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Client Alert: Supreme Court Clarifies the Scope of Copyright Protection for Features of Useful Articles

The Supreme Court's recent decision in *Star Athletica L.L.C. v. Varsity Brands, Inc.* clarifies that the original designs on useful articles, such as common household items and personal electronics, may be protected by copyright if they can be imagined separate and apart from the article, and if, when identified and imagined separately, would qualify as pictorial, graphic or sculptural works either on their own or when fixed in some other format (e.g., a painting or sculpture).

The Copyright Act provides that copyright protection is available for "pictorial, graphic or sculptural features" of the "design of a useful article" if those features "can be identified separately from, and are capable of functioning independently of, the utilitarian aspects of the design." 17 U. S. C. §101. However, application of this standard has been the subject of widespread disagreement. Indeed, at least nine separate tests were developed by different district courts to determine how a design feature may be "identified separately." Accordingly, the Supreme Court heard the case to clarify when a feature of a useful article is protectable under the Copyright Act.

The case was filed by Star Athletica when it sought a declaration that the chevron and stripe designs of Varsity Brands' cheerleading uniforms were not protectable under the Copyright Act. Star Athletica argued that the designs had a utilitarian function – namely, to identify

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cheerleaders as cheerleaders – and therefore should not be eligible for copyright protection. The district court agreed, and held that because the designs could not be separated from the uniform’s utilitarian function, they were not protectable. Reversing that decision, the Sixth Circuit found that designs could be identified separately from the uniform because they were not essential to the function of the underlying garment. *Star Athletica* appealed to the Supreme Court seeking clarity on the Copyright Act’s separability doctrine.

In its 6-2 decision ruling that Varsity Brands’ designs were protectable, the Supreme Court articulated a new test: a feature of a useful article is eligible for copyright protection if it (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) when imagined separately from the useful article, the original design would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium. *Star Athletica L.L.C. v. Varsity Brands, Inc.*, No. 15-866, 580 U.S. ___ at 1 (2017). In applying this standard, the Court upheld the Sixth Circuit’s decision, explaining that the “lines, chevrons and colorful shapes” on the uniforms were protectable because they are conceptually separate from the useful articles of clothing. The Court further explained that these “decorations” are no different than a mural painted on a wall or a design etched into a guitar. Because the decorations can be imagined in either medium, they are separable. Because they would qualify for copyright protection as a pictorial, graphic or sculptural work, if fixed in such a medium, the decorations are eligible for copyright protection as well.

The decision reaffirms that copyright protection continues to be a viable option for product designers across multiple disciplines. Previously, the circumstances in which a court would find features of a useful article to be protectable under copyright were unclear and inconsistent. In affirming that the Varsity Brands’



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cheerleading uniform designs could be copyrighted and articulating a new test, the Supreme Court has provided much needed guidance as to when copyright protection is available to features of product designs.

The Supreme Court's decision also underscores the competitive benefits of obtaining copyright protection and reminds product designers to include copyright protection in their intellectual property strategy. Because of the traditional uncertainty in copyright law with respect to features of useful designs, many product designers have traditionally focused their resources on obtaining other forms of protection through, for example, trade dress registrations and design patents. While these forms of protection are effective, they are often more expensive and difficult to obtain than copyright protection.

Unlike trade dress registrations and design patents, which can involve substantial fees and protracted prosecution at the Patent and Trademark Office, copyright protection arises automatically as soon as an original design is fixed in a tangible medium, and, when necessary, registration of a copyright is inexpensive and typically requires little, if any, formal prosecution. Moreover, unlike trade dress registrations (which require ongoing use to maintain) and design patents (which expire after 15 years), copyright protection outlives the author by 70 years (or 120 years from the creation date for anonymous works and works made for hire). In addition, copyrights endow their owners with the ability to enjoin others from making unauthorized copies of their designs, and from using the designs to make derivative works. Further, if timely registered, a copyright registration entitles the owner to statutory damages up to \$30,000 per work infringed, and up to \$150,000 per work in the context of willful infringement, which are deterrents to would-be infringers. The Supreme Court decision therefore affirms



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the viability and sometimes critical protections that
copyright provides product designs.