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Hip, Hip, Hooray for Copyrightable Decorative Elements

After months of standing on the sidelines of the most closely watched case impacting the fashion industry in recent years, legal practitioners and fashion designers now have a framework for protecting decorative elements of apparel.

In a Supreme Court opinion released March 22, Justice Clarence Thomas articulated the two-part test for copyrightability of a feature incorporated into the design of a useful article (such as a piece of clothing):

1. If the feature “can be perceived as a two- or three-dimensional work of art separate from the useful article” to which it is affixed, and
2. If the feature “would qualify as a protectable pictorial, graphic or sculptural work either on its own or in some other medium if imagined separately from the useful article” into which it is incorporated.¹

The opinion resolves a years-long dispute between Varsity Brands, Inc. (Varsity), the nation’s largest supplier of cheerleading apparel, and freshman Star Athletica, L.L.C. (Star Athletica). Varsity initially sued Star Athletica in 2010, alleging that Star Athletica’s uniforms infringed Varsity’s copyrighted designs, which included stripes, chevrons, color combinations and other decorative elements incorporated in cheerleading uniforms. Star Athletica argued that such design elements were inseparably intertwined with the function of the underlying uniforms, and therefore were not eligible for copyright protection.

The lower court rooted for Star Athletica, finding that “the colors-and-designs component of a cheerleading uniform cannot be conceptually separated from the utilitarian object itself,” otherwise the cheerleading uniform becomes a “blank canvas” and “loses its utilitarian function.”² The Sixth Circuit booted that decision, holding that Varsity’s graphic designs are copyrightable because “the graphic features of Varsity’s designs can be identified separately from, and are capable of existing independently of, the utilitarian aspects of cheerleading uniforms.”³

The Supreme Court ultimately declared Varsity the victor, but was careful to limit its ruling: the “two-dimensional work of art fixed in the tangible medium of the uniform fabric” is eligible for copyright protection, but Varsity has “no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut and dimensions to the ones

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¹ *Star Athletica, L.L.C. v. Varsity Brands, Inc., et. al.*, 580 U.S. __, __ (2017) (slip op., at 17)

² *Varsity Brands, Inc., et. al. v. Star Athletica, L.L.C.*, Case No. 10-2508, 2014 WL 819422 (M.D. Tenn. 2010)

³ *Star Athletica, L.L.C. v. Varsity Brands, Inc., et. al.*, 799 F.3d 468 (6th Cir. 2015)

on which the decorations in this case appear.”⁴ The Court notably did not express an opinion as to whether Varsity’s designs met the threshold level of originality required for copyright protection under *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991); it simply held that such designs are separable from the function of a uniform, and thus eligible for protection.

While apparel and accessory designs are still not entirely protectable under US copyright law, this decision may provide a new weapon for designers to combat copycats and counterfeiters. Fashion brands should reevaluate which two- or three-dimensional surface designs in their portfolios may be candidates for copyright filings. Copyrighting such designs may offer an additional enforcement tool, as well as another licensing opportunity.

⁴ *Star Athletica, L.L.C. v. Varsity Brands, Inc., et. al.*, 580 U.S. __, __ (2017) (slip op., at 12)

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