I. Introduction to Conceptual Separability.

On October 31, 2016, The Supreme Court of the United States heard oral argument in the case of Star Athletica, LLC (“Star”) v. Varsity Brands, Inc. (“Varsity”) (hereinafter the “Varsity case”) on the following question:

What is the appropriate test to determine when a feature of the design of a useful article is protectable under Section 101 of the Copyright Act?\(^2\)

With this question, the Supreme Court seeks to resolve—or at least provide guidance—as to the appropriate test when analyzing the doctrine of conceptual separability. Many copyright litigators, practitioners, legal scholars, and copyright owners are anxiously awaiting the Supreme Court’s opinion, as “[c]ourts 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.”\(^3\) One Court of Appeals has described conceptual separability as a “metaphysical quandary.”\(^4\) Another Court of Appeals judge has declared that “the law in this area is a mess,” lamenting that “until we get much-needed clarification, courts will continue to struggle and the business world will continue to be handicapped by the uncertainty of the law.”\(^5\) In Star v. Varsity, the useful articles at issue were five Varsity cheerleading uniforms that feature graphic designs appearing on the surface of the uniforms, characterized by the Sixth Circuit as “stripes, chevrons, color blocks, and zigzags.”\(^6\) Other lawsuits that address the issue of conceptual separability have involved items ranging from designer belt buckles,\(^7\) hardwood flooring,\(^8\) water hookahs,\(^9\) and even the Batmobile.\(^10\) The issue

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1 The authors represent the respondents/plaintiffs in the case Star Athletica, LLC v. Varsity Brands, Inc. The comments in this paper are the opinions of the authors only.
2 136 S. Ct. 1823 (2016).
3 Masquerade Novelty, Inc. v. Unique Indus., Inc., 912 F.2d 663, 670 (3d Cir. 1990).
4 See Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc., 618 F.3d 417, 434 (4th Cir. 2010).
6 Varsity Brands, 799 F.3d at 492.
7 Kieselstein–Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) (involving decorative and jeweled belt buckles and finding “the primary ornamental aspect of the [belt] buckles [was] conceptually separable from their subsidiary utilitarian function”).
8 Home Legend, LLC v. Mannington Mills, Inc., 784 F.3d 1404, 1412 (11th Cir. 2015) (finding the two-dimensional Glazed Maple design on laminate flooring was both physically and conceptually separable from the utilitarian flooring itself).
likewise continues to be a focus of litigation, with courts in the past year having to address conceptual separability, as discussed below.\textsuperscript{11} In light of the wide range of industries that can be impacted by conceptual separability, this issue is not as esoteric as one might be initially led to believe.

II. Copyright Law and Conceptual Separability.

Section 102(a)(5) of the Copyright Act (the “Act”) provides that protectable works include “pictorial, graphic and sculptural works,” which are defined as follows:

two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned . . . .\textsuperscript{12}

The Act further provides that

the design of a useful article ……… shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.\textsuperscript{13}

A “useful article” is defined as one having an “intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”\textsuperscript{14} Under this definition a lamp is a useful article whereas a painting is not.

Separability exists when elements are either physically or conceptually separable from the article on which they appear. The Copyright Office uses the following standard to determine whether physical separability exists:

The useful elements of an article will be considered separable from the copyrightable elements if the copyrightable elements could be physically removed without altering the useful aspects of the article. This is known as the physical separability test. Physical separability means that the useful article contains pictorial, graphic, or sculptural features that can be physically separated from the

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\textsuperscript{9} Inhale, Inc. v. Starbuzz Tobacco, Inc., 755 F.3d 1038, 1042 (9th Cir. 2014) (holding that the distinctive shape of a hookah water container was not conceptually separable from its function as a container because the shape accomplished the function of holding liquid).
\textsuperscript{10} DC Comics v. Towle, 989 F. Supp. 2d 948, 970 (C.D. Cal. 2013), aff’d, 802 F.3d 1012 (9th Cir. 2015) (finding the design elements of the two versions of the Batmobiles at issue conceptually separable from the underlying car).
\textsuperscript{11} See Section IV, “Recent Cases involving conceptual separability,” infra.
\textsuperscript{12} 17 U.S.C. § 101.
\textsuperscript{13} Id.
\textsuperscript{14} Id.
article by ordinary means while leaving the utilitarian aspects of the article completely intact.\textsuperscript{15}

If the Copyright Office determines that the useful article contains pictorial, graphic, or sculptural features that cannot be physically separated from that article, then the Copyright Office applies the conceptual separability test.\textsuperscript{16} In applying the conceptual separability test, the Copyright Office employs the following standard:

Conceptual separability means that a feature of the useful article is clearly recognizable as a pictorial, graphic, or sculptural work, notwithstanding the fact that it cannot be physically separated from the article by ordinary means. This artistic feature must be capable of being visualized — either on paper or as a free-standing sculpture — as a work of authorship that is independent from the overall shape of the useful article. In other words, the feature must be imagined separately and independently from the useful article without destroying the basic shape of that article. A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works — one an artistic work and the other a useful article. For example, the carving on the back of a chair or an engraving on a vase would be considered conceptually separable, because one could imagine the carving or the engraving as a drawing on a piece of paper that is entirely distinct from the overall shape of the chair and the vase. Even if the carving or the engraving was removed the shape of the chair and the vase would remain unchanged, and both the chair and the vase would still be capable of serving a useful purpose.\textsuperscript{17}

In addition to the Copyright Office’s standard above, others tests for conceptually separability have been proposed over the years by courts and scholars. In the \textit{Varsity} case, the Sixth Circuit identified nine such tests\textsuperscript{18}:

\begin{enumerate}
\item \textbf{The Copyright Office’s Approach:} “A pictorial, graphic, or sculptural feature satisfies [the conceptual-separability] requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article.”\textsuperscript{19}
\end{enumerate}

\textsuperscript{15} Compendium of U.S. Copyright Office Practices \$ 924.2(A), at 900:40 (3d ed. 2014) (“Compendium III”) (giving the example of “[a] sufficiently creative decorative hood ornament on an automobile”).

\textsuperscript{16} Compendium III \$ 924.2(B), at 900:40.


\textsuperscript{18} \textit{Varsity Brands}, 799 F.3d at 484–85 (footnotes not in original).

\textsuperscript{19} Compendium III \$ 924.2(B), at 900:40.
(2) **The Primary–Subsidiary Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the artistic features of the design are “primary” to the “subsidiary utilitarian function.”

(3) **The Objectively Necessary Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the artistic features of the design are not necessary to the performance of the utilitarian function of the article.

(4) **The Ordinary–Observer Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if “the design creates in the mind of the ordinary[, reasonable] observer two different concepts that are not inevitably entertained simultaneously.”

(5) **The Design–Process Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the “design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.”

(6) **The Stand–Alone Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if “the useful article’s functionality remain[s] intact once the copyrightable material is separated.”

(7) **The Likelihood–of–Marketability Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if “‘there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.’”

(8) **Patry’s Approach:** It is unnecessary to engage in a separability analysis if (A) the work is the design of a three-dimensional article, and (B) the design is not of a “useful article.” When determining whether pictorial, graphic, or sculptural features are protectable under the Copyright Act, the focus should be on whether those pictorial, graphic, or sculptural aspects are separable from the “utilitarian aspects” of the article, not the “article” because “the protected features need not be capable of existing apart from the article, only from its functional aspects.” This task requires two additional steps. First, the court “must be able to discern pictorial, graphic, or sculptural features.” Second, the pictorial, graphic, or sculptural features “must be capable of existing as intangible features independent of the utilitarian aspects of the useful article, not independent of the whole article.

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20 Kieselstein–Cord, 632 F.2d at 993.
21 Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411, 419 (2d Cir. 1985).
22 Id. at 422 (Newman, J., dissenting).
24 Pivot Point Int’l Inc. v. Charlene Prods., Inc., 372 F.3d 913, 934 (7th Cir. 2004) (Kanne, J., dissenting).
25 Galiano v. Harrah’s Operating Co., 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 Nimmer on Copyright § 2.08(B)(3)).
27 Id. § 3:146.
This necessitates asking “whether the pictorial, graphic, or sculptural features are dictated by the form or function of the utilitarian aspects of the useful article.” If form or function—rather than aesthetics—dictates the way that the pictorial, graphic, or sculptural features appear, then those pictorial, graphic, and sculptural features are not capable of existing independently of the utilitarian aspects of the useful article.\(^\text{28}\)

(9) **The Subjective–Objective Approach:** Conceptual separability is determined by balancing (A) “the degree to which the designer’s subjective process is motivated by aesthetic concerns”; and (B) “the degree to which the design of a useful article is objectively dictated by its utilitarian function.”\(^\text{29}\) Under the first factor, a court considers the degree to which aesthetic concerns, as opposed to functional ones, motivate the designer, while the second factor considers asks whether “the design is mostly dictated by function” or “hardly dictated by function at all.”\(^\text{30}\) If the design of the useful article “is mostly dictated by function,” then that fact “weigh[s] against conceptual separability, and therefore, against copyright protection,” whereas if the design “is hardly dictated by function at all” then that fact “weigh[s] in favor of a finding of conceptual separability.”\(^\text{31}\)

Under certain of the above tests, courts have found specific sculptural elements of mannequins used by cosmetology students,\(^\text{32}\) belt buckles,\(^\text{33}\) and furniture\(^\text{34}\) conceptually separable from the articles’ useful functions and therefore copyrightable but have also determined that that certain aspects of a bike rack were not conceptually separable because they were driven by utilitarian pressures.\(^\text{35}\) For example, the Second Circuit found that with regard to the bike rack “form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices.”\(^\text{36}\)

The separability of dress and other clothing designs has generated considerable litigation prior to the case under discussion. Designs of clothing, i.e., the shape, cut, and dimensions of these items, have generally been considered by the courts not to be physically or conceptually separable from the utilitarian aspects of the clothing. On the other hand, certain designs on clothing have been protected, e.g., a Halloween costume,\(^\text{37}\) a multicolored striped sweater with puffy leaf appliques,\(^\text{38}\) a sweater which has a squirrel and leaves appliqued onto its multipaneled

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\(^{28}\) Id.


\(^{30}\) Id. at 142.

\(^{31}\) Id.

\(^{32}\) *Pivot Point*, 372 F.3d at 931-32.

\(^{33}\) *Kieselstein–Cord*, 632 F.2d at 993.

\(^{34}\) *Universal Furniture* 618 F.3d at 434.

\(^{35}\) *Brandir*, 834 F.2d at 1147.

\(^{36}\) Id.

\(^{37}\) See *Chosun International, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 325 (2d Cir. 2005).

\(^{38}\) See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995).
III. Star Athletica, LLC v. Varsity Brands, Inc.

A. The District Court Case.

Varsity filed suit against Star for copyright infringement of its designs in the Western District of Tennessee, along with other claims. The parties cross-moved for summary judgment after the close of discovery. Judge Robert Cleland from the Eastern District of Michigan granted summary judgment to Star, holding that the designs were not separable from the cheerleading uniforms on which they appeared. The court engaged in what it characterized as an exercise in “classical philosophy” (citing Plato’s The Republic and Plato’s concept of “treeness”) and concluded that the designs were too closely associated with “the ideal” of “cheerleading-uniform-ness” to be protected under the copyright laws, holding that “[i]t is not possible to either physically or conceptually sever Varsity’s designs from the utilitarian function of the resulting cheerleading uniforms.

B. The Sixth Circuit Appeal.

The parties had their next day in court before the Sixth Circuit for oral argument on April 24, 2015. Five months later on August 19, 2015, the appellate court, in a 2-1 decision, reversed the district court while finding on an issue of first impression that the arrangements of stripes, chevrons, color blocks, and zigzags on the surface of the uniforms were conceptually separable from the uniforms themselves and therefore copyrightable.

Throughout the litigation, Star contended that Varsity’s cheerleading uniforms function to identify the wearer as a cheerleader and a member of a cheerleading team. The Sixth Circuit rejected this argument as no different from saying that a utilitarian aspect of a cheerleading uniform is to convey to others the fact that the wearer of the uniform is a cheerleader for a particular team, citing to § 101’s definition of a useful article as “an article having an intrinsic utilitarian function that is not merely to . . . convey information.”

The Sixth Circuit also rejected Star’s “decorative function” argument—i.e., that the designs’ “decorative function” is one of the “utilitarian aspects” of a cheerleader uniform—

Id. at *9.
44 Judge Karen Moore delivered the opinion of the court joined by Judge Ralph Guy. Judge David McKeague dissented.
45 Varsity Brands, 799 F.3d at 492.
46 Id. at 490 (citing 17 U.S.C. § 101).
finding that “[s]uch a holding would render nearly all artwork unprotectable.”47 As the Varsity court correctly noted, “[u]nder this theory of functionality, Mondrian’s painting would be unprotectable because the painting decorates the room in which it hangs.”48

After considering the nine approaches to conceptual separability discussed supra, the Sixth Circuit settled upon its own test based on § 101’s statutory text:

(i) Is the design a pictorial, graphic, or sculptural work?

(ii) If the design is a pictorial, graphic, or sculptural work, then is it a design of a useful article — “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”? If the design is not the design of a useful article, then there is no need to inquire into whether there are “pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article.”

(iii) What are the utilitarian aspects of the useful article?

(iv) Can the viewer of the design identify “pictorial, graphic, or sculptural features” “separately from ... the utilitarian aspects of the [useful] article[?]” If the viewer cannot identify pictorial, graphic, or sculptural features within the design of the useful article, then the design of the useful article is not copyrightable.

(v) Can “the pictorial, graphic, or sculptural features” of the design of the useful article “exist[] independently of[] the utilitarian aspects of the [useful] article[?]”49

Applying this test, the Court found the designs appearing on the cheerleading uniforms to be conceptually separable from the underlying useful articles.50 The Court regarded as significant to its finding of conceptual separability that the designs “may be incorporated onto the surface of a number of different types of garments, including cheerleading uniforms, practice wear, t-shirts, warm-ups, and jackets, among other things.”51

In reaching its decision, the Sixth Circuit also found that the district court had erred by failing to give greater deference to the Copyright Office’s registration determinations (and the attendant presumption of validity) which the Sixth Circuit, in a second issue of first impression, decided should be Skidmore deference as opposed to Chevron deference.52 The Sixth Circuit

47 Id.
48 Id.
49 Id. at 487 (citing 17 U.S.C. §§ 101-102).
50 Id. at 492.
51 Id. at 491.
52 Id. at 479.
held that, although the presumption of validity is rebuttable, Star had the burden to overcome the presumption, and failed to do so.\textsuperscript{53}

Judge David McKeague in dissent stated that the case presented a “metaphysical quandary,” and “the law in this area is a mess” while calling upon Congress or the Supreme Court to clarify copyright law with respect to garment design.\textsuperscript{54} Star petitioned the Sixth Circuit thereafter for \textit{en banc} review but denied. Heeding Judge McKeague’s advice, Star petitioned the Supreme Court for certiorari, which was granted on May 2, 2016.\textsuperscript{55}

C. The Parties’ Arguments Before the Supreme Court.

In its brief, Star set forth the following separability test, which it described as a “sub-optimal prophylactic rule”\textsuperscript{56}:

1. A court begins the separability analysis by deciding whether the pictorial, graphic, or sculptural work is a design of a useful article. Designs of useful articles are presumptively not entitled to copyright protection. A feature of a useful article is protectable only if that feature satisfies the separability test, with doubts resolved against copyrightability.

2. The presumption against extending copyright protection to utilitarian objects requires courts to identify all of the article’s inherent, essential, or natural functions. The uses for which an article is marketed is strong evidence of its functions.

3. Next, the court considers whether a feature of a useful article can be recognized as a unit by itself, apart from the article’s utilitarian aspects (the identified-separately requirement) because it is purely artistic. If the answer is no, the feature cannot be copyrighted. Period.

4. Finally, the court considers whether the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article (the exist-independently requirement). So on the one hand, the feature cannot advance the utility of the article, and the article cannot depend on the feature for its utility. On the other hand, the article cannot advance the aesthetics of the feature, and the feature cannot depend on the article for its aesthetics. To assist in this analysis, a court should consider physical separability (which, if met, is dispositive), design process (which can be dispositive), and

\textsuperscript{53} Id. at 480, 493. The court further noted that the issue of originality of the designs was not before it and would have to be considered by the district court on remand. \textit{Id.} at 493.

\textsuperscript{54} \textit{Varsity Brands}, 799 F.3d at 497 (McKeague, J., dissenting).

\textsuperscript{55} \textit{Star Athletica, LLC v. Varsity Brands, Inc.}, Docket 15-866.

\textsuperscript{56} See Brief of Petitioner Star Athletica, LLC at 39, filed July 15, 2016.
marketability (which can also be dispositive). Again, copyrightability turns on whether the feature is purely artistic. If the feature is even slightly utilitarian, it cannot be copyrighted.

In applying its proposed test, Star argued that “[t]he presumption against copyright for garment design extends to any feature normally incorporated into the garment—such as the stripes, chevrons, or zigzags at issue here—unless a particular feature can satisfy the separability analysis, i.e., the feature is solely artistic.” In Star’s view, “[e]ven the slightest utilitarian function results in no copyright for the feature.” Star asserts that “Congress’s persistent refusal to extend copyright protection not only to garment design but the design of any useful article aside from boat hulls” supports its position.

In contrast, Varsity took the position, “[a]s a threshold matter,” that its designs are not designs of useful articles but rather “two-dimensional graphic designs that appear on useful articles,” thus obviating any need for a separability analysis. Multiple copyright scholars likewise agree with this position. Nonetheless, to the extent the designs are considered to be designs of useful articles, Varsity contended that two-dimensional artwork appearing on a useful article satisfies § 101’s separability analysis because “two-dimensional designs can appear on a variety of different media” and, as a result, “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of any three-dimensional useful article on which they happen to appear,” regardless of whether the useful article is clothing or some other useful article. Under Varsity’s approach, the separability analysis focuses on the identifiable artistic features of a useful article and asks whether they could exist independently of the functions that make an article useful. Additionally, Varsity contended that Star’s proposed test would underprotect “applied art” (i.e., artwork applied to a useful article), for instance, by requiring “that a feature is separately identifiable only if it is ‘purely artistic.’”

Varsity’s position was supported by the Solicitor General on behalf of the Register of Copyrights. The Solicitor General sided with Varsity, declaring in unambiguous terms that

57 See Brief of Petitioner Star Athletica, LLC at 44-45, filed July 15, 2016.
58 Id. at 45.
59 Id. at 43 (emphasis in original).
60 See Brief of Respondent Varsity Brands, Inc. at 52, filed Sept. 14, 2016.
61 See 2 William F. Patry, Patry on Copyright § 3:151, at 3-485 (Mar. 2016) (“Courts looking at two-dimensional design claims should not apply the separability analysis regardless of the three-dimensional form that design is embodied in.”); Jane C. Ginsburg, “Courts Have Twisted Themselves Into Knots”: U.S. Copyright Protection for Applied Art, 40 Colum. J.L. & Arts 1 (2016) (courts properly “avoid[] inquiry into conceptual separability” when presented with a “PGS work on a useful article”).
62 See Varsity Brief at 26, 28.
63 Id. at 19.
64 Compendium III § 503.1(BA), at 500:7 (applied art is “artwork applied to a useful article”).
65 See Varsity Brief at 34; Star Brief at 38.
66 See Brief for the United States as Amicus Curiae Supporting Respondents at 1, filed Sept. 21, 2016. The Register of Copyrights directs the United States Copyright Office and is responsible for, among other things, examining applications for copyright registration and determining whether the material deposited constitutes copyrightable subject matter. Id.
Varsity’s designs “are protected by the Copyright Act.” As the Solicitor General explained, “[t]he Copyright Office has distinguished between ‘three-dimensional aspects of clothing,’ which generally are not copyrightable, and ‘two-dimensional design applied to the surface of the clothing,’ which ‘may be registered,’” an approach “long reflected in Copyright Office practices.” The Solicitor General was thus clear in its brief on behalf of the Copyright Office that “[t]he Copyright Act codifies longstanding administrative practice, approved by [the Supreme Court in] Mazer v. Stein, 347 U.S. 201 (1954).” Because Varsity’s designs, “if viewed as the ‘design of a useful article,’ . . . could be represented as an independent work, [the designs are] thus conceptually separate from the useful article itself.” Accordingly, in the opinion of the Register of Copyrights, “[Varsity’s] works, if sufficiently original, are copyrightable.”

The Court heard oral argument from the parties on October 31, 2016. A decision from the Court is expected any day now.

IV. Topics for Discussion.

- Will the Supreme Court select a pre-existing test for conceptual separability or create its own test? Should the Supreme Court create its own test?
- How will the Supreme Court’s ruling in the Star v. Varsity case impact the fashion industry? Other industries?
- Would a holding of non-separability based on a “decorative function” theory or an “identity function” theory contradict § 101’s definition of “useful article,” which requires that the article have an intrinsic function “not merely to portray the appearance of the article or convey information”?

Recent Cases involving conceptual separability:

  - The Central District of Illinois denied the defendant’s motion summary judgment on the plaintiff’s copyright infringement claim, finding as a matter of law that the bird design at issue was both physically and conceptually separable from the utilitarian aspect of the work. First, the bird design could be physically removed while leaving the utilitarian function of the clothespin intact, thus physical separability was found to be present. Second, the court found that the bird design was a product of the designer’s artistic judgment unconstrained by functional considerations, therefore conceptual separability was present. The court

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67 Id. at 13.
68 Id. at 9, 13.
69 Id. at 16.
70 Id. at 17.
71 Id.
determined that “[t]he bird shape does not accomplish the purpose of the clothespin holding items—even though the bird design may also be used as a hanger.” Even though the bird design itself could also be used as a hangar, the court deemed this a “secondary function,” which does not affect the copyrightability of the item under copyright case law.


▪ The District of Colorado granted summary judgment to the defendant on the plaintiff’s copyright infringement claim, finding that the defendant failed to create a dispute with respect to the material facts that the copyrighted work at issue—the Maniken® human skeleton model—was designed for anatomically-functional reasons not independent from his artistic judgment.