

The Legal Intelligencer

THE OLDEST LAW JOURNAL IN THE UNITED STATES 1843-2017

PHILADELPHIA, WEDNESDAY, MAY 3, 2017

VOL 255 • NO. 85

An **ALM** Publication

INTELLECTUAL PROPERTY



Copyright Infringement Suits Are Becoming Fashionable

BY ANTHONY S. VOLPE
AND TOM GUSHUE

Special to the Legal

Designers of haute couture fashion have long been troubled by the inability to protect their designs, and the speeds at which designs can be copied now have added to their frustrations. The root of the problem for many years was the U.S. copyright law, which was considered to prohibit enforcement of a copyright in wearable fashions. The Copyright Act, 17 U. S. C. Section 101 et seq., limited copyright protection for “pictorial, graphic, or sculptural features” of “a useful article” to features that “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” This generally prohibited fashion designers from copyrighting the entire designs of an article of clothing because clothing is understood to be a



VOLPE

ANTHONY S. VOLPE is a shareholder at Volpe and Koenig, an intellectual property law firm with offices in Philadelphia and Princeton, New Jersey. He has corporate and private-practice experience in securing, licensing and enforcing all aspects of intellectual property rights.



GUSHUE

TOM GUSHUE is an associate at the firm where his practice focuses primarily on securing and protecting intellectual property rights for clients in the mechanical field.

useful article and the design was embedded in or was not “capable of existing independently of, the utilitarian aspects of the article.” Some fashion designers, such as Crocs Inc., successfully overcame this prohibition on designs that are incorporated in an article of clothing by seeking design patent protection. However, other designers

have found that they cannot meet the requirements for design patent protection and continued to seek copyright protection. The recent Supreme Court decision in *Star Athletica v. Varsity Brands*, No. 15—866, slip opinion, (March 22), may offer designers expanded copyright relief by providing a broader definition of features that “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” *Star Athletica* may lead to a shift in the landscape for fashion designers protecting their intellectual property, if they establish the separate nature of what is alleged to be protected.

In *Star Athletica*, the Supreme Court expanded the scope of copyright protection afforded to fashion designs by expanding on the concept of what is capable of existing independently of the utilitarian aspects of the article. Varsity originally sued *Star Athletica* for infringing five registered

copyrights on two-dimensional designs, displayed on the surface of cheerleader uniforms, that consisted of the various “combinations, positionings and arrangements of elements” that include “chevrons ... lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring and shapes.” Star Athletica responded by alleging that the designs were not protectable because they did not qualify as protectable pictorial, graphic or sculptural works, i.e., they were inseparable. The district court agreed with Star Athletica and issued a summary judgment in Star Athletica’s favor, (*Star Athletica v. Varsity Brands* (WD Tenn., March 1, 2014)). The U.S. Court of Appeals for the Sixth Circuit reversed the district court’s decision, and found that the graphic designs of the uniforms were separately identifiable because the designs and “a blank cheerleading uniform can appear ‘side by side’—one as a graphic design and one as a cheerleading uniform.” (*Star Athletica v. Varsity Brands*, 799 F. 3d 468, 491 (2015)). The Sixth Circuit concluded the designs were “capable of existing independently” because they can be incorporated onto the surface of different types of garments, or hung on the wall as framed art.

The Supreme Court agreed with the reasoning of the circuit court and stated that “an artistic feature of the design of a useful article is

eligible for copyright protection if the feature can be perceived as a two- or three-dimensional work of art separate from the useful article and 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.” The court painstakingly explained its separability test and attempted to provide guidance on applying this fairly abstract concept. The court rejected Star Athletica’s defense

In Star Athletica, the Supreme Court expanded the scope of copyright protection afforded to fashion designs by expanding on the concept of what is capable of existing independently of the utilitarian aspects of the article.

that the asserted designs were not copyright eligible because when they were extracted from the useful article, i.e. the cheerleader uniform, they retained the distinguishing outline of that useful article, i.e., the cheerleader uniform. The court held that this is not a bar to copyright nor is it the appropriate test for determining if a design is copyrightable. According to the court, the fact that a design is

applied to and follows the configuration of an irregularly shaped medium does not disqualify the design from copyright protection. Stated differently, conforming to the shape of the decorated object does not disqualify the design for purposes of copyright protection. As the court explained, “just as two-dimensional fine art corresponds to the shape of the canvas on which it is painted, two-dimensional applied art correlates to the contours of the article on which it is applied. A fresco painted on a wall, ceiling panel or dome would not lose copyright protection, for example, simply because it was designed to track the dimensions of the surface on which it was painted.” The court’s separability test is summarized as follows “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.”

Justice Stephen Breyer’s dissent in *Star Athletica* challenged the majority’s separability test. Breyer explained he could not understand how to conceptualize the design features of the cheerleader uniform in a way that does not picture the cheerleading uniform itself. Taking this conceptual exercise a step further, Breyer explained that if you removed the designs from the

cheerleading uniforms and applied the designs to a blank canvas, the aesthetic elements would be of a cheerleader's uniform. Breyer provided two examples regarding a lamp, along with illustrations showing these examples in an appendix to the decision, to further explain his point. The first lamp included a base, with a cat statue sitting on one side of the base, and a vertical brass rod with wiring and a light bulb fixture on another side of the base away from the cat statue. The second lamp included a base and a cat statue sitting directly in the middle of the base, with wires running internally through the cat's body, and a light bulb fixture extending from the cat's head. Citing *Mazer v. Stein* (347 U.S. 201 (1954)), which similarly dealt with a lamp and a decorative statue base, Breyer explained that the cats in both the first and second lamp were clearly perceivable as separate cat figurines that are copyrightable on their own without replicating the actual lamp fixture. Despite Breyer's articulate dissent, the majority disagreed with his conclusions and the framework for the separability test will determine future copyright disputes with respect to designs.

The underlying copyrightable reasoning behind the *Star Athletica* decision, i.e., pictorial, graphic or sculptural features on wearables are protectable, is likely to have fairly sweeping and long-lasting effects on how companies protect

their wearable fashion designs. Consider the two prongs of the separability test. One, can the design be perceived separate from the useful article? It is fairly easy to consider if a design "can" be removed from a useful article, so long as it is not an integral component of what makes the useful article. Two, asks a similar question but from a slightly different perspective, can the design qualify as a protectable work either on its own or in some other medium separate from the useful article? This is more difficult, as Breyer noted, when the design continues to be connected with or dictated by the underlying article, i.e., the cheerleader uniform.

While this *Star Athletica* separability test is not as clear to apply as may be desired, it is likely to encourage copyright holders to push the boundaries for copyrightable elements associate with wearable fashion designs. A little more than one week after the *Star Athletica* decision, Puma sued Forever 21 for copyright infringement of a number of features associated with footwear endorsed by Rihanna, (*Puma v. Forever 21*, 2:17-cv-02523 (C.D. Cal.)). Puma asserted copyright claims for a "ridged vertical cooling and grainy texture," a "fur slide" and a "bow slide," and cited *Star Athletica* for the proposition that the designs can be perceived as two-dimensional or three-dimensional works of art

separate from the footwear and as protectable works—either on their own or fixed in some other tangible medium of expression. The *Puma* complaint is an interesting blueprint on how a company can blend copyrights, trade dress and design patents with their different forms of protection to achieve well-rounded protection to ward off competitors.

Star Athletica is likely to lead to increased efforts for copyright protection on wearables that may not have been traditionally viewed as copyrightable. As the *Puma* lawsuit illustrates, copyrights can be a potent tool, alone or when used in conjunction with design patents and trade dress, to protect a company's competitive advantage. •