

## Copyright Protection for Applied Art and Works of Artistic Craftsmanship After *Star Athletica*

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Thanks very much. As the very first session proclaimed, the *Star Athletica* case has not been a model of total clarity on the Supreme Court's part.<sup>1</sup> I'm going to explore that proposition. I will go through some basic elements of the copyright statute, and will then apply those rules to several examples. Rob Kasunic also has examples.<sup>2</sup> In fact, we have some overlapping examples, but we might have different views about those examples.

The Copyright Act sets out the category of pictorial, graphic, and sculptural ("PGS") works, whose statutory definition includes applied art. That was the subject matter at issue in *Star Athletica*. The statute also provides that PGS works "shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned."<sup>3</sup> "Works of artistic craftsmanship" has been a somewhat overlooked category, but I think, as a result of *Star Athletica* and also the pending amendments of the *Compendium of U.S. Copyright Office Practices*, that this category will receive a lot more attention. It does not, however, necessarily follow that the meaning of that category will be any clearer than the standard for what is a PGS work. For example, there may be some difference of opinion as to whether a work of artistic craftsmanship is distinct from a work of applied art. Perhaps Rob Kasunic will discuss that further.

The Copyright Act establishes that a "useful article" will be a PGS work only if it "incorporates [PGS] features that [1] can be identified separately from, and [2] are capable of existing independently of, the utilitarian aspects of the article."<sup>4</sup> This is

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1. *Star Athletica v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).
2. See generally Robert Kasunic, *Applying Star Athletica's Teachings in the Copyright Office*, 43 COLUM. J.L. & ARTS 431 (2020).
3. 17 U.S.C. § 101 (2020) (defining "pictorial, graphic, and sculptural works").
4. *Id.*

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known as the “separability test,” and that is what courts have struggled mightily over, culminating in *Star Athletica*.<sup>5</sup>

But we only get to the problem of separability if the object in contention is a useful article, a term the statute defines.<sup>6</sup> A useful article in the sense of the statute is not the same thing as an article that has certain kinds of utility.<sup>7</sup> Thus, the statute tells us, if the usefulness of the article is to “portray the appearance of the article or to convey information,” those features may be useful in some abstract sense, but they do not make the work a “useful article” in the sense of the Copyright Act.<sup>8</sup> For example, René Magritte’s famous painting *La Trahison des images* is a joke on Magritte’s part because it says “this is not a pipe,” which is true: It is not a pipe, it is a *representation* of a pipe.<sup>9</sup> It is not an actual pipe, and therefore, it is a PGS work because it is simply portraying a useful article. It is not itself a useful article.

Another example: this is a sculpture of a chair.<sup>10</sup> It is not an actual chair. It looks like it would be extremely uncomfortable if you wanted to sit in it. And as a sculpture of a chair—as a representation of a chair—it is protectable. It is not a useful article. But § 113(b) makes clear that you don’t get to have exclusive rights in a useful article by drawing a picture of the useful article.<sup>11</sup> So, Magritte has exclusive rights in his representation of the pipe, but that does not give him the exclusive right to manufacture actual pipes that look like his drawing of a pipe.



5. *Star Athletica*, 137 S. Ct. 1002.

6. 17 U.S.C. § 101 (2020) (defining “useful article”).

7. *Id.*

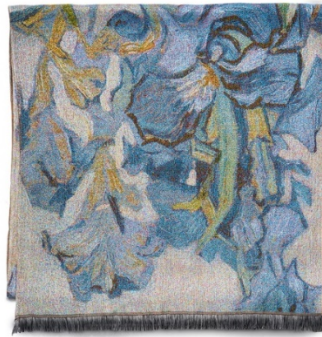
8. *Id.*

9. See René Magritte, *La trahison des images (The Treachery of Images)*, L.A. COUNTY MUSEUM OF ART, <https://perma.cc/XXW9-QSDD> (last visited Feb. 23, 2020).

10. Photograph of chair sculpture by Jane C. Ginsburg. See Tuomas Markunpoika, *Sculpture Engineering Temporality*, DESIGN MUSEUM HELSINKI, <https://perma.cc/LJV3-3YMN> (last visited Feb. 25, 2020).

11. 17 U.S.C. § 113(b) (2020).

On the other hand, § 113(a) tells us that if you have a PGS work, the scope of protection in your PGS work includes the right to reproduce it, including on a useful article.<sup>12</sup> This brings a lot of merchandising properties under the artist's copyright control. Van Gogh's work is in the public domain, but if it were not in the public domain, he would have the exclusive right to license the reproduction of his image on a useful article—in this case, a scarf.<sup>13</sup>



Somebody mentioned Basquiat earlier. So, these are skateboards with reproductions of Basquiat.<sup>14</sup> The protection does not extend to the skateboard, but the exclusive right to reproduce the image on a skateboard is within the scope of copyright for a PGS work. The same thing for fabric design.<sup>15</sup>



This brings us to *Star Athletica*.<sup>16</sup> One problem with *Star Athletica* concerns the Court's characterization of the case as one about useful articles. A better conceptualization may have been to consider the works not as cheerleader uniforms,

12. 17 U.S.C. § 113(a) (2020).

13. *Van Gogh Irises Shawl*, THE MET STORE, <https://perma.cc/7V4A-77PT> (last visited Feb. 23, 2020).

14. *Jean-Michel Basquiat: Skateboard Triptych in Italian*, MOMA DESIGN STORE, <https://perma.cc/6BE7-RRTR> (last visited Feb. 23, 2020).

15. *See Fabric Archive: Elizabeth*, TULA PINK, <https://perma.cc/TJX5-4Y9D> (last visited Feb. 23, 2020).

16. *Star Athletica v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).

but as two-dimensional designs reproduced on a useful article—the useful article being a cheerleader uniform.<sup>17</sup> A design which is reproduced on a useful article is not the same thing as a useful article. In that light, the Supreme Court never should have gotten to the separability question; if the work is not a useful article, separability is not an issue. But once the Court decided that the case concerned a useful article—the cheerleader uniform—it then had to determine whether the designs which were reproduced on the cheerleader uniforms were separable from the uniforms.



The ancestor separability case is *Mazer v. Stein*.<sup>18</sup> Originally, the sculpture was a ballerina,<sup>19</sup> but it was also reproduced as a lamp base.<sup>20</sup> The Court had to determine whether the sculpture was still protectable as a work of fine art under the previous version of the Copyright Act, even though it had been incorporated in a useful article.<sup>21</sup> The Supreme Court ruled (relying on a Copyright Office regulation<sup>22</sup>) that the sculpture did not lose copyright protection when it was incorporated in a useful

17. *Varsity Brands, Inc. v. Star Athletica LLC*, 799 F.3d 468, 472–73 (6th Cir. 2015) (image of uniform designs).

18. *Mazer v. Stein*, 347 U.S. 201 (1954).

19. Trademarks Are Magic, *Mazer v. Stein*, PINTEREST, <https://perma.cc/G2B6-29LU> (last visited Feb. 23, 2020) (photograph of dancer statuette).

20. Rebecca Tushnet, *That's Where The Light Is*, REBECCA TUSHNET'S 43(B)LOG, <https://perma.cc/Q683-FC6L> (last visited Feb. 23, 2020) (image of lamp advertisement).

21. *Mazer*, 347 U.S. 201.

22. A 1949 Copyright Office regulation covered useful articles “includ[ing] works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspect are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture.” 37 C.F.R. § 202.8 (1949).

article.<sup>23</sup> The present separability rule in § 101 derives in part from that Copyright Office regulation.



The Supreme Court has now told us that discerning what “separability” means follows a two-step test.<sup>24</sup> First, do you perceive in the object a two- or three-dimensional element that appears to have PGS qualities?<sup>25</sup> One of the problems with *Star Athletica* is that it talks in terms of two or three dimensions, but the case itself involved a two-dimensional design (that was reproduced on the shape of the dress). That disconnect has led to some overbroad statements by the Court that may not translate to three-dimensional articles. Nonetheless, on to step two: if you can perceive a PGS aspect, can this separately identified feature exist apart from the utilitarian aspects of the article?<sup>26</sup> Just what that means is still not entirely clear. The Court has provided some guidance by reference to § 113(a) (the exclusive right to reproduce the design on a useful article): If one reverse-engineered the article, could one imagine that the design is standing on its own, with the useful article as something that the design has been reproduced onto?<sup>27</sup>

The limits of the so-called “imagination test,” however, are encountered in this cautionary phrase, which I think throws everything back into uncertainty. We’ve imagined this element as having an independent existence, except that notwithstanding that imagining, the Court has told us that the imagined feature cannot itself be a useful article.<sup>28</sup> Let me show you why this is a problem. Imagine this chair base as the PGS element.<sup>29</sup> One could see this as some sort of a sculpture

23. *Mazer*, 347 U.S. 201.

24. *Star Athletica v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017).

25. *Id.*

26. *Id.*

27. *Id.* at 1010–11.

28. *Id.* at 1010 (“Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or ‘[a]n article that is normally a part of a useful article’ (which is itself considered a useful article).”).

29. *Complaint, Heptagon Creations, Ltd. v. Core Grp. Mktg. LLC*, No. 1:11CV01794, 2011 WL 2352535 at \*48 (S.D.N.Y. Mar. 15, 2011) (image of plaintiff’s “Cocoon Chair”).

vaguely representative of a tree trunk, and then it becomes a useful article when you drop the chair into it. But the thing that you have imagined as being a separate PGS element is also a part of the useful article because it is a part of this chair: It forms the base and the arms of the chair. There may be an internal contradiction in imagining that sculptural element as something existing independently of the chair on the one hand, but on the other hand, because the sculptural element forms the base and arms of the chair, the element is no longer separable.



Let's look at a few other examples. These were all photographed at the Design Museum Helsinki. (Anytime I go anywhere, I like to go to the local design museum and take pictures and then send them to Rob Kasunic, inquiring, "Would you register this?") With this chair,<sup>30</sup> would we consider that the lips are a separable, protectable element? I think Rob and I disagree about whether those lips are sufficiently original to be copyrightable, but if they are, you can certainly imagine them separate from the chair. But on the other hand, they are the back of the chair, so we're back to the problem discussed above, because the lips are also a part of a useful article.



30. Photograph of chair by Jane C. Ginsburg. See Rita Taskinen, *Chair Kiss*, DESIGN MUSEUM HELSINKI, <https://perma.cc/5WJ8-CRAS> (last visited Feb. 23, 2020).

With this wine rack,<sup>31</sup> again, it's unclear whether one would analyze this as being separable. The Supreme Court's failure to grapple with a three-dimensional useful article rather than the two-dimensional designs applied to the cheerleader uniforms leaves us uncertain about how to analyze this article. It certainly doesn't have to look like this to be a wine rack; indeed, this is not the most efficient design for a wine rack. But those features figure in a merger analysis, and whatever separability means, it is a more restrictive standard than merger. The availability of alternative wine rack designs thus is probably irrelevant. Perhaps we could avoid separability problems altogether if we resorted to another statutory category, "works of artistic craftsmanship." The Copyright Office takes the position that separability is not an issue for works of artistic craftsmanship.<sup>32</sup> So far, so good. But what *is* a work of artistic craftsmanship?

In lieu of an answer, I'll show you some pictures, and then let Rob answer the question of what is a work of artistic craftsmanship. Here is a very nice Nordic-design necklace.<sup>33</sup> We have the famous bear-paw slippers,<sup>34</sup> which were held separable.<sup>35</sup> And then we have a fish pitcher.<sup>36</sup> We have some nice dishware—this is from the Design Museum.<sup>37</sup> And we have a candle-holder,<sup>38</sup> and we have a telephone.<sup>39</sup> The design elements of the telephone: would they be a work of artistic craftsmanship? Would they be separable features of a useful article? I'm not sure, following *Star Athletica*, whether the imagination test is going to do us any good. And I'm not sure whether defaulting to a new category—work of artistic craftsmanship, where we don't have to worry whether something is a part of a useful article—will save the day, but Rob is now going to answer all of these questions.

31. Photograph of wine rack by Jane C. Ginsburg. See Olafur Thordardson, *Bottle Stand Delirium Tremens*, DESIGN MUSEUM HELSINKI, <https://perma.cc/MHR3-4H5K> (last visited Feb. 23, 2020).

32. U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 925.3 (3d ed., rev. public drft. 2019).

33. Photograph of necklace (on next page) by Jane C. Ginsburg. See Björn Weckström, *Planetary Valleys*, DESIGN MUSEUM HELSINKI, <https://perma.cc/MM3R-WHSN> (last visited Feb. 23, 2020).

34. *Bear Paw Slippers*, MY BOO THANG (July 31, 2017), <https://perma.cc/YC9B-4TXN>.

35. *Animal Fair, Inc. v. AMFESCO Industries, Inc.*, 620 F. Supp. 175 (D. Minn. 1985), *aff'd*, 794 F.2d 678 (8th Cir. 1986).

36. Vintage4Vintage, *Glug Jug Pitcher - Ceramic Golden Fish*, ETSY, <https://perma.cc/WD8U-EVMM> (last visited Feb. 23, 2020).

37. Photograph of dishware by Jane C. Ginsburg. See Wilhelm Kåge, *Tableware Set Praktika Weekend*, DESIGN MUSEUM HELSINKI, <https://perma.cc/9EEA-63LC> (last visited Feb. 23, 2020).

38. Photograph of candleholder by Jane C. Ginsburg. See Anu Pentik (Pentikäinen), *Candleholder*, DESIGN MUSEUM HELSINKI, <https://perma.cc/L67Q-835U> (last visited Feb. 23, 2020).

39. Photograph of Nokia telephone by Jane C. Ginsburg.

