

# Sense and Separability: Clarifying *Star Athletica* Amongst Lower Court Confusion

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## INTRODUCTION

Copyright law is designed to protect the artistic, the creative. For centuries, courts have been careful to avoid granting copyright protection to systems or processes better suited to patent protection.<sup>1</sup> For instance, in a book explaining how to build a house, the text of the book as creative expression would be copyrightable. However, copyright protection would not extend to the actual system or process for building the house. This idea-expression dichotomy becomes more complicated in cases of useful articles with design elements.<sup>2</sup> In the 1954 case *Mazer v. Stein*, the Supreme Court first addressed the need to physically and/or mentally separate the utilitarian and ornamental elements to determine which aspects, if any, may be copyrighted.<sup>3</sup> This case led to the codification of separability in the Copyright Act of 1976; § 101 requires that a copyrightable pictorial, graphic, and sculptural work (“PGS work”) contain “sculptural features that can be identified separately from, and are capable of existing

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1. See *Baker v. Selden*, 101 U.S. 99, 102 (1879) (“To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright.”).

2. A “useful article” is an item with a utilitarian function: a shovel, a chair, even a t-shirt. Useful articles on their own are not copyrightable. However, a wrinkle emerged as creators wished to copyright creative design elements adorning or comprising their useful articles (think: a t-shirt with an original creative design printed on it, or a lamp base that is a statuette of a dancer, as we see in *Mazer v. Stein*, 347 U.S. 201 (1954)).

3. *Mazer*, 347 U.S. at 213–14 (“The successive acts, the legislative history of the 1909 Act and the practice of the Copyright Office unite to show that ‘works of art’ and ‘reproductions of works of art’ are terms that were intended by Congress to include the authority to copyright these statuettes . . . Such expression, whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color, is copyrightable.”).

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independently of, the utilitarian aspects of the article.”<sup>4</sup> Despite this attempt at clarification, a nine-way circuit split emerged, with courts—as well as the Copyright Office itself—taking various approaches to the separability analysis.<sup>5</sup> In fact, the Second Circuit developed three different approaches itself, each attempting to identify the supremacy of the artistic or creative elements over the utilitarian aspects of a work in order to award it copyright protection.<sup>6</sup>

In order to resolve this widespread confusion, the Supreme Court laid out its test for conceptual separability in *Star Athletica v. Varsity Brands*: an artistic design feature of a useful article is copyrightable if it: (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 in some other medium if imaged separately from the useful article.”<sup>7</sup> This opinion has had far-reaching effects on lower courts trying to make sense of separability. This lower court confusion highlights the lack of clarity in the *Star Athletica* opinion.

This Note begins in Part I with a background of the development of copyright law, with particular emphasis on separability, followed by an analysis of the *Star Athletica* majority opinion, concurrence, and dissent. I argue that the *Star Athletica* decision fails to achieve the widespread clarity it had intended. Part II supports this assertion by identifying and analyzing lingering areas of confusion among lower courts attempting to implement the Supreme Court’s holding: furniture and interior design, and geometric patterns on useful articles. Part III weighs various solutions to better harmonize the lower courts in these key areas. This Note argues that the most ideal solution is to amend the copyright statute utilizing the Second Circuit’s approach of finding more concrete proxies for the ambiguous concepts of *separate identity* and *independent existence*. This way, copyright law can more effectively protect the artistic and creative while avoiding the purely utilitarian.

## I. BACKGROUND

### A. COPYRIGHT LAW PRE-*STAR ATHLETICA*

#### 1. Pre-1976

Copyright law has its constitutional basis in Article I, section 8, in which the Nation’s Founders endowed Congress with the power to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the

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4. 17 U.S.C. § 101.

5. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484–85 (6th Cir. 2015) (describing the various approaches to the separability analysis).

6. *See generally* *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980); *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411 (2d Cir. 1985); *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

7. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 424 (2017).

exclusive Right to their respective Writings and Discoveries.”<sup>8</sup> This clause makes clear that intellectual property protection should not be permanent, but should grant some form of exclusivity while it is active. The Founders also clearly differentiated scientific inventions from the writings of authors.

The Copyright Act of 1909 governed copyright prior to the passing of the current Copyright Act of 1976. Under the 1909 Act, the requirements for a work to be copyrighted borrowed heavily from the constitutional language, specifying “[t]hat the works for which copyright may be secured under this Act shall include all the writings of an author.”<sup>9</sup> Despite the apparent narrowness of the term “writings,” courts were willing to grant copyright protection to works of creative expression in a variety of media.<sup>10</sup>

The 1909 Act did not explicitly address ornamental designs on useful articles; in fact, this was an area of confusion for courts, creatives, and the Copyright Office itself. The Act protected “works of art; models or designs for works of art,” implying that copyright protection may extend beyond the purely aesthetic.<sup>11</sup> However, in 1910, the Copyright Office issued a regulation narrowing its interpretation of “works of art” to only the fine arts.<sup>12</sup> Despite this regulation, the Copyright Office was still granting copyright registrations to utilitarian objects such as salt shakers, clocks, and candlesticks.<sup>13</sup> Courts took varying approaches to address this discrepancy; some adhered to the “fine arts only” view expressed in the 1910 Bulletin while others expanded their view of art to works with utilitarian function.<sup>14</sup> In 1948, the Copyright Office issued a regulation allowing the copyrightability of works of “artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned.”<sup>15</sup>

8. U.S. CONST. art. I, § 8, cl. 8 (punctuation changed).

9. Copyright Act of 1909, Pub. L. No. 60-349, § 4, 35 Stat. 1075, 1076 (1909) (prior to repeal by 1976 Act).

10. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) (extending copyright protection to photographs: “[N]o one would now claim that the word ‘writing’ in this clause of the constitution, though the only word used as to subjects in regard to which authors are to be secured, is limited to the actual script of the author, and excludes books and all other printed matter. By writings in that clause is meant the literary productions of those authors, and congress very properly has declared these to include all forms of writing, printing, engravings, etchings, etc., by which the ideas in the mind of the author are given visible expression . . . We entertain no doubt that the constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original . . . conceptions of the author.”).

11. Copyright Act of 1909 § 5(g).

12. U.S. COPYRIGHT OFF., BULL. NO. 15, RULES AND REGULATIONS FOR THE REGISTRATION OF CLAIMS TO COPYRIGHT 8 (1910); see also Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC’Y U.S.A. 339, 342 (1990).

13. Perlmutter, *supra* note 12, at 342–43.

14. Perlmutter, *supra* note 12, at 343. See *Pellegrini v. Allegrini*, 2 F.2d 610 (E.D. Pa. 1924); see also *Kemp & Beatley, Inc. v. Hirsch*, 34 F.2d 291 (E.D.N.Y. 1929).

15. Thomas S. Key, *Trudging Through the Thicket: Copyright Protection for Designs of Useful Articles in the Wake of Star Athletica*, 49 AIPLA Q.J. 55, 60 (2021) (quoting 37 C.F.R. § 202.8 (1949)).

In *Mazer v. Stein* (1954), the Supreme Court first addressed the concept of separability.<sup>16</sup> The case concerns statuettes of dancing figures that served as a base for functioning table lamps.<sup>17</sup> The statuettes were submitted for copyright registration without the functional lamp features (wiring, lampshade, etc.) included.<sup>18</sup> The Court held that the statuettes were copyrightable, despite serving as the base of a lamp and being sold as such, because they were sculptural works eligible for copyright separate from the utilitarian function of the lamp.<sup>19</sup>

## 2. The Copyright Act of 1976

The *Mazer* decision was incorporated into the Copyright Act of 1976 to create a formal separability standard. The statutory definition of “pictorial, graphic, and sculptural works” specifies that for “works of artistic craftsmanship,” the “form” may be eligible for copyright protection, but not any “mechanical or utilitarian aspects.”<sup>20</sup> The definition then lays out more specific requirements for separability: that the pictorial, graphic, or sculptural features “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”<sup>21</sup> The House Report accompanying the Act explains that either physical or conceptual separability can be a basis for finding copyright protection of a pictorial, graphic, or sculptural work.<sup>22</sup>

## 3. Circuit Confusion Pre-*Star Athletica*

While the 1976 Act attempts to “draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design,”<sup>23</sup> the Act’s language has been confusing in its application; prior to the *Star Athletica* decision, there was a circuit split with at least nine different tests for separability. The Sixth Circuit pinpoints the following different approaches to separability in its approach to the *Star Athletica* dispute.<sup>24</sup>

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16. *Mazer v. Stein*, 347 U.S. 201, 205 (1954) (“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.”).

17. *Id.* at 202.

18. *Id.*

19. *Id.* at 217.

20. 17 U.S.C. § 101.

21. *Id.*

22. H.R. REP. NO. 94-1476, at 55 (1976) (“A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statute or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art.”).

23. *Id.*

24. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484–85 (6th Cir. 2015).

a. *The Copyright Office*

The Copyright Office asserts that the conceptual separability requirement is met only if the pictorial, graphic, or sculptural element and the useful article “could both exist side by side and be perceived as fully realized, separate works.”<sup>25</sup> This approach implies an at least somewhat physical approach to separability. A design element that only exhibits conceptual separability would be unlikely to satisfy a requirement of “existing side by side.”

b. *D.C. Circuit*

The D.C. Circuit expresses a similar distaste for conceptual separability in *Esquire v. Ringer*, a pre-1976 case in which the court conducts a separability analysis.<sup>26</sup> The court upheld the Copyright Register’s decision to refuse to extend copyright protection to the shape of a useful article, no matter how “unique [or] attractively shaped” it may be.<sup>27</sup> This decision appears to reject conceptual separability entirely.

c. *Second Circuit*

The Second Circuit has taken three distinct approaches to conceptual separability: the primary-subsidiary approach (*Kieselstein-Cord*), the objectively necessary approach (*Carol Barnhart*), and the design-process approach (*Brandir*).<sup>28</sup> Each of the three approaches attempts to find a proxy for the ambiguous concepts of “identified separately from” and “existing independently of.”<sup>29</sup> The *Kieselstein-Cord* court determined that there was conceptual separability if the artistic features are “primary” to the object, and the utilitarian feature is “subsidiary.”<sup>30</sup> In *Carol Barnhart*, the court found conceptual separability where the artistic features of the design are not necessary to the performance of the utilitarian function.<sup>31</sup> The Sixth Circuit in *Varsity Brands* also considers the approach taken by Judge Newman in his dissent: that there is conceptual separability if “the design creates in the mind of the ordinary [reasonable] observer two different concepts that are not inevitably entertained simultaneously.”<sup>32</sup> Finally, the *Brandir* court held that there is conceptual separability if the pictorial, graphic, or sculptural elements reflect the artistic choices of the designer, and are not purely a result

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25. *Id.* at 484 (citing U.S. COPYRIGHT OFF., COMPENDIUM OF U.S. COPYRIGHT OFF. PRACS. § 924.2(B) (2014)).

26. *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978).

27. *Id.* at 800.

28. See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980); *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411 (2d Cir. 1985); *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

29. See 17 U.S.C. § 101.

30. *Kieselstein-Cord*, 632 F.2d at 993.

31. *Carol Barnhart*, 773 F.2d at 419.

32. *Id.* at 422 (Newman, J., dissenting); see also *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484 (2015).

of functionality.<sup>33</sup> In *Brandir*, the court declined to find a bicycle rack copyrightable because its design, while arguably creative, was purely a result of the utilitarian goal of fitting as many bicycles on the rack as possible.<sup>34</sup>

*d. Fifth Circuit*

In *Galiano*, the Fifth Circuit focused on marketability as the requirement for separability: conceptual separability exists if the artistic elements of the useful article would still be marketable without the utilitarian elements to generate appeal (as adapted from *Nimmer on Copyright*).<sup>35</sup> This approach establishes potential market value as a proxy for independent existence of a design element.

*e. Seventh Circuit*

Judge Kanne's dissent in *Pivot Point* provides another option for analyzing conceptual separability.<sup>36</sup> In this test, there is conceptual separability if "the useful article's functionality remain[s] intact" without the design element.<sup>37</sup>

*f. Sixth Circuit*

In its *Varsity Brands* opinion, the Sixth Circuit decided that the cheerleading uniforms at issue were eligible for copyright protection even if they cannot be physically separated from the useful article. The decision explicitly recognized conceptual separability as a sole basis for copyright protection of a pictorial, graphic, or sculptural work.<sup>38</sup> The Sixth Circuit grounded its analysis in the text of the Copyright Act itself: first, it determined whether the uniforms would be considered useful articles.<sup>39</sup> After determining that the uniforms were indeed useful articles, it chose to adopt the *Carol Barnhart* objectively necessary approach to answer the question of independent existence. The Sixth Circuit also found *Brandir's* design-process approach

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33. *Brandir*, 834 F.2d at 1147–48.

34. *Id.*

35. *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 417 (5th Cir. 2005) (quoting 1 NIMMER ON COPYRIGHT § 2.08[B][3], at 2–101 (2004)).

36. *Pivot Point Int'l Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004) (Kanne, J., dissenting).

37. *Id.* at 934 (Kanne, J., dissenting). The *Pivot Point* majority follows the Second Circuit, combining the *Brandir* and *Carol Barnhart* tests to assert that "[i]f the [design] elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is 'as much the result of utilitarian pressures as aesthetic choices,' the useful and aesthetic elements are not conceptually separable." *Id.* at 931 (quotation omitted).

38. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 493 (6th Cir. 2015).

39. *Id.* at 487. The Sixth Circuit leaned on the definition of useful article found in 17 U.S.C. § 102: "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."

helpful, but not instructive.<sup>40</sup> Finally, the court leaned on the Copyright Office's approach to separability: that the artistic and utilitarian features could "both exist side by side."<sup>41</sup>

Respondent, Varsity Brands, a manufacturer of cheerleading uniforms, brought suit against competing manufacturer Star Athletica for alleged infringement of their copyrighted uniform designs.<sup>42</sup> Varsity Brands, at the time of suit, possessed over 200 copyright registrations for various designs containing chevrons, lines, and other shapes.<sup>43</sup> At issue was whether these designs, adorning the "useful article" of a cheerleading uniform, are in fact copyright protectable.

## B. THE *STAR ATHLETICA* DECISION

### 1. Justice Thomas's Majority Opinion

The *Star Athletica* majority opinion, penned by Justice Thomas, seeks to "resolve widespread disagreement" over the 1976 Act's separability standard through a two-part test.<sup>44</sup> The Supreme Court articulates its test as follows:

[A] feature incorporated into the design of a useful article is eligible for copyright protection only 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.<sup>45</sup>

Throughout the opinion, Justice Thomas takes a textualist approach, asserting that the text of the statute is clear and the application of his two-part test to cheerleading uniforms is "straightforward."<sup>46</sup> As to the first step, he encounters no difficulty imagining the designs separately from the uniforms. Though the second step is more complicated, Justice Thomas finds it similarly clear to apply. He asserts that if the designs were removed from the uniform and painted onto a canvas, that would be a work of art that is different from the uniform.<sup>47</sup> The majority then rebuts an argument by the dissent—one that is shared by the Petitioner—that there is no separability because any reproduction of the uniform designs in another medium would necessarily recreate the uniform itself.<sup>48</sup> The dissent asserts that a painting of the chevron patterns

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40. *Id.* at 488 ("The design-process approach may also help courts determine whether a design feature is necessary to the utilitarian aspects of the article . . . But we do not endorse the design-process approach in its entirety.").

41. *Id.* at 488–89 (quoting COMPENDIUM, *supra* note 25).

42. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 405 (2017).

43. *Id.*

44. *Id.* at 409.

45. *Id.*

46. *Id.* at 417.

47. *Id.*

48. *Id.*

of the uniform would appear to be a painting of the uniform because the designs are so closely intertwined with the cut and shape of the uniform.<sup>49</sup> Justice Thomas acknowledges that this may be true, but: “[T]his is not a bar to copyright.”<sup>50</sup> He argues that although the shape of the object played in a role in how the artistic feature is designed, the uniform designs are still copyrightable.

Justice Thomas then attempts to cabin the opinion—and reiterate the ultimate goal of separability—by pointing out that copyright protection only applies to “the two-dimensional work of art fixed in the tangible medium of the uniform fabric.”<sup>51</sup> Any other person or entity can manufacture a cheerleading uniform with the same shape or cut without violating the copyright; they just cannot reproduce the surface decorations on or using any medium.

Justice Thomas also acknowledges the disagreement among the parties to the case as well as the Sixth Circuit regarding the function of the uniforms to signal to others that the wearer is a cheerleader.<sup>52</sup> While he lays out both arguments in detail, he ultimately appears to eschew the debate altogether, stating that “[t]he debate over the relative utility of a plain white cheerleading uniform is unnecessary.”<sup>53</sup> He believes that whether the signaling function is a utilitarian feature is irrelevant, as the cheerleading uniform is a useful article regardless. Further, he asserts that the portion of the useful article “left behind” after separation from design elements need not even be a fully functioning useful article. Overall, Justice Thomas appears to take an overly permissive view of the separability analysis; all that is required for copyright protection is the capacity to imagine the design separately, and the possibility of it being recreated in another medium as a work of art.

## 2. Justice Ginsburg’s Concurrence

While Justice Ginsburg concurs in the judgment that the designs on the cheerleading uniforms are copyrightable, she does not see a need to reach the question of separability at all.<sup>54</sup> She views the designs at issue as pictorial, graphic, or sculptural works that were simply reproduced on useful articles, not designs of useful articles themselves.<sup>55</sup> She specifically points out that the designs were originally sketched on pieces of paper, and were copyrighted as two-dimensional works of art.<sup>56</sup>

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49. *Id.* at 448 (Breyer, J., dissenting).

50. *Id.* at 418.

51. *Id.* at 419.

52. *Id.* at 420.

53. *Id.*

54. *Id.* at 425 (Ginsburg, J., concurring).

55. *Id.* (Ginsburg, J., concurring).

56. *Id.* at 426 (Ginsburg, J., concurring).



### 3. Justice Breyer's Dissent

In his dissenting opinion, Justice Breyer argues that under the majority's own test for separability, the designs at issue cannot be copyrightable because they would fail step one.<sup>57</sup> Specifically, the designs on the uniforms cannot be perceived separately from the utilitarian aspects of the uniforms because to reproduce the designs just reproduces something that can only be seen as a cheerleading uniform.

In analyzing the majority's test, Justice Breyer identifies "two exercises" that judges must undergo to determine separability.<sup>58</sup> There is first the physical exercise of determining whether the design element can be physically separated from the useful article. For this exercise, Justice Breyer provides the example of a lamp with a Siamese cat figure sitting on top of the lamp base.<sup>59</sup> There is also the mental exercise of determining conceptual separability, which is much more abstract. Can the design element be conceived of separately even if doing so would damage the design element and/or the useful article?<sup>60</sup> In this exercise, Justice Breyer alters his lamp example to have the Siamese cat form the base itself, with wires running through it. While this lamp would demonstrate conceptual separability, Justice Breyer contrasts it from objects like heart-shaped measuring spoons or boat-shaped candleholders that do not exhibit conceptual separability.<sup>61</sup>

Justice Breyer is critical of the majority's focus on whether the design can be thought of as a two- or three-dimensional work of art; he argues that this test is far too permissive to provide helpful guidance.<sup>62</sup> Instead, he sees the conceptual separability question as whether the design features can exist separably from the useful article without "bringing along" the useful article they are adorning.<sup>63</sup> In his view, the cheerleading uniform designs fail this test. The designs were created with the shape of the uniform in mind, and upon transferring the designs to another medium, this shape is replicated. Further, Justice Breyer expresses doubt that the geometric shapes of the designs are creative enough to be copyrightable if they had been submitted as a two-dimensional work of art.<sup>64</sup>

Inherent in the dissent is Justice Breyer's view that the designs function to support the utilitarian purpose of the uniforms. Because they are so intertwined that they cannot be reproduced without reproducing the uniform, they are not works of art that happen to exist on the uniforms, but rather designs that enhance the functionality of the uniform.

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57. *Id.* at 439 (Breyer, J., dissenting).

58. *Id.* at 440 (Breyer, J., dissenting).

59. *Id.* at 441 (Breyer, J., dissenting).

60. *Id.* (Breyer, J., dissenting).

61. Justice Breyer explains that there is no conceptual separability when the design itself makes up the shape of the useful article, or "necessarily bring[s] along the underlying utilitarian object." *Id.* at 442-43 (Breyer, J., dissenting).

62. *Id.* at 444 (Breyer, J., dissenting).

63. *Id.* at 447 (Breyer, J., dissenting).

64. *Id.* at 448 (Breyer, J., dissenting).

#### 4. The Opinions: Differing Approaches to Separability

Justice Thomas's view that copyright is not barred when a reproduction of the uniform's designs would necessarily recreate the shape of the uniform appears to conflict with the Second Circuit's design-process approach in *Brandir*. The *Brandir* court is wary of artists receiving copyright protection for features stemming from functionality instead of creative choice.<sup>65</sup> However, Justice Thomas does not seem to share that concern, as the level of intertwinement between the uniform designs and the uniforms themselves does not weigh on his copyright analysis. Conversely, Justice Breyer seems to echo a similar sentiment to the Second Circuit when he declines to extend copyright protection in *Star Athletica*. If a design of a useful article is so closely interlaced with the useful article that reproducing it also reproduces a version of that useful article, it can be inferred that much of the "creative" choice put into the design actually stems from the practical limitations or guidelines imposed by utilitarian elements themselves.

Additionally, Justice Breyer and Justice Ginsburg take differing approaches to separability based on which element "came first." In *Star Athletica*, Justice Ginsburg argues that because the designs were originally sketched in two dimensions on paper, they are copyrightable pictorial, graphic, or sculptural works.<sup>66</sup> Whether those designs were eventually applied to a useful article is not relevant to her analysis. Conversely, Justice Breyer asserts that the designs were created with the uniforms in mind, and depend so thoroughly on the shape and cut of the uniform that they cannot be imagined separately.<sup>67</sup> These differing views on which element came first and how that chronology in turn affects the separability analysis presents a "chicken or the egg" issue that is likely to confuse lower courts.

Finally, both Justice Thomas's and Justice Breyer's opinions invite a discussion of the merger doctrine, which stems from the idea-expression dichotomy first addressed by the Supreme Court in *Baker v. Selden*.<sup>68</sup> The merger doctrine states, essentially, that while copyright protects expression and not ideas, if there are a limited number of ways to express an idea, the expression may merge with the idea itself and therefore become uncopyrightable.<sup>69</sup> Varsity Brands copyrighted its designs containing "chevrons . . . ,

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65. See *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987) ("While the RIBBON Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices.").

66. *Star Athletica*, 580 U.S. at 426 (Ginsburg, J., concurring).

67. *Id.* at 439 (Breyer, J., dissenting).

68. 101 U.S. 99, 107 (1879). In this case, the Court held that blank account books could not be copyrighted because they represented Selden's system of bookkeeping, and therefore were an idea, not the expression of an idea (the latter of which would be copyright eligible).

69. See *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967) ("When the uncopyrightable subject matter is very narrow, so that 'the topic necessarily requires,' if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party of parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance . . . We cannot recognize copyright as a game of chess in which the public can be checkmated.") (citations omitted).

lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring, and shapes”—all common geometric elements for cheerleading uniforms.<sup>70</sup> It could be argued that only a finite number of arrangements of these elements would effectively serve as designs for cheerleading uniforms, as the uniforms need to be distinctive from regular dresses or athletic wear to serve their purpose of identifying the cheerleader. If signaling the wearer’s position as a cheerleader is a valid utilitarian function (the Sixth Circuit ruled it was not<sup>71</sup>), then copyrighting these designs may be prohibiting other companies from achieving this signaling purpose by making many of the most effective designs “off-limits.”

### C. WHERE THAT LEAVES US

While *Star Athletica* presents many follow-up questions and points of confusion for lower courts, the majority opinion appears to pave the way for expanded copyright protection of clothing items and costumes, areas that previously were seemingly off-limits to copyright.

The Supreme Court granting cert on *Star Athletica* was an opportunity to clarify the separability analysis in a lasting way. While Justice Thomas saw clarity in the case at hand and the two-part test he put forward, lower courts have struggled to find that same clarity in their own separability analyses.

## II. DISCREPANCIES AMONG LOWER COURTS

### A. MAJOR POST-STAR ATHLETICA OPINIONS

Post-*Star Athletica*, courts have become more permissive in allowing copyright protection for costumes.<sup>72</sup> In *Silvertop*, the Third Circuit upheld copyright protection for a banana costume.<sup>73</sup> The court acknowledged a previous Second Circuit case in which the court declined to address the copyrightability of costumes, but expressed that clothing items more generally are “particularly unlikely” to meet the separability tests: “[T]he very decorative elements that stand out [are] intrinsic to the decorative function

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70. *Star Athletica*, 580 U.S. at 410 (ellipsis in original).

71. The Sixth Circuit asserts in its *Varsity Brands* decision that the function of the uniforms to identify someone as a cheerleader is not a valid utilitarian function under the Copyright Act because it merely “convey[s] information.” *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015).

72. Based on the *Star Athletica* majority opinion, this is a fair assessment by courts. The opinion itself states that the first requirement of separate identification “is not onerous”; merely identifying any element that has pictorial, graphic, or sculptural qualities is sufficient. *Star Athletica*, 580 U.S. at 414. As to step two, the Court observes that the “the independent-existence requirement is ordinarily more difficult to satisfy. *Id.* However, at this step, the Court is only looking for a PGS work that could have been created in a medium other than the useful article it is part of. *Id.* at 415. Under these guidelines, it seems inevitable that lower courts would deem costumes as meeting these permissive standards.

73. *Silvertop Assocs., Inc. v. Kangaroo Mfg., Inc.*, 931 F.3d 215, 222 (3d Cir. 2019).

of the clothing.<sup>74</sup> The *Silvertop* court found that *Star Athletica* barred them from utilizing such an approach.<sup>75</sup> The opinion does not delve into the separability analysis, only acknowledging that the costume has sculptural elements that can be copyrightable.<sup>76</sup> The Eastern District of New York found *Silvertop* instructive when it was tasked with a copyright claim from a company selling Halloween costumes, undergoing a separability analysis to find protectable elements on the costumes at issue.<sup>77</sup> The *Silvertop* court expressed that while it believed clothing items were still not generally copyrightable, pictorial, graphic, or sculptural features of costumes have become an “exception” after *Star Athletica*.<sup>78</sup>

While courts have become more permissive in the area of costumes, they still show hesitance to allow the copyrightability of items better suited for patent protection. The Federal Circuit held in *Lanard Toys* that a toy chalk holder shaped like a pencil was not protectable under copyright law.<sup>79</sup> The court determined that because the copyright was for the chalk holder itself, it was invalid; under *Star Athletica*, “the feature cannot itself be a useful article.”<sup>80</sup> Similarly, the Southern District of New York declined to extend copyright protection to a control panel operating a dryer.<sup>81</sup> The court held that the control panel could not exist independently of the utilitarian features because the panel itself was inherently utilitarian.<sup>82</sup>

## B. AREAS OF LOWER COURT CONFUSION

While lower courts appear to be unified in how they now approach the copyrightability of costumes and fully-utilitarian patentable devices, there is mounting confusion in two major areas: decorative furniture or interior design, and geometric designs on useful articles.

### 1. Decorative Furniture and Interior Design

Lower courts have experienced significant confusion in determining separability of artistic design elements of furniture items or interior design features. In *Jetmax*, the Southern District of New York considered separability of teardrop-shaped covers for

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74. *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989).

75. *Silvertop*, 931 F.3d at 222.

76. *Id.* While the Third Circuit does not engage in the separability analysis, this was done at the district level. The district court noted that the combination of multiple features—the overall shape, length, black color on the ends, soft and smooth appearance of the fabric, and the color—is distinct from a natural banana and demonstrates sufficient creativity. *Silvertop Assocs., Inc. v. Kangaroo Mfg., Inc.*, 319 F. Supp. 3d 754, 764–65 (D.N.J. 2018).

77. *Diamond Collection, LLC v. Underwraps Costume Corp.*, No. 17-CV-0061 (JS) (SIL), 2019 WL 347503, at \*4 (E.D.N.Y. Jan. 22, 2019).

78. *Silvertop Assocs., Inc. v. Kangaroo Mfg., Inc.*, 931 F.3d 215, 222 (3d Cir. 2019).

79. *Lanard Toys, Ltd. v. Dolgencorp LLC*, 958 F.3d 1337, 1346 (Fed. Cir. 2020).

80. *Id.* (quoting *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 415 (2017)).

81. *Town & Country Linen Corp. v. Ingenious Designs LLC*, 436 F. Supp. 3d 653, 664–65 (S.D.N.Y. 2020).

82. *Id.*

string lights.<sup>83</sup> Defendants in this case argued that the light set is not copyrightable because it is a useful article and lacks originality.<sup>84</sup> The court utilized the then-brand-new *Star Athletica* opinion to conduct a separability analysis. It was found that the light covers are sculptural elements that may be separated from the utilitarian features of the lights themselves.<sup>85</sup> The *Jetmax* court took a more literal or physical approach to separability than was taken in *Star Athletica*, determining that the covers can be separated because their purpose is almost purely decorative and they can be removed from the lights, leaving them still functional.<sup>86</sup>

The Central District of California similarly found copyright protectability in lampshades.<sup>87</sup> The *Corinna Warm* court admits to confusion in conducting its separability analysis: “[W]hat satisfies the ‘independent-existence requirement’ of *Star Athletica* is not yet well-defined in the context of the extreme breadth with which something can be construed to be a sculpture or sculptural.”<sup>88</sup> Despite this challenge, the court asserts that the lampshades are copyrightable because they can be separated from the useful article, the core lamp features of the bulb, wires, and base.<sup>89</sup> Defendants argue that lampshades are themselves utilitarian, as they serve the function of softening the harsh light from the bulb.<sup>90</sup> The court concedes that “a lampshade is indeed part of a useful article,” but extends copyright protection because the lampshades could hypothetically exist as sculptures in another medium.<sup>91</sup> *Corinna Warm* is a prime example of lingering court confusion; despite a lampshade serving a primarily (and undeniable) utilitarian purpose, the court upholds copyright merely because a sculpture of the same shape could exist and be considered a work of art.<sup>92</sup>

## 2. Geometric Designs on Useful Articles

There has also been confusion as to the treatment of geometric patterns adorning useful articles, both in terms of copyrightability of the geometric patterns themselves as well as their separability from the useful article. The District of New Jersey held that

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83. *Jetmax Ltd. v. Big Lots, Inc.*, No. 15-cv-9597, 2017 WL 3726756, at \*1 (S.D.N.Y. Aug. 28, 2017).

84. *Id.* at \*3.

85. *Id.* at \*6.

86. *Id.* at \*6. *See also Star Athletica*, 580 U.S. at 422 (undermining the physicality of separability: “The statutory text indicates that separability is a conceptual undertaking.”).

87. *Corinna Warm and Studio Warm LLC v. Innermost Ltd.*, No. 21-cv-4402, 2022 WL 2062914, at \*1 (C.D. Cal. Apr. 26, 2022).

88. *Id.* at \*3.

89. *Id.*

90. *See id.*

91. *Id.*

92. It is also worth noting that *Star Athletica* has been used by lower courts as an example of textualism. Both the First Circuit and Sixth Circuit have noted *Star Athletica* as standing for the proposition of grounding statutory interpretation purely in the language of the text. While Justice Thomas employs a textualist lens in his *Star Athletica* opinion, it is ironic to use this case as a textualist exemplar when courts have been struggling so significantly to make sense of the statutes explaining separability. *See United States v. Arif*, 897 F.3d 1, 6 n.5 (1st Cir. 2018); *Hueso v. Barnhart*, 948 F.3d 324, 333 (6th Cir. 2020).

geometric designs on car seat covers are eligible for copyright protection.<sup>93</sup> The *Day to Day* court's reasoning behind its decision indicates lingering confusion from the *Star Athletica* opinion. Primarily, the court rested on the *Star Athletica* majority's refutation of Justice Breyer's argument that separating the design from the useful article simply recreates the useful article.<sup>94</sup> Instead, the *Day to Day* court emphasizes that even if the shape of the car seat cover is recreated by reproducing the design, that is not a bar to copyright.<sup>95</sup> The court also determines that the car seat cover designs can be separated from the utilitarian features of the covers in part because the design does not affect the seat covers' functionality or effectiveness.<sup>96</sup> This rationale, resembling the *Carol Barnhart* "objectively necessary" approach, was rejected by the *Star Athletica* majority.<sup>97</sup>

In *Inhale v. Starbuzz*, the Central District of California held that geometric designs on a hookah water container were not copyrightable.<sup>98</sup> The court takes issue with the breadth of copyright protection sought: "When an entity seeks protection for the arrangement of all the parts of an article, combined in the manner necessary to create the article, it is effectively seeking protection for the article as a whole. However, such wholesale protection is not allowed for useful articles."<sup>99</sup> The court cannot identify a specific pictorial, graphic, or sculptural feature to copyright separately from the utilitarian elements of the water container. Further, the design adorning the container contains geometric shapes "of the most common type."<sup>100</sup> Despite Justice Thomas's broad direction that courts may find a copyrightable pictorial, graphic, or sculptural work if the artistic elements could be transferred to another medium and constitute a work of art, the *Inhale* court determines that this test was not met. However, the court leaves open the possibility that a more creative geometric design could pass the *Star Athletica* test.<sup>101</sup> Following *Star Athletica*, courts have taken differing approaches to geometric patterns adorning useful articles, necessitating a more effective solution.

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93. *Day to Day Imps., Inc. v. FH Grp. Int'l, Inc.*, No. 18-cv-14105, 2019 WL 2754996, at \*1 (D.N.J. July 2, 2019).

94. *Id.* at \*5.

95. *Id.*

96. *Id.* at \*6.

97. Jane Ginsburg, *The Sum Is More Public Domain than Its Parts?: US Copyright Protection for Works of Applied Art Under Star Athletica's Imagination Test*, 166 U. PA. L. REV. 83, 91 (2017) (quoting *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 421 (2017)).

98. *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, No. 11-cv-03838, 2017 WL 4163990, at \*1 (C.D. Cal. May 8, 2017) (This case was decided prior to *Star Athletica*, though the court declined to reconsider its decision, explaining that applying the *Star Athletica* test would not change the outcome).

99. *Id.* at \*3.

100. *Id.*

101. *Id.*

### III. PROPOSED SOLUTION: AMENDING THE STATUTE WITH THE SECOND CIRCUIT AS A GUIDE

#### A. ISSUES THE SOLUTION MUST ADDRESS

##### 1. Insufficient Distinction Between Applied Art and Industrial Design

The *Star Athletica* opinion appears to classify “art” too broadly, implying that anything with creative properties could qualify for copyright protection.<sup>102</sup> Justice Thomas articulates that the geometric patterns adorning the cheerleading uniforms were sufficiently creative pictorial, graphic, or sculptural works because if transferred to another medium—such as a canvas—they could be seen as a work of two-dimensional art.<sup>103</sup> Among lower courts, this issue appears most notably in the *Corinna Warm* decision, in which obviously utilitarian lampshades were granted copyright protection because they could have possibly existed as sculpture, had they been crafted in a different medium.<sup>104</sup> Both cases illustrate the potential for copyright law to be too generous to designs of useful articles, perhaps finding creativity and artistic prowess in situations not imagined by Congress or the Founders when they intended to protect the “Writings” of “Authors.”<sup>105</sup>

##### 2. Imaginative Nature of the Current Conceptual Separability Test

Another critical issue causing lower court confusion and disparate outcomes is the imaginative and hypothetical nature of the *Star Athletica* test. In asserting that “separability is a conceptual undertaking,” the *Star Athletica* majority is necessitating an exercise that is at least partially determinative on the strength of a judge’s imagination.<sup>106</sup> The confusion caused by this type of test is seen in Justice Breyer’s use of the same test to reach a different outcome. While Justice Thomas conceived of the uniform designs as a two-dimensional work of art, Justice Breyer could not: He could only see a reproduction of the uniforms themselves.<sup>107</sup> While all statutes or legal tests are open to some amount of interpretation, basing a test on a judge’s imaginative capabilities is a recipe for confusion that must be clarified.

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102. This classification becomes even broader when considering the Supreme Court’s decision in *Bleistein*, in which Justice Holmes asserted that judges should not fancy themselves art critics for the purposes of determining copyrightability. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”).

103. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 417–18 (2017).

104. See *Corinna Warm and Studio Warm LLC v. Innermost Ltd.*, No. 21-cv-4402, 2022 WL 2062914, at \*3 (C.D. Cal. Apr. 26, 2022).

105. For further discussion of *Star Athletica*’s failure to properly distinguish between applied art and industrial design, see Rebecca Tushnet, *Shoveling a Path After Star Athletica*, 66 U.C.L.A. L. REV. 1216 (2019).

106. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 422 (2017).

107. See discussion *infra* Part I.B.

## B. POTENTIAL SOLUTION I: SUPREME COURT CLARIFICATION

As a potential solution, the Supreme Court could grant certiorari on another copyright case involving an artistic design on a useful article, taking that opportunity to further clarify its approach to conceptual separability. This would allow the Court to cabin its interpretation of a design element being capable of existing as a separate work of art, and offer more standardized guidelines for judges to follow. A judicial opinion would allow for a more long-form, nuanced explanation of these issues with direct guidance on how judges should conduct their analyses.

However, there are significant logistical concerns to this solution. It is doubtful that deciding on another copyright case will lead to a revised test. Clarifying the test with the above issues in mind would likely lead to a different outcome in a case like *Star Athletica*. If the conceptual nature of the separability analysis were fettered, the cheerleading uniform designs would likely not be seen as separable works of art, but rather designs of minimal creativity that enhance the utilitarian purposes of the uniform (and cannot be separated from those purposes).

While the makeup of the Supreme Court has changed since 2017, five of the six majority voters in *Star Athletica* still currently sit on the court—Chief Justice Roberts, Justice Thomas, Justice Alito, Justice Sotomayor, and Justice Kagan. It can be presumed that these Justices all agreed with the outcome of *Star Athletica* and the separability test as was applied. Therefore, due to the corresponding logistical challenges, Supreme Court clarification on the *Star Athletica* test is not the ideal method of clarifying lower court confusion.

## C. POTENTIAL SOLUTION II: AMENDING THE STATUTE

Another solution would be for Congress to amend a portion of the Copyright Act of 1976 to more clearly define separability or establish a statutory test. As a textualist opinion, *Star Athletica* grounds itself in admittedly ambiguous statutory text; amending that text would more effectively guide courts looking to be true to the statute. Further, it would give Congress a chance to express whether it had intended for the expanded protection now offered to costumes.<sup>108</sup>

Choosing not to amend the statute could have significant economic and market effects.<sup>109</sup> Under the current ambiguous test, litigation among fashion, furniture, and interior design companies is likely to continue as manufacturers struggle to understand what is infringement and what is not.<sup>110</sup> Further, the market for Halloween and other types of costumes is likely to be further disrupted as more courts rule in favor of copyrighting design elements of costumes. Halloween spending in 2023 was projected to total a record \$12.2 billion; this is a major industry with the potential to take a hit

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108. See Angelo Marchesini, *Thin Separability: An Answer To Star Athletica*, 43 SEATTLE U. L. REV. 1087, 1105 (2020).

109. *Id.*

110. *Id.*



should costumes be copyrighted en masse.<sup>111</sup> Amending the statute gives Congress the power to minimize the effects on the costuming industry by choosing not to offer copyright protection, should it desire to go in that direction.

#### D. THE SOLUTION: AMENDING THE STATUTE BASED ON SECOND CIRCUIT TESTS

Based on the weaknesses of the current separability test and the likelihood of success of each solution, the ideal solution would be amending the Copyright Act of 1976 using the Second Circuit's three major pre-*Star Athletica* tests—from *Brandir*, *Carol Barnhart*, and *Kieselstein-Cord*—as a guide. The Second Circuit opinions aim to concretize the ambiguous standards of being “identified separately from” and “existing independently of” utilitarian features. This type of specificity eliminates most of the imaginative guesswork currently required of judges and is vital for standardizing lower court opinions.

The primary-subsidary test, advanced in *Kieselstein-Cord*,<sup>112</sup> is perhaps the least helpful in guiding the amendment of the statute; by requiring that the artistic features be “primary” to the “subsidiary” utilitarian function is missing the point of designs on useful articles. If an item is a useful article, then practically by definition, its utilitarian features will be primary to the artistic designs adorning it. The *Star Athletica* cheerleaders donned their uniforms for the primary purposes of (1) identifying themselves as cheerleaders, and (2) utilizing the uniforms' design features to aid in their cheers, tumbling, etc. Of course, the designs could have attracted the coach to choose certain uniforms over others, but it is very unlikely that these uniforms are being worn primarily for their designs (not for the utilitarian functions). Therefore, this test seems to hold PGS works adorning useful articles to too high of a standard, and one that will be difficult for judges to decide on cohesively.<sup>113</sup>

The design-process test from *Brandir* is much more promising.<sup>114</sup> The idea behind this test is that creators should not receive the benefit of copyright protection for an element that came about as a result of the utilitarian feature and was not the direct result of independent creativity.<sup>115</sup> Codifying a version of this test would avoid one of Justice Breyer's chief complaints about the *Star Athletica* opinion: that removing the

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111. Lottie Watts, *Halloween Spending To Reach Record \$12.2 Billion as Participation Exceeds Pre-Pandemic Levels*, NAT'L RETAIL FED'N (Sept. 20, 2023), <https://nrf.com/media-center/press-releases/halloween-spending-reach-record-122-billion-participation-exceeds-pre> [https://perma.cc/3N5H-PZS3] [<https://web.archive.org/web/20240119191245/https://nrf.com/media-center/press-releases/halloween-spending-reach-record-122-billion-participation-exceeds-pre>].

112. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980).

113. Daan G. Erikson argues for the use of a test similar, but not identical to, the primary-subsidary test: Judge Forrest's “primary purpose” test is utilized in *Jetmax Ltd. v. Big Lots, Inc.*, No. 15-cv-9597, 2017 WL 3726756, at \*6 (S.D.N.Y. Aug. 28, 2017). While Erikson notes that Judge Forrest's “primary purpose” test focuses more on separability than the primary-subsidary test, I believe the same problem remains. Determining whether something is “primarily” artistic is simply too subjective to effectively clarify the post-*Star Athletica* confusion. See Daan G. Erikson, *Copyright Protection for Conceptually Separable Artistic Features Post-Star Athletica: A Useful Article on Useful Articles*, 18 CHI-KENT J. OF INTELL. PROP. 56, 78 (2019).

114. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147–48 (2d Cir. 1987).

115. *Id.* at 1145.

designs and transferring them to a piece of paper or a canvas would produce a picture of a cheerleading uniform. The designs inherently stem from the shape of the uniforms, imposing natural limitations nonexistent with a blank canvas. If a design cannot be copyrighted because it is largely the result of functional considerations, *Star Athletica* would likely be decided the other way. The lines and chevrons were designed with the purpose of appearing on the uniforms and complementing their existing shape and cut.<sup>116</sup> Therefore, it seems that much of the design process was the result of functional considerations rather than creativity. Including a design-process test in the statute would serve a clarifying function for lower courts while staying true to the Constitutional basis of copyright.<sup>117</sup>

The objectively necessary test from *Carol Barnhart* nicely complements the design-process test.<sup>118</sup> Determining whether the design element is necessary to the utilitarian function necessarily addresses the “signaling” issue that Justice Breyer alludes to in his dissent. *Star Athletica*’s focus on cheerleading uniforms adds a complicated dimension because the uniform designs can either be seen as purely aesthetic, or as functional in that they identify the wearer as a cheerleader in a way a plain uniform could not. While cases like this will allow for some judicial discretion, gauging whether the design element is necessary to the functioning of the useful article serves as a helpful proxy for whether the design element is truly separate.

The statute would be best amended by adding another subsection to the § 101 definitions that would better define the phrases “identified separately from” and “existing independently of.”<sup>119</sup> These definitions should encapsulate both the design-process and objectively necessary tests. I propose that “identified separately from” be defined roughly as follows: The pictorial, graphic, or sculptural features of the design do not exist primarily to enhance, nor as a direct result of, the functionality of the useful article. I believe that the design-process test gets to the heart of the separate identification issue; if a design feature primarily exists because of the utilitarian features of a useful article, there is no meaningful separation. Of course, this proposed definition is somewhat clunky and invites further debate on what it means for a design to be the “direct result of” an object’s utilitarian features. However, this definition guides judicial thinking in a more structured way by looking for creativity in the form of artistic choice, a principle at the heart of the copyright statute.<sup>120</sup>

Similarly, I propose that “existing independently of” be defined as follows: “The pictorial, graphic, or sculptural features of the design are not necessary in carrying out one or more of the useful article’s utilitarian features. This definition, adapted from the

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116. *Star Athletica L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 439 (2017) (Breyer, J., dissenting).

117. It has been argued that the *Brandir* test’s focus on process rather than result does not reflect existing copyright law, nor the goals of copyright law. See Perlmutter, *supra* note 12, at 372. However, copyright law, as specified in the Constitution, seeks to protect the “Writings” of “Authors”: their original, creative work. Requiring that protectable works be the result of a creative process, rather than of limitations imposed by functionality, is in fact closely aligned with the purposes and goals of copyright.

118. *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985).

119. 17 U.S.C. § 101.

120. See 17 U.S.C. § 102 (requiring “original works of authorship”).

objectively necessary test, seems to be the most straightforward proxy for independent existence. A design element and a utilitarian feature can only truly be independent if they do not depend on one another. Again, this definition still allows for some judicial discretion in a case like *Star Athletica*, where the parties—as well as the district and circuit courts—disagree over whether the designs play a totally aesthetic or somewhat utilitarian role.<sup>121</sup> However, the addition of the phrase “one or more” to the definition creates a stricter standard where copyright can be invalidated if the design feature is necessary for even one of the useful article’s utilitarian functions.

It has been suggested that a more effective course of action would involve explicitly funneling useful article designs into the realm of design patents.<sup>122</sup> In drafting § 101, Congress did not explicitly shape a policy for designs of useful articles.<sup>123</sup> The *Star Athletica* majority then declined to expand Congress’ conception of separability, “merely highlight[ing] § 101’s flawed construction” instead of providing its own clarity.<sup>124</sup> While it is clear from *Star Athletica* and later lower court decisions that the separability issue has not been adequately solved, funneling useful article designs to design patents is unlikely to bring about long-term improvement.

On a functional level, design patents are unlikely to be the right avenue for costume, uniform, or fashion designers to protect their work. Design patents are only valid for fifteen years, significantly shorter than the duration of copyright protection.<sup>125</sup> Designers may find this time period insufficient to effectively protect their work. Further, as a form of patent protection, design patents require a long and intense application period,<sup>126</sup> in which the United States Patent and Trademark Office evaluates the design for novelty and non-obviousness, among other requirements.<sup>127</sup> These stringent requirements could disqualify a large portion of designs; many fashion designers gain inspiration from other artists, and this is not something we should seek to punish or disincentivize. Conversely, copyright’s requirement of independent creation and a “modicum of creativity” is better suited to the nature of costume or uniform design.<sup>128</sup> Therefore, the most effective solution does not completely separate designs of useful articles, but rather places clearer restraints on the requirements of separate identification and independent existence.

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121. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 470–71 (6th Cir. 2015).

122. See Emily Smithey, *The Borderlands of Copyright: The Useful-Article Doctrine in Light of Star Athletica v. Varsity Brands*, 87 UMKC L. REV. 461, 478 (2019).

123. *Id.* at 477.

124. *Id.*

125. 35 U.S.C. § 173. See also Marchesini, *supra* note 91, at 1105.

126. See Brief of Council of Fashion Designers of America, Inc. as Amicus Curiae in Support of Respondents at 16, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-cv- 866, 2016 WL 5404369 (2016) (“In 2015, the average time for an initial determination of patentability was 17.3 months, during which time a designer might release up to ten collections.”).

127. 35 U.S.C. § 171.

128. *Feist Publ’ns, Inc. v. Rural Television Serv. Co.*, 499 U.S. 340, 346 (1991) (“originality requires independent creation plus a modicum of creativity”).

#### IV. CONCLUSION

The *Star Athletica* opinion was published at a time when lower courts were struggling to understand separability of designs of useful articles and guidance was needed to standardize the analysis. The majority established a two-part test whose application it deemed “straightforward.”<sup>129</sup> While the opinion successfully clarified that conceptual separability is sufficient to find a copyrightable pictorial, graphic, or sculptural work, it falls short in properly standardizing the test that should be used in the separability analysis, which has led to confusion among lower courts. We primarily notice this confusion in furniture and interior design as well as geometric designs on useful articles. Courts have struggled with the overly imaginative nature of the test and the majority’s broad definition of “art.” To solve this confusion, the Supreme Court’s ambiguous test needs to be clarified, ideally at the statutory level, to provide workable proxies for the ambiguous requirements of “identified separately from” and “existing independently of.” The Second Circuit’s design-process and objectively necessary tests serve as useful guides in crafting new statutory definitions. With increased clarity, conceptual separability can become an issue better understood by judges and litigants, and decided in a more standardized way by courts.

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129. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 417 (2017).