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GIVE ME ... "SEPARABILITY!" SUPREME COURT HOLDS CHEERLEADING UNIFORM DESIGNS COPYRIGHTABLE

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In an important copyright case for retailers, the Supreme Court, in *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. (2017), resolved "widespread disagreement" among the circuits, and adopted a single test to determine the copyrightability of designs incorporated in "useful articles." The Court held that "an artistic feature of the design of a useful article is eligible for copyright protection if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article." Applying that test to Varsity Brands' cheerleading uniforms, the Court concluded that the "arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms" are separable from the uniforms and eligible for copyright protection.

In *Star Athletica*, a producer of cheerleading uniforms sued a competitor for infringing copyrights in five cheerleading uniform designs, one example of which is shown below for reference, consisting primarily of "combinations, positionings, and arrangements of...chevrons, lines, curves, stripes," and similar shapes, and color combinations. The U.S. District Court for the Western District of Tennessee granted summary judgment in the alleged infringer's favor, finding that "the designs did not qualify as protectable pictorial, graphic or sculptural works" because they served the "'utilitarian' function of identifying the garments as 'cheerleading uniforms' and therefore could not be 'physically or conceptually' separated" from the uniform. The U.S. Court of Appeals for the Sixth Circuit reversed, concluding that the "'graphic designs' were 'separately identifiable' because the designs 'and a blank cheerleading uniform can appear "side by side" - one as a graphic design, and one as a cheerleading uniform.'" Affirming, the Supreme Court reached several notable holdings.

First, the Court addressed whether a separability analysis is required at all where a two-dimensional "surface decoration" is applied to a useful article. Reviewing the text of Section 101 of the Copyright Act of 1976, the Court found no basis to distinguish between designs *of* useful articles on one hand, and designs *reproduced on* useful articles, on the other. Thus, a separability analysis is required for all design features applied to useful articles.

Next, the Court "abandoned the distinction between 'physical' and 'conceptual' separability, which some courts and commentators have adopted based on the Copyright Act's legislative history." Instead, the Court held, the "statutory text indicates that separability is a conceptual undertaking." Accordingly, the Court's single separability test applies to all designs of useful articles.

In reaching the single separability test, the Court focused on Section 101's definition of "pictorial, graphic, and sculptural works." The Court construed that section to provide that "a 'pictorial, graphic, or sculptural feature' incorporated into the 'design of a useful article' is eligible for copyright protection if it (1) 'can be identified separately from,' and (2) is 'capable of existing independently of, the utilitarian aspects of the article.'" To satisfy the first element, the "decision maker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities." To satisfy the second, the feature "must be able to exist as its own pictorial, graphic or sculptural work…once it is imagined apart from the useful article." The Court emphasized that the "focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction." Likewise, the statute "does not require that we imagine a non-artistic replacement for the removed feature to determine whether that *feature* is capable of an independent existence." (emphasis in original).

Applying this test to the facts of the case, the Court concluded: "First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities." "Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium—for example, on a painter's canvas—they would qualify as 'two-dimensional…works of…art,' § 101." The Court rejected the argument that imaginatively removing the designs and placing them on a canvas would create "pictures of cheerleader uniforms." Rather, the Court said, the design is simply "a two-dimensional work of art that corresponds to the shape of the useful article to which it was applied," just as a painting "corresponds to the shape of the canvas on which it is painted" or a fresco tracks the shape of a wall.

In light of the procedural posture, the Court did not reach whether the particular designs at issue were sufficiently original to qualify for copyright protection. The Court also emphasized that "the only feature of the cheerleading uniform eligible for a copyright in this case is the two-dimensional work of art fixed in the tangible medium of the uniform fabric," and that the plaintiff has "no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear."

The useful articles at issue in *Star Athletica* were specialty articles of clothing, but the decision will likely have implications in a broad range of retail and consumer products industries and other applied arts. The decision may also warrant a fresh look at design patent protection, which the Court reiterated is not mutually exclusive of copyright protection. The practical effect of the Court's ruling will likely vary by jurisdiction, depending on which prior regional test is supplanted by its holding.

If you would like to discuss how this decision may affect your business, please contact a member of Bryan Cave's Intellectual Property Client Service Group or Retail team.

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