorial, graphic or sculptural work, has circa ten tests depending on the circuit or even on the judge: clarification is much needed on this issue.³ Second, deciding how courts will understand the function of cheerleading uniforms will potentially clarify legal categorization of Fashion designs⁴ in general, communicating a preference for whether Fashion designs should be protected by the patent regime or copyright.⁵

³ As Judge McKeague made clear in his dissent to the Sixth Circuit's majority opinion in the *Varsity* case, "It is apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design. The law in this area is a mess—and it has been for a long time." *Varsity*, slip op. at 36.

⁴ It is important to note at this juncture that by using the term "Fashion designs" the author does not mean the shape or cut of items of ladies' dress, i.e. garment design, which courts, Congress, and the parties to the case have clearly agreed is not copyrightable subject matter. See *Varsity*, slip op. at 29; Brief for the United States as Amicus Curiae supporting Respondents at 35, *Star Athletica, L.L.C. v. Varsity Brands, Inc. et al*, No. 15-866 (2016); Transcript of Oral Argument at 47, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016). Rather, Fashion design is used in this paper to broadly mean not garment design, but decorative appliques, fabric decoration and others elements of a Fashion object other than the shape and cut of a garment that may potentially be copyrightable as a pictorial, graphic or sculptural work. Obviously, certain designs of useful objects with which courts have previously dealt do not easily map on to Fashion items (for example, the Seventh Circuit's description of a copyrightable "hungry look" of a mannequin). In trying to reconcile previous case precedent with the *Varsity* case, the author understands that garment design itself is not copyrightable and does not proceed to argue that it is.

⁵ Copyright has long been seen as economically driven. While the exclusive rights granted through copyright can last for up to a century or more, design patents only give their owners fifteen years in which to exclusively create and license their design. See 35 U.S.C. §173. While rewarding inventors, design patents still allows competitors to compete fairly quickly on the marketplace. In the Fashion industry, however, design patents are seen both as costly and as too hard to obtain in time for adequate protection, given the lengthy review process which is at odds with the Fashion season and cycle. See Susan Scafidi, *Intellectual Property and Fashion Design*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 115, 122 (Peter K. Yu ed., Praeger Publishers 2007). The desire to not extend copyright to items of Fashion has been grounded in the reasoning that since Fashion items are at heart utilitarian, they belong in the patent regime, and are better protected through design patent. See Brief Amicus Curiae on Behalf of Intellectual Property Professors in Support of Petitioner at 15, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016) ("the union of form and function can readily be protected through the law of design patent, as Congress intended.") See however, Mark P. McKenna and Katherine J. Strandburg, *Progress and Competition in Design*, 17 STANFORD TECHNOLOGY L. REV. 1 (noting "Aesthetics and utility intersect at the integration of form and function and that, we argue, is

In its final decision, which is expected mid-term,⁶ the Supreme Court will seemingly choose between two characterizations of cheerleading uniforms: the District Court's reasoning that cheerleading uniforms function as communicators of identity in their entirety, that almost no part of them can therefore be conceptually separable from their function, definitively characterizing a Fashion design as a non-copyrightable useful article; and the Sixth Circuit Court of Appeals' reasoning that the design of a cheerleading uniform's chevrons, zig zags, and stripes may indeed be conceptually separated from a cheerleading uniform's narrow utilitarian purpose of "cover[ing] the body, wick[ing] away moisture, and withstand[ing] the rigors of athletic movement"⁷ and therefore be a copyrightable pictorial, graphic or sculptural work. While the Court's reasoning and decision will be of primary importance for fashion designers and commercial manufacturers of clothes seeking to protect their products in the marketplace, it also, as a tangential matter, may potentially be of support for other actors in the Fashion industry, namely those who seek not to sell, but to archive, preserve, and historically present exemplary Fashion designs. As one of the amicus briefs implied, some items of Fashion arguably serve no purpose but to convey information or portray appearance⁸: if the Supreme Court, however, insists on characterizing Fashion designs as useful articles by seeing every function they serve as part of a broader utility, then Fashion designs, no matter where or how they are displayed or how they may be perceived, may definitively be considered subject matter that is ineligible for copyright protection under the current statutory framework.

where design patents must be justified, if they can be justified at all"; seeming to hinge design patent's ability to properly address the marriage of form and function on a proper definition of nonobviousness).

⁶ For this prediction see W. Edward Ramage, *Supreme Court argues copyrighting cheerleader uniforms*, LEXOLOGY, November 16, 2016, <http://www.lexology.com/library/detail.aspx?g=19aec52d-20f9-406c-bb6b-1e422e53e43a>. The Supreme Court's term runs from the first Monday in October until June/July, and therefore this prediction likely means that the Court will render an opinion in January of 2017. For a description of the Supreme Court and its procedures see *The Court and its Procedures*, SUPREME COURT OF THE UNITED STATES, <https://www.supremecourt.gov/about/procedures.aspx>.

⁷ *Varsity*, slip op. at 25.

⁸ Brief of Fashion Law Institute et al as Amici Curiae in Support of Respondents at 32-33, *Star Athletica L.L.C. v. Varsity Brands, Inc.*, et al, Docket No. 15-866 (2016).

The purpose of this paper is to present the *Varsity* case within the context of its changing perception of the function of Fashion, the case's core issue. Depending upon how the utilitarian function of a cheerleading uniform is understood in this particular case, Fashion design overall is more or less likely to be understood as conceptually separable and therefore as copyrightable subject matter. If Fashion design through the lens of the *Varsity* case is conceptually separable, then Fashion design might more easily be understood as a repository of historically relevant and culturally significant information while also, however, providing a springboard for a Fashion design monopoly. On the other hand, if Fashion design through the lens of the *Varsity* case is deemed an inextricable part of a useful article and not conceptually separable, it will cease to be a potential tool for a monopoly in Fashion design, but its ability to be legally conceived as works on par with more traditional pictorial, graphic and sculptural works will be compromised. In this sense, there seems to be an explicit relationship between imaginary and practicality: an imaginative view of Fashion may lead to an effect grant of monopolies on the market.

Section 2 summarizes the legal framework of conceptual separability as it now stands. Section 3 gives the facts and procedural posture of the *Varsity* case, spotlighting the parties' arguments that are most relevant to the paper's purpose. Section 4 hypothesizes as to future issues that might be tangential results of the Supreme Court's decision, including what result for other Fashion designs that are, like *Varsity*'s designs, both applied to the garment and indelibly linked to the garment's design and potential utilitarian functions. At stake in the *Varsity* litigation are two fundamental questions: how the U.S. copyright regime protects certain creative expressions while allowing for innovation, and what type of trust to put in judges' powers of perception. A presentation of the *Varsity* case and its core issue will both shed light on how the Supreme Court might choose to answer these fundamental questions and the future copyrightability of other Fashion designs.

2. Law

In the United States, the government's authority to legislate copyright is embodied in Article 1, Section 8, clause 8 of the U.S. Constitution,⁹ and the law of copyright is codified by statute.¹⁰ Copyright protection is extended to "original works of authorship fixed in any tangible medium of expression."¹¹ Copyright protection for works made on or after January 1, 1978 by a single author lasts for the life of that author plus seventy years.¹² While U.S. copyright requires originality, fixation, and expression (which enjoy their own legal nuances and some of which have at times been acknowledged by the parties to the *Varsity* case as relevant to their own arguments¹³), it also names categories of works of authorship.¹⁴ Pictorial, graphic and sculptural works are one of the specific categories of works of authorship enumerated by the statute as

⁹ The so-called Intellectual Property clause: "The Congress shall have Power... To promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right for their respective Writings and Discoveries." U.S. Constitution Art I, Section 8, Clause 8.

¹⁰ See generally 17 U.S.C. §101 et seq.

¹¹ 17 U.S.C. §102.

¹² For more details of terms and term limits, as well as nuances and changing term limits depending on the type of author see *Duration of Copyright*, Copyright Circular, <https://www.copyright.gov/circs/circ15a.pdf>, at 1 ("The law automatically protects a work that is created and fixed in a tangible medium of expression on or after January 1, 1978, from the moment of its creation and gives it a term lasting for the author's life plus an additional 70 years. For a 'joint work prepared by two or more authors who did not work for hire,' the term lasts for 70 years after the last surviving author's death. For works made for hire and anonymous and pseudonymous works, the duration of copyright is 95 years from first publication or 120 years from creation, whichever is shorter (unless the author's identity is later revealed in Copyright Office records, in which case the term becomes the author's life plus 70 years). For more information about works made for hire, see Circular 9, Works Made for Hire under the 1976 Copyright Act. For details about pseudonymous works, see fl 101, Pseudonyms.") The length of *Varsity's* copyright would fall into the work for hire category, hence *Star's* argument that *Varsity* would effectively be given a hundred year long copyright. Transcript of Oral Argument at 62, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016).

¹³ As mentioned by the government both at oral argument and in their brief, *Varsity's* designs might still not fulfill the necessary spark of creativity or the merger doctrine, according to which copyright is not extended to an expression when only one or a limited number of ways exist to express the idea behind the expression: the idea and expression therefore are said to merge into a non-copyrightable whole. The case *Baker v. Selden* is usually cited for the merger doctrine. See *Baker v. Selden*, 101 U.S. 99 (1879).

¹⁴ 17 U.S.C. §102.

eligible for copyright.¹⁵ While these categories should be “viewed broadly”¹⁶, there are rules that do act as gatekeepers to inclusion in a category. Indeed, the statute itself draws specific boundaries around the category in its definition of pictorial, graphic, and sculptural works:

Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work **only if, and only to the extent that**, such 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.¹⁷

Useful articles are not eligible for copyright protection.¹⁸ They are defined as:

*“article[s] having an intrinsic utilitarian function that is **not merely** to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article’.”*¹⁹

This “boundary” between useful articles and pictorial, graphic and sculptural works is understood as the separability requirement.

¹⁵ 17 U.S.C. §101’s full definition of pictorial, graphic and sculptural works is “two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such 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.” *Id.*

¹⁶ Basics of Copyright, Copyright Circular, <http://www.copyright.gov/circs/circ01.pdf>, at 3 (“These categories should be viewed broadly. For example, computer programs and most “compilations” may be registered as “literary works”; maps and architectural plans may be registered as “pictorial, graphic, and sculptural works.”)

¹⁷ 17 U.S.C. §101.

¹⁸ *Id.*

¹⁹ *Id.*

While separability is found in the statute, case law has framed the inquiries for its determination. When a plaintiff brings an infringement suit, they need to prove ownership of a valid copyright before proving that the infringer copied and that the infringing work is substantially similar to the copyrighted one.²⁰ As a result, courts often address questions of validity within the context of an infringement suit.²¹ There are two types of separability: physical and conceptual. Physical separability occurs when the court asks if the decorative parts of an object can be actually, physically separated from the useful object: as one court put it, using Professor Nimmer's example, the jaguar on top of the aptly-named Jaguar car is still a decorative jaguar sculpture whether it is on the car or not.²² Conceptual separability, on the other hand, has been defined through numerous crafted standards as it has evolved over time; it has, therefore, been the subject of great ideological and practical legal debate. It is conceptual separability with which the *Varsity* case is concerned.

The primary challenge of conceptual separability lies in the need for courts to determine if and how separation is to occur when the design of a useful article and the intrinsic utilitarian purpose of the useful article are so fused as to be almost one. How, in such a case, is a court to

²⁰ GRAEME B. DINWOODIE AND MARK D. JANIS, *Trade Dress and Design Law* 465 (Aspen Publishers 2010).

²¹ See for example *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (1980) (where Pearl copied sculptural belt buckles made by Barry Kieselstein-Cord and the court addresses the copyrightability of the belt buckles within that context). While the Copyright Registrar does issue important opinions regarding the copyrightability of works, copyright does not have a review process like its counterpart regime – patent. As a result, many investigations into whether a useful work deserves copyright protection happen in court, if the plaintiff has the means to sue.

²² "What must be carefully considered is the meaning and application of the principle of 'conceptual separability.' Initially, it may be helpful to make the obvious point that this principle must mean something other than 'physical separability.' That latter principle is illustrated by the numerous familiar examples of useful objects ornamented by a drawing, a carving, a sculpted figure, or any other decorative embellishment that could physically appear apart from the useful article. Professor Nimmer offers the example of the sculptured jaguar that adorns the hood of and provides the name for the well-known British automobile...With all of the utilitarian elements of the automobile physically removed, the concept, indeed the embodiment, of the artistic creation of the jaguar would remain." *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 420-21 (2d Cir. 1985).

separately identify the pictorial, graphic or sculptural parts that can indeed exist independently of the article's utilitarian aspects? Think, for example of an Alessi orange juicer, a Magritte-esque mannequin, a Tom Ford clutch, a Christian Louboutin lipstick necklace, Marcel DuChamp's Fountain, and a recent Untitled work for sale by Maurizio Cattelan (b. 1960) [Figure 2].

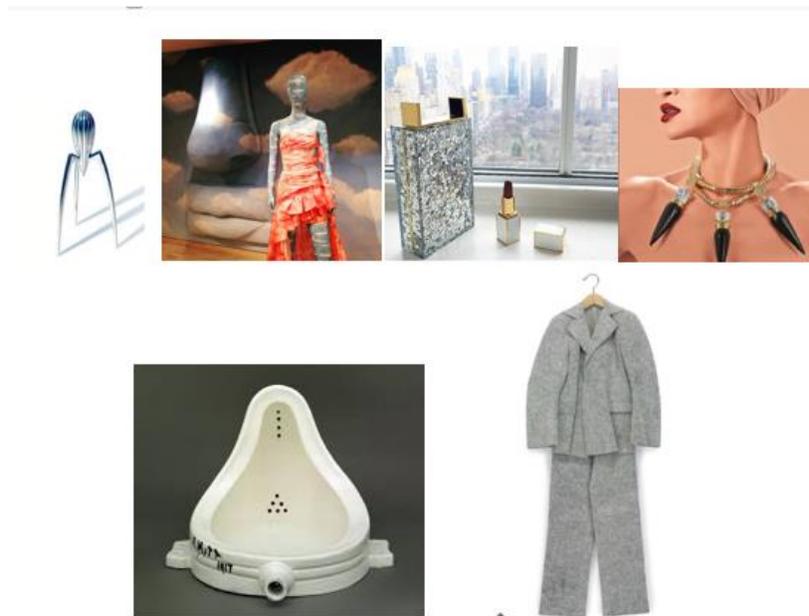


Figure 2

Each of these objects has a utilitarian function, but they also have non-functional facets.²³ Should certain aspects of these works be protected by copyright as pictorial, graphic or sculptural works? A long tradition in U.S. copyright case law negates the use of aesthetic judgment in copyright decisions: in the U.S. Supreme Court decision *Bleistein v. Donaldson*

²³ The Alessi orange juicer has ridges and legs that are shaped like a spider or an alien, but these ridges also serve the purpose of juicing an orange. The Magritte-esque mannequin is shaped to display clothing, but its sky skin may not be necessary to the display of clothing. Both the lipstick container and the purse serve a function, but put them together and you may not realize what they are at all- perhaps just a glittery sculpture? The Louboutin necklace simply adorns and yet it also functions as a lipstick holder. DuChamp's urinal is in fact not functioning as a urinal at all, no matter its appearance, much as Cattelan's suit- both are works of modern and contemporary art, respectively.

Lithographing Co., the Court observed, while holding circus posters used for advertising to be pictorial illustrations worthy of copyright protection, that

[i]t [is] a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations...it would be bold to say that [pictures with a commercial value] have not an aesthetic value.²⁴

And U.S. courts do indeed shy away from deciding whether or not an item has aesthetic value; the tests that they have crafted to determine conceptual separability do, however, at times display similarities with certain aesthetic theories.²⁵

Ten different tests to determine conceptual separability have evolved both in different circuits and even, in certain cases, thanks to a particular judge. The Sixth Circuit, in its *Varsity* opinion, concisely summarized them²⁶, and then added its own:

²⁴ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) (holding a circus poster worthy of copyright protection).

²⁵ This has been noted by Alfred Yen, who has written "...the distinction between aesthetic reasoning and legal reasoning is illusory. To be sure, copyright opinions do not openly adopt specific aesthetic perspectives to justify case outcomes...Nevertheless, the analytical premises of copyright opinions are practically identical to those of major aesthetic theories." Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247, 251 (1998). While Yen's understanding of aesthetics to make this pronouncement is broad- an aesthetic judgment can range from whether a work is art, to a work's artistic value, to concepts of authorship- he notes that this broad definition evolves the question of the relationship between copyright and aesthetics into "not whether aesthetics should affect copyright, but how." *Id.* at n. 14 (citing also to a number of other scholarly articles on the concept of romantic authorship in copyright). Yen identifies certain key copyright separability cases with aesthetic theories: *Mazer v. Stein* (holding statuettes that were lamp bases could be copyrightable despite their utilitarian function) with formalism since the court emphasized the "instant recognizability" of the statuettes as a copyrightable object through its form. *Id.* at 282; *Kieselstein-Cord v. Accessories by Pearl* (applying the conceptual separability doctrine to hold belt buckles were copyrightable) with intentionalism and institutionalism since the court cited to the artist's use of other art objects for inspiration and the inclusion of the belt buckles in the collection of the Metropolitan Museum of Art, *Id.* at 283; *Brandir International, Inc. v. Cascade Pacific Lumber Co.* (holding a minimalist bike rack originally conceived by the artist as a wire sculpture was not copyrightable) with a new legal intentionalist aesthetic test "studying the extent to which nonaesthetic, utilitarian concerns governed the creator's choice of features", *Id.* at 283.

²⁶ The following summaries and quotes are from *Varsity*, slip op., at 17-19. It is important to note at this stage that not all of these tests are part of binding legal precedent. The tests raised in the dissent are, for example, only persuasive and generally do not hold great weight. All these tests are, however, to one

- The Copyright office asks if “the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works”
- In *Kieselstein-Cord*, the Second Circuit held belt buckles copyrightable by reasoning that the buckles’ “primary ornamental aspect” was “conceptually separable from their subsidiary utilitarian function”²⁷; the court also mentioned the buckle’s inclusion in the collection of the Metropolitan Museum of Art, the designer’s inspiration from art nouveau, and the fact that some consumers wore the buckle as jewelry.
- In another case, *Carol Barnhart*, the Second Circuit emphasized necessity, holding mannequins with hollowed out rears made to display clothes were not copyrightable because such a shape was necessary for the performance of their utilitarian function, unlike the belt buckles in *Kieselstein* whose “unique artistic design” was unnecessary for performance of the utilitarian function of a belt buckle²⁸
- However, in the same case, Judge Newman’s dissent argued for an application of a test that would ask whether “[the useful] article...stimulate[s] in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function”; that is, a design of a useful article would be conceptually separable and therefore copyrightable subject matter “whenever the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously”²⁹, and to concretize his test Judge Newman gave the example of an “artistically designed chair displayed in a museum”³⁰
- Professor Denicola’s test requiring an examination of the process of the designer was embraced by the Second Circuit in a third case, *Brandir*, where the design of a RIBBON Rack bicycle was found uncopyrightable since its designer, although adapting the rack from a

extent or another cited to in court opinions that address issues of conceptual separability and they are all also mentioned in the Sixth Circuit opinion in *Varsity*.

²⁷ *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d at 994.

²⁸ *Carol Barnhart*, 773 F.2d at 419.

²⁹ *Carol Barnhart*, 773 F.2d at 422-423.

³⁰ *Id.*

minimalist sculpture, had adapted “the original aesthetic elements to further a utilitarian purpose”³¹; the same test was also embraced by the majority in the Seventh Circuit in *Pivot* when it found a mannequin head that displayed a “hungry look” copyrightable since the mannequin “was the product of a creative process unfettered by functional concerns”³²

- In the same *Pivot* case, however, Judge Kanne in his dissent called for the same mannequin to *not* be considered copyrightable because its aesthetic functions could not be separated from its utilitarian function as a teaching aid to beauty students, characterizing the “hungry look” not as a separable feature, but as an aspect of the mannequin’s utility³³

- In *Galiano*, the Fifth Circuit, using a likelihood-of-marketability test, held designs of casino uniforms were not copyrightable because they could not be marketed only for their aesthetic qualities, but were, rather, only marketable because of their function as casino uniforms³⁴; the Fifth Circuit specified this test was only for garment design; the court seemed to suggest that certain designs in costume museums might potentially meet their test and be copyrightable³⁵

- The Patry Test, as described by the Sixth Circuit in its *Varsity* opinion, would find pictorial, graphic or sculptural features of a useful article copyrightable if these features were

³¹ *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987).

³² *Pivot Point Int’l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 932 (7th Cir. 2004).

³³ *Pivot Point*, 372 F.3d 913 at 934. (“To be copyrightable, the statute requires that the useful article’s functionality remain intact once the copyrightable material is separated. In other words, Pivot Point needs to show that Mara’s face is not a utilitarian “aspect” of the product “Mara,” but rather a separate non-utilitarian “feature.” The majority, by looking only to whether the features could also “be conceptualized as existing independently of their utilitarian function” and ignoring the more important question of whether the features themselves are utilitarian aspects of the useful article, mistakenly presupposes that utilitarian aspects of a useful article can be copyrighted. If we took away Mara’s facial features, her functionality would be greatly diminished or eliminated, thus proving that her features cannot be copyrighted.”)

³⁴ *Galiano v. Harrah’s Operating Company*, 416 F.3d 411, 421- 422 (5th Cir., 2005).

³⁵ *Galiano*, 416 F.3d at 422. (“Gianna correctly notes that there are costume museums and that they are replete with extravagant designs that might also have utilitarian qualities, but Gianna does not demonstrate that its designs describe such material. We therefore affirm the denial of summary judgment.”)

separable from the utilitarian aspects of the useful article and if “aesthetics dictates the way that the pictorial, graphic, or sculptural features appear”³⁶, not form or function

- An approach which considers both the extent to which a designer’s process is dictated by aesthetics and the extent to which the design of the item itself is dictated by function³⁷

- In *Varsity*, the Sixth Circuit crafted a five-part test for conceptual separability asking

1. whether the design is a pictorial, graphic, or sculptural work

2. if it is, then whether the design is a design of a useful article (“an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”)

3. if the design is such, then the court should identify the utilitarian aspects of the useful article at issue (which do not include portraying the appearance of the useful article or conveying information), and only then ask

4. whether a viewer of the design could identify pictorial, graphic or sculptural features separately from these utilitarian aspects and finally,

5. whether the pictorial, graphic or sculptural features of the design of the useful article can exist independently of these utilitarian aspects (with reference to the Copyright Office’s test, the design process approach, and the objectively necessary approach)³⁸

Adding other spokes to this already intricate and complicated wheel, certain intellectual property professors have proposed in their amicus briefs to the Supreme Court another test, following legislative history:

- that conceptual separability be understood as only a coda to actual physical separability, and therefore that the court only ask first, whether “the claimed feature of the useful article [can] be extracted from the article, even if doing so would destroy the article” and second, if once extracted the claimed feature of the useful article would stand alone “as an original

³⁶ *Varsity*, slip op., at 19.

³⁷ *Id.*

³⁸ *Id.* at 23-24.

pictorial, graphic, and sculptural work that is not a useful article”³⁹; this test sees only applied art as copyrightable and purports to simplify the issue, relegating industrial design to the patent regime⁴⁰

Other intellectual property professors have proposed understanding the utilitarian functions of garments as useful articles to include making the wearer more attractive.⁴¹

As is immediately apparent, legally understanding and defining conceptual separability- both in general and in the particular case of fashion design- is a contested issue with little to no consensus; small wonder the Supreme Court granted certiorari in the *Varsity* case. Adding to the complexity are the specific applications of these tests that have been made to specific facts, leading to results which are by no means similar. In *Hart*, the Second Circuit found fish mannequins for taxidermy copyrightable – contrasting the case with *Barnhart* where the mannequins were but “glorified coat hangers.”⁴² Judge Calabresi, writing for the majority, found fish mannequins to be sculptural works in and of themselves because their function was to portray the appearance of the fish (“[t]he function of the fish form is to portray its own appearance, and that fact is enough to bring it within the scope of the Copyright Act”).⁴³ In *Jovani*, the Second Circuit found certain design elements of prom dresses to not be copyrightable, reasoning that sequins and tulle that were applied by the designer with the prom dress’ function, to clothe for a special occasion, in mind did not invoke a concept separate from a special occasion dress.⁴⁴ In contrast, the Second Circuit in *Chosun*, with Judge Calabresi again

³⁹ Brief Amicus Curiae on Behalf of Intellectual Property Professors in Support of Petitioner, *Star Athletica LLC v. Varsity Brands, Inc.*, et al, Docket No. 15-866 (2016) at 2-3.

⁴⁰ Brief Amicus Curiae on Behalf of Intellectual Property Professors in Support of Petitioner at 15, *Star Athletica LLC v. Varsity Brands, Inc.*, et al, Docket No. 15-866 (2016) (“the union of form and function can readily be protected through the law of design patent, as Congress intended.”)

⁴¹ See generally Brief of Professors Buccafusco and Jeanne Fromer as *Amici Curiae* in support of Petitioner, *Star Athletica, L.L.C. v. Varsity Brands, Inc.* et al, No. 15-866 (2016).

⁴² *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 323 (2d Cir. 1996).

⁴³ *Id.*

⁴⁴ Seemingly a combination of both Professor Denicola and Judge Newman’s test. *Jovani Fashion, Limited v. Fiesta Fashions*, 500 Fed.Appx. 42, 44- 45 (2nd Cir., 2012).

writing for the majority and applying the test laid out in *Brandir*, noted that heads of Halloween costumes might invoke a concept separate from the function of clothing and therefore be conceptually separable and copyrightable.⁴⁵

Of course, central to all these conceptual separability tests is the definition of the utilitarian aspects of the useful article (whether fish mannequin, uniform, prom dress, belt buckle, mannequin, costume, or uniform). Logically, a court's likelihood of identifying the design of a useful article as conceptually separable and therefore copyrightable depends on how it defines a useful article's intrinsic function and utilitarian aspects. Which brings us to the arguments in the *Varsity* case.

3. *Facts and Procedural Posture*

Varsity Brands, Inc. ("Varsity") is a corporation which "designs, manufactures, and sells apparel and accessories for use in cheerleading."⁴⁶ In 2007 and 2008 Varsity registered a number of its cheerleading designs with the Copyright Office [Figure 1].⁴⁷ The designs were classified as "two-dimensional artwork."⁴⁸ Star Athletica, L.L.C. ("Star") says the Copyright Office "initially

⁴⁵ *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 330 (2d Cir. 2005) ("That is, *Chosun* may be able to show that [face masks] invoke in the viewer a concept separate from that of the costume's 'clothing' function, and that their addition to the costume was not motivated by a desire to enhance the costume's functionality *qua* clothing.")

⁴⁶ *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, No. 10-2508, 2014 WL 819422 at *1 (W.D. Tenn. 2014).

⁴⁷ For a full list of the designs registered by Varsity see Copyright Office Search Results, COPYRIGHT OFFICE, <http://cocatalog.loc.gov> (Search "Varsity"). For images of the specific designs at issue in the case see *Varsity*, slip op., at 4-5. See also Figure 1 on p. 1 of this paper. On a substantive note, copyright exists in works as soon as the work is created but registration gives a copyright owner certain rights, including the right to sue.

⁴⁸ Compare *Varsity*, 2014 WL 819422, at *2 ("Varsity registered five cheerleading uniform designs with the Copyright Office for the following Varsity design numbers: 074, 078, 0815, 299A, and 299B. (Pg. ID # 2230-31.) For three of these designs (074, 078, and 0815), Varsity submitted a sketch of the uniform as deposit material and the nature of the work and authorship is listed as "2-dimensional artwork." For the remaining two uniforms (299A and 299B), Varsity submitted a photograph of a completed uniform incorporating the design as deposit material, the nature of the work is listed as "fabric design (artwork)"

rejected many of Varsity's cheerleading-uniform designs"⁴⁹, reasoning that Varsity's designs were not copyrightable because they were useful articles of clothing in the face of Varsity's insistence that it only wanted to copyright the designs on the cheerleading uniform itself, "stripes, chevrons, and color blocks"⁵⁰; Varsity, however, insists that the Copyright Office's initial rejections had nothing to do with their designs' functionality.⁵¹ In any event, the Copyright Office ultimately registered Varsity's designs, concluding that they were copyrightable.⁵² Although some facts point to Varsity's perception that its copyright was in the entire design of its cheerleading uniform⁵³, Varsity has insisted in its' respondent's brief to the Supreme Court that it only claims copyright in its two-dimensional designs of chevrons, stripes, zig zags and color blocks, as they are applied to the cheerleading uniform, not in the whole design of the cheerleading uniform itself.⁵⁴ In describing the creative process by which its

and the nature of authorship is listed as "2-dimensional artwork." (Pg. ID # 2231-36.)" with *Varsity*, slip op., at 3 ("Varsity sought and received copyright registration for "two-dimensional artwork" for many of its designs, including the following designs, which are the subject of this lawsuit.").

⁴⁹ Petition for Certiorari at 15, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016).

⁵⁰ *Id.*

⁵¹ Brief for the Respondents in Opposition at 7, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016) (arguing these initial qualms had to do with originality). This paper deals with originality only in passing, concentrating more on what is possibly copyrightable subject matter. Originality does, of course act as a possible bar to copyrightability for expressions that are so like facts that they do not have the requisite creative spark. See Transcript of Oral Argument at 38, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016).

⁵² *Varsity*, slip op., at 12-13 ("the Copyright Office consistently found the arrangements of stripes, chevrons, and color-blocking to be original and separable from the utilitarian aspects of the articles on which they appear, and therefore copyrightable.")

⁵³ Brief for the Petitioner at 17, *Star Athletica, L.L.C. v. Varsity Brands, Inc. et al*, No. 15-866 (2016).

⁵⁴ As noted in n. 5 *supra* no copyright has been recognized for garment design. Brief for the Respondents in Opposition at 8 n. 4, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016). See also of interest Brief Amicus Curiae on Behalf of Intellectual Property Professors in Support of Petitioner at 15, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016), which seems to insist that Varsity is claiming copyright in the arrangement of individual chevrons, etc because individually these design elements do not satisfy the spark of creativity ("The claimant here could, using an analogy to fabric prints, claim only the chevrons and not the coordination and arrangement thereof, which constitute the cut of the garment. But that is not what the claimant asserts, likely because the chevrons themselves are standard uniform elements that lack the minimal spark necessary for copyrightability. Cf. Design

designs come into existence, Varsity has made much of the fact that its designers are not constrained by functional concerns, that its designs are applied to the fabric of the actual dress in various ways, and that individual customers may also create their own individual design by selecting from Varsity’s proffered options.⁵⁵ In 2010 Star, another company that “markets and sells uniforms and accessories for football, baseball, basketball, lacrosse, and cheerleading”⁵⁶, presented cheerleading uniforms for sale in its catalog which Varsity thought were substantially similar to Varsity’s copyrighted designs, and therefore infringing.⁵⁷ Varsity sued Star for copyright infringement, among other claims.⁵⁸

Deciding the case on summary judgment⁵⁹, the District Court held, when addressing the first element needed to establish copyright infringement, that Varsity’s copyrights were not valid⁶⁰: the District Court’s main reason was that “colors-and-designs component of a

cheerleading uniform cannot be conceptually separated from the utilitarian object itself. Copyright protection, as a matter of law, cannot apply.”⁶¹ As part of its reasoning, the District Court made a point of highlighting the many different tests in different jurisdictions for

Ideas, Ltd. v. Yankee Candle Co., Inc., 889 F. Supp. 2d 1119 (C.D. Ill. 2012) (finding that candle holders in the generalized shape of sailboats were probably not separable, but definitely not creative enough for copyright protection).” Brief Amicus Curiae on Behalf of Intellectual Property Professors in Support of Petitioner, at 17. Varsity’s insistence that they claim only the arrangement is also contrary to Star’s characterization of Varsity’s previous position.

⁵⁵ See Brief for the Respondents in Opposition at 6, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016).

⁵⁶ *Varsity*, slip op., at 5. The District Court opinion described Star as “a marketer and designer of various sports apparel.” *Varsity*, 2014 WL 819422, at *1.

⁵⁷ For a description of a suit of infringement see *Varsity*, 2014 WL 819422, at *1.

⁵⁸ *Varsity*, 2014 WL 819422, at *1; *Varsity*, slip op., at 6.

⁵⁹ For the elements of summary judgment see *Varsity*, 2014 WL 819422, at *2.

⁶⁰ One of the elements of copyright infringement. *Id.* at *2 (“In order to establish copyright infringement, two elements must be proven: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.” *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 361, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991) . Determining whether an item is subject to copyright protection is question of law for the court to decide. See *Tastefully Simple, Inc. v. Two Sisters Gourmet, L.L.C.*, 134 F. App'x 1, 4 (6th Cir. 2005).”)

⁶¹ *Id.* at *1.

conceptual separability.⁶² The court placed particular emphasis, however, on the definition of utility within the specific context of the cheerleading uniform: indeed it characterized the endeavor as separating an object from an ideal and discovering its thing-ness.⁶³ As the District Court understood it, the key issue in the case was “can a cheerleading uniform be conceived without any ornamentation or design, yet retain its utilitarian function as a cheerleading uniform?”⁶⁴ According to the District Court, it cannot: “a cheerleading uniform loses its utilitarian function as a cheerleading uniform when it lacks all design and is merely a blank canvas.”⁶⁵ Looking to the Second Circuit’s *Jovani* opinion for guidance, which held that sequins, crystals, ruched satin and layers of tulle on a prom dress were not conceptually separable from the functionality of the dress for a special occasion because these decorative elements enhanced

⁶² Citing to *Pivot Point*, the court summarized the tests as follows: “1) the artistic features are “primary” and the utilitarian features “subsidiary,” *Kieselstein–Cord [v. Accessories by Pearl, Inc.]*, 632 F.2d [1989,] 993 [2d Cir.1980]; 2) the useful article “would still be marketable to some significant segment of the community simply because of its aesthetic qualities,” *Melville B. Nimmer & David Nimmer*, 1 *Nimmer on Copyright* § 2.08[B] [3], at 2–101 (2004); 3) the article “stimulate[s] in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function,” *Carol Barnhart [Inc., v. Econ. Cover Corp.]*, 773 F.2d [411,] 422 (Newman, J., dissenting); 4) the artistic design was not significantly influenced by functional considerations, see *Brandir Int’l, [Inc. v. Cascade Pac. Lumber Co.]*, 834 F.2d at 1145 (adopting the test forwarded in [Robert C.] *Denicola*, [Applied Art & Industrial Design: A Suggested Approach to Copyright in Useful Articles, 67 *Minn. L.Rev.* 707, 741 (1983)]); 5) the artistic features “can stand alone as a work of art traditionally conceived, and ... the useful article in which it is embodied would be equally useful without it,” *Goldstein*, 1 [Goldstein on] *Copyright* § 2.5.3, at 2:67; and 6) the artistic features are not utilitarian, see *William F. Patry*, 1 *Copyright Law & Practice* 285 (1994). *Pivot Point*, 372 F.3d at 923 (citations altered). Although it does not appear that the Sixth Circuit has addressed this issue, several recent out-of-circuit cases—including *Pivot Point* —are instructive.” *Id.* at *4.

⁶³ *Varsity*, 2014 WL 819422, at *1 (“Classical philosophy does not often come to play in the field of mundane legal analysis. But today it does, because central to the question the court must resolve in this copyright infringement case is to think about, and come close to defining, the essence of a ‘cheerleading uniform.’ The philosopher Plato famously discussed the essence of a physical object as separate from their ideal. Taking the example of a tree, we may well consider as a “tree” a thing with only a few branches and fewer leaves, because it still reflects, however poorly, the ideal we inherently know to be ‘tree.’ It possesses tree-ness. See, e.g., Plato, *The Republic* 207, 253–58, 361–66 (Benjamin Jowett trans., Vintage Books 1991).”)

⁶⁴ *Id.* at *8.

⁶⁵ *Id.*

the dress's special occasion function⁶⁶, the District Court understood a cheerleading uniform's utilitarian function to include all its elements, both decorative and functional. Just like the special occasion nature of a prom dress is enhanced by sequins, so chevrons, stripes and color blocks enhance a cheerleading uniform's function: to identify a cheerleader. Indeed, the District court analogized the function of a cheerleading uniform to that of a prom dress: "[s]imilar to the prom dresses at issue in *Jovani*, a cheerleading uniform is 'a garment specifically meant to cover the body in an attractive way for a special occasion.'"⁶⁷ The design of the chevrons, stripes and color blocks do not bring another concept to mind other than a cheerleader.⁶⁸

In reaching the decision that Varsity's chevrons, stripes, zig zags and color blocks were not copyrightable subject matter, the District Court, counterintuitively, seems to have subsumed certain Fashion designs into the functional world: these designs, especially in the case of cheerleading uniforms, can, for the District Court, be nothing but functional.⁶⁹ According to the court, a cheerleading uniform is not a cheerleading uniform without the visual decorative elements on it that communicate allegiance with a particular team and that as a result reinforce society given roles: without chevrons, stripes and color blocks the silhouette⁷⁰ of a cheerleader's dress is no longer one because the information a cheerleader's dress is meant to convey is no

⁶⁶ *Jovani Fashion, Limited v. Fiesta Fashions*, 500 Fed. Appx. 42, 44-45 (2nd Cir., 2012).

⁶⁷ *Varsity*, 2014 WL 819422, at *8.

⁶⁸ *Id.* ("Put another way, a cheerleading uniform loses its utilitarian function as a cheerleading uniform when it lacks all design and is merely a blank canvas. An examination of the blank cheerleading silhouettes that Varsity submitted illustrates this point. (See Pg. ID # 2825-26.) Without the kind of ornamentation familiar to sports (or cheerleading) fans, the silhouette no longer evokes the utilitarian concept of a cheerleading uniform, a garment that is worn by a certain group of people in a specific context.")

⁶⁹ Note, however, that the importance of Fashion as a conveyor of information is highlighted and understood as a nonutilitarian function in Brief of Fashion Law Institute et al as Amici Curiae in Support of Respondents at 4, *Star Athletica LLC v. Varsity Brands, Inc.*, et al, Docket No. 15-866 (2016). See discussion *infra*.

⁷⁰ The term the court used to refer to a blank cheerleading dress (*see Varsity*, 2014 WL 819422, at *8), and what can be understood as the garment design.

longer there.⁷¹ Again, according to the District Court, the conveyance of this identificative information accomplished by the chevrons, stripes and color blocks is part of the utilitarian function of the dress, alongside “cover[ing] the body to the same degree, wick[ing] away moisture, and withstand[ing] the rigors of cheerleading.”⁷² To quote the District Court directly:

*“the utilitarian function of a cheerleading uniform is not merely to clothe the body; it is to clothe the body in a way that evokes the concept of cheerleading. Artistic judgment and design are undeniably important in this context, but they are not separable from the utilitarian function of the resulting garment.”*⁷³

Cheerleading uniform design in this case, the District Court therefore concluded, is essential to communication of identity⁷⁴, and this *fashion communication*, being functional, renders the objects which perform it useful articles ineligible as copyrightable subject matter. The Sixth Circuit, however, reached an opposite result.

⁷¹ This is again contrary to Fashion’s conception as an information bearing good over and above its function as clothing by certain legal scholars and other fashion theorists: its ability to convey information is not seen as strictly functional but social and expressive. Again see Brief of Fashion Law Institute et al as Amici Curiae in Support of Respondents at 4, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016). (“Fashion is an information bearing good.”) See also INGRID LOSCHEK, *WHEN CLOTHES BECOME FASHION: DESIGN AND INNOVATION SYSTEMS* 134 (2009) (noting Fashion has “a social purpose, above and beyond those of function and aesthetics”).

⁷² As Varsity argued the utilitarian purpose of cheerleading uniforms to be. See *Varsity*, 2014 WL 819422, at *8.

⁷³ *Id.* at *8.

⁷⁴ A belief that the District Court’s opinion would protect individuals who create their own costumes, exercising their “expression of opinion”, is at the heart of another amicus brief filed at the Supreme Court. Brief of Public Knowledge, the Royal Manticorn Navy, and the International Costumers’ Guild as *Amici Curiae* in Support of Petitioner at 18, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016) (“by ensuring that works intended to demonstrate a group association are treated as functional and thus not copyrightable, this Court would protect the substantial interest in “expression of opinion” that lies at the core of individual freedom of association.”) Indeed, if decorative aspects are indeed non-copyrightable then there seems to be little to no risk of infringing this constitutional right because no other person will be able to assert a right in the decoration.

On appeal, the case still presented the same issue, “Are cheerleading uniforms truly cheerleading uniforms without the stripes, chevrons, zigzags and color blocks?”⁷⁵ The Sixth Circuit, however, held that the chevrons, stripes, and color blocks on Varsity’s cheerleading uniforms were copyrightable, identifying them with fabric design.⁷⁶ To arrive at its legal conclusion, the Sixth Circuit added to the multitude of tests for conceptual separability, crafting its own five part test.⁷⁷ As part of the second and third prongs of its test, the Sixth Circuit directly identified the utilitarian, functional aspects of a cheerleading uniform, and reasoned that the intrinsic utilitarian aspect of a cheerleading uniform was solely to “cover the body, wick away moisture, and withstand the rigors of athletic movements”, not to identify the cheerleader.⁷⁸ The Sixth Circuit deliberately noted the absurdity of defining the function of a cheerleading uniform in terms of its ability to communicate information about identity, seeming to suggest that such a conveyance of information is simply outside the purview of what the Copyright Act understands as utilitarian.⁷⁹ The Sixth Circuit also reasoned that a decorative function should not be considered a utilitarian function, disagreeing with the Second Circuit’s characterization in *Jovani* that because “[c]lothing, in addition to covering the body, serves a

⁷⁵ *Varsity*, slip op., at 2. In other words, stated more broadly and with terminology more familiar to the copyright regime, “When can the “pictorial, graphic, or sculptural features” that are incorporated into “the design of a useful article” “be identified separately from, and [be] capable of existing independently of the utilitarian aspects of the article[?]” *Id.*

⁷⁶ *Id.* at 3.

⁷⁷ See also *infra* at 10. See also *Varsity*, slip op., at 22-24. The Sixth Circuit expressly rejected looking at the designer’s intent, the marketability of the separate features, or the reasons behind the designer’s choice of the ultimate design. *Id.*

⁷⁸ *Id.* at 25-26.

⁷⁹ *Varsity*, slip op., at 25 (“Star contends that cheerleading uniforms identify the wearer as a cheerleader and a member of a cheerleading team. See Appellee Br. at 32, 39, 51–52. But this is no different than saying that a utilitarian aspect of a cheerleading uniform is to convey to others the fact that the wearer of the uniform is a cheerleader for a particular team. See 17 U.S.C. § 101 (“A ‘useful article’ is an article having an intrinsic utilitarian function that is not merely to . . . convey information.”). And therefore Star’s purported utilitarian aspect of a cheerleading uniform is an impermissible factor. See *supra* Section II.B.2”) .

‘decorative function,’ so that the decorative elements of clothing are generally ‘intrinsic’ to the overall function, rather than separable from it.”⁸⁰ In the Sixth Circuit’s understanding, defining a useful object based on its decorative ability would rule out the copyrightable nature of nearly all artwork.⁸¹ In their petition for certiorari to the Supreme Court, Star deliberately took issue with this facet of the Sixth Circuit’s reasoning, citing to Judge McKeague’s dissent to argue that the proffered example of useful objects whose utilitarian aspect would be defined as decoration (a Mondrian painting that decorates a room) is actually an example of a non-useful object, which would therefore never be considered a useful object in the first place.⁸²

Because of its different definition of the utilitarian function of cheerleading uniform, the Sixth Circuit found Varsity’s chevron, stripes and color blocks conceptually separable from the utilitarian aspects of a cheerleading uniform and therefore copyrightable subject matter.⁸³ The District Court reasoned that the chevrons, stripes and color blocks were indeed transferable, and that they were interchangeable between uniforms themselves, and therefore not tied to the uniform’s function of covering the body.⁸⁴ Moreover, the Sixth Circuit expressly noted that “‘nothing (save perhaps good taste) prevents’ Varsity from printing or painting its [graphic] designs, framing them, and hanging the resulting prints on the wall as art.”⁸⁵ The Sixth Circuit

⁸⁰ *Varsity*, slip op., at 26 (citing to *Jovani* 500 F. App’x at 45).

⁸¹ *Id.* (“To the extent that Star contends that pictorial, graphic, or sculptural features are inextricably intertwined with the utilitarian aspects of a cheerleading uniform because they serve a decorative function, see Appellee Br. at 51–52, we reject that argument. Such a holding would render nearly all artwork unprotectable. Under this theory of functionality, Mondrian’s painting would be unprotectable because the painting decorates the room in which it hangs. But paintings are copyrightable. It would also render the designs on laminate flooring unprotectable because the flooring would be otherwise unattractive. But the Copyright Act protects flooring designs that “hid[e] wear or other imperfections in the product.” [inner citations omitted]).

⁸² Petition for Certiorari, *supra* note 26, at 17 (“Judge McKeague also rejected the claim that such a conclusion [that a uniform at its core identifies its wearer as a member of a group and the stripes, chevrons and color blocks are integral to that function] would “render nearly all artwork unprotectable.” Artwork is not a “useful article” under § 101 and thus is protected. App. 54a.”)

⁸³ *Varsity*, slip op., at 28.

⁸⁴ *Id.* at 29.

⁸⁵ *Id.* at 28 (citing to *Home Legend*, 784 F.3d at 1413).

did draw a strong line between dress design and fabric design, however. It noted that dress design, defined as “[that] which ‘graphically sets forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment,’”⁸⁶ was, unlike the fabric design with which it identified Varsity’s chevrons, zig zags and color blocks, absolutely not copyrightable.

The Sixth Circuit excluded *fashion communication* from its understanding of the function of a cheerleading uniform, limiting such a uniform’s function to that of simple clothing: its utilitarian function is to cover the body. In doing so the Sixth Circuit opened the door for the conception of certain Fashion designs as copyrightable subject matter. Whereas under the District Court’s holding no Fashion design is seemingly copyrightable because it will always serve some sort of function, under the Sixth Circuit’s holding certain Fashion designs on a variety of clothing may indeed be copyrightable subject matter.

In January of 2016, Star Athletica appealed the Sixth Circuit’s decision to the Supreme Court, petitioning for certiorari.⁸⁷ Framing the issue as a determination of the appropriate test for conceptual separability, Star emphasized the circuit split exacerbated by the Sixth Circuit’s decision, and emphasized the Copyright Office’s historical classification of garments as useful articles not eligible for copyright protection.⁸⁸ Star further emphasized that extending copyright to Varsity’s supposedly separable elements through case-law was simply a roundabout way of circumventing Congress’ clear intention and directive that garment designs may not be eligible for copyright.⁸⁹ It also characterized defining function in the area of copyright as judicial

⁸⁶ *Id.* at 28-30.

⁸⁷ For a timeline of the case see *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, SCOTUSblog: SUPREME COURT OF THE UNITED STATES BLOG, <http://www.scotusblog.com/case-files/cases/star-athletica-llc-v-varsity-brands-inc/>.

⁸⁸ Petition for Certiorari at 31, *Star Athletica L.L.C. v. Varsity Brands, Inc.*, et al, Docket No. 15-866 (2016).

⁸⁹ *Id.* at 30 (see Copyright Office policy quoted at 33). Note that another issue, copyright deference, was also raised, but certiorari for that issue was not granted by the Supreme Court.

activism.⁹⁰ Moreover, Star emphasized the importance of the case for other objects of industrial design.⁹¹ Most especially, however, Star placed the case the context of a parade of horrors- the horrible mess in which the Fashion industry would now find itself if copyright were so extended to both designs in 2-dimensional representations and to a wide variety of products that could now be considered substantially similar to others.⁹²

In its response brief, Varsity deliberately downplayed the circuit split on separability, emphasizing that the decision taken by the Sixth Circuit in regards to its own designs was made under a part of copyright law and separability that is in fact uncontested: fabric designs are eligible for copyright.⁹³ Varsity also attempted to frame the issue as fact-based and not as a purely legal question, implying the issue was more proper for the lower courts.⁹⁴ Varsity emphasized that in its reading of the statute, utility did not include portraying appearance or conveying information.⁹⁵ In describing the design process of its proposed two-dimensional designs placed on top of its cheerleading uniforms, Varsity again emphasized not only that their designs were cut and sewn and also transferred as ink onto the fabric by heat, but also that their designers exercised artistic judgment.⁹⁶ Seemingly ridiculing Star's petition for certiorari, Varsity characterized what the Court would need to do as a review of the "metaphysics of

⁹⁰ *Id.* at 7, 40.

⁹¹ *Id.*

⁹² *Id.* at 39.

⁹³ Brief for Respondents in Opposition at 15-16, *Star Athletica L.L.C. v. Varsity Brands et al*, No. 15-866 (2016). Varsity took pains to distinguish its characterization of its chevrons and stripes from the casino uniforms in *Harrah's* (deciding the copyrightability of the arrangement of buttons and characterizing that case as garment design and therefore unlike Varsity's designs) and *Jovani* (again dealing with three-dimensional design and not the two-dimensional design at issue according to Varsity).

⁹⁴ Such an argument is a way to persuade the Supreme Court not to grant certiorari. ["A petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law."] RULES OF THE SUPREME COURT 6 (2013) available at <https://www.supremecourt.gov/ctrules/2013RulesoftheCourt.pdf>.

⁹⁵ Brief for Respondents in Opposition, *supra* n. 93 at 17-18

⁹⁶ *Id.*

cheerleading uniforms”, characterizing this as a “fact-based assertion.”⁹⁷ It further argued that a mere association of designs with a certain activity should not affect the definition of their function and therefore their separability.⁹⁸ Varsity also argued the separability analysis should not even apply because its chevrons, stripes, zig zags and color blocks were only two-dimensional and therefore obviously copyrightable.⁹⁹

In response, Star pointed out that Varsity’s claim that its design were now copyrightable fabric design was in direct contrast not only to its previous representations in litigation, but also to the fact that Varsity submitted two-dimensional sketches depicting three-dimensional uniforms¹⁰⁰, just as its counterparts in *Galiano*, who were attempting to copyright garment design, had.¹⁰¹ In its own words, Star argued that pictures of garments are simply not fabric designs.¹⁰² Star also emphasized that copyright law has long provided that copyright in a picture of a car does not prohibit production of actual cars.¹⁰³

The Supreme Court granted *certiorari* on May 2, 2016.¹⁰⁴

In their merits briefs, the parties to *Varsity* emphasized similar arguments made in their briefs for *certiorari* but also proposed specific tests for conceptual separability. Star identified a

⁹⁷ *Id.* The characterization of the issue as a “metaphysical quandary” was common to both sides: each used the characterization in an attempt to discredit the other’s argument and other proposed conceptual separability tests. Brief for the Petitioner at 42, *Star Athletica L.L.C. v. Varsity Brands et al*, No. 15-688 (2016) (reference to metaphysics as part of Judge Newman’s test).

⁹⁸ *Id.* at 22.

⁹⁹ Brief for Respondents in Opposition, *supra* n. 93, at 26.

¹⁰⁰ Reply Brief for the Petitioner at 2, *Star Athletica L.L.C. v. Varsity Brands et al*, No. 15-866 (2016) (see also at 6, “When one goes to a fabric store and purchases a bolt of material with a pattern on it, that is a fabric design; Varsity’s designs are not designs printed on fabric which is then incorporated into its cheerleading uniforms.”)

¹⁰¹ Star’s exact words were to characterize Varsity’s fabric design argument as a “strawman.” *Id.* at 6.

¹⁰² *Id.*

¹⁰³ *Id.* at 10. This argument is based in reference to 17 U.S.C. §113(b).

¹⁰⁴ *Star Athletica, LLC v. Varsity Brands, Inc.*, SCOTUSBlog: Supreme Court of the United States Blog, <http://www.scotusblog.com/case-files/cases/star-athletica-llc-v-varsity-brands-inc/> (last accessed December 3, 2016).

simple test based on classic statutory construction and the plain meaning of the text.¹⁰⁵ Arguing for a broad understanding of intrinsic utilitarian function where the definition of intrinsic is anything that is part of the “natural, essential or inherent nature of the useful article”¹⁰⁶, Star advanced a two part test in which the purely decorative elements of a useful article would be first identified according to this expansive definition of function and then secondly analyzed for their ability to exist independently¹⁰⁷, with reference to the tests of physical separability, design process, and marketability.¹⁰⁸ Star also argued for a presumption against copyright eligibility for designs of useful articles in close cases.¹⁰⁹

In its response merits brief, Varsity again characterized its chevrons, stripes, and colorblocks as applied art, emphasizing that the design found itself *on* the cheerleading uniform and not as a part of it.¹¹⁰ Emphasizing that “looking good” is not a utilitarian function under the statute¹¹¹, Varsity insisted that Star’s test was too narrow and that it would allow only pure art to be copyrighted.¹¹² Emphasizing the word *merely* in the definition of useful articles, Varsity argued it was used to exclude conveying information and portraying appearance entirely from the definition of function, not as an indicator of “how many functions a useful article has.”¹¹³ Endorsing the Copyright Office’s side by side analysis, Varsity noted that this extended copyright eligibility through separability to elements of useful articles first “capable of being visualized – either on paper or as a free-standing sculpture- as a work of authorship

¹⁰⁵ *Id.* at 23.

¹⁰⁶ *Id.* at 29.

¹⁰⁷ *Id.* at 22.

¹⁰⁸ *Id.* at 42.

¹⁰⁹ *Id.* at 27.

¹¹⁰ Brief for the Respondents at 16-17 and 18, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (2016).

¹¹¹ As the amicus brief of Professor Buccafusco would have it, *see* Brief of Professors Buccafusco and Jeanne Fromer as *Amici Curiae* in support of Petitioner at 4, *Star Athletica, L.L.C. v. Varsity Brands, Inc.* et al, No. 15-866 (2016); *Id.* at 17-18 (“if it were utility would completely subsume aesthetics”).

¹¹² *Id.* at 17 (“But requiring complete blindness to practicalities would leave nothing protected except fine art, whereas the statute robustly protects *applied* art as well.”)

¹¹³ *Id.* at 43.

independent from the overall shape of a useful article”¹¹⁴; and then existing independently by being perceived “as a fully realized, separate work.”¹¹⁵

The United States Government filed an amicus brief in support of Varsity (and later participated at oral argument) in which it proffered hypothetical examples to the court of Van Gogh’s *Starry Night* and Klimt’s portrait of Adele Bloch-Bauer reproduced on dresses.¹¹⁶ Comparing Varsity’s chevrons, stripes and color blocks to Van Gogh and Klimt, the government noted that, like Van Gogh or Klimt would have the right to reproduce their work on a dress, so Varsity has the right to reproduce its chevrons, stripes, and color blocks on a cheerleading uniform.¹¹⁷ As part of this reasoning the Government placed specific emphasis on the relationship between Section 101 and Section 113 of the statute, calling them the “mirror image” of each other.¹¹⁸ How, it reasoned, could Section 113(b) grant a copyright owner the exclusive right to reproduce its copyrighted image on a useful article if the definition of a useful article in Section 101 was read (as Star suggested) so broadly that any design on it was understood as affecting or adding to its utility?¹¹⁹ The Government also took pains to emphasize that the separability analysis was just a first step: any conceptually separable element deemed a pictorial, graphic or sculptural work would still have to fulfill the requirement of originality and be subject to the defense of merger.¹²⁰

¹¹⁴ *Id.* at 24.

¹¹⁵ *Id.* at 24.

¹¹⁶ For images of these masterpieces applied to dresses see Brief for the United States as Amicus Curiae Supporting Respondents at 18-21, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (2016).

¹¹⁷ *Id.* at 22.

¹¹⁸ *Id.* at 26.

¹¹⁹ *Id.* at 30.

¹²⁰ *Id.* at 40 (“...if it were impossible to create a garment evocative of cheerleading without copying one of the respondents’ designs, then the Act would permit such copying....[s]imilar principles would preclude leveraging a copyright in garment decoration to prevent others from evoking the idea of cheerleading....Nimmer... (explaining that “merger” doctrine permits use of copyrighted expression when it is the only way to express an idea)”).

In response, Star emphasized that two-dimensional works can indeed be functional and therefore were still subject to the separability test.¹²¹ It cited as examples of two-dimensional functional work not only camouflage but fonts, blank forms, and emergency designs on safety trucks.¹²² Star emphasized that the Copyright Office's side by side analysis endorsed by Varsity was "pure imagination" and that its test, while perhaps not ideal, offered more concrete ways for judges to decide what was properly conceptually separable.¹²³ It also noted that had Congress not understood portraying appearance and conveying information as part of a useful article's function and instead understood such functions as part of pictorial, graphic and sculptural works, it would have added a last phrase to the definition of pictorial, graphic and sculptural works: "other than portraying the appearance of the article of portraying information."¹²⁴

At oral argument the Justices seemed concerned about the practicalities of allowing Varsity to claim a copyright in its chevrons, stripes and color blocks. The Justices alternatively raised the issue of a Fashion monopoly and sought guidelines for what could and could not be understood as a non-infringing design.

When Star argued that *fashion communication* is not a conveyance of information outside the statutory definition of function¹²⁵, Justice Kagan countered that the statute could also be read

¹²¹ Reply brief for the Petitioner at 1-2, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (2016).

¹²² *Id.* at 4-5.

¹²³ *Id.* at 9.

¹²⁴ *Id.* at 13-14.

¹²⁵ Transcript of Oral Argument at 16-17, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016) ("That's different than conveying information like facts and figures. In addition, Your Honor, the conveyance of information is actually something that has to be considered as part of the exists-independently prong. And you can see this on page 2 of the blue brief where we have Section 101, both the "pictorial graphic" and "sculptural works" definition and the "useful article" definition. And if you start with the "useful article" definition, to determine whether something is a useful article in the first instance, you ask whether it has an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. So portraying the appearance and conveying information are utilitarian functions, but if that's the only thing that they do, then it's not a useful article.

the opposite way: conveying information and portraying appearance are not utilitarian functions at all, and should be disregarded during the separability analysis.¹²⁶

When Star emphasized that Varsity's copyright was limited in scope and only prohibits the creation of other two-dimensional images that copy that image and not the design of three-dimensional utilitarian objects that bear that design¹²⁷, Justice Breyer, seizing on this part of Star's argument, seemed to use Judge Newman's test to emphasize the point: calling out Marcel Duchamp, Breyer hypothesized "So when Marcel Duchamp has a shovel on the wall and says it's a work of art, he can have a copyright as long as he doesn't try to sue people who make shovels."¹²⁸ While Star agreed with Justice Breyer¹²⁹, it nevertheless exhibited extreme nervousness about such a "side by side" test, especially in the face of Justice Breyer's emphasis on imagination as the only thing that seems to allow the concept of a "work of art" to be separate from a useful object.¹³⁰ Star emphasized that when the imagination of the separate concept makes the useful object lose its utilitarian function (because in imagining a dress always from the fabric, for example, you are essentially compromising its ability to be a dress), then

But once you've decided that a garment like a cheerleader uniform is a useful article, now you turn to the separability test.")

¹²⁶ *Id.* at 21 ("That -- that those "utilitarian aspects" should be understood to encompass only the utilitarian functions that make something a useful article in the first place, which means that they should be held to exclude things that relate to the -- portraying the appearance of the article or things that relates to conveying information, and that seems to me a pretty good -- I mean, it's a confusing statute, but it seems to me a pretty good holistic understanding of this statute. But that is what this statute is trying to do, is to say there are certain kinds of things that might in a broad sense be considered utilitarian, which has to do with portraying appearance or conveying information, that, for this inquiry, we want you to exclude, that the separability test does not relate to those kinds of things.")

¹²⁷ *Id.* at 12-13. ("They have a copyright in the image. Our position is that they cannot then take that image and prohibit us from making the actual three-dimensional uniform. And the reason for that under Section 101 is because the design neither can be identified separately, nor can exist independently, which are the statutory requirements of the "utilitarian aspects" of the cheerleader uniform.")

¹²⁸ *Id.* at 24.

¹²⁹ *Id.*

¹³⁰ *Id.* at 25.

that separate concept is not in fact separable or copyrightable because the objects cannot exist without each other.¹³¹

This issue of the scope of Varsity's copyright seemed to greatly concern the Justices: indeed Justice Breyer asked Varsity to disavow him of the notion that "we are in to monopoly big-time."¹³² Justice Sotomayor wondered aloud if a university that buys a cheerleading uniform with a copyrighted design from Varsity and proceeds to rely on it for their team knows that they are essentially locked in to buying from Varsity for years and years for team consistency and brand loyalty?¹³³ Moreover, as Justice Breyer further noted in the face of objections from Varsity's counsel¹³⁴, from a practical standpoint a two-dimensional image of a dress, while not giving ownership in the actual dress, does seem in actuality to give rise to a colorable argument to copyright in the design of that dress.¹³⁵ Varsity's counsel tried to disavow the Court of this notion by emphasizing that fabric designs, with which Varsity is identifying its own designs, are already copyrightable and that it simply does not make sense to include portraying appearance or conveying information as utilitarian objects; it distinguished the issue of

¹³¹ *Id.* at 25-26.

("Bursch: But what they ignore is that it has to be independent. That means completely separate on both sides --

Stephen G. Breyer: All right. And this --

John J. Bursch: -- of the "utilitarian aspects." And so -- so then you lose the utility. You know, they would say under their test that -- that here, because I can conceptualize this uniform separate from the fabric, that that's enough. But -- but it's not, because if that design is doing work on the fabric in the place where it was designed to be, then utilitarian function is lost when you remove it. And that's exactly what Section 101 requires, right?

Stephen G. Breyer: True, true.

John J. Bursch: So you have to look not only at the design; you have to look at the article as well. And if the article does less work when that thing is gone, it's not separable.")

¹³² *Id.* at 34.

¹³³ *Id.* at 32.

¹³⁴ *Id.* at 38. ("Only in the surface design, not the folds, not the pleats, not the shape, not the cut.")

¹³⁵ *Id.* at 37. ("I'm not yet satisfied with your answer to the practical question because I fear that any good designer or lawyer could go and take any dress or suit, just about, and produce a picture that looks very much like that and then sue the companies that use the same dress or style.")

camouflage's usefulness by noting its intrinsic function is to hide someone in the forest, not to identify its wearer as a member of the military.¹³⁶

The United States Government boiled the issue down in oral argument to "what the utilitarian aspects of the "useful article" are."¹³⁷ He emphasized, to allay Justice Breyer's concerns of a monopoly, his brief's point that if there were only a few ways to express an idea for example, a military uniform or a police uniform, then the merger doctrine would apply to allow another to produce items with the copyrighted image on it that would otherwise be infringing.¹³⁸ Moreover, limiting the scope of Varsity's copyright so that it could not reproduce its chevrons, stripes, and zig zags (like fabric design) on useful articles would be contrary to Section 113(a) of the copyright statute, which gives the owner "the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 [which] includes the right to reproduce the work in or on any kind of article, whether useful or otherwise."¹³⁹

In its rebuttal, Star again emphasizing the functionality of the stripes, chevrons and zig zags as applied to the cheerleading uniform, fed the Court's concern of a monopoly and asked that the Court "not grant a 100 year copyright monopoly in design."¹⁴⁰

¹³⁶ *Id.* at 23.

¹³⁷ *Id.* at 47.

¹³⁸ *Id.* at 50. ("Now, if someone were trying to assert a copyright in the design of a policeman uniform in such a way that it turned out there were, say, only a limited number of ways to identify someone as a policeman and a copyright were being asserted to prevent identification of someone as a policeman, then the defenses that we discuss at pages 39 to 40 of our brief, the "merger" doctrine, the "scènes à faire" doctrine, would apply to prevent what would effectively be monopolization of that idea. So if that were really happening in this case -- and there are some reasons to think that's not actually happening in the cheerleading realm, and we discuss those in our brief -- if that were happening, those defenses would apply.")

¹³⁹ 17 U.S.C. § 113(a); *Id.* at 55 ("And I think one -- I think one problem with the approach you've just articulated is it really divorces Section 101 and 113(a) because you could get a copyright in the illustration, and then he would say it's not copyrightable in certain applications, and that doesn't make much sense. Thank you.")

¹⁴⁰ *Id.* at 62.

4. Future Issues

What the arguments in the briefs and the Supreme Court's comments at oral argument seem to reveal is a divide between imagination and practicality. On the one hand, the Copyright Office's side by side test, and others (including Judge Newman's in *Barnhart* and the majority's in *Pivot Point*) seemingly endorse a perception based appreciation of designs of useful articles. By looking at some useful objects themselves in a way that does not prejudice an appreciation of their designs as decorative objects, courts seem willing to extend some sort of small legal recognition to certain aspects of designs of useful articles- the "hungry look" of a mannequin, the designs of fish mannequins, the design of a belt buckle. When dealing with Fashion objects, however, this imaginative view seems blocked by grave market concerns. Even Justice Breyer's passing (as Justice Kagan characterized them) romantic comments that "the clothes on the hanger do nothing; the clothes on the woman do everything"¹⁴¹ and his existential questions as to why the Justices wear robes¹⁴², reveal a respect and affection for the imaginative aspects of Fashion common to all people that is at odds with the extension of a copyright to one individual or corporation. An imaginative view of Fashion may, in its specific case, lead to an effective grant of monopolies on the market. The Supreme Court seems ill at ease with perceiving Fashion design as one thing in the courtroom when it is in fact used as another in the market place. Varsity's chevrons, stripes, and zig zags may indeed be imagined as art hung on a wall¹⁴³; but their use on cheerleading uniforms in the marketplace may in some way be necessary.

While many of the amicus briefs filed in the case fell into one of two camps- those supporting hardly any extension of copyright to Fashion designs, deeming protection under the patent regime more appropriate and those seeking a broader or more clear copyright

¹⁴¹ Transcript of Oral Argument at 77, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016).

¹⁴² *Id.*

¹⁴³ *Varsity Brands et al v. Star Athletica*, No. 14-527, slip. op at 28 (6th Cir., August 19, 2015).

standard¹⁴⁴ - no amicus brief seemed to truly capture this tension between the imaginary and practicality. Intellectual property professors in the former camp framed the patent regime as the best way to protect industrial design in economic or static utilitarian terms; while the Fashion Law Institute's brief, in the latter camp, did emphasize Fashion's status as an information bearing good and that Fashion contains certain aesthetic and informational expressions worthy of copyright protection¹⁴⁵, its emphasis on the creativity of designers was seemingly at odds with the public interest at the heart of the imaginary. An amicus brief filed by the International Costumers' Guild did articulate the potential for an infringement of First Amendment rights of association if corporations like Varsity are granted copyrights in their designs¹⁴⁶, but its arguments, despite being contextualized within historical re-enactments, were also couched in terms of a monopoly.¹⁴⁷

¹⁴⁴ Other amicus briefs include those generally seeking a clearer conceptual separability test (in the interest of 3D printers (Brief of Amici Curiae FromLabs, Inc., Matter and Form, Inc., and Shapeways, Inc., in Support of Petitioner, *Star Athletica, L.L.C. v. Varsity, Inc.*, No. 15-866 (2016)), various intellectual property associations seeking to advance one particular test or their own in support of neither party (Brief amicus curiae of American Intellectual Property Law Association in support of neither party, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016); Brief amicus curiae of New York Intellectual Property Law Association in support of neither party, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016); Brief amicus curiae of Intellectual Property Law Association of Chicago in support of neither party, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016)), and intellectual property professors seeking a narrow definition of utility in support of Varsity (Brief amici curiae of Professors Jeannie Suk Gersen and C. Scott Hemphill, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016)), and still others seeking to import the trade dress test of aesthetic functionality to copyright (Brief amicus curiae for Chosun International, Inc. in support of Respondents, *Star Athletica L.L.C. v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016)). For a full list of amicus curiae briefs files see *Star Athletica, LLC. v. Varsity Brands, Inc.*, SCOTUSBlog: Supreme Court of the United States Blog, <http://www.scotusblog.com/case-files/cases/star-athletica-llc-v-varsity-brands-inc/> (last accessed December 4, 2016).

¹⁴⁵ Brief of Fashion Law Institute et al as Amici Curiae in Support of Respondents at 4, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016).

¹⁴⁶ Brief of Public Knowledge, the Royal Manticorn Navy, and the International Costumers' Guild as *Amici Curiae* in Support of Petitioner at 18, *Star Athletica LLC v. Varsity Brands, Inc., et al*, Docket No. 15-866 (2016).

¹⁴⁷ *Id.* at 3.

While the tension between the imaginary and practicality is well founded, there are still instances in which they are not potentially in conflict. The folds on Issake Miyake’s Flying Saucer dress, the lace design of a Spring/Summer 2012 Alexander McQueen dress, and the accordion structures on Nah Raviv’s work are all designs of *haute couture* dresses.

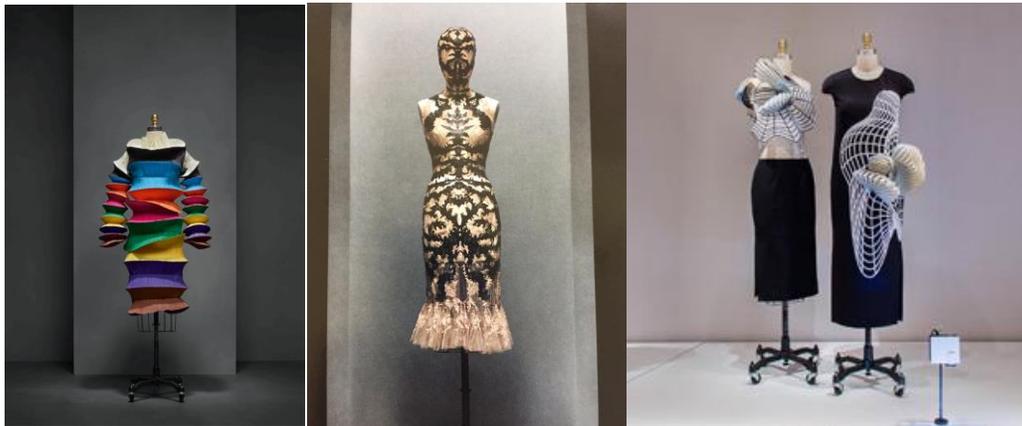


Figure 4 Issey Miyake “Flying Saucer Dress”; Alexander McQueen Spring/Summer 2012; Ensemble by Noa Raviv

Unlike garment design, these Fashion designs do not portray the shape and cut of a dress. Rather, like Varsity’s chevrons and color blocks and zig zags, they are to a certain extent applied to the fabric while still arguably being caught up with the overall message and function of the dress- whether that is defined as clothing the body or conveying the message that its wearer is a sophisticated member of an elite Fashion group. Extending copyright to these Fashion designs might not have an overwhelming effect on the market due to their specialized clientele. Even if one could argue that certain *haute couture* designs are part of a trickle-down style influence, these specialized designs that are not easily sold to the everyday consumer might not be considered necessary at all. Moreover, the recognition that these Fashion designs are indeed copyrightable would do much to support the perception of these dresses as works on par with other objects more traditionally understood as pictorial, graphic and sculptural works. Like a DuChamp shovel, these folds, lace designs, and accordion structures would be works of authorship.

5. Conclusion

The issue in the *Varsity* case concerns conceptual separability in U.S. copyright law. It asks what is the proper test for conceptual separability in the case of chevrons, stripes, and zig zags that are part of cheerleading uniforms. U.S. copyright protection is extended to “original works of authorship fixed in any tangible medium of expression.”¹⁴⁸ Conceptual separability fits in to the requirement of works of authorship, separating certain designs of useful articles that are pictorial, graphic or sculptural works, and therefore copyrightable subject matter, from other designs of useful articles that are instead non-copyrightable useful articles. The case arises at a time when clarification as to the legal test for conceptual separability is much needed- not only are there ten different tests scattered throughout circuits, but there is a perennial struggle between patent and copyright for exclusivity over designs of useful articles. Crucial to the identification of one test for conceptual separability is the definition of utilitarian function within the context of statutory definitions of pictorial, graphic and sculptural works and useful articles.

Understanding function as including the ability to portray appearance or convey information, or as including only capabilities apart from these, will to a great extent determine whether designs of useful articles are perceived as copyrightable subject matter because they are conceptually separable from the useful article with which they are affiliated. Characterizing designs of useful articles as applied art, as *Varsity* attempts to do, may at first seem to clarify the issue. Garment or dress design- the shape or cut of a garment- is understood by courts, Congress, and the parties to the case as ineligible for copyright protection. Fabric design, on the other hand, is generally understood as copyrightable and potentially conceptually separable. Ultimately, however, *Varsity*'s characterizations seem to make the discussion even more murky; two dimensional images, such as camouflage, can themselves still be functional. Two

¹⁴⁸ See *supra* n. 11.

dimensional designs may also be so intertwined with their useful article that an easy characterization of them as copyrightable applied art or fabric design seems counterintuitive. What then is most important in these circumstances is the way in which the design of the useful object is perceived. After defining the function of the useful article courts must engage with the relationship between the useful article and its design in the majority of current tests. Perception of the design proves to be an activity with which courts seem to be ill at ease- some judges seem eager to exercise it, while others wonder what practical consequences their perceptions will have on the marketplace. It is perhaps for this reason that concrete factors to evaluate conceptual separability have appeared as part of the myriad of tests currently in force: design process and likelihood of marketability provide objective actions and margins with which courts may support their, at times, abstract legal decisions.

At the same time, however, legal tradition and precedent asks to what extent the qualities and powers of perception to evaluate conceptual separability may be completely abandoned: defining function and useful objects broadly would perhaps relegate all useful objects, no matter their quality or quantity of decoration, to the patent regime, a decision seemingly at odds with the Supreme Court's previous conceptual separability precedent *Mazer v. Stein*. Imaginary aspects of useful articles are sometimes envisioned as part of the copyright regime, and yet this imaginary can create a strong tension with practicality that undercuts copyrightability. The specific facts of the *Varsity* case involve simple chevrons, stripes and zig zags: decorations whose copyrightability seems to raise definite practical concerns that cut against their inclusion in any other space but one traditionally regulated by patent. At the same time, however, Fashion designs that would not support or add to this tension do exist: the utilitarian function of *haute couture* dresses might be so narrow that their Fashion designs might be comfortably deemed conceptually separable.

Of course, conceptual separability is just one doctrine in the legal framework of U.S. copyright law and it may not provide definitive answers for Fashion designs. While how the Supreme Court identifies both a cheerleading uniform and its decorative aspects in the *Varsity*

case will potentially have great effect on how designs of useful articles, and therefore Fashion designs, are legally protected in the copyright regime, the future remains: perhaps a separate and new category for works of aesthetic authorship, or a clear relegation to the design patent regime by Congress might be on the horizon. In any event, the *Varsity* case is one to watch and the Supreme Court's decision will have sure ramifications both for those who create, market and sell Fashion and those who seek to archive, preserve, and historically present it.