

# Give Me A 'C' (In A Circle): Cheerleader Uniforms At High Court

Law360, New York (May 9, 2016, 11:07 AM ET) --

In August of last year, a Sixth Circuit judge wrote in a dissenting opinion: "It is apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design. The law in this area is a mess — and it has been for a long time." Last week, the U.S. Supreme Court took up the invitation to clarify the law, by granting certiorari in *Star Athletica LLC v. Varsity Brands Inc.* *Star Athletica* concerns whether the designs on cheerleading uniforms can be subject to copyright protection, but the impact of the ruling is likely to spread well beyond uniforms — perhaps beyond garment design to other everyday useful articles.



Eleanor M. Lackman

## Competing Intellectual Property Rights for Apparel

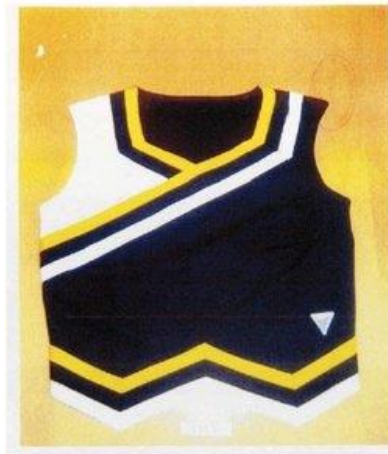
For decades, it has been well understood that apparel and other items in the fashion industry may be subject to several types of protection. A handbag or shoe may receive design patent protection; the design on particular material or the color of a sole of a shoe might be so recognized as to receive trademark or trade dress protection; and the hangtag or label on an item — or even the item itself — might bear several trademarks registered with trademark offices around the world.

Fashion designs do enjoy some well-settled copyright protection as well, in fabric patterns, lace and weave designs, certain designs applied onto a garment, or particular ornamental features that are physically separable from the item. However, garment design itself generally does not enjoy copyright protection in the United States, and recent efforts to amend the Copyright Act to add fashion design have foundered. *Star Athletica* presents a type of middle ground between the protection of a garment design under copyright law, and the protection for designs that may appear on the garment itself. Not surprisingly, the Sixth Circuit struggled in identifying which side of the line the uniforms fell on, and the legal framework that the court had in front of it did not make the task any easier.

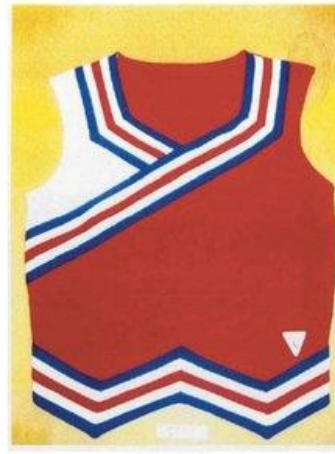
## The "Mess" in the Law for Protection of Useful Articles

The plaintiff-appellant *Varsity Brands* was the owner of several copyright registrations for the designs of cheerleading uniforms.





Design 299B  
Registration No. VA 1-319-226



Design 299A  
Registration No. VA 1-319-228



Design 074  
Registration No. VA 1-411-535

Varsity sued Star Athletica, a competitor, on the ground that Star's designs seemed too similar. The district court found that the designs were integral to the cheerleading uniforms, which themselves served the function of wearing apparel, and that the stripes, chevrons and color-blocking on the uniforms served the functional purpose of identifying the wearer as a cheerleader.

Neither party disagreed that the cheerleading uniforms themselves were "useful articles" under the law, defined under Section 101 of the Copyright Act as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." Rather, the appeal focused on the test for whether the design of a useful article was one that was copyrightable under the test in the statute: where "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." Varsity claimed that the graphic features of its cheerleading-uniform designs were separable; Star claimed that they were not.

With the issue clear, the Sixth Circuit majority turned to the legal tests that guide whether pictorial, graphic, or sculptural features are "separable." The court noted that the question here was not one of "physical separability" — for example in a situation involving a hood ornament that could be removed from an automobile without destroying either — but

“conceptual separability,” in light of the fact that the designs on the uniforms could not be removed from the uniforms themselves. As with patterns on fabric or lace designs, the U.S. Copyright Office has opined that an engraving on a vase, the carving on the back of a chair, or artwork printed on a T-shirt would be conceptually separable and therefore protectable under copyright law.

In the analysis of whether Varsity’s uniform designs met the test of conceptual separability, the Sixth Circuit found a wide-ranging array of approaches across circuits and from scholars. It enumerated nine different tests that focused on amorphous concepts such as consumer perception, the motivation behind the design of an object, the relationship between the functionality of the product and the resulting design, and the motivation of a consumer behind purchasing the object. Complicating matters, the court further noted that in some cases, courts adopted multiple tests to apply a “hybrid” test to the question before the court. The Second Circuit applied three tests in finding that Halloween costumes made to look like stuffed toy animals were protectable, and affirmed a ruling applying four tests in concluding that the patterns and layering of tulle in prom dresses were not copyrightable. The Fourth Circuit took two tests in finding that decorative elements adorning furniture were copyrightable. The majority concluded that it would adopt a similar “hybrid” approach — in the form of a five-question test — to the analysis of whether an artistic design is conceptually separable from the utilitarian aspects of the article.

Under its new test, the court rejected the argument that the designs on the uniform were inextricably intertwined with the uniform itself, and that the decorative function of the designs does not make them unprotectable. Nor did the designs enhance the functionality of the uniforms, according to the majority. After all, they could be identified as graphic designs separate from the design as integrated on the uniform itself. The majority concluded that the arrangement of stripes, chevrons, color blocks, and zigzags could exist independently of the utilitarian aspects of a cheerleading uniform. In essence, to the majority, the uniform designs were more like fabric design within a garment (which is protectable) than the overall garment design (which is not).

Judge David McKeague disagreed with the majority’s conclusion, finding that it is the design of the uniform that allows a person to identify the wearer as a cheerleader — as opposed to someone who might be playing a tennis match in an all-white outfit. He cited to the Fifth Circuit’s ruling that casino uniforms are not copyrightable due to their function to serve as a casino uniform, and to the Second Circuit’s ruling that the designs on a prom dress are integral to the function of covering the body in an attractive way for a special occasion. In the judge’s view, the various designs on the uniform were no different: they identify the wearer as a member of a particular cheerleading squad. Struggling with the contours of the definition of “function,” Judge McKeague pointed to the struggle by the majority and the dissent in sorting out the law, noting that “until we get much-needed clarification, courts will continue to struggle and the business world will continue to be handicapped by the uncertainty of the law.”

## **The Supreme Court’s Upcoming Review**

On the back of the split-panel ruling, Star Athletica petitioned the Supreme Court to grant certiorari on two questions. The petition was granted on the first: “What is the appropriate test to determine when a feature of a useful article is protectable under Section 101 of the Copyright Act?”

Undoubtedly the court will endeavor to fix the “mess” that Judge McKeague identified — a “mess” that now includes arguably 10 or more tests that a court may apply separately or in “hybrid” fashion. However, the way the question is posed also allows the court to look broadly at the issue of conceptual separability — a topic that the court has not taken up since its decision in *Mazer v. Stein* over 60 years ago, and for the first time since the passage of the current Copyright Act in 1976. The array of goods that the ruling could affect is wide-ranging: from household furnishings and lighting (such as decorative lamps in *Mazer*), to apparel, to glassware and salt-and-pepper shakers, to audio devices and automobiles, to 3-D-printed objects. The case has been set for argument in the October

term of 2016, and the questions posed will provide further insight as to how broadly the court intends its resulting opinion to apply.

## Conclusion

The Supreme Court's pending opinion in *Star Athletica v. Varsity Brands, Inc.* should help provide uniformity to the way in which lower courts analyze whether a design is conceptually separable from its utilitarian function. Given the high demand for high design in everyday objects, developing a test that is uniform and consistent with the contours of copyright law will be no easy task. The court must take care not to encroach on design patent law or disrupt stakeholders' long-standing expectations that, among other things, fabric designs are copyright-protected while the design of the garments that may incorporate the fabric are not.

In *Star Athletica's* petition for certiorari, *Star* claimed, "industrial designers can claim copyright protection in the Sixth Circuit for pleats on tennis skirts, button patterns on golf shirts, and colored patches on rugby uniforms," and that the arrangement of stripes and color blocks could provide protection for "band uniforms to everyday apparel." But that may not be so, not under the Sixth Circuit's opinion itself, and perhaps not even if *Varsity* prevails before the court. A win for *Varsity* does not mean that the case is over. Far from it: The Sixth Circuit did not address whether *Varsity's* designs were unoriginal, and therefore unprotectable, because the district court had declined to address the question. Nor did the parties address the originality of the designs as to either party. Accordingly, it is entirely possible that — had the questions been answered — *Varsity* might have lost the case anyway. For example, *Varsity's* designs could have been so basic as to not rise to the level of creativity to receive copyright protection, or may be otherwise subject to the merger doctrine; moreover, *Varsity's* designs could have been based on other designs, making them either wholly unoriginal or entitled to only thin protection, or *Star Athletica* arguably could have independently created the designs.

Without rulings from the district court or the appellate court on these issues, we will have to wait even longer to find out whether *Varsity* — even if its designs are ruled conceptually separable — might find its copyright registrations either subject to attack or otherwise of minimal enforceability, issues that will persist in "useful article" cases long after the Supreme Court rules.

—By Eleanor M. Lackman, Cowan DeBaets Abrahams & Sheppard LLP

*Eleanor Lackman is a partner in the litigation, copyright and trademark groups in Cowan DeBaets' New York office.*

*The opinions expressed are those of the author(s) and do not necessarily reflect the views of the firm, its clients, or Portfolio Media Inc., or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.*

---

All Content © 2003-2016, Portfolio Media, Inc.