

THE COMPLEXITY OF COPYRIGHT: THE HIGHEST COURT'S ATTEMPT TO "FIX" A NONEXISTENT PROBLEM AND A SIMPLE SOLUTION

Amy L. Johnson[†]

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INTRODUCTION

Imagine a world where only the richest people are able to have things like nice clothing, cars, shoes, and household items. What would happen to the middle class? What would happen to those who live in poverty? In a world where anything and everything is subject to copyright protection, this exclusivity of consumer goods could very well be possible.

When a designer creates a new style dress, for example, she typically can only be protected by copyright in the textile design of the dress. The shape of the dress, cut of the holes for the head and arms, and choice of

[†] J.D. Candidate, Syracuse University College of Law, 2019; B.S Mass Communications, Towson University, 2015. I would like to thank my Note Advisor, Professor Laura Lape, for her guidance throughout the drafting process and for introducing me to the fascinating world of Copyright Law, as well as the editors of the *Syracuse Law Review* for all of their hard work.

fabric typically cannot be subject to copyright protection due to the intrinsic utilitarian functions of those features. Because of this lack of protection, the general public has access to less expensive, knock-off versions of the latest clothing styles, shoes, cars, household items, and more. There are concerns, however, that this may change with the Supreme Court's recent decision in the case of *Star Athletica, LLC v. Varsity Brands, Inc.*¹ A case the Court took with the intention of clarifying the test for determining copyright protection, ended up providing lower courts with a "test" that reiterates the unworkable statute governing these types of cases, seemingly opening the door to allow more and more articles to receive copyright protection.

The goal of this Note is to demonstrate that the Supreme Court's decision in *Star Athletica* failed to address the true issue federal courts face in determining when a useful article qualifies for copyright protection. Further, this Note will highlight how the decision has opened up the copyright world to allow protection on the industrial designs Congress specifically intended copyright not to reach. Part I provides an overview of the Copyright Act, Congress's intention in the expansion to include pictorial, graphic, and sculptural elements, and the current copyright law.

Part II focuses primarily on the tests used in the U.S. Courts of Appeals for the Second and Seventh Circuits, prior to *Star Athletica*, in determining whether an object qualifies for copyright protection. The section highlights the similarities in those tests and the common errors that occur in the courts' application.

Part III will focus on the error made and corrected by the district court and U.S. Court of Appeals for the Sixth Circuit, respectively, in the earlier *Star Athletica* decisions. It will then closely evaluate the Supreme Court's decision in *Star Athletica*, specifically addressing Justice Clarence Thomas' decision and the "test" articulated as the uniform and proper way to evaluate copyrightability of useful articles.

Part IV will then focus on the aftermath of *Star Athletica*. Since the Supreme Court's decision in *Star Athletica*, the few district courts that have been presented with copyright issues have quickly concluded that the object qualified for copyright protection. It seems as though the Supreme Court's new test for copyright protection is a lesser burden to satisfy. This will expand the protections of copyright law, and may lead to substantial impacts on the economy, specifically in the knock-off industry.

Finally, Part V will propose the way the copyright analysis should

1. 137 S. Ct. 1002 (2017).

take place in order to effectively correct the errors frequently made in federal courts, and to also avoid expanding copyright laws beyond Congress's intent. A more effective test would include following distinct stages, answering either in the negative or in the affirmative, and proceeding through as required. Utilizing this type of analysis, courts will reduce the likelihood of error in determining an article's intrinsic utilitarian function, and subsequently, may apply the separability test they deem most workable. Outcomes in copyright determinations should then become consistent.

I. A HISTORY AND BACKGROUND OF THE COPYRIGHT ACT

The first American copyright law was enacted by the First Congress on May 31, 1790.² The law was enacted “[t]o promote the Progress of Science . . . by securing the limited Times to Authors . . . the exclusive Right to their . . . Writings”³ At that time, authors and publishers recorded their copyright claims with federal courts and submitted copies of their works in support.⁴ These works were stored in a variety of locations, meaning there was no centralized system for tracking, consolidating, preserving, or using the copyrighted works.⁵ By 1897, Congress established a central copyright management system by creating the U.S. Copyright Office headed by the Register of Copyrights.⁶

The current Copyright Act was enacted in 1976, became effective January 1, 1978, and is codified in Title 17 of the United States Code.⁷ The Copyright Act protects “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”⁸ Works of authorship under the Copyright Act include, among other things, literary works, musical works, dramatic works, choreographic works, and the focus of this Note: pictorial, graphic, and sculptural works.⁹

2. Act of May 31, 1790, ch. 15, 1 Stat. 124; *see also* U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT PRACTICES 4 (3d ed. 2014) (“Comprehensive revisions were enacted, at intervals of about 40 years, in 1831, 1870, and 1909.”).

3. U.S. CONST. art I, § 8; H.R. REP. NO. 94-1476, at 47 (1976).

4. U.S. COPYRIGHT OFFICE, *supra* note 2.

5. *Id.*

6. *Id.*

7. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended in scattered sections of 17 U.S.C.); *see also* U.S. COPYRIGHT OFFICE, *supra* note 2, at 13.

8. 17 U.S.C. § 102(a) (2012).

9. *Id.*

Pictorial, graphic, and sculptural works include two and three dimensional “works of fine, graphic, and applied art.”¹⁰ The design of a useful article is considered a pictorial, graphic, and 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.”¹¹ The Judiciary Committee added this language “in an effort to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection.”¹² Congress’s House Report regarding the Copyright Act makes clear that, although the shape and appearance of various industrial designs may be aesthetically pleasing, the Committee intended not to offer copyright protection to all of these designs.¹³

In an effort to steer courts away from awarding copyright protection to all industrial designs, Congress created the requirement of separability.¹⁴ Only the elements which can be identified separately from the utilitarian aspects of the useful article, whether physically or conceptually separable, are copyrightable under the Copyright Act.¹⁵ The courts must first identify the intrinsic utilitarian function of the useful article to determine if there are any elements that may be separated from the article’s utilitarian function.¹⁶ 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.”¹⁷ Thus, the utilitarian function of a dress, for example, is not to look beautiful, but to cover the body from the elements; the utilitarian function of a chair is not to decorate a space, but to provide a place to sit. This stage, as will be discussed later, is where many courts have had difficulty in analyzing accurately, and thus, have created inconsistencies in applying copyright protection.

If, after identifying the intrinsic utilitarian function of the useful article, there are elements that can be identified as either physically or conceptually separable from the utilitarian aspects of the article, those elements independently may be subject to copyright protections.¹⁸ Justice Stephen Breyer explained that in order to determine whether an element

10. 17 U.S.C. § 101 (2012).

11. *Id.*

12. H.R. REP. NO. 94-1476, at 54 (1976).

13. *Id.* at 55.

14. *Id.*

15. *Id.*

16. *Id.*

17. 17 U.S.C. § 101 (2012).

18. H.R. REP. NO. 94-1476, at 55.

of a useful article is separable you must ask, “Can the design features (the picture, the graphic, the sculpture) be physically removed from the article . . . all the while leaving the fully functioning utilitarian object in place?”¹⁹ If that question cannot be answered in the affirmative, it must then be asked, “Can one nonetheless conceive of the design features separately without replicating a picture of the utilitarian object?”²⁰

Congress made clear in the House Report for the 1976 Copyright Act that not all designs were meant to be protected by copyright.²¹ Congress specifically stated that the Committee was “seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.”²² The separability requirement was created with the intent that this standard would prevent the protecting of industrial designs, such as the shape of automobiles, television sets, food processors, or dresses, by copyright law.²³ Thus, ensuring that consumer goods remained available to all citizens.

II. THE CIRCUIT “SPLIT”—VARYING TESTS FOR DETERMINING COPYRIGHT ELIGIBILITY

A. *Common Tests Applied*

The statutory language of the Copyright Act did not provide courts with a workable test for determining whether certain elements of a useful article qualify for copyright protection. This is evidenced by the fact each of the circuit courts of appeals apply the statutory language in a different manner to determine whether a useful article’s elements receive copyright protection. In determining whether elements are eligible for copyright protection, courts focus on tests applied in determining physical and conceptual separability.²⁴ Although each court’s test is facially different, the final outcome of each test is typically consistent.²⁵ The Second and Seventh Circuits have been the venue of many of the most influential separability cases and therefore, will be the focus of this discussion.

19. *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1031 (2017) (Breyer, J., dissenting).

20. *Id.*

21. See H.R. REP. NO. 94-1476, at 54–55 (discussing that there is a need for a “clear line” between what should and should not be protected by copyright law).

22. *Id.* at 55.

23. *Id.* at 54–55 (“Unless the shape . . . can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted . . .”).

24. See, e.g., *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 418–19 (5th Cir. 2005).

25. However, the U.S. Court of Appeals for the Fifth Circuit’s *Galiano* test is one of the rare instances in which the court applies a test that makes just about anything separable. See *id.* at 421–22.

1. Second Circuit

One of the first notable copyright cases to come before the Second Circuit was *Kieselstein-Cord v. Accessories by Pearl, Inc.*²⁶ There, the court decided whether belt buckles qualified for copyright protection under title 17 of the United States Code.²⁷ The belt buckles in question contained sculptural elements, including several surface levels, grooves, and cut outs.²⁸ Appellee argued that the buckles could not be protected under copyright law because they were simply useful articles and lacked any pictorial, graphic, or sculptural elements.²⁹ Appellee further pointed out that the law did not intend to create a monopoly over useful articles.³⁰ Despite the strength of these arguments, the court determined that the buckles did contain separable sculptural elements, influenced by the fact that purchasers used the buckles as ornamentation for body parts other than their waists.³¹

In deciding the case, the court began by explaining the difficulty of identifying which elements, if any, are either physically or conceptually separable from the utilitarian aspects of the useful article.³² The court decided that the primary ornamental aspects of the buckles were conceptually separable from the subsidiary utilitarian function of the belt itself.³³ The court's application has been characterized as a primary/subsidiary test to determine separability because the court seemed to look at whether the artistic value was "primary" to the function.³⁴ These buckles were identified by the court as ornamental pieces of applied art—a concept that the court asserted had been identified and established as qualifying for copyright protection.³⁵

The classification of this case as utilizing a primary/subsidiary test is unnecessary. The belt buckle's intrinsic utilitarian function is to hold

26. 632 F.2d 989 (5th Cir. 2005).

27. *Id.* at 991, 994; *see also* 17 U.S.C. §§ 101–102 (2012).

28. *Kieselstein-Cord*, 632 F.2d at 990.

29. *Id.* at 991–92.

30. *Id.* at 993.

31. *Id.*

32. *Id.* (first quoting H.R. REP. NO. 94-1476, at 55 (1976); and then quoting *Esquire, Inc. v. Ringer*, 591 F.2d 796, 807 (D.C. Cir. 1978) (Leventhal, J., concurring)).

33. *Kieselstein-Cord*, 632 F.2d at 993.

34. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484 (6th Cir. 2015) (describing the court's approach in *Kieselstein-Cord* as the "Primary-Subsidiary Approach").

35. *Kieselstein-Cord*, 632 F.2d at 993 (citing *Boucher v. Du Boyes, Inc.*, 253 F.2d 948, 949 (2d Cir. 1958)) (explaining that the belt buckles may be considered jewelry, "the form of which is subject to copyright protection").

up the wearer's pants—a utilitarian function that is not portraying the article's appearance or conveying information.³⁶ Although the buckle could not be physically removed from the belt and maintain the function of holding up the wearer's pants, the designs within the buckle could conceptually be separated from the function of holding up the wearer's pants. Thus, this case demonstrates that an element that is conceptually separable from the article's utilitarian functions may be protected under copyright law.³⁷ Therefore, deciding the “primary” or “subsidiary” purpose of an element is unnecessary.

Another notable copyright case the Second Circuit decided was the case of *Carol Barnhart, Inc. v. Economy Cover Corp.*³⁸ There, the court had to determine whether four human torso forms had any artistic or aesthetic features that were separable from the utilitarian function.³⁹ The forms of the torsos were created to display shirts, sweaters, and jackets.⁴⁰ All were life-like and had hollow backs to hold excess fabric from the garments being displayed.⁴¹ The court identified the forms' utilitarian function as displaying clothes, and subsequently determined that the aesthetic and artistic elements of the forms were neither physically nor conceptually separable from that utilitarian function.⁴²

The court stated that although the forms were used in ways other than to display clothes, the multi-use itself was insufficient to show that the forms possessed any aesthetic or artistic features that were separable from the utilitarian function.⁴³ The court then contrasted this decision to that in *Kieselstein-Cord*,⁴⁴ where the ornamental aspects of the buckles were not in any way necessary to maintain the utilitarian function.⁴⁵ Whereas the curves on the buckle surface were not needed, the configuration of the breasts, shoulders, and torso of mannequins are wholly necessary to serve the function of modeling clothing.⁴⁶ Without these elements, there was no way that the forms would adequately serve their

36. *See id.* (noting that wearers have used the buckles as “ornamentation for parts of the body other than the waist”). It can therefore be assumed a function the court likely considered was holding up the wearer's pants.

37. *See id.* at 993–94.

38. 773 F.2d 411 (2d Cir. 1985).

39. *Id.* at 414.

40. *Id.* at 412.

41. *Id.*

42. *Id.* at 418.

43. *Barnhart*, 773 F.2d at 418 (intrinsic meaning intended by the creator).

44. *See id.* at 418–19 (citing *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F. 2d 989, 993, 995 (5th Cir. 2005)).

45. *See Kieselstein-Cord*, 632 F. 2d at 993, 995.

46. *Barnhart*, 773 F.2d at 419.

utilitarian purpose.⁴⁷ Due to the inability to separate any element of the forms from the central utilitarian purpose, the court determined these forms were not copyrightable.⁴⁸ This is a distinguishable decision from *Kieselstein-Cord*, so it did not overrule the *Kieselstein-Cord* decision.⁴⁹ The holding here demonstrates that artistic and aesthetic features that are intertwined with utilitarian features cannot be protected under copyright law.

Judge Jon O. Newman wrote a significant dissent in *Barnhart*, articulating his own test for determining when an industrial design has elements subject to copyright protection.⁵⁰ Judge Newman's test for conceptual separability says that "the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by [the] utilitarian function."⁵¹ A beholder, Judge Newman says, is a reasonable observer.⁵² To be separate, there must be "two different concepts that are not inevitably entertained simultaneously."⁵³ Although on its face Judge Newman's test seems to be an easily applicable way to determine whether a useful article has pictorial, graphic, or sculptural features that can be conceptually separable from the useful article itself and thus, eligible for copyright protection, the test has been criticized as a complex and inefficient method of reaching a copyright determination.⁵⁴

Finally, another key Second Circuit decision was *Brandir International, Inc. v. Cascade Pacific Lumber Co.*⁵⁵ There, the court had to determine whether any copyright protection was available to a bicycle rack made of bent tubing that was supposedly modeled after a wire sculpture.⁵⁶ To determine this, the court adopted a test Professor Robert C. Denicola proposed which provided: "[I]f 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 de-

47. *Id.*

48. *See id.*

49. *See id.* at 418–19.

50. *See id.* at 419–26 (Newman, J., dissenting).

51. *Barnhart*, 773 F.2d at 422 (Newman, J., dissenting).

52. *Id.*

53. *Id.*

54. *See Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987) (quoting *Barnhart*, 773 F.2d at 419 n.5).

55. *Id.*

56. *Id.* at 1143.

signer's artistic judgment exercised independently of functional influences, conceptual separability exists."⁵⁷ In application, the court determined it was clear that the rack's form was significantly influenced by the bike rack's utilitarian concerns and the aesthetic elements could not be conceptually separated from that utilitarian function.⁵⁸

As evidenced by these cases, the Second Circuit takes a step-by-step approach in determining whether an industrial design qualifies for copyright protection. First, the court determines what the useful article's intrinsic utilitarian function is. Next, the court asks whether the aesthetic or artistic elements can be physically separated from the useful article, meaning whether they can stand alone. If not, the court will look at whether those elements can be conceptually separated from the useful article. In determining whether the elements are conceptually separable, the court may consider whether the aesthetic elements are significantly influenced by the utilitarian functions or inherently intertwined with the utilitarian functions, whether the artistic aspects are primary to the utilitarian function, or whether the artistic design was influenced by the functional considerations.

2. Seventh Circuit

The Seventh Circuit takes a similar approach to that of the Second Circuit by utilizing the aesthetic influence test. This is demonstrated in the case *Pivot Point International, Inc. v. Charlene Products, Inc.*⁵⁹ There, the court decided whether a human head mannequin was subject to copyright protection.⁶⁰ Again, the court was faced with an issue of conceptual separability as the elements of the human face on the mannequin could not be physically removed from the object while maintaining its utilitarian function. In making its decision, the court went through various Second Circuit decisions to determine which test should be applied in the case at hand.⁶¹ The court determined: "If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is 'as much the result of utilitarian pressures as aesthetic choices,' the useful and aesthetic elements are not conceptually separable."⁶²

57. *Id.* at 1145; see also Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741–42 (1983).

58. *Brandir*, 834 F.2d at 1146–47.

59. See 372 F.3d 913, 930–31 (7th Cir. 2004).

60. *Id.* at 916.

61. See *id.* at 930–31 (discussing copyright cases throughout the Second Circuit's history).

62. *Id.* at 931 (quoting *Brandir*, 834 F.2d at 1147).

In application, the court determined that the mannequin face was eligible for the protection of copyright law.⁶³ The mannequin's utilitarian function was to be used in hair displays and makeup training; thus, the specific facial features could easily be conceptualized separate from the mannequin itself.⁶⁴ There may have been different facial features chosen, or another "hungry look" expressed on the mannequin, and it still would have maintained its utilitarian function of being used in hair and makeup training.⁶⁵ There was no evidence that the specific facial features were utilized because of any functional consideration; if so, that would have been "weigh[ed] against a determination that [the mannequin] was purely the product of an artistic effort."⁶⁶ Therefore, because the mannequin's face was fully the product of the creative process, not the product of functional concerns, the mannequin was deemed subject to the protections of copyright law.⁶⁷

The Seventh Circuit also addressed the test Professor Paul Goldstein proposed which states that "a pictorial, graphic[,] or sculptural feature incorporated in the design of a useful article is 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."⁶⁸ This was the test that the district court applied in *Pivot Point*.⁶⁹ The court determined that this test however, when applied alone, is too similar to physical separability and "does not give a sufficiently wide berth to Congress'[s] determination that artistic material conceptually separate from the utilitarian design can satisfy the statutory mandate."⁷⁰ Therefore, the court rejected the application of this test in the *Pivot Point* case specifically; however, it is important to note, the court did not reject the test absolutely.⁷¹

While the Seventh Circuit in *Pivot Point* claimed to be applying the test from *Brandir*, the court did not, in fact, do so.⁷² The Seventh Circuit

63. *Id.*

64. *Pivot Point*, 372 F.3d at 931.

65. *Id.*

66. *Id.* at 932.

67. *Id.*

68. *Id.* at 917 (emphasis added) (quoting 1 PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW & PRACTICE § 2.5.3, at 109 (1989)).

69. *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 170 F. Supp. 2d 828, 833–34 (N.D. Ill. 2001), *vacated*, 372 F.3d 913 (7th Cir. 2004).

70. *Pivot Point*, 372 F.3d at 924.

71. *See id.*

72. *See id.* at 931–32; *see also Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

did not ask whether the nose, mouth, and eyes were designed independently of the functional consideration of serving as a model for learning to apply makeup.⁷³ Had the designs been made independently of functional considerations, the nose could have been under the mouth, and the eyes could have been on the cheeks or in the hair. Factually, this case parallels *Barnhart*, but the outcomes are opposite.⁷⁴ The Seventh Circuit essentially asked whether a different nose or mouth could have worked, and that answer is always yes! Just as a different configuration of tubing could have been used in *Brandir*, or different shoulders could have been used in *Barnhart*. The *Brandir* test is to ask whether the designer took function into account in developing this feature, and if that answer is yes, there is no separability.⁷⁵ In *Pivot Point*, the designer clearly took the mannequin's function into account in designing the nose, eyes, and mouth. The nose was meant to look like a nose, and the eyes were meant to look like eyes. There were no abstract shapes or alterations made to make the mannequin unable to serve as a teaching device for makeup application.⁷⁶ Therefore, no separability should have been found.

However, like the Second Circuit, the Seventh Circuit utilizes a variety of tests to come to the final decision of copyright protection.⁷⁷ Although different on their faces, in application the circuit courts are typically able to reach consistent outcomes when utilizing these various tests for determining conceptual separability.

B. Inconsistencies

Although tests for physical and conceptual separability are generally consistent in outcome, there are of course many cases which illustrate the inconsistencies in determining copyright protection. For example, the Second Circuit made a clear error in its decision in the case of *Jovani Fashion, Ltd. v. Fiesta Fashions*.⁷⁸ In that case, the court had to determine

73. See *Pivot Point*, 372 F.3d at 931–32; see also *Brandir*, 834 F.2d at 1145.

74. Compare *Pivot Point*, 372 F.3d at 931 (determining a mannequin's utilitarian function was to be used in hair displays and makeup training, and that the specific facial features could easily be conceptualized separate from the mannequin itself, making it subject to the protection of copyright law), with *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985) (determining four human torso forms' utilitarian function to be displaying clothes, and that the aesthetic and artistic elements of the forms were neither physically nor conceptually separable from that utilitarian function, therefore making them unprotected under the copyright law).

75. *Brandir*, 834 F.2d at 1145.

76. See *Pivot Point*, 372 F.3d at 931.

77. See *id.* at 930–31.

78. See 500 Fed. App'x 42, 44–45 (2d Cir. 2012).

whether the design of a prom dress was subject to copyright protection.⁷⁹ The dress was deemed a useful article, with an intrinsic utilitarian function of conveying the information that the wearer was in a prom dress: “[A] garment specifically meant to cover the body in an attractive way”⁸⁰ Therefore, it was determined that the design elements of sequins and crystals on the dress could not be physically separated from the dress and sold without adversely affecting the garment’s function.⁸¹ The court went on, stating that “[n]o different conclusion obtains as to conceptual separability,” and that these elements were in place to “enhance the functionality of the dress as clothing for a special occasion.”⁸²

It is clear, however, that the *Jovani Fashion* court’s inconsistent holding does not result from the manner in which physical and conceptual separability were determined, but stems from the error in the earlier stage of determining the useful article’s intrinsic utilitarian function. The court identified the useful article’s intrinsic utilitarian function here as a prom dress—a dress that was designed to be attractive and to be worn for a special occasion.⁸³ However, this is precisely the type of function that Congress’s definition of useful article was meant to exclude from the scope of intrinsic utilitarian function.⁸⁴ A useful article, the court states in its decision, is “one having an intrinsic utilitarian function ‘that is not merely to portray the appearance . . . or to convey information.’”⁸⁵ Yet, the court goes on to identify the useful article here as a prom dress, which is to be attractive and worn for a special occasion.⁸⁶ This is an identification that is portraying an appearance and conveying information! Here, there is an obvious error in the copyright determination process, regardless of the physical or conceptual separability standard later utilized.

If the court had identified the intrinsic utilitarian function as covering the body to keep it warm, maintaining and promoting hygiene, or protecting the body from the elements, then it is clear that the sequins, crystals, and other artistic elements could in fact be removed from the dress with no effect on its utilitarian function. Moreover, once the court correctly identified the intrinsic utilitarian function, the chosen separability analysis that followed would provide the same outcome regardless of the test applied. For example, applying the Denicola test from *Brandir*, the

79. *Id.* at 43.

80. *Id.* at 44.

81. *Id.*

82. *Id.* at 44–45.

83. *Jovani Fashion*, 500 Fed. App’x at 45.

84. *See* 17 U.S.C. § 101 (2012).

85. *Jovani Fashion*, 500 Fed. App’x at 45 (quoting 17 U.S.C. § 101).

86. *Id.* at 44.

court would ask whether the designer's choices were influenced by functional considerations.⁸⁷ Here, it is clear sequins and crystals were not added in consideration of the function of covering the body, but for artistic enhancement, and therefore, are subject to the protections of copyright law. If the court applied the Goldstein test from *Pivot Point*, the court would ask whether the feature can stand on its own as art traditionally conceived and whether the article would be equally as useful without the feature.⁸⁸ Here, a cluster of sequins and crystals can in fact be perceived as art,⁸⁹ and the dress with or without the sequins will fulfill its function of covering the body just as well. This again leads to a finding of copyright.

In deciding the *Jovani Fashion* case, it is clear the court disregarded Congress's intention. In an earlier case, *Whimsicality v. Rubie's Costume Co.*, which is factually similar to *Jovani Fashion*, the court stated, "While the pictorial, graphic[,] and sculptural aspects of useful articles may be copyrightable if they are separable from the article, physically or conceptually, clothes are particularly unlikely to meet that test—the very decorative elements that stand out being intrinsic to the decorative function of clothing."⁹⁰ Although the court in *Whimsicality* was determining the copyrightability of costumes rather than prom dresses, the key to the outcome again was not the application of the separability test, but the classification of the useful article's intrinsic utilitarian function.⁹¹ The plaintiff in *Whimsicality* attempted to classify the objects as soft sculptures, a classification that would have led to copyright protection, while the court correctly identified them as useful articles (wearable costumes).⁹² By identifying the objects as wearable costumes, there was nothing that could be physically or conceptually separated from the intrinsic utilitarian function of covering the body; whereas, by identifying the objects as soft sculptures, they were inherently copyrightable.⁹³ In *Jovani Fashion*, because the court identified the function as being attractive and worn for a special

87. See *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

88. See *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 924 (7th Cir. 2004).

89. Art is a massively subjective concept. One might go to a museum and see paintings that are solid black canvases, or trash clustered together on the floor. It is not for the courts to say what is and is not "art."

90. 891 F.2d 452, 455 (2d Cir. 1989) (first citing 17 U.S.C. § 101; and then citing *Brandir*, 834 F.2d at 1145).

91. See *id.* at 455–56.

92. *Id.*

93. *Id.*

occasion, the decorative features were deemed not separable,⁹⁴ when they should have been found as separable. This again shows the test applied regarding physical and conceptual separability is not as crucial to the copyright analysis as the determination of the article's intrinsic utilitarian function.

III. STAR ATHLETICA V. VARSITY BRANDS, INC.

One of the most recent and crucial decisions in the world of copyright law is the case of *Star Athletica, LLC v. Varsity Brands, Inc.*⁹⁵ The case made its way up to the Supreme Court and was argued on October 31, 2016, with a decision issued in March 2017.⁹⁶ The decision has shaken up the copyright world and although taken on certiorari to clear the confusion on the test to apply in determining separability,⁹⁷ the decision has left the lower courts in knots about how to work through these cases.

A. District Court's Decision

The case of *Varsity Brands, Inc. v. Star Athletica, LLC*, asked the court to decide whether the chevron, stripes, and braids of cheerleading uniform designs were eligible for copyright protection.⁹⁸ In deciding the case, the U.S. District Court for the Western Division of Tennessee discussed the many tests applied in copyright cases to ascertain whether pictorial, graphic, and sculptural elements can be identified separately from useful articles and thus, have protection under copyright law.⁹⁹ The court began by identifying the useful article's intrinsic utilitarian function as being a cheerleading uniform, specifically stating that "the utilitarian function of a cheerleading uniform is not merely to clothe the body; it is to clothe the body in a way that evokes the concept of cheerleading."¹⁰⁰ This classification directly conflicts with the definition of a useful article. Again, 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."¹⁰¹ But here, the intrinsic utilitarian function articulated by

94. *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. App'x 42, 44 (2d Cir. 2012).

95. 137 S. Ct. 1002 (2017).

96. *See id.* at 1002.

97. *See id.*

98. No. 10-2508, 2014 U.S. Dist. LEXIS 26279, at *22 (W.D. Tenn. Mar. 1, 2014).

99. *Id.* at *17-19 ("It is obvious that there is considerable disagreement regarding the proper standard to apply when considering whether elements of protectable PGS works [pictorial, graphic, and sculptural works] are separable from their utilitarian function.")

100. *Id.* at *24.

101. 17 U.S.C. § 101 (2012).

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the court was conveying the information that the wearer was a cheerleader.¹⁰²

After determining that the useful article's intrinsic utilitarian function was to convey the wearer was a cheerleader, the court had to determine whether the "cheerleading uniform [can] be conceived without any ornamentation or design, yet retain its utilitarian function as a cheerleading uniform[.]"¹⁰³ The court determined that no, the designs were not separable from the uniform because without them the uniform's blank canvas would be unable to portray the concept that the garment was a cheerleading uniform.¹⁰⁴ The court went on to explain that without the chevrons, stripes, ribbons, and designs, the garment invokes an entirely different concept in the viewers mind than that of a cheerleading uniform.¹⁰⁵ As such, the uniform's design merged with the utilitarian function it serves.¹⁰⁶ Even attempting to physically separate the decorations from the garment, the court found, invokes the same result: "[P]lacing them on a different canvas does not remove their association as cheerleading uniforms."¹⁰⁷ Therefore, as a matter of law, the court determined that the uniforms did not qualify for copyright protection.¹⁰⁸

B. Circuit Court's Decision

The decision of the district court was appealed to the Sixth Circuit, where the question of whether elements of the cheerleading uniforms were subject to copyright protection was revisited.¹⁰⁹ A crucial difference in the circuit court's decision in comparison to the district court was the identification of the useful article's intrinsic utilitarian function. Here, the court determined that the utilitarian function of the uniform was to cover the body, wick away moisture, and withstand the athletic movements.¹¹⁰ The district court had previously determined that the utilitarian aspect of the uniform was to convey that the wearer was a cheerleader—an impermissible intrinsic utilitarian function under the copyright law's definition of a useful article.¹¹¹

102. *Star Athletica*, 2014 U.S. Dist. LEXIS 26279, at *24.

103. *Id.* at *22.

104. *Id.* at *23.

105. *Id.* at *22.

106. *Id.* at *24.

107. *Star Athletica*, 2014 U.S. Dist. LEXIS 26279, at *25.

108. *Id.* at *26.

109. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 470–71 (6th Cir. 2015).

110. *Id.* at 490.

111. *Star Athletica*, 2014 U.S. Dist. LEXIS 26279, at *24; *see also* 17 U.S.C. § 101 (2012).

After correcting the district court's error in determining what the intrinsic utilitarian function of the uniform was, the circuit court addressed whether the pictorial, graphic, or sculptural design elements could be identified separately from the uniform design's utilitarian function.¹¹² The court here again disagreed with the district court,¹¹³ which determined that the stripes, chevrons, zigzags, and other design elements were intertwined with the utilitarian function of conveying that the wearer is a cheerleader.¹¹⁴ The court instead found that the designs can in fact be identified separately from the utilitarian aspects of the uniforms, as evidenced by the fact that consumers can identify differences and choose between the features of each of the designs.¹¹⁵

Subsequently, the court determined that these designs could exist independently of the utilitarian aspects of the cheerleading uniform.¹¹⁶ For example, the designs could appear on practice gear, warm-ups, t-shirts, or jackets, and the various arrangements and designs are interchangeable.¹¹⁷ Therefore, the designs were deemed unnecessary to the uniform's ability to keep the body covered, allow for athletic movements, and wick away moisture, and were entitled to the protections of copyright law.¹¹⁸

C. Supreme Court's Decision

The Sixth Circuit's decision was appealed to the Supreme Court and heard in October 2016.¹¹⁹ The Supreme Court granted certiorari to "resolve [the] widespread disagreement over the proper test for implementing [17 U.S.C.] § 101's separate identification and independent-existence requirements."¹²⁰ The Court's decision here, as written by Justice Thomas, held that the cheerleading uniforms satisfied the test of separability and the decision of the Sixth Circuit was affirmed.¹²¹

In the decision, the Court articulated that the main issue facing the

112. *Star Athletica*, 799 F.3d at 490–91 (quoting 17 U.S.C. § 101).

113. *See id.* at 491 (quoting *Star Athletica*, 2014 U.S. Dist. LEXIS 26279, at *24).

114. *Star Athletica*, 2014 U.S. Dist. LEXIS 26279, at *24.

115. *Star Athletica*, 799 F.3d at 491 (citing *Star Athletica*, 2014 U.S. Dist. LEXIS 26279, at *25).

116. *Id.*

117. *Id.*

118. *Id.* at 492 (citing *Carol Barnhart Inc. v. Econ Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985)).

119. *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1002 (2017) (argued in October 2016 and decided in March 2017).

120. *Id.* at 1007.

121. *Id.*

Court was whether the lines, chevrons, and shapes were “eligible for copyright protection as separable features of the design of those cheerleading uniforms.”¹²² In reaching its decision, the Court first articulated that a separability analysis must be used, as the item at hand was a useful article that incorporated pictorial, graphic, and sculptural features.¹²³ Next, the Court addressed whether the features “can be identified separately from and [are] capable of existing independently of the [article’s] utilitarian aspects”¹²⁴ This is where the Court focuses its analysis, determining what the proper uniform test is that should be used to decide separability.¹²⁵ The Court begins with the statute’s text, which states that “a ‘pictorial, graphic, or sculptural featur[e]’ incorporated into the ‘design of a useful article’ is eligible for copyright protection if it (1) ‘can be identified separately from,’ and (2) is capable of existing independently of, the utilitarian aspects of the article.”¹²⁶

From this statutory interpretation, the Court looked to previous analyses in cases which applied the statute. To support its interpretation of the Copyright Act, the Court looked specifically to *Mazer v. Stein*.¹²⁷ *Mazer* was decided under the 1909 Copyright Act, and its holding that copyright protection was available to a sculpture used as a lamp base, despite its intention for use as a part of a useful article,¹²⁸ led to Congress’s enactment of a new regulation under copyright law.¹²⁹ Later, that language from the *Mazer* case, and the subsequent copyright regulation, was essentially “lifted” into the current Copyright Act governing *Star Athletica*.¹³⁰ Based on that history, the Court determined that “a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.”¹³¹

Notably, Justice Thomas makes no reference to the clear error made by the district court, and subsequently corrected by the Sixth Circuit,

122. *Id.* at 1008–09.

123. *Id.* at 1009.

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

125. *Id.* at 1009.

126. *Id.* at 1010 (alteration in original) (quoting 17 U.S.C. § 101 (2012)).

127. *Id.* at 1011 (citing 347 U.S. 201, 214, 218–19 (1954)).

128. *Mazer*, 347 U.S. at 202, 214, 218–19.

129. *See Star Athletica*, 137 S. Ct. at 1011 (citing MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 2A.08(B)(1)(b) (2018)); *see also* 37 C.F.R. § 202.10(c) (1960) (superseded).

130. *Star Athletica*, 137 S. Ct. at 1011–12; *see also* 17 U.S.C. § 101.

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

which identified the useful article's intrinsic utilitarian function as protecting the body and allowing for athletic movements.¹³² Without any clear mention of this phase of determining copyrightability, the Court jumps immediately to the separability test and states that the application in this case is straightforward.¹³³ Abandoning the concept of physical and conceptual separability, the Court articulates the uniform test for determining separability:

[A]n artistic feature of the design of a useful article is eligible for copyright protection if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article.¹³⁴

Then, the Court makes the general conclusion that the "decorations can be identified as features having pictorial, graphic, or sculptural qualities."¹³⁵ Next, the Court concludes that if those decorations were separated from the uniform and applied in other mediums, they would qualify as works of art under § 101.¹³⁶

The analysis in Justice Thomas' decision regarding the copyrightability of the cheerleading uniform is minimal. General conclusions are stated by the Court with no real explanation as to how or why they were reached. This case was taken by the Supreme Court for the purpose of articulating a universal test to be applied by all courts in determining what is and is not protected by copyright law.¹³⁷ The test articulated, however, seems to be no more than a reiteration of the statute; a statute which courts have demonstrated, through their adoption of various separability tests, is not a workable basis for determining copyright protections. With such a

132. *See id.* at 1007–08.

133. *Id.* at 1008–12. In jumping right to the separability analysis, it may be assumed that the Court is deeming the phase of identifying the intrinsic utilitarian function as an unnecessary step in the copyright analysis. If this is the case, the separability analysis is no longer necessary. Congress makes clear that separability is only used when an article is deemed useful, and thus the only way it is eligible for copyright protection is if there are pictorial, graphic, or sculptural works that can be identified separate from the useful article itself. 17 U.S.C. § 101. If the Supreme Court is no longer deeming the identification of the useful article's intrinsic utilitarian function necessary, then in actuality, a separability analysis is not the proper way to determine whether copyright law should protect the article. However, because the court did not expressly reject the intrinsic utilitarian function determination, this Note will not develop this possibility further, and will assume that the Court adopted the Sixth Circuit's determination.

134. *Star Athletica*, 137 S. Ct. at 1016.

135. *Id.* at 1005–06.

136. *Id.* at 1006.

137. *Id.* at 1007.

minimal analysis, the decision leaves future courts faced with copyright issues without guidance as to how this test is to be applied or analyzed.

Furthermore, the decision of Justice Thomas failed to discuss, or even mention, the crucial mistake made in the district court and corrected in the circuit court.¹³⁸ That mistake, in identifying the useful article's intrinsic utilitarian function, is what ultimately steered the outcome of the copyright determination, regardless of what "test" was applied in the separability portion of the analysis.¹³⁹ By ignoring this clear error, the Court failed to recognize the true inconsistencies in copyright protection and instead created a "test" that essentially did nothing more than restate the copyright statute.

IV. STAR ATHLETICA'S AFTERMATH—THE "TEST" AND ITS IMPLICATIONS

Based on the new "test" as articulated by Justice Thomas, courts are now forced to abandon the physical and conceptual separability tests previously applied in their specific circuits, and apply the generic, statute-like test of *Star Athletica*. As evidenced by subsequent cases, this new test has opened the door to copyright protection to a variety of useful articles, which may not have received protection under the previous methods of analysis. If this continues to prove to be true, the consumer goods Congress intended to keep widely available to the public may become only available to the select few who can afford the newly copyrighted goods.

A. Recent Case Decisions—Post *Star Athletica*

One of the first cases to face the federal courts after *Star Athletica* was the case of *Jetmax, Ltd. v. Big Lots, Inc.*¹⁴⁰ In the case of *Jetmax*, the U.S. District Court for the Southern District of New York had to determine whether a tear drop light set contained artistic elements that qualified for copyright protections.¹⁴¹ The light set there had an undisputed, intrinsic utilitarian function of providing light to a room.¹⁴² The court then had to decide whether the set contained any artistic elements sufficient to warrant copyright protection.¹⁴³ In making the decision, the court applied the test as articulated in the case of *Star Athletica*, and in doing so the

138. *Id.* at 1007–08.

139. *See* *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015).

140. No. 15-cv-9597, 2017 U.S. Dist. LEXIS 138041, at *1 (S.D.N.Y. Aug. 28, 2017).

141. *Id.* at *12.

142. *Id.* at *11–12.

143. *Id.* at *12.

court conclusively determined that the decorative covers of the light set could be identified separately from the intrinsic utilitarian function of the light, and that those covers were sculptural works that could exist apart from the light set.¹⁴⁴ The primary purpose of the covers was artistic and even without the covers, the light string remained useful.¹⁴⁵ Therefore, the tear drop light set was deemed eligible for copyright protection.¹⁴⁶ However, if the court would have applied the test from *Brandir* or *Barnhart*, the court would have likely taken into account that the covers were designed with the functional consideration of protecting the bulb, and were therefore, not subject to the protections of copyright.

Similarly, in *Design Ideas Ltd. v. Meijer, Inc.*, the U.S. District Court for the Central District of Illinois was faced with the question of whether a clothespin with a bird on the top (“Sparrow Clip”) qualified for copyright protection.¹⁴⁷ In making the determination, the Court applied the test as articulated in *Star Athletica*.¹⁴⁸ In doing so, the Sparrow Clip was deemed eligible for the protections of copyright law because the bird portion could be seen as a three-dimensional work of art separate from the useful article (the clothespin itself) and that bird portion would qualify as a sculptural work on its own.¹⁴⁹ Therefore, the Sparrow Clip was deemed eligible for copyright protection.¹⁵⁰ However, this finding would have also been easily reached applying either the test from *Brandir* or *Barnhart*, and is factually parallel to the *Mazer* case, after which Congress modeled the relevant statute.

In both *Jetmax* and *Design Ideas*, the courts reached the conclusion of whether features of the useful article were subject to copyright after a very brief, conclusory analysis. Like in *Star Athletica*, the courts applying this new test have no explanatory rationale as to why or how they reached the conclusion of copyright protection. The opinions simply state the test articulated in *Star Athletica* and the conclusion that the features are subject to such protection.¹⁵¹

Applying this new test to cases such as *Brandir* and *Barnhart* lead

144. *Id.* at *15 (quoting *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1008 (2017)).

145. *Jetmax*, 2017 U.S. Dist. LEXIS 138041, at *16.

146. *Id.* at *8.

147. No. 15-cv-03093, 2017 U.S. Dist. LEXIS 94489, at *3 (C.D. Ill. June 20, 2017).

148. *Id.* at *5–8.

149. *Id.* at *6, *8.

150. *Id.* at *7–8.

151. See generally *Jetmax*, 2017 U.S. Dist. LEXIS 138041, at *1 (providing a minimal analysis in determining whether a tear drop light set could receive copyright protection); *Design Ideas*, 2017 U.S. Dist. LEXIS 94489, at *1 (providing minimal analysis in deciding whether a sparrow clip could receive copyright protection).

to similar outcomes. *Brandir*, for example, where the Second Circuit found copyright protection did not apply,¹⁵² would qualify for copyright protection under this new test. The shape of the tube can be perceived as a two- or three-dimensional work of art, and if imagined elsewhere it would qualify as a pictorial, graphic, or sculptural work, namely, a sculpture.¹⁵³ Thus, under the court's new test, the *Brandir* court would have concluded copyright protection exists for the bike rack. Similarly, *Barnhart*, a case where the Second Circuit found copyright did not apply,¹⁵⁴ would qualify for copyright protection under this new test. The shape of the mannequin could in fact be perceived as a three-dimensional work of art, and if imagined in another medium it again could be perceived as pictorial, graphic, or sculptural work. Thus, again under the court's new test, the *Barnhart* court would also have ended in finding copyright protection existed.

This is worrisome to many in the industry who believe that because of this, copyright protection will extend beyond Congress's intention in the creation of the Copyright Act,¹⁵⁵ and should be worrisome to the general public as a whole. When consumer goods qualify for copyright protection, one company has control. This will drive up prices, and potentially create a monopoly over designs that Congress intended to be readily available for all.¹⁵⁶

B. Implications of the New Copyright "Test"

As previously analyzed, Congress limited the protection for industrial designs.¹⁵⁷ If, however, this test opens the doors to copyright protection as it has done so far, these consumer goods may become so exclusive, and so highly priced, that they are only available to the elite of society.

The global knock-off industry accounts for about \$461 billion according to a report by the Organisation for Economic Cooperation and Development.¹⁵⁸ This massive industry may be drastically affected by the new copyright standards the Supreme Court created in *Star Athletica*.

152. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1143 (2d Cir. 1987).

153. *Id.* at 1147.

154. *Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 412 (2d Cir. 1985).

155. See H.R. REP. NO. 94-1476, at 55 (1976) (identifying the types of items that Congress intended not to receive copyright protection).

156. Ann Bartow, *Trademark: Today and Tomorrow: Institute for Intellectual Property & Information Law Symposium: Counterfeits, Copying and Class*, 48 HOUS. L. REV. 707, 708 (2011).

157. See *id.*

158. Alanna Petroff, *The 'Fakes' Industry is Worth \$461 Billion*, CNN MONEY (Apr. 18, 2016, 6:05 AM), <http://money.cnn.com/2016/04/18/news/economy/fake-purses-shoes-economy-counterfeit-trade/index.html>.

Amanda Ciccattelli¹⁵⁹ argued that the implications of *Star Athletica* will cause fashion retailers to “adjust their business models . . . as elements of the designs that may not have been deemed copyrightable may soon be.”¹⁶⁰ Currently, fashion retailers are able to generate large amounts of revenue from knock-offs of luxury items because of the fact that there is so little protection for the designs.¹⁶¹ Now, with a test that has allowed increased copyright protection, the protection on fashion designs may greatly expand and cause the knock-off industry to drop. As stated in a recent article referencing the *Star Athletica* case:

If courts perform separability analysis in such a way that increases the protection of clothing design, as the Supreme Court recently did, then the low-IP equilibrium within which fashion operates will change. Many companies and individuals that were not infringing before will become infringers, transaction costs might increase, and fashion may face a tragedy of the anticommons.¹⁶²

This may have severe repercussions on the public as a whole, as the majority of people cannot afford luxury brands and buy mainly knock-off, or less expensive models and brands of consumer goods.

This expansion goes completely against the intent of Congress. Congress specifically created the current Copyright Act as a way to “draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.”¹⁶³ The Supreme Court’s decision, however, has seemingly blurred that line, and has created a test that will likely lead to many industrial designs being protected by copyright law. If courts continue to apply this test in such a conclusory manner, they may begin to grant copyright protection to things like clothing designs, car designs, household items, and more. This will likely cause these now common items to only be available to the wealthy members of society due to their exclusiveness (which will lead to an increase in price). This is the exact opposite of what was intended in creating this law.¹⁶⁴

Moreover, now that the Supreme Court has issued a decision on the topic, it is unlikely that the Court will revisit a decision of the same nature

159. Amanda Ciccattelli is a research journalist and writer for *Inside Counsel*. See *Amanda Ciccattelli*, MUCK RACK, <https://muckrack.com/amanda-ciccattelli> (last visited Feb. 6, 2019).

160. Amanda Ciccattelli, *Star Athletica, LLC vs. Varsity Brands Case Continues to Spark Fashion Law Controversy*, INSIDE COUNSEL, May 18, 2016.

161. *Id.*

162. Margot E. Kaminski & Guy A. Rub, *Copyright’s Framing Problem*, 64 UCLA L. REV. 1102, 1172–73 (2017).

163. H.R. REP. NO. 94-1476, at 55 (1976).

164. Congress expressed its desire to create a line between what the Copyright Act should and should not protect. See *id.*

anytime soon. This decision may not be called into question by any lower courts, causing them to continue to conclusory grant copyright protection to industrial designs which previously would not have received such protection. Without the Court's intervention, the only hope to change the impact of this decision is a legislative change implemented by Congress. However, in light of the political climate and hot topic issues such as healthcare and immigration, it is unlikely Congress will address this anytime in the near future.

V. NEW TEST PROPOSAL

Since the Supreme Court issued its decision in *Star Athletica*, professionals in the intellectual property field have proposed a variety of theories as to what the Court's decision will do to industrial designs and consumer goods, and what the Court should have done in formulating a uniform test for copyright protection.¹⁶⁵ In deciding this case, the Supreme Court focused on the discrepancies between circuit courts' tests for analyzing whether there are any artistic elements separable from the utilitarian aspect of the article.¹⁶⁶ In doing so, the Court completely ignored the importance of the initial classification of the useful article's intrinsic utilitarian function.¹⁶⁷ It is the determination of the intrinsic utilitarian function of a useful article, not the application of the separability test, that truly determines the outcome. In fact, the separability test will not even be applied if an article is not deemed to be "useful"—having an intrinsic utilitarian function other than conveying an appearance or portraying information.¹⁶⁸ The outcome of the second test, separability, hinges on that initial determination.

For example, in *Star Athletica*, the district court framed the article's intrinsic function as looking like a cheerleading uniform and therefore,

165. See, e.g., Bill Donahue, *The Biggest Open Question in Copyright Law*, LAW360 (Sept. 6, 2017, 9:43 PM), https://www.law360.com/ip/articles/958500/the-biggest-open-questions-in-trademark-law-part-1?nl_pk=88415768-d0fc-4b8c-ac54-c442ceb4e1f6&utm_source=newsletter&utm_medium=email&utm_campaign=ip.

166. See generally *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (referencing different separability tests from the decisions of various circuit courts across the nation).

167. *Id.* at 1007–08.

168. The copyright statute provides that pictorial, graphic, and sculptural works qualify for copyright protection. 17 U.S.C. § 102 (2012). However, according to the definition of a pictorial, graphic, or sculptural work, the design of useful articles may only be eligible for copyright protection if they exist separately from the article's intrinsic utilitarian function. See *id.* Thus, without finding a utilitarian function, there is no need for a separability analysis.

regardless of the test applied, the article was not subject to copyright protection.¹⁶⁹ However, a notable error is that the intrinsic utilitarian function identified was in clear conflict with Congress's definition of an intrinsic utilitarian function, in that, the court's determination is a function that is clearly conveying information.¹⁷⁰ On appeal, the circuit court framed the article's intrinsic utilitarian function as covering the body, wicking away moisture, and allowing for athletic movements.¹⁷¹ This change in identifying the article's intrinsic utilitarian function completely changed the outcome of copyright protection, regardless of which test was applied, and the court found the uniform was in fact subject to copyright protection.¹⁷² It did not matter in either instance if the court applied the Denicola test, looking at whether the artistic and utilitarian elements had merged, or the Seventh Circuit's test determining the creator's artistic intent. Either way, the outcome turned on that initial classification of the article's intrinsic utilitarian function.

Similarly, as previously discussed, the court in *Jovani Fashion* classified the article's utilitarian function as being a prom dress, meant to cover the body in a beautiful way for a special occasion.¹⁷³ Due to this identification, the court went on to decide that the dress then could not be subject to copyright protection because removing any of its elements would take away from the intrinsic utilitarian function.¹⁷⁴ However, had the court correctly identified the utilitarian function as being clothing to cover and protect the body from the elements, rather than a function that is precisely what Congress said *not* to do, a function that is portraying an appearance,¹⁷⁵ the court would have likely determined that the additional design elements, such as the gems and sequins, could in fact be separated from the dress (irrespective of what separability analysis is applied), and therefore, be eligible for copyright protection.

Finally, looking at the case of *Chosun International, Inc. v. Chrisha Creations, Ltd.*, the court had to determine whether Halloween costumes that contained hoods with animal figures on them were subject to the protections of copyright.¹⁷⁶ There, the court correctly identified the intrinsic

169. See *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 U.S. Dist. LEXIS 26279, at *24–26 (W.D. Tenn. Mar. 1, 2014).

170. See *id.* at *24; see also 17 U.S.C. § 101 (2012).

171. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015).

172. See *id.* at 491–92.

173. *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. App'x 42, 44 (2d Cir. 2012).

174. *Id.* (citing *Mazer v. Stein*, 347 U.S. 201, 203 (1953)).

175. See 17 U.S.C. § 101; H.R. REP. NO. 94-1476, at 55 (1976).

176. 413 F.3d 324, 325 (2d Cir. 2005).

utilitarian function as covering the body of the wearer.¹⁷⁷ With this function in mind, the court could not say that the animal head is not in any way separable from the ability to cover the wearer's body, and thus, these costumes were covered by the protections of copyright.¹⁷⁸ However, if the court had incorrectly identified the utilitarian function of the costume to be to allow the wearer to look like an animal for Halloween, then the court would have had a hard time determining that removing the animal head would still allow that utilitarian function to remain intact, irrespective of the particular test for separability the court applied. This again demonstrates that the identification of the article's intrinsic utilitarian function determines the outcome of the copyright analysis.

Despite the clear errors in identifying the intrinsic utilitarian function, and inconsistencies in outcome no matter the separability test applied when the intrinsic utilitarian function is correctly identified, the Supreme Court disregarded the intrinsic utilitarian function issue and focused on the separability analysis tests.¹⁷⁹ In reality, the Court should have articulated a uniform test for identifying the intrinsic utilitarian function of a useful article. If the Court would have done so, it is likely that the inconsistencies in the copyright analysis outcome would no longer occur.

It is difficult to determine how to make a simple test even more simplified, but it is evident by the Courts' difficulty in application, that doing so is necessary. The Copyright Act provides that a useful article is an article that has an intrinsic utilitarian function *other than* portraying an appearance or conveying information.¹⁸⁰ Therefore, in the initial question of identifying whether an article is a useful one, the Court must identify a function of the article that is not (1) portraying an appearance, or (2) conveying information. Seemingly, this is easy to do, but notably the courts are struggling.

It is proposed that in order to determine what the intrinsic utilitarian function of a useful article is, the Court should follow a particular stage-by-stage format, only moving on to the next stage when appropriate:

- (1) identify *any* function of the article;
- (2) determine whether that identified function portrays an appearance—if the answer is yes, go back to stage (1); if the answer is no, go on to stage (3);
- (3) determine whether that identified function conveys information—if the answer is yes, go back to stage (1); if the answer is

177. *Id.* at 330.

178. *Id.*

179. *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007–08 (2017).

180. 17 U.S.C. § 101 (2012).

no, the article is a useful article;

(4) apply the separability analysis.

If courts follow this format proceeding stage-by-stage, not moving on to the final conclusion until the court can answer in the negative to parts (2) and (3), then courts should be able to correctly identify the article's intrinsic utilitarian function, and therefore, steer the copyright analysis in the correct direction.

For example, if the Court needed to determine whether elements of a prom dress qualified for copyright protection, like in *Jovani Fashion*, the Court would first identify *any* function of the article.¹⁸¹ If the Court determined the function was "for the wearer to look beautiful," the Court would move to stage two and determine whether that function portrayed an appearance. It is clear that looking beautiful is portraying an appearance; thus, back to stage one. Another function could be "to flatter the body." Stage two would again push the Court back into phase one as this is portraying an appearance. The Court could go through this process for as long as necessary until it reaches a function that will survive all stages; for example, a function of covering the body. With that function, stage two would lead to a negative outcome; thus, moving on to stage three. At stage three, again the Court would be able to answer in the negative and be able to properly apply a separability analysis. The outcome there would in fact be that the added elements are subject to copyright protection.

It is therefore clear that by correctly identifying an article's intrinsic utilitarian function the separability analysis that follows, regardless of which test the court uses, will lead to consistent outcomes. The Supreme Court not only ignored the clear errors in identifying an article's intrinsic utilitarian function, but created a uniform "test" for separability that is no more than a reiteration of the relevant statute, which courts have demonstrated, by creating other tests, is not workable. It is proposed rather, that the courts follow the stages articulated here in making its determination of an article's utilitarian function. From there, the Court should apply whichever separability test it deems the most workable, and consistent outcomes will follow.

Another possibility to correcting inconsistencies in copyright law, yet more difficult in application, would be the creation of a specialized court. Currently, the U.S. Court of Appeals for the Federal Circuit handles all patent appeals due to the complex and specialized area of law patent. Similarly, the United States has separate courts for Veterans Appeals, Family Court matters, and Drug Court. Thus, the difficulties courts

181. See *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. App'x 42, 43 (2d Cir. 2012).

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have had in determining copyright, and the important societal impacts of the Court's copyright decisions, may steer the legislature to determine that a separate court system would eliminate any current issues and inconsistencies.

CONCLUSION

Congress created the 1976 Copyright Act specifically taking into account the importance of having consumer goods readily available for the public. The Supreme Court's recent determination in the copyright case of *Star Athletica* has seemed to open the door to copyright protection for industrial designs far beyond Congress's intent. This may have drastic impacts on the public and could have easily been avoided by simply breaking down the method in which the intrinsic utilitarian function is determined into a stage-by-stage process, as articulated here.