Monday, April 24, 2017 / Volume 109 / Number 78

THE DAILY RECORD

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

IP FRONTIERS

Copyright and design protection post-Star Athletica

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On March 22, the U.S. Supreme Court released its much-anticipated decision in *Star Athletica v. Varsity Brands.*[1] As readers of The Daily Record may remember,[2] the *Star Athletica* case was about whether the design elements (stripes, chevrons, lines, etc.) on cheerleading uniforms are eligible for copyright protection. In a 6-2 decision, the Supreme Court answered in the affirmative and articulated a new test to determine when a feature incorporated into the design of a useful article qualifies for copyright protection. According to the Supreme Court's recent decision, a design feature is copyright eligible if it satisfies a two-part test, namely 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 fixed in some other tangible medium of expression — if it were imagined separately from the useful article into which it is incorporated. So what does the decision mean?

Star Athletica was the first ever Supreme Court case to deal with the copyrightability of fashion and design apparel, and the first case dealing with the copyrightability of useful articles since Mazer v. Stein in 1954. The decision is likely to have a significant impact in fashion and other high-end design and luxury good industries and may increase the availability of copyright protection for two- and three-dimensional designs incorporated into useful articles such as clothing, furniture and lighting fixtures.

The basic premise of copyright law is to protect expression, but not the underlying ideas, facts or utility. This is known in copyright as the idea-expression dichotomy, first explained by the Supreme Court in *Baker v. Selden* in 1879, and now codified under section 102(b) of the Copyright Act. Utility protection falls within the domain of patent law and is a fundamental difference between patents and copyrights. However, it is also true that an otherwise copyrightable work does not lose protection simply by virtue of being incorporated into a useful article. That is, while useful articles themselves cannot be protected by copyright, in *Mazer v. Stein*, the Supreme Court held that a pictorial, graphic, or sculptural work incorporated in a useful article can be protected if it is separable from the useful article. Since Mazer, this "separability" doctrine is where the inherent subjectivity, and hence difficulty, lies.

The separability doctrine was later codified in section 101 of the Copyright Act, which states that a design is protectable if it can be "identified separately from, and [is] capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101. Separability has been an issue in copyright cases involving a variety of useful articles — belt buckles, bike racks, mannequins, costumes, etc. — and Circuits were split regarding the appropriate test to determine when a feature of a useful article is separable (and protectable) under section 101. In construing section 101, courts turned to the legislative history of the act, in which the lawmakers referred to physical or conceptual separability. See H.R. Rep. 94-1476. In a Daily Record article published in June 2016 after the Supreme Court accepted certiorari in *Star Athletica*, we discussed the legal background of the case and the various separability tests applied throughout the circuits.

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Perhaps most significantly, the Star Athletica decision eliminates the distinction between conceptual and physical separability and provides some normalization in an area of law that desperately needed unification. Justice Clarence Thomas issued the majority opinion setting forth the above two-part test, which closely follows the statutory language of section 101. The Supreme Court also went on to clarify that section 101 does not require the decision maker to imagine a fully functioning useful article without the separated design feature, or even an equally useful one. According to the Court, the

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focus of the separability inquiry is on the extracted design feature and not on any aspects of the useful article that remain after the imaginary extraction. Thus, an artistic feature that would be eligible for copyright protection on its own cannot lose that protection simply because it was first created as a feature of the design of a useful article, even if it makes that article more useful. This language appears to broaden the scope of copyright protection for designs applied to useful articles when compared to some of the more restrictive separability tests that were applied by the circuit courts and the U.S. Copyright Office.

While the decision articulates a seemingly clean and succinct new standard, it remains to be seen precisely how much protection it will provide designers. For example, because Star Athletica deals with two-dimensional artwork, many question the scope of the decision's applicability to three-dimensional useful articles. But one thing is clear, the decision reaffirms that designs applied to useful articles are copyright eligible, giving designers' copyright claims some teeth.

To understand the full significance of the Star Athletica decision, we will have to wait and see how lower courts apply the standard to other cases. Although the Supreme Court iterated the appropriate test to apply, there is likely to be divergence in how the two-part test is applied in the various circuits, which will be largely fact specific. The good news is we may not have to wait very long.

On March 31, the week after the Supreme Court's decision, Puma sued Forever 21 alleging copyright infringement, among other things, of its "Fenty" line of shoes and citied *Star Athletica*.[3] Puma's Fenty shoes were created in conjunction with pop star Rihanna and have been extremely successful, partly because Puma keeps the volumes small and limits sales to increase the label's desirability.

Given the nature of the shoe designs, which are a far cry from stripes, chevrons and lines on cheerleading uniforms, Puma's claim that the Fenty shoes contain separable and protectable design elements is sure to test the boundaries of the *Star Athletica* decision, and is likely to highlight just how subjective copyright protection for designs applied to useful articles remains despite the Supreme Court's two-part test. Only time will tell how much guidance the Puma case and other lower court cases will provide in interpreting the Supreme Court's new separability test, and whether the various circuits will simply revert to their own varied separability tests under the guise of applying the Star Athletica holding. Likewise, the manner in which the U.S. Copyright Office interprets the Supreme Court's decision in its review of copyright applications for designs applied to useful articles is yet to be determined, but will be a critical consideration for fashion and luxury good designers as well.

Meanwhile, in the wake of Star Athletica, individuals and companies investing money in the design of useful articles should consider obtaining copyright protection proactively, keeping in mind that copyright is only one piece of a well-rounded intellectual property (IP) strategy. Designers should continue to evaluate all applicable types of IP (copyright, design patents, utility patents, trade dress) and develop a protection strategy on a product-by-product basis. The most successful strategies are fact and market specific, taking into consideration important factors such as the anticipated life span of the product, novelty, budget, susceptibility to knock-offs and functionality.

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1 *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (March 22, 2017).

2 Alana M. Fuierer, Esq., *Which team will cheer the loudest before the Supreme Court*, Daily Record, June 20, 2016.

3 Puma SE v. Forever 21, Inc., Civil Action No. 2:17-cv-02523 (C.D. Cal.).