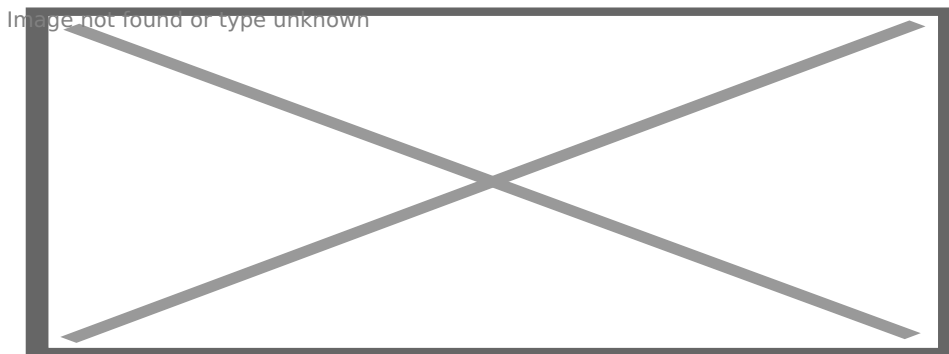


Supreme Court Finds Cheerleading Uniform Designs Copyrightable

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On March 22, 2017, the Supreme Court held in *Star Athletica, LLC v. Varsity Brands, Inc.* that designs on cheerleading uniforms may be protectable under the Copyright Act. The Court's 6-2 decision, clarifying the protectability of fashion designs under copyright law, and, more broadly, designs on useful articles, holds that a feature incorporated into the design of a useful article is eligible for copyright protection if it is conceptually separable from the article, and sets forth a two-part test for assessing separability.

The Respondents, Varsity Brands, Inc. and its affiliates, design and make cheerleading uniforms and own more than 200 U.S. copyright registrations for designs covering the surface of their uniforms and other garments. Respondents sued Petitioner Star Athletica LLC, which also manufactures and markets cheerleading uniforms, for infringing their copyrights in five designs on cheerleading uniforms. The designs in question were primarily "combinations, positions, and arrangements of elements" that included stripes, chevrons, zigzags, and colorblocks.



In March 2014, the District Court for the Western District of Tennessee entered summary judgment on the ground that Respondents' designs were not copyrightable because they were not "physically or conceptually" separable from the utilitarian function of a cheerleading uniform. In October 2015, the U.S. Court of Appeals for the Sixth Circuit reversed and held that the "graphic designs" on the uniforms were "separately identifiable," and thus copyrightable, because the designs were "capable of existing independently." The Sixth Circuit's decision acknowledged that courts had struggled to formulate a test for whether a design is separable from a useful article. Indeed, the various federal circuit courts applied a number of different tests to determine separability.

The Supreme Court's decision has put this issue to rest, holding that "a feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated." The Court noted that the first prong of the test typically is straightforward; in most cases, it is the second prong that is more difficult to satisfy.^[1]

With respect to the cheerleading uniforms at issue in the case, the Court first found that the decorations on the uniform had pictorial, graphic or sculptural qualities. Next, the Court found that if the arrangements of colors, shapes, stripes and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied to another medium, such as a painter's canvas, they would qualify as two-dimensional works of art. In fact, the Respondents *had* applied the designs to other media of expression, such as different types of clothing, without replicating the uniform. Thus, the decorations were separable from the uniforms and eligible for copyright protection. The Court, however, expressed no opinion on whether the surface decorations on the uniforms were sufficiently original to qualify for copyright protection. It further clarified that the only copyrightable feature of the cheerleading uniform is the two-dimensional art on the uniform fabric, and not the shape, cut or dimensions of the uniform itself.

The Court rejected the Government's argument that copyright extends only to useful articles that are equally useful without their artistic design features. Instead, the Court stated that the focus of the separability analysis should be on the copyrightability of the "extracted feature" and not on aspects of the useful article that remain. The Court also rejected incorporating certain "objective" components into its analysis. The Petitioner advocated for a test that would consider (1) whether the design elements showed artistic judgment independent of functional influence and (2) whether the design elements would still be marketable without their utilitarian functions. But the Court held that such a test would be inconsistent with the text of the Copyright Act because the statute limits courts' inquiry to how the article and feature are perceived, not how they are designed, and says nothing about copyrightability depending on marketability. Finally, the Court reiterated that there is no presumptive hostility towards copyright protection for industrial designs, even if Congress has not expressly provided protection for designs on articles of clothing.

Justice Ginsberg's concurrence argued that applying the separability test under the Copyright Act was unwarranted because the designs at issue were not designs of useful articles, such as clothing. Instead, she contended, the designs were copyrightable pictorial or graphic works that Respondents reproduced on useful articles. A dissent authored by Justice Breyer, while not disagreeing with the majority's test for separability, argued that the designs at issue on the cheerleading uniforms could not be perceived as works of art separable from the uniform itself, perhaps suggesting difficulty lower courts may have in applying the Court's separability test.

The impact of yesterday's decision will resonate within the fashion industry, as it upholds protections for pictorial, graphic or sculptural designs that are considered conceptually separable on clothing, and clarifies the standard for conceptual separability under the Copyright Act. While designs themselves must separately consist of copyrightable subject matter, as long as they can be perceived as separable from the utilitarian purposes of the useful articles they reside on, they are eligible for copyright protection.

The decision also is noteworthy for the sports industry, as it could arm teams and leagues with another weapon to protect original and distinctive team uniform designs. Protecting uniforms under trademark law would require a showing of a likelihood of consumer confusion, whereas protecting original and distinctive uniforms under copyright law requires only a showing of copying of protectable expression.

[\[1\]](#) Section 101 of the Copyright Act, from which the Court's separability test is derived, provides:

'Pictorial, graphic, and sculptural works' include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. § 101.

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