

Note: The opinion refers to the analyses of copyrightability made by several other courts in other cases. You can find pictures of the works at issue in the 2d Circuit's cases in the Casebook. The belt buckles at issue in the *Keiselstein-Cord* case are on page 185, the plastic shirt forms at issue in the *Carol Barnhart* case are on page 186, and the bike rack in the *Brandir* case is on page 188.

Varsity Brands, Inc. v. Star Athletica, LLC

799 F.3d 468 (6th Cir. 2015) *cert. granted* 2016 U.S. LEXIS 3031 (May 2, 2016)

KAREN NELSON MOORE, Circuit Judge.

Are cheerleading uniforms truly cheerleading uniforms without the stripes, chevrons, zigzags, and color blocks? That is the question that strikes at the heart of this appeal. Plaintiffs-Appellants Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc. (collectively "Varsity") have registered copyrights for multiple graphic designs that appear on the cheerleading uniforms and warm-ups they sell. Defendant-Appellee Star Athletica, LLC, also sells cheerleading gear bearing graphic designs that, according to Varsity, are substantially similar to the designs for which Varsity has valid copyrights. Star asserts that Varsity's copyrights are invalid because the designs at issue are unprotectable "design[s] of . . . useful article[s]." 17 U.S.C. § 101 (2012). The district court concluded that a cheerleading uniform is not a cheerleading uniform without stripes, chevrons, zigzags, and colorblocks, and therefore Varsity's copyrights are invalid. Varsity now appeals, and we take up the question that has confounded courts and scholars: When can the "pictorial, graphic, or sculptural features" that are incorporated into "the design of a useful article" "be identified separately from, and [be] capable of existing independently of the utilitarian aspects of the article[?]" *Id.*

For the reasons we now explain, we **REVERSE** the district court's judgment and enter partial summary judgment for Varsity with respect to whether Varsity's designs are copyrightable pictorial, graphic, or sculptural works, and **REMAND** the case for further proceedings consistent with this opinion.

I. BACKGROUND

Varsity designs and manufactures apparel and accessories for use in cheerleading and other athletic activities. It employs designers who sketch design concepts consisting of "original combinations, positionings, and arrangements of elements which include V's (chevrons), lines, curves, stripes, angles, diagonals, inverted V's, coloring, and shapes" When creating these designs, the designers do not consider functionality of the uniform or the ease of producing a full-sized uniform that looks like the sketch. After a designer completes a sketch, Varsity decides whether to implement that design concept for cheerleading or other uniforms, or whether to abandon the design concept altogether. Once Varsity selects a design for production, the production crew re-creates the design using one of four methods to create a cheerleading uniform: "cutting and sewing panels of fabric and braid together"; sublimation; embroidery; or screen printing. Varsity sells its merchandise by advertising in catalogs and online by inviting customers to choose a design concept among the many designs that Varsity offers, before selecting the shape, colors, and braiding for the uniform.

Varsity sought and received copyright registration for "two-dimensional artwork" for many of its designs, including the following designs, which are the subject of this lawsuit:

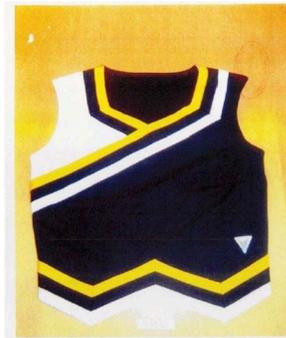
Varsity Brands, Inc. v. Star Athletica, LLC



Design 078
Registration No. VA 1-417-427



Design 0815
Registration No. VA 1-675-905



Design 299B
Registration No. VA 1-319-226



Design 299A
Registration No. VA 1-319-228



Design 074
Registration No. VA 1-411-535

Star markets and sells uniforms and accessories for football, baseball, basketball, lacrosse, and cheerleading. Varsity filed this lawsuit after seeing Star's marketing materials and noticing that Star was advertising cheerleading uniforms that looked a lot like Varsity's five registered designs. Varsity alleges five claims of copyright infringement for "selling[,] distributing, [and] advertising . . . goods bearing . . . design[s] that [are] copied from and substantially similar to" five of Varsity's designs in violation of the Copyright Act, 17 U.S.C. § 101 *et seq.* *Id.* at 7-10. . . . Star denied liability for all of Varsity's claims and asserted counterclaims, including a claim that Varsity made fraudulent representations to the Copyright Office.

At the close of the discovery period, both parties filed motions for summary judgment. Star argued that it was entitled to summary judgment on all of Varsity's claims. With respect to Varsity's copyright-infringement claims, Star argued that Varsity does not have a valid copyright in the five designs for two reasons: (1) Varsity's designs are for useful articles, which are not copyrightable; and (2) the pictorial, graphic, or sculptural elements of Varsity's designs were not physically or conceptually separable from the uniforms, making the designs ineligible for copyright protection. Varsity asserted a right to summary judgment, as well, arguing that its copyrights were valid because the designs were separable and non-functional, and that Star infringed those valid copyrights. Varsity also sought dismissal of Star's counterclaims. In response to Varsity's motion for summary judgment, Star primarily focused on whether Varsity's designs were unprotectable useful articles, but also argued that Varsity had not met its obligation "to prove which 'key elements' of its designs are original." Varsity responded in its sur-reply to Star's claim that Varsity's designs were unoriginal.

The district court entered summary judgment in Star's favor on the copyright claims, concluding that Varsity's designs were not copyrightable because the graphic elements of Varsity's designs are not physically or conceptually separable from the utilitarian function of a cheerleading uniform because the "colors, stripes, chevrons, and similar designs typically associated with sports in general, and cheerleading in particular" make the garment they appear on "recognizable as a cheerleading uniform." In other words, the district court held that the aesthetic features of a cheerleading uniform merge with the functional purpose of the uniform. The district court did not address whether Varsity's designs were unoriginal, and therefore unprotectable. . . .

This appeal followed. Varsity challenges the district court's entry of summary judgment on the issue of copyright infringement. . . .

II. COPYRIGHT INFRINGEMENT

We review the district court's grant of summary judgment de novo. [Citation.] When reviewing an entry of summary judgment, we view the record in the light most favorable to, and draw all reasonable inferences in favor of, the non-moving party. *Id.* The moving party is entitled to summary judgment if "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a).

Varsity has alleged that Star infringed its valid copyrights. To prevail, Varsity must show that (1) it owned a valid copyright in the designs, and (2) that Star "copied protectable elements of the work." *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 534 (6th Cir. 2004). We have said that "[t]he first prong tests the originality and non-functionality of the work," *id.* . . . We have also said, "[t]he second prong tests whether any copying occurred (a factual matter) and whether the portions of the work copied were entitled to copyright protection (a legal matter)." *Lexmark*, 387 F.3d at 534. This means that "a court should first identify and eliminate those elements that are unoriginal [or not copyrightable] and therefore unprotected" "before comparing similarities between" the plaintiff's and defendant's works. *Kohus v. Mariol*, 328 F.3d 848, 853 (6th Cir. 2003). If the elements of the work that the defendant copied as a factual matter were not copyrightable—that is, non-original or ineligible for copyright protection—then the plaintiff cannot establish that the defendant has infringed the copyright. [Citation.] The only element of the validity of Varsity's copyright that is at issue in this appeal is whether Varsity's designs are protectable subject matter under the Copyright Act. The parties do not address the originality of the designs, and therefore we do not address that issue now.

. . . Varsity contends that the district court used the wrong approach to determine whether a design is a protectable pictorial, graphic, or sculptural work that is separable from the utilitarian

aspects of the article. . . .Varsity [also] asserts that its designs are copyrightable as a matter of law because they are graphic works and not useful articles. We address each of these arguments in turn.

....

B. Useful Articles and Separable Designs

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The Copyright Act of 1976 provides protection for "original works of authorship fixed in any tangible medium of expression . . ." 17 U.S.C. § 102(a) (2012). Among the "works of authorship" that the Act protects are "pictorial, graphic, and sculptural works." *Id.* § 102(a)(5). "[P]ictorial, 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." *Id.* § 101. "[T]he design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work," and thus copyrightable, "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." *Id.* "A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." *Id.*

These provisions together require a two-part inquiry to determine whether an article is protectable: first, whether the design for which the author seeks copyright protection is a "design of a useful article," and if so, second, whether the design of the useful article "incorporates 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." *Id.* This second question is often referred to as testing the "separability" of the pictorial, graphic, or sculptural features of the design of a useful article. *See, e.g.,* COMPENDIUM III §§ 924.1-2 ("When examining a useful article, the [Copyright] Office must determine whether the article contains any pictorial, graphic, or sculptural features that are separable from its utilitarian function."); *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970, 972 (6th Cir. 1983) ("'[U]seful articles' are not generally copyrightable, although certain features of 'useful articles' may be copyrighted separately."). This appeal primarily concerns the separability of the graphic features of Varsity's cheerleading-uniform designs.

1. Separability

Courts, scholars, and students have endeavored to create a test to determine whether pictorial, graphic or sculptural features "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101; *see, e.g.,* 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:135-147 (2015); Note, Barton R. Keyes, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 Ohio St. L.J. 109, 115-143 (2008); Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y U.S.A. 339 (1990). We have not yet adopted an approach to determining whether the pictorial, graphic, or sculptural features of the design of a useful article are separable from the utilitarian aspects of a useful article, and so we do so now.

There are two ways to determine whether a pictorial, graphic, or sculptural work is separable from the utilitarian aspects of an article—physical separability and conceptual separability. The Copyright Office defines the physical-separability test as follows: "Physical separability means that the useful article contains pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact." COMPENDIUM III § 924.2(A). The Copyright Office considers "[a] sufficiently creative decorative hood

ornament on an automobile," which could be ripped from the hood of the automobile without destroying the ornament or the automobile, a physically separable sculptural aspect of the design of an automobile, which "can be identified separately from, and [is] capable of existing independently of, the utilitarian aspects of" the automobile. COMPENDIUM III § 924.2(A); 17 U.S.C. § 101.

Few scholars or courts embrace relying on the physical-separability test without considering whether the pictorial, graphic, or sculptural features of an article are conceptually separable because the physical-separability test has limitations. The physical-separability test works well to draw the distinction between aesthetic articles and useful articles when the objects at issue are three-dimensional, such as statuettes that serve as lamp bases. *See Mazer v. Stein*, 347 U.S. 201 (1954). The test is less effective, however, when the article at issue is two-dimensional because it is nearly impossible physically to detach the article from the object on which it appears. Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 744-45 (1983). And the statute expressly offers copyright protection to two-dimensional articles. 17 U.S.C. § 101 ("Pictorial, graphic, and sculptural' works include two-dimensional . . . works . . ."). Moreover, the physical-separability test can lead to inconsistent results that turn on how the article is made. Keyes, *supra*, at 120. For example, if the artist makes the statuette separately before putting a lamp fixture on top of it, then it is copyrightable under the physical-separability test. In contrast, if the statuette is wired through the body with a lamp socket in the head, then the statuette may not be eligible for copyright protection. *Id.*

Since Congress passed the Copyright Act of 1976, no court has relied exclusively on the physical-separability test without considering whether the pictorial, graphic, or sculptural features of a design are conceptually separable from the utilitarian aspects of the useful article. And we decline to be the first to reject conceptual separability altogether. To start, the House Report, which discusses the amendments to the Copyright Act, expressly refers to design "element[s] that, physically or conceptually, can be identified as separable from the utilitarian aspects of" a useful article. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 47, 55 (1976). We believe that abandoning conceptual separability altogether is therefore contrary to Congress's intent. In addition, our sibling "circuits have been almost unanimous in interpreting the language of § 101 to include both types of separability," *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 922 n.8 (7th Cir. 2004) (collecting cases), and we see no reason to create a circuit split. Therefore, we hold that the Copyright Act protects the "pictorial, graphic, or sculptural features" of a design of a useful article even if those features cannot be removed physically from the useful article, as long as they are conceptually separable from the utilitarian aspects of the article.

When the Copyright Office "determines that the useful article contains pictorial, graphic, or sculptural features that cannot be physically separated" from the utilitarian aspects of the useful article, then the Copyright Office applies the "conceptual separability test." COMPENDIUM III § 924.2(B). "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." *Id.* For example, the Copyright Office considers the following works of art conceptually separable from useful articles: "[a]n engraving on a vase," a "carving on the back of a chair," "[a]rtwork printed on a t-shirt," or "[a] drawing on the surface of wallpaper." *Id.*

Courts have struggled mightily to formulate a test to determine whether "the pictorial, graphic, or sculptural features" incorporated into the design of a useful article "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article" when those features cannot be removed physically from the useful article. [Citation.] Through the years, courts and scholars have proposed or used the following approaches to conceptual separability:

- (1) **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." COMPENDIUM III § 924.2(B).

(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." *Kieselstein-Cord [v. Accessories by Pearl, Inc.]*, 632 F.2d 989, 994 (2d Cir. 1980)] at 993.

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

(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." *Id.* at 422 (Newman, J., dissenting).

(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." *Brandir [International v. Cascade Pac. Lumber Co.]*, 834 F.2d 1142 (2d Cir. 1987)] at 1145; *see also Pivot Point*, 372 F.3d at 930-31; Robert C. Denicola, *supra*, at 741-45.

(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." *Pivot Point*, 372 F.3d at 934 (Kanne, J., dissenting).

(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." *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 NIMMER ON COPYRIGHT § 2.08[B][3]).

(8) **Patry's Approach:** There no need to engage in a separability analysis if (A) the work is the design of a three-dimensional article, and (B) the design is not of a "useful article." 2 PATRY ON COPYRIGHT § 3:145. 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." *Id.* § 3:146. This task requires two additional steps. *Id.* First, the court "must be able to discern pictorial, graphic, or sculptural features." *Id.* 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 . . ." *Id.* 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." *Id.* 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. *Id.*

(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." *See Keyes, supra*, at 141. "The first factor requires courts to consider the degree to which aesthetic concerns, as opposed to functional ones, motivate the designer." *Id.* The second factor considers

whether "the design is mostly dictated by function" or "hardly dictated by function at all." *Id.* at 142. 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." *Id.* If the design "is hardly dictated by function at all" then that fact "weigh[s] in favor of a finding of conceptual separability." *Id.*

In recent years, our colleagues on the Second and Fourth Circuits have used multiple of the above-listed approaches in the same case when analyzing whether the "pictorial, graphic, or sculptural features" of a design of a useful article "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article." 17 U.S.C. § 101. In *Chosun International, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 325 (2d Cir. 2005), the Second Circuit addressed whether a company that created and manufactured plush Halloween costumes made to look like stuffed toy animals had a valid copyright in its costume designs. The district court dismissed the complaint pursuant to Federal Rule of Civil Procedure 12(b)(6) on the basis that the costumes were not copyrightable. ... On appeal, the Second Circuit reversed, using multiple theories of copyrightability to explain why the designer-plaintiff's copyright-infringement claims could proceed. First, the court said that the costume's design elements could "be 'conceptualized as existing independently of their utilitarian function.' . . . Second, the court concluded that, even if some of the aesthetic design elements merged with the utilitarian elements, and therefore were not conceptually separable, the design was conceptually separable if the "design elements can be identified as reflecting the designer's artistic judgment exercised *independently* of functional influences." . . . Finally, the court noted that evidence may show that the plaintiff's designs were conceptually separable from the utilitarian function of the costume because the design "invoke[s] in the viewer a concept separate from that of the costume's 'clothing' function, and that their addition to the costume was not motivated by a desire to enhance the costume's functioning *qua* clothing"—a formulation of conceptual separability that harkens back to Judge Newman's ordinary-observer approach. [Citations.]

In *Jovani Fashion, Inc. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542 (S.D.N.Y. 2011), the district court used multiple approaches to address the copyrightability of a designer's prom-dress designs. To start, the district court identified the portion of the dress design that Jovani claimed was separable from the dress: "the selection and arrangement of sequins and beads and their respective patterns of the bust portion, as well as the wire-edged tulle added to the lower portion of the depicted dress." [Citation.] First, the district court found that no element of the design could be "ripped off the" dress and "reused or resold" "in its freestanding form," and therefore the elements were not physically separable. [Citation.] Despite the dress's "vague association with the aquatic," the district court concluded that the design did not "'invoke in the viewer a concept separate from that of the dress's 'clothing' function.'" [Citation.] Second, the design failed the design-process test because "each of the individual elements [was] plainly fashioned to fit the specific needs of a prom dress." . . . Each element of the design was part of the dress: "[t]he cloth swatch containing the sequins and beads is formed to compose the bust portion of the dress; the ruched-satin fabric is shaped into a waistband; and the layers of tulle make up the dress's skirt." [Citation.] Third, the "primary role of each element [of the dress's design] is to contribute to an attractive prom dress, or at least to attempt to do so," and therefore the aesthetic components of the design were not primary over the utilitarian elements' function. [Citation.] Fourth, and finally, "none of the elements," standing alone, "has any marketable worth." [Citation.]

Our colleagues on the Second Circuit affirmed, "largely for the reasons stated by the district court." *Jovani Fashion, Inc. v. Fiesta Fashions*, 500 F. App'x 42, 44 (2d Cir. 2012). The court additionally explained that "the artistic judgment exercised in applying sequins and crystals to the dress's bodice and using ruched satin at the waist and layers of tulle in the skirt does not invoke in the viewer a concept other than that of clothing" [Citation.] Thus, the court concluded that "these design elements are used precisely to enhance the functionality of the dress as clothing for a special occasion," and therefore "the aesthetic merged with the functional to cover the body in a particularly attractive way for that

special occasion." [Citation.] Finally, the Second Circuit acknowledged "that clothing, in addition to covering the body, serves a 'decorative function,' so that the decorative elements of clothing are generally 'intrinsic' to the overall function, rather than separable from it." [Citation.]

The Fourth Circuit also uses this "hybrid" approach to conceptual separability. In *Universal Furniture [Intl. v. Collezione Europa USA]*, 618 F.3d 417 (4th Cir. 2010), the court considered whether decorative elements adorning furniture, a useful article, were eligible for copyright protection. [Citation.] In reaching the conclusion that the design features were protectable, the Fourth Circuit used two approaches to conceptual separability. [Citation.] Our colleagues used the objectively necessary approach: "[T]he designs are 'wholly unnecessary' to the furniture's utilitarian function." [Citations.] They also applied the design-process approach: "[The designer's] process reflects an 'artistic judgment exercised independently of functional influences.'" [Citation.] The Fourth Circuit did not apply or consider any other approaches.

These cases from the Second and Fourth Circuits illustrate that it is difficult to select one approach to the question whether an artistic design is conceptually separable from the utilitarian aspects of the article. We adopt a similar hybrid approach now.

2. The Sixth Circuit Approach to Identifying Pictorial, Graphic, and Sculptural Works

We believe the best approach to determining whether a design is a copyrightable "pictorial, graphic, or sculptural work[]," 17 U.S.C. § 102, is to ask a series of questions that are grounded in the text of the Copyright Act: (1) Is the design a pictorial, graphic, or sculptural work? (2) 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"? *Id.* 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." 17 U.S.C. § 101.

Before addressing separability, a court should ask: (3) What are the utilitarian aspects of the useful article? For example, the utilitarian aspect of a chair is to provide a place for a person to sit. "Portray[ing] the appearance of the [useful] article" and "convey[ing] information" are two utilitarian aspects that courts may not use to determine whether pictorial, graphic, or sculptural features are separable. 17 U.S.C. § 101 (defining "useful article"). We believe that considering these two functions' "utilitarian aspects" in addition to an article's other utilitarian functions for the purpose of determining the separability of a graphic design would be at odds with the Copyright Act's definition of what makes an article a useful article.

Not only is this approach consistent with the text of the Copyright Act, it is consistent with the holdings of our sibling circuits. In *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 323 (2d Cir. 1996), the defendant in a copyright-infringement suit argued that fish mannequins "act as a mount for [fish] skin," and therefore the sculptural features of the mannequins were not separable from the mannequin's display function. The Second Circuit rejected that argument because "fish mannequins, even if considered 'useful articles,' are useful insofar as they 'portray the[ir] appearance.'" [Citations.] And the Second Circuit recently "express[ed] skepticism" about the contention that masquerading is a useful function because masquerading involves "portray[ing] the appearance of something (like a lion, ladybug, or orangutan), and in so doing, . . . cause[s] the wearer to be associated with, or appear as, the item portrayed." *Chosun*, 413 F. 3d at 329-30 n.2.

Once we have identified permissible utilitarian aspects, we ask the final two questions that have to do with separability. (4) Can the viewer of the design identify "pictorial, graphic, or sculptural features" "separately from . . . the utilitarian aspects of the [useful] article[?]" 17 U.S.C. § 101. 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. (5) Can "the pictorial, graphic, or sculptural features" of the design of the useful article "exist[] independently of[] the utilitarian aspects of the [useful] article[?]" *Id.* The objectively necessary approach is useful to answer this final question. If the pictorial, graphic, or sculptural features of the design of the useful article are "not required by [the useful article's] utilitarian functions" or are "wholly unnecessary to performance of the utilitarian function" of the useful article, then the pictorial, graphic, or sculptural features are not dictated by the function of the useful article, and therefore can exist without the useful article. [Citation.] The design-process approach may also help courts determine whether a design feature is necessary to the utilitarian aspects of the article because the designer's testimony may offer clues as to which components of the design are essential to the functionality of the useful article. [Citation.] But we do not endorse the design-process approach in its entirety. Finally, the Copyright Office has provided a helpful way to think about answering questions four and five: the pictorial, graphic, and sculptural features incorporated into the design of a useful article are conceptually separable if "the artistic feature [of the design] 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." COMPENDIUM III § 924.2(B). If the viewer of a design can imagine the pictorial, graphic, or sculptural features of the design of a useful article as an artistic work, then those features are separately identifiable and can exist independently.

We do not endorse looking at why the designer chose the ultimate design as the final expression of the result she was trying to achieve to the exclusion of other evidence. Nor do we adopt the likelihood-of-marketability test because it privileges a judge's personal taste in popular art, is often based entirely on conjecture, and is often undermined by the simple fact that the defendant in a copyright action has copied the work at issue. [Citations.] We also may not consider "the intention of the author as to the use of the work" in determining whether a pictorial work is registrable. 37 C.F.R. § 202.10(a).

With this background in mind, we now turn to address whether Varsity's designs "incorporate[] 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." 17 U.S.C. § 101.

C. Varsity's Designs

Question One: We begin our analysis by first identifying whether Varsity's designs are "pictorial, graphic, or sculptural works." 17 U.S.C. § 101. Varsity's designs, for which they received copyright registration, are "two-dimensional works of . . . graphic . . . art."

Question Two: Are Varsity's designs "design[s] of . . . useful article[s?]" 17 U.S.C. § 101. Varsity's designs are sketches that depict cheerleading crop tops and skirts—the components of a cheerleading uniform. In other words, they are designs of cheerleading uniforms and sportswear, which have an "intrinsic utilitarian function that is not merely to portray the appearance of [clothing] or to convey information." 17 U.S.C. § 101.

Question Three: What are the "utilitarian aspects" of cheerleading uniforms? Cheerleading uniforms have "an intrinsic utilitarian function," namely to "cover the body, wick away moisture, and withstand the rigors of athletic movements." Star contends that cheerleading uniforms identify the wearer as a cheerleader and a member of a cheerleading team. But this is no different than 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. *See* 17 U.S.C. § 101 ("A 'useful article' is an article having an intrinsic utilitarian function that is not merely to . . . convey information."). And therefore Star's purported utilitarian aspect of a cheerleading uniform is an impermissible factor. *See supra* Section II.B.2.

It also appears that Star makes one final argument as to why Varsity's graphic designs cannot "be identified separately from, and are [in]capable of existing independently of, the utilitarian aspects of the article": the designs' "decorative function" is one of the "utilitarian aspects" of a cheerleader uniform.

...
To the extent that Star contends that pictorial, graphic, or sculptural features are inextricably intertwined with the utilitarian aspects of a cheerleading uniform because they serve a decorative function, we reject that argument. Such a holding would render nearly all artwork unprotectable. Under this theory of functionality, Mondrian's painting would be unprotectable because the painting decorates the room in which it hangs. But paintings are copyrightable. [Citation.] It would also render the designs on laminate flooring unprotectable because the flooring would be otherwise unattractive. But the Copyright Act protects flooring designs that "hid[e] wear or other imperfections in the product." [Citation.] And statuettes adorning the base of a lamp would not be copyrightable under this theory because they serve the function of decorating an otherwise boring lamp base. But they are copyrightable under certain circumstances. *Mazer*, 347 U.S. at 214. Finally, holding that the decorative function is a "utilitarian aspect[] of [an] article," 17 U.S.C. § 101, would make all fabric designs, which serve no other function than to make a garment more attractive, ineligible for copyright protection. But it is well-established that fabric designs are eligible for copyright protection. *Accord Folio Impressions*, 837 F.2d at 763. We therefore conclude that a pictorial, graphic, or sculptural work's "decorative function" does not render it unable to "be identified separately from," or "[in]capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101.

Question Four: Can we identify pictorial, graphic, or sculptural features separately from the parts of the cheerleading-uniform design, which cover the body, permit free movement, and wick moisture? We can identify graphic features of Varsity's designs—the arrangement of stripes, chevrons, zigzags, and color-blocking. The district court concluded that these graphic features are not separately identifiable from a cheerleading uniform because a cheerleading uniform "without team colors stripes, chevrons, and similar designs typically associated with sports in general, and cheerleading in particular, is not recognizable as a cheerleading uniform." We disagree. First, Varsity's graphic designs do not "enhance the [cheerleading uniform's] functionality *qua* clothing." [Citation.] A plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip. The top and skirt are still easily identified as cheerleading uniforms without any stripes, chevrons, zigzags, or color-blocking. Moreover, the record establishes that not all cheerleading uniforms must look alike to be cheerleading uniforms. The five Varsity designs are examples of how a cheerleading uniform still looks like a cheerleading uniform no matter how different the arrangement of the stripes, chevrons, colorblocks, and zigzags appear on the surface of the uniform. All of Varsity's graphic designs are interchangeable. Varsity's customers choose among the designs in the catalog, including the five designs at issue, select one of the designs, and then customize the color scheme. The interchangeability of Varsity's designs is evidence that customers can identify differences between the graphic features of each design, and thus a graphic design and a blank cheerleading uniform can appear "side by side"—one as a graphic design, and one as a cheerleading uniform. Compendium III § 924.2(B). We therefore conclude that each of these graphic design concepts can be identified separately from the utilitarian aspects of the cheerleading uniform.

Question Five: Can the arrangement of stripes, chevrons, color blocks, and zigzags "exist[] independently of" the utilitarian aspects of a cheerleading uniform? We believe they can. Varsity's designers sketch their designs and select, place, and arrange various graphic elements, "such as stripes, lines, chevrons, inverted chevrons, angles, curves, coloring, and shapes." Varsity's production department either applies these graphic designs onto cheerleading uniforms or recreates the designs by sewing panels of fabric together. Varsity's 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." This evidence establishes that the designs are transferrable to articles

other than the traditional cheerleading uniform (crop top and skirt). In addition, the interchangeability of Varsity's various designs is evidence that the graphic design on the surface of the uniform does not affect whether the uniform still functions as a cheerleading uniform. Indeed, "nothing (save perhaps good taste) prevents" Varsity from printing or painting its designs, framing them, and hanging the resulting prints on the wall as art. [Citation.] We therefore conclude the arrangement of stripes, chevrons, color blocks, and zigzags are "wholly unnecessary to the performance of" the garment's ability to cover the body, permit free movement, and wick moisture. [Citation.]

Because we conclude that the graphic features of Varsity's designs "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of [cheerleading uniforms]," we hold that Varsity's graphic designs are copyrightable subject matter. 17 U.S.C. § 101. This conclusion is faithful to the statutory text of the Copyright Act and consistent with other courts' treatment of the protectability of clothing and the pictorial and graphic features that appear on clothing under the Copyright Act. Courts have drawn a line between "fabric design" and "dress design." "Fabric designs" are "design[s] imprinted on a fabric, such as a rose petal, which in a completed dress may appear repeatedly throughout the dress fabric, or may appear but once on a given dress." [Citation.] Take the work of Piet Mondrian, for example. Mondrian's artwork or design is separable as a work of art because not only is it possible to recreate the design on t-shirts, grocery bags, cellphone cases, or notebooks, but also it actually has been done: Yves St. Laurent used Mondrian's famous color-blocking and thick, black stripes to create cocktail dresses known as the "Mondrian look." *See N. Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1032 (9th Cir. 1992) (holding that a jury should determine whether the presumption of a valid copyright for a design of the front of pullover tops based on Mondrian designs was rebutted by claimed lack of originality). Mondrian's arrangement of color blocks and use of stripes are pictorial and graphic features "that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of" Yves St. Laurent's dress.

In contrast, it is impossible either physically or conceptually to separate a "dress design," which "graphically sets forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment," from the utilitarian aspects of clothing, i.e., to cover, protect, and warm the body. [Citation.] The shapes of the neckline (v-neck, square-neck, crew-neck), sleeves (short, long, puffy), skirt shape (a-line, pencil, midi, maxi), trouser cut (pleated, plain-front, cuffed), or pockets (patch, welt, jetted)—these are the components of a design that are inextricably connected with the utilitarian aspects of clothing: pockets store pencils or pens; pants and skirts cover the legs; shirts cover the torso modestly or less modestly depending on the neckline. The designs of these components of an article of clothing "can[not] be identified separately from, [or be] capable of existing independently of, the utilitarian aspects of the article [of clothing]." 17 U.S.C. § 101.

The Copyright Act protects fabric designs, but not dress designs. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 763 (2d Cir. 1991). A designer may obtain valid copyrights for "a multicolored striped sweater with puffy leaf appliques" and a cardigan, "which has a squirrel and leaves appliqued onto its multipaneled front." *Knitwaves*, 71 F.3d at 999 appx. The sweater has a utilitarian function—to provide warm cover for the torso and arms—and the sweaters still perform that function without the leaf or squirrel designs. Similarly, the design of a rose and "the placement of that rose repeated in horizontal rows against an ornate background" on fabric receive copyright protection. *Folio Impressions*, 937 F.2d at 761, 763, 765. But the creative arrangement of sequins, beads, ribbon, and tulle, which form the bust, waistband of a dress, do not qualify for copyright protection because each of these elements (bust, waistband, and skirt) all serve to clothe the body. *Jovani*, 808 F. Supp. 2d at 550.... And a collection of uniforms, which includes chef hats shaped like vegetables, tuxedo jackets with a "distinctive shawl collar styling with a deep V neckline," and semi-fitted jackets with princess seams and star buttons, does not receive copyright protection. *See Galiano*, 416 F.3d at 415 & n.3, 422.

Creative and arguably attractive as these articles may be, they are merely inventive designs used to cover the wearer's body and hair. Thus, the design of these hats and jackets (useful articles) "can[not] be identified separately from," and are not "capable of existing independently of, the utilitarian aspects of" a hat or a jacket. 17 U.S.C. § 101.

Because we believe that the graphic features of Varsity's cheerleading-uniform designs are more like fabric design than dress design, we hold that they are protectable subject matter under the Copyright Act. We therefore enter summary judgment for Varsity solely on the issue of the protectability of Varsity's designs as pictorial, graphic, or sculptural works. . . . We express no opinion about whether Varsity's designs are ineligible for copyright protection because they lack originality or any other reason. The district court did not address Star's contention that Varsity's designs are unoriginal and therefore we leave that issue for the district court to address in the first instance.

....

IV. CONCLUSION

Because the district court erroneously concluded that Varsity's designs were not copyrightable, we **VACATE** the judgment in favor of Star and enter partial judgment for Varsity on the sole issue of whether Varsity's designs are copyrightable pictorial, graphic, or sculptural works. . . We **REMAND** the case to the district court for further proceedings consistent with this opinion.

McKEAGUE, Circuit Judge, dissenting.

The majority presents a thoughtful approach to this difficult "metaphysical quandary" that courts have wrestled with for years. *See Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010). I agree with the majority's general approach. We first define the work's function and then ask whether the claimed elements can be identified separately from, or exist independently of, that function. I depart with the majority's analysis, however, in how the function of these designs is defined. I would hold that there is no conceptual separability and that Varsity's designs are not copyrightable. I therefore dissent.

Function. The majority explains that the function of a cheerleading uniform is to wick away moisture and "permit the wearer to cheer, jump, kick, and flip." That broad definition could be used to describe all athletic gear. But the particular athletic uniforms before us serve to identify the wearer as a cheerleader. Without stripes, braids, and chevrons, we are left with a blank white pleated skirt and crop top. As the district court recognized, the reasonable observer would not associate this blank outfit with cheerleading. This may be appropriate attire for a match at the All England Lawn Tennis Club, but not for a member of a cheerleading squad.

A narrower approach to "function" finds support in other circuits' caselaw. In *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 F. App'x 42, 44 (2d Cir. 2012), the Second Circuit concluded that the function of a prom dress was to clothe the body "in an attractive way for a special occasion" because this "clothing, in addition to covering the body, serves a 'decorative function.'" [Citation.] Why? Because "the decorative elements of clothing are generally 'intrinsic' to the overall function, rather than separable from it." [Citation.]. Similarly, the Fifth Circuit in *Galiano v. Harrah's Operating Co.*, 416 F.3d 411 (5th Cir. 2005), explained that a casino uniform's function is just that: to serve as a "casino uniform[]." *Id.* Clothing

provides many functions, but a uniform at its core identifies its wearer as a member of a group. It follows that the stripes, braids, and chevrons on a cheerleading uniform are integral to its identifying function.

The majority rejects this categorization because this holding would purportedly "render nearly all artwork unprotectable." That's not true. It renders unprotectable only artwork that is integral to an item's utilitarian function. In defining that function, we are confined by caselaw and by common sense. Take a dresser, for example. The function of a dresser is to store clothes and other articles. Any ornamental designs displayed on the surface of a dresser are not integral to that function. *Cf. Universal Furniture*, 618 F.3d at 434. Those ornamental designs would therefore be copyrightable. *Id.* In contrast, a painting is not subject to the separability analysis because it does not qualify as a "useful article" under 17 U.S.C. § 101.

Separability. Once function is properly defined, it logically follows: the placement of the stripes, braids, and chevrons is not separable from that function. In *Jovani Fashion*, in relation to a prom dress, the court excluded from copyright "the arrangement of decorative sequins and crystals on the dress bodice; horizontal satin ruching on the dress waist; and layers of tulle on the skirt." [Citation.] Here, as in that case, there is no evidence that Varsity's designers "exercise[d] artistic judgment 'independently of functional influences,' rather than as a 'merger of aesthetic and functional considerations.'" *Id.* . . . In both cases, the designers' aesthetic considerations merged with functional concerns: "to cover the body in an attractive way for a special occasion," *id.*, and to identify the wearer as a member of a particular cheerleading squad. Without the stripes, braids, and chevrons, a blank shell of a cheerleading uniform would lose an important dimension of its functional utility.

These designs are unlike other items that are copyrightable. Take the belt buckles in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980). The court in that case concluded that while belt buckles are utilitarian objects designed to hold pants in place, the claimed designs were "conceptually separable sculptural elements." *Id.* Here, unlike *Kieselstein-Cord*, Varsity's designs would lose their ability to identify the wearer as a cheerleader without these aesthetic elements. Rather than simply "giv[ing the pieces] a pretty face," [citation], Varsity's designs enhance the garment's utility. The claimed artistic choices thus cannot be separated from that function.

....

The fact that Varsity's artistic choices may have been "aesthetically satisfying and valuable" likewise does not change this conclusion. *See Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985) (quoting H.R. REP. NO. 94-1476 at 55 (1976)). Rather, a more particularized assessment of function accounts for the inherent tension created by protection of clothing design in the Intellectual Property arena. In dicta, this Court has discussed questions implicated by extending copyright protection to articles with utilitarian value, like clothing. Recognizing copyright protection for items with utilitarian function "would allow for the protection of patent-like features without having to fulfill the rigorous standards for obtaining a design patent." [Citation/]

Ultimately, this case turns on how function is defined. How broadly should courts define the function of an article of clothing? Should they define it at its most basic function, to cover the body? Should they define it broadly, as the majority does in this case, as wicking away moisture and "permit[ting] the wearer to cheer, jump, kick, and flip"? Or should they define it more particularly, in relation to its specific purpose—as identifying the wearer as a cheerleader? *See Jovani Fashion*, 500 F. App'x at 44 (concluding that the function of a prom dress is "to cover the body in an attractive way for a special occasion"). For the above reasons I submit the more particularized assessment is more sensible and consonant with the purposes of the law.

* * *

It is apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design. The law in this area is a mess—and it has been for a long time. *See Fashion Originators Guild of Am. v. Fed. Trade Comm'n*, 114 F.2d 80, 81 (2d Cir. 1940) (Hand, J.). The majority takes a stab at sorting it out, and so do I. But 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.

I respectfully dissent.