3-28-2019

Star Athletica Tells the Fashion Industry to Knock-It-Off with the Knockoffs

Samantha Burdick
Pepperdine School of Law

Follow this and additional works at: https://digitalcommons.pepperdine.edu/plr
Part of the Intellectual Property Law Commons

Recommended Citation
Samantha Burdick Star Athletica Tells the Fashion Industry to Knock-It-Off with the Knockoffs, 46 Pepp. L. Rev. 367 (2019)
Available at: https://digitalcommons.pepperdine.edu/plr/vol46/iss2/4

This Comment is brought to you for free and open access by the School of Law at Pepperdine Digital Commons. It has been accepted for inclusion in Pepperdine Law Review by an authorized editor of Pepperdine Digital Commons. For more information, please contact josias.bartram@pepperdine.edu, anna.speth@pepperdine.edu.
Star Athletica Tells the Fashion Industry to Knock-It-Off with the Knockoffs

Abstract

At any given fast fashion store, there may be a near exact replica of a ‘designer’ clothing item that sells for four times less than the amount it would at a luxury retailer. Wait—isn’t that illegal? After the Supreme Court’s landmark separability test created in Star Athletica, the answer may soon be yes.

Fast fashion chains make their money exploiting the historical lack of copyright protection in the fashion industry. Lamps, shoes, and clothes have long been held ineligible for copyright protection because the utilitarian features are inseparable from the artistic. In other words, the part of clothing that is functional (such as, the cut of a t-shirt including a neck and two arm holes) may not be copyrighted. This is because a copyright would prevent others within the industry from also creating t-shirts with this classic shape that serves the utilitarian purpose of covering the body. However, after the Supreme Court’s landmark separability test created in Star Athletica, the Court has said that artistic elements of clothing are eligible for copyright protection. So long as the artistic elements, such as chevrons and stripes on a cheerleading uniform, are separable from the utilitarian elements, clothing may qualify for copyright protection. This new separability test provides greater copyright eligibility for clothing than ever before, and thus greater incentive to bring actions against those in the knockoff market. This comment discusses the implications of the new separability test on the fashion and knockoff industries through a historical overview and real-world applications.
TABLE OF CONTENTS

I. INTRODUCTION .................................................................................................................. 369
II. BACKGROUND: HISTORY OF COPYRIGHT PROTECTION IN THE
FASHION INDUSTRY .................................................................................................................. 371
   A. Mazer v. Stein ..................................................................................................................... 372
   B. *The Copyright Act of 1976* ......................................................................................... 374
   C. Separability Tests Prior to Star Athletica ....................................................................... 377
III. CURRENT STATE OF THE LAW ...................................................................................... 382
   A. Star Athletica, L.L.C. v. Varsity Brands, Inc. .............................................................. 382
   B. Design Ideas, Ltd. v. Meijer, Inc. .................................................................................. 388
   C. Jetmax Ltd. v. Big Lots, Inc. ......................................................................................... 390
   D. L.A. T-Shirt & Print, Inc. v. Rue 21, Inc. ................................................................. 391
   E. *Compendium of U.S. Copyright Office Practices* ................................................. 392
IV. PRACTICAL EFFECTS AND CRITIQUE ...................................................................... 393
   A. *The Effect of Star Athletica on Fashion Design Companies
      and the Knockoff Market* ............................................................................................... 395
      1. Limitations on Judicial Subjectivity ........................................................................ 395
      2. Protection from Infringement ................................................................................. 396
      3. *Puma SE v. Forever 21, Inc.* ................................................................................ 397
   B. A Practical Application of Star Athletica ...................................................................... 400
V. CONCLUSION ..................................................................................................................... 402
I. INTRODUCTION

"[Y]ou’re killing knock-offs with . . . copyright. You haven’t been able to do it with trademark law. You haven’t been able to do it with patent designs. We are now going to use copyright law to kill . . . the knockoff industry." As Justice Sotomayor aptly stated during Star Athletica’s oral argument, intellectual property law in the clothing industry is drastically changing and, for the first time, may grant copyright protection to additional aspects of clothing.2

Intellectual property protection for clothing has generally been divided into three categories: (1) copyright, (2) patent design, and (3) trademark.3 The United States’ $370 billion dollar fashion industry4 currently utilizes each category of intellectual property law to protect its original creations such as fabric prints,5 source-identifying marks of brands,6 and “original and ornamental design[s]”7 of articles. However, fashion design—for example the cut, color, and shape of clothing—has long been held ineligible for intellectual property protection.8 This has led to an assumption that, although clothing surely “possess[es] at least some minimal degree of creativity,” companies who create

2. Id.; see also Star Athletica, 137 S. Ct. at 1016. In that case, the Court spoke for the first time on how lower courts should conduct the illusive “separability analysis” to determine whether certain elements of a useful article, like clothing, may be eligible for copyright. Star Athletica, 137 S. Ct. at 1016; see infra Section III.A. Prior to the 1979 Copyright Act, Congress had rejected nearly seventy clothing design protection bills since 1914. Esquire, Inc. v. Ringer, 591 F.2d 796, 800, n.12 (D.C. Cir. 1978).
4. Star Athletica, 137 S. Ct. at 1035.
5. See Folio Impressions, Inc. v. Byer Cal., 937 F.2d 759, 763 (2d Cir. 1991) (finding that fabric designs are copyright eligible); Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc., 490 F.2d 1092, 1094–95 (2d Cir. 1974) (holding that a fabric design copyright was valid and infringed upon).
innovative fashion designs on t-shirts or dresses lack the ability to protect themselves from "copy-cats" or "knockoffs." This is because Congress has long defined clothing as a "useful article" used to cover one’s body. Still, some argue that the utility of fashion design is of less importance than the medium of expression it provides to designers. Design patents and trademark laws have long been the only recourse available to clothing companies who attempt to protect their designs on clothing. However, contrary to the behavior predicted by the incentive theory of copyright law, fashion design has persisted through each and every knockoff.

Prior to Star Athletica, the Supreme Court was silent on copyright protection in the context of fashion designs. It was known that limited copyright protection was available for elements of useful articles so long as they may be considered separately from the useful article itself, but courts struggled in determining how to separate copyrightable material from the underlying useful article. After Star Athletica, it is likely that clothing designs will receive


10. U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924 (3d ed. 2017). Useful articles are defined in 17 U.S.C. § 101 (2010), discussed infra Section II.B. As the court explained in Esquire, Inc. v. Ringer, useful articles are specifically ineligible for copyrights because it would prevent others from producing the same article. 591 F.2d 796, 801 n.15 (D.C. Cir. 1978). Thus, in order to protect designs from copying, and to delineate the boundary between copyright and patent law, useful articles must meet the more rigorous elements of patent law. See H.R. REP. NO. 94-1476, at 55 (1976).


13. See id. at 1689; Irina Obarman Khagi, Who’s Afraid of Forever 21?: Combating Copycatting Through Extralegal Enforcement of Moral Rights in Fashion Designs, 27 FORDHAM INT’L L.J. 67, 93 nn.129–30 (2016) (comparing the cost barriers to trademark registration with the relatively low price of copyright registration and explaining that typically by the time a trademark litigation suit is brought for a fashion design, the season has already passed).

14. See Khagi, supra note 13 at 70 & n.9.

15. See Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1014 (2017); Jacqueline Lefebvre, The Need for “Supreme” Clarity: Clothing, Copyright, and Conceptual Separability, 27 FORDHAM INT’L L.J. 143, 148 (2016) (“With no clear approach to determining whether the artistic and utilitarian aspects of useful articles are conceptually separable, courts and scholars have devised a number of ways to apply this standard.”). Star Athletica presents the first time the Supreme Court has considered the separability requirement and its ruling created a uniform test that overrules the previous ten irreconcilable tests established by the lower courts. See generally
greater protection than they ever have before.\textsuperscript{16} Justice Thomas’ opinion focused largely on the statutory interpretation of the Copyright Act of 1976 and found that the statute gives extensive protection to separable aspects of useful articles, so long as they would have been copyrightable if they had been originally fixed to another medium.\textsuperscript{17} This broad interpretation, if followed by the lower courts, will likely lead to greater protection for clothing designs; but at what cost to the fashion industry’s knock-off market, and further, the public’s ability to purchase on-trend clothing at a reasonable price?\textsuperscript{18}

This Comment argues that the rule created in \textit{Star Athletica} provides greater protection for fashion designers and drastically alters knock-off fashion market operations through the Court’s low standard regarding what qualifies for copyright protection on clothing items.\textsuperscript{19} Part II provides an overview of the history of copyright protection, or the lack thereof, in the fashion industry.\textsuperscript{20} Part III examines \textit{Star Athletica}, as well as the few cases highlighting where courts have already struggled to apply the Court’s rule.\textsuperscript{21} Part IV discusses the lasting impact the \textit{Star Athletica} test will have on the fashion industry and, specifically, the way that lower courts will interpret the test to crush the knock-off market.\textsuperscript{22} Part V concludes.\textsuperscript{23}

II. BACKGROUND: HISTORY OF COPYRIGHT PROTECTION IN THE FASHION INDUSTRY

Prior to a discussion of \textit{Star Athletica} and its future impacts, it is necessary to look back to the history of copyright to understand the landscape to which \textit{Star Athletica} applies today.\textsuperscript{24} In the United States, the Copyright Act of 1790 granted copyright protection for specific items.\textsuperscript{25} Since then,

\footnotesize

\tiny

Lefebvre, \textit{supra}, (discussing the separability requirement in depth as it relates to clothing); \textit{infra} Part II.

\textsuperscript{16} See \textit{Star Athletica}, 137 S. Ct. at 1035. \textit{Star Athletica} opened the door for separability to be met in any case where the creative element of a useful article can be “imagined separately from the useful article,” for example on a canvas. \textit{Id.} at 1016.

\textsuperscript{17} \textit{Id.} at 1008–11.

\textsuperscript{18} See \textit{infra} Parts II–V.

\textsuperscript{19} See \textit{Star Athletica}, 137 S. Ct. at 1011; \textit{infra} Part III.

\textsuperscript{20} See \textit{infra} Part II.

\textsuperscript{21} See \textit{infra} Part III.

\textsuperscript{22} See \textit{infra} Part IV.

\textsuperscript{23} See \textit{infra} Part V.

\textsuperscript{24} See \textit{infra} Part II.

\textsuperscript{25} Act of May 31, 1790, 1st Cong., 2d Sess., ch. 15, § 1, 1 Stat. 124, 124 (repealed 1802). This Act was the first extension of rights granted to authors of “map[s], chart[s], book or books.” \textit{Id.} This
Congress slowly extended copyright protection beyond two-dimensional visual arts to include some three-dimensional works. Later, Congress replaced the Act of 1870 with the Act of 1909 ("1909 Act"), which included copyright protection for all "[w]orks of art; models or designs for works of art." This change left the door open for new forms of art to meet the requirements under copyright law without resorting to other, often more expensive and time-consuming forms of intellectual property protection. Following these developments in the intellectual property sphere, subsequent case law, and further amendments to the Copyright Act, the Court found itself compelled to comment on how to apply the separability analysis not only for clothing, but also for other original works of art.

A. Mazer v. Stein

Until Star Athletica sixty-three years later, the Supreme Court offered its only interpretation of the boundaries of copyright protection for useful articles in Mazer v. Stein. In Mazer, the respondent manufactured and sold lamps, shown in Figure 1 below, that used statuette figures of men and women as the base of their lamps.

Act, and each of the others passed after it, have been created pursuant to Congress’s Constitutional power to “promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries” (known as the “Patent and Copyright Clause” or “Intellectual Property Clause”). U.S. CONST. art. I, § 8, cl. 8.

26. See e.g., Act of Apr. 29, 1802, 7th Cong., 1st Sess., ch. 36, § 2, 2 Stat. 171, 171 (including “historical and other prints”). Next, the Act of Mar. 3, 1865, 38th Cong., 2d Sess., ch. 126, § 1, 13 Stat. 540, 540, added photographs. The Act of July 8, 1870, 41st Cong., 2d Sess., ch. 230, § 86, 16 Stat. 198, 212 (repealed 1909), permitted copyrights for certain three-dimensional works such as statues and models which qualified as “fine arts.” The U.S. Copyright Office defines Visual Art Work as "(i) pictorial, graphic, and sculptural works, and (ii) architectural works." U.S. COPYRIGHT OFFICE, supra note 10, § 903; see also infra notes 48–49.


28. See supra note 10 and accompanying text (discussing the issues with design patents, trademarks, and other forms of intellectual property that, alone, do not satisfactorily protect the fashion industry and other useful articles).

29. See infra Sections II.A–B.


32. Id. at 202.

372
The respondents submitted their statuette figures to the U.S. Copyright Office as “works of art” under the 1909 Act (without reference to their use as lamp bases), and the office granted their copyright. However, the respondents subsequently modified the statuettes into lamp bases and sold the statuettes primarily as components of lamps within the United States (as opposed to selling them as stand-alone works of art). The success of the respondent’s lamp sales inspired the petitioners to copy the statuette figures and sell their own knockoff statuette-lamps. This action for copyright infringement presented the Mazer Court with the question of whether statuettes were copyright eligible “when the copyright applicant intended primarily to use the statuettes in the form of lamp bases . . . ?” Further, this issue required the Court to

33. Russ & Meyer, supra note 8, at 22.
34. Mazer, 347 U.S. at 202–03.
35. Id. at 203.
36. Id.
37. Id. at 204–05. In other words, the Court needed to consider whether the copyright originally granted to the respondent as a “work of art” applied to the “art” when used as a lamp base, which is in
determine for the first time whether the statuette, registered with the copyright office from a two-dimensional drawing (without the lamp components), qualified for copyright protection under the "work of art" requirement of the 1909 Act even when sold as a lamp.\textsuperscript{38}

The Court reasoned that a lamp itself is a useful article, considering its function of providing light to a room, while the statuette presents separable artistic attributes, such as its artistic value as a sculpture.\textsuperscript{39} Despite the sale of the statue as a lamp, the Court found "nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration."\textsuperscript{40} The Court’s interpretation of the 1909 Act explained that in determining what qualifies as a "work of art," the Court must consider more than an "individual perception of the beautiful."\textsuperscript{41} Accordingly, \textit{Mazer} concluded that copyright protection extends to "the author's tangible expression of his ideas," even when expressed upon useful articles.\textsuperscript{42} The Court’s struggle with defining what is a "work of art" led to the Copyright Act of 1976 explaining the copyright protection of useful articles.\textsuperscript{43}

B. The Copyright Act of 1976

Following the Court’s decision in \textit{Mazer}, the Copyright Office offered recommendations on how Congress should interpret the 1909 Act regarding "industrial designs" and useful articles.\textsuperscript{44} The recommendation stated:

\begin{quote}
see a useful article. \textit{See id.} For further evidence of lamps or lighting fixtures defined as useful articles see Lamps Plus, Inc. v. Seattle Lighting Fixture Co., 345 F.3d 1140, 1147 (9th Cir. 2003); Esquire, Inc. v. Ringer, 591 F.2d 796, 803–04 (D.C. Cir. 1978).
\end{quote}

\begin{quote}
\textsuperscript{38} \textit{See Mazer}, 347 U.S. at 202–03 ("Respondents are partners in the manufacture and sale of electric lamps. One of the respondents created original works of sculpture in the form of human figures by traditional clay-model technique. From this model, a production mold for casting copies was made. The resulting statuettes, without any lamp components added, were submitted by the respondents to the Copyright Office for registration as 'works of art' or reproductions thereof . . . . ").
\end{quote}

\begin{quote}
\textsuperscript{39} \textit{See id.} at 205 ("The case requires an answer, not as to a manufacturer's right to register a lamp base but as to an artist's right to copyright a work of art intended to be reproduced for lamp bases.").
\end{quote}

\begin{quote}
\textsuperscript{40} Id. at 218.
\end{quote}

\begin{quote}
\textsuperscript{41} Id. at 213–14, 218.
\end{quote}

\begin{quote}
\textsuperscript{42} Id. at 214. The Court in \textit{Star Athletica} rephrased the Court's rule from \textit{Mazer} as: "If a design would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article." \textit{Star Athletica, L.L.C. v. Varsity Brands, Inc.}, 137 S. Ct. 1002, 1011 (2017).
\end{quote}

\begin{quote}
\textsuperscript{43} \textit{See infra} Section II.B.
\end{quote}

\begin{quote}
\end{quote}
If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.\footnote{37 C.F.R. § 202.10(c) (1960) (emphasis added). This rule created the separability requirement, discussed infra Section II.C.}

The language offered by the Court in Mazer and the Copyright Office presented options to Congress, which they analyzed to create the Copyright Act of 1976.\footnote{See 17 U.S.C. § 101 (2012); Lefebvre, supra note 15, at 152.} As a result, today, copyright protection is granted to “original works of authorship fixed in any tangible medium of expression . . . [including:] pictorial, graphic, and sculptural works”\footnote{17 U.S.C. § 102(a)(5).} (“PGS”) that are not utilitarian in nature (i.e. “useful articles”).\footnote{Id. § 101. PGS works are defined as 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.}

Additionally, an article is found to be a useful article when it lacks the “creative”\footnote{Id.} aspects of art that

\footnote{Id. It is likely that Congress intended for their interpretation of “useful articles” to expand the scope of protection from the Copyright Office’s original recommendation, but its effect actually limited the number of copyrightable works because of the difficulty in interpreting the separability standard. Lefebvre, supra note 15, at 153.}
are intended to be incentivized and protected by copyright law.\textsuperscript{51} Useful articles, such as clothing or lamps, have long been held ineligible for copyright protection.\textsuperscript{52} However, clothing is one of the more difficult utilitarian articles to classify because it possesses both useful (i.e. physical protection from the elements) and aesthetic (i.e. artistic expression in design) attributes.\textsuperscript{53} Once a PGS work is determined to contain features of a useful article, the Court analyzes the copyrightability of the PGS work through the separability analysis.\textsuperscript{54} As discussed below, among lower courts and scholars in the industry this has proven to be exceedingly difficult.\textsuperscript{55}

\textit{Id.} (emphasis added) (internal citation omitted) (quoting 1 Melville B. Nimmer \& David Nimmer, \textit{Nimmer on Copyright} \textsection 1.08[C][1] (1990)).

\textsuperscript{51} Christophe Geiger, \textit{Promoting Creativity through Copyright Limitations: Reflections on the Concept of Exclusivity in Copyright Law}, 12 VAND. J. ENT. \& TECH. L. 515, 532 (2010) (recognizing a creator’s “interests [in] securing a financial reward for his creative activity” through achieving “effective copyright protection”). Article I, Section 8, Clause 8 of the United States Constitution empowers Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, \textsection 8, cl. 8. There are several theories behind intellectual property law and its purposes, for example, incentive theory. See Raustiala \& Sprigman, \textit{supra} note 12, at 1689. Incentive theory holds that in order to encourage inventors to share their creative ideas, society should grant them a temporary monopoly in exchange for allowing others to use it to build upon. See generally Adam D. Moore, \textit{A Lockean Theory of Intellectual Property}, 21 HAMLIN L. REV. 65 (1997).

\textsuperscript{52} See, e.g., Mazer v. Stein, 347 U.S. 201, 217 (1954). There, the Court held that a lamp is a useful article and is thus ineligible for copyright protection. Id. However, if there are separable elements of the design, those elements may be copyright eligible. Id.; see also Lori Levine, Jeffrey D. Waxler \& Bobby Ghajar, \textit{Protecting Fashion Through Copyrights: The Supreme Court Will Decide Whether Cheer Uniform Designs Are Protectable}, PILLSBURY L. (May 11, 2016), https://www.pillsburylaw.com/en/news-and-insights/protecting-fashion-through-copyrights-the-supreme-court-will.html ("For example, a white t-shirt cannot garner copyright protection because the t-shirt is a useful item with no separately artistic element.").

\textsuperscript{53} See Shira Perlmutter, \textit{Conceptual Separability and Copyright in the Designs of Useful Articles}, 37 J. COPYRIGHT SOC'Y U.S.A. 339, 339 (1990) ("[A]n otherwise copyrightable work of art embodied in a useful article is protectable; the shape of a purely utilitarian product, no matter how aesthetically satisfying, is not."). This copyright issue presents a common theme in fashion law. See e.g., Allison DeVore, \textit{The Battle Between the Courthouse and the Fashion House: Creating a Tailored Solution for Copyright Protection of Artistic Fashion Designs}, 35 T. JEFFERSON L. REV. 193, 195 (2013). DeVore’s introduction presents a well-written example of the many ways in which clothing possesses both useful and artistic elements by comparing Coco Chanel’s Little Black Dress (a closet staple for most women; which inspired years of Little Black Dress copies to come) to Alexander McQueen’s clamshell dress (far closer to a wearable piece of art than to a common dress; it is now on display at the Metropolitan Museum of Art). Id. at 193–95.

\textsuperscript{54} See infra notes 59–62 and accompanying text.

\textsuperscript{55} See infra Section III.C.
C. Separability Tests Prior to Star Athletica

As defined by Congress, PGS works are eligible for copyright protection when their features “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”56 Prior to the Supreme Court’s rule in Star Athletica, the lower courts used a variety of tests to determine whether aspects of useful articles were eligible for copyright protection based on whether the aesthetic aspect of the article was separable, as defined by § 101,57 from the useful property of the article.58 There are three steps to determine whether the separability analysis of a useful PGS article is appropriate:59 (1) Does the work qualify as PGS under § 101;60 if yes, (2) does the PGS work meet the definition of a useful article?;61 if yes, (3) does the PGS attribute of the useful article satisfy the separability requirement in § 101?62

Although the language on its face seems simple enough, the interpretation of the statutory language regarding separability has long been considered “the most vexing, unresolved question in copyright law.”63 Courts struggle with the conceptual, physical, and literal aspects that a separability analysis requires.64 With no guidance from the Supreme Court until 2017, the lower courts have varied dramatically in their application of the separability requirements and in their rulings as to which types of PGS attributes are separable.65

57. See id.; see also supra note 49.
58. See infra notes 77–100 (discussing the ten different tests used to interpret the separability standard created by Congress in § 101).
61. See supra note 49 and accompanying text. The Court in Star Athletica summarized these requirements, stating: “In sum, 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.” Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1012 (2017).
62. See supra note 48.
64. Goldstein, supra note 63.
65. See infra notes 66–70.
On the one hand, fabric patterns, belt buckles, and mannequin heads have been held copyright eligible based on the separability of the artistic elements from the useful article. On the other hand, costumes and casino uniforms have been deemed inseparable and thus, copyright ineligible. The courts in these cases have reached their holdings through several proposed tests aimed at interpreting the separability requirement of § 101. Looking back to each of the lower court tests the Supreme Court was presented, we can better understand the Court’s reasoning in creating their own test and how it differs from the lower courts’ varying tests without overruling any underlying cases. Although intended to establish clarity among the lower courts, the Supreme Court’s test leaves the door open to wide interpretation of the many

66. See, e.g., Charles E. Colman, The History and Doctrine of American Copyright Protection for Fashion Design: Managing Mazer, 7 Harv. J. Sports & Ent. L. 150, 163–70 (2016) (citing a number of cases explaining the court’s rational for how the creativity present in fabric design is sufficient for copyright eligibility).


68. Pivot Point Int’l, Inc. v. Charlene Prods., Inc., 372 F.3d 913, 932 (7th Cir. 2004) (finding that a mannequin head’s aesthetic features are conceptually separable from a mannequin as a useful article).

69. See supra notes 66–68.

70. Compare Whimsicality, Inc. v. Battat, 27 F. Supp. 2d 456, 463 (S.D.N.Y. 1988) (holding that plaintiff’s costume was a useful article with PGS features that are inseparable from the useful article), with Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 2.08[H][3] (2004) (offering several examples of lower courts holding that masquerade costumes are copyright eligible).

71. Galiano v. Harrah’s Operating Co., 416 F.3d 411, 422 (5th Cir. 2005) (holding that the uniform designer made “no showing that its designs are marketable independently of their utilitarian function as casino uniforms”).

72. See Mark A. LoBello, The Dichotomy Between Artistic Expression and Industrial Design: To Protect or not to Protect, 13 Whittier L. Rev. 107, 107–08 (1992). The application of the separability test to such an array of products highlights its importance as a doctrine, but also its lack of clarity in practice. See id. at 110.

73. 17 U.S.C. § 101 (2012); see infra notes 78–102. Each of these tests are summarized and highlighted in the Sixth Circuit’s opinion in Varsity Brands, Inc. v. Star Athletica, L.L.C., 799 F.3d 468, 484–86 (6th Cir. 2015), aff’d sub nom. Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017). Larry C. Russ and Nathan D. Meyer summarize the general principles of the nine separability tests prior to Star Athletica as essentially creating two competing tests that were combined through the Sixth Circuit’s hybrid approach. See Russ & Meyer, supra note 8, at 22–23.

74. See Star Athletica, 137 S. Ct. at 1010–11 (holding that the Court’s interpretation of separability is consistent with Mazer, the history of the Copyright Act, and the lower courts); see also infra notes 92–101 and accompanying text. The tests fall into two categories: “1) whether the artistic work and the useful article could be conceptually separated with one part surviving (conceptually) as a useful article and the element as an artistic work, or 2) whether there were aspects of the design of the useful article that were not dictated by function.” See Russ & Meyer, supra note 8, at 22 (internal citations omitted).
factors discussed in the lower court’s tests.75 Particularly, in creating the Star Athletica test, the Court did not state that any of the lower court’s prior considerations in determining separability were incorrect.76 This means that, in future cases, the rationale behind the nine prior tests still holds and may be persuasive in showing how to interpret the Star Athletica separability test.77 The proposed tests were as follows:

1. The Copyright Office’s Approach states that “[a PGS] 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.”78

2. The Primary-Subsidiary Approach finds that a PGS work is “conceptually separable if the artistic features of the design are ‘primary’ to the ‘subsidiary utilitarian function.’”79

3. The Objectively Necessary Approach concludes that a PGS feature is “conceptually separable if the artistic features of the design are not necessary to the performance of the utilitarian function of the article.”80

4. The Ordinary-Observer Approach stems from a dissenting opinion in the same case as the Objectively Necessary Approach.81 It determines that a PGS feature is “conceptually separable if the ‘design elements can be identified as reflecting the designer’s artistic judgment exercised independently of

---


76. See Star Athletica, 137 S. Ct. at 1014.

77. See infra notes 78–102.

78. Varsity, 799 F.3d at 484 (quoting U.S. COPYRIGHT OFFICE, COMPREHEND OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2(B) (3d ed. 2014)). The example of the shape of a chair back is used to illustrate that this analysis determines that the carving is conceptually separable from the utility of the chair because the carving could be imagined as a drawing on paper that does not reflect the overall shape of the chair. U.S. COPYRIGHT OFFICE, supra, § 924.2(B). Additionally, if the carving on the chair back was removed, the utility of the chair would remain. Id.

79. Varsity, 799 F.3d at 484 (quoting Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980)). In determining the separability of belt buckles, the Second Circuit created the Primary-Subsidiary Approach by holding that the “primary” aesthetic aspect of the buckle was conceptually separable from the “subsidiary utilitarian function” of the belt itself. Kieselstein-Cord, 632 F.2d at 993. This test is particularly problematic because it encourages the courts to become judges not of law, but of artistic abilities and elements within articles. See Sonja Wolf Sahsten, I’m a Little Treepot: Conceptual Separability and Affording Copyright Protection to Useful Articles, 67 FLA. L. REV. 941, 954 n.88 (2015).

80. Varsity, 799 F.3d at 484. In developing this approach, the Second Circuit held that mannequins’ aesthetic features are necessary to the use of the utilitarian article and are thus inseparable. See Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411, 411 (2d Cir. 1985).

81. See Carol Barnhart, 773 F.2d at 422 (Newman, J., dissenting).
functional influences.”82

(5) The Design-Process Approach finds that a PGS feature is conceptually separable if the “design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.”83

(6) The Stand-Alone Approach also stems from a dissenting opinion.84 It determines that PGS features are conceptually separable if “the useful article’s functionality remain[s] intact once the copyrightable material is separated.”85

(7) The Likelihood-of-Marketability Approach holds that a PGS 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.”86

(8) Patry’s Approach analyzes the utilitarian aspects of the article, rather than the article’s utility as a whole.87 The difference here lies in whether the PGS features are “dictated by the form or function of the utilitarian aspects of the useful article.”88

(9) The Subjective-Objective Approach balances (a) “the degree to which

---

82. Varsity, 799 F.3d at 484. In his dissent, Judge Newman explained that conceptually separability requires the article to “stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.” Carol Barnhart, 773 F.2d at 422 (Newman, J., dissenting). This test would require the ordinary, reasonable person to determine when a concept is considered “separate” by finding “two different concepts that are not inevitably entertained simultaneously.” Id.

83. Varsity, 799 F.3d at 484 (quoting Brandt Int’l, Inc. v. Cascade Pac. Lumber, Co., 834 F.2d 1142, 1145 (2d Cir. 1987)). The Second Circuit adopted yet another test here, using this test to resolve the split in their majority and dissent. See Brandt, 834 F.2d at 1145. Later, the Seventh Circuit utilized this test to determine that a mannequin head—unlike the purely functional mannequin in Carol Barnhart discussed supra note 80—possessed separable aesthetic features because they required significant artistic judgment by the designer. Pivot Point Int’l, Inc. v. Charlene Prods., Inc., 372 F.3d 913, 931–32 (7th Cir. 2004). This is yet another test that shifts the focus of the court away from the legal aspects of the claims, and towards the judge’s understanding of the subjective intent, or their attorney’s ability to phrase their intent, of the author. See Darren Hudson Hick, Conceptual Problems of Conceptual Separability and the Non-Usefulness of the Useful Articles Distinction, 57 J. COPYRIGHT SOC’Y U.S.A. 37, 44–45 (2009).

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

85. Varsity, 799 F.3d at 484 (quoting Pivot Point, 372 F.3d at 934 (Kanne, J., dissenting)). Judge Kanne’s test in Pivot Point requires a PGS feature to not take away—or add to—the utility of an item. 372 F.3d at 934 (Kanne, J., dissenting). His test would create the opposite outcome for the mannequin’s faces because removing the facial features removes the functionality of the item. Id.

86. Varsity, 799 F.3d at 484 (quoting Galiano v. Harrah’s Operating Co., 416 F.3d 411, 419 (5th Cir. 2005)). In applying this test, the Fifth Circuit concluded that casino uniforms were not copyrightable because they were not “marketable to some significant segment of the community” independent of their utilitarian function as casino uniforms. Galiano, 416 F.3d at 422.

87. Varsity, 799 F.3d at 484–85.

the designer’s subjective process is motivated by aesthetic concerns,” 89 with (b) “the degree to which the design of a useful article is objectively dictated by its utilitarian function.” 90

(10) Perhaps most complex, when Varsity presented the separability issue, the Sixth Circuit determined that none of the underlying tests were adequate to determine separability of the cheerleading uniform. 91 Thus, the court created yet another test, the Hybrid Approach, which asks five questions. 92 First, “is the design a pictorial, graphic, or sculptural work?” 93 If yes, then second, “is it a design of a useful article?” 94 Third, “[w]hat are the utilitarian aspects of the useful article?” 95 Fourth, “[c]an the viewer of the design identify [PGS] features ‘separately from . . . the utilitarian aspects of the useful article?’” 96 If yes, then fifth, can the PGS features identified in step four “exist[] independently of[] the utilitarian aspects” identified in step three? 97 The Sixth Circuit’s test combines aspects of the Objectively Necessary Approach, 98 the Design-Process Approach, 99 and the Copyright Office’s approach. 100 Generally, the Sixth Circuit’s Hybrid Approach requires the observer of a PGS useful article to imagine the aesthetic elements of the work separately from the useful article to determine if they can exist independently. 101

Presented with the same issue which gave rise to the Sixth Circuit’s Hybrid Approach, the Supreme Court in Star Athletica created yet another test in the hope of establishing a more uniform application of the separability

89. See Keyes, supra note 59, at 141. This factor “requires courts to consider the degree to which aesthetic concerns, as opposed to functional ones, motivate the designer.” Id.

90. Id. This factor considers whether “the design is mostly dictated by function” or “hardly dictated by function at all,” with designs that are hardly dictated by function at all weighing in favor of conceptual separability, and thus, copyright protection. Id. at 142.

91. Varsity, 799 F.3d at 487.

92. Id.

93. Id.

94. Id.

95. Id. This element, as discussed by Judge McKeague, shifts the focus from the article’s functionality to how the utility of the article is defined. See id. at 495–96 (McKeague, J., dissenting). There, Judge McKeague cautions the court’s focus on the design of the uniform in covering the body, rather than the specific utility of the article in identifying the wearer as a cheerleader. Id.

96. Id. at 488 (quoting 17 U.S.C. § 101 (2012)).

97. Id. (quoting 17 U.S.C. § 101 (2012)).

98. See supra note 80.

99. See supra note 83.

100. See supra note 78.

101. Varsity, 799 F.3d at 488–89.
analysis. As shown in the Court’s opinion—composed of a five-Justice majority, one concurrence, and two dissenting votes—consensus with this test is still not likely in the lower courts. The following discussion examines the Court’s decision in Star Athletica, the implications the Court’s new test has on the fashion industry with respect to “knockoffs,” and how the lower courts will likely interpret the new test going forward.

III. CURRENT STATE OF THE LAW

A. Star Athletica, L.L.C. v. Varsity Brands, Inc.

In Star Athletica, the Court “granted certiorari to resolve widespread disagreement over the proper test for implementing § 101’s separate-identification and independent-existence requirement,” known as the separability analysis. This case concerned Varsity Brands (“Varsity”), the market leader in cheerleading uniform manufacturing, which holds more than 200 copyright registrations for its two-dimensional designs used on its uniforms. These designs largely consist of lines, shapes, and chevrons that are found on the surface of the uniforms it creates for cheerleaders in high school, college, and professional leagues across the country. Star Athletica is a competing cheerleading uniform manufacturer that Varsity claimed infringed on its copyrights. The designs of both manufacturers are shown for comparison in Figure 2, below.


103. See id. at 1002.

104. See infra Parts III-IV.


106. Star Athletica, 137 S. Ct. at 1007.


The district court granted summary judgment for Star Athletica on the basis that the chevron style angles and lines “could not be ‘physically or conceptually’ separated”\textsuperscript{109} from the uniforms and were, therefore, ineligible for copyright protection under the useful article doctrine.\textsuperscript{111} The Sixth Circuit reversed the lower court and held that the graphics could be “identified separately” and were “capable of existing independently” of the article’s

\textsuperscript{109} Star Athletica, 137 S. Ct. at 1017.

\textsuperscript{110} Id. at 1008 (quoting \textit{Varsity}, 2014 WL 819422, at *9). The court there utilized language from the lower court tests discussing the need to distinguish between physical and conceptual separability. \textit{Compare supra} notes 81–82 and accompanying text (discussing the Ordinary-Observer Approach which focuses on conceptual separability), \textit{with supra} notes 84–85 and accompanying text (discussing the Stand-Alone Approach which focuses on physical separability of the useful article from the PGS element).

\textsuperscript{111} \textit{Varsity}, 2014 WL 819422, at *1. The district court largely focused on whether or not the designs were essential to the use of the uniform to identify the wearer as a cheerleader stating:

Here, the court’s focus eventually turns to the “cheerleading-uniform-ness” of a fabric garment without any of the physical designs and colors ordinarily printed upon or otherwise imparted to a garment that identifies it, generally, as an unavoidably imperfect reflection of the ideal of a “cheerleading uniform.” In this case, because the court finds that the absence of such designs and colors simply fails to call to mind, or otherwise signal the presence of a cheerleading uniform in the garment at hand, it must also conclude that the presence of such designs and colors is at the core of the ideal—of “cheerleading-uniformness.” With that conclusion, it also follows that the colors-and-designs component of a cheerleading uniform cannot be conceptually separated from the utilitarian object itself. Copyright protection, as a matter of law, cannot apply.

\textit{Id.}
“utilitarian aspects” under § 101. The court’s reasoning was supported by
the proposition that the graphics and the utilitarian article could appear side
by side as separately identifiable articles. For example, “they could be in-
corporated onto the surface of different types of garments, or hung on the wall
and framed as art.” These lower court decisions are one example of many
struggles the lower courts have had since Mazer in applying the separability
test to determine whether an aspect of a useful article is copyright eligible,
thus highlighting the importance of guidance from the Supreme Court.

The Supreme Court’s preliminary inquiry in Star Athletica was whether
the separability analysis was necessary in that case. The Court’s determina-
tion relied on dictionary definitions of “[d]esign,” “pictorial,” and
“graphic.” Justice Thomas wrote that § 101 “requires separability analysis
for any ‘pictorial, graphic, or sculptural features’ incorporated into the ‘design
of a useful article.’” For this reason, contrary to the concurring opinion
of Justice Ginsburg, the Court found that the separability analysis is necessary
to determine if PGS features were even included on useful articles.

Circuit similarly focused on whether cheerleading uniforms can be “cheerleading uniforms
without the stripes, chevrons, zigzags, and other color blocks.” Id. at 470. Unlike the lower court, the Sixth
Circuit held that the purpose of the uniform was not primarily to identify the wearer as a cheerleader,
but to “permit the wearer to cheer, jump, kick, and flip,” which the uniforms could functionally do
even if the designs were separated. Id. at 491.

113. Id. The Sixth Circuit identified the difference between useful articles and design components
by stating the following:
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].”

Id. at 492 (quoting 17 U.S.C. § 101 (2012)).

114. Star Athletica, 137 S. Ct. at 1008 (citing Varsity, 799 F.3d at 491–92).

115. See, e.g., Colman, supra note 66, at 162–202, 204 (discussing the history in the lower courts
leading to Star Athletica and the need for clarity from the Court).

116. Star Athletica, 137 S. Ct. at 1009; see also supra notes 59–62 and accompanying text.

117. Star Athletica, 137 S. Ct. at 1009. The Court found that the Oxford English Dictionary defines
design as “‘the combination’ of ‘details’ or ‘features’ that ‘go to make up’ the useful article.” Id.
(quoting Design, OXFORD ENGLISH DICTIONARY (3d ed. 1933)).


119. Id. at 1018 (Ginsburg, J., concurring).

120. Id. at 1009.
Following this determination, the Court moved to the central question of whether the designs on the surface of the uniforms qualify for copyright protection because they "are capable of existing independently[] of the utilitarian aspects of the article."121 Star Athletica argued that Varsity's stripes and chevrons served no independent creative function, but solely served the utilitarian function of identifying the wearer as a cheerleader.122 Varsity argued that the identification function of the uniforms was secondary to the artistic function of the stripes and chevrons in their unique design, placement, and creative elements.123

Understanding these arguments, the Supreme Court attempted to clarify the confusion among the lower courts' separability requirements by creating a single test to determine whether a feature incorporated into the design of a useful article is eligible for copyright protection.124 The Court held that copyright protection is available

"[O]nly if the feature (1) can be perceived as a two- or three-dimen-
sional work of art separate from the useful article and (2) would qual-
ify 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 in-
corporated.125"

In its opinion, the Court dismissed several arguments against granting copyright protection for this type of decoration on a useful article and provided some guidance for the lower courts.126

First, the Court justified its use of a canvas to find that the designs are separable by stating that not finding so would "extend protection to two-di-

121. *Id.* at 1008 (quoting 17 U.S.C. § 101). Under § 101, the Court concluded that this case required a separability analysis because the designs of useful articles, meaning "‘the combination’ of ‘details’ or ‘features’ that ‘go to make up’ the useful article," include surface decorations that are used on useful articles. *Id.* at 1009 (quoting 3 Design, OXFORD ENGLISH DICTIONARY (3d ed. 1933)).

122. *Id.* at 1013.
123. *Id.* at 1009.
124. *Id.* at 1007.
125. *Id.*
126. See *id.* at 1012–17 (rejecting the argument that "copyright extends only to ‘solely artistic’ fea-
tures of useful articles" as well as the proposition that copyrightability depends on whether the useful article remains useful after separation (quoting Brief for Petitioner at 33, *Star Athletica*, 137 S. Ct. 1002 (No. 15-866))).
the same design if it covered the entire article.”127 Second, the Court clarified that the only copyright eligible elements are the surface decorations.128 The “shape, cut, and dimensions” of the uniform on which the decorations appear remain ineligible for copyright protection.129 Next, the Court dismissed the petitioner’s argument that the useful article must remain equally useful after the removal of the surface decorations based upon the reasoning that:

The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.130

The Court proceeded to explain that in their separability analysis, the

127. Id. at 1012. The Court determined that 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 . . . . Or consider, for example, a design etched or painted on the surface of a guitar. If that entire design is imaginatively removed from the guitar’s surface and placed on an album cover, it would still resemble the shape of a guitar. But the image on the cover does not “replicate” the guitar as a useful article. Rather, the design is a two-dimensional work of art that corresponds to the shape of the useful article to which it was applied. The statute protects that work of art whether it is first drawn on the album cover and then applied to the guitar’s surface, or vice versa.

Id.; see also id. at 1018 n.3 (“That Varsity’s designs can be placed on jackets or T-shirts without replicating a cheerleader’s uniform supports their qualification as fabric designs.”).

128. Id. at 1013 (“[Varsity] may prohibit only the reproduction of the surface designs in any tangible medium of expression—a uniform or otherwise.”). Interestingly, the Court did not comment on the originality requirement established in Feist which requires only minimal creativity. See supra note 9.

129. Star Athletica, 137 S. Ct. at 1016. This finding is importantly consistent with Esquire, Inc. v. Ringer, 591 F.2d 796, 801 n.15 (D.C. Cir. 1978). In Esquire, the court outlined three considerations Congress used to determine that the shape of utilitarian articles are ineligible for copyright. Id. First, the shape of utilitarian objects may be dictated by function, such as paper clips or scissors, and completely preventing another from producing the same article would severely limit the market. Id. Second, the shape may be dictated by consumer preference, providing the example of a stove, which would have a similar limiting effect on the market. Id. Third, basic geometric shapes are limited and, as a result, always in the public domain regardless of how well “integrated [it is] into a utilitarian article.” Id.

130. Star Athletica, 137 S. Ct. at 1013. The Court further explained that the statute “necessarily” requires there to be some aspect of the useful article “left behind,” but that it does not require a “fully functioning useful article at all, much less an equally useful one.” Id. at 1014.
“conceptual”\textsuperscript{131} and “physical”\textsuperscript{132} separability distinction has been eliminated.\textsuperscript{133} Additionally, the Court rejected arguments advocating for consideration of the creator’s intent in creating the work,\textsuperscript{134} as well as whether the market would “be interested in” the separated features of the useful article once they were removed.\textsuperscript{135} Last, concerns for the copyrightability of future industrial designs were found equally unpersuasive.\textsuperscript{136} Accordingly, the Court held that because the chevron designs on the cheerleading uniforms meet the separability test, they are copyright eligible.\textsuperscript{137}

Justice Ginsburg wrote separately to express her agreement with the majority’s finding, but disagreed with the use of \textit{Star Athletica} to resolve the separability issue.\textsuperscript{138} According to Justice Ginsburg, the Court should have stopped at the first issue of the case and held that the designs were copyrightable as standalone PGS works, rather than as separable elements of a useful article because they were simply attached to a garment.\textsuperscript{139}

Justice Breyer’s dissent, with whom Justice Kennedy joined, disagreed with the finding that the graphics were separable, under the same test the

\begin{footnotesize}
\begin{enumerate}
\item[131.] See \textit{Goldstein}, supra note 63 (discussing the inability of the lower courts to agree on a conceptual separability test).
\item[132.] See supra notes 83--84.
\item[133.] \textit{Star Athletica}, 137 S. Ct. at 1014 (“Because separability does not require the underlying useful article to remain, the physical-conceptual distinction is unnecessary.”). This distinction is one of the most prominent holdings of the case because of the divide between lower courts on whether physical or conceptual separability is required under the statute. \textit{See supra} notes 78--101; \textit{see also infra} Section IV.A.
\item[134.] \textit{Star Athletica}, 137 S. Ct. at 1015 (“The statute’s text makes clear, however, that our inquiry is limited to how the article and feature are perceived, not how or why they were designed.”); see \textit{Brandir Int’l}, Inc. v. \textit{Cascade Pac. Lumber Co.}, 834 F.2d 1142, 1152 (2d Cir. 1987) (Winter, J., concurring in part and dissenting in part) (explaining that the statute does not require consideration of the various stages the creator went through in developing a ribbon style bicycle rack).
\item[135.] \textit{Star Athletica}, 137 S. Ct. at 1015 (“Nothing in the statute suggests that copyrightability depends on market surveys.”); see Bleistein v. \textit{Donaldson Lithographing Co.}, 188 U.S. 299, 251 (1903) (famously stating that courts, trained only in law, are not in a position to “constitute themselves final judges of the worth of pictorial illustrations”).
\item[136.] \textit{Star Athletica}, 137 S. Ct. at 1015 (“Congress has provided for limited copyright protection for certain features of industrial design, and approaching the statute with presumptive hostility toward protection for industrial design would undermine Congress’ choice.”). This final, yet brief consideration of future copyrightability of industrial design, coupled with Congress’ history of extending copyrightability to some designs, leads to my opinion that the future of clothing copyrightability may be changing soon. \textit{See infra} Part IV.
\item[137.] \textit{Star Athletica}, 137 S. Ct. at 1016.
\item[138.] \textit{Id.} at 1018 (Ginsburg, J., concurring). Justice Ginsburg wrote in her concurrence that consideration of the separability is unwarranted based on distinguishing between “designs of useful articles” and “designs reproduced on useful articles.” \textit{Id.}
\item[139.] \textit{Id.}
\end{enumerate}
\end{footnotesize}
majority created.\textsuperscript{140} The dissenting justices struggled with Justice Thomas’s ability to imagine the uniforms on a canvas without the image simply re-producing a cheerleading uniform on paper.\textsuperscript{141} The dissent claims that if one simply follows “the Court’s words” the “difficulty [in determining physical and conceptual separability] tends to disappear.”\textsuperscript{142} Offering the example of Van Gogh’s painting of a pair of old shoes, the dissent claimed that the design of the shoes, if created in a physical shoe form, would not qualify for copyright protection because the designs cannot be physically separated from the shape of the shoes that they are part of.\textsuperscript{143} Justice Breyer continued with a detailed criticism of the majority’s view towards separability via conceptualizing the designs on a canvas.\textsuperscript{144} As shown in this cautionary dissent, using the same separability test, Justices Breyer and Kennedy were unable to see the designs as separable, though five other Justices were able to.\textsuperscript{145} In the wake of the Star Athletica decision, the lower courts, as seen in Design Ideas, Ltd. v. Meijer, Inc.,\textsuperscript{146} are already struggling with the flexible and subjective nature of the separability rule created by the Court.\textsuperscript{147}

B. Design Ideas, Ltd. v. Meijer, Inc.

One case following Star Athletica, decided only three months later, was Design Ideas.\textsuperscript{148} Design Ideas was a manufacturer who made “Sparrow Clips”

\textsuperscript{140} Id. at 1030 (Breyer, J., dissenting). This provides a preview to the confusion that will inherently follow Star Athletica among the lower courts. See Section III.B–D; Part IV.

\textsuperscript{141} Star Athletica, 137 S. Ct. at 1031 (Breyer, J., dissenting) (“A picture of the relevant design features, whether separately ‘perceived’ on paper or in the imagination, is a picture of, and thereby ‘replicates,’ the underlying useful article of which they are a part.”). The dissent additionally explained that “if extracting the claimed features would necessarily bring along the underlying useful article, the design is not separable from the useful article.” Id. at 1033. This directly contradicts the majority’s rule that an image of the graphic PGS elements of the uniforms, if imagined separately, would not produce a picture of a cheerleading uniform. Id. at 1008 (majority opinion).

\textsuperscript{142} Id. at 1031 (Breyer, J., dissenting). Here, the dissent advocates for keeping the physical and conceptual separability requirements that have muddled the lower courts since Mazer. Id.

\textsuperscript{143} Id. at 1032–33 (“[O]ne cannot easily imagine or otherwise conceptualize the design of the . . . shoes without that picture, or image, or replica being a picture of . . . shoes. The designs necessarily bring along the underlying utilitarian object.”).

\textsuperscript{144} Id. at 1033–34.

\textsuperscript{145} See id. at 1030–31.


\textsuperscript{147} See infra Sections III.B–C.

\textsuperscript{148} Design Ideas, 2017 WL 2662473, at *1.
which are “clothespin[s] with a silhouetted bird design on top.” Meijer was a manufacturer who created an allegedly infringing Sparrow Clip, giving rise to the action for copyright infringement. In August 2016, the district court, applying the Seventh Circuit’s separability test at the time, granted summary judgment in favor of finding that the Sparrow Clip was eligible for copyright protection based upon the bird portion of the clip’s ability to be physically separable from the useful aspects of the clip. The court granted review following Star Athletica in June 2017 to confirm whether summary judgment was properly granted as to the bird portion of the Sparrow Clip. The district court ultimately granted Meijer’s petition to reconsider the case under the new rule.

Applying the Star Athletica test, the district court determined first that the bird portion of the clip could “be perceived as a [two- or] three-dimensional work of art separate from the useful article.” The court—in one sentence—summarized that the bird had PGS qualities based upon its inherent three-dimensional sculptural nature. Next, the court asked if the PGS work “would qualify as a protectable sculptural work on its own if it were imagined separately from the useful article into which it was incorporated.” The court rejected Meijer’s argument that the bird itself was a useful article because it could be hung from a rod or a string. In doing so, the court inquired as to what “the usefulness of hanging the bird from a rod or hanging the bird on a string by its beak” would be. In determining that an analysis of the

149. See id. Similar to Star Athletica’s copyright protection for only the separable design aspects of their chevrons and stripes, Design Ideas sought copyright protection for only the bird portion of the clip. Id.
150. Id. Plaintiff moved for summary judgment to determine that it, in fact, held a valid copyright of the Sparrow Clip as the artistic elements were separable from the useful article. Id.
151. See Pivot Point Int’l, Inc. v. Charlene Prods., Inc., 372 F.3d 913, 927 (7th Cir. 2004).
153. Id.
154. Id.
155. Id. at *2.
156. Id. This element was not discussed in great detail; however, the sparrow clothespin claim, here, is less abstract than that of the cheerleading uniforms in Star Athletica. See Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1007 (2017). The reasoning may be because whereas in Star Athletica, the Court had to consider the separability of identifying marks of clothing, in Design Ideas, the court could easily remove the bird portion of the pin and consider it as a separate PGS work on its own. Compare Star Athletica, 137 S. Ct. at 1012, with Design Ideas, 2017 WL 2662473, at *3.
158. Id.
159. Id. The court compared the “bird on a string” example to the Compendium of U.S. Copyright Office Practices which states that “a sculpture does not become a useful article simply because it could
usefulness of a bird on a rod was unnecessary, the court affirmed its prior motion and granted Design Ideas partial summary judgment, extending copyright protection to the bird portion of the clip.\textsuperscript{160}

\textbf{C. Jetmax Ltd. v. Big Lots, Inc.}

Another court recently applied the \textit{Star Athletica} separability test—the Southern District of New York in \textit{Jetmax Ltd. v. Big Lots, Inc.}\textsuperscript{161} There, the court considered whether a tear drop light set contained separable elements of a useful article and was eligible for copyright protection.\textsuperscript{162}

\begin{figure}[h]
\centering
\includegraphics[width=0.5\textwidth]{figure3.png}
\caption{Figure 3\textsuperscript{163}}
\end{figure}

\textsuperscript{160} Design Ideas, 2017 WL 2662473, at *3. This conclusory analysis is applicable to this case because the nature of the clothespin is more clearly separable than that of clothing designs or even sculptural qualities, which are intertwined with the useful aspects of the PGS work. \textit{See id.} For example, a more in-depth analysis may have been required if the entire clothespin had been shaped as a bird, as opposed to there simply being a bird superficially attached to the pin. \textit{See id.}


\textsuperscript{162} \textit{Id.} The tear drop light set is a string light set, often used for lighting homes or patios, with tear drop shaped plastic and wire covers over the bulbs. \textit{Id.} at *2.

\textsuperscript{163} \textit{Id.} (picture the tear drop light set referenced in the case).
The court reviewed *Star Athletica*’s analysis and highlighted the limitations that the Court imposed in its opinion.\textsuperscript{164} Similar to *Design Ideas*, the court quickly determined that the first element, whether the tear drop light set possessed three-dimensional sculptural qualities, was met.\textsuperscript{165} Next, the court highlighted that the second element, independent existence, was satisfied because the utilitarian lights (foreseeably used to light a room) were separate from the covers’ usefulness in conveying artistic beauty.\textsuperscript{166} The court concluded by succinctly stating that the remainder of the light set, once the cover was removed, was a “functioning but unadorned light string.”\textsuperscript{167} Thus, the court established that under *Star Athletica* the PGS elements are separable from the useful elements.\textsuperscript{168} The conclusory nature of these opinions seem appropriate for the subject matter at issue; however, the analysis becomes far more hazy when it is applied to clothing items, as shown below.\textsuperscript{169}

D. *L.A. T-Shirt & Print, Inc. v. Rue 21, Inc.*

*L.A. T-Shirt & Print, Inc. v. Rue 21, Inc.* presented the first use of *Star Athletica* for clothing copyrightability; however, it is not a direct analysis of the separability requirement because the copyrighted images were applied to the t-shirt (useful article) rather than incorporated as a part of them.\textsuperscript{170} The issues in this case center around four copyrighted designs applied to t-shirts.\textsuperscript{171} L.A. T-Shirt owns copyrights for the “Tribal Bear” (a bear colored in a tribal pattern wearing red sunglasses, a feathered headdress, and holding a red cup in its hand), “Party Bear” (a bear colored in the same tribal pattern, wearing

\textsuperscript{164} *Id.* at *5* (“The Supreme Court clarified that it is no longer important whether an artistic element was originally incorporated into a useful article or created independently, and that a useful article need not be equally or similarly useful once the artistic element is removed.”) (internal citation omitted).

\textsuperscript{165} Compare *id.* (“The Tear Drop Light Set undoubtedly has three-dimensional decorative covers that have sculptural qualities.”), with *Design Ideas*, 2017 WL 2662473, at *3* (holding that a bird sculpture attached to a clothespin clearly has three-dimensional sculptural qualities).

\textsuperscript{166} Jetmax, 2017 WL 3726756, at *6.

\textsuperscript{167} *Id.*

\textsuperscript{168} *Id.*

\textsuperscript{169} See infra Sections III.D–E.


\textsuperscript{171} *Id.* This differs from *Star Athletica* because, there, the Court did not consider the copyrighted elements of the work to be images transposed onto the garment—rather, the Court considered the garment as a whole and attempted to separate the PGS elements from the useful elements. See *Star Athletica*, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1010 (2017). Whereas here, the court treated the image as inherently separate from the garment. *L.A. T-Shirt*, 2017 WL 3575699, at *1.
red sunglasses, but no headdress, and raising a red cup), “Navajo Pattern” (the tribal pattern coloring the bears), and “Ornate Elephant” (an elephant with the trunk depicted to the right and an intricate tribal pattern coloring in the animal).\textsuperscript{172} L.A. T-Shirt alleged that Rue 21 sold infringing T-shirts featuring animals substantially similar to its Tribal Bear and Ornate Elephant copyrighted images.\textsuperscript{173} There, the issue was less of whether designs were separable, but whether the separability analysis used in \textit{Star Athletica} to find that a pattern of geometric designs was copyright eligible may be used to find other patterns similarly copyrightable.\textsuperscript{174}

The court used the \textit{Star Athletica} opinion to find that the colored patterns and stripes on the animal designs were protectable.\textsuperscript{175} Focusing on how \textit{Star Athletica} found the “arrangement of colors, shapes, stripes, and chevrons” copyright eligible, the court determined that stripes and designs were similarly eligible, although they were printed within the shape of a bear on a useful article.\textsuperscript{176} Thus, this case has already extended the application of \textit{Star Athletica} beyond determining whether surface decorations are eligible for copyright, to whether an arrangement of patterns are protectable within surface decorations.\textsuperscript{177}

\textbf{E. Compendium of U.S. Copyright Office Practices}

In addition to the impact \textit{Star Athletica} has on upcoming case law, the Court’s ruling has inspired change to the Compendium of U.S. Copyright Office Practices (“Compendium”).\textsuperscript{178} The Compendium guides attorneys and courts in “the contents and scope of particular registrations and records” and “seeks to educate applicants about a number of common mistakes.”\textsuperscript{179} In September 2017, the U.S. Copyright Office (“Copyright Office”) released an

\begin{footnotesize}
\begin{tabular}{ll}
\textsuperscript{172. } & \textit{Id.} \\
\textsuperscript{173. } & \textit{Id.} \\
\textsuperscript{174. } & \textit{Id.} at *6. There, the court compared the geometric tribal design elements on a bear, which many have argued to be “basic ideas” that depict only an animal’s natural appearance. \textit{Id.} at *5. However, the court further analyzed similar cases of tree frogs, jellyfish, and turtles, holding that an animal’s physiology is not protectable, but the “original expressions of the animal’s appearance” is protectable. \textit{Id.} at 6. \\
\textsuperscript{175. } & \textit{Id.} \\
\textsuperscript{176. } & \textit{Id.} (quoting \textit{Star Athletica}, 137 S. Ct. at 1012). \\
\textsuperscript{177. } & Compare \textit{id.}, with Star Athletica, 137 S. Ct. at 1012. \\
\textsuperscript{178. } & \textit{See U.S. COPYRIGHT OFFICE, supra note 10, § 924.} \\
\textsuperscript{179. } & \textit{Id.} at 2 (“Courts have cited the \textit{Compendium} in numerous copyright cases.”). While the Compendium seeks to educate lawyers, it is not a source of law and is not binding upon the court, Copyright Office, or Register. \textit{Id.} \\
\end{tabular}
\end{footnotesize}
update to their administrative guidelines, including the separability require-
ment for useful articles as defined in Star Athletica.\footnote{180}

Although the guide has been updated to include the Star Athletica test, the final paragraph simply states the test with no further guidance.\footnote{181} The Copyright Office agrees with the decision in Star Athletica, stating, “The U.S. government’s brief supported the plaintiff, explaining, among other things, that the Office has for decades accepted registration of graphic designs used on clothing. In March 2017, the Supreme Court held that the plaintiff’s designs were copyrightable; the opinion generally reflected the government’s position in the case.”\footnote{182} Interestingly, this contradicts the dissenting opinion, which argues that the practices of the Copyright Office and Congress have been to deny registration to useful articles, like the cheerleading uniforms, as they viewed the designs as elements of the useful articles.\footnote{183}

In light of each of these decisions, it is necessary to look to the future of this uncertain landscape in order to predict the impact on this large industry and how the market most in jeopardy here—the knockoffs—will proceed to operate.\footnote{184}

IV. Practical Effects and Critique

Prior to Star Athletica, clothing had long been thought of as ineligible for copyright protection based upon the firm precedent stating that cut and design of clothing articles (such as where arm holes go in a t-shirt, or the shape of pants requiring a waistline plus two legs) are useful articles.\footnote{185} Star Athletica purports to offer the first uniform test to assist clothing manufacturers in determining the copyrightability of their clothing features.\footnote{186} Yet, the Court’s decision came from only a five-Justice majority, with one Justice

\footnote{180. \textit{Id.} § 924.}
\footnote{181. \textit{Id.} The paragraph explains that the Copyright Office is working to create future guidance on the registration of PGS works but has not yet done so. \textit{Id.}}
\footnote{183. Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1034 (2017) (Breyer, J., dissenting) (“And it is clear that Congress has not extended broad copyright protection to the fashion design industry.”).}
\footnote{184. \textit{See infra} Part IV.}
\footnote{185. \textit{See supra} note 8 and accompanying text.}
\footnote{186. \textit{See supra} notes 14–16 and accompanying text.}
concurring. Using the same separability test as the majority, Justices Breyer and Kennedy found that the chevrons and stripes were not separable and, thus, copyright ineligible. If the intent of the majority was to create a rule that all lower courts could uniformly follow, and to eliminate the ten previous separability tests, it should have constructed a different test that garnered consensus; a dissenting opinion means the lower courts will likely have as much difficulty applying the new rule as they did with their previous rules.

But nonetheless, the majority opinion presents a new intellectual property protection that is historically cheaper and easier to obtain. It is time for fashion, like other artistic forms that have stemmed from historically useful articles, to claim stronger intellectual property protection. However, courts will likely struggle with applying this standard as fashion power houses fight to protect their designs and crush the knockoff market in the process. Additionally, it is highly likely that the lower court’s previous versions of the separability test will become persuasive in applying the Star Athletica test. It is nearly impossible to discuss whether an aspect of a useful article is separable from, and identifiable independently of, the useful article itself without considering, for example, the articles side by side or whether the artistic elements of the separable piece are part of the utilitarian function.

187. Star Athletica, 137 S. Ct. at 1018 (Ginsburg, J., concurring) (stating that no analysis of separability was required in the first place).
188. Id. at 1007 (majority opinion) (“(1) [C]an [the feature] be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would [it] 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.”).
189. Id. at 1030–31 (Breyer, J., dissenting).
190. See id. at 1031.
191. See generally Whitney Potter, Intellectual Property’s Fashion Faux Pas: A Critical Look at the Lack of Protection Afforded Apparel Design Under the Current Legal Regime, 16 INT’L PROP. L. BULL. 69 (2011) (describing the issue of balancing between affording protection and stifling innovation, in addition to describing how the fashion industry has had less intellectual property rights than other creative industries).
192. See id. at 74. Potter offers the example of a tapestry, highlighting that its original purpose was to protect buildings from the elements. Id. However, the functionality of protecting was soon “superseded”...[by] its consideration as a form of art.” Id. at 75 (quoting William S. Lieberman, Modern French Tapestries, 6 METRO. MUSEUM OF ART BULL. 142, 142 (1948)).
193. See infra Section IV.A.
194. See supra Section II.C
195. See supra Part II.
A. The Effect of Star Athletica on Fashion Design Companies and the Knockoff Market

In oral arguments, Justice Breyer romantically stated that “[t]he clothes on the hanger do nothing; the clothes on the woman do everything. And that is, I think, what fashion is about.”196 Indeed, many argue that clothing’s usefulness reaches far beyond covering one’s body from the elements.197 The history of copyright law has dismissed creative elements of clothing as being “inexorably linked with the utilitarian function of clothing.”198 Under Star Athletica, design houses have greater hope that their creative expressions will be protected by being seen apart from the useful medium they are imposed upon.199 The following are examples of the impact that Star Athletica will have on courts and fashion intellectual property lawyers in future claims for clothing copyright protection.200

1. Limitations on Judicial Subjectivity

One win for designers, and the lower courts, following Star Athletica is the new clarity regarding a judge’s role in determining what elements of an article are useful.201 Unlike the Primary-Subsidiary Approach,202 Ordinary-Observer Approach,203 Design-Process Approach,204 and Likelihood-of-Marketability Approach,205 the new test eliminates judicial subjectivity and focuses on statutory interpretation.206 This may allow fashion designers who attempt to copyright original, yet basic, separable elements, to bring claims.

197. See Potter, supra note 191, at 71 (“Unlike goods bought for their intrinsic usefulness, such as a dishwasher or a broom, consumers buy status-conferring goods for their communicative functionality.”).
198. See id. at 73 (quoting Jennifer Mencken, A Design for the Copyright of Fashion, 1997 B.C. INTELL. PROP & TECH F. 121201, *30 (1997)).
199. See id. at 74.
200. See infra Sections IV.A.1–2.
201. Star Athletica, 137 S. Ct. at 1015 (citing Brandir Int’l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1152 (2d Cir. 1987) (Winter, J., concurring in part and dissenting in part)) (“The statute’s text makes clear, however, that our inquiry is limited to how the article and feature are perceived, now how or why they were designed.”).
202. See supra note 79 and accompanying text.
203. See supra notes 81–82 and accompanying text.
204. See supra note 83 and accompanying text.
205. See supra note 86 and accompanying text.
206. Star Athletica, 137 S. Ct. at 1015.
without worry that judges will misinterpret their design’s artistic value.207 Similarly, for designers who hope to bring claims against their knockoff competitors, judges will face the task of determining whether the designs are separable, without the ability to consider the economic impact of the designs208 or the remaining elements of the useful article after the PGS designs are removed.209 The lower court’s ability to follow the Supreme Court’s guidance on remaining impartial remains to be seen, but it is a step in the right direction to afford designers greater protection for their clothing designs as works of art.210

2. Protection from Infringement

The Court provided another clarification worth cheering about in finding Varsity’s argument that its designs were surface PGS decorations unpersuasive.211 In rejecting this argument, the Court established that similar designs to Varsity’s are designs on useful articles, rather than designs of useful articles.212 Addressing this point later in its application of the separability test to Varsity’s copyright registrations, the Court stated that “imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself.”213 This, perhaps inadvertently, heightened the standard that knockoff brands will have to meet in order to show that similar—but perhaps not exact in the angle, design, or useful article they are placed on—works are not infringing.214 For example,

207. See id.
208. See supra notes 78, 80, 85 (outlining the Copyright Office’s Approach, Objectively Necessary Approach, and Stand-Alone Approach, respectively); see also Star Athletic, 137 S. Ct. at 1015 (“[A]sking whether some segment of the market would be interested in a given work threatens to prize popular art over other forms, or to substitute judicial aesthetic preferences for the policy choices embodied in the Copyright Act.”).
209. Star Athletic, 137 S. Ct. at 1014. Following Mazer, the Court held that “the statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one.” Id.
210. See Lefebvre, supra note 15, at 171 (discussing the separability requirement in depth and the need for clarity to guide lower courts in its application to clothing design).
211. See Star Athletic, 137 S. Ct. at 1009 (“[Respondents] contend that the surface decorations in this case are ‘two-dimensional graphic designs that appear on useful articles,’ but are not themselves designs of useful articles.” (quoting Brief for Respondents at 52, Star Athletic, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017) (No. 15-866))).
212. Id.
213. Id. at 1012 (emphasis added).
214. See id.; see also 17 U.S.C. § 501(a) (2012). Section 501, essentially, holds that when any person copies another’s work, they are liable for copyright infringement. Id. Under the language used
Varsity’s chevrons and stripes on their uniform tops and skirts are also theoretically their designs to print on all other clothing articles, or other useful articles, such as books, bags, or even lamps. The theoretical repercussions of *Star Athletica* have not been solidified yet, but cases are already in the process of using *Star Athletica* to extend copyright protection onto useful articles in ways that have been unsuccessful in years prior. The next subsection provides real-world examples of the separability test in action, with a discussion of the repercussions on the knockoff market.


Perhaps the most relevant case yet to be decided following *Star Athletica* may be *Puma*. This case focuses on Forever 21’s long-standing business of offering knockoff versions of popular brands in nearly identical ways. Puma, in conjunction with pop star and fashion icon Rihanna, created a line of “Fenty shoes,” shown below:

![Figure 4](image)

by the majority in *Star Athletica*, copying of the cheerleading uniform may be found when similar chevrons and stripes are included on pants, jackets, and more. *See Star Athletica*, 137 S. Ct. at 1012.


217. *See infra Section IV.B.3.*


219. *Id. at *1; see C. Scott Hemphill & Jeannie Suk, The Law, Culture, and Economics of Fashion, 61 Stan. L. Rev. 1147, 1173 (2009) (“Forever 21 was a defendant in fifty-three suits [between 2003 and 2008].”).*

Puma argues that Forever 21’s version of these three shoes violates their copyright in the shoe design and cites Star Athletica as precedent showing that the original elements of their shoe designs are copyright eligible. In Star Athletica, the Court confirmed that there is no protection for shape, cut, or dimensions of useful articles—here, one may argue this is analogous to the base of the shoes and shape of the parts that hold one’s feet in place. However, Puma argues that the copyrightable elements of their shoe designs are its (1) “casually knotted satin bow with pointed endings,” (2) “ridged

---

221. Id. at 11.

222. Id. It is interesting to note that the brief contends that the shoes were copied by Forever 21 only one week after they were offered for sale by Puma. Id. at 3. This highlights the need for copyright protection to evolve in a high-technology society where copying is rampant and rapid. See Potter, supra note 191, at 83–86.


vertical tooling and grainy texture encompassing the thick rubber outer sole," and 3) "wide strap decorated with plush fur extending to the base of the sandal." 

First, under *Star Athletica*, it is possible that a court may find that the bow element, rigid vertical texture, and fur plush strap, of the shoes depicted in Figures 4–6 are—assuming originality is met—separable as a three-dimensional works of art applied to and separable from the useful article.\(^{228}\) As stated in *Star Athletica*'s dissent, the main issue courts will have to focus on in interpreting the Court's separability test is "whether the design can be imagined as a 'two- or three-dimensional work of art.'"\(^{229}\) Justice Breyer claims that "virtually any industrial design can be thought of separately as a 'work of art': Just imagine a frame surrounding the design, or its being placed in a gallery."\(^{230}\) This Comment encompasses the *Star Athletica* decision by highlighting the difficulty in conceptualizing what does or does not create a separable aspect of a useful article, specifically one that does not create an identical image of the outline of the article the PGS features are attached to.\(^{231}\)

Second, a court may find that the PGS elements of the shoes, the bow, vertical texture, and fur strap, are separable from the shoes.\(^{232}\) This may be found by conceptually removing the designs as applied onto the straps and soles of the shoes, and placing them onto a canvas, like in *Star Athletica*.\(^{233}\) Further, it is clear that the artistic elements of the shoes are not subject to objective judicial scrutiny—the value the shoes possess without the artistic PGS elements, and the value of the separated PGS elements are not a relevant part of the analysis.\(^{234}\)

This yet-to-be-determined case will help the fashion and copyright community see how the lower courts respond to the Supreme Court doing away with their individual tests.\(^{235}\) An example to illustrate this challenge is

---

\(^{226}\) Second Amended Complaint at 11, Puma SE v. Forever 21, Inc., 2017 WL 4771004 (C.D. Cal. June 29, 2017) (No. 2:17-cv-02523); see Figure 4, *supra* note 220.

\(^{227}\) Id.

\(^{228}\) Second Amended Complaint at 11, Puma SE v. Forever 21, Inc., 2017 WL 4771004 (C.D. Cal. June 29, 2017) (No. 2:17-cv-02523); see Figure 5, *supra* note 221.

\(^{229}\) *See Star Athletica*, 137 S. Ct. at 1007.

\(^{230}\) Id. at 1033 (Breyer, J., dissenting).

\(^{231}\) Id.

\(^{232}\) *See id.* at 1032–36; *supra* Section III.A.

\(^{233}\) *See generally Star Athletica*, 137 S. Ct. at 1033 (Breyer, J., dissenting).

\(^{234}\) *See id.* at 1012 (majority opinion).

\(^{235}\) *See Puma SE v. Forever 21, Inc., No. CV17-2523, 2017 WL 4771004 (C.D. Cal. June 29, 2017).* It is important to note that this case may be in the process of settling, or the litigants could be
explained, below.\textsuperscript{236}

\textbf{B. A Practical Application of Star Athletica}

Ruffles seem to be the "it" look for Winter 2018.\textsuperscript{237} How does the arrangement of superficially placed ruffles, say on a sweater or a t-shirt, fall within \textit{Star Athletica}'s test?\textsuperscript{238} Analyze the following images in Figures 7 and 8:

\begin{figure}[h]
\centering
\includegraphics[width=0.4\textwidth]{sweater1.png}
\includegraphics[width=0.4\textwidth]{sweater2.png}
\caption{Figure 7\textsuperscript{239} Figure 8\textsuperscript{240}}
\end{figure}

A copyright attorney may argue application of the \textit{Star Athletica} test in the following way.\textsuperscript{241} First, looking to whether the ruffles are two- or three- 

\textsuperscript{236} See infra Section IV.B.
\textsuperscript{238} See \textit{Star Athletica}, 137 S. Ct. at 1016.
\textsuperscript{241} See infra notes 242-44 and accompanying text. This application is ignoring for the moment
dimensional features separate from the useful article, one may argue in good faith that the ruffles are three-dimensional features attached to the general shell of a sweater (the “useful article” i.e., a clothing article that usefully covers your body) consisting of two full sleeve-length arms, a high neckline, and a full torso-length body.242 Second, do the ruffles qualify as a PGS work on their own or fixed in some other tangible medium of expression?243 If the ruffles were removed from the shell of the top, the ruffles could be envisioned on a canvas and hung on a wall, indeed there are many artistic pieces using an arrangement of ruffles on an otherwise blank canvas, with the useful features of the arms, neck, and torso still intact.244 Though, as the Court stated, whether or not the useful aspect of the article remains is not part of the separability analysis.245 Does the holding in Star Athletica now mean that no clothing company other than the first to create/ register may put ruffles in the same shape, pattern, length, width, etc. on any other clothing item?246 According to the majority, it appears that this may be the case.247 However, the dissent argues that removing the superficial designs of useful articles will retain the shape/cut of the original clothing item and the designs are thus copyright ineligible.248 There is a good argument that the designs of ruffles on useful articles, such as sweaters, are even more superficially attached than the chevrons on the cheerleading uniforms in Star Athletica.249 Should a court find that the ruffles were separable, the originality requirements of copyright ownership

the issue of originality, as the Court did in Star Athletica. See Star Athletica, 137 S. Ct. at 1012. This analysis simply argues that application of Star Athletica could result in potential copyrightability. See infra notes 242–44 and accompanying text.

242. See Star Athletica, 137 S. Ct. at 1008–09; supra notes 238–40.

243. See Star Athletica, 137 S. Ct. at 1008.

244. See id. at 1012. The Court in Star Athletica similarly concluded that the second element of the separability analysis was met through imagining the chevrons on a blank canvas. Id. However, the majority in Star Athletica pointed out that the remainder of the article need not be equally useful once the PGS work is separated from the article. Id. at 1013. This presents yet another confusing addition to the analysis that fashion houses’ attorneys will have to make in determining whether to apply for and enforce their copyright. Id. at 1033 (Breyer, J., dissenting).

245. Compare id. at 1013 (majority opinion) (holding that whether or not the useful article remains intact is not a relevant aspect of the inquiry), with Pivot Point Int’l, Inc. v. Charlene Prods., Inc., 372 F.3d 913, 934 (7th Cir. 2004) (Kane, J., dissenting) (stating that the only relevant inquiry is whether or not the usefulness of the article remains).

246 See Star Athletica, 137 S. Ct. at 1035–36 (Breyer, J., dissenting).

247. See id. at 1016 (majority opinion).

248. See id. at 1032 (Breyer, J., dissenting).

would remain a barrier to generic styles such as this one that may be found in any store in the country. This will inevitably shift a huge burden to the Copyright Office and the courts to determine what designs on clothing items are sufficiently original.

V. CONCLUSION

If Star Athletica is found to protect designs such as the ruffles on the sweaters above, the impact this will have on innovation and creativity in the fashion industry is incredible. When fast fashion retailers, like Forever 21, are able to reproduce nearly the exact same article of clothing with none of the developmental costs associated with designing the article, the sales of the original decline. However, as some argue, this constant turnover and required innovation also drives the fashion industry and promotes continuous sales of new products.

In the United States, incentive theory drives copyright protection. It holds that in order to encourage creativity in society, authors must be incentivized through monopoly protections of their creations. Yet, prior to Star Athletica, the fashion industry has behaved contrary to this theory by continuously creating fashion pieces, even while knowing they are likely to be knocked-off. In fact, many have argued that in fashion, it is “almost always impossible to separate the expressive components (which may be copyrighted) from the utilitarian components (which may not be copyrighted) as required by [§ 101].” A view from some commentators expresses that the

250. See Star Athletica, 137 S. Ct. at 1012 n.1 (stating that the Court holds no opinion on whether or not the designs of the chevrons and stripes were sufficiently original to meet the Copyright Office’s requirements of eligibility).


252. See generally Raustiala & Sprigman, supra note 12, at 1722, 1733–34, 1774–75.

253. See Hemphill & Suk, supra note 219, at 1175.

254. See Raustiala & Sprigman, supra note 12, at 1722.


256. See Mazer v. Stein, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’ Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”).

257. See Hemphill & Suk, supra note 219, at 1181.

effects of knockoffs are positive in the industry. Another scholar argues that knockoff versions of high-end retail items have the effect of communicating to the public what is “on-trend” for the season and confirming the desire for the pricier brand’s “real” items.

Star Athletica certainly puts a new lens on what was once considered settled law regarding the copyrightability of clothing designs. Beyond the patterns, drawings, and designs of printed artwork on clothing that have been held copyrightable for years, Star Athletica, in its attempt to settle the separability paradox, opens the door to copyrightability of design features that are intertwined with the useful articles they are depicted on. With this door open, fashion powerhouses are likely to rush to the gates of the Copyright Office and demand that their innovative designs, often entangled with the cut, shape, and style of the clothing, be granted copyright protection just like the cheerleading uniforms.

Samantha Burdick*

---

to U.S. law, fashion items cannot be protected by copyrights, mainly due to the—useful—nature of clothing. This legislation entails the consequence that designers should look for protection guaranteed by intellectual property law, such as designs, trademarks and trade dress.


260. See Raustiala & Sprigman, supra note 12, at 1728.

261. See Russ & Meyer, supra note 8, at 20.


* J.D. Candidate, Pepperdine University School of Law; B.S. in Psychology, Santa Clara University.
***