FASHION ISSUE

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CARTWHEELING THROUGH COPYRIGHT LAW: STAR ATHLETICA, L.L.C. v. VARSITY BRANDS, INC.: THE SUPREME COURT LEAVES AS MANY OPEN QUESTIONS AS IT PROVIDES ANSWERS ABOUT THE VIABILITY AND SCOPE OF COPYRIGHT PROTECTION FOR FASHION DESIGNS∗

By Eleanor M. Lackman∗∗

I. INTRODUCTION

Despite repeated efforts over the years to advocate for copyright protection for fashion designs in the United States, creators of apparel have had limited protection under copyright law for their designs. The generally accepted scope of protection under copyright law was limited to fabric patterns, lace designs, separable embellishments, and the like. In the fashion business, designers have focused on trademark protection for brands, logos, and certain design elements with secondary meaning; for certain valuable shapes of designs—often for handbags and shoes—design patent protection is sometimes sought.

When a bill last came before Congress, proposing protection for fashion similar to that existing in France under the French Intellectual Property Code, industry reaction was mixed. While many involved in the debate claimed that they did not want their designs knocked off, others (particularly independent designers without budgets to engage in prosecuting or defending infringement claims) claimed that taking designs out of the public domain would inhibit the development of apparel designs that are similar to protected designs. To date, efforts to pass a bill have not succeeded in Congress, leaving copyright protection for fashion articles only on the margins.

A case pending before the United States Supreme Court portended to change the balance in copyright law on fashion design. On March 22, 2017, in Star Athletica, L.L.C. v. Varsity Brands, Inc., the Court took up the issue of whether the stripes, chevrons, and color-blocks on cheerleading uniforms met the test for copyright protection, and the fashion world was watching. More broadly

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worded, the issue was how to determine when pictorial, graphic, or sculptural design elements of a useful article may be protected by copyright.

The eight justices—known for their attire of shapeless, all-black robes (with the occasional lace collar)—chose Star Athletica as the vehicle to address what a Sixth Circuit judge had previously referred to as a “mess” in the jurisprudence concerning whether a design incorporated into a useful article is “conceptually separable” and hence might be subject to copyright protection under the U.S. Copyright Act. Until the Supreme Court took the case, any one of ten or more tests applied by the various Circuit Courts could decide the copyrightability fate of a design—or one or more design elements—of a useful article, such as a lamp, a chair, a piece of jewelry, a bicycle rack, or a mannequin or—as considered in Star Athletica—apparel.

The Supreme Court, in tacit recognition of the situation decried by the dissenting Sixth Circuit judge in the case below, chose this case as the vehicle to address the split among the circuits with respect to protectability under copyright law of elements of useful articles. This issue could have reached the Supreme Court under a variety of factual circumstances, but because this issue reached the Supreme Court in the context of wearing apparel, the fashion industry took note, given that the decision could affect the fashion world for years to come.

The Court’s holding, while potentially significant, leaves much uncertainty. Despite defining the appropriate test for determining conceptual separability, the Court’s opinion lacked any deep discussion of copyright, particularly as applied to fashion. The ruling, and the subsequent case history, did, however, shine a light on the myriad of issues that courts will have to grapple with as creators of fashion designs seek to rely on copyright law for protection of their designs. As the Justices’ opinions in Star Athletica herald, the path to copyright or other sui generis protection

1. Varsity Brands, Inc. v. Star Athletica, L.L.C., 799 F.3d 468, 497 (6th Cir. 2015). The term “mess” refers to the dozens of differing and often-conflicting tests that courts around the country had developed in their assessment of whether the design of a useful article could be subject to copyright protection.


covering elements of clothing could be as uncertain in the courts as it has been before Congress.8

II. THE SUPREME COURT ESTABLISHES A CONSISTENT TEST FOR ALL COURTS . . . WITH INSTANTLY INCONSISTENT OUTCOMES

The facts of Star Athletica9 are simple. Varsity Brands complained that the appearance of certain design elements of Star Athletica’s cheerleading uniforms was substantially similar to their appearance on Varsity Brands’ cheerleading uniforms, the designs of which Varsity Brands had registered with the U.S. Copyright Office, and which are shown here:

Varsity Brands had no angle to pursue relief under trademark, trade dress, or design patent law (although it may have in countries that provide specific statutory protection for fashion designs). Moreover, as U.S. copyright law provides industrial design protection in limited instances, e.g., for boat hulls, Varsity Brands’ only hope of redress was to rely on infringement of its claimed copyright in the graphic designs depicted in its copyright registrations (which reflect the designs of its cheerleading uniforms) by Star Athletica’s incorporation of similar designs into its own cheerleading uniforms.

Star Athletica’s primary defense was that the stripes, chevrons, and color-blocking on the uniforms served no independent creative function. Rather, the function of these design elements was informational, serving to identify the wearer of the uniform as a cheerleader. As such, these design elements were outside the scope


of copyright protection, as utilitarian elements of a useful article. This defense opened the door to the issue that the Supreme Court decided to take up.

Under the plain text of the Copyright Act, the key to resolving the question of copyrightability in elements of a useful article is determining whether the designs of the uniforms incorporated “pictorial, graphic, or sculptural features” that “can be identified separately from” the design and “are capable of existing independently of,” the utilitarian aspects of the article. As a result of the plurality of tests for conceptual separability, the task for the High Court was to identify how lower courts are to conduct this “separability” analysis—in other words, how to determine whether a design has its own independent (non-utilitarian) existence.

In a straightforward opinion written by Justice Thomas, which focused on the statutory language, the Court held that a feature incorporated into the design of a useful article (such as wearing apparel) is eligible for copyright protection if the feature: (1) can be perceived as a two- or three-dimensional work of art separate from the useful article; and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated. To look at it another way, the question is whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article.

The pronouncement of a single test might have been expected to result in a unanimous decision on the question of copyrightability. Yet only six of the eight justices agreed that the designs were eligible for copyright protection and one of those six, Justice Ginsburg, rejected the need for separability analysis in the first place. The five-member majority opinion decided that the uniforms met the test. The majority held that the graphics on the

11. In what may be a recognition of some concerns from the dissenting justices about the practical impact of the Court’s holding on the fashion industry, the opinion expressly stated that the Court was not conducting “a free-ranging search for the best copyright policy[.]” Star Athletica, L.L.C. v. Varsity Brands, Inc., 580 U.S. ___ (2017) (slip op. at 6).

12. Star Athletica, slip op. at 1.

13. Id. at 8.

14. Justice Ginsburg, relying on the fact that the registrations depicted two-dimensional graphic designs, rather than actual cheerleader uniforms, did not believe that the Court needed to examine the separability test to find the designs eligible for copyright. Justice Ginsburg’s contention was that the copyrights were not asserted in elements of the cheerleader uniforms that could be separated from the articles themselves, but were created as independent two-dimensional graphic designs that were then applied to the useful articles. Id., slip op., concurrence at 1 (Ginsburg, J., concurring).
uniforms were features that had pictorial, graphic, or sculptural qualities, and that the arrangement of the colors, shapes, stripes, and chevrons on the surface of the uniform, if placed on a painter’s canvas instead of on clothing fabric, would qualify as two-dimensional works of art.\textsuperscript{15} The majority noted that Varsity Brands had applied the designs on different types of clothing without replicating the uniform.\textsuperscript{16} According to the Court, the fact that the designs would retain the outline of a cheerleading uniform was of no relevance, as taking such fact into consideration would effectively preclude protection for an artistic element of a work simply because it was applied originally to an object with a utilitarian shape.\textsuperscript{17}

In dissent, Justice Breyer (joined by Justice Kennedy) did not reject the majority’s formulation of the legal test; however, “[e]ven applying the majority’s test,” Justice Breyer wrote, the designs cannot be perceived as two- or three-dimensional works of art separate from the useful article.\textsuperscript{18} Justice Breyer explained that the Copyright Office received pictures of cheerleading uniforms, and cheerleading uniforms are useful articles, the design of which has no independently separable existence; therefore, plaintiff’s claimed work cannot be perceived as separate from the useful article in which it is incorporated.

Using an analogy to two different types of lamps bearing Siamese cat motifs,\textsuperscript{19} Justice Breyer noted that unlike the cheerleader uniform designs, the cats could be envisioned alone even if no lamp structure were at the center of the cat-shaped base. Likewise, one could envision the cat designs without drawing the conclusion that they had anything to do with a lamp or any other utilitarian object, as one must do with the cheerleading uniforms at issue in the case. As the dissent explained it, when looking at objects that may have an artistic design, such as measuring spoons shaped like heart-tipped arrows or candleholders shaped like sailboats, the design cannot be imagined separately: “[t]he designs necessarily bring along the underlying utilitarian object.”\textsuperscript{20}

The dissent expressed concern that the majority’s broad interpretation would mean that everyday objects might become

\textsuperscript{15} Star Athletica, slip op. at 10.
\textsuperscript{16} Id.
\textsuperscript{17} Id. at 11.
\textsuperscript{18} Star Athletica, dissent at 1 (opinion of Breyer, J., dissenting). This observation appears to center on the first element of the test, namely, that the claimed work can be perceived as a two- or three-dimensional work of art separate from the useful article, which the majority found less difficult to satisfy, rather than the second element of the test, whether the work would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression, on which the majority opinion spends nearly all of its time. See id. at 7.
\textsuperscript{19} See id., dissent at Figs. 1 and 2 (Breyer, J., dissenting).
\textsuperscript{20} Id. at 5.
eligible for copyright protection. The majority put that concern aside, agreeing that there was no place in copyright law for Duchamp’s “readymades,” even though, under the Court’s test, there may be eligibility for a Mondrian or Magritte.\textsuperscript{21} \textit{Ceci n'est pas une cheerleading uniform.}

\section*{III. THE \textit{STAR ATHLETICA} TEST IN A COMPLICATED COPYRIGHT CONTEXT}

To appreciate the potential impact of \textit{Star Athletica}, including whether and to what extent the ruling creates certainty for copyright protection for fashion designs, it is vital to realize the context in which the ruling sits. Putting aside the foreboding fact that six intelligent jurists can see the designs as conceptually separable and two intelligent jurists cannot, the majority noted that, despite its holding that the designs are \textit{eligible} for copyright protection, it does not follow that they are in fact protectable or that any copyright inhering in the works was infringed by the defendant’s designs. In a footnote, the Court confirmed that it was expressing no opinion on whether the works were sufficiently original to qualify for copyright protection, or whether any other prerequisite of a valid copyright had been satisfied.\textsuperscript{22} The original trial court had declined to address the question of originality, and thus this issue was not ripe for appeal. And beyond the question of originality, it could be that the designs would be subject to the merger doctrine (which holds that, where an idea can be expressed in only one, or an extremely limited number of effective ways, such expression(s) are not protectable), or based so much on other designs that only extremely thin protection might exist, or perhaps \textit{Star Athletica} could have independently created the designs. Any of these outcomes could have doomed Varsity Brands’ case even as to a highly similar or even nearly identical design.\textsuperscript{23}

For these reasons, the \textit{Star Athletica} decision is akin to the first battle in a war: the battle of eligibility for copyright protection has been won, but this victory says little about the likely outcome in subsequent battles to determine whether particular fashion elements are copyrightable since that issue will be determined by any number of factors, some of which are noted in the preceding paragraph.

As it turns out, we will never know what impact the ruling might have had on the other questions to be examined when the case

\textsuperscript{21} See \textit{id.\textsuperscript{,} slip op. at 12 n.2 (discussing protectability of shovels in response to the dissent’s discussion of a Duchamp work consisting of a shovel).}

\textsuperscript{22} \textit{Id.\textsuperscript{,} slip op. at 11, n.1.}

\textsuperscript{23} Or, perhaps, the same stripes and chevrons on a floor-length, long-sleeved dress with a scoop-neck rather than the customary outline of a cheerleading uniform—or in a plain, rectangular space, as the \textit{Star Athletica} dissent imagined.
was remanded back to the district court. Less than five months after
the Supreme Court decision, Varsity Brands reached a settlement
with Star Athletica’s insurer and the case was dismissed.24

Star Athletica itself objected to dismissal of the action. It seems
that Star Athletica, after seven years of litigation and a trip to the
Supreme Court, wanted to litigate its affirmative defenses of
originality, copyright use, and fraud on the Copyright Office.
Certainly, Star Athletica was not alone in wanting to see how the
case would play out on a full record. But until the next case is
brought and litigated, we will not know the scope or impact of Star
Athletica on the extent of copyright protection for various elements,
including graphic design elements of fashion designs.

IV. THE FUTURE OF FASHION DESIGN
PROTECTION AFTER STAR ATHLETICA:
SOMETHING FOR PLAINTIFFS TO CHEER ABOUT,
OR JUST MORE “FIGHT, FIGHT, FIGHT”?

The Star Athletica Court made one thing clear: even if Varsity
Brands succeeded in establishing a valid copyright in the surface
decorations at issue, they had “no right to prohibit any person from
manufacturing a cheerleading uniform of the identical shape, cut,
and dimensions to the ones on which the decorations in this case
appear.”25 Only the reproduction of the surface designs (assuming
the designs are ultimately copyrightable) could be prohibited.26 This
was cold comfort to the dissent, however, which found the holding
to reinforce the idea of protection for garments, as the stripes and
chevrons on a rectangular space would likely be uncopyrightable
themselves.27

The dissent devoted a significant portion of its discussion to its
concern that expanded copyright protection would add undue costs
to the fashion industry, including “increased prices and
unforeseeable disruption in the clothing industry.”28 Justice
Breyer’s dissent stands as a clear warning that the scope of the
majority’s opinion should be kept limited, particularly to avoid
inadvertently extending copyright protection to the protection of the
design of a garment.29 Lower court judges either will pay heed or, as
with other dissenting opinions, the warning may be lost to time.

2017).
25. Star Athletica, slip op. at 12.
26. Id.
27. Id., dissent at 11 (Breyer, J., dissenting).
29. Id., dissent at 8 (“The Constitution grants Congress primary responsibility for
assessing comparative costs and benefits and drawing copyright’s statutory lines. Courts
must respect those lines and not grant copyright protection where Congress has decided not
While it is far too soon to determine the practical impact of *Star Athletica* on the fashion industry, the *Star Athletica* decision may embolden a wider group of designers of useful articles to try using copyright law to enforce rights in two-dimensional or three-dimensional designs covering or decorating fashion articles. This, in turn, would bring new types of designs before the courts to assess. Concomitantly, a nervous population of creators might wonder if they are at greater risk for litigation if they use design elements that—unlike the designs on fabric and the patterns of lace—were previously thought to be so generic as to be outside of copyright law’s reach.

Perhaps even those in the film and television industry might wonder whether they need to get permission from the designer of a color-block dress that an “extra” wears on set, and a designer may have to rack her brain for whether she has seen a similar design of stripes on a jacket before she feels comfortable sending the design out on the runway. Some may worry that the risk may create a stifling effect on creativity and evolution in fashion.

Such unease is understandable. Copyright law can often be a complicated and confusing area of law, and new judicial interpretations that adjust how courts assess infringement often shake up how and to what extent other applicable aspects of copyright law may come into play in a given case. If there is any way to calm the concerns of those in the fashion industry who might believe that they now must rigorously assess copyright risk when designing apparel, that comfort may come in the fact that judges often dig through the multifaceted copyright statutes and cases in order to issue a ruling that brings about results that do not upset the balance that the copyright law endeavors to maintain. Judges who previously seemed compelled to find that almost everything is subject to copyright protection if the item is not fully functional may end up having to assess questions that they might not have before, and they may be more likely to put these questions to a jury rather than resolving them earlier on summary judgment, which can result in increased litigation cost.30 However, even in a strict-liability area of law where intent is irrelevant to liability, policy considerations, as well as “good eyes and common sense,”31 often play heavily in the

to do so. And it is clear that Congress has not extended broad copyright protection to the fashion design industry.”); id. at 9 (“That is why I believe it important to emphasize those parts of the Court’s opinion that limit the scope of its interpretation.”).


31. See Petrella v. Metro-Goldwyn-Mayer, Inc., 572 U.S. ___ (2014), slip op. at 18 (“And the adjudication [of copyright infringement] will often turn on the factfinder’s direct comparison of the original and the infringing works, i.e., on the factfinder’s ‘good eyes and common sense’ in comparing the two works’ ‘total concept and overall feel.’”) (citation omitted).
ultimate outcome. For example, cases where the facts seem superficially similar, such as cases involving secondary liability for copyright infringement on the Internet,\textsuperscript{32} or cases involving wholesale copying of a work,\textsuperscript{33} can often result in different outcomes that, despite the differences, show a clear theme: the flexible nature of the copyright law will generally protect artistic innovation from piracy yet allow for other forms of creativity and innovation to flourish.

The same can be expected here. While we do not know how the Supreme Court would have judged the \textit{Star Athletica} case on the full merits, the fact that the dissent took a strong view about the majority’s application of its test does not mean that we will start seeing absurd results under the majority’s ruling as the law of the land. Specifically, the fact that color-blocks and chevrons on apparel, in the shape of apparel, may be within the scope of copyright protection does not mean that someone who makes garments with similar color-blocks and chevrons is an infringer. The lower courts are quite familiar with identifying the difference between protectable expression in a work and stock elements or themes that are common to a genre. The question for them now, after \textit{Star Athletica}, may no longer be whether the works are within the scope of copyright protection, but whether they are original, whether the portions copied were stock elements that are inherent to the genre, or whether the taking of the copyright-protected elements is \textit{de minimis} or a fair use. Further, as more judicial precedent develops on these additional features inherent in a full analysis of copyright infringement involving useful articles, new patterns and better guidance should, in time, help provide clarity in the law.

Apart from the obligation to accept and apply the letter of the two-element test from the \textit{Star Athletica} holding, there is no reason to think that the courts will materially adjust their full analyses of copyright infringement in fashion cases from how they have analyzed tough questions previously. A case may be assigned to a judge whose assessment of a case is heavily influenced by the types of concerns that led Justice Breyer to dissent, and that may lead to ways to distinguish or limit the application of the \textit{Star Athletica}

\textsuperscript{32} Compare Viacom Int’l, Inc. v. YouTube, Inc., 676 F.3d 19 (2d Cir. 2012) (finding that principals of YouTube were not responsible for the uploading of infringing material on the site), with Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd., 545 U.S. 913 (2005) (holding that designers of a system called Grokster, which was designed to share music files, were secondarily liable for copyright infringement).

\textsuperscript{33} Compare Bridgeport Music, Inc. v. Dimension Films, 410 F.3d 792 (6th Cir. 2005) (finding the use of a short sample from a full song to be infringing), with Authors Guild, Inc. v. Google, Inc., 804 F.3d 202 (2d Cir. 2015), cert. denied, 138 S. Ct. 1658 (2016) (finding that copying vast quantities of copyrighted books in full for purposes of providing research tools falls within copyright infringement exception of “fair use” under Section 107 of the Copyright Act).
holding to the case before her. Alternatively, a judge may apply *Star Athletica* but take a closer look at the other angles of the case—such as originality and whether the copying of copyright-protected elements is “substantial” —to reach an outcome where the plaintiff loses. Of course, with the separability test settled, the analysis of these other aspects of copyright law (originality, merger doctrine, *scènes à faire*, and the like) could end up moving in a variety of directions based on the facts of the case before the court. One could even imagine that the reason why so many different copyrightability tests were created was the desire to get to the “right” result. For example, some cases have found multi-layered prom dresses and casino uniforms not copyrightable, while others have found costumes of all types to fit squarely within copyright protection. And now, per *Star Athletica*, relatively basic shapes integrated into cheerleading uniforms are within the bounds of copyright. This, in turn, raises the question: Did *Star Athletica* clean up a mess, or simply create a new one?

**V. CONCLUSION: CONCEIVING NEW APPROACHES UNDER THE NEW CONCEPTUAL SEPARABILITY TEST**

Those in the fashion industry are right to take notice of the fact that, under the *Star Athletica* test, a design of something is protectable if, in essence, one could imagine it with a picture frame around it or as an art piece displayed on a coffee table in a living room. However, the bright-line nature of the ruling does not necessarily dictate outcomes; it merely shifts the focus rather than foreclosing any debate. For example, a defendant might argue that, consistent with Justice Breyer’s argument, a given design may not be able to be imagined without conjuring up the article itself.34 Whereas a defendant might have previously pushed heavily on the issue of copyrightability, defendants may now seek to adjust their practices by retaining documentation of independent creation or their use of sources that are so old that they—or their components—are in the public domain. Plaintiffs may push more on the elements they have created that seem new or innovative in their aesthetic appearance, while defendants may turn the discussion toward how the design is dictated by the function of covering the body. Finally, while the ruling opens the door to the concept that identical copying of designs may result in liability for the party who engaged in the copying, courts should always keep in mind that one cannot obtain

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34. In the author’s view, the way in which the majority applied the facts in *Star Athletica*—and the fact that the majority elected to apply the facts at all and thereby leave a roadmap for lower courts to follow—makes this argument an uphill battle, but it is worth making if the design of the items in the case that is before the court are sufficiently distinguishable.
copyrights that would give the holder “any rights in the useful article that inspired it.” 35

35. *Star Athletica*, slip op. at 8.