

In a decision that included some spirited inter-Justice banter (see what I did there?), the Supreme Court upheld the 6th Circuit Court of Appeals decision in *Star Athletica, LLC v. Varsity Brands, Inc.*, by clarifying that the several designs Varsity Brands applies to their cheerleader uniforms – and registers with the Copyright Office – are copyright eligible. While affirming the outcome from the 6th Circuit, the Court did take the opportunity to clarify the proper manner of analysis for determining whether the aesthetic design of a useful article is eligible for copyright protection.

The opinion of the Court’s 6 to 2 decision was drafted by Justice Thomas and appears well-grounded in the express language of the copyright act. To begin, 17 U.S.C §102 defines copyright eligible subject matter to include:

“original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- literary works;
- musical works, including any accompanying words;
- dramatic works, including any accompanying music;
- pantomimes and choreographic works;
- **pictorial, graphic, and sculptural works;**
- motion pictures and other audiovisual works;
- sound recordings; and
- architectural works.”

Aesthetic designs, such as those applied to Varsity Brands’ cheerleading uniforms, generally fall under category five eligible works of authorship. However, because the designs in question are applied to useful articles, §101 provides three additional guidelines:

1. *“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.”*
2. Within those categories, copyright only protects *“works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned;”* and
3. Finally, the form, but not utility, of a category five covered work applied to a useful article is eligible for protection if, and only to the extent that, the category five features can *“be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”*

The Court also indicated the reason cert was granted was “to resolve widespread disagreement over the proper test for implementing §101’s separate identification and independent-existence requirements.” The rule enunciated by the Court essentially mirrors the language of §101, declaring that the only questions to be considered when determining whether the design of a useful article is copyrightable are:

“(1) whether the design can be perceived as a two- or three-dimensional work of art separate from the useful article, AND

(2) whether the design would qualify as a protectable pictorial, graphic, or sculptural work – either on its own or fixed in some other tangible medium of expression – if it were imagined separately from the useful article into which it is incorporated.”

While a rule that directly tracks statutory language would seemingly be fairly straight-forward for lower courts to implement, the Court clearly felt it necessary to expressly consider and reject a number of alternative tests, factors, arguments, etc., that lower courts and parties had asserted under the guise of statutory interpretation and/or legislative history. Specifically, the Court established that:

- A two-dimensional design placed *on* a useful article is not necessarily different from

the design *of* a useful article. (Opinion p. 5)

- It doesn't matter whether the design, when imaginatively separated from the useful article, still resembles or is shaped like the useful article. (Opinion p. 11)
- Courts should not consider the useful article once the design has been theoretically removed. Diminished utility of the useful article once the design has been removed doesn't matter – only the design matters. (Opinion p. 13)
- Whether the design of a useful article adds utility to the useful article doesn't matter because “applied art” inherently provides some utility. The utility is not protected, but overlapping utility does not preclude protection of the artistic portions. (Opinion p. 14)
- Physical separability of the design from the useful article is not required because imaginative or theoretical separability is all the statute requires. (Opinion p. 15)
- Courts should not consider “whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influence.” (Opinion p. 15)
- Courts should not consider whether “there is a substantial likelihood that the pictorial, graphic, or sculptural feature would still be marketable to some significant segment of the community without its utilitarian function.” (Opinion p. 15)
- Industrial design is not categorically removed from copyright protection. (Opinion p. 17)

Ultimately, then, it is clear that the Court intends to apply the language of §101 and §102 to include designs for useful articles as simple as clothing. Further, given the relative ease of procuring copyright, the fact there are potentially decades of useful article designs with at least common law copyright, and the greatly extended lifespan of such copyrights, it certainly seems that Varsity Brands will not be the last we hear on the matter.