



Supreme Court Eases Copyright Protection For Fashion, Product Designs

By: David Rabinowitz, Eric P. Bergner and Deborah L. Shapiro

Copyright protection for design features of products got a boost last week from the Supreme Court. In a case involving design elements of cheerleaders' uniforms, the Supreme Court held such elements protectable even though they formed part of a product, namely, the uniforms.

While the Copyright Act has long provided protection for design elements of products, the new decision reduced the previously complicated requirements for such protection to one simple rule: If the design element can be imagined separately from the product and if it would still be copyrightable, it is copyrightable. The Court rejected any additional requirements, such as that the design be separately marketable from the product or that it be created independently of "functional influence" (functional design elements, as opposed to ornamental or decorative elements, remain un-copyrightable).

This decision may open the door to broader protection for the decorative or ornamental elements of products including fashion designs jewelry, and furniture. Now is a good time for those in industries using decorative or ornamental designs in or on products to audit those products and designs to see if copyright might be available. Registering copyrights in

designs provides recourse against copyists that otherwise might not be available.

A more detailed discussion of the *Star Athletica* decision follows.

Discussion

On March 22, the Supreme Court issued a 6-2 decision in the cheerleader uniform copyright case, *Star Athletica, L.L.C. v. Varsity Brands, Inc.* The Court upheld the possibility of copyright in two-dimensional design features of a cheerleader uniform. (Whether the particular designs will actually be found copyrightable on remand depends upon whether there is sufficient originality and authorship). This is the first major Supreme Court copyright decision on utilitarian works since *Mazer v. Stein*, 347 U. S. 201 (1954).

The Court described the standard for protection:

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.

Applying this test to the surface decorations on the cheerleading uniforms is straightforward. First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium—for example, on a painter’s canvas—they would qualify as “two-dimensional . . . works of . . . art,” §101. And imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself. Indeed, respondents have applied the designs in this case to other media of expression—different types of clothing—without replicating the uniform. See App. 273–279. The decorations are therefore separable from the uniforms and eligible for copyright protection. (Opinion, pp. 10-11)

The Court went on to give an example of a protectable design element:

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. Failing to protect that art would create an anomaly: It would extend protection to two-dimensional designs that cover a part of a useful article but would not protect the same design if

it covered the entire article. The statute does not support that distinction, nor can it be reconciled with the dissent’s recognition that “artwork printed on a t-shirt” could be protected. *Post*, at 4 (internal quotation marks omitted). (Opinion, pp. 11-12)

This opinion makes it clear that a design feature of a utilitarian object is copyrightable if, when imagined on its own, separate from the object of which it is part or to which it is applied, it satisfies the requirements for copyright – originality and quantum of authorship. This clarifies the current “conceptual separability” test by rejecting the proposition that the design feature is utilitarian (and therefore not copyrightable) if the useful article to which it is applied could not exist or function were the design element removed. The Court holds that the focus is on the design element and not the useful article to which it is applied. (Opinion, pp. 14-15)

The Court also rejected, as criteria for copyrightability, whether the design elements were created independently of “functional influence” or whether the design elements would in isolation be marketable. (Opinion, p. 15)

Finally, the Court confirmed that design patent and copyright “are not mutually exclusive.” (Opinion, p. 17)

This opinion may be significant in expanding the copyrightability of elements of fashion design, which has long been a copyright battlefield. For that industry (whether on the origination or copying side), this opinion may affect their future choices. It certainly encourages both applications to the Copyright Office to register the design elements of utilitarian works and enforcement of copyright claims in such elements.

MOSES & SINGER LLP

Since 1919, [Moses & Singer](#) has provided legal services to diverse types of businesses and high-net-worth individuals. Among the firm's broad array of U.S. and international clients are leaders in banking and finance, entertainment, media, real estate, healthcare, advertising, and the hotel and hospitality industries.

In a world of giant, multi-office law businesses assembled by mergers, built on associate leverage and driven by billable hour quotas, the needs of clients can get lost. Moses & Singer offers a difference. That difference is the attention of leading practitioners-partners in the firm-with the experience and knowledge to provide our clients creative, cost effective, result-oriented representation. The direct involvement of our partners means aggressive, focused problem solving. The firm's attorneys concentrate their practices in the following areas:

- Accounting Law Practice
- Advertising
- Asset Protection
- Banking and Finance
- Business Reorganization, Bankruptcy and Creditors' Rights
- Corporate/M&A
- Employment and Labor
- Entertainment
- Family Office
- Global Outsourcing and Procurement
- Healthcare
- Hospitality, Food Service and Restaurants
- Income Tax
- Intellectual Property
- Internet/Technology
- Legal Ethics and Law Firm Practice
- Litigation
- Matrimonial and Family Law
- Privacy
- Private Funds
- Promotions
- Real Estate
- Securities and Capital Markets
- Securities Litigation
- Trusts and Estates
- White Collar Criminal Defense and Government Investigations

Disclaimer

Viewing this or contacting Moses & Singer LLP does not create an attorney-client relationship.

This is intended as a general comment on certain developments in the law. It does not contain a complete legal analysis or constitute an opinion of Moses & Singer LLP or any member of the firm on the legal issues herein described. This contains information that may be modified or rendered incorrect by future legislative or judicial developments. It is recommended that readers not rely on this general guide in structuring or analyzing individual transactions or matters but that professional advice be sought in connection with any such transaction or matter.

Attorney Advertising

It is possible that under the laws, rules or regulations of certain jurisdictions, this may be construed as an advertisement or solicitation.

Copyright © 2016 Moses & Singer LLP
All Rights Reserved