

Keywords: 17 USC §101, useful article, copyright eligibility, separability test

STAR ATHLETICA, LLC v. VARSITY BRANDS, Inc.

Supreme Court of the United States

Case Nos. 15-866

Decided March 22, 2017

I. Facts

Plaintiff Varsity Brands, Inc. (“Varsity”) sells cheerleading uniforms. Varsity has obtained or acquired more than 200 U. S. copyright registrations for two-dimensional designs appearing on the surface of their uniforms and other garments. Defendant Star Athletica, L. L. C. (“Star”), also markets and sells cheerleading uniforms. Varsity sued Star for infringing five of their copyrighted designs, i.e. Designs 299A, 299B, 074, 078, and 0815.



The District Court entered summary judgment for Star on Varsity’s copyright claims on the ground that the designs did not qualify as protectable pictorial, graphic, or sculptural works. It reasoned that the designs served the useful, or “utilitarian,” function of identifying the garments as “cheerleading uniforms” and therefore could not be “physically or conceptually” separated under §101 “from the utilitarian function” of the uniform. 2014 WL 819422, *8–*9 (WD Tenn., Mar. 1, 2014).

The Court of Appeals for the Sixth Circuit reversed. 799 F. 3d 468, 471 (2015). In its view, 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.” *Id.*, at 491.

II. Issues

1. Was the separability analysis necessary for determining copyright eligibility of a two dimensional graphic design that appear on useful article?
2. What is the appropriate separability test for determining copyright eligibility for design of a useful article?

III. Discussion

1. Yes. 17 U.S.C. §101 provides that “the design of a useful article, as defined in this section, 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.” The Court turned to a dictionary to define the terms of the statute. “Design” was found to mean “the combination” of “details” or “features” that “go to make up” the useful article. Furthermore, the words “pictorial” and “graphic” were found to include, in the present context, two-dimensional features such as pictures, paintings, or drawings. The Court also noted that the statute expressly defines “[p]ictorial, graphical, and sculptural works” to include “two dimensional . . . works of . . . art.” §101. The Court found that the statute thus provides that the “design of a useful article” can include two-dimensional “pictorial” and “graphic” features, and that, therefore, the separability analysis is applicable to those features, just as it is to three-dimensional “sculptural” features.

2. The appropriate test is: a 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. The Court noted that the first requirement—separate identification—is not onerous; it requires that 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. For the independent-existence requirement, the Court found that the decision maker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article (i.e., the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in §101 once it is imagined apart from the useful article.) The Court stated that if the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.

In the present case, the Court found that if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms of Varsity were separated from the underlying uniform and applied in another medium, for example, a painters canvas, they would qualify as two dimensional works of art under Section 101. Additionally, the Court noted that removal of the surface decorations at issue and applying them to another medium would not replicate the uniform itself (Varsity has applied their designs to different types of clothing without replicating uniforms). Therefore, the Court found that the decorations of Varsity are separable from their underlying uniforms and, accordingly, eligible for copyright protection. The Court also rejected the argument that the a useful article must remain after the artistic feature has been separated from the article and additionally rejected the argument that objective components to the test of separability should be added to guide lower courts (whether the design elements can be identified as reflecting artistic judgment exercised independently from functional influence and whether there is a substantial likelihood that the pictorial, graphic, or sculptural feature would still be marketable to some significant segment of the community without its utilitarian function), finding no grounding in the statute for these arguments.

IV. Conclusion

The Court affirmed the decision of the appellate court, holding that the designs on Varsity’s cheerleader uniforms are eligible for copyright protection.