

# A MISSED OPPORTUNITY: THE SUPREME COURT'S NEW SEPARABILITY TEST IN *STAR ATHLETICA*

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## I. INTRODUCTION

In *Star Athletica v. Varsity Brands*, the Supreme Court sought to fix one of the most troublesome areas of copyright law: § 101's separability test under the useful article doctrine.<sup>1</sup> The case concerned the designs on cheerleading uniforms—namely whether the chevrons, stripes, and lines adorning the uniforms were separable from the outfits.<sup>2</sup> In attempting to sort out the trouble with the useful article doctrine, the Supreme Court created a new test that reset the playing board and rid the circuits of their various tests.<sup>3</sup> However, as this Note will show, this new test will continue to create “uncertainty for creators, litigants, and judges”<sup>4</sup> because the Court's analysis was far too vague for future courts deciding the issue of separability.

In a majority opinion, the Supreme Court created a seemingly straightforward two-pronged separability test.<sup>5</sup> It held that an artistic feature of the design of a useful article could be copyrighted if 1) it “can be perceived as a two- or three-dimensional work of art separate from the useful article,” and 2) it “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.”<sup>6</sup> This holding purportedly focused on the two requirements in the 1976 Copyright Act for separability: separate identification and independent existence.<sup>7</sup> However, the holding fails to give sufficient guidance on how to apply the test,<sup>8</sup> and raises more questions than it answers.

Scholars are sharply divided when it comes to the *Star Athletica* decision.

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1. *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

2. *Id.* at 1007–08.

3. *Id.* at 1007.

4. Christopher Buccafusco & Jeanne C. Fromer, *Forgetting Functionality*, 166 U. PA. L. REV. ONLINE 119, 119 (2017), [http://scholarship.law.upenn.edu/cgi/viewcontent.cgi?article=1206&context=penn\\_law\\_review\\_online](http://scholarship.law.upenn.edu/cgi/viewcontent.cgi?article=1206&context=penn_law_review_online) [https://perma.cc/CAL4-QT9L].

5. *Star Athletica, LLC*, 137 S. Ct. at 1016.

6. *Id.*

7. *See* 17 U.S.C. § 101 (2012).

8. *See Star Athletica, LLC*, 137 S. Ct. at 1012.

Some believe it may infringe on other areas of intellectual property law,<sup>9</sup> while others praise the decision for its simplicity and possible move toward fashion design protection.<sup>10</sup> Finally, a third group believes this case was not the proper vehicle for simplifying the array of separability tests plaguing the circuits.<sup>11</sup>

Whatever scholars' positions may be, the new test creates layers of unpredictability. Under the new test, if one draws a plain picture of a shovel, one could not protect the useful article (the shovel) through copyright.<sup>12</sup> But, can one receive a copyright in an artistic aspect of that shovel, and thereby gain a copyright in the useful article as a whole? If the shovel had an intricate, sculpture-like handle or shovel head, can one receive a copyright in the shovel itself? In other words, can an artistic feature that is informed by the utilitarian features of a useful article be separated from the underlying useful article?<sup>13</sup> The answer is, unfortunately, unknown and perhaps even unpredictable at this time.

This Note argues that the Supreme Court failed to create a more unified separability test, and created the possibility of protecting utilitarian features of useful articles going forward. In order to avoid these problems, it should have laid out a more comprehensive separability analysis of Varsity Brands' designs when applying the new two-factor test. That way, lower courts would not have to grapple with vague and general language in determining how artistic features could be separated from the useful articles themselves. Further, this Note argues that, going forward, courts will have to keep in mind certain limiting principles that the dissent and the majority referred to when deciding cases where the pictorial, graphic, or sculptural (PGS) features are completely inseparable from the overall design of the useful article.

In Part II, this Note briefly discusses the background law surrounding the case—the useful article doctrine and the different tests circuits have come up

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9. See Peter S. Menell & Daniel Yablon, *Star Athletica's Fissure in the Intellectual Property Functionality Landscape*, 166 U. PA. L. REV. ONLINE 137, 137 (2017), <http://www.pennlawreview.com/online/166-U-Pa-L-Rev-Online-137.pdf> [<https://perma.cc/4b86-6C29>].

10. See generally David E. Shipley, *All for Copyright Stand Up and Holler! Three Cheers for Star Athletica and the U.S. Supreme Court's Perceived and Imagined Separately Test*, 36 CARDOZO ARTS & ENT. L.J. 149 (2018).

11. See Jane C. Ginsburg, *Courts Have Twisted Themselves into Knots: U.S. Copyright Protection for Applied Art*, 60 COLUM. J.L. & ARTS 1, 51 (2016).

12. See *Star Athletica*, 137 S. Ct. at 1013 n.2 (noting that one may not obtain a copyright in a shovel from a copyrighted picture of one, despite what Justice Breyer argued in his dissent).

13. For an example of a design that was informed by utilitarian needs, see *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (1987) (holding a PGS feature is conceptually separable if “the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences”).

with over the years. Part III examines the cases leading up to the Supreme Court's ruling, as well as the ruling itself—Justice Thomas' majority holding, Justice Ginsburg's concurring opinion, and Justice Breyer's dissenting opinion. Part IV turns to the aftermath of the opinion, and three very important aspects that have arisen since its release—namely, the worry about increased litigation and whether the test may be useful in simple cases, the overlap between copyright and design patent, and the possibility of copyright protecting functional aspects. In Part IV, this Note also discusses principles that courts should keep in mind to better apply the *Star Athletica* test. Part V concludes.

## II. THE USEFUL ARTICLE DOCTRINE AND BACKGROUND CASE LAW

This Part looks at the *Mazer* decision, the useful article doctrine, and the nine different tests circuits and scholars created to deal with copyright's separability issue. It also provides a way to classify these tests into two different categories—one focusing on creativity and one focusing on utility—so that the different approaches may be more easily understood.

### A. MAZER V. STEIN AND THE USEFUL ARTICLE DOCTRINE

The useful article doctrine was created under the 1909 Copyright Act in the Supreme Court case of *Mazer v. Stein*,<sup>14</sup> and codified in the 1976 Copyright Act.<sup>15</sup> In *Mazer*, the Supreme Court held that a ballerina lamp base, though initially designed for a useful article,<sup>16</sup> could be copyrighted.<sup>17</sup> In doing so, it created the separability analysis, in which PGS features of useful articles could be copyrighted so long as they could be identified separately and exist independently from the underlying useful articles.<sup>18</sup> The theory behind the

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14. *Mazer v. Stein*, 347 U.S. 201, 213 (1954).

15. *See generally* 17 U.S.C. § 101 (2012).

16. *See id.* (“A ‘useful article’ is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article.’”).

17. *See Mazer*, 347 U.S. at 218:

We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration . . . Nor do we think the subsequent registration of a work of art published as an element in a manufactured article, is a misuse of the copyright.

18. 17 U.S.C. § 101 (2012) states:

[T]he 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.

holding was that it did not matter whether the aesthetic features were first created as part of a useful article or reproduced on a useful article; the features were still copyrightable so long as they could be separated.<sup>19</sup>

Congress codified this holding in the 1976 Copyright Act<sup>20</sup> and recognized there were two different ways in which courts could separate the PGS features from the useful articles: physically and conceptually.<sup>21</sup> This is important because after *Mazer* and its codification, there was uncertainty. The *Mazer* Court had failed to outline a standard separability test or provide detailed reasoning behind its conclusion that the statuettes were separate from the lamps.<sup>22</sup> As a result, each circuit developed a different approach to interpreting the statute and determining whether a design feature was separable from a useful article.<sup>23</sup>

#### B. THE NINE DIFFERENT TESTS FOR DETERMINING SEPARABILITY

To better understand this confusion surrounding the useful article doctrine, we must delve into the nine different tests used by circuit courts and

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19. *See Mazer*, 347 U.S. at 218:

We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration . . . Nor do we think the subsequent registration of a work of art published as an element in a manufactured article, is a misuse of the copyright.

20. *See* 17 U.S.C. § 101 (2012):

‘Pictorial, graphic, and sculptural works’ include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; 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.

21. *See* *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1031 (2017) (Breyer, J., dissenting) (citing H. R. REP. NO. 94-1476 (1976)).

22. *See Mazer*, 347 U.S. at 218:

We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration . . . Nor do we think the subsequent registration of a work of art published as an element in a manufactured article, is a misuse of the copyright.

23. *See* *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484–85 (6th Cir. 2015) (describing nine different tests circuits and scholars came up with to deal with the useful article doctrine).

proposed by scholars before the Supreme Court decided *Star Athletica*. Articulated by the Sixth Circuit’s decision leading up to *Star Athletica*, these tests are: 1) the Copyright Office Approach;<sup>24</sup> 2) the Primary-Subsidiary Approach;<sup>25</sup> 3) the Objectively Necessary Approach;<sup>26</sup> 4) the Ordinary-Observer Approach;<sup>27</sup> 5) the Design Process Approach;<sup>28</sup> 6) the Stand-Alone Approach;<sup>29</sup> 7) the Likelihood-of-Marketability Approach;<sup>30</sup> 8) Patry’s Approach;<sup>31</sup> and 9) the Subjective-Objective Approach.<sup>32</sup> Additionally,

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24. *See id.* at 484 (citing U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2(B) (3d ed. 2014)) (“A pictorial, graphic, or sculptural feature satisfies [the conceptual-separability] 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.”).

25. *See id.* (citing *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (holding that a belt buckle was copyrightable because “the artistic features of the design [were] ‘primary’ to the ‘subsidiary utilitarian function’ ”).

26. *See id.* (citing *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985)) (a PGS “feature is conceptually separable if the artistic features . . . are not necessary to the performance of the utilitarian function of the article”).

27. *See id.* (citing *Carol Barnhart, Inc.* 773 F.2d at 422 (Newman, J. dissenting)) (a PGS “feature is conceptually separable if ‘the design creates in the mind of the ordinary[, reasonable] observer two different concepts that are not inevitably entertained simultaneously’ ”).

28. *See id.* (citing *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987)) (a PGS “feature is conceptually separable if ‘the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences’ ”).

29. *See id.* (citing *Pivot Point Int’l, Inc. v. Charlene Prods.*, 372 F.3d 913, 934 (7th Cir. 2004) (Kanne, J. dissenting)) (a PGS “feature is conceptually separable if ‘the useful article’s functionality remain[s] intact once the copyrightable material is separated’ ”).

30. *See id.* (citing *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005)) (a PGS “feature is conceptually separable if ‘there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities’ ”).

31. *See id.* at 484–85 (citing 2 PATRY ON COPYRIGHT §§ 3:145, 3:146 (2015)) (Courts do not need to engage in a separability analysis if: “(A) the work is the design of a three-dimensional article, and (B) the design is not of a ‘useful article.’ ” Furthermore, the focus should be on whether the PGS aspects “are separable from the ‘utilitarian aspects’ of the article, not the ‘article’ because the ‘protected features need not be capable of existing apart from the article, only from its functional aspects’ ”).

32. *See id.* at 485 (citing Barton R. Keyes, *Note: Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L.J. 109, 141 (2008)) (“Conceptual separability is determined by balancing (A) ‘the degree to which the designer’s subjective process is motivated by aesthetic concerns’; and (B) ‘the degree to which the design of a useful article is objectively dictated by its utilitarian function.’ ” Furthermore, “[i]f the design of the useful article ‘is mostly dictated by function,’ then that fact ‘weigh[s] against conceptual separability, and therefore, against copyright protection.’ ”).

although the Sixth Circuit never explicitly stated as such,<sup>33</sup> the test it created was a hybrid approach, effectively increasing the number of possible separability tests to at least ten.<sup>34</sup>

Although the number of separability tests associated with the useful article doctrine may seem quite daunting, these tests fall into either one of two separate categories. Depending on the test used, a court focused on creativity and the artistic PGS features, or function and the useful article's utilitarian aspects.<sup>35</sup> In other words, the tests can be separated into a creative category and a utilitarian category. Separating the previous tests in this manner allows us to easily categorize the multitude of approaches to separability under the useful article doctrine for this Note and helps to better understand the focus of *Star Athletica's* test.<sup>36</sup>

The first category focuses on the creative aspects of the useful article itself. These tests asked courts to look at factors such as whether an ordinary observer could see a PGS work apart from the useful article (the Ordinary-Observer Approach), whether the PGS features would be marketable by themselves (the Likelihood of Marketability Approach), whether the artistic features were the primary appeal to the useful article (the Primary-Subsidiary Approach), and whether the artistic features could stand alone apart from the useful article once separated (the Copyright Office Approach).<sup>37</sup> Each of these tests emphasized an examination of the creative PGS features of the design of a useful article when determining separability.<sup>38</sup> Put another way, these tests placed much greater weight on the art and artistic judgment of creators than on the utility of a useful article.<sup>39</sup>

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33. *Id.* at 487–88.

34. *Id.*; see also Alexandra Spina, *Varsity Brands, Inc. v. Star Athletica, LLC*, 61 N.Y.L. SCH. L. REV. 239, 245 (2016).

35. See *infra* notes 38 & 40. For another way to separate these tests, see Larry C. Russ & Nathan D. Meyer, *Fashion Forward*, 40 L.A. LAW. 20, 22 (2017) (noting similarly that the nine tests focus on “(1) whether the artistic work and the useful article could be conceptually separated with one part surviving (conceptually) as a useful article and the element as an artistic work, or 2) whether there were aspects of the design of the useful article that were not dictated by function”).

36. See Russ, *supra* note 35, at 22.

37. See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484–85 (6th Cir. 2015); see also *supra* notes 24, 25, 27, 30. Each of these tests focuses on the PGS features, in other words, whether an ordinary observer could see the PGS work apart from the utilitarian article, whether the PGS features would be marketable by itself if it had no utilitarian function, or whether the PGS features could be removed from the utilitarian article without destroying the usefulness of said article. In essence, they all focus on the creative aspects of the useful articles.

38. See *id.*; see also Russ, *supra* note 35, at 22.

39. See *Varsity Brands, Inc.*, 799 F.3d at 484–85; see also *supra* notes 24, 25, 27, 29, 30; Case Comment, *Copyright Act of 1976—Useful Articles—Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 131 HARV. L. REV. 363, 368–69 (2017) [hereinafter *Copyright Act of 1976—Useful Articles*].

On the other hand, the second category focuses on the utilitarian aspects of the useful article. The tests within this category asked a court to determine such things as whether or not removing the PGS features left the utilitarian aspects of the useful article intact (Stand Alone Approach), whether the artistic design fit the utilitarian function (Design Process Approach), whether the artistic features were necessary for the function of the useful article (Objectively Necessary Approach), or whether the designer's process was influenced by concerns with the useful article's functionality (Subjective-Objective Approach).<sup>40</sup> Each of these tests placed much more emphasis in examining the utilitarian aspects of the article rather than the separable PGS features.<sup>41</sup> Put another way, the ultimate focus of these tests was function and utility, not art or artistic judgment.<sup>42</sup>

Although the overall inquiry required courts to examine both the PGS features (creativity) and the useful article (utility), these tests forced a court to focus on one or the other.<sup>43</sup> As a result, the analysis of useful articles was subjective, and ultimately up to each court's discretion.<sup>44</sup> For instance, the creative category of tests allowed courts to use their subjective artistic judgment when deciding separability cases<sup>45</sup> by examining such things like the primary function of a useful article,<sup>46</sup> or whether the PGS features could be marketable to a large section of the public when detached from the useful article.<sup>47</sup> The problem with these types of tests, as the Sixth Circuit alluded to in its decision, is that focusing on artistic features “[privilege] a judge’s personal taste” and are “often based entirely on conjecture.”<sup>48</sup>

Conversely, the utilitarian category of tests asked courts to determine the

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40. See *Varsity Brands, Inc.*, 799 F.3d at 484–85; see also *supra* notes 26, 28, 29, and 32. For instance, each of these tests focus on whether form fits function, such as the *Brandir* bicycle rack, or whether the PGS features are necessary to the performance of the utilitarian function (with a focus on the utilitarian function). In essence, each of these examples focus on the utilitarian function of the work itself—not the creative aspects part of the article.

41. See *id.*

42. See *id.*

43. For a discussion of issues with subjectivity and the types of separability tests before *Star Athletica*, see *Copyright Act of 1976—Useful Articles*, *supra* note 39, at 369.

44. See *id.* at 369–70.

45. See *id.* at 368–69.

46. See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (holding that a belt buckle was copyrightable because the artistic features of the design were “primary” to the “subsidiary utilitarian function”).

47. See *Varsity Brands, Inc.*, 799 F.3d at 484–85 (citing *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005)) (a PGS “feature is conceptually separable if ‘there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities’”).

48. See *id.* at 489.

actual function of the useful article itself.<sup>49</sup> While perhaps seemingly more objective than those in the creative category, these tests were just as subjective. Take, for instance, the *Varsity Brands* series of cases leading to *Star Athletica*. While the District Court held the designs to be part of the utilitarian features of the cheerleading uniforms because they informed onlookers that the person wearing the uniform was a cheerleader,<sup>50</sup> the Sixth Circuit held that the utilitarian features were limited to “cover[ing] the body,” “wick[ing] away moisture,” and permitting free movement.<sup>51</sup> Interestingly, the dissenting opinion in the Sixth Circuit argued that a broader definition of function was required when dealing with the cheerleading uniforms at issue.<sup>52</sup> As discussed below, even the Supreme Court seemed to have difficulty with this issue and punted it in *Star Athletica*.<sup>53</sup>

With this large number of tests, each of which approached the useful articles differently, it is no wonder why the conceptual separability test “continue[d] to flummox federal courts” since its codification.<sup>54</sup> The question the Supreme Court had to answer in *Star Athletica* was whether any of these previous tests were the proper test for the separability analysis, or whether the circuits needed a new, more standardized, and consistent test.<sup>55</sup> As will be shown below, the *Star Athletica* test falls fully into the creative category, as it focuses solely on the PGS features of the useful article and seemingly forgoes any focus on the useful aspects of a useful article.<sup>56</sup>

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49. See *Copyright Act of 1976—Useful Articles*, *supra* note 39, at 369–70.

50. *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422 at \*23–24 (W.D. Tenn. Mar. 1, 2014); see also *Varsity Brands, Inc.*, 799 F.3d at 475.

51. See *Varsity Brands, Inc.*, 799 F.3d at 490–91.

52. *Id.* at 495 (McKeague, J., dissenting) (“It follows that the stripes, braids, and chevrons on a cheerleading uniform are integral to its identifying function.”).

53. See *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1013–14 (2017) (“The debate over relative utility of a plain white cheerleading uniform is unnecessary. The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction.”).

54. *Galiano v. HARRAH’s Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005).

55. See Lili Levi, *The New Separability* at 2–4 (Univ. of Miami Legal Studies Research Paper No. 17-28, 2017), <https://ssrn.com/abstract=3044830>, [<https://perma.cc/P5AE-SC2D>].

56. According to the Supreme Court in *Star Athletica, LLC*, 137 S. Ct. at 1013: The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a non-useful pictorial, graphic, or sculptural work on its own.

### III. *STAR ATHLETICA V. VARSITY BRANDS*

This Part delves into the Supreme Court's decision in *Star Athletica v. Varsity Brands* by examining the lower courts' rulings, the Supreme Court majority's decision and the reasoning behind it, and, finally, Justice Ginsburg's concurring opinion as well as Justices Breyer and Kennedy's dissenting opinion.

#### A. THE ROAD TO *STAR ATHLETICA*

Varsity Brands designs, makes, and sells cheerleading uniforms.<sup>57</sup> Before *Star Athletica*, it owned over two hundred U.S. copyright registrations for two-dimensional designs that appeared on the surface of cheerleading uniforms.<sup>58</sup> These designs were usually composed of a combination of chevrons, angles, diagonals, stripes, lines, and curves.<sup>59</sup> *Star Athletica* was also in the business of selling and marketing cheerleading uniforms.<sup>60</sup>

Varsity Brands brought a suit against *Star Athletica* in the Western District of Tennessee alleging *Star Athletica* infringed five of their copyrighted designs.<sup>61</sup> The district court held the designs were inseparable from the useful articles.<sup>62</sup> In doing so, the district court reasoned that a blank cheerleading uniform lost its utility when it lacked surface designs.<sup>63</sup> Therefore, it was not possible to physically or conceptually separate the copyrighted designs from the uniforms because they were a fundamental part of the cheerleading uniforms' function by portraying those who wore them as cheerleaders.<sup>64</sup> As a result, the district court granted *Star Athletica*'s cross-motion for summary judgment on the copyright claims.<sup>65</sup>

However, the Sixth Circuit reversed, holding that the designs were separable from the underlying uniforms.<sup>66</sup> Noting that its sister circuits had used nine different approaches to determine whether a PGS feature was conceptually separable from the utilitarian aspects of a useful article, it then came up with one of its own.<sup>67</sup> The Sixth Circuit adopted an approach asking a series of questions aimed at whether there were pictorial, graphic, or

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57. *Id.* at 1007.

58. *Id.*

59. *Id.*

60. *Id.*

61. *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422 at \*1–2 (W.D. Tenn. March 1, 2014).

62. *Id.* at \*8–9.

63. *Id.*

64. *Id.*

65. *Id.* at \*9–10.

66. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 471 (6th Cir. 2015).

67. *Id.* at 487.

sculptural features that existed on a useful article with utilitarian or functional aspects.<sup>68</sup> If there were PGS features, the court went on to ask whether those features were required for the functioning of the useful article or were ultimately unnecessary to its utilitarian performance.<sup>69</sup> Rejecting the district court's holding that the designs were "inextricably intertwined with the utilitarian aspects of a cheerleading uniform," the Sixth Circuit noted that such a holding would "render nearly all artwork unprotectable."<sup>70</sup> As a result, the Sixth Circuit held that the designs were separable from the cheerleading uniforms and reversed and remanded the case.<sup>71</sup> Star Athletica then appealed this decision to the Supreme Court, which granted certiorari.<sup>72</sup>

#### B. MAJORITY HOLDING

The Supreme Court granted certiorari to, in its own words, "resolve widespread disagreement over the proper test for implementing" the separability analysis of § 101.<sup>73</sup> The Court looked to both the plain language of the statute as well as the history of the Copyright Act to create a new § 101 separability test.<sup>74</sup> The Court noted that the combination of § 101 and § 113(a)<sup>75</sup> ensures that "copyright protection extends to pictorial, graphic, and sculptural works regardless of whether" they were created as features of useful articles or as standalone works of art.<sup>76</sup> Given this understanding of the statute, the ultimate question for the Court was "whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article."<sup>77</sup> The Court formulated a test in which:

[A] feature incorporated into the design of a useful article is eligible for copyright protection only 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 pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of

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68. *Id.*

69. *Id.* at 488.

70. *Id.* at 490–91.

71. *Id.* at 491–92.

72. *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

73. *Id.*

74. *Id.* at 1010–11; *see also* 17 U.S.C. § 101 (2012).

75. *Star Athletica, LLC*, 137 S. Ct. at 1010–11; *see also* 17 U.S.C. § 113(a) (2012) ("Subject to the provisions of subsection (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.").

76. *Star Athletica, LLC*, 137 S. Ct. at 1010–11.

77. *Id.* at 1011.

expression—if it were imagined separately from the useful article into which it is incorporated.<sup>78</sup>

The majority created a test that focuses on the creative aspects of a utilitarian article. As long as the design of a useful article is capable of being perceived as a work of art separate from the useful article and would qualify as a PGS work “on its own or fixed in some other tangible medium of expression,” it is separable from the useful article.<sup>79</sup> In other words, *Star Athletica* asks a court to simply look at the artistic PGS features without much regard to the utilitarian features of a useful article.<sup>80</sup>

In a “straightforward” analysis applying the new test, the Court held the “decorations” were separable from the uniforms in question.<sup>81</sup> The Court noted that the first part of the test, separate identification, was not hard to overcome.<sup>82</sup> In its analysis of the designs at hand, the Court reasoned that “one can identify the decorations as features having pictorial, graphic, or sculptural qualities” and that “imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself.”<sup>83</sup> That comprises the entirety of the majority’s analysis of Varsity Brands’ designs at issue in *Star Athletica*.

Furthermore, the Court rejected both *Star Athletica*’s and the dissent’s arguments that the designs were not separable because trying to separate the designs from the uniforms created a picture of a cheerleader uniform.<sup>84</sup> The Court instead noted that “two-dimensional applied art” necessarily “correlates to the contours of the article on which it is applied.”<sup>85</sup> It likened the designs on the cheerleading uniforms to a fresco on a wall or a design “etched or painted” on a guitar.<sup>86</sup> These examples are easy to understand because both are two-dimensional works that “correspond[] to the shape of the useful article to which they are applied,” but are still capable of existing apart from the useful articles themselves.<sup>87</sup>

Under the Supreme Court’s new test, separability hinges on whether the feature would have been eligible as a PGS work had it been originally fixed in

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78. *Id.* at 1007.

79. *Id.*

80. *Id.*; see also *supra* Section II.B, text accompanying notes 37–42.

81. *Star Athletica, LLC*, 137 S. Ct. at 1012.

82. *Id.* at 1010 (“The first requirement—separate identification—is not onerous. The decisionmaker 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.”).

83. *Id.*

84. *Id.*

85. *Id.*

86. *Id.*

87. *Id.*

some other medium than a useful article. The test is simple for two-dimensional designs.<sup>88</sup> For instance, as the Court noted, an artistic print design on the surface of a guitar is easily separated from the underlying useful article itself.<sup>89</sup> Circuit courts will most likely find the issue of separability very straightforward in such a case.<sup>90</sup>

However, determining the separability of a three-dimensional feature of a useful article that has some functionality will be more difficult for courts.<sup>91</sup> Put aside the guitar from the Court majority's dicta,<sup>92</sup> and examine one of the hardest separability cases prior to *Star Athletica: Brandir International*.<sup>93</sup> As discussed in Part II, the court in *Brandir* held the PGS features of the ribbon bike rack were not separable from the utilitarian aspects.<sup>94</sup> That case was difficult because the artistic design was completely intertwined with the overall function of the useful article.<sup>95</sup> If a court were to apply the *Star Athletica* test to the ribbon rack, it could conceivably go either way in its analysis.<sup>96</sup> Under the first step of the Court's new test, the ribbon rack can be perceived as a separate PGS work because a lay observer can imagine the ribbon bike rack as a PGS work in and of itself. Second, if drawn or created in a separate medium, it would be protectable as a PGS work. Therefore, the bike rack could pass the separability test and receive copyright protection in its useful aspects.<sup>97</sup> One of the more prominent issues scholars have pointed out is this very problem—the uncertainty regarding three-dimensional designs in the majority's test might extend copyright protection to a useful article's utilitarian features,<sup>98</sup> as the example above demonstrates.

### C. JUSTICE GINSBURG'S CONCURRENCE

In her concurring opinion, Justice Ginsburg argued that the Court should not have reached the separability issue.<sup>99</sup> Justice Ginsburg noted that the designs at issue were “not designs of useful articles,” but instead PGS works

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88. See Shipley, *supra* note 10, at 153.

89. See *Star Athletica, LLC*, 137 S. Ct. at 1012.

90. See Shipley, *supra* note 10, at 153.

91. See *id.*

92. *Star Athletica, LLC*, 137 S. Ct. at 1012.

93. See *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (1987) (holding a PGS feature is conceptually separable if “the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences”).

94. See *id.*

95. See *id.*

96. See *Star Athletica*, 137 S. Ct. at 1012; see also *Brandir Int'l, Inc.*, 834 F.2d at 1145.

97. See *Star Athletica, LLC*, 137 S. Ct. at 1016.

98. See Shipley, *supra* note 10, at 173–74.

99. *Star Athletica, LLC*, 137 S. Ct. at 1019 (Ginsburg, J., concurring).

“reproduced on useful articles.”<sup>100</sup> Therefore, there was no need for the Court to address separability because the owner of a copyright in a PGS work can reproduce the work in or on any medium they so desire without losing protection.<sup>101</sup> Her concurrence follows the advice of her daughter, Professor Jane C. Ginsburg, who similarly argued that *Star Athletica* did not involve designs of useful articles, but designs reproduced on useful articles.<sup>102</sup> To her, *Star Athletica* was an inappropriate case to rule on such a problematic issue that had troubled courts for decades.<sup>103</sup>

If the majority had followed Justice Ginsburg’s concurrence, *Star Athletica* would have been a Supreme Court decision on PGS works reproduced on useful articles—not a redrawing of the separability test that has plagued the circuit courts.<sup>104</sup> Justice Ginsburg’s approach would have ultimately maintained the anarchy of having multiple circuit tests, but it also might have saved the issue of separability for another, perhaps better, case for the Supreme Court to more thoroughly address this thorny and problematic issue.<sup>105</sup>

#### D. DISSENT

Justice Breyer, joined by Justice Kennedy, dissented, arguing that the designs were not separable from the cheerleading uniforms.<sup>106</sup> Breyer reasoned that applying the majority’s test to Varsity’s designs resulted in an unprotectable work because Varsity’s designs were not capable of being physically or conceptually separated from the underlying useful article.<sup>107</sup> Justice Breyer argued that the majority saw Varsity’s designs as something completely different than what they were.<sup>108</sup> To him, the designs did not simply depict designs; they depicted articles of clothing.<sup>109</sup> In Justice Breyer’s mind, Varsity wanted to protect “the design and cut of the dresses by seeking to

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100. *Id.* at 1018.

101. *See id.* (citing 17 U.S.C. § 113(a) (2012)).

102. *See* Ginsburg, *supra* note 11, at 24.

103. *See id.* (“A PGS work applied to (‘reproduced on’) a useful article is not itself a useful article, and courts need not ‘twist themselves into knots’ endeavoring to parse the meaning of the statutory separability standard.”).

104. *See Star Athletica, LLC*, 137 S. Ct. at 1019–20 (Ginsburg, J., concurring).

105. *Id.*; *see also supra* note 11 at 24.

106. *Star Athletica, LLC*, 137 S. Ct. at 1030 (Breyer, J., dissenting).

107. *Id.* at 1032–33.

108. *Id.* at 1036.

The majority imagines that Varsity submitted something different—that is, only the surface decorations of chevrons and stripes, as in a textile design. As the majority sees it, Varsity’s copyright claim would be the same had it submitted a plain rectangular space depicting chevrons and stripes, like swaths from a bolt of fabric. But considered on their own, the simple stripes are plainly unoriginal.

109. *Id.*

protect surface decorations whose ‘treatment and arrangement’ are *coextensive with that design and cut*.”<sup>110</sup> He warned the Court that it had “lost sight of its own important limiting principle” because copyrights in a useful article cannot be claimed by simply creating a replica in some other medium.<sup>111</sup>

The dissent’s argument suggests the majority’s holding will allow creators to copyright previously uncopyrightable designs of useful articles.<sup>112</sup> Some scholars and practitioners have agreed with this contention.<sup>113</sup> However, others have disagreed and predicted that the new test will not lead to many changes in the current landscape of protection for designs of useful articles.<sup>114</sup> Whatever impact the test may have on the copyrightability of useful articles, the majority’s holding is extremely vague. The dissent’s application of the test already demonstrates that courts will create and contend with varying interpretations of the same test going forward.<sup>115</sup>

#### E. IMPLICATIONS AND CHANGES IN THE LEGAL LANDSCAPE

*Star Athletica* deceptively simplifies the useful article doctrine’s separability test. The test itself has two prongs: whether the claimed aesthetic features can be perceived as a work of art separate from the useful article, and whether they would qualify as a PGS work if imagined in some separate medium of expression.<sup>116</sup> The Court noted the first prong, separate identification, is not particularly difficult to overcome.<sup>117</sup> However, the Supreme Court offered very little in terms of substantial analysis when applying the first prong to the cheerleading uniforms.<sup>118</sup> The Court simply noted that it could identify the aesthetic features as having PGS qualities.<sup>119</sup> Not onerous, indeed. Despite the Supreme Court’s contention that the first prong can be easily applied, other courts will have to grapple with several questions, including how best to

110. *Star Athletica, LLC*, 137 S. Ct. at 1036 (Breyer, J., dissenting). For a critique on this argument, see Menell & Yablon, *supra* note 9, at 138–39.

111. *Star Athletica, LLC*, 137 S. Ct. at 1036 (Breyer, J., dissenting).

112. *See id.*

113. *See generally* Shipley, *supra* note 10, at 150 nn. 2, 3, & 4 (discussing several practitioners’ opinions on the case’s new test and potential outcome for the useful article doctrine’s application to fashion designs and useful articles).

114. *Id.*

115. *See Star Athletica, LLC*, 137 S. Ct. at 1036 (Breyer, J., dissenting); *see also* Levi, *supra* note 55, at 21.

116. *Star Athletica, LLC*, 137 S. Ct. at 1016.

117. *See id.* at 1010 (“The first requirement—separate identification—is not onerous. The decisionmaker 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.”).

118. *See id.* at 1012 (“First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities.”).

119. *See id.*

recognize PGS features, what the purpose of the first prong really is, and which types of features of a design of a useful article are inherently not able to satisfy the first prong.<sup>120</sup>

The second prong is much more problematic for courts going forward because of the extreme uncertainty it creates. The Court noted that the second prong, independent existence, is much harder to overcome.<sup>121</sup> To satisfy this prong, the aesthetic features must be able to exist as a PGS work separate from the utilitarian aspects of the useful article.<sup>122</sup> Applying this prong of the test to cheerleader uniforms seemed relatively straightforward because the designs were easily imagined in another medium.<sup>123</sup> Perhaps what made the Court's analysis so simple was the fact that the designs at issue were two-dimensional aesthetic features applied to useful articles, not three-dimensional features intertwined with the utilitarian aspects.<sup>124</sup> Once again, the Court's analysis fell short in terms of substantially explaining how to apply the test.<sup>125</sup> For instance, the Court noted the surface design arrangements could be imagined on some other medium of expression.<sup>126</sup> Therefore, the designs at issue were separable from the useful articles.<sup>127</sup> The vague and ill-explained reasoning will most likely cause inconsistent results across the circuits once more.<sup>128</sup> This is especially true because the majority's test can be subject to a broad range of interpretations.<sup>129</sup>

With *Star Athletica*, the Supreme Court not only “supposedly simpl[ified]” the separability test, it also erased the existing multitude of tests across the circuit courts.<sup>130</sup> Where the circuit courts distinguished between physical and conceptual separability, the Supreme Court opted instead for an overall conceptual inquiry.<sup>131</sup> In so doing, the Court rejected the distinction between physical and conceptual separability of the useful article's features.<sup>132</sup> It also rejected the previous separability tests of the circuit courts that focused on the

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120. See Levi, *supra* note 55, at 19–21 (discussing the problems, concerns, and possible questions courts may have going forward regarding the first prong).

121. *Star Athletica, LLC*, 137 S. Ct. at 1010.

122. See *id.*

123. See *id.* at 1012.

124. See *id.* at 1012–13.

125. See *id.*; see also Levi, *supra* note 55, at 21–24.

126. See *Star Athletica, LLC*, 137 S. Ct. at 1012.

127. See *id.*

128. Levi, *supra* note 55, at 21.

129. See *id.* at 21; see also *Star Athletica, LLC*, at 1012–13 (referring to the dissent's contention that the designs were not separable because imagining the designs in a separate medium resulted in the useful articles themselves).

130. See Levi, *supra* note 55, at 15.

131. See *id.* at 17–19; see also *Star Athletica, LLC*, 137 S. Ct. at 1014.

132. See Levi, *supra* note 55, at 17–19.

remaining useful article itself, choosing to move the focus entirely to the perceived PGS features once they were separated from the useful articles.<sup>133</sup> As Professor Levi notes, courts will now have to focus on the claimed aesthetic features of the useful article itself—not on the marketability, functional considerations, or primary artistic appeal of the useful articles.<sup>134</sup> Furthermore, erasing the previous precedents creates another important problem for courts going forward—there is no guidance or precedent for courts to use when determining how to apply the *Star Athletica* separability test.<sup>135</sup> Given the opposing interpretations of the test within the case itself,<sup>136</sup> it is likely the test will yield inconsistent results.<sup>137</sup>

#### IV. AFTERMATH OF THE OPINION

In the weeks following *Star Athletica*'s publication, a spate of lawyers and commentators argued vehemently about whether the opinion created a sound and consistent test. Both scholars and practitioners entered the fray, arguing for and against the new test. A few argued the opinion completely changed the legal landscape surrounding the useful article doctrine. Others argued the new test allows for a broader spectrum of copyrightability in useful articles.<sup>138</sup> A third group argued the new test may infringe on other aspects of intellectual property, such as design or utility patents.<sup>139</sup> This Part first examines current cases that grappled with or are currently grappling with the *Star Athletica* test. This Part then turns to the three biggest implications of the new test, and the problems courts will face going forward.

##### A. PARALLELS BETWEEN THE PREDICTIONS MADE AND CURRENT CASES

In the year since the Supreme Court decided *Star Athletica*, only a small smattering of cases have brought up the separability issue—one of which tacked on a copyright infringement claim to an existing design patent complaint. Most, however, have analyzed the test at a very surface level and

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133. See Levi, *supra* note 55, at 15–16; see also *Star Athletica, LLC*, 137 S. Ct. at 1013–14.

134. See Levi, *supra* note 55, at 16–17.

135. See *id.* at 14–15.

136. *Star Athletica, LLC*, 137 S. Ct. at 1012–13 (referring to the dissent's contention that the designs were not separable because imagining the designs in a separate medium resulted in the useful articles themselves).

137. See Levi, *supra* note 55, at 14–15.

138. See Gene Quinn & Steve Bachmann, *Copyrights at the Supreme Court: Star Athletica v. Varsity Brands, IPWATCHDOG* (March 22, 2017), [www.ipwatchdog.com/2017/03/22/copyrights-supreme-court-star-athletica-v-varsity-brands/id=79767/](http://www.ipwatchdog.com/2017/03/22/copyrights-supreme-court-star-athletica-v-varsity-brands/id=79767/) [https://perma.cc/D84F-F9EF] (citing practitioner responses to *Star Athletica*'s holding).

139. See Menell & Yablon, *supra* note 9, at 137.

granted summary judgment on copyright separability issues.

1. *Applying the New Test in New Cases*

As noted above, scholars disagree about the implications of this new ruling on the useful article doctrine and copyright law going forward. Some argue the test simplifies the existing landscape while others argue the test creates more questions than answers. For instance, Professor David Shipley believes the new test “brings uniformity” and “should be relatively easy to apply” when it comes to pictorial or graphic works.<sup>140</sup> He believes the test could expand copyright protection where it was denied in the past.<sup>141</sup> For Shipley, the problem with the test is the difficulty in applying it to sculptural features on useful articles.<sup>142</sup> However, Professor Lee Burgunder takes issue with the Court’s new test because it fails to guide judges implementing this test in the future.<sup>143</sup> Indeed, he argues that the test itself will require judges to create even more tests to resolve this lack of guidance.<sup>144</sup> Similarly, Professor Lili Levy argues that courts will have a troublesome time with the second prong of the test because it is susceptible to opposite interpretations.<sup>145</sup> To her, the Court’s new test will be problematic going forward because courts will either apply it extremely liberally or conservatively depending on their subjective methodology.<sup>146</sup> Perhaps confirming Professor Shipley’s predictions about the application of *Star Athletica*’s test to simple two- and three-dimensional designs, courts have already applied the test with relative ease to straightforward cases.

Soon after the Supreme Court decided *Star Athletica*, the District Court for the Central District of Illinois reconsidered a partial summary judgment order in a copyright infringement case in light of *Star Athletica*.<sup>147</sup> At issue was the

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140. Shipley, *supra* note 10, at 151.

141. *See id.* at 167–71, 171–74. More specifically, Professor Shipley revisits (somewhat) *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120 (2d Cir. 1998), *Pivot Point Int’l, Inc. v. Charlene Prods.*, 372 F.3d 913 (7th Cir. 2004), *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985), *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), and, finally, *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

142. *See* Shipley, *supra* note 10, at 151.

143. Lee Burgunder, *Does Star Athletica Raise More Questions Than it Answers?*, IPWATCHDOG (April 13, 2017), <http://www.ipwatchdog.com/2017/04/13/star-athletica-raise-questions-answers/id=81977> [<https://perma.cc/7CCU-MGSC>].

144. Lee Burgunder, *District Court Applies New Supreme Court Product Design Standard to Light Bulbs*, IPWATCHDOG (September 19, 2017), <http://www.ipwatchdog.com/2017/09/19/district-court-applies-new-product-design-standard-light-bulbs/id=87667/> [<https://perma.cc/GH27-Q5ZL>].

145. *See* Levi, *supra* note 55, at 21.

146. *See id.*

147. *Design Ideas, Ltd. v. Meijer, Inc.*, No. 15-cv-03093, 2017 U.S. Dist. LEXIS. 94489 (C.D. Ill. June 20, 2017).

copyright to a clothespin clip that had “a silhouetted bird design on top.”<sup>148</sup> In the original motion for summary judgment, the court had applied the separability test under the law at the time and found that the bird design was “both physically and conceptually separable from the utilitarian aspect of the work.”<sup>149</sup> In light of the new standard set forth by *Star Athletica*, the district court again found that the bird design on the clothespin was separable from the underlying useful article.<sup>150</sup> The bird design could 1) be “perceived as a three-dimensional work of art separate from the useful article,” and 2) “qualify as a protectable sculptural work on its own if it were imagined separately from the useful article.”<sup>151</sup>

The defendant argued that the bird design on top of the clothespin was useful because the clothespin could be hung from a variety of places using the bird’s beak.<sup>152</sup> The district court rejected this argument because, in its own words, “what is the usefulness of hanging the bird from a rod or hanging the bird on a string by its beak?”<sup>153</sup> Therefore, the district court’s original ruling was still valid under the new *Star Athletica* separability test.<sup>154</sup>

This case represents a relatively simple application of *Star Athletica*’s new separability test to a three-dimensional feature. For instance, the bird on the clothespin was easily separable from the useful article.<sup>155</sup> The sculptural bird statuette was not integrated with the form or function of the clothespin and only sat on top.<sup>156</sup> As a result, the court was able to do a simple and straightforward surface level analysis to hold that it was separable.<sup>157</sup> In other words, the bird was separable because it simply topped the clothespin itself—there was no integration of form and function.<sup>158</sup>

In another ongoing case concerning copyright infringement and the issue of separability, the District Court for the Southern District of New York rejected a defendant’s motion for summary judgment because the copyrighted feature of a light set could be separable from the useful article.<sup>159</sup> At issue, in

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148. *Id.* at \*1.

149. *Id.* at \*3.

150. *Id.* at \*5–6.

151. *Id.* at \*6.

152. *Id.*

153. *Id.* at \*7 (“The *Star Athletica* Court noted that the design feature must qualify as a nonuseful pictorial, graphic, or sculptural work.”) (referring to *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1013 (2017)).

154. *See id.* at \*8.

155. *Id.* at \*5–6.

156. *See id.*

157. *See id.*

158. *See id.*

159. *Jetmax Ltd. v. Big Lots, Inc.*, 15-cv-9597 (KBF), 2017 U.S. Dist. LEXIS 138041, at \*2–3 (August 28, 2017).

this case, is an ornamental light set with a teardrop cover and wire frame.<sup>160</sup> Holding that the teardrop covers were separable from the underlying useful article, the court noted the covers “undoubtedly . . . ha[d] sculptural qualities.”<sup>161</sup> Furthermore, the court noted the covers, as sculptural works, were “capable of existing apart from the utilitarian aspect of the light set.”<sup>162</sup> As with the bird clothespin case discussed above, this was a relatively straightforward application of the new separability test; the decorative light covers could be seen as standalone PGS works apart from the useful article and were not integrated into the overall function or form of the light string.<sup>163</sup>

## 2. *Copyright’s Overlap with Design Patent*

After the *Star Athletica* decision came out, some scholars predicted possible adverse effects in realms of overlapping intellectual property law, such as that of copyright and design patent. For instance, Professor Peter Menell argues that the decision may have “more significant effects on design patent protection and the larger intellectual property landscape than . . . on copyright[s] . . . useful article doctrine.”<sup>164</sup> Arguably, Professor Menell’s prediction is correct because the line between obtaining copyright or design patent protection in most cases is extremely blurry—they both protect nonfunctional artistic aspects of useful articles.<sup>165</sup>

The *Star Athletica* decision continues to muddy the distinction between the two intellectual property regimes<sup>166</sup> by noting in its dicta that design patent and copyrights are not mutually exclusive.<sup>167</sup> In Professor Viva Moffat’s opinion, the availability of multiple forms of intellectual property protection for designs makes it difficult to determine which regime—design patent, copyright, or trademark—is appropriate to protect ornamental designs.<sup>168</sup> As a result, the

160. *See id.* at \*3–4.

161. *Id.* at \*15.

162. *Id.* at \*16 (“[O]nce the covers are removed, the remainder is a functioning but unadorned light string.”).

163. *See id.*

164. Menell & Yablon, *supra* note 9, at 137.

165. *See* Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1475–77 (2004) (discussing the erosion of the boundaries between patents, copyrights, and trademarks, the greater protection sought by creators through multiple intellectual property regimes, and the failure of Congress to address this problem).

166. *See id.* at 1475–77.

167. *See* *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1015–16 (2017) (noting that “we have long held that design patent and copyright are not mutually exclusive” (discussing *Mazer v. Stein*, 347 U.S. 201, 217 (1954))).

168. *See* Moffat, *supra* note 165 at 1511–12 (discussing the problems of the overlapping intellectual property regimes protecting ornamental design features).

overlap between copyright and design patent is detrimental to the intellectual property regime as a whole because the different regimes are not properly coordinated and provide only patchwork protection for ornamental designs.<sup>169</sup> For instance, whereas copyright protection extends to any PGS features of a useful article,<sup>170</sup> a design patent protects “new, original, and ornamental design[s]” of articles of manufacture so long as the design is “primarily ornamental.”<sup>171</sup> Therefore, much like the useful article doctrine of copyright limiting protection for functionality, design patents protect non-functional aspects of articles of manufacture.<sup>172</sup> Because of this overlap of protection, designers can choose between the different regimes when trying to protect design features of functional articles.<sup>173</sup>

There is one notable case that is grappling with the *Star Athletica* decision in this regard, *Puma, SE v. Forever 21*, which involves a specific line of Puma shoes.<sup>174</sup> Perhaps validating the dissent’s fear,<sup>175</sup> Puma added copyright infringement to their design patent claim against Forever 21 after *Star Athletica*’s holding came out.<sup>176</sup> The case itself revolves around a line of shoes co-designed and created by Rihanna and Puma.<sup>177</sup> This shoe line is protected by design patents, but because of *Star Athletica*’s holding, Puma amended its complaint to include claims of copyright infringement.<sup>178</sup> As a result, Puma has combined the two different regimes of copyright and design patent into one complaint to try and protect a line of designer shoes from being copied by Forever 21.<sup>179</sup>

According to commentators, this is an example of a company seeking to push the boundary of copyright protection for useful articles.<sup>180</sup> To fashion

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169. *See id.* at 1512.

170. *See* 35 U.S.C. §§ 101–102 (2012).

171. 35 U.S.C. § 171 (2012); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

172. *See* Mark P. McKenna & Christopher Jon Sprigman, *What’s In, and What’s Out: How IP’s Boundary Rules Shape Innovation*, 30 HARV. J.L. & TECH. 491, 502 (2017).

173. *See* Alana M. Fuierer & Shanna K. Sanders, *Copyright and Design Protection Post-Star Athletica: Supreme Court Issues Key Decision Regarding Copyrightability of Design Features of Useful Articles*, HRFM TODAY (May 5, 2017), <http://www.hrfmtoday.com/2017/05/copyright-and-design-protection-post-star-athletica.html> [<https://perma.cc/7ZAP-MLHW>].

174. *See* Amended Complaint, *Puma v. Forever 21, Inc.*, No. 2:17-cv-02523-PSG-E, 2017 WL 3309169 (C.D. Cal. April 4, 2017) [hereinafter Amended Complaint].

175. *See supra* note 109; *see also* Amended Complaint, *supra* note 174, at 3–6.

176. *See* Amended Complaint, *supra* note 174, at 6–8; *see also* *Puma SE et al. v. Forever 21, Inc.*, No. CV17-2523 PSG Ex, 2017 WL 4771004, at \*1, \*6–8 (granting Forever 21’s motion to dismiss in part and allowing Puma to amend its copyright infringement claim).

177. *See id.*

178. *See id.*

179. *See id.*

180. *See id.*; *see also* Levi, *supra* note 55, at 4.

industry experts and copyright lawyers, *Star Athletica* represented a step toward allowing fashion designers to more easily protect original aspects of their clothing designs against the knock-off industry through copyright without having to go through the hassle of obtaining a design patent.<sup>181</sup> By amending their design patent complaint against Forever 21 to include copyright infringement, Puma is effectively doing just that—testing the boundaries of the *Star Athletica* ruling.<sup>182</sup> It remains to be seen, however, whether *Star Athletica* will push the boundaries of copyright protection for fashion designs or designs of useful articles in general.<sup>183</sup> Despite this uncertainty, the Supreme Court's ruling strengthens the trend for creators to prefer and seek copyright protection rather than other areas of intellectual property law for protecting aesthetically artistic features of useful articles.<sup>184</sup>

### 3. *Protecting Functionality*

More worrisome, however, is the question of whether this ruling allows some functional aspects of useful articles to be copyrighted. Professors Christopher Buccafusco and Jeanne C. Fromer argue that the Supreme Court's ruling effectively rejected the idea that copyright law should only protect the exclusively expressive features of a useful article.<sup>185</sup> To them, the ruling creates a potential problem that conflicts with the underlying purpose of the useful article doctrine: preventing the protection of functional aspects.<sup>186</sup> Thus, they argue, this holding pushes some of the burden of policing functionality to other copyright doctrine mechanisms.<sup>187</sup> For example, the merger doctrine and the filtering analysis that copyright law demands when examining an infringing work might be able to render functional separable PGS features unprotectable.<sup>188</sup>

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181. See Levi, *supra* note 55, at 4; see also Patrick J. Concannon, *Many Options to Protect Your Fashion Design, but No One-Stop Shop*, ART L.J. (July 10, 2017), <https://artlawjournal.com/fashion-design> [https://perma.cc/R7H2-TD2S].

182. See Amended Complaint, *supra* note 174, at 8 (including a copyright claim against Forever 21); see also Levi, *supra* note 55, at 4.

183. See Quinn & Backmann, *supra* note 138 (citing practitioner responses to *Star Athletica*'s holding).

184. See Shipley, *supra* note 10, at 152–53.

185. Christopher Buccafusco & Jeanne C. Fromer, *Fashion's Function in Intellectual Property Law*, 93 NOTRE DAME L. REV. 51, 91 (2017).

186. See *id.* at 91–92.

187. See *id.* at 91–92.

188. See *id.* The merger doctrine denies copyright protection when there are only a limited number of ways in which one may express something. The filtering analysis described above refers to courts filtering out unprotectable elements from a copyrighted work when engaging in an infringement analysis. Professors Buccafusco and Fromer argue that both of these aspects of copyright law might render PGS features on useful articles unprotectable. See *id.* at 92.

The problem posed in Section IV.A.2, that there will be a trend toward increased copyright protection for PGS aspects of useful articles, has the potential for allowing creators to copyright utilitarian features of useful articles.<sup>189</sup> Justice Breyer's dissent alluded to such an issue because, as he noted, almost any artistic industrial design can be perceived as a separate PGS work in some other medium.<sup>190</sup> His famed example being that of Marcel Duchamp's shovel art.<sup>191</sup> This idea is potentially even more dangerous because the majority noted that the "imagined remainder" does not have to be a fully functioning useful article.<sup>192</sup> Therefore, it is not inconceivable that overall designs of useful articles that can be conceived as separate PGS works could be separable and copyrightable under the Supreme Court's test.<sup>193</sup> The question then becomes one of how much of the utilitarian aspects of a useful article should remain before a court determines the PGS features are not separable.<sup>194</sup> This question is extremely important in cases where the design of the useful article is completely intertwined with the utilitarian aspects of a useful article and are not separable from its function.<sup>195</sup>

As there is no current case dealing with this issue, older cases where form and function were one are important to examine under the Court's new test. For instance, as discussed in Section III.B, applying the *Star Athletica* test to the facts and circumstances of *Brandir* might have led a court to rule that the ribbon bike rack is separable.<sup>196</sup> Another case that perhaps can be called into question here is *Kieselstein-Cord*.<sup>197</sup> In *Kieselstein-Cord*, the Second Circuit considered evidence that decorative belt buckles were primarily sold as jewelry, despite evidence of the belt buckles in question being used normally as well.<sup>198</sup> As a result, the Second Circuit held the PGS features of the belt buckles were conceptually separable from the underlying useful article because their primary

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189. See Shipley, *supra* note 10, at 150–51 (discussing the danger of applying the *Star Athletica* test too leniently); see also Menell & Yablon, *supra* note 9, at 145–47.

190. See *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1033–34 (2017) (Breyer, J., dissenting).

191. See *id.* at 1033–34.

192. See *id.* at 1006 (majority opinion).

193. See Shipley, *supra* note 10, at 171 ("Moreover, notwithstanding the Court's statement in *Star Athletica* that 'the statute does not require the imagined remainder to be a fully functioning useful article at all,' the opinion should not be pushed to hold that the overall shapes . . . are copyrightable . . .").

194. See *id.*

195. See *id.*

196. See *supra* Section III.B, notes 91–96 and accompanying text.

197. See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (holding that a belt buckle was copyrightable because the artistic features of the design were "primary" to the "subsidiary utilitarian function").

198. See *id.* at 990–91.

function was artistic.<sup>199</sup> Under *Star Athletica*'s test, a court will not look to see whether the PGS features of a belt buckle are primary to the utilitarian features of a useful article.<sup>200</sup> Instead, a court will determine whether the belt buckle's PGS features can exist in some other medium of expression apart from the useful article.<sup>201</sup> Given the fact that the belt buckles' PGS features were held to be separable from the utilitarian aspects,<sup>202</sup> the case may have come out differently under *Star Athletica*'s test depending on the amount of function a court allowed the PGS features to encompass.<sup>203</sup>

To avoid giving copyright protection to utilitarian aspects of useful articles, a court should, under the new test, still keep the functional aspects of a useful article in mind before turning to focus on the PGS features. The Supreme Court majority pushed aside any consideration of a useful article's utilitarian aspects when it decided to focus solely on the claimed PGS features.<sup>204</sup> While this approach avoids the sticky question of what constitutes the utility of a useful article, it also raises the problem of differentiating between the PGS and utilitarian features. As both the District Court's holding and Sixth Circuit's dissent in *Varsity Brands* demonstrate,<sup>205</sup> defining the term "function" and understanding the article's utility is an important first step; without first defining that term, a court will not be able to separate the PGS features from the utilitarian features when engaging in the separability analysis.

Furthermore, in those rare cases where form and function are intertwined, a court must keep in mind the majority's statement that the claimed PGS feature cannot be a useful article in and of itself.<sup>206</sup> As alluded to in Justice Breyer's dissent,<sup>207</sup> a generous approach to applying the new test could render almost any aesthetically pleasing design of a useful article copyrightable as a PGS work. However, there may be a faint glimmer of hope for avoiding copyright protection for functional aspects given the majority's limiting statement that the design cannot constitute a useful article by itself.<sup>208</sup>

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199. *See id.* at 993–94.

200. *See id.*

201. *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1016 (2017).

202. *See Kieselstein-Cord*, 632 F.2d at 994–95 (Weinstein, J., dissenting).

203. *See supra* note 185; *see also* Section IV.A.3, notes 185–195.

204. *See Star Athletica, LLC*, 137 S. Ct. at 1013–14 (“But the statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one.”).

205. *See Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 494–95 (6th Cir. 2015) (McKeague, J., dissenting); *see also Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422 at \*8–9 (W.D. Tenn. Mar. 1, 2014).

206. *See Star Athletica, LLC*, 137 S. Ct. at 1010 (“Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article[.]”).

207. *See id.* at 1033–34 (Breyer, J. dissenting).

208. *See id.* at 1010 (majority opinion) (“Of course, to qualify as a pictorial, graphic, or

Therefore, when the utilitarian and PGS features are completely intertwined and nigh-indivisible, courts should not give copyright protection to functional aspects of useful articles.<sup>209</sup> This is ultimately, however, a question for the lower courts, which, due to the vague and unhelpful analysis of the Supreme Court, will likely create a morass of tests similar to the useful article doctrine's legal landscape before *Star Athletica*.<sup>210</sup>

## V. CONCLUSION

While the Supreme Court wanted to create a standard test for separability across the circuit courts, it ultimately created a vague test that presents more questions than answers. In other words, *Star Athletica* was a missed opportunity to provide much-needed clarification on copyright's useful article doctrine. While applications of the test related to two-dimensional and some three-dimensional designs are unlikely to be difficult so long as they have no part in the functionality of the useful article, applications of the test to functional, aesthetically pleasing three-dimensional artworks will be much more difficult.

While courts must focus on the artistic PGS features of a useful article, they should also keep in mind the overall function and utility of the useful article. That way, courts are better able to separate the copyrightable PGS features from the non-copyrightable utilitarian features. However, when these two features are intertwined, courts would do well to remember the Supreme Court's limiting sentence: "[o]f course, to qualify as a [PGS] work on its own, the feature cannot itself be a useful article."<sup>211</sup> As Professor Ginsburg points out, this part of the holding has the potential to limit protection of useful articles when the design and function are one.<sup>212</sup> Hopefully, this will ensure that courts can avoid giving copyright protection to useful articles where the PGS features encompass the entirety of the useful article.

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sculptural work on its own, the feature cannot itself be a useful article[.]").

209. See Jane C. Ginsburg, *The Sum Is More Public Domain than Its Parts?: US Copyright for Works of Applied Art Under Star Athletica's Imagination Test*, 166 U. PA. L. REV. ONLINE 83, 97–100 (2017), <http://www.pennlawreview.com/online/166-U-Pa-L-Rev-Online-83.pdf> [<https://perma.cc/H4NQ-Q6WR>].

210. See *Copyright Act of 1976—Useful Articles*, *supra* note 39, at 371–72.

211. See *Star Athletica, LLC*, 137 S. Ct. at 1010.

212. See Ginsburg, *supra* note 209, at 97–98.