

THE DAILY RECORD

WESTERN NEW YORK'S SOURCE FOR LAW, REAL ESTATE, FINANCE AND GENERAL INTELLIGENCE SINCE 1908

IP FRONTIERS

Which team will cheer the loudest before the Supreme Court: Cheerleading uniforms vs. 3d printing

Copyright protection requires, among other things, that the original “work of authorship” be non-functional. Over 60 years ago, the U.S. Supreme Court decided *Mazer v. Stein*,¹ a pivotal decision for protecting designers against knock-offs and copycats under the Copyright Act.

In *Mazer*, the Court held that sculptural, non-functional features of a design are copyrightable even if they are part of a useful article – whether it be an armoire, laminated flooring, a belt buckle, a costume, or a lighting fixture.

Twenty years after *Mazer*, Congress amended the Copyright Act to expressly clarify that the design of a useful article, ... 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 U.S.C. § 101 (emphasis added).

As such, the artistic craftsmanship of sculptural works that are embodied in useful articles is copyright protectable. Furthermore, the Second Circuit (and most Circuits) has held that sculptural, aesthetic elements are subject to copyright protection if they are *conceptually* separable from the functional aspects of the useful article; that is, they need not be physically separable (e.g. able to be cut off). Often referred to as the “separability doctrine,” the copyright principle that aesthetic, decorative design features (e.g. pictorial, graphic or sculptural features) that are either physically or conceptually separable from the function of a product are copyright protectable is well recognized by the courts and the Copyright Office. See



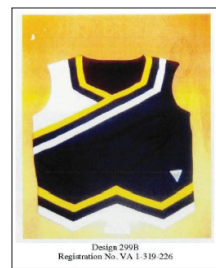
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Daily Record
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Compendium of U.S. Copyright Office Practices, Third Edition, §924.2 (2014). However, since *Mazer*'s confirmation that useful articles may contain copyrightable elements, the courts have wrestled with precisely how to determine when a design feature contains elements that are separable, either physically or conceptually, and thus deemed non-functional and protectible. The Supreme Court has been silent on this issue, but that could change, as the Court recently agreed to address the following issue: “What is the appropriate test to determine whether a feature of a useful article is protectable under ... the Copyright Act?” *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (U.S. May 2, 2016).

In *Mazer*, the work was a lamp base (shown below), which the Supreme Court found could be protected by copyright.²



Examples of other sculptural designs found to be copyright protectable since *Mazer* include: picture frames, stuffed animals, mannequins, jewelry, belt buckles, and lighting.³ Examples of sculptural designs found not to be copyright protectable include: mannequins; utility lighting; a wheel cover; and a bike rack.⁴



In *Star Athletica*, the works at issue are five designs for cheerleading uniforms, each comprising an arrangement of stripes, chevrons and color blocks (shown below).⁵ In 2015, on appeal, the Sixth Circuit held each design contained copyright protectable elements.

However, according to the arguments of the petitioner, Star Athletica (the accused infringer), the design of cheerleading uniforms is unprotectable by copyright. On the other hand, Varsity Brand (the owner of the copyright) argues its cheerleading uniform designs are protectable as fabric designs, separable from and applied to the

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surface of the uniform. The district court found Varsity Brand's arrangement of color blocks, stars and chevrons was not suitable as a copyrightable work, as the designs were not physically or conceptually separable from the function of the uniform itself.⁶

The Sixth Circuit disagreed, holding that Varsity Brand's cheerleading uniform designs were a copyrightable work because the designs were transferrable to articles other than the traditional cheerleading uniform (e.g. a T-shirt, picture hanging on the wall). Thus, the designs were unnecessary to the performance of the uniforms ability to cover the body (e.g. permit free movement and wick moisture).⁷ In arriving at this conclusion, the Sixth Circuit first identified at least nine (9) distinct "separability" tests various Circuits and commentators have applied in determining whether a design is separable from the function of an article.⁸ In the end, the 6th Circuit applied a six-part separability test:

(1) Is the design a pictorial, graphic, or sculptural work?

(2) If yes, then is the design a useful article? That is, an article having an intrinsic function that not merely to portray the appearance of the article or to convey information?

(3) What are the utilitarian aspects of the useful article?

(4) Can the viewer of the design identify the pictorial, graphic, or sculptural features separately from the utilitarian aspects of the useful article?

(5) Can the pictorial, graphic, or sculptural features of the design exist independently of the utilitarian function?

As for the fifth factor, the 6th Circuit stated that "[i]f the pictorial, graphic, or sculptural features are not required by the useful article's utilitarian functions or are wholly unnecessary to performance of the utilitarian function of the useful article, then the...features are not dictated by the

function of the useful article, and therefore can exist without the useful article," and are thus copyrightable subject matter. *Varsity Brands, Inc.*, 799 F.3d at 487-89 (emphasis added).⁹

Perhaps also influencing the high court's decision to hear the *Star Athletica* case, the Copyright Office recently spoke on the issue of conceptual separability in its revised practice guide, providing the following guidance which appears to improperly restrict copyright protection only to design elements that are *physically* separable:

[The] artistic feature must be capable of being visualized – either on paper or as a free-standing sculpture – as a work of authorship that is independent from the overall shape of the useful article. In other words, the features must be imagined separately and independently from the useful article without destroying the basic shape of that article.

The pictorial, graphic, or sculptural feature satisfies this requirement 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, Third Edition, §924.2(B) (2014) (emphasis added). Thus, the issue before the Supreme Court is how to determine if an artistic work (e.g. the arrangement of chevrons, color blocks and zig zags) is copyright protectible when it cannot be physically separated and can only be separated conceptually from a useful article (e.g. cheering leading uniform).

While cheerleader uniform designs are the item in dispute under *Star Athletica*, the high court's decision could impact several areas besides fashion design. On the one team are the original designers for the tech industry and high-end design, luxury products. Historically, this "Team" has been afflicted by knock-offs on the national and international market, and often turns to copyright protection as one form of intellectual property protection because

no intellectual property law standing alone provides adequate protection.¹⁰

On the other "Team" are the potential imitators. This is perhaps best evidenced by the amicus brief of three 3D printing companies who state it is important to have a single test under the separability doctrine for determining what is and isn't copyrightable.¹¹ In other words, which aspects of a useful article can be copied and which are protected by copyright.

3D printed objects that are purely ornamental and nonfunctional, such as an exact replica of a sculpture or a complex jewelry design, are protectable by copyright; designs that are purely functional useful articles, such as a basic wrench or a replacement gear, are not. In intermediate cases, however, the application is uncertain. A significant percentage of 3D printed objects combine utilitarian and artistic elements in complex ways. These mixed-use objects engage copyright in a more involved manner and require distinguishing between the copyrightable subject matter and the noncopyrightable utilitarian elements.¹²

As the amicus brief states, it is likely that "[a]s the 3D printing industry expands, so will the number of copyright claims and disputes connected to physical objects that incorporate both creative and functional parts."¹³ The Supreme Court's decision could clarify this area of copyright law beyond the fashion industry, as requested by the 3D printing companies, or make it more complicated. Either way, one thing is for certain; the Supreme Court decision will be watched closely by both teams in the fashion, high tech and luxury products industries.

The Supreme Court is scheduled to hear arguments in *Star Athletica* sometime in October 2016 to June 2017.

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1 347 U.S. 201 (1954).

2 *Mazer*, 347 U.S. 201.

3 *Boyd's Collection, Ltd. v. Bearington Collection, Inc.*, 360 F. Supp. 2d 655 (M.D. Pa. 2005) (stuffed animals); *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320 (2d Cir 1996) (fish mannequins); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir 1980) (belt buckles); *Van Cleef & Arpels Logistics, S.A. v. Jewelry*, 547 F. Supp. 2d 356 (S.D. N.Y. 2008)(jewelry); *Stanislawski v. Jordan*,

337 F. Supp. 2d 1103 (E.D. Wis. 2004)(decorative picture frames); *Universal Furniture Intern., Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010)(decorative elements on furniture); *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir.2004) (mannequins); *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005)(costumes); *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404, 1413 (11th Cir. 2015)(laminated flooring).

4 *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir 1985) (mannequins); *Esquire, Inc. v. Ringer*, 591 F.2d 796 (11th Cir 1978) (modern-looking, unadorned utility light); *Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983)(wheel cover); *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) (unadorned bike rack).
5 See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 471-473 (6th Cir. 2015).

6 *Varsity Brands Inc. et al. v. Star Athletica LLC*, No. 10-2508, 2014 WL 819422 (W.D. Tenn. Mar. 1, 2014). (“Artistic judgment and design are undeniably important in this context, but they are not separable from the utilitarian function of the resulting garment”).

7 See *Varsity Brands, Inc.*, 799 F.3d at 490-493.

8 The 6th Circuit opined that delineating the boundaries of what design features are copyrightable has long “confounded courts and scholars” alike and resulted in an inconsistent patchwork of legal tests across the Circuit courts. *Varsity Brands, Inc.*, 799 F.3d at 471, 483-487.

9 Other similar conceptual separability tests include

the 2nd, 4th and 7th Circuit tests, wherein conceptual separability exists “where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.” See, e.g., *Chosun International, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005); *Universal Furniture International, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010); *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 931-2 (7th Cir.2004). In contrast, for example, the 5th Circuit applies a marketability test, that is conceptually separable exists if article “would still be marketable

to some significant segment of the community simply because of its aesthetic qualities.” See *Galianov. Harrah’s Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005).

10 For example, other possible legal protections include trade dress and design patents.

11 *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, Brief of Amici Curiae Formlabs Inc., Matter and Form Inc., and Shapeways, Inc. in Support of Petitioner, 2016 WL 537499 (2016).

12 *Id.* at *9.

13 *Id.* at *10