

# Chicago Daily Law Bulletin®

Volume 162, No. 131

Serving Chicago's legal community for 161 years

## Apparel function vs. design copyright dispute may get settled by high court

**T**he U.S. Supreme Court will weigh in on the issue of whether an ornamental feature of a useful article, such as a garment, is copyrightable.

The case is an appeal from the 6th U.S. Circuit Court of Appeals' decision in *Varsity Brands Inc. v. Star Athletica LLC*, 799 F.3d 468, 470 (6th Cir. 2015). Varsity Brands Inc., a manufacturer and distributor of cheerleading uniforms, obtained copyright registrations for two-dimensional sketches of cheerleading uniform designs incorporating certain stripes, chevrons and color blocks.

Varsity sued Star Athletica LLC in the federal court in Memphis, Tenn., for allegedly infringing Varsity's copyrights by manufacturing and distributing cheerleading uniforms with stripes, chevrons and color blocks substantially similar to Varsity's copyrighted designs.

The U.S. District Court held that Varsity's copyrights could not be used to prohibit Star from manufacturing actual cheerleading uniforms, reasoning that a uniform, without the stripes, chevrons and color blocks, could not stand alone as a cheerleading uniform so that the designs had a functional purpose.

In a 2-1 decision, the 6th Circuit reversed.

The panel majority concluded that the stripes, chevrons and color blocks used on Star's cheerleading uniforms were purely aesthetic and served no utilitarian function. Thus, Varsity could rely on their copyrights to preclude Star from producing cheerleading uniforms with these designs.

In its decision, the court addressed the conflict among the circuits over the separability analysis for design copyrights. It adopted an approach that requires courts to define the work's function and to ask whether the claimed elements can be identified separately from, or exist independently of, that function.

The dissent argued that the stripes, chevrons and color blocks are functional as they identify the cheerleaders and the team they are supporting.

Arguing that the 6th Circuit's decision contradicts long-settled law that other circuits and Congress have refused to change, Star successfully petitioned the Supreme Court to resolve the circuit split and clarify the appropriate test for determining which features of a useful article can be copyrighted.

The court has not addressed this issue since *Mazer v. Stein*, 347 U.S. 201 (1954), where the court held that statuettes of dancing figures made of china that were intended for use and used as bases for table lamps with electric wiring, sockets and lamp shades attached, were copyrightable as works of art.

The court stated that "intended or actual use in industry of an article eligible for copyright does not bar or invalidate its registration" and that "the subsequent registration of a work of art published as an element in a manufactured article is not a misuse of the copyright." *Id.* at 218-219.

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Star's petition asserts that there are at least nine different separability tests. Among these tests is

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the copyright office's test, which permits copyright registration of a pictorial, graphic or sculptural feature of a useful article "only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works — one an artistic work and the other a useful article." *Compendium [of U.S. Copyright Office Practices] III* Section 924.2(B) (2014).

The only circuit decisions that have addressed separability in the context of apparel is the 2nd Circuit's decision in *Jovani Fashion Ltd. v. Fiesta Fashions*, 500 F. App'x 42 (2d Cir. 2012) (owner of

actual uniforms based on those sketches).

The 2nd and 5th Circuits found that the decorative elements of the articles of clothing at issue enhanced the articles' functionality and therefore the articles were not copyrightable. Under this separability test, Varsity's attempt to extend copyright protection to cheerleading uniforms would have likely been rejected.

The 7th Circuit has adopted the so-called Goldstein test, which provides that a pictorial, graphic or sculptural feature is conceptually separable if the "artistic features can stand alone as a work of art traditionally conceived, and whether the useful article in which it is embodied would be equally useful without it." *Pivot Point International Inc. v. Charlene Products*, 372 F.3d 913, 923 (7th Cir. 2004) (quoting Paul Goldstein, "Copyright: Principles, Law & Practice," Section 2.5.3, at 2:67 (1989)).

In *Pivot Point*, the 7th Circuit found the "Mara" mannequin head, portraying a "hungry look," subject to copyright protection where a human face could be conceptualized independent of Mara's unique facial features and where Mara was the product of a creative process not influenced by functional concerns.

Thus, the artistic features could be identified separately from and exist independently of the mannequin's utilitarian aspects. *Id.* at 932.

The *Star Athletica* case provides the Supreme Court with an opportunity to settle the question of an appropriate test to determine when a design feature of a garment, as well as other useful articles, is protectable under Section 101 of the Copyright Act.

A standard test for courts to determine copyrightability for designs of useful articles should lead to greater predictability in copyright litigation and decrease forum shopping.