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## Gimme a “C” for Copyright!

High Court Says Decorative Elements of  
Cheerleading Uniforms Copyrightable

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## Today's Presenters



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## Star Athletica v. Varsity Brands



- On March 22, the Supreme Court announced its decision in *Star Athletica, LLC v. Varsity Brands, Inc.*
- The decision sets forth a test for determining when a feature of a useful article is protectable under § 101 of the Copyright Act

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## Recap: Useful Articles under the Copyright Act



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.

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## Recap: Case History



- Varsity Brands sued competing cheerleading uniform manufacturer competitor Star Athletica claiming Star Athletica copied five of Varsity Brands' copyrighted cheerleading uniform designs
- Varsity Brands had successfully registered all five of the designs at issue with the Copyright Office
- The designs at issue included varying arrangements of stripes, chevrons, zig zags, and color block

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## Recap: Varsity Brands' Designs



078  
Design 078  
Registration No. VA 1-417-427

Design 074  
Registration No. VA 1-411-535



Design 0815  
Registration No. VA 1-675-905

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# Recap: Varsity Brands' Designs



Design 299B  
Registration No. VA 1-319-226



Design 299A  
Registration No. VA 1-319-228

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# Recap: Allegedly Infringing Designs



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## Recap: Case History



- The district court held that the designs were *not* eligible for copyright protection
- Sixth Circuit reversed, holding Varsity Brands' graphic designs can be identified separately from, and are capable of existing independently of, the utilitarian aspects of cheerleading uniforms, therefore, *are copyrightable*

## Recap: Case History



- Petition for Certiorari asked two questions
  - » What is the appropriate test for determining when a feature of a useful article is protected by copyright?
  - » What level of deference should be given to the Copyright Office's decision to register a copyright claim?
- The Court granted cert on the first question

## Recap: Case History



### ■ What this case is NOT about

- » Doesn't address whether Varsity Brands' copyrights are *valid*
- » Doesn't decide there was *infringement*

## Recap: Tests for Separability



### ■ Physical vs. Conceptual

### ■ Courts have used a number of tests for conceptual separability, including:

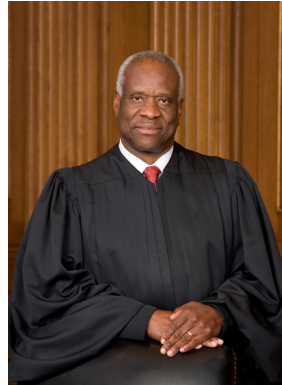
- » Primary-Subsidiary
- » Objectively Necessary
- » Ordinary-Observer
- » Design-Process
- » Stand-Alone
- » Likelihood of Marketability
- » And others . . .



## Court's Ruling – A New Test



“[An] artistic feature of the design of a useful article is eligible for copyright protection if the feature (i) can be perceived as a two- or three-dimensional work of art separate from the useful article and (ii) 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.”



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## Court's Ruling



- “[C]opyright protection extends to pictorial, graphic, and sculptural works regardless of whether they were created as freestanding art or as features of useful articles.”
- 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”.



Fiona Rabbeck, Kate Winslet Wows in Another Body-Con Stella McCartney Dress, Marie Claire (Nov. 21, 2011), <http://www.marieclaire.co.uk/news/fashion/532781/kate-winslet-wows-in-another-body-con-stella-mccartney-dress.chtml#index=1>

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## Court's Ruling



- Ginsburg's concurrence: Varsity's registered designs actually first appeared as sketches, not constructed uniforms



Design 073  
Registration No. VA 1-417-427



Design 074  
Registration No. VA 1-411-535



Design 0815  
Registration No. VA 1-675-905

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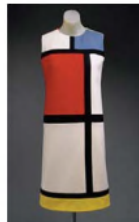
## Court's Ruling



- “[I]maginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself.”



Piet Mondrian, Composition with Large Red Plane, Yellow, Black, Gray, and Blue (1921) (oil on canvas)



Yves Saint Laurent, "Mondrian" day dress, The Metropolitan Museum of Art, <http://www.metmuseum.org/toah/works-of-art/CJ.69.23> (wool jersey composed of separate color blocks)



"Mondrian" cheerleader apparel designed by Katie Graham in Toyota - Car Launch, BRAZEN Hussy (April 27, 2010)

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## Court's Ruling



- Court abandons distinction between physical and conceptual separability



Photo by: Thom Quine



Jovani's Style # 154416, from Jovani website  
See *Jovani Fashion, Inc. v. Cinderella Divine, Inc.*,  
808 F.Supp.2d 542 (S.D.N.Y. 2011), *aff'd* 500  
Fed.Appx. 42 (2d Cir. 2012)

## Court's Ruling



- Focus is on the *extracted features only* and whether they qualify, not what does or does not remain.



## Court's Ruling



- **Rejects consideration of objective factors**
  - » whether design elements reflect designer's artistic judgment exercised independently of functional influences
  - » whether the feature would still be marketable without its utilitarian feature
- **Court does not want to “prize popular art over other forms, or . . . substitute judicial aesthetic preferences for the policy choices embodied in the Copyright Act.”**

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## Dissent



- **Justice Stephen Breyer authored a strong dissent, joined by Justice Anthony Kennedy**
- **Agrees with much of the court's opinion, but disagrees that the designs are copyrightable**

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# Dissent



- Imaginatively remove the design elements “as they are arranged on the neckline, waistline, sleeves, and skirt of each uniform”
- Apply the design elements to a hypothetical painter’s canvas
- Result is a painting of a cheerleader’s dress
- Therefore, cannot be separated from the useful article and “cannot be copyrighted”

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# Dissent



Fig. 3: Vincent Van Gogh, "Shoes"



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## What's Next



- Remand to the district court – does Varsity Brands have a *valid copyright*?
- Originality - *Feist Publications v Rural Telephone Service Company*, 499 U.S. 340 (1991)
  - » independently created by the author (as opposed to copied from other works)
  - » possess minimal degree of creativity
- Judicial Doctrines
  - » public domain
  - » merger
  - » scènes à faire

## What's Next



- If Varsity Brands establishes a valid copyright, it could only be used to prohibit the reproduction of the surface designs in a tangible medium of expression
- Cannot be used to “prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in [the] case appear.”

## Ruling - Advantages



- Nationwide application – resolves multiple circuit splits
- Test applies to any design elements of useful articles in any media
  - » 3D printing
  - » New technologies
- Accounts for spatial limitations or constraints
  - » Shape of a dress
  - » Curves of a domed ceiling
  - » Size of canvas

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## Ruling - Disadvantages



- Uncertainty
- Application of test can lead to different results

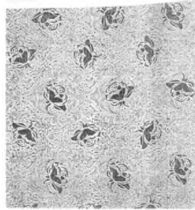


Photo by: Giuliano Bekor, CC BY-SA 4.0

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## Application – What's Copyrightable?



Fabric Design  
*Folio Impressions, Inc. v. Byer California*, 752 F.Supp. 583 (S.D.N.Y. 1990)



*Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996, 999 (2d Cir. 1995)

Copyright Reg. No. VA0001930383, from the amicus brief of the United States



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



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## Application



- The Copyright Office has indicated it will publish updated guidance in the Compendium
- Look to existing guidance for now
  - » *Compendium of U.S. Copyright Office Practices, Third Edition*, § 924.3 (2014)
- Watch for lower court decisions applying new test

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# Application



- Evaluate features of clothing designs – what’s copyrightable under the new test?
- File applications for potentially copyrightable designs
  - » Registration is a prerequisite to bringing suit for infringement
  - » Timing of registration can impact damages and/or attorneys fees (17 U.S.C. § 412)

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# Thank You



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- CLE questions? Contact Delia Dai at [ddai@foley.com](mailto:ddai@foley.com). Certificates of attendance will be distributed to eligible participants approximately 8 weeks after the web conference via email
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