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ARTICLES AFTER *STAR ATHLETICA V. VARSITY
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ISSN 0041-9915 (print) 1942-8405 (online) • DOI 10.5195/lawreview.2018.574
<http://lawreview.law.pitt.edu>



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IMAGINING THINGS: COPYRIGHT FOR USEFUL ARTICLES AFTER *STAR ATHLETICA V. VARSITY BRANDS*

Robert C. Denicola *

I. INTRODUCTION

The federal copyright statute extends protection to “pictorial, graphic, and sculptural works,”¹ including works of “applied art.”² The “design of a useful article,” however, is “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.”³ This standard, universally described as “separability,” plays a critical role in efforts by designers and manufacturers to control the copying of their products.⁴ The separability test has confounded courts and commentators.⁵ The Sixth Circuit in *Varsity Brands, Inc. v.*

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¹ 17 U.S.C. § 102(a)(5) (2012).

² *Id.* § 101 (defining “pictorial, graphic, and sculptural works”).

³ *Id.*

⁴ Other forms of protection against the copying of non-functional product designs have significant legal and practical limitations. Design patents, which protect the “ornamental design” of a manufactured article, are subject to a non-obvious standard that can preclude protection for many product designs, and the associated administrative and attorney’s fees often make design patents an impractical alternative. 35 U.S.C. § 171 (Supp. I 2013); *id.* § 103. Trademark protection for non-functional product designs requires proof that the design is understood by consumers as an indication of the product’s source. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212 (2000). The United States has consistently refused to enact more generalized product design protection. *See infra* text accompanying notes 26–32.

⁵ *See, e.g.*, *Masquerade Novelty, Inc. v. Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990) (“Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article’s utilitarian function.”). The author of a leading copyright treatise concurs. 1 PAUL GOLDSTEIN, 1 GOLDSTEIN ON COPYRIGHT § 2.5.3 (3d ed. 2017) (“Of the many lines that run through the Copyright Act, none is more

Star Athletica, LLC,⁶ a case involving the copying of cheerleading uniforms, counted *nine* different approaches to separability propounded by administrators, courts, and scholars,⁷ and promptly added one more of its own.⁸ Perhaps seeking to avoid more politically-sensitive matters while shorthanded due to the death of Justice Antonin Scalia, the U.S. Supreme Court chose to weigh in on the case.⁹ In its subsequent decision, Justice Thomas swept away most of what had gone before.¹⁰ In its place he left a single test that largely tracks the statutory language.¹¹ His approach to the statute may be doomed to replicate much of the uncertainty that preceded it. Indeed, the Justices themselves could not agree on the application of the new test to cheerleading uniforms—or shovels.¹²

This Article examines the Supreme Court's new approach to copyright in useful articles. Specifically, it strives to decipher and appraise the Court's interpretation of the separability standard. It begins with a brief description of the relevant statutory framework. Next, it reviews what the Supreme Court said about separability, and then analyzes the implications of the Court's new formulation. Finally, it applies the results of that analysis to the facts of several well-known and highly-disputed cases. The aim is to provide a comprehensive assessment of the new rules governing copyright protection for useful articles.

II. A BRIEF BACKGROUND

The Supreme Court's opinion in *Star Athletica* draws from a single precedent—the Court's 1954 decision in *Mazer v. Stein*, a case involving china statuettes of Balinese dancing figures used as bases for table lamps.¹³ The statuettes, *sans* wires and lamp sockets, had been registered with the Copyright Office as “works of art” or

troublesome than the line between protectable pictorial, graphic and sculptural works and unprotectable utilitarian elements of useful articles.”).

⁶ *Varsity Brands v. Star Athletica, LLC*, 799 F.3d 468 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002 (2017).

⁷ *Id.* at 484–85.

⁸ *Id.* at 487.

⁹ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 136 S. Ct. 1823 (2016) (granting a petition for writ of certiorari).

¹⁰ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).

¹¹ *Id.* at 1016.

¹² *See id.*

¹³ *Mazer v. Stein*, 347 U.S. 201, 201 (1954).

“reproductions of a work of art” under the terms of the 1909 Copyright Act.¹⁴ Rival lamp makers copied the designs.¹⁵ Copyright Office regulations described the “works of art” category as including “works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned”¹⁶ The copiers challenged the copyrightability of the statuettes, citing federal design patent law, which extends protection to “any new, original and ornamental design for an article of manufacture.”¹⁷ They insisted that only design patents, with their more exacting standards, could protect the design of mass-produced industrial products.¹⁸ Their argument was flatly rejected: “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.”¹⁹ This holding from *Mazer* was specifically reaffirmed in *Star Athletica*—intent to incorporate a work into a useful article does not affect its copyrightability,²⁰ and it is irrelevant whether the work is first created as a freestanding work or as part of the useful article itself.²¹ *Mazer*’s holding, however, was narrow. “The case requires an answer, not as to a manufacturer’s right to register a lamp base but as to an artist’s right to copyright a work of art intended to be reproduced for lamp bases.”²² A dancing figure remained a copyrightable “work of art” despite its use as part of a lamp, but what of the shape of a toaster, automobile, or even a more “ordinary-looking” lamp base?

Copyright Office regulations were quickly amended to reflect the narrow ruling in *Mazer*.²³ In an effort to preclude copyright protection for all manner of commercial

¹⁴ *Id.* at 202–03. See 17 U.S.C. § 5 (Supp. V 1952) (current version at 17 U.S.C. § 101 *et seq.* (2012)).

¹⁵ *Mazer*, 347 U.S. at 203.

¹⁶ *Id.* at 212–13. See 37 C.F.R. § 202.8 (1949).

¹⁷ 35 U.S.C. § 171 (Supp. I 2013).

¹⁸ *Mazer*, 347 U.S. at 215–16.

¹⁹ *Id.* at 218.

²⁰ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1011 (2017).

²¹ *Id.* at 1011 (“Nor do we think the subsequent registration of a work of art published as an element in a manufactured article, is a misuse of copyright. This is not different from the registration of a statuette and its later embodiment in an industrial article.”) (quoting *Mazer*, 347 U.S. at 218–19).

²² *Mazer*, 347 U.S. at 205.

²³ 37 C.F.R. § 202.10(b) (Supp. 1956) (“The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile or textile product. The potential availability of protection under the design patent law will not affect the registrability of a work of art”).

goods, the Copyright Office soon settled on a formulation that could accommodate the statuettes in *Mazer* while excluding the general realm of industrial design.²⁴ It was the first appearance of the “separability” standard.

During the laborious efforts to amend the federal copyright statute that had begun soon after the decision in *Mazer*, the Copyright Office consistently counseled against any expansion of copyright into industrial design, emphasizing the potential anticompetitive consequences of broad (and lengthy) copyright protection for commercial goods.²⁵ Attention focused instead on design protection legislation that would be separate from both copyright and design patent.²⁶ The Senate formally joined design protection with copyright reform in 1969, adding it as *Title II* of the general copyright revision bill.²⁷ *Title II* offered protection for the “original ornamental design of a useful article,” with “staple or commonplace” designs and designs “dictated solely by a utilization function of the article” excluded.²⁸ It met the fate of its many predecessors. As explained by the House Judiciary Committee,

[T]he Committee will have to examine further the assertion of the Department of Justice, which testified in opposition to the Title, that Title II would create a new monopoly which has not been justified by a showing that its benefits will outweigh the disadvantage of removing such designs from free public use.²⁹

²⁴ 37 C.F.R. § 202.10(c) (1959) (“If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.”).

²⁵ COPYRIGHT LAW REVISION, REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW, HOUSE COMM. ON THE JUDICIARY, 87TH CONG. 13 (Comm. Print 1961) (“In the years since the *Mazer* decision, full protection under the copyright law has not proved inappropriate for ‘works of art’ used as a design or decoration of useful articles. We do not believe, however, that it would be appropriate to extend the copyright law to industrial designs as such.”).

²⁶ The idea was hardly novel. “Since 1914, approximately seventy design protection bills have been introduced in Congress, none of which has been enacted into law.” *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 n.12 (D.C. Cir. 1978).

²⁷ H.R. REP. NO. 94-1476, at 50 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659.

²⁸ S. 22, 94th Cong. §§ 201(a), 202 (1975), *reprinted in* S. REP. NO. 94-473, at 39 (1975).

²⁹ H.R. REP. NO. 94-1476 at 50.

Proponents of design protection did eventually break through when Chapter 13 was added to Title 17 of the U.S. Code in 1998.³⁰ Chapter 13 creates an elaborate scheme of protection for “an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public”³¹ However, in what may pass for legislative humor, for purposes of Chapter 13, a “useful article” is defined only as “a vessel or boat hull.”³²

The 1976 Copyright Act broke little new ground on useful articles. It contains a narrow codification of *Mazer*, stating in § 113(a) that the exclusive right to reproduce a copyrighted work “includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.”³³ The “works of art” category of the 1909 Act was abandoned, replaced by “pictorial, graphic, and sculptural works.”³⁴ The definition of that category incorporates the Copyright Office’s separability standard so that designs of useful articles³⁵ are within its scope only if they contain features “that can be identified separately from, and are capable of existing independently of” the article’s utilitarian aspects.³⁶

Although ignored by Justice Thomas in *Star Athletica*, the legislative history of the 1976 Copyright Act’s separability test bears attention:

³⁰ Pub. L. No. 105-304, 112 Stat. 2905 (codified at 17 U.S.C. §§ 1301–32 (2012)).

³¹ 17 U.S.C. § 1301(a)(1) (2012).

³² *Id.* at § 1301(b)(2). The generalized form of Chapter 13 invites expansion. The fashion industry has been the most active participant lobbying to extend the reach of Chapter 13. *See, e.g.*, Innovation Design Protection Act of 2012, S. 3523, 112th Cong. (2012).

³³ 17 U.S.C. § 113(a) (2012).

³⁴ *Id.* § 102(a)(5).

³⁵ The Copyright Office regulations had demanded separability only when “the *sole* intrinsic function of an article is its utility” (emphasis added). *See supra* note 24 and accompanying text. Articles serving both aesthetic and utilitarian ends were arguably beyond the reach of the limitation, and thus useful articles that could also pass as “art” could escape the separability requirement. *See, e.g.*, *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733, 736 (S.D.N.Y. 1966) (pencil sharpener simulating the appearance of an antique telephone copyrightable since utility was not its “sole intrinsic function”). The 1976 Act’s definition of “useful article” substituted “*an* intrinsic utilitarian function” for “sole intrinsic function.” *See* 17 U.S.C. § 101 (2012) (emphasis added) (definition of “useful article”). Although the definition closes the loophole in the former regulation, its broadened scope creates new uncertainty. *See, e.g.*, *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970, 973 (6th Cir. 1973) (toy airplane “has no intrinsic utilitarian function”).

³⁶ 17 U.S.C. § 101 (2012) (definition of “pictorial, graphic, and sculptural works”).

[T]he Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statute [sic] or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrightable under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design—that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable.³⁷

"Applied art," as in *Mazer*, still enjoys protection, but "industrial design," even if aesthetically pleasing, is excluded from copyright by the separability standard that befuddled the Supreme Court in *Star Athletica*.

III. STAR ATHLETICA—WHAT THE SUPREME COURT SAID

Varsity Brands designs, manufacturers, and markets apparel and accessories used in cheerleading.³⁸ Among its products were five cheerleading uniforms onto which two-dimensional designs had been incorporated by sewing or heat transfer.³⁹ The designs, consisting of lines, curves, stripes, angles, and diagonals in various colors, had been created by Varsity employees who sketched them on paper with no

³⁷ H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659. For more extensive treatments of the genesis of the separability standard, see Jane C. Ginsburg, "Courts Have Twisted Themselves Into Knots": *U.S. Copyright Protection for Applied Art*, 40 COLUM. J.L. & ARTS 1 (2016); Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y 339 (1990); Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Article*, 67 MINN. L. REV. 707 (1983).

³⁸ *Varsity Brands, Inc. v. Star Athletica, LLC.*, 2014 WL 819422, *1 (W.D. Tenn. 2014), *rev'd*, 799 F.3d 468 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002 (2016).

³⁹ *Id.*

instructions or limitations from the clothing production department.⁴⁰ The designs were accepted for registration by the Copyright Office as “2-dimensional artwork.”⁴¹ Varsity claimed that Star Athletica had copied the designs for its own cheerleading uniforms and sued for copyright infringement.⁴² The defendant won a summary judgment following Judge Cleland’s determination that the designs were not copyrightable.⁴³ Noting with some understatement that “there is considerable disagreement regarding the proper standard to apply when considering whether elements of protectable [pictorial, graphic, and sculptural] works are separable from their utilitarian function,” Judge Cleland held that the designs were not separable from the utilitarian aspects of the uniforms.⁴⁴ He justified that conclusion by observing that the uniform “loses its utilitarian functionality as a cheerleading uniform” when the design is removed,⁴⁵ and even when viewed on its own, the design “evokes the image and concept of a cheerleading uniform.”⁴⁶

The defendant’s summary judgment was vacated by the Sixth Circuit, which held the designs to be copyrightable.⁴⁷ After reciting nine differing standards for determining separability, Judge Moore settled on a “hybrid” approach that borrowed elements from several of the earlier tests.⁴⁸ The court ultimately concluded that the graphic features could be identified separately and could exist independently of the utilitarian aspects of the uniforms, noting, for example, that the designs could be transferred onto other articles such as shirts, jackets, and skirts.⁴⁹ Judge McKeague, in dissent, echoed the lower court’s conclusion that the designs could not be separated from the utilitarian aspects of the uniforms because they were integral to identifying the wearer as a cheerleader.⁵⁰ Judge Moore’s majority opinion countered

⁴⁰ *Id.* at *2.

⁴¹ *Id.*

⁴² *Id.* at *1.

⁴³ *Id.*

⁴⁴ *Id.* at *6.

⁴⁵ *Id.* at *8.

⁴⁶ *Id.* at *9.

⁴⁷ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 494 (6th Cir. 2015), *aff’d*, 137 S. Ct. 1002 (2016).

⁴⁸ *Id.* at 484–87.

⁴⁹ *Id.* at 491.

⁵⁰ *Id.* at 495–96 (McKeague, J., dissenting).

that “convey[ing] information” such as identification was not a utilitarian aspect of an article for purposes of determining separability in light of the Copyright Act’s express exclusion of that function in its definition of a “useful article.”⁵¹ Judge McKeague, complaining that “[t]he law in this area is a mess,” concluded his dissent with a plea for “much-needed clarification.”⁵² Although the Supreme Court sought to oblige, “clarification” is not necessarily an apt description of its efforts.

There was no dispute that Varsity’s uniforms were “useful articles.”⁵³ However, Varsity argued that the two-dimensional designs copied by Star Athletica appeared *on* the useful articles; they were not designs *of* useful articles subject to the separability test under § 101.⁵⁴ The proposition that separability does not apply to two-dimensional works that have been applied to useful articles has been forcefully asserted by William Patry, author of a treatise on copyright law.⁵⁵ Justice Thomas quotes Patry as declaring, “Courts looking at two-dimensional design claims should not apply the separability analysis regardless of the three-dimensional form that design is embodied in.”⁵⁶ It is not a defensible proposition. As Justice Thomas notes, the statement of the separability test in § 101 specifically refers to “*pictorial, graphic, or sculptural features*” that can be separated from the utilitarian aspects of a useful article,⁵⁷ and “pictorial, graphic, and sculptural works” specifically include “two-dimensional” works.⁵⁸

Justice Ginsburg, in a concurring opinion, raises a more sophisticated objection to the necessity of a separability analysis.⁵⁹ Section 113(a) of the Copyright Act grants the owner of a pictorial, graphic, or sculptural work the exclusive right to

⁵¹ 17 U.S.C. § 101 (2012) (defining “useful article”) (“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.”).

⁵² *Varsity Brands, Inc.*, 799 F.3d at 496–97.

⁵³ See, e.g., *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 422 (5th Cir. 2005) (casino uniforms not copyrightable as useful articles); cf. *Poe v. Missing Persons*, 745 F.2d 1238, 1239 (9th Cir. 1984) (material issue of fact as to whether the work was “artwork in the medium of soft sculpture” or a swimsuit).

⁵⁴ *Star Athletica*, 137 S. Ct. 1002, 1009 (2017).

⁵⁵ See generally WILLIAM F. PATRY, *PATRY ON COPYRIGHT* (2016).

⁵⁶ 137 S. Ct. at 1009 (quoting 2 PATRY, *PATRY ON COPYRIGHT* § 3:151, *supra* note 55).

⁵⁷ 17 U.S.C. § 101 (2012) (emphasis added) (definition of “pictorial, graphic, and sculptural works”).

⁵⁸ *Id.* Indeed, the legislative history of § 101 uses a series of examples involving two-dimensional works to illustrate the operation of the separability standard. See *supra* note 37 and accompanying text.

⁵⁹ See *Star Athletica*, 137 S. Ct. at 1018 (Ginsburg, J., concurring).

reproduce the work in or on a useful article.⁶⁰ A painter, for example, has the exclusive right to reproduce her painting on a vase, and thus has a claim for infringement against another who does so without permission. The separability analysis is irrelevant to such a case since the work in which the author claims copyright was not part of the design of a useful article. Undoubtedly influenced by a law review article written by her daughter, Jane Ginsburg,⁶¹ Justice Ginsburg argued that the works at issue in *Star Athletica* were “standalone” pictorial and graphic works that had been created on paper and registered at the Copyright Office as two-dimensional artworks.⁶² Thus, the works were copyrightable without regard to separability and the case should be controlled by § 113(a).⁶³ Justice Thomas for the majority declined to engage that contention directly, arguing that although the issue had been raised by the United States as *amicus curiae*, it had not been advanced by the parties.⁶⁴ Justice Thomas did, however, address the relationship between § 113(a) and § 101’s separability standard in the course of applying the separability standard to Varsity’s designs; “[s]ection 101 is, in essence, the mirror image of § 113(a). Whereas § 113(a) protects a work of authorship first fixed in some tangible medium other than a useful article and subsequently applied to a useful article, § 101 protects art first fixed in the medium of a useful article.”⁶⁵ Taken literally, that statement calls into question the Court’s own analysis. Varsity’s designs were first fixed on paper and only later applied to the uniforms. Section 101’s separability standard thus appears irrelevant, and Varsity should prevail merely by asserting its exclusive right under § 113(a) to reproduce its copyrighted works on useful articles. According to *Mazer v. Stein*, the fact that Varsity created the works with the intention of

⁶⁰ 17 U.S.C. § 113(a) (2012).

⁶¹ See Ginsburg, *supra* note 37. Justice Ginsburg cites the article in a footnote only for the proposition that the separability test “has resisted coherent application.” *Star Athletica*, 137 S. Ct. at 1018 n.1 (Ginsburg, J., concurring).

⁶² 137 S. Ct. at 1018. The fact that Varsity Brands registered more than two hundred two-dimensional uniform designs, *id.* at 1007, prompts Lili Levi to worry about the risk of market foreclosure. See Lili Levi, *The New Separability*, 20 VAND. J. ENT. & TECH. L. 709 (2018). However, since a defendant will be liable for copyright infringement only if it actually *copies* the design, copyright registrations themselves do not create the same market foreclosure risks associated with patent aggregations.

⁶³ See *id.*; see also Ginsburg, *supra* note 37, at 21–24 (reaching the same conclusion).

⁶⁴ 137 S. Ct. at 1009. Varsity’s copyright registrations for “2-dimensional artwork,” however, were clearly part of the record before the Court. *Id.*

⁶⁵ *Id.* It is an odd comparison since § 101’s definition of “pictorial, graphic, and sculptural works” goes to the subject matter eligible for copyright protection, whereas § 113(a) amplifies the exclusive rights granted to eligible subject matter. See 17 U.S.C. §§ 101, 113(a) (2012).

subsequently applying them to useful articles does not affect their copyrightability⁶⁶—a proposition expressly reaffirmed by Justice Thomas in *Star Athletica*.⁶⁷ Nevertheless, the Court’s decision to invoke the separability standard is probably wise. Treating Varsity’s designs as standalone works subject to § 113(a) simply because they were created prior to the actual manufacture of the cheerleading uniforms would leave very little within the scope of § 101’s separability test. Useful articles are not typically designed or produced in a single step as a full-blown whole. Instead, individual elements are more likely to be created first on paper or on a computer with the intention of ultimately incorporating them into a finished product. If fixation prior to incorporation into a useful article is the touchstone, almost any design element could plausibly claim the status of a pre-existing standalone work eligible for copyright without regard to separability. Application of the separability standard is warranted in *Star Athletica*, despite the prior creation of the designs, because Varsity itself chose to incorporate the designs into the useful articles that were subsequently copied by Star Athletica.⁶⁸ A defendant who copies elements of a useful article may have no knowledge of the design history of the article, and thus would be unable to assess whether an element is copyrightable if applicability of the separability standard turns on the order of creation. The statuette in *Mazer*, for example, was created prior to its use by the owner in lamps,⁶⁹ yet the legislative history of § 101’s separability test uses *Mazer* as an illustration of separability.⁷⁰ Section 113(a) is best reserved for truly standalone works—works the creator has not herself applied to a useful article that has been reproduced by a copier.

After concluding that a separability analysis was necessary in order to assess the copyrightability of Varsity’s designs, the Court set out its interpretation of the applicable standard: “We hold that 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

⁶⁶ *Mazer v. Stein*, 347 U.S. 201, 218 (1954) (“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.”).

⁶⁷ 137 S. Ct. at 1011 (“Two of *Mazer*’s holdings are relevant here. First, the Court held that the respondents owned a copyright in the statuette even though it was intended for use as a lamp base.”).

⁶⁸ *Id.* at 1018.

⁶⁹ *Mazer*, 347 U.S. at 202.

⁷⁰ See *supra* note 37 and accompanying text; see, e.g., *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404 (11th Cir. 2015) (applying the separability standard to uphold copyright in a digital photograph applied by the copyright owner to laminate flooring subsequently copied by a competitor).

qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.”⁷¹ One obvious characteristic of the Court’s formulation is that it largely paraphrases the statutory text in § 101.⁷² Another is the formal division of the “identified separately” and “capable of existing independently” elements in the § 101 definition. Although some courts had treated the standard as a more unified whole,⁷³ the distinction is unlikely to affect results, particularly in light of the limited role played by the first element in the Court’s analysis.⁷⁴ Except for a brief reference rejecting two “objective” components derived from earlier cases,⁷⁵ the Court declined to comment on any of the multiple tests surveyed below by the Sixth Circuit, nor did it discuss or cite any of the numerous scholarly articles offering analysis and commentary on the separability standard.⁷⁶

Several of the Court’s general comments on separability merit attention. *Star Athletica* argued Varsity’s designs were not separable from the cheerleading uniforms because the uniforms would not be equally useful without them—the designs identified the wearer as a cheerleader and enhanced the wearer’s appearance.⁷⁷ Justice Thomas found the debate over the relative utility of plain white cheerleading uniforms irrelevant; focusing on the extracted feature rather than on what was left behind after separation, he stated that “[t]he statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic

⁷¹ *Star Athletica*, 137 S. Ct. at 1007. See also *id.* at 1017 (reciting a virtually identical formulation).

⁷² See 17 U.S.C. § 101 (2012).

⁷³ See, e.g., *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 417 (5th Cir. 2005) (“Although the statutory language ostensibly requires that two conditions be satisfied, the consensus among courts and academics is that . . . § 101’s separateness requirements implement what is called the ‘conceptual separability test.’”) (footnotes omitted); *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 921 (7th Cir. 2004) (“Although [§ 101] contains two operative phrases—‘can be identified separately from’ and ‘are capable of existing independently of’—we believe, as have other courts that have grappled with this issue, that Congress, in amending the statute, intended these two phrases to state a single, integrated standard . . .”).

⁷⁴ See *infra* notes 110–21 and accompanying text.

⁷⁵ See *infra* notes 151–58 and 168–72 and accompanying text.

⁷⁶ See, e.g., Viva R. Moffat, *The Copyright/Patent Boundary*, 48 RICH. L. REV. 611 (2014); Eric Setliff, *Copyright and Industrial Design: An “Alternative Design” Alternative*, 30 COLUM. J.L. & ARTS 49 (2006); Sepehr Shahshahani, *The Design of Useful Article Exclusion: A Way Out of the Mess*, 57 J. COPYRIGHT SOC’Y U.S. 859 (2010); Denicola, *supra* note 37; Ginsburg, *supra* note 37; Perlmutter, *supra* note 37.

⁷⁷ 137 S. Ct. at 1013.

feature.”⁷⁸ That proposition had previously been in doubt. For example, the *Compendium of U.S. Copyright Office Practices* then in effect took the position that a feature was separable if it could be “physically removed without altering the useful aspects of the article” or if “the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works.”⁷⁹ As Justice Thomas notes, a requirement that extraction of the feature must leave the utility of the useful article intact is inconsistent with *Mazer*.⁸⁰ With the statuette removed, “the ‘lamp’ would be just a shade, bulb, and wires.”⁸¹ Removal of a graphic pattern from a textile fabric may decrease the fabric’s usefulness in upholstery or dress-making, but the design nevertheless remains copyrightable as a separable work.⁸²

Justice Thomas extracted a corollary from his conclusion that the utility of the useful article need not remain intact after separation of the copyrightable pictorial, graphic, or sculptural work.⁸³ The legislative history of § 101’s separability test states that the standard can be met if the element is “physically or conceptually” separable.⁸⁴ That distinction has made repeated appearances in the case law.⁸⁵ It has also formed the basis for scholarly⁸⁶ and administrative⁸⁷ analysis. Interpreting physical separability to mean that a feature can “be physically separated from the

⁷⁸ *Id.*

⁷⁹ U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2(A)–(B) (3d ed. 2014). *See also, e.g.*, 1 GOLDSTEIN, *supra* note 5, at § 2.5.3 (“[P]rotectible if it can be physically separated from the article without impairing the article’s utility” or “conceptually separable if it can stand on its own as a work of art traditionally conceived, and if the useful article in which it is embodied would be equally useful without it.”).

⁸⁰ *Star Athletica*, 137 S. Ct. at 1014.

⁸¹ *Id.*

⁸² *See supra* note 37 and accompanying text. *See also* Home Legend, LLC v. Mannington Mills, Inc., 784 F.3d 1404 (11th Cir. 2015) (digital photograph applied by the copyright owner to laminate flooring held separable).

⁸³ *Star Athletica*, 137 S. Ct. at 1014.

⁸⁴ *See supra* note 37 and accompanying text.

⁸⁵ *See, e.g.*, Home Legend, LLC, 784 F.3d 1404 (11th Cir. 2015); Chosun Int’l, Inc. v. Chricha Creations, Ltd., 413 F.3d 324 (2d Cir. 2005); Pivot Point Int’l, Inc. v. Charlene Prods., Inc., 371 F.3d 913 (7th Cir. 2004); Brandir Int’l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142 (2d Cir. 1987); Norris Indus., Inc. v. Int’l Tel. & Tel. Corp., 696 F.2d 918 (11th Cir. 1983).

⁸⁶ *See, e.g.*, 1 GOLDSTEIN, *supra* note 5, § 2.5.3; 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2A.08[B][3] (2017).

⁸⁷ *See* U.S. COPYRIGHT OFFICE, *supra* note 79, § 924.2(A)–(B).

article by ordinary means while leaving the utilitarian aspects of the article intact,”⁸⁸ and conceptual separability to potentially apply “if the feature physically could not be removed from the useful article by ordinary means,”⁸⁹ Justice Thomas abandoned the distinction: “Because separability does not require the underlying useful article to remain, the physical-conceptual distinction is unnecessary.”⁹⁰ To Justice Thomas, “separability is a conceptual undertaking.”⁹¹ This revision is unlikely to have substantive consequences. A feature that can be removed from the useful article with a hacksaw should have no trouble being “imaginatively separated” from the article.⁹²

One general comment in the Court’s opinion is particularly unsettling: “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.*”⁹³ In context, the statement is merely a reiteration of the Court’s relatively uncontroversial conclusion that the utility of the useful article need not remain intact after separation of the copyrightable feature. That the lamp in *Mazer* will not function without the separated statuette, for example, does not preclude copyright protection. Literally, however, the Court’s statement can be read to go much further, welcoming into copyright features whose specific designs improve the functioning of useful articles. Varsity’s design patterns on its cheerleading uniforms are copyrightable, but what of a mesh pattern shown to be particularly effective in keeping the wearer cool, or a specific pattern of light and dark shapes on a jacket shown to provide superior camouflage for deer hunters? Extending copyright protection to the functional aspects of useful articles would represent a dramatic expansion. Courts and commentators have consistently interpreted the separability standard to exclude features whose designs contribute to an article’s function.⁹⁴ Indeed, the Supreme Court in *Mazer* spoke of protecting the

⁸⁸ 137 S. Ct. at 1014 (quoting U.S. COPYRIGHT OFFICE, *supra* note 79, § 924.2(A)).

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Id.* (“Because we reject the view that a useful article must remain after the artistic feature has been imaginatively separated from the article, we necessarily abandon the distinction between ‘physical’ and ‘conceptual’ separability . . .”).

⁹³ *Id.* (emphasis added).

⁹⁴ See, e.g., *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005) (“[F]unctional items are not eligible for the relatively long-term protections of copyright.”); *Am. Dental Ass’n v. Delta Dental Plans Ass’n*, 126 F.3d 977, 980 (7th Cir. 1997) (“A lamp may be entirely original, but if the novel elements are also functional the lamp cannot be copyrighted.”) (dicta); *Norris Indus., Inc. v. Int’l Tel. &*

statuettes in “form but not their mechanical or utilitarian aspects.”⁹⁵ The conclusion is rooted in a recognition of the channeling function of the separability test, pushing technical innovations into the patent regime, with its more exacting requirements of novelty and inventiveness and its shorter term of protection.⁹⁶ The Supreme Court itself has been careful to maintain a similar distinction between the subject matters of trademark and patent protection.⁹⁷ The language of the separability test supports this fundamental limitation on copyrightable subject matter. Section 101 demands that the feature be identified separately from and be capable of existing independently of “*the utilitarian aspects* of the article.”⁹⁸ A feature whose specific design improves the functioning of a useful article hardly seems separate and independent of the article’s “utilitarian aspects.” To maintain the basic distinction between copyright and patent, the Court’s reference to features that make the article more useful should be interpreted to refer only to the fact that the useful article need not be functional once the separated feature is removed, as in *Mazer*. If the specific

Tel. Corp., 696 F.2d 918, 924 (11th Cir. 1983) (“The wire wheel covers in this case are not superfluous ornamental designs, but functional components of utilitarian articles.”); 1 HOWARD B. ABRAMS, *THE LAW OF COPYRIGHT* § 3:26 (2017) (“If the feature or combination of features does not serve to assist the article in performing its functional purpose, it can be protected by copyright.”); 1 GOLDSTEIN, *supra* note 5, § 2.5.3 (“[I]t seems appropriate to place designs of useful articles that are not essential to the utility of the useful article on the copyrightable side of the line.”); Moffat, *supra* note 76, at 663–64 (“[R]equiring proof that the aspects sought to be protected are not functional—or useful—by demonstrating that they are not essential to the item’s operation and do not affect the cost or quality of the item.”).

⁹⁵ *Mazer v. Stein*, 347 U.S. 201, 218 (1954) (internal citation omitted).

⁹⁶ See, e.g., *Chosun Int’l, Inc.*, 413 F.3d at 328; *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 669 (3d Cir. 1990) (“[I]f an artist claimed copyright protection for his design of the shape of an automobile, for example, and the shape of the car made it more aerodynamic, then allowing protection for the artist’s design might limit the availability of cars with this improvement in aerodynamics Protecting the shape via copyright might thus afford the artist a *de facto* patent on an industrial innovation that would otherwise not satisfy the more rigorous requirements necessary to obtain a patent, as opposed to a copyright.”); 1 ABRAMS, *supra* note 94 (“In short, a court should ask whether a given feature or combination of features serves the purpose of making the article work, or work better. If the feature or combination of features serves this purpose, it is properly protected by patent and only by patent.”); Moffat, *supra* note 76, at 620–21 (“[T]he useful article doctrine is a channeling doctrine, meant to direct works away from the copyright realm and toward patent law, the public domain, or, perhaps, some other form of protection.”).

⁹⁷ See, e.g., *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (“‘a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article’”) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

⁹⁸ 17 U.S.C. § 101 (2012) (definition of “pictorial, graphic, and sculptural works”) (emphasis added).

design of the feature is itself important to the article's utility, it should not be considered separable from the utilitarian aspects of that article.

There are at least two indications, however, that the Court may have intended what it literally said. In announcing its new test to determine separability, the Court twice misstates the statutory language. Justice Thomas requires for copyrightability that the feature can be perceived "separate from the useful article," and would qualify for copyright if "imagined separately from the useful article."⁹⁹ The statute, however, requires separation, not from the useful article, but from "the utilitarian aspects" of the useful article. The latter is a more exacting standard that is more likely to exclude features that contribute to an article's utility. The Court's misstatement is odd, given how closely the Court's test otherwise adheres to the statutory language. There is another comment in the Court's opinion that may support copyright protection even for functional features. Although again stated in the context of emphasizing that the useful article need not remain useful after separation, Justice Thomas said, "The statute does not require that we imagine a nonartistic replacement for the removed feature to determine whether that *feature* is capable of an independent existence."¹⁰⁰ This might indicate that the Court did indeed intend to include even designs that are specifically necessary to the optimal functioning of the useful article.

Judges and lawyers struggling to push back against allowing copyright in features that make an article more useful can emphasize that Justice Thomas' entire discussion of the utility of the identified feature, and of the elements of the useful article left behind, is arguably dicta. The discussion came in response to defendant Star Athletica's contention that Varsity's designs could not be protected because without them the uniforms would not be equally useful. But according to Star Athletica, the utilitarian aspects of the uniforms to which the designs contribute are "identifying the wearer as a cheerleader and enhancing the wearer's physical appearance."¹⁰¹ Neither purpose, however, may count as a "utilitarian function" under § 101's definition of a "useful article." That definition excludes the functions of portraying the appearance of the article or conveying information.¹⁰² Identifying

⁹⁹ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007, 1017 (2017) (reciting virtually identical formulations).

¹⁰⁰ *Id.* at 1014.

¹⁰¹ *Id.*

¹⁰² 17 U.S.C. § 101 (2012) (definition of "useful article"). *See, e.g.*, *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320 (2d Cir. 1996) (animal mannequins used in taxidermy are not useful articles since the function of the forms is to portray their own appearance); *Masquerade Novelty, Inc. v. Unique Indus.*,

the wearer as a cheerleader is an informational function, and enhancing the wearer's appearance may well be attributed to the mere appearance of the article itself.¹⁰³ Thus, the designs may not have contributed to the "utility" of the dresses at all, and hence it was unnecessary to decide whether a useful article must be equally useful without the separated features. Another doctrinal tool may also become increasingly relevant as part of post-*Star Athletica* efforts to maintain the traditional separation between copyright and patent.¹⁰⁴ The Court in *Star Athletica* did not hold that Varsity's designs were protected by copyright—merely that they were "separable from the uniforms and eligible for copyright protection."¹⁰⁵ "We do not today hold that the surface decorations are copyrightable."¹⁰⁶ Like all works seeking the benefits of copyright protection, separable design features must still satisfy the usual requirements of fixation, originality, and creativity.¹⁰⁷ Features whose designs reflect functional necessities due to the lack of alternatives designs capable of fulfilling that utilitarian function may be barred from copyright by the merger doctrine.¹⁰⁸

The impact of *Star Athletica* will turn primarily on the interpretation of its test for separability. That test bears repeating:

Inc., 912 F.2d 663 (3d Cir. 1990) (animal nose masks are not useful articles since their only utility derives from portraying their appearance).

¹⁰³ Cf. Ginsburg, *supra* note 37, at 23 ("'aesthetic functionality' is not a utilitarian function in the copyright sense").

¹⁰⁴ See *supra* note 96.

¹⁰⁵ 137 S. Ct. at 1012 (footnote omitted).

¹⁰⁶ *Id.* at 1012 n.1.

¹⁰⁷ See 17 U.S.C. § 102(a) (2012) ("[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression"). See also *infra* notes 155–67.

¹⁰⁸ See *infra* notes 155–67. Two post-*Star Athletica* decisions have already pushed back against copyright protection for utilitarian features. In *Silvertop Associates, Inc. v. Kangaroo Manufacturing, Inc.*, 1:17-cv-7919 (NLH/KMW), 2018 WL 2427120 (D.N.J. May 5, 2018), the court refused to extend protection to the cutout holes on a banana costume because they performed the utilitarian function of making the costume wearable. The Copyright Office Review Board reversed a refusal to register the pattern on an automobile floor liner only after the applicant represented that "this specific decorative pattern serves no utilitarian purpose." *In re Floor Liner*, U.S. Copyr. Office Rev. Bd. (Apr. 19, 2018) (www.copyright.gov/rulings-filings/review-board/index.html); cf. 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 Separability Test*, 36 CARDOZO ARTS & ENT. L.J. 149, 178 (2018) ("[T]here is a significant risk that some courts, when applying the new two-part test, will afford copyright protection to utilitarian features of useful articles that should be left in the public domain.").

We hold that 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 protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.¹⁰⁹

How is this test likely to be interpreted?

IV. *STAR ATHLETICA*—WHAT IT MIGHT MEAN

A. *Separate Identification*

The first element of the Supreme Court’s new test for copyright in the designs of useful articles requires that the design “can be perceived as a two- or three-dimensional work of art separate from the useful article.”¹¹⁰ To Justice Thomas, this criterion appears to be little more than a requirement of specific identification. “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.”¹¹¹ The requirement thus serves to define the boundaries of the plaintiff’s claim. In a subsequent reiteration of the issue, Justice Thomas rephrased the two elements: “The ultimate separability question, then, is whether the feature for which copyright protection is claimed” would satisfy the second of the Court’s criteria.¹¹² Application of this first element to the cheerleading uniforms in *Star Athletica* was “straightforward.”¹¹³ “First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities.”¹¹⁴ The separate identification element apparently serves a function analogous to the general requirement of fixation. Copyright is available only to works that are “fixed in any tangible medium of

¹⁰⁹ *Star Athletica*, 137 S. Ct. at 1007.

¹¹⁰ *Id.* at 1007, 1016.

¹¹¹ *Id.* at 1010.

¹¹² *Id.* at 1011.

¹¹³ *Id.* at 1012.

¹¹⁴ *Id.*

expression,”¹¹⁵ which ensures that the boundaries of the work are sufficiently defined to assess questions of copyrightability and infringement.¹¹⁶

Read literally, the first element sets a higher—and more uncertain—benchmark. In the two most formal recitations of the element, Justice Thomas speaks of perceiving a two- or three-dimensional “work of art” separate from the useful article.¹¹⁷ That description invites mischief. “Work of art” is not a category of copyrightable work under the 1976 Act.¹¹⁸ The phrase may prompt litigants or judges to incorporate assessments of artistic merit into the determination of separability, with the inevitable discrimination in favor of representational or traditional art.¹¹⁹ However, there is no indication that the Court intended to invite such an inquiry. Justice Thomas appears to have employed the “work of art” terminology simply as shorthand for the statutory category of “pictorial, graphic, or sculptural” work. In his application of the first element to the designs of the cheerleading uniforms, for example, he separately identifies the decorations not as “works of art,” but as “features having pictorial, graphic, or sculptural qualities.”¹²⁰ In another description of the criterion, Justice Thomas speaks of spotting “some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.”¹²¹ It would be unfortunate if the apparently casual reference to “work of art” prompts courts to engraft an assessment of artistic merit onto the first of the Court’s required elements.

B. *Independent Existence*

The second part of the Court’s test requires that the separately identified two- or three-dimensional feature “would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is

¹¹⁵ 17 U.S.C. § 102(a) (2012).

¹¹⁶ See, e.g., *Kelley v. Chicago Park Dist.*, 635 F.3d 290, 304–05 (7th Cir. 2011) (“Moreover, a garden is simply too changeable to satisfy the primary purpose of fixation; its appearance is too inherently variable to supply a baseline for determining questions of copyright creation and infringement.”).

¹¹⁷ 137 S. Ct. at 1007, 1017.

¹¹⁸ See 17 U.S.C. § 102(a) (2012).

¹¹⁹ See *infra* note 173 and accompanying text.

¹²⁰ *Star Athletica*, 137 S. Ct. at 1012.

¹²¹ *Id.* at 1010.

incorporated.”¹²² This is a perplexing criterion. Literally, the test seems to add little to the first criteria, which requires the identification of a two- or three-dimensional element. The definition of “pictorial, graphic, and sculptural works” includes “two-dimensional and three-dimensional works of fine, graphic, and applied art”¹²³ Virtually all two- or three-dimensional features imaginatively separated from a useful article would appear to be pictorial, graphic, or sculptural works under that definition.¹²⁴ A subsequent attempt to explain the requirement does little to clarify its scope. “The ultimate separability question, then, is 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 before being applied to a useful article.”¹²⁵ This too initially appears to exclude almost nothing, since if the two- or three-dimensional feature had not been part of a useful article, it would have been eligible for protection as a pictorial, graphic, or sculptural work under the statutory definition. Perhaps the most significant—and Delphic—comment by the Court is its statement that “[i]f 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.”¹²⁶ How can a separated two- or three-dimensional feature *not* be capable of existing as a pictorial, graphic, or sculptural work? The answer to that question, and the heart of the Court’s separability analysis, lies in the opening sentence of the succeeding paragraph of Justice Thomas’ opinion: “[o]f course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or ‘[a]n article that is normally a part of a useful article’ (which is itself considered a useful article).”¹²⁷

The requirement that the extracted feature “would qualify as a protectable pictorial, graphic, or sculptural work” if imagined separately is apparently intended to test whether that feature is itself still a useful article.¹²⁸ Separated features that are

¹²² *Id.* at 1007, 1016.

¹²³ 17 U.S.C. § 101 (2012) (definition of “pictorial, graphic, and sculptural works”).

¹²⁴ According to the legislative history, “[t]he definition of ‘pictorial, graphic, and sculptural works’ carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic quality.” H.R. REP. NO. 94-1476, at 54.

¹²⁵ *Star Athletica*, 137 S. Ct. at 1011.

¹²⁶ *Id.* at 1010.

¹²⁷ *Id.*

¹²⁸ *Id.* at 1016.

useful articles do not qualify for protection as pictorial, graphic, or sculptural works.¹²⁹ The feature need not be a “whole” useful article; as Justice Thomas notes, the definition of “useful article” includes features that are “normally a part of a useful article.”¹³⁰ This interpretation appears to be confirmed by the Court’s application of the test to the designs incorporated into the cheerleading uniforms. After identifying the designs as two-dimensional features separate from the uniforms under the first element of its test, Justice Thomas applied the second criterion and found that the separated designs would qualify for protection under § 101.¹³¹ He specifically emphasized that “imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself.”¹³² That is, identifying and imaginatively separating the designs does not bring along the useful article—the cheerleading uniforms. This prohibition against copyright in separated features that “replicate” a useful article, in whole or in part, is central to the Court’s analysis, and indeed explains the disagreement between the majority and Justices Breyer and Kennedy, who would hold that the designs are not separable from the cheerleading uniforms and hence are uncopyrightable.¹³³ Their dispute is in essence an argument about what counts as a “replication” of a useful article that precludes the separated design feature from qualifying as a pictorial, graphic, or sculptural work on its own.

To Justice Breyer, separately-identified design features that create a “picture” of the useful article thereby “replicate” it and are thus ineligible for copyright.¹³⁴ He would ask if a person can “conceive of the design features separately without replicating a picture of the utilitarian object?”¹³⁵ If the answer is “yes,” the design is eligible for copyright protection.¹³⁶

¹²⁹ *Id.* at 1013–14 (“[B]ecause the removed feature may not be a useful article—as it would then not qualify as a pictorial, graphic, or sculptural work . . .”).

¹³⁰ 17 U.S.C. § 101 (2012) (definition of “useful article”).

¹³¹ *Star Athletica*, 137 S. Ct. at 1012.

¹³² *Id.*

¹³³ *Id.* at 1030 (Breyer, J., dissenting).

¹³⁴ *Id.* at 1031 (“A picture of the relevant design features, whether separately ‘perceived’ on paper or in the imagination, is a picture of, and thereby ‘replicate[s],’ the underlying useful article of which they are part.”).

¹³⁵ *Id.*

¹³⁶ *Id.*

In many or most cases, to decide whether a design or artistic feature of a useful article is conceptually separate from the article itself, it is enough to imagine the feature on its own and ask, “Have I created a picture of a (useful part of a) useful article?” If so, the design is not separable from the useful article. If not, it is.¹³⁷

This conception of replication led directly to his conclusion that Varsity’s designs were not separable from the underlying uniforms: “Were I to accept the majority’s invitation to ‘imaginatively remov[e]’ the chevrons and stripes *as they are arranged* on the neckline, waistline, sleeves, and skirt of each uniform, and apply them on a ‘painter’s canvas,’ . . . that painting would be of a cheerleader’s dress.”¹³⁸ Justice Thomas responded directly: “[t]he dissent argues that the designs are not separable because imaginatively removing them from the uniforms and placing them in some other medium of expression—a canvas, for example—would create ‘pictures of cheerleader uniforms.’ . . . This is not a bar to copyright.”¹³⁹ He offered the example of a decorated guitar.

[C]onsider, for example, a design etched or painted on the surface of a guitar. If that entire design is imaginatively removed from the guitar’s surface and placed on an album cover, it would still resemble the shape of a guitar. But the image on the cover does not ‘replicate’ the guitar as a useful article.¹⁴⁰

If the purpose of the “replication” inquiry is to distinguish features that can qualify separately as protectable pictorial, graphic, or sculptural works from features that are ineligible because they are useful articles, Justice Breyer’s conception of “replication” is off the mark. A picture of a useful article is not itself a useful article under the statutory definition since its only utilitarian function is to portray its appearance or convey information.¹⁴¹ Such a picture fits comfortably within the statute’s definition of “pictorial, graphic, and sculptural works.”¹⁴² More importantly, permitting copyright protection for separated design features that might “picture” the useful article does not give the copyright owner any exclusive rights in

¹³⁷ *Id.* at 1033.

¹³⁸ *Id.* at 1035.

¹³⁹ *Id.* at 1012 (majority opinion).

¹⁴⁰ *Id.*

¹⁴¹ See 17 U.S.C. § 101 (2012) (definition of “useful article”).

¹⁴² See *id.* (definition of “pictorial, graphic, and sculptural works”).

the “pictured” article itself. Both the majority and dissent clearly recognize this fact. As Justice Thomas notes, “Nor could someone claim a copyright in a useful article merely by creating a replica of that article in some other medium Although the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.”¹⁴³ Justice Breyer agrees, citing § 113(b) for the proposition that copyright in a work portraying a useful article does not extend to the manufacture of the article itself.¹⁴⁴ Thus, there is no reason to deny copyright protection to separately-identified features of a useful article solely on the ground that they continue to depict or picture the useful article after separation.

It is unfortunate the Supreme Court chose a dispute involving graphic designs on cheerleading uniforms as the vehicle to expound on the rules governing copyright in useful articles. Two-dimensional design cases are usually straightforward. The two-dimensional features are easily identified and imaginatively separated from the underlying useful article, and the separated features themselves will almost never be

¹⁴³ 137 S. Ct. at 1010.

¹⁴⁴ *Id.* at 1033 (Breyer, J., dissenting). Section 113(b) of the Copyright Act does not actually state that copyright in a work that portrays a useful article affords no protection against the manufacture of the depicted article. 17 U.S.C. § 113(b) (2012). Instead, it states that the copyright owner of such a work has no “greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed” than those afforded under the law prior to the effective date of the 1977 Act. *Id.* In a *Supplementary Register’s Report on the General Revision of the U.S. Copyright Law*, the Register of Copyrights identified two lines of relevant cases. HOUSE COMM. ON THE JUDICIARY, 89TH CONG., 1ST SESS. 48 n.2 (1965) [hereinafter *Supplementary Register’s Report*]. One line included *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 188 (S.D.N.Y. 1934), which held that copyright in a drawing of a dress “secured no exclusive monopoly of the dress shown in the drawing.” *Supplementary Register’s Report, supra*, at 48 n.2. It also included *Kashins v. Lightmakers*, 155 F. Supp. 202 (S.D.N.Y. 1956), holding that the plaintiff’s copyrighted catalog containing photographs of its lamps was not infringed by the defendant’s manufacture of similar lamps or the subsequent publication of a catalog containing photographs of the imitations. *Supplementary Register’s Report, supra*, at 48 n.2. The other line of cases identified in the *Supplementary Register’s Report* consisted of two decisions holding that copyright in two-dimensional cartoon characters was infringed by three-dimensional dolls, and *Jones Brothers Co. v. Underkoffler*, 16 F. Supp. 729 (M.D. Pa. 1936), which ruled that copyright in a drawing of a cemetery monument was infringed by construction of the depicted monument. *Supplementary Register’s Report, supra*, at 48 n.2. The latter cases, however, do not involve depictions of “useful articles” not themselves copyrightable. The *Supplementary Register’s Report* surprisingly concluded that the Copyright Office had “been unable to find any statutory formulation that would express the distinction satisfactorily.” *Id.* at 48. The result is the extraordinary cop-out in § 113(b). Case law under § 113(b) has nevertheless consistently interpreted the subsection as denying copyright owners protection against manufacture of the depicted useful article. *See, e.g.*, *Donald Frederick Evans and Assocs., Inc. v. Continental Homes, Inc.*, 785 F.2d 897, 901 n.7 (11th Cir. 1986); *Forest River, Inc. v. Heartland Recreational Vehicles, LLC*, 753 F. Supp. 2d 753 (N.D. Ind. 2010); *Combustion Eng’g, Inc. v. Murray Tube Works, Inc.*, 222 U.S.P.Q. 239, 244 (E.D. Tenn. 1984).

disqualified as a useful article. They would be copyrightable under virtually any understanding of separability. As the legislative history notes, “A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like.”¹⁴⁵ Resolving a dispute over three-dimensional features might have propelled the Court toward a more nuanced analysis.

C. *Three-Dimensional Design Features*

The first of the Court’s two requirements for copyright—separate identification—is no more troublesome for three-dimensional features than for two-dimensional designs. “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.”¹⁴⁶ A three-dimensional design feature clearly possesses “sculptural qualities.” The second requirement—independent existence—is potentially more problematic for three-dimensional features since, unlike two-dimensional designs, they are more likely to still be “useful articles” and thus less likely to satisfy the criteria that the feature “qualify as a protectable pictorial, graphic, or sculptural work” if imagined separately.¹⁴⁷ This is especially true in view of the fact that “[a]n article that is normally a part of a useful article is considered a ‘useful article.’”¹⁴⁸ Three-dimensional designs, in other words, are more likely to “replicate” in whole or in part the useful article from which they have been separated.

When is a three-dimensional design feature still a useful article (or a normal part thereof) and thus unprotectable as a sculptural work even when imagined separately? Obviously, the fact that the three-dimensional feature was *literally* a part of a useful article cannot itself disqualify the feature under the separability test since no feature would then ever survive the test. The Court’s endorsement of *Mazer* and its dancing figure lamp base also emphasizes that the focus is on the “separately

¹⁴⁵ H.R. REP. NO. 94-1476, at 55. Testifying on Copyright Office practices under its earlier separability regulation, the Register of Copyrights stated, “[V]irtually all original two-dimensional designs for useful articles, such as textile fabrics, wallpaper, floor tiles, painted or printed decorations, and so forth, were subject to copyright registration.” HEARINGS ON H.R. 2223 BEFORE THE SUBCOMM. ON COURTS, CIVIL LIBERTIES AND THE ADMIN. OF JUSTICE OF THE HOUSE JUD. COMM., 94TH CONG., 1ST SESS. 1857 (1975).

¹⁴⁶ *Star Athletica*, 137 S. Ct. at 1010.

¹⁴⁷ *Id.* at 1016.

¹⁴⁸ 17 U.S.C. § 101 (2012) (defining “useful article”).

identified feature”¹⁴⁹ itself rather than the generic role the feature plays in the useful article. A lamp base, for example, is presumably “normally a part of a useful article,” but a dancing figure is not, and it therefore remains eligible for copyright as a sculptural work despite its utilitarian use as a lamp base.¹⁵⁰ Justice Thomas was also clear that the marketability of the separately-imagined feature as a work of art is irrelevant, citing the danger of “substitut[ing] judicial aesthetic preferences for the policy choices embodied in the Copyright Act.”¹⁵¹ The marketability test is chiefly associated with Professor Melville Nimmer, author of a standard treatise on copyright law.¹⁵² The test had made periodic appearances in the case law.¹⁵³ It required predictions about markets that typically did not exist and seemed a questionable proxy for separability since some clearly separable designs—wallpaper patterns, for example—might have no independent market value as art. More generally, the opinions in *Star Athletica* leave no role for assessments of artistic merit in determining whether a separated feature is a useful article and is hence unprotectable as a pictorial, graphic, or sculptural work. An imagined-as-art test had occasionally been propounded by scholars¹⁵⁴ and judges.¹⁵⁵ The test directly

¹⁴⁹ See *Star Athletica*, 137 S. Ct. at 1010.

¹⁵⁰ See also Justice Breyer’s example of a porcelain Siamese cat used as lamp base. *Id.* at 1032 (Breyer, J., dissenting). Imagining the cat separately “does not replicate the lamp.” *Id.*

¹⁵¹ 137 S. Ct. at 1015 (“Nothing in the statute suggests that copyrightability depends on market surveys.”).

¹⁵² 1 NIMMER & NIMMER, *supra* note 86, at § 2A.08[B][4] (“[I]t may be concluded that conceptual separability exists when there is any 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.”).

¹⁵³ See, e.g., *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 421 (5th Cir. 2005); *Magnussen Furniture, Inc. v. Collezione Europa USA, Inc.*, 116 F.3d 472 (4th Cir. 1997) (unpublished table decision); *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 421–22 (2d Cir. 1985) (Newman, J., dissenting).

¹⁵⁴ See Perlmutter, *supra* note 37, at 377 (emphasizing “the ordinary observer’s ability to perceive the object as a work of art”).

¹⁵⁵ See, e.g., *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404, 1414 (11th Cir. 2015) (wood grain design might be framed and hung on the wall as art); *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 423 (2d Cir. 1985) (Newman, J., dissenting) (inquiring whether an observer could conceive of the design as a work of art without at the same time contemplating its utilitarian function); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (separating the “primary ornamental aspect” from the “subsidiary utilitarian function”). *Contra Brandir Int’l v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987) (“It is unnecessary to determine whether to the art world the RIBBON Rack properly would be considered an example of minimalist sculpture. The result under the copyright statute is not changed.”); *Carol Barnhart, supra*, at 419 n.5 (“Almost any utilitarian article may be viewed by some separately as art . . .”).

contradicts the legislative history, which states that “even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable.”¹⁵⁶ Results that turn on aesthetic appreciation cannot implement the legislative distinction between applied art and industrial design. Justice Breyer in dissent was at pains to emphasize the danger of a test focused on “whether the design can be imagined as a ‘two- or three-dimensional work of art.’”¹⁵⁷ Justice Thomas appeared to appreciate the concern; “[b]ut a shovel, like a cheerleading uniform, even if displayed in an art gallery, is ‘an article having an intrinsic utilitarian function’”¹⁵⁸

Consider the “shape, cut, and dimensions” of a cheerleading uniform or the shape of a shovel. Both are outside the scope of copyright according to Justice Thomas despite their obvious three-dimensional sculptural qualities.¹⁵⁹ Why are they disqualified as useful articles while the *Mazer* statuette employed as a lamp base is not? The answer can be found in the definition of a “useful article.” Having a utilitarian function is not itself sufficient to satisfy the statutory definition. The utilitarian function must be “intrinsic” to the article.¹⁶⁰ A sculpture of a dancing figure can be used as a doorstop, paperweight, lamp base, bookend, hat rack, even a hammer, etc. But those functions are arguably not “intrinsic” to the article, and thus the sculpture, once identified and imagined separately from any useful article of which it may be part, is protectable as a sculptural work that satisfies the test of separability propounded in *Star Athletica*.¹⁶¹ We also know from *Mazer* that the fact

¹⁵⁶ H.R. REP. NO. 94-1476, at 55.

¹⁵⁷ 137 S. Ct. at 1033 (Breyer, J., dissenting). “That is because virtually any industrial design can be thought of separately as a ‘work of art.’” *Id.*

¹⁵⁸ 137 S. Ct. at 1013 n.2.

¹⁵⁹ *Id.* at 1013 (“[R]espondents have no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear.”). “But a shovel as a shovel cannot [be copyrighted].” *Id.* at 1013 n.2.

¹⁶⁰ 17 U.S.C. § 101 (2012) (definition of “useful article”) (“an article having an *intrinsic* utilitarian function”) (emphasis added).

¹⁶¹ According to the COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES, “[a] work of authorship that does not have an intrinsic utilitarian purpose is not considered a useful article, even if that work could potentially be used in a functional manner.” U.S. COPYRIGHT OFFICE, *supra* note 79, § 924.1; *cf.* *Boyd's Collection, Ltd. v. Bearington Collection, Inc.*, 365 F. Supp. 2d 612, 617 (M.D. Pa. 2005) (“That clothes for a doll could *hypothetically* have a utilitarian function, such as protection or preservation, does not alter this conclusion [that the clothes were not used in this case as useful articles]. Classification of a design as

that a design was created with a specific utilitarian function in mind is not in itself sufficient to make that function “intrinsic” and thus make the resulting article a “useful article.” The statuettes held copyrightable in that case were specifically created for use as lamp bases.¹⁶² The three-dimensional design features of a dress or a shovel, on the other hand, are apparently considered by the Court to have intrinsic utilitarian functions and thus they remain useful articles even when imagined separately. What makes a utilitarian function “intrinsic” to an article? The most relevant definition in the *Oxford English Dictionary* (cited three times by Justice Thomas for its definitions of “design,” “capable,” and “applied”)¹⁶³ is “[b]elonging to the thing in itself, or by its very nature; inherent, essential, proper; ‘of its own.’”¹⁶⁴ The definition apparently rests on a metaphysical distinction between *being* a hammer and merely being *used* as a hammer. It is obviously an elusive standard, but it is the standard that the statute stipulates once the question of separability is made to turn on whether the separately-identified feature is a “useful article” and thus not copyrightable as a pictorial, graphic, or sculptural work.

The narrowest interpretation of an “intrinsic” utilitarian function might limit the concept to situations in which an article’s design is *dictated* by that function. Indeed, one treatise writer has promoted the “dictated” standard as the ultimate test for separability.¹⁶⁵ That standard would exclude almost nothing from copyright since very few utilitarian designs are *dictated* by function. The shape of car bodies and dresses are not *dictated* by their function—hence the multitude of different car models and designer gowns that all accommodate the underlying utilitarian functions. The legislative history of the separability test is clear that “even if the appearance of an article is determined by aesthetic (as opposed to functional)

a ‘useful article’ is not an all-or-nothing proposition; the issue must be addressed on a case-by-case basis.”).

¹⁶² *Star Athletica*, 137 S. Ct. at 1011.

¹⁶³ *Id.* at 1009–10, 1014.

¹⁶⁴ Definition of “intrinsic,” OXFORD ENG. DICTIONARY, <https://en.oxforddictionaries.com/definition/intrinsic> (last visited Mar. 29, 2018).

¹⁶⁵ 2 PATRY, *supra* note 56, at § 3:146 (“The inquiry here is simply whether the pictorial, graphic, or sculptural features are dictated by the form or function of the utilitarian aspects of the useful article. If they are, they are not capable of existing independently of those aspects. If the pictorial, graphic, or sculptural features are *not* dictated by the form or function of the utilitarian aspects of the useful article, they can be said to be capable of existing independently of those aspects and hence are protectable.”). *See also* Shahshahani, *supra* note 76, at 860, arguing that copyright should be denied only when protection would inhibit the efficient production of the useful article.

considerations,”¹⁶⁶ the separability test is still applicable. The Court itself in *Star Athletica* interpreted its separability standard to deny protection for the shape, cut, and dimensions of the uniforms, despite the fact that those features were clearly not dictated by their utilitarian functions. The cases interpreting the definition of “useful article” have never required that the design be *dictated* by function. In the rare instance in which the design of a feature is in fact dictated by the function it must perform, that design would usually be barred from copyright in any case by the merger doctrine.¹⁶⁷

¹⁶⁶ H.R. REP. NO. 94-1476, at 55. *See also, e.g.*, U.S. COPYRIGHT OFFICE, *supra* note 79, § 924.2(B) (“The fact that a useful article could have been designed differently or the fact that an artistic feature is not necessary to or dictated by the utilitarian aspects of that article is irrelevant to [the separability] analysis.”); Ginsburg, *supra* note 37, at 2 (“Whatever ‘separability’ means, it excludes more designs than would a test that merely inquires whether there exist other designs for the same kind of useful article.”).

¹⁶⁷ Separability determines whether design features of useful articles are *eligible* for copyright as pictorial, graphic, or sculptural works. However, qualifying works must still meet the normal standards for copyright. As Justice Thomas noted, the decision in *Star Athletica* did “not today hold that the surface decorations are copyrightable.” *Star Athletica*, 137 S. Ct. at 1012 n.1. The standards of copyrightability are set out in § 102(a) of the Copyright Act. 17 U.S.C. § 102(a) (2012). Copyright subsists “in original works of authorship fixed in any tangible medium of expression. . . .” *Id.* Fixation in some imagined medium is assumed as part of Judge Thomas’ separability test. The work must also be “original,” which in copyright law means only that the work must be an independent creation as opposed to a copy of a preexisting work. *E.g.*, *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951) (“‘Original’ in reference to a copyrighted work means that the particular work ‘owes its origin’ to the ‘author.’”) (quoting *Burrow-Giles Lithographic Co. v. Saroni*, 111 U.S. 53, 57–58 (1884)). “Originality in this context ‘means little more than a prohibition of actual copying.’” *Id.* at 103 (quoting *Hoague-Sprague Corp. v. Frank C. Meyer, Inc.*, 31 F.2d 583, 586 (E.D.N.Y. 1929)). The work, however, must also be “a work of authorship,” which according to the Supreme Court in *Feist Publications v. Rural Telephone Service*, 499 U.S. 340, 345 (1991), requires that “it possesses at least some minimal degree of creativity.” In *Feist*, the Court embraced a quantitative standard, demanding only “more than a *de minimis* quantum of creativity,” *id.* at 363, and noted, “[t]o be sure, the requisite level of creativity is extremely low; even a slight amount will suffice.” *Id.* at 345. The graphic designs held separable in *Star Athletica* might well have pushed up against even this minimal requirement of creativity. However, on remand from the Supreme Court, the plaintiff reached a settlement with the defendant’s insurer and the case was dismissed over the objection of the defendant. *Varsity Brands, Inc. v. Star Athletica, LLC*, 2017 WL 3446292 (W.D. Tenn. 2017).

If the design of a product feature is dictated by the function it must serve, another limitation on copyright becomes relevant. As summarized by Professor Goldstein, “Courts will withhold copyright even from a work’s original expression in cases where the work’s underlying idea can effectively be expressed in only one way.” 1 GOLDSTEIN, *supra* note 5, § 2.3.2. This limitation is designed to implement the exclusion from copyright of “any idea, procedure, process, system, method of operation, concept, principle, or discovery,” 17 U.S.C. § 102(b) (2012), in circumstances in which there is a merger of the idea and its expression. The “merger” doctrine is often traced to the Supreme Court’s decision in *Baker v. Selden*, 101 U.S. 99 (1879) (forms necessary to implement an accounting system are not copyrightable). It has been extended to situations in which an idea can be expressed in only a limited number of ways. *See, e.g.*, *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763 (9th Cir. 2003); *Morrissey v. Procter & Gamble*

Aside from being dictated by function, what else might render a design's utilitarian function "intrinsic" and thus leave the design unprotectable as a useful article even when imagined separately? Several decades ago, I wrote an article arguing that the separability of design features from the utilitarian aspects of useful articles should turn on the extent to which the design reflects utilitarian as opposed to aesthetic influences.¹⁶⁸ That approach was adopted by the Second Circuit in *Brandir International, Inc. v. Cascade Pacific Lumber Company*,¹⁶⁹ and also made appearances in other circuits.¹⁷⁰ The approach was suggested to the Supreme Court as a test for separability in *Star Athletica*.¹⁷¹ Justice Thomas rejected it, commenting that the approach "would require the decisionmaker to consider evidence of the creator's design methods, purposes, and reasons. . . . The statute's text makes clear, however, that our inquiry is limited to how the article and feature are perceived, not how or why they were designed."¹⁷² From this perspective, the issue is now whether we would perceive the design feature as being a useful article, or a normal part

Co., 379 F.2d 675 (1st Cir. 1967). The doctrine has been frequently summoned to limit the protection of software code. *See, e.g.*, *Computer Associates Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992); 4 NIMMER & NIMMER, *supra* note 86, § 13.03[F][1]–[3]. If copyright protection for a separated design feature would effectively monopolize the underlying idea, method of operation, concept, or discovery, the merger doctrine can be invoked to deny protection. 1 GOLDSTEIN, *supra* note 5, § 2.5.3 ("If an industrial design's shape is mandated by its function, copyright law's merger doctrine would bar protection in any event.") (footnote omitted).

¹⁶⁸ *See generally* Denicola, *supra* note 37. "The exclusion of industrial design from the scope of copyright is best understood as an attempt to bar forms influenced in significant measure by utilitarian concerns. Thus, copyright is reserved to product features and shapes that reflect even in their utilitarian environment the unconstrained aesthetic perspective of the artist." *Id.* at 748.

¹⁶⁹ 834 F.2d 1142, 1145 (2d Cir. 1987) ("To state the Denicola test in the language of conceptual separability, if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.").

¹⁷⁰ *See, e.g.*, *Pivot Point Int'l v. Charlene Prods., Inc.*, 372 F.3d 913, 931 (7th Cir. 2004) ("This independence is necessarily informed by 'whether the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences.' *Brandir*, 834 F.2d at 1145."); *Universal Furniture Int'l v. Collezione Europa USA, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010) ("As in *Pivot Point*, Mr. Russell's process reflects an 'artistic judgment exercised independently of functional influences.' 372 F.3d at 931.").

¹⁷¹ *Star Athletica*, 137 S. Ct. at 1015.

¹⁷² *Id.* Perhaps *Brandir*'s inquiry into utilitarian design influences will retain relevance, not as a direct test for separability, but to inform the determination of whether a utilitarian function is "intrinsic" for purposes of applying the second portion of the Supreme Court's new separability test. *See* Barton Beebe, *Star Athletica and the Problem of Panaestheticism*, 9 U.C. IRVINE L. REV. (forthcoming 2019).

thereof, even when it is imagined separately. What will determine this perception? The more the features of a design reflect a utilitarian function, the more likely we are to intuitively perceive that function as “intrinsic” to the article. The more likely we are, in other words, to perceive it as *being* a hammer and thus a useful article rather than a three-dimensional sculptural work merely capable of being *used* as a hammer. We perceive the shape of a car body or the design of a shovel or the three-dimensional designs of the uniforms in *Star Athletica*, for example, as having intrinsic utilitarian functions because their designs seem calculated to fulfill those functions. On the other hand, the statuette in *Mazer*, although used as a lamp base, is not perceived as a useful article after separation because its design does not appear to be specifically tailored for that use and thus we no longer recognize its utilitarian function after separation. If the statuette in *Mazer* survives the separability test because it is not perceived as a useful article once it is separated from the lamp, the same should be true of a more abstract sculptural work that has similarly been enlisted as a lamp base. In rejecting the marketability standard, Justice Thomas specifically sought to avoid any test that “threatens to prize popular art over other forms,” or rests on “judicial aesthetic preferences.”¹⁷³ However, perhaps a more “ordinary-looking” lamp base will still be perceived as part of a useful article even when imagined separately from the remainder of the lamp.

¹⁷³ *Id.* Judge Thomas quoted Justice Holmes’ sentiment in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903), that “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.” Similar concerns about artistic discrimination have frequently been expressed by courts struggling with the separability standard. Judge Oakes in *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145 n.3 (2d Cir. 1978), cautioned that

we judges should not let our own view of styles of art interfere with the decisionmaking process in this area. Denicola suggests that the shape of a Mickey Mouse telephone is copyrightable because its form is independent of function, and ‘[a] telephone shape owing more to Arp, Brancusi, or Moore than Disney may be equally divorced from utilitarian influence.’ [Denicola, *supra* note 37] at 746.

See also, e.g., *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985) (“We find no support in the statutory language or legislative history for the claim that merely because a utilitarian article falls within a traditional art form it is entitled to a lower level of scrutiny in determining its copyrightability.”). *But see* *Esquire, Inc. v. Ringer*, 591 F.2d 796, 805 (D.C. Cir. 1978) (“But we can see no justification, at least in the circumstances of this case, for extending the nondiscrimination principle of *Bleistein* to include action having an unintentional, disproportionate impact on one style of artistic expression. Such an extension of the nondiscrimination principle would undermine other plainly legitimate goals of copyright law in this case the congressional directive that copyright protection should not be afforded to industrial designs.”).

In its simplest form, *Star Athletica*'s test for separability appears to be whether we still perceive the separated feature as a useful article, or a normal part of a useful article, because we recognize its intrinsic utilitarian function even after we imagine it separately. Whether the perception of an intrinsic function can be informed by evidence relating to the factors that influenced the design is unclear.

D. *The Problem of Overall Shape*

Whether the overall shape of a useful article can ever be eligible for copyright protection has been a vexing question. The Copyright Office has been adamant that overall shapes can never satisfy the separability standard. *Esquire, Inc. v. Ringer*,¹⁷⁴ a mandamus action under the 1909 Copyright Act to compel the Copyright Office to register the overall design of outdoor lighting fixtures, remains the dominant precedent. The Copyright Office insisted that its regulation on separability¹⁷⁵ barred registration of the overall shape or configuration of useful articles,¹⁷⁶ and the court adopted that "reasonable and well-supported" interpretation.¹⁷⁷ The Ninth Circuit similarly deferred to the Copyright Office's position in *Inhale, Inc. v. Starbuzz Tobacco, Inc.*,¹⁷⁸ holding that the shape of a hookah water container used for smoking was not eligible for copyright under the 1976 Copyright Act.¹⁷⁹ The *Compendium of U.S. Copyright Office Practices* in effect at the time of the decision in *Star Athletica* continued the Copyright Office's refusal to recognize copyright in overall shape.¹⁸⁰

¹⁷⁴ 591 F.2d 796 (D.C. Cir. 1978).

¹⁷⁵ 37 C.F.R. § 202.10(c) (1959).

¹⁷⁶ *Esquire*, 591 F.2d at 800.

¹⁷⁷ *Id.*

¹⁷⁸ 755 F.3d 1038 (9th Cir. 2014). On a motion to reconsider following the decision in *Star Athletica*, the district court stated in dicta that a useful article as a whole was not eligible for copyright. *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 2017 WL 4163990 (C.D. Cal. 2017).

¹⁷⁹ Other cases holding the overall shapes of useful articles ineligible for copyright include *Progressive Lighting, Inc. v. Lowe's Home Centers, Inc.*, 549 Fed. Appx. 913, 921 (11th Cir. 2013) ("Our precedent makes clear that an entire useful article cannot receive copyright protection . . .") (overall shape and appearance of light fixtures not eligible for copyright) (unpublished); *Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983) (automobile wheel covers).

¹⁸⁰ U.S. COPYRIGHT OFFICE, *supra* note 79, § 924.2(B) ("Merely analogizing the general shape of a useful article to a work of modern sculpture or an abstract sculpture does not satisfy the conceptual separability test, because it does not provide an objective basis for visualizing the artistic features and the useful article as separate and independent works.") (citing *Esquire*, 591 F.2d at 804).

The arguments against copyright in overall shapes offered by the Copyright Office in *Esquire* are hardly compelling. The Copyright Office's brief to the court expressed concern that copyright for overall shape could extend to shapes mandated by the function of the article, thus providing the copyright owner with a monopoly over the sale of some useful products.¹⁸¹ In such cases, however, the merger doctrine already protects the public interest in access to the mandated feature.¹⁸² The brief also argued that consumer preference for uniformity of shape for certain useful articles would be undermined.¹⁸³ However, the requirement of originality, which prohibits copyright in pre-existing matter that has been copied by the claimant, would bar copyright claims in the traditional shapes of consumer goods.¹⁸⁴ Finally, the brief worried about claims to basic product shapes such as circles, squares, and rectangles.¹⁸⁵ These too, however, are already excluded from copyright by the originality requirement.¹⁸⁶ The complete exclusion of overall shapes cannot be reconciled with other decisions that demonstrate no such reluctance. The overall shapes of coin banks, for example, have consistently received protection when the normal prerequisites of copyright have been satisfied, despite their apparent status as useful articles.¹⁸⁷ Copyright has also been extended to the overall shape of products including bear paw slippers,¹⁸⁸ animal-shaped pajama bags,¹⁸⁹ back packs,¹⁹⁰ and pencil sharpeners.¹⁹¹

¹⁸¹ *Esquire*, 591 F.2d at 801 n.15.

¹⁸² See *supra* note 167. See also 1 GOLDSTEIN, *supra* note 5, § 2.5.3.

¹⁸³ *Esquire*, 591 F.2d at 801 n.15.

¹⁸⁴ See *supra* notes 166–67. See also 1 GOLDSTEIN, *supra* note 5, § 2.5.3; 1 NIMMER & NIMMER, *supra* note 86, § 2A.08[B][1][d].

¹⁸⁵ *Esquire*, 591 F.2d at 801 n.15.

¹⁸⁶ See *supra* notes 166–67. See also 1 GOLDSTEIN, *supra* note 5, § 2.5.3; 1 NIMMER & NIMMER, *supra* note 86, § 2A.08[B][1][d].

¹⁸⁷ See, e.g., *Goldman-Morgen, Inc. v. Dan Brechner & Co.*, 411 F. Supp. 382 (S.D.N.Y. 1976); *Royalty Designs, Inc. v. Thriftcheck Serv. Corp.*, 204 F. Supp. 702 (S.D.N.Y. 1962). Cf. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976) (copyright in “Uncle Sam” bank invalid for lack of originality).

¹⁸⁸ *Animal Fair, Inc. v. AMFESCO Indus.*, 620 F. Supp. 175 (D. Minn. 1985).

¹⁸⁹ *R. Dakin & Co. v. A & L Novelty Co.*, 444 F. Supp. 1080 (E.D.N.Y. 1978).

¹⁹⁰ *Act Young Imports, Inc. v. B and E Sales Co.*, 667 F. Supp. 85 (S.D.N.Y. 1986).

¹⁹¹ *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (pencil sharpener shaped like an antique telephone).

Star Athletica offers no definitive statement on the status of overall shapes. Two comments, however, could be read to support the Copyright Office's long-standing exclusionary rule. The Court describes its separability test as applicable to a "feature" of the design of a useful article, arguably referring to something less than the whole of the design. In context, however, that term can equally be understood simply as the label for whatever subject matter the claimant seeks to copyright.¹⁹² Second, Justice Thomas, at one point, states that "there necessarily would be some aspects of the original useful article 'left behind' if the feature were conceptually removed,"¹⁹³ again perhaps implying that the claim cannot relate to the entire shape. That comment, however, is made only in the context of emphasizing that the "imagined remainder"¹⁹⁴ need not be a functioning useful article.

Can any overall shapes survive the Supreme Court's new test for separability, which asks whether the identified subject matter is eligible for protection as a pictorial, graphic, or sculptural work or ineligible because it is a useful article? Justice Thomas assures us that two-dimensional pictorial features can satisfy that test even if their shape corresponds to the surface shape of the useful article on which they appear—a design etched on a guitar or a fresco painted on a dome, for example—because the features do not replicate the useful articles.¹⁹⁵ Can three-dimensional sculptural features whose shapes correspond to the overall shape of a useful article similarly survive if they too do not replicate the useful article? We know from *Star Athletica* that the overall shape of a cheerleading uniform and a shovel do not satisfy the separability standard because they are useful articles.¹⁹⁶ The same is undoubtedly true of the overall shapes of most useful articles. But the overall shape of a useful article is not *always* itself a useful article. The shape can qualify for copyright as a pictorial, graphic or sculptural work, provided that it does not have an "*intrinsic* utilitarian function" as required under the statute's definition of "useful article."¹⁹⁷ Consider again the statuette used as a lamp base in *Mazer*. Assume that the 1950's manufacturer ran a more diversified business, offering, in addition to

¹⁹² Under the definition of "useful article," an article that is normally a part of a useful article is itself considered a "useful article." 17 U.S.C. § 101 (2012) (definition of "useful article"). Thus, protection for the shape of a part of a larger useful article technically covers the overall shape of a "useful article."

¹⁹³ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1014 (2017).

¹⁹⁴ *Id.*

¹⁹⁵ *Id.* at 1012.

¹⁹⁶ *Id.* at 1013 n.2.

¹⁹⁷ 17 U.S.C. § 101 (2012) (definition of "useful article") (emphasis added).

lamps, matching cigarette lighters in which the head of an identical dancing figure lifts to expose the internal lighting mechanism. Or imagine the *Mazer* statuette as a coin bank or a Wi-Fi antenna. The statuette is now the overall shape of a useful article. It would be odd to conclude that the statuette is copyrightable when used as a lamp base, but not when the utilitarian aspects of the useful article have been internalized within the exact same sculptural work. The statuette is “separable” in all these contexts because once imagined separately it does not have an *intrinsic* utilitarian function. After separation, we no longer recognize it as a useful article. If the desire to preclude protection for overall shapes is based on the fear of extending copyright protection to industrial design,¹⁹⁸ that fear is overstated. Few overall shapes will survive the test in *Star Athletica*. Hostility toward the remaining few seems inconsistent with the Supreme Court’s new-found tolerance for exactly those outcomes.¹⁹⁹

V. OLD CASES AND NEW CASES

The new approach to separability propounded in *Star Athletica* can be evaluated by applying it to past disputes. Consider the contemporary outdoor street lights that were refused registration in *Esquire, Inc. v. Ringer*,²⁰⁰ or the automobile wheel covers that were denied copyright protection in *Norris Industries, Inc. v. International Telephone and Telegraph Corp.*²⁰¹ Those cases were decided under a rule that completely barred the overall shapes of useful articles. *Star Athletica* may invite a more nuanced analysis. Once imagined separately, are the overall shapes still perceived as having intrinsic utilitarian functions and thus disqualified as useful articles from receiving protection as sculptural works? In both cases, the answer is almost certainly “yes.” The shapes of the lights and wheel covers replicate the original useful articles, just as do the overall shapes of a dress or shovel. We perceive them as useful articles, and they thus fail to satisfy the separability standard.²⁰²

¹⁹⁸ *Esquire, Inc. v. Ringer*, 591 F.2d 796, 801 (D.C. Cir. 1978) (“In the Register’s view, registration of the overall shape or configuration of utilitarian articles would lead to widespread copyright protection for industrial designs.”).

¹⁹⁹ 137 S. Ct. at 1015 (“Congress has provided for limited copyright protection for certain features of industrial design, and approaching the statute with presumptive hostility toward protection for industrial design would undermine Congress’ choice.”).

²⁰⁰ *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978).

²⁰¹ *Norris Indus., Inc. v. Int’l Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983).

²⁰² The court in *Norris* responded to the claimant’s argument that since the wire wheel covers were not very efficient at keeping dirt and debris from reaching the wheels, they should not be considered useful articles. “As the Register observes, however, the efficiency of a utilitarian article is irrelevant for copyright

Consider next the face of the human head mannequin used by hair and make-up stylists in *Pivot Point International, Inc. v. Charlene Products, Inc.*²⁰³ According to the court, conceptual separability turned on “whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.”²⁰⁴ Judge Ripple said the mannequin’s facial features were the product of artistic choices, and hence were copyrightable.²⁰⁵ That focus on the design process is now barred by *Star Athletica*.²⁰⁶ However, the same lack of utilitarian influences on the facial design relied upon by Judge Ripple also make it unlikely that the specific face, once separated from the utilitarian article, will be perceived as a useful article under the test in *Star Athletica*. It is easy to recognize the separated face as an artistic work with no intrinsic utilitarian function and thus eligible for copyright as a pictorial, graphic, or sculptural work.

The two contemporary belt buckles held copyrightable in *Kieselstein-Cord v. Accessories by Pearl, Inc.*²⁰⁷ present a more difficult issue. The subject matter of the plaintiff’s claim was never quite clear. The Second Circuit’s opinion refers to the copyrightability of the plaintiff’s “belt buckles.”²⁰⁸ Considered as a whole, that claim may be problematic under *Star Athletica*. The overall shapes of belt buckles, even interestingly-designed ones, are still likely to be perceived as useful articles and hence ineligible for copyright as sculptural works. However, the court’s analysis seemed primarily focused on the surface contours of the buckles.²⁰⁹ A subsequent Second Circuit decision refers to the “ornamented surfaces of the buckles” in

purposes.” 696 F.2d at 922 n.8. That is an entirely sensible proposition. However, as the design becomes less and less efficient at accomplishing a utilitarian function, we may be less and less likely to perceive the design as having an intrinsic utilitarian purpose and thus less likely to recognize it as a useful article that is ineligible for copyright protection.

²⁰³ *Pivot Point Int’l v. Charlene Products, Inc.*, 372 F.3d 913 (7th Cir. 2004).

²⁰⁴ *Id.* at 931 (quoting *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987)).

²⁰⁵ *Id.*

²⁰⁶ *See supra* notes 168–73 and accompanying text.

²⁰⁷ *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980).

²⁰⁸ The first two sentence of the court’s opinion, for example, state, “This case is on a razor’s edge of copyright law. It involves belt buckles, utilitarian objects which as such are not copyrightable.” *Id.* at 990.

²⁰⁹ *See, e.g., id.* (“The Vaquero gives the appearance of two curved grooves running diagonally across one corner of a modified rectangle, and a third groove running across the opposite corner. On the Winchester buckle two parallel grooves cut horizontally across the center of a more tapered form, making a curving ridge which is completed by the tongue of the buckle.”).

Kieselstein-Cord,²¹⁰ perhaps analogous to a western belt buckle bearing an engraving of a covered wagon. If we understand the claimed features as limited to the surface designs, the court's decision, although not its analysis, may well survive *Star Athletica*. The Second Circuit relied on "the primary ornamental aspect" of the buckles, noting they had been accepted by the Metropolitan Museum of Art for its permanent collection and had been worn by users as ornamentation for parts of the body other than the waist.²¹¹ This focus on whether the work can be perceived as art is inconsistent with *Star Athletica*.²¹² The emphasis now is on whether the work is still perceived as a useful article. To the extent that the plaintiff's claim is focused on the surface contours of the buckles, the separated features have no intrinsic utilitarian function. They will not be perceived as useful articles and thus remain eligible for copyright as pictorial, graphic or sculptural works.

The Supreme Court's test for separability does not necessarily make hard cases easy. In *Carol Barnhart Inc. v. Economy Cover Corp.*,²¹³ the plaintiff claimed copyright in four human torso forms that were used to display clothing. The polystyrene forms, two male and two female, had hollow backs to hold the excess fabric of the displayed garments. One male and one female torso were unclad for the purpose of displaying shirts; the other two forms were sculpted with shirts in order to display sweaters and jackets.²¹⁴ The court held that the forms were not copyrightable under the separability test because their designs were "inextricably intertwined with the utilitarian feature, the display of clothes."²¹⁵ After *Star v. Athletica*, the result would not turn directly on the connection between form and function, but instead on whether that connection would lead us to perceive the forms as useful articles with an intrinsic utilitarian function. Their polystyrene construction is probably irrelevant since the copyright claim goes to the sculptural shape rather than the composition. Ultimately, the inquiry would be whether the hollowed-out backs and other features of the designs would cause an observer to perceive them as mannequins rather than as sculptures of human torsos—a question with no easy answer.

²¹⁰ *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985).

²¹¹ *Kieselstein*, 632 F.2d at 991, 993.

²¹² See *supra* notes 151–58 and accompanying text.

²¹³ 773 F.2d 411 (2d Cir. 1985).

²¹⁴ *Id.* at 412.

²¹⁵ *Id.* at 419.

The bicycle rack in *Brandir International, Inc. v. Cascade Pacific Lumber Company*²¹⁶ presents an equally difficult issue. The designer had originally created a wire sculpture with a continuous undulating form, and later had the thought of using that form for a bicycle rack.²¹⁷ To accomplish that adaptation, the upper loops of the original wire design were widened to allow bikes to be parked under, as well as over, the rack's curves; the ends were straightened to permit installation in the ground; and the wire was replaced with standard steam pipe bent into form.²¹⁸ Judge Oakes held that the design was not copyrightable:

[i]t seems clear that the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements. . . . Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices.²¹⁹

This focus on the *process* of design is now precluded by *Star Athletica*.²²⁰ However, the utilitarian influences on the design may well affect our perception of it as a bicycle rack rather than simply a piece of modern sculpture. If we perceive the design as having an intrinsic utilitarian function, it is a useful article that is ineligible for copyright as a sculptural work. The case for protection may be stronger after *Star Athletica*, but the outcome is far from certain.²²¹

Finally, there is no reason to anticipate a windfall to the fashion industry. Clothing clearly retains its status as a useful article after *Star Athletica*. Fashion designs—the “shape, cut, and dimensions”²²² of apparel—are still perceived as useful articles even when imagined separately under the Court's test for separability, and thus generally remain ineligible for copyright as pictorial, graphic, or sculptural

²¹⁶ *Brandir Int'l v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

²¹⁷ *Id.* at 1146.

²¹⁸ *Id.* at 1147.

²¹⁹ *Id.* at 1146–47.

²²⁰ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1015 (2017).

²²¹ Assuming separability, there may well be a debatable issue as to whether the work reflects the “minimal degree of creativity” necessary for copyright. See *Feist Publ'ns v. Rural Tel. Serv.*, 499 U.S. 340, 345 (1991); see also *supra* note 167.

²²² *Star Athletica*, 137 S. Ct. at 1013.

works. As in *Star Athletica*, two-dimensional design features will typically survive, perhaps along with the occasional three-dimensional bow or flower,²²³ but for fashion design in general, the wait for a general design protection statute will continue.²²⁴

The earliest in an undoubtedly extensive series of lower court cases that will parse *Star Athletica* are beginning to appear. In *Triangl Group Ltd. v. Jiangmen City Xinhui District Lingzhi Garment Company*,²²⁵ the plaintiff won a default judgment that protected a pattern of decorative black trim on bikini tops and bottoms. The court analogized the features to the patterns of stripes and chevrons that Justice Thomas said would qualify for protection as two-dimensional art works after separation from the cheerleading uniforms.²²⁶ *Jetmax Ltd. v. Big Lots, Inc.*,²²⁷ is a more challenging case. The plaintiff claimed copyright in the decorative covers of its *Tear Drop* string of ornamental lights. The parties did not dispute that the light sets were useful articles.²²⁸ The court optimistically declared that *Star Athletica* had “resolved widespread disagreement over the proper test for determining whether the design of a useful article is entitled to copyright”²²⁹—optimism belied by its own misreading of the case. After finding that the light covers could be identified separately from the useful article, the court concluded that they would also qualify as protectable sculptural works after separation because “the primary purpose of the cover is artistic; once the covers are removed, the remainder is a functioning but unadorned

²²³ Citing *Star Athletica*, German sportswear company Puma has filed a copyright claim against Forever 21 for copying Rihanna’s *Fenty* line of shoes marketed by Puma, including the “Bow Slide” shoe. The complaint also alleges design patent and trade dress infringement. Complaint, Puma SE v. Forever 21, Inc., 2017 WL 1193694 (C.D. Cal. filed Mar. 31, 2017) (No. 2:17-cv-02523). *But see* Jovani Fashion, Ltd. v. Fiesta Fashions, 500 Fed. Appx. 42, 44 (2d Cir. 2012) (declining to extend copyright to “the arrangement of decorative sequins and crystals” on the bodice of a prom dress). The court treated the decorative purpose of the elements as an “intrinsic” function of the dress despite the exclusion in the statutory definition of “useful article” of a function that is “merely to portray the appearance of the article.” *Id.* at 45; 17 U.S.C. § 101 (2012) (definition of “useful article”).

²²⁴ See *supra* notes 26–32 and accompanying text. See Shipley, *supra* note 108, at 166 (“[C]lothing designers have not really gained much additional protection due to *Star Athletica*.”).

²²⁵ *Triangl Grp. Ltd. v. Jiangmen City Xinhui Dist. Lingzhi Garment Co.*, 16 CIV. 1498 PGG, 2017 WL 2829752 (S.D.N.Y. June 22, 2017).

²²⁶ *Id.* at *8.

²²⁷ *Jetmax Ltd. v. Big Lots, Inc.*, 15-cv-9597 (KBF), 2017 WL 3726756 (S.D.N.Y. Aug. 28, 2017).

²²⁸ *Id.* at *4.

²²⁹ *Id.*

light string.”²³⁰ The functionality of the useful article after the separation of the claimed design feature is irrelevant under *Star Athletica*,²³¹ and a primarily artistic purpose is not itself sufficient to satisfy the independent-existence requirement. The latter now demands that the separated feature be eligible for protection as a pictorial, graphic or sculptural work because it is not itself a useful article—an issue that the court in *Jetmax* never reached.

*Design Ideas, Ltd. v. Meijer, Inc.*²³² is more promising. The case involved a claim of copyright in a bird silhouette on the plaintiff’s *Sparrow Clip* clothespins. Prior to *Star Athletica*, the court had granted a summary judgment upholding the validity of the copyright after asking whether “the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.”²³³ According to the court, the bird feature was the product of the designer’s “artistic judgment” that “was not constrained by functional considerations.”²³⁴ Upon reconsideration after *Star Athletica*, the court again upheld the copyrightability of the bird portion of the *Sparrow Clip*. Tracking the Supreme Court’s analysis, the court found that the bird feature would qualify for protection as a sculptural work if imagined separately. “The *Star Athletica* Court noted that the design feature must qualify as a nonuseful pictorial, graphic, or sculptural work. . . . However, once the bird portion is removed from the clothespin, what is the usefulness of hanging the bird from a rod or hanging the bird on a string by its beak?”²³⁵

Courts of Appeal will soon be required to parse *Star Athletica* for themselves. If their past decisions on separability are any guide, a quick consensus is unlikely.

VI. CONCLUSIONS

In the absence of a general design protection statute, copyright protection for commercial products remains a crucial issue for designers and manufacturers. The lower court in *Star Athletica v. Varsity Brands* counted nine competing tests to

²³⁰ *Id.* at *6.

²³¹ *See supra* notes 77–82 and accompanying text.

²³² *Design Ideas, Ltd. v. Meijer, Inc.*, 15-cv-03093, 2017 WL 2662473 (C.D. Ill. 2017).

²³³ *Design Ideas, Ltd. v. Meijer, Inc.*, 15-cv-03093, 2016 WL 4487830 at *11 (C.D. Ill. Aug. 25, 2016) (quoting *Brandir Int’l Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987)).

²³⁴ *Id.* at *12.

²³⁵ *Design Ideas*, 2017 WL 2662473 at *3.

determine the copyrightability of useful articles and proceeded to add one more of its own. The Supreme Court replaced them all with yet another standard:

We hold that 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 protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.²³⁶

The first element merely insures that the claimed feature is specifically identified. The second element is the core of the new analysis. The requirement that the separately-imagined feature qualify for protection as a pictorial, graphic, or sculptural work operates to exclude features that remain useful articles even after separation. Useful articles must have “an intrinsic utilitarian function.”²³⁷ When the design of the separated feature reflects its utilitarian function we are likely to identify that function as “intrinsic” to the feature and thus perceive the feature as an unprotectable “useful article.”

In sum, the test of separability adopted by the Supreme Court in *Star Athletica v. Varsity Brands* ultimately turns on whether we recognize the separated feature as designed to serve a utilitarian function. Whether this latest articulation of the separability standard will yield the predictability and consistency that has eluded earlier efforts remains to be seen.

²³⁶ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

²³⁷ 17 U.S.C. § 101 (2012) (definition of “useful article”).

