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The Need for "Supreme" Clarity: Clothing, Copyright, and Conceptual Separability

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Cover Page Footnote

Senior Writing and Research Editor, Fordham Intellectual Property, Media & Entertainment Law Journal, Volume XXVII; J.D. Candidate, Fordham University School of Law, 2017; B.A., Business Economics and French, University of California, Santa Barbara, 2012. I would like to thank Professor Susan Scafidi for introducing me to this topic and the IPLJ Editorial Board and Staff for their efforts throughout the editorial process.

The Need for “Supreme” Clarity: Clothing, Copyright, and Conceptual Separability

Jacqueline Lefebvre*

*For the first time in history, the U.S. Supreme Court will address copyright protection in the context of apparel in the case *Star Athletica, LLC v. Varsity Brands, Inc.* This case tackles arguably the most vexing, unresolved question in copyright law: How to determine whether artistic features of a useful article—such as a garment or piece of furniture—are conceptually separable from the article and thus protectable. Indeed, this case comes more than sixty years after *Mazer v. Stein*, the Supreme Court’s first and, until this date, only decision in this area. A lack of clear guidance from the Supreme Court and Congress in determining whether the artistic and utilitarian aspects of useful articles are conceptually separable, has resulted in a multitude of conflicting and effectively unreliable approaches by courts and scholars in an attempt to establish a standard. Given this reality, the current state of conceptual separability demands clarity and reform.*

This Note proposes a two-part conceptual separability test, which asks: (1) what are the claimed design elements of the article; and (2) can those design elements be identified separately from, and exist independently of, the utilitarian features of the article? This Note’s proposed test is an effective and appropriate approach for determining when a feature of a useful article is protectable under the Copyright Act for several reasons: focusing the conceptual separability inquiry on the article’s design elements as opposed to its utilitarian features avoids inconsistent

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results; the two-part inquiry draws from language of the Copyright Office, which in turn reflects agreement between the legislative and judicial branches; the ordinary, reasonable observer standard is consistent with other aspects of copyright law; and the proposed test is practical in its application.

INTRODUCTION	145
I. THE DEVELOPMENT OF COPYRIGHT PROTECTION FOR USEFUL ARTICLES	149
<i>A. Establishing Copyright Law for Useful Articles</i>	149
<i>B. Mazer v. Stein</i>	150
<i>C. Codifying the Current Separability Standard</i>	151
II. THE INADEQUACIES OF CONCEPTUAL SEPARABILITY AS CURRENTLY APPLIED	154
<i>A. Existing Conceptual Separability Tests</i>	155
1. Copyright Office’s Approach	155
2. Primary-Subsidiary Approach	156
3. Objectively Necessary Approach	156
4. Ordinary-Observer Approach.....	157
5. Design-Process Approach	158
6. Stand-Alone Approach.....	159
7. Likelihood-of-Marketability Approach.....	160
8. Patry’s Approach.....	161
9. Subjective-Objective Approach.....	161
10. Sixth Circuit’s “Hybrid” Approach	162
<i>B. Mounting Inadequacies of Current Conceptual Separability Tests</i>	163
<i>C. The Need for One Uniform Application of Conceptual Separability</i>	166
III. RESOLVING THE MOST VEXING PROBLEM IN COPYRIGHT LAW	171
<i>A. The Proposed Test for Conceptual Separability</i>	171
<i>B. Advantages of the Proposed Test</i>	174
1. An Initial Consideration of Design Rather than Utility Avoids Inconsistent Results.....	175
2. The Proposed Test Uses Language of the Copyright Office, Which Is Consistent with the Legislative and Judicial Branches	176

3. The Ordinary, Reasonable Observer Standard Is Consistent with Other Areas of Copyright Law	177
4. The Proposed Test Is Practical in Its Application	177
CONCLUSION	179

INTRODUCTION

Some say that imitation is the sincerest form of flattery, but fashion designers may disagree. According to industry reports, fashion is a global business worth more than \$1.2 trillion, with over \$250 billion spent on fashion in the United States yearly.¹ Despite fashion’s economic and artistic contributions to our global economy, American designers are provided limited intellectual property protection.² Predominantly a result of emerging technologies and lack of intellectual property protection, knockoffs and counterfeits may be immediately and effortlessly produced at a much cheaper price point.³ As a result of a loss in sales, market share, and good will, unauthorized copies can effectively damage or even destroy a designer’s career.⁴ Thus, intellectual property rights are an essential component in the promotion of innovation and creativity within the fashion industry.⁵

¹ Darrell Mottley, *Intellectual Property Alert: U.S. Supreme Court Will Weigh In on Star Athletica, LLC v. Varsity Brands Inc.*, JD SUPRA (May 3, 2016), <http://www.jdsupra.com/post/contentViewerEmbed.aspx?fid=ec9e3583-2835-4016-b62b-a46a7c1dd066> [<https://perma.cc/CYH3-H97L>]; *see also* Petition for Writ of Certiorari at 6, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (U.S. Jan. 4, 2016).

² *See* Christiane Schuman Campbell, *Protecting Fashion Designs Through IP Law*, LEGAL INTELLIGENCER (Apr. 14, 2015), http://www.duanemorris.com/articles/protecting_fashion_designs_through_ip_law_5516.html [<https://perma.cc/UG36-S63T>].

³ *See id.*

⁴ *See* Ahlam Al Tamimi, *Intellectual Property is an Enormous Asset in the Fashion Industry*, FASHION L. (July 27, 2016), <http://www.thefashionlaw.com/home/intellectual-property-is-an-enormous-asset-in-the-high-fashion-industry> [<https://perma.cc/2RZA-7SKR>].

⁵ *See id.*

There are generally three forms of intellectual property protection for fashion designers: patents, trademarks, and copyrights.⁶ Patents are typically difficult to obtain because they are expensive and the process is time-consuming.⁷ Trademarks do not actually protect designs, but rather protect “source identifiers” such as logos, symbols, and brand names.⁸ Clothing designs are traditionally afforded limited protection under U.S. copyright law, which protects “original works of authorship fixed in any tangible medium of expression.”⁹ In order to meet the originality requirement, a work must be independently created by its author, and possess at least some minimal degree of creativity.¹⁰ Clothing designs certainly fall within this ambit of originality, however, little protection is offered to clothing under copyright law because copyright protection does not extend to functional items.¹¹ The only way for clothing to acquire copyright protection is if the clothing article’s design elements “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”¹² What this entails has been the subject of much confusion and debate.¹³

In *Star Athletica, LLC v. Varsity Brands, Inc.*, the U.S. Supreme Court agreed to review an August 2015 ruling by the Sixth Circuit to determine whether the stripes, chevrons, and color-blocking on cheerleading uniforms are entitled to copyright protection under federal law.¹⁴ This is the first time the Supreme Court has addressed copyright protection in the context of apparel. The case arose from a dispute between two competing manufacturers of

⁶ See Campbell, *supra* note 2.

⁷ See Oliver Herzfeld, *Protecting Fashion Designs*, FORBES (Jan. 3, 2013), <http://www.forbes.com/sites/oliverherzfeld/2013/01/03/protecting-fashion-designs/#726f85d673f8> [<https://perma.cc/TLL7-K5RM>].

⁸ See *id.*

⁹ See 17 U.S.C. § 102 (2012).

¹⁰ “For example, a white [T]-shirt cannot garner copyright protection because the [T]-shirt is a useful item with no separately artistic element.” Lori Levine, Jeffrey D. Wexler & Bobby Ghajar, *Protecting Fashion Through Copyrights: The Supreme Court Will Decide Whether Cheer Uniform Designs Are Protectable*, PILLSBURY L. 1 (May 11, 2016), <https://www.pillsburylaw.com/siteFiles/Publications/AlertMay2016IPProtectingFashionThroughCopyrights.pdf> [<https://perma.cc/GK72-74VA>].

¹¹ See *id.*

¹² See 17 U.S.C. § 101 (2012).

¹³ See Levine et al., *supra* note 10.

¹⁴ Mottley, *supra* note 1.

cheerleading uniforms, in which Varsity Brands accused Star Athletica of reproducing the copyrighted design elements of its cheerleading uniforms.¹⁵ In a 2-1 decision, the Sixth Circuit held that the stripes, chevrons, zigzags, and color-blocking of a cheerleading uniform were eligible for copyright protection, effectively reversing the district court’s decision.¹⁶ The district court judge, in determining that the designs themselves were not copyrightable, explained that he could not distinguish between the creative aspects of the uniforms and the purpose of the uniforms themselves.¹⁷

Although *Varsity Brands* involves unusual subject matter for the Supreme Court, the implications of this decision will resonate far beyond cheerleading uniforms. Star Athletica, in its petition for certiorari, argued that this case involved “the most vexing, unresolved question in copyright law: how to determine whether a feature of a useful article—such as a garment or piece of furniture—is conceptually separable from the article and thus protectable.”¹⁸

The determination of separability¹⁹ has proven to be particularly difficult in the context of fashion, likely due to clothing possessing *both* functional and aesthetic attributes. Clothing serves the utilitarian function of protecting the body from natural elements, but also contains original designs that account for purely artistic preferences.²⁰ As illustrated by cases in the Second Circuit, a court will first inquire whether the claimed copyrighted work is physically

¹⁵ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 474–75 (6th Cir. 2015), *cert. granted in part*, 136 S.Ct. 1823 (2016).

¹⁶ See Bonnie Eslinger, *6th Circ. Leaves Cheerleader Uniform IP Protection in Place*, LAW360 (Oct. 7, 2015), <http://www.law360.com/articles/712215/6th-circ-leaves-cheerleader-uniform-ip-protection-in-place> [<https://perma.cc/9V7D-XW23>].

¹⁷ See *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at *9 (W.D. Tenn. Mar. 1, 2014), *vacated*, 799 F.3d 468 (6th Cir. 2015).

¹⁸ Petition for Writ of Certiorari, *supra* note 1, at 5.

¹⁹ The determination of separability is a two-fold standard, which illustrates a philosophical quality to copyright disputes as it often deals with questions of “essence.” See *Varsity Brands*, 2014 WL 819422, at *1 (“The philosopher Plato famously discussed the essence of physical objects as separate from their ideal. Taking the example of a tree, we may well consider as a ‘tree’ a thing with only a few branches and fewer leaves, because it still reflects, however poorly, the ideal we inherently know to be ‘tree.’ It possesses tree-ness.”).

²⁰ See Edward F. Maluf, *Why Creativity Needs IP Protection*, APPAREL (Oct. 13, 2015), <http://apparel.edgl.com/news/Why-Creativity-Needs-IP-Protection102742> [<https://perma.cc/9CRB-CBJT>].

separable from the utilitarian object such that it “can actually be removed from the original item and separately sold, without adversely impacting the article’s functionality.”²¹ If the design elements are not physically separable, a court will undertake another inquiry into whether the elements are “conceptually separable.”²²

With no clear approach to determining whether the artistic and utilitarian aspects of useful articles are conceptually separable, courts and scholars have devised a number of ways to apply this standard.²³ Indeed, in *Varsity Brands*, the Sixth Circuit argued that there are as many as nine existing conceptual separability tests, before formulating its own “hybrid” approach, adding to the already convoluted area of law.²⁴ Consequently, the multitude of approaches have led to inconsistent results among the courts. Thus, by agreeing to hear the case, “the Supreme Court has the opportunity to settle the law of clothing and copyright, which currently is anything but clear.”²⁵

This Note focuses on the need to harmonize copyright law by determining one uniform application of conceptual separability for all courts and scholars to follow. Part I discusses the history of copyright law in the context of useful articles, the development of the separability standard, and the relevant statutory language of the Copyright Act. Part II introduces ten existing conceptual separability tests used by courts and scholars today, explains why the existing tests are inadequate, and addresses the need for one conceptual

²¹ See *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328–29 (2d Cir. 2005); see also *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (providing a classic example of a copyrightable design that satisfies the physical separateness requirement is an ornament that is affixed to a belt buckle that could also be worn separately as a pin).

²² See Maluf, *supra* note 20.

²³ See generally Barton R. Keyes, Note, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L.J. 109 (2008).

²⁴ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484–87 (6th Cir. 2015), *cert. granted in part*, 136 S.Ct. 1823 (2016).

²⁵ Press Release, Shiva Stella, Pub. Knowledge, *Supreme Court Agrees to Hear Star Athletica v. Varsity Brands* (May 2, 2016), <https://www.publicknowledge.org/press-release/supreme-court-agrees-to-hear-star-athletica-v-varsity-brands> [<https://perma.cc/AMK9-FP3U>].

separability test. Part III proposes a new single conceptual separability test, and highlights the advantages of its application.

I. THE DEVELOPMENT OF COPYRIGHT PROTECTION FOR USEFUL ARTICLES

Before delving into the intricacies of conceptual separability, it is necessary to introduce some background information on copyright law. Section A reflects on the creation of copyright law for useful articles and the powers vested in Congress through the U.S. Constitution to create such law. Section B examines *Mazer v. Stein*, the first case involving the concept of separability in copyright. Section C discusses the current separability standard and the legislative history leading up to its codification.

A. Establishing Copyright Law for Useful Articles

The U.S. Constitution grants Congress the power to enact laws establishing a system of copyright in the United States.²⁶ In particular, Article I, Section 8 grants Congress the power to “promote the Progress of Science and useful Arts.”²⁷ Since the first federal copyright law in 1790, which protected books, maps, and charts, Congress has included some form of useful works of art in its scope of protection.²⁸ It was not until 1870, however, that protection was extended beyond two-dimensional works of the visual arts to include, for the first time, certain three-dimensional works “intended to be perfected and executed as a work of the fine arts.”²⁹ After a series of amendments, Congress eliminated the 1870 “fine arts” requirement and broadened the scope of copyright protection to include all “[w]orks of art; models or design for works of art” in

²⁶ See U.S. COPYRIGHT OFFICE, CIRCULAR 1A, UNITED STATES COPYRIGHT OFFICE A BRIEF INTRODUCTION AND HISTORY, <http://copyright.gov/circs/circ1a.html> [https://perma.cc/J3ZK-D6W5] (last visited Oct. 6, 2016).

²⁷ U.S. CONST. art. I, § 8, cl. 8.

²⁸ See U.S. COPYRIGHT OFFICE, *supra* note 26.

²⁹ See Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (repealed 1909).

the 1909 Act.³⁰ The broadening of copyright beyond the purely aesthetic thus set the stage for protecting designs of utilitarian works.³¹

B. *Mazer v. Stein*

In 1954, forty-five years after the enactment of the 1909 Act, the Supreme Court made its first and, to this date, only venture into the statutory and administrative ambit of copyright protection for useful articles when it decided *Mazer v. Stein*.³² At issue in *Mazer* were statuettes of male and female dancing figures “intended for use and used as bases for table lamps, with electric wiring, sockets and lamp shades attached.”³³ The plaintiff, the manufacturer of the lamps, successfully registered the statuettes (sans lamp components) with the U.S. Copyright Office as “works of art” under the Copyright Act of 1909.³⁴ The plaintiff sold the statuettes throughout the United States, with the majority of profits coming from sales of the statuette in its functional lamp assembly.³⁵ The plaintiff brought suit against the defendant, a competing manufacturer, who copied plaintiff’s statuettes without permission and sold copies of the statuettes for defendant’s own lamps.³⁶

The issue in *Mazer* was presented as follows: “Can statuettes be protected . . . when the copyright applicant intended primarily to use the statuettes in the form of lamp bases . . . ?”³⁷ The Supreme Court answered in the affirmative, concluding the statuettes were eligible for copyright protection.³⁸ The Court explained that the use or intended use of the statuettes as lamp bases did not bar or invalidate its registration as copyrightable works of art.³⁹ In making its decision, the Supreme Court referred to the development of the Copyright Act, the legislative history of the 1909 Act, and the

³⁰ See Copyright Act of 1909, Pub. L. No. 60-349, ch. 320, § 5, 35 Stat. 1075, 1077 (repealed 1976).

³¹ See Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC’Y 339, 342 (1990).

³² 347 U.S. 201 (1954).

³³ *Id.* at 202.

³⁴ *See id.* at 202–03.

³⁵ *See id.* at 203.

³⁶ *See id.*

³⁷ *Id.* at 204–05.

³⁸ *See id.* at 214.

³⁹ *See id.* at 218.

Copyright Office’s practices.⁴⁰ The Court explained that the removal of “fine art” in the 1909 Act eliminated any “[v]erbal distinctions between purely aesthetic articles and useful works of art,” and was intended “to include more than the traditional fine arts.”⁴¹ In determining that the statuettes qualified as “works of art,” the Court held:

Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. . . . [Works of art] must be original, that is, the author’s tangible expression of his ideas. Such expression, whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color, is copyrightable.⁴²

C. Codifying the Current Separability Standard

Following the *Mazer* decision, the Copyright Office, at the request of Congress, evaluated the current copyright law and proposed regulations to be used for a comprehensive reform of the 1909 Copyright Act.⁴³ In 1961, the Register of Copyrights⁴⁴ issued his recommendations:⁴⁵ The Register acknowledged the holding in *Mazer*, but still intended to not “extend the copyright law to industrial designs.”⁴⁶ Regarding the copyrightability of useful articles, the regulation stated: “If the *sole* intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art.”⁴⁷ This first sentence of the reg-

⁴⁰ See Perlmutter, *supra* note 31, at 344.

⁴¹ See *Mazer*, 347 U.S. at 211–13.

⁴² *Id.* at 214 (citation omitted); *cf.* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (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.”).

⁴³ See Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 717–18 (1983).

⁴⁴ The Register of Copyrights, as the director of the Copyright Office, is responsible for all administrative functions and duties under the Copyright Act and is authorized to establish regulations consistent with the Copyright Act. 17 U.S.C. § 701 (2012).

⁴⁵ See STAFF OF H. COMM. ON THE JUDICIARY, 87TH CONG., REP. OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 14–15 (Comm. Print 1961).

⁴⁶ *Id.* at 13.

⁴⁷ 37 C.F.R. § 202.10(c) (1960) (emphasis added).

ulation was created entirely by the Copyright Office, raising a new issue of determining the “sole intrinsic function” of a particular article.⁴⁸ The regulation further stated: “However if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be *identified separately and are capable of existing independently* as a work of art, such features will be eligible for registration.”⁴⁹ The second sentence essentially paraphrased the holding in *Mazer* and established what came to be known as the separability standard.

Congress selected particular regulations suggested by the Copyright Office, including the separability standard, and codified them in what is now known as the Copyright Act of 1976 (the “1976 Act”).⁵⁰ The 1976 Act, which grants copyright protection to “original works of authorship fixed in any tangible medium of expression,” is the current copyright law of the United States.⁵¹ Section 102(a) of the Act affords copyright protection to categories of “works of authorship,” including “pictorial, graphic, and sculptural works.”⁵² By replacing the term “works of art” from the 1909 Act with the “pictorial, graphic, sculptural works” (“PGS”) category, Congress sought to finally end copyright’s association with fine arts.⁵³ Section 101 of the 1976 Act defines PGS works as “two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.”⁵⁴ The definition continues: “Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned.”⁵⁵ The final part of the PGS definition draws from the language of the Copyright Office regulation: The design of a useful article shall be considered a PGS work “only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be

⁴⁸ See Perlmutter, *supra* note 31, at 346.

⁴⁹ § 202.10(c) (emphasis added).

⁵⁰ See 17 U.S.C. § 101 (2012).

⁵¹ See *id.* § 102.

⁵² *Id.*

⁵³ See § 101.

⁵⁴ *Id.*

⁵⁵ *Id.*

*identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”*⁵⁶

The definition of PGS works also cross-references the definition of a “useful article.”⁵⁷ It was here that Congress’s language in the 1976 Act was a significant deviation from the Copyright Office’s recommended regulation. Congress removed the word “sole” contained in the Copyright Office regulation, leaving section 101 of the Act to define a “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁵⁸ This omission broadened the scope of “useful articles” from works that have *exclusive* utilitarian function to those that have *any* utilitarian function.⁵⁹ In effect, this expansion in scope actually limited the number of copyrightable works by subjecting more works to the separability standard.⁶⁰

It is common ground among courts that the language added by the 1976 Act was intended to differentiate creative works that enjoy protection from those elements of industrial design that do not.⁶¹ Although Congress may have had a clear goal in mind, application of this language has presented courts with considerable difficulty.⁶² Indeed, as one scholar noted: “Of the many fine lines that run through the Copyright Act, none is more troublesome than the line between protectible pictorial, graphic and sculptural works and unprotectible [sic] utilitarian elements of industrial design.”⁶³ Since the Copyright Act defines neither “identified separately” nor “existing independently,”⁶⁴ the Copyright Act’s legislative history is

⁵⁶ *Id.* (emphasis added).

⁵⁷ *See id.*

⁵⁸ *Id.*

⁵⁹ *See* Perlmutter, *supra* note 31, at 350. *Compare* § 101 (“A ‘useful article’ is an article having an *intrinsic utilitarian function* that is not merely to portray the appearance of the article or to convey information.” (emphasis added)), *with* 37 C.F.R. § 202.10(c) (1960) (“If the *sole intrinsic function* of an article is its utility the fact that the article is unique and attractively shaped will not qualify it as a work of art.” (emphasis added)).

⁶⁰ *See* Perlmutter, *supra* note 31, at 350.

⁶¹ *See* Pivot Point Int’l, Inc. v. Charlene Products, Inc., 372 F.3d 913, 920–21 (7th Cir. 2004).

⁶² *See id.* at 921.

⁶³ 1 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.5.3 (3d ed. 2005).

⁶⁴ § 101.

looked to for guidance. The congressional report⁶⁵ explains that the purpose behind Congress's language was "to draw as clear a line as possible between copyrightable works of applied art and non-protectable works of industrial design."⁶⁶ The report emphasizes the legislature's intent to exclude industrial design from protection:

Although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an . . . industrial product contains some element that, physically *or conceptually*, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.⁶⁷

The report's most notable reference is the potential for copyright protection of an element that can be conceptually identified as being separable from the useful article.⁶⁸ This language of conceptual separability produced a wide variety of ways to interpret the separability standard. Consequently, the report's attempt for clarification may have only blurred the line between copyrightable expression and non-copyrightable utilitarian designs, thus laying out the inevitable demand for judicial analysis.

II. THE INADEQUACIES OF CONCEPTUAL SEPARABILITY AS CURRENTLY APPLIED

In his dissenting opinion in *Varsity Brands*, Judge McKeague made clear that a resolution for conceptual separability was

⁶⁵ Congressional reports are the designated class of publications by which congressional committees report and make recommendations to the House or Senate as a whole. These reports concern the findings of committee hearings or the outcome of committee deliberations. They can contain discussions of legislative intent, a short history of a bill, and comparisons of current and proposed law text. Specific to this Note's discussion, House Report No. 94-1476 addressed the general revision of the Copyright Law, title 17 of the United States Code.

⁶⁶ H.R. REP. No. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668.

⁶⁷ *Id.* (emphasis added).

⁶⁸ See Perlmutter, *supra* note 31, at 351.

needed.⁶⁹ “The law in this area is a mess—and it has been for a long time,” Judge McKeague wrote.⁷⁰ “The majority takes a stab at sorting it out, and so do I. But 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.”⁷¹ Accordingly, Section A introduces the existing conceptual separability tests that are currently used by courts and scholars. Section B highlights particular conceptual separability tests that should not be considered by the Supreme Court in *Star Athletica v. Varsity Brands*. Section C addresses the conflicts which arise when courts use multiple conceptual separability tests in their analysis.

A. Existing Conceptual Separability Tests

In *Varsity Brands*, the Sixth Circuit examined nine conceptual separability tests that are currently used by courts and scholars. In the end, the Sixth Circuit created a tenth test for determining conceptual separability, adding to this already crowded and confusing territory of copyright law.

1. Copyright Office’s Approach

Under the Copyright Office’s approach to conceptual separability, the artistic features of a useful article “must be imagined separately and independently from the useful article without destroying the basic shape of that article.”⁷² In other words, if the artistic features are an integral part of the overall shape or contour of the useful article, the features are not conceptually separable because removing the features would destroy the basic shape.⁷³ This approach provides an objective basis for visualizing the artistic features and the useful article as separate and independent works.⁷⁴ Thus, a “pictorial, graphic, or sculptural feature satisfies [the conceptual separability] requirement only if the artistic feature and the

⁶⁹ See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 496 (6th Cir. 2015) (McKeague, J., dissenting), *cert. granted in part*, 136 S.Ct. 1823 (2016).

⁷⁰ *Id.* at 496–97.

⁷¹ *Id.* at 497.

⁷² U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2(B) (3d ed. 2014) [hereinafter COMPENDIUM III].

⁷³ See *id.*

⁷⁴ See *id.*

useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article.”⁷⁵

To illustrate its analysis, the Copyright Office gives the example of a carving on the back of a chair.⁷⁶ The Copyright Office explains that the carving is conceptually separable from the chair, and thus copyrightable, “because one could imagine the carving . . . as a drawing on a piece of paper that is entirely distinct from the overall shape of the chair.”⁷⁷ Moreover, even if the carving was removed, the shape of the chair would remain unchanged and would still be capable of serving its useful purpose.⁷⁸

2. Primary-Subsidiary Approach

The primary-subsubsidiary approach⁷⁹ arose out of *Kieselstein-Cord v. Accessories by Pearl*⁸⁰ in 1980. The case was declared to be “on the razor’s edge of copyright law” as it involved drawing a “fine line” under applicable copyright law to determine whether belt buckles, a utilitarian object, could be eligible for copyright protection.⁸¹ The Second Circuit held that the primary ornamental aspect of the buckles was conceptually separate from the belts’ subsidiary utilitarian function.⁸² Thus, the primary-subsubsidiary approach allows PGS features to be copyrightable when the artistic features of the design are “primary” to the “subsidiary utilitarian function.”⁸³

3. Objectively Necessary Approach

The objectively necessary approach⁸⁴ developed from *Carol Barnhart Inc. v. Economy Cover Corp.*⁸⁵ in 1985. The Second Circuit held that mannequins of partial human torsos used to display ar-

⁷⁵ *Id.*

⁷⁶ *See id.*

⁷⁷ *Id.*

⁷⁸ *See id.*

⁷⁹ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484 (6th Cir. 2015), *cert. granted in part*, 136 S. Ct. 1823 (2016).

⁸⁰ 632 F.2d 989 (2d Cir. 1980).

⁸¹ *Id.* at 990.

⁸² *See id.* at 993.

⁸³ *Id.*

⁸⁴ *Varsity*, 799 F.3d at 484.

⁸⁵ 773 F.2d 411 (2d Cir. 1985).

ticles of clothing were not copyrightable.⁸⁶ The court explained that the mannequins were utilitarian articles that did not possess artistic or aesthetic features that were conceptually separable from their utilitarian dimension.⁸⁷ The Second Circuit arrived at this approach by looking to the legislative history of the 1976 Act.⁸⁸ Applying the principles found within the legislative history,⁸⁹ the court was persuaded by the fact that the aesthetic and artistic features of the mannequins were inseparable from the forms’ use as utilitarian articles.⁹⁰ Moreover, “to the extent the forms possess aesthetically pleasing features, even when these features are considered in the aggregate, they cannot be conceptualized as existing independently of their utilitarian function.”⁹¹ Put another way, the objectively necessary approach finds that a PGS feature is conceptually separable if the artistic features of the design are not necessary to the performance of the utilitarian function of the article.⁹²

4. Ordinary-Observer Approach

The ordinary-observer approach⁹³ stems from Judge Newman’s dissenting opinion in *Carol Barnhart*.⁹⁴ Judge Newman explained that for a design feature to be conceptually separable, “the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”⁹⁵ Therefore, two questions are to be asked in this analysis: (1) who is the beholder, and (2) when may a concept be considered separate?⁹⁶ Judge Newman believed that “the relevant beholder must

⁸⁶ *See id.* at 418

⁸⁷ *See id.*

⁸⁸ *See id.* at 415.

⁸⁹ *See id.* at 418 (“The legislative history thus confirms that, while copyright protection has increasingly been extended to cover articles having a utilitarian dimension, Congress has explicitly refused copyright protection for works of applied art or industrial design which have aesthetic or artistic features that cannot be identified separately from the useful article.”).

⁹⁰ *See id.*

⁹¹ *Id.*

⁹² *See id.* at 419.

⁹³ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484 (6th Cir. 2015), *cert. granted in part*, 136 S. Ct. 1823 (2016).

⁹⁴ *See Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting).

⁹⁵ *Id.*

⁹⁶ *See id.*

be that most useful legal personage—the ordinary, reasonable observer.”⁹⁷ This “person” is the same profile used to decide many conceptual issues in copyright law, such as the concept of “substantial similarity.”⁹⁸ Judge Newman concluded that the design concept is separate “only when the non-utilitarian concept can be entertained in the mind of the ordinary observer without at the same time contemplating the utilitarian function.”⁹⁹ In other words, a PGS feature is conceptually separable if “the design creates in the mind of the ordinary [reasonable] observer two different concepts that are not inevitably entertained simultaneously.”¹⁰⁰

5. Design-Process Approach

The design-process approach¹⁰¹ stems from Robert Denicola’s article, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*.¹⁰² Professor Denicola argues that copyrightability “ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations.”¹⁰³ In the 1987 case *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, the Second Circuit found Denicola’s approach to be the best test for conceptual separability.¹⁰⁴ The Second Circuit, in addressing its deviation from the conceptual separability approach used in *Carol Barnhart* two years prior, explained that perhaps the difference between the majority and the dissent in *Carol Barnhart* might have been resolved had they had Denicola’s article before them.¹⁰⁵ Thus, the Second Circuit, by adopting Denicola’s approach, held that a PGS feature is conceptually separable

⁹⁷ *Id.*

⁹⁸ *Id.* For an explanation of how the “ordinary observer” personage is used in substantial similarity analysis, see *Boisson v. Baniar, Ltd.*, 273 F.3d 262, 271–72 (2d Cir. 2001).

⁹⁹ *Carol Barnhart*, 773 F.2d at 423 (Newman, J., dissenting).

¹⁰⁰ *See id.* at 422.

¹⁰¹ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484 (6th Cir. 2015), *cert. granted in part*, 136 S. Ct. 1823 (2016).

¹⁰² Robert C. Denicola is a Professor of Law at the University of Nebraska. *See generally* Denicola, *supra* note 43.

¹⁰³ *Id.* at 741.

¹⁰⁴ *See* 834 F.2d 1142, 1145 (2d Cir. 1987).

¹⁰⁵ *See id.*

if the “design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.”¹⁰⁶

The design-process approach was revisited in the 2004 case *Pivot Point International, Inc. v. Charlene Products, Inc.*, which involved a female mannequin head named “Mara.”¹⁰⁷ The Seventh Circuit reasoned that the mannequin could be conceptualized as existing independent from its use in hair display or make-up training because it was the product of the designer’s artistic judgment.¹⁰⁸ The designer was not constrained by any specific measurements or dimensions; indeed, there was no evidence that the designer’s artistic judgment was constrained by functional considerations.¹⁰⁹ Rather, the designer “had carte blanche to implement that vision as he saw fit.”¹¹⁰ By contrast, this was not a situation, such as in *Carol Barnhart*, in which the mannequin features were included in the design for purely functional reasons.¹¹¹ Thus, the Seventh Circuit held that because the “Mara” mannequin was “the product of a creative process unfettered by functional concerns,” it therefore met the requirements of conceptual separability and was eligible for copyright protection.¹¹²

6. Stand-Alone Approach

The stand-alone approach¹¹³ stems from Judge Kanne’s dissenting opinion in *Pivot Point*.¹¹⁴ Judge Kanne proposed that when determining the copyrightability of a PGS feature, the important question to ask is “whether the features themselves are utilitarian aspects of the useful article.”¹¹⁵ In other words, under the stand-

¹⁰⁶ *Id.*

¹⁰⁷ 372 F.3d 913, 915 (7th Cir. 2004).

¹⁰⁸ *See id.* at 931.

¹⁰⁹ *See id.*

¹¹⁰ *Id.* at 932.

¹¹¹ *See Brandir*, 834 F.2d at 1145 (“[I]n *Carol Barnhart* the distinctive features of the torsos—the accurate anatomical design and the sculpted shirts and collars—showed clearly the influence of functional concerns.”).

¹¹² *Pivot Point*, 372 F.3d at 932.

¹¹³ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484 (6th Cir. 2015), *cert. granted in part*, 136 S. Ct. 1823 (2016).

¹¹⁴ *See Pivot Point*, 372 F.3d at 934 (Kanne, J., dissenting).

¹¹⁵ *Id.*

alone approach, a pictorial, graphic, or sculptural feature is conceptually separable if “the useful article’s functionality remain[s] intact once the copyrightable material is separated.”¹¹⁶ Therefore, Mara’s features could not be copyrighted because taking away the facial features would greatly diminish or eliminate the mannequin’s functionality.¹¹⁷

7. Likelihood-of-Marketability Approach

The likelihood-of-marketability approach¹¹⁸ stems from the language of the leading treatise in the field, *Nimmer on Copyright*.¹¹⁹ Nimmer considers conceptual separability to exist where “there is any substantial likelihood that, even if the article had no utilitarian use, it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.”¹²⁰ In other words, a PGS work is considered conceptually separable from its utilitarian counterpart if the aesthetic element would have market value on its own.

In *Galiano v. Harrah’s Operating Co.*, the Fifth Circuit endorsed Nimmer’s approach as applied to garment designs only.¹²¹ The basic issue in *Galiano* was whether casino uniforms were copyrightable.¹²² The Fifth Circuit acknowledged that the conceptual separability test is not precisely defined but found, however, that the likelihood-of-marketability test was the most determinative analysis at that time.¹²³ Ultimately, the Fifth Circuit held that the designs were not marketable independently of their utilitarian function as casino uniforms.¹²⁴

¹¹⁶ *Id.*

¹¹⁷ *See id.*

¹¹⁸ *Varsity Brands*, 799 F.3d at 484.

¹¹⁹ 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2A.08[B][4], LEXIS (database updated June 2016).

¹²⁰ *Id.*

¹²¹ *See* 416 F.3d 411, 421 (5th Cir. 2005).

¹²² *See id.* at 416.

¹²³ *See id.* at 421.

¹²⁴ *See id.* at 422.

8. Patry’s Approach

Copyright expert William Patry’s approach, which claims “[s]eparability need not be complex or elusive,”¹²⁵ relies on the statutory language of the Copyright Act. Accordingly, when determining whether PGS features are protectable under the Copyright Act, Patry’s approach focuses on whether the PGS features are capable of existing independently of the utilitarian *aspects* of the useful article.¹²⁶ Patry’s approach emphasizes the fact that the features must be capable of existing as *intangible* features independent of the utilitarian *aspects* of the article, not the article as a whole.¹²⁷ The 1976 Act redirected the focus away from “article” by using the term “aspect” which made clear that “the protected features need not be capable of existing apart from the article, only from its functional aspects.”¹²⁸

Put another way, Patry’s approach inquires whether the PGS features are “dictated by the form or function of the utilitarian aspects of the useful article.”¹²⁹ If the features are dictated by the form or function of the utilitarian aspects of the useful article, then the features are not capable of existing independently of the utilitarian aspects.¹³⁰ To the contrary, if the PGS features are *not* dictated by the form or function of the functional aspects, then the features can be said to be capable of existing independently, and consequently are eligible for copyright.¹³¹

9. Subjective-Objective Approach

Under the subjective-objective approach,¹³² conceptual separability is determined by balancing two considerations: (1) “the degree to which the designer’s subjective process is motivated by aesthetic concerns,” and (2) “the degree to which the design of a use-

¹²⁵ 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:146, Westlaw (database updated Sept. 2016).

¹²⁶ *See id.*

¹²⁷ *See id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *See id.*

¹³¹ *See id.*

¹³² *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 485 (6th Cir. 2015), *cert. granted in part*, 136 S. Ct. 1823 (2016).

ful article is objectively dictated by its utilitarian function.”¹³³ The first consideration requires courts to assess “the degree to which aesthetic concerns, as opposed to functional ones, motivate the designer.”¹³⁴ The second consideration focuses on whether “the design is mostly dictated by function” or “hardly dictated by function at all.”¹³⁵ If the useful article’s design is “mostly dictated by function,” then the design elements are likely not conceptually separable from the useful article, and thus ineligible for copyright protection.¹³⁶ To the contrary, if the design is “hardly dictated by function at all,” then the courts will more likely consider the PGS work to be copyrightable.¹³⁷

10. Sixth Circuit’s “Hybrid” Approach

In *Varsity Brands*, the Sixth Circuit, after analyzing the nine previous conceptual separability tests, came up with its own “hybrid” approach, grounded in the language of the Copyright Act.¹³⁸ The Sixth Circuit found the best approach was to engage in a five-question inquiry. The court first asks: (1) “Is the design a pictorial, graphic, or sculptural work?”¹³⁹ If the design is a PGS work, then the court next asks: (2) “[I]s it a design of a useful article,” and (3) “[w]hat are the utilitarian aspects of the useful article?”¹⁴⁰ Here, the court gave an example of a chair, explaining that the chair is a useful article because it serves the utilitarian purpose of providing a place for a person to sit.¹⁴¹ Once the court has identified permissible utilitarian aspects, the court asks two final questions: (4) “Can the viewer of the design identify ‘pictorial, graphic, or sculptural features’ ‘separately from... the utilitarian aspects of the useful article?’”¹⁴² And if so, the court asks: (5) “Can ‘the pictorial, graphic, or sculptural features’ [identified in response to question

¹³³ Keyes, *supra* note 23, at 141.

¹³⁴ *Id.*

¹³⁵ *Id.* at 142.

¹³⁶ *See id.*

¹³⁷ *Id.*

¹³⁸ *See Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 487 (6th Cir. 2015), *cert. granted in part*, 136 S.Ct. 1823 (2016).

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *See id.*

¹⁴² *Id.* at 488.

four] ‘exist independently of the utilitarian aspects’ [identified in response to question three]?”¹⁴³

The Sixth Circuit’s test is viewed as a hybrid approach because the court borrowed aspects from several other existing tests. For example, the objectively necessary approach is used to answer the fifth question: If the PGS features of the useful article are “not... required by utilitarian functions” or are “wholly unnecessary to performance of the utilitarian function,” then the PGS features are not dictated by the function of the useful article, and therefore can exist independently.¹⁴⁴ Additionally, the Sixth Circuit took the design-process approach into consideration because the designer’s testimony may offer guidance as to which components of the design are necessary to the functionality of the useful article.¹⁴⁵ The court also found the Copyright Office’s approach to be helpful in its analysis: Conceptual separability exists if “the artistic feature [of the design] and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article.”¹⁴⁶ In other words, if the observer can imagine the PGS features of a useful article as an artistic work, then those features are separately identifiable and can exist independently.

B. Mounting Inadequacies of Current Conceptual Separability Tests

The existing conceptual separability tests differ in the article at issue and the method by which courts and scholars evaluate the article’s eligibility for copyright protection.¹⁴⁷ As such, depending on the subject at issue, there are varying advantages and disadvantages to the existing approaches. However, the overall status is multiple conflicting tests employed by the courts with no clear definition of the conceptual separability standard.¹⁴⁸ Not only do several of these tests clash with each other, but some tests lack suffi-

¹⁴³ *Id.*

¹⁴⁴ *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985).

¹⁴⁵ *See Varsity Brands*, 799 F.3d at 488 (citing *Pivot Point Int’l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 931–32 (7th Cir. 2004)). However, the Sixth Circuit did not endorse the design-process approach in its entirety. *Id.*

¹⁴⁶ *Varsity Brands*, 799 F.3d at 488–89 (quoting COMPENDIUM III, *supra* note 72).

¹⁴⁷ *See Pivot Point*, 372 F.3d at 930.

¹⁴⁸ *See supra* Section II.A.

cient support within their own analysis. Since this Note will propose a new, single conceptual separability test as the most effective,¹⁴⁹ it is not necessary to address and weigh the flaws of each individual conceptual separability test. However, there are three tests—the primary-sub subsidiary approach, the design-process approach, and the likelihood-of-marketability approach—which are particularly weak in their comprehension and application. Thus, the Supreme Court should avoid these tests in particular when considering the appropriate conceptual separability standard.

To begin, the problem with the primary-sub subsidiary approach is that it offers little guidance to the trier of fact as to what is being measured by the classifications of “primary” and “sub subsidiary.” To illustrate this point, Judge Weinstein dissented in *Kieselstein-Cord* arguing that the majority opinion’s decision marked a distinct shift from prior developments in the law.¹⁵⁰ Judge Weinstein argued:

[C]ourts . . . have tried to follow the principle of the [C]opyright [A]ct permitting copyright to extend only to ornamental or superfluous designs contained within useful objects while denying it to artistically designed functional components of useful objects. Generally they have favored representational art as opposed to non-representation artistic forms which are embodied in, and part of the structure of, a useful article.¹⁵¹

The concerns associated with the primary-sub subsidiary approach were further addressed in the dissenting opinion of *Carol Barnhart*.¹⁵² Judge Newman, in his dissenting opinion, claimed that the primary-sub subsidiary approach “does not focus on frequency of utilitarian and non-utilitarian usage since the belt buckles in [the *Kieselstein-Cord*] case were frequently used to fasten belts and less of-

¹⁴⁹ See *infra* Part III.

¹⁵⁰ See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 996 (2d Cir. 1980) (Weinstein, J., dissenting).

¹⁵¹ *Id.*

¹⁵² See *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 421–22 (2d Cir. 1985) (Newman, J., dissenting).

ten used as pieces of ornamental jewelry displayed at various locations other than the waist.”¹⁵³

Additionally, the design-process approach exemplifies another ineffective conceptual separability test. For instance, in *Brandir*, the Second Circuit argued that Denicola’s design-process approach was not difficult to administer in practice.¹⁵⁴ However, the inability to practically apply this approach is exactly where the design-process approach fails. The Second Circuit claimed that the “work itself will continue to give ‘mute testimony’ of its origins” and that parties will be required to provide evidence relating to their design process and the nature of their work.¹⁵⁵ However, this approach, which relies on the designer’s personal artistic judgment, seems near impossible, if not at the very least counterintuitive, to allow for a comprehensive, unbiased analysis of the work.

Furthermore, Judge Kanne, in his dissenting opinion in *Pivot Point*, was of a similar position regarding the design-process approach. Judge Kanne argued that the majority opinion in *Pivot Point* bore little resemblance to the copyright statute.¹⁵⁶ Further, he claimed that the “copyright statute is concerned with protecting only non-utilitarian features of the useful article.”¹⁵⁷

Finally, the likelihood-of-marketability approach has been heavily criticized for its impractical application. Even the Fifth Circuit in *Galiano* was aware of the pitfalls involved when applying the likelihood-of-marketability approach.¹⁵⁸ For example, the approach “might unduly favor more conventional forms of art” over modern ideas.¹⁵⁹ Another problem with this “market” approach is that it runs the risk of restricting copyright protection to only those articles that the market demands.¹⁶⁰ This is a hazard that even Nim-

¹⁵³ *Id.* at 421.

¹⁵⁴ *See Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

¹⁵⁵ *Id.*

¹⁵⁶ *See Pivot Point Int’l v. Charlene Prods., Inc.*, 372 F.3d 913, 934 (7th Cir. 2004) (Kanne, J., dissenting).

¹⁵⁷ *Id.*

¹⁵⁸ *See Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 421 (5th Cir. 2005).

¹⁵⁹ *Id.* at 421 n.26.

¹⁶⁰ *See Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting).

mer has acknowledged.¹⁶¹ Copyright restriction is at issue because there is likely a much wider range of people who would consider a sculpted form a piece of art, than there are people who are actually capable or willing to purchase the sculpted forms.¹⁶²

The Fifth Circuit attempted to reason that these issues were trade-offs it was willing to make in order to have a determinative rule,¹⁶³ but this is a significant concern in the area of copyright. The court's defense that its single-subject test aligns with other single-subject tests is inaccurate. To illustrate, the Fifth Circuit gives the example of an allegedly different test for the protection of maps.¹⁶⁴ Yet, "[m]aps are not subject to the separability test, and in fact, the Fifth Circuit does not apply a different standard for protection for maps than for any other work."¹⁶⁵ Moreover, the Fifth Circuit claimed their approach was less problematic because it applied only to one art form.¹⁶⁶ However, this singular approach may only lead to a plethora of tests for different types of applied art, inevitably creating even more confusion.

C. The Need for One Uniform Application of Conceptual Separability

Not only are several of the existing conceptual separability tests inadequate in their own capacity, but courts' application of multiple tests has also lead to paradoxical results. The question has been presented: "[I]f all roads lead to Rome, then why restrict the conceptual separability inquiry to one test?"¹⁶⁷ In other words, what is the need for one conceptual separability test if the existing conceptual separability tests eventually provide for the same result? The answer is simple: the choice of which test to apply is outcome determinative.¹⁶⁸ As *Star Athletica* addressed in its petition for certiorari, one test may result in granting copyright protection

¹⁶¹ 1 NIMMER & NIMMER, *supra* note 119.

¹⁶² *See Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting).

¹⁶³ *See Galiano*, 416 F.3d at 421.

¹⁶⁴ *See id.* at 422 n.27.

¹⁶⁵ 2 PATRY, *supra* note 125, § 3:143 n.2.

¹⁶⁶ *See Galiano*, 416 F.3d at 421–22.

¹⁶⁷ Susan Scafidi, Dir., Fashion Law Inst., Panel Presentation at the Fashion Law Institute's Sixth Annual Symposium: Fashion Planet (Apr. 22, 2016).

¹⁶⁸ *See* Petition for Writ of Certiorari, *supra* note 1, at 27.

to a PGS work, while another test may not.¹⁶⁹ Thus, there is a very apparent need to reexamine and harmonize the way in which we analyze conceptual separability.

There is room for debate as to whether there are in fact ten distinct tests.¹⁷⁰ However, regardless of an exact number, the use of more than one test has already created conflict among the courts.¹⁷¹ Furthermore, as each decision in this area develops, it is likely that courts and scholars will continue to articulate additional tests. This is evidenced by the tendency of dissenting judges to propose a different test than what the majority adopts.¹⁷² Ultimately, a major concern that underlines the current state of conceptual separability is the fact that the numerous existing conceptual separability tests have created unreliable results in copyright law.

To illustrate this issue, Star Athletica addressed two cases relevant to the discussion of conceptual separability in the context of apparel.¹⁷³ First, Star Athletica discussed *Galiano v. Harrah’s Operating Co.*, in which the Fifth Circuit considered whether a casino was prevented from making actual uniforms based on copyrighted two-dimensional sketches of the uniform.¹⁷⁴ The Fifth Circuit used the likelihood-of-marketability approach, which draws from the language of *Nimmer on Copyright*,¹⁷⁵ and limited its application to

¹⁶⁹ See *id.*

¹⁷⁰ See, e.g., Tom Kjellberg, Cowan Liebowitz & Latman, P.C., Panel Presentation at the Fashion Law Institute’s Sixth Annual Symposium: Fashion Planet (Apr. 22, 2016) (“There is no circuit split. These [conceptual separability] tests are just different analytical frameworks.”).

¹⁷¹ See Craig B. Whitney & Rachel Kronman, *Debating Designs: Varsity Brands and Intellectual Property Protection for Fashion Designs*, 24 NYSBA BRIGHT IDEAS, no. 3, Winter 2015, at 18, 18.

¹⁷² See, e.g., *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 496 (6th Cir. 2015) (McKeague, J., dissenting), *cert. granted in part*, 136 S.Ct. 1823 (2016); *Pivot Point Int’l, Inc. v. Charlene Prods. Inc.*, 372 F.3d 913, 934 (7th Cir. 2004) (Kanne, J., dissenting); *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1151 (2d Cir. 1987) (Winter, J., concurring in part and dissenting in part); *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting).

¹⁷³ See *Varsity Brands*, 779 F.3d at 486.

¹⁷⁴ See 416 F.3d 411, 413–14 (5th Cir. 2005).

¹⁷⁵ See 1 NIMMER & NIMMER, *supra* note 119 (stating that conceptual separability exists “where there is any substantial likelihood that, even if the article had no utilitarian use, it would still be marketable to some significant segment of the community simply because of its aesthetic qualities”).

garment designs only.¹⁷⁶ Applying this approach to casino uniforms, the Fifth Circuit held that the buttons, pleats, and collars of the uniform were not separable because the designs were not “marketable independently of their utilitarian function as casino uniforms.”¹⁷⁷

In its petition for certiorari, Star Athletica claimed that Varsity’s designs would fail the likelihood-of-marketability test because “Varsity’s cheerleading-uniform designs are not marketable apart from their utilitarian function as cheerleading uniforms.”¹⁷⁸ However, this conclusion is incorrect. To the contrary, Varsity’s copyrighted stripes, chevrons, and zigzags could be incorporated onto the surface of a number of articles, such as warm-ups and gym bags, and therefore the two-dimensional designs are marketable for purposes other than that of the uniform itself.¹⁷⁹

Star Athletica next addressed *Jovani Fashion, Ltd. v. Fiesta Fashions*, in which the Second Circuit determined whether the sequins, crystals, satin ruching, and tulle of the designer’s prom dress were eligible for copyright protection.¹⁸⁰ The court applied the design-process approach, finding that the decorative elements of the prom dress enhanced the clothing’s decorative function.¹⁸¹ The Second Circuit agreed with the district court, which described the function of the prom dress as “a garment specifically meant to cover the body in an attractive way for a special occasion.”¹⁸² The Second Circuit concluded that the designer’s prom dress was not eligible for copyright protection because the aesthetic aspects of the dress were inseparable from the functional aspects.¹⁸³ Important to note for this case in particular, however, is that the way in which the functionality of the prom dress was defined ultimately determined the outcome of the case.¹⁸⁴

¹⁷⁶ See *Galiano*, 416 F.3d at 421.

¹⁷⁷ *Id.* at 421–22.

¹⁷⁸ Petition for Writ of Certiorari, *supra* note 1, at 28.

¹⁷⁹ See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 491 (6th Cir. 2015), *cert. granted in part*, 136 S.Ct. 1823 (2016).

¹⁸⁰ See 500 F. App’x 42, 44 (2d Cir. 2012).

¹⁸¹ See *id.* at 45.

¹⁸² *Id.* at 44.

¹⁸³ See *id.* at 45.

¹⁸⁴ See discussion *infra* Section III.B.1.

The district court in *Varsity Brands* also applied the design-process approach and held that “[a]rtistic judgment and design are undeniably important in this context, but they are not separable from the utilitarian function of the resulting garment.”¹⁸⁵ Judge Cleland further stated that the utilitarian function of a cheerleading uniform is to “clothe the body in a way that evokes the concept of cheerleading.”¹⁸⁶ As a result of the district court considering the function of cheerleading uniforms as identifying the wearer as a cheerleader and enhancing the wearer’s attractiveness, the district court viewed the decorative elements of cheerleading uniforms as intrinsically linked to, and thus inseparable from, the utilitarian aspects.¹⁸⁷

Applying a different conceptual separability approach, the Sixth Circuit analyzed the very same set of facts as the district court, and yet came to a different conclusion in *Varsity Brands*. In particular, under the third question of the Sixth Circuit’s hybrid test, the Sixth Circuit defined the function of a cheerleading uniform namely to “cover the body, wick away moisture, and withstand the rigors of athletic movements.”¹⁸⁸ Thus, by using a different definition of a garment’s functionality, the Sixth Circuit found that the stripes, chevrons, and zigzags were in fact conceptually separable from the utilitarian aspects of the cheerleading uniform.¹⁸⁹

Galiano, Jovani, and Varsity Brands are just a few examples of how the choice of which conceptual separability test to apply entirely affects the outcome of a case. As to be expected with a multitude of tests, there is a mounting frustration among courts regarding the inconsistency within this area of the law.¹⁹⁰ The dissenting

¹⁸⁵ *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at *8 (W.D. Tenn. Mar. 1, 2014), *vacated*, 799 F.3d 468 (6th Cir. 2015), *cert. granted in part*, 136 S.Ct. 1823 (2016).

¹⁸⁶ *Id.*

¹⁸⁷ See Brief for the Respondents in Opposition at 29, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (U.S. Mar. 4, 2016).

¹⁸⁸ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015).

¹⁸⁹ See *id.* at 492.

¹⁹⁰ See Bill Donahue, *In Cheerleader Case, Justices Could Clean Up Fashion ‘Mess,’* LAW360 (Apr. 14, 2016), <http://www.law360.com/articles/784087/in-cheerleader-case-justices-could-clean-up-fashion-mess> [<https://perma.cc/BU2A-KADC>] (“At least nine

opinion in *Varsity Brands* underscores this point; Judge McKeague explained, “the law in this area is a mess—and it has been for a long time.”¹⁹¹ Without the Supreme Court’s determination to have one conceptual separability test, it is very likely that courts and scholars will continue to devise new approaches. The accumulation of conceptual separability inquiries will only congest the already overcrowded and confusing area of copyright law.

Furthermore, in the face of this growing inconsistency among copyright law, artists and creators will be deterred from generating new works of art, which in turn will stifle creativity and innovation.¹⁹² To illustrate, there is a new generation of consumers that are considered a part of the “makers movement.”¹⁹³ Potentially a result of economic shifts, activities such as crafting, “do-it-yourself” projects, and three-dimensional printing are increasingly prevalent.¹⁹⁴ However, without the proper guidance in copyright law, the mounting uncertainty regarding conceptual separability will further burden not only fashion designers, but also the growing industry of so-called makers who will be unsure as to how to protect their works.

Ultimately, the clash between innovation and lack of protection “disrupts the balance of copyright law.”¹⁹⁵ In an effort to protect themselves given this uncertainty, creators tend to make the understandable choice of over-assuming copyright protection by asserting overly broad copyright claims.¹⁹⁶ This tendency effectively muddles the distinction between copyrightable and non-copyrightable works, which in turn thwarts creativity and innova-

distinct approaches have been devised over the years as the courts, in the words of the Sixth Circuit, have ‘struggled mightily to formulate a test’ for conceptual separability.”).

¹⁹¹ *Varsity Brands*, 799 F.3d at 496–97 (McKeague, J., dissenting).

¹⁹² See Brief of Amici Curiae Formlabs Inc. et al. in Support of Petitioner at 10, *Star Athletica*, No. 15-866 (U.S. Feb. 8, 2016) [hereinafter Formlabs Brief].

¹⁹³ See Karen Cator, *Inspiring the Next Generation of Makers*, DIGITAL PROMISE (Mar. 4, 2016), <http://digitalpromise.org/2016/03/04/inspiring-the-next-generation-of-makers/> [https://perma.cc/CF8X-Y6L3].

¹⁹⁴ See *id.*; see also CHRIS ANDERSON, *MAKERS: THE NEW INDUSTRIAL REVOLUTION* 13 (2012) (“We are all Makers. . . . Knitting and sewing, scrapbooking, beading, and cross-stitching—all Making.”).

¹⁹⁵ Formlabs Brief, *supra* note 192.

¹⁹⁶ See *id.*

tion.¹⁹⁷ “Ambiguity pushes the scope of copyright protection outward,” which unjustifiably stifles expression: either designers are inhibited from creating without interferences, or copyright holders are incapable of exercising their rights under conflicting rules for conceptual separability.¹⁹⁸ In the end, the public is deprived of access to creativity.¹⁹⁹

III. RESOLVING THE MOST VEXING PROBLEM IN COPYRIGHT LAW

Since the 1976 Act, there has been no guidance by the Supreme Court regarding conceptual separability. In fact, the last time the Supreme Court addressed the doctrine of conceptual separability was over sixty years ago in *Mazer v. Stein*.²⁰⁰ Thus, the Supreme Court’s decision to hear *Star Athletica v. Varsity Brands*, and hopefully provide clarity on conceptual separability, comes at an imperative time. Accordingly, Section A proposes a new single conceptual separability test for the Supreme Court to adopt. Section B addresses the advantages of this proposed test and why it will allow for an effective application of conceptual separability moving forward.

A. *The Proposed Test for Conceptual Separability*

In essence, this Note’s proposed test for conceptual separability is a two-part inquiry which draws upon the language of the Copyright Office and refines the Sixth Circuit’s “hybrid” approach articulated in *Varsity Brands*.²⁰¹ Specifically, the proposed conceptual separability test asks: (1) what are the claimed design elements of the article; and (2) can those design elements be identified separately from, and exist independently of, the utilitarian features of the article?

¹⁹⁷ *See id.*

¹⁹⁸ *Id.* at 11.

¹⁹⁹ *See id.*

²⁰⁰ *See supra* Section I.B.

²⁰¹ *See Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 487 (6th Cir. 2015), *cert. granted in part*, 136 S.Ct. 1823 (2016).

This Note's proposed test begins its conceptual separability analysis with an identification of the claimed design elements. By placing the design elements at the forefront of the inquiry, as opposed to an article's utilitarian features, a court's analysis follows the statutory language and the constitutional foundation of the Copyright Act.²⁰² Under section 102(a)(5), copyright protection exists in PGS works, which section 101 defines as "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned."²⁰³ The statute first focuses on the design, before articulating any useful features of the work.²⁰⁴ Thus, the claimed design is at the crux of the conceptual separability inquiry; the fact finder should always ask "is the claimed design protectable?"²⁰⁵ Indeed, it is only the creative or expressive features of an article that render the article original and therefore entitled to copyright protection in the first place.²⁰⁶

Once the article's design elements are accurately identified, the fact finder is better situated to analyze the aesthetic features and utilitarian article "side by side."²⁰⁷ This leads the conceptual separability inquiry to the second question of the proposed test: whether the claimed design elements can be "identified separately from" and "exist independently of" the utilitarian aspects of the article.²⁰⁸ Unlike the Sixth Circuit's hybrid approach which makes two distinct inquiries on "separate identification" and "independent existence," this question is posed as a single inquiry.²⁰⁹ As an

²⁰² See Brief of Amicus Curiae American Intellectual Property Law Association in Support of Neither Party at 7, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (U.S. July 22, 2016) [hereinafter AIPLA Brief].

²⁰³ See 17 U.S.C. § 101 (2012).

²⁰⁴ See AIPLA Brief, *supra* note 202.

²⁰⁵ *Id.* at 24.

²⁰⁶ *Id.* at 7; see, e.g., *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) ("[O]riginality is a constitutionally mandated prerequisite for copyright protection.").

²⁰⁷ COMPENDIUM III, *supra* note 72.

²⁰⁸ *Id.*

²⁰⁹ This single, integrated inquiry supports the Seventh Circuit and other courts that have concluded that "Congress, in amending the statute, intended these two phrases to state a single, integrated standard to determine when there is sufficient separateness between the utilitarian and artistic aspects of a work to justify copyright protection." See Brief of Amicus Curiae New York Intellectual Property Law Association in Support of Neither Party at 29, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (U.S. July

integrated inquiry, the test properly interprets the statutory framework set out in the Copyright Act and allows for a simple and practical application of the separability analysis.²¹⁰

In order for a PGS work to be copyrightable, the aesthetic features of the article should not enhance the article’s utilitarian functionality, but rather invoke in the viewer a concept that is separate from that of the article’s utilitarian function.²¹¹ Thus, the PGS features are conceptually separable if the artistic features and the useful article are “perceived as fully realized, separate works—one an artistic work and the other a useful article.”²¹² Courts should analyze separability of the article’s features in the eyes of an ordinary, reasonable observer. An ordinary, reasonable observer avoids the criticism directed toward Judge Newman’s dissenting opinion in *Carol Barnhart*.²¹³ Unlike Judge Newman’s approach, which requires “a complete temporal displacement of the utilitarian function by the aesthetic features,” under this proposed test, the ordinary, reasonable observer who *simultaneously* perceives the article’s aesthetic features with its utilitarian function, still satisfies the conceptual separability.²¹⁴ The ordinary, reasonable observer is a hypothetical character and thus, the fact finder deciding the case should also use as guidance the objective indicia of the public perception (such as whether the article is displayed in museums or is otherwise presented for public viewing)²¹⁵, and whether the article has an alternative use as a work of art apart from its utilitarian function (such as whether the article is displayed as a piece of art in an entirely nonfunctional manner).²¹⁶

22, 2016) (quoting *Pivot Point Int’l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 922 (7th Cir. 2004)).

²¹⁰ See *id.* at 30.

²¹¹ See *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 330 (2d Cir. 2005).

²¹² COMPENDIUM III, *supra* note 72.

²¹³ See *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting).

²¹⁴ See Sonja Wolf Sahlsten, Note, *I’m a Little Treepot: Conceptual Separability and Affording Copyright Protection to Useful Articles*, 67 FLA. L. REV. 942, 972 (2015).

²¹⁵ See, e.g., *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 991 (2d Cir. 1980) (taking into account that plaintiff’s belt buckles were accepted by the Metropolitan Museum of Art for its permanent collection).

²¹⁶ See Sahlsten, *supra* note 214, at 972–73.

Included in the second part of this inquiry is whether the PGS features of the article can exist independently of its utilitarian aspects. This inquiry relies on the Sixth Circuit’s analysis in *Varsity Brands* and ultimately draws from the objectively necessary approach.²¹⁷ Essentially, this part of the proposed test asks whether the aesthetic features of the PGS work are “wholly unnecessary to the performance of”²¹⁸ the article’s utilitarian function. Two factors to consider when determining the necessity of the aesthetic features include, whether the artistic features are transferable or capable of existing on other articles, and whether the artistic features are interchangeable.²¹⁹ To illustrate, in *Varsity Brands*, the Sixth Circuit held that Varsity’s two-dimensional designs may be incorporated on the surface of different types of garments, including shirts and practice wear.²²⁰ Additionally, the Sixth Circuit held that the ability of those designs to be arranged on the cheerleading uniforms in multiple ways was evidence that the graphic designs on the surface of the uniform did not affect its actual function.²²¹ In fact, “nothing (save perhaps good taste) prevents” Varsity from printing its designs, framing them, and hanging the prints on the wall as art.²²² Therefore, the Sixth Circuit concluded that Varsity’s designs were “wholly unnecessary to the performance of” the garment’s ability to cover the body, permit free movement, and wick away moisture.²²³

B. Advantages of the Proposed Test

This Note’s proposed two-part analysis for determining conceptual separability is an effective test because it achieves the goals of the copyright regime and clarifies a much-needed area of copyright law. The Supreme Court should adopt this Note’s two-part test as the appropriate approach for determining when a feature of

²¹⁷ See discussion *supra* Section II.A.10.

²¹⁸ *Carol Barnhart*, 773 F.2d at 419.

²¹⁹ See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 491–92 (6th Cir. 2015), *cert. granted in part*, 136 S.Ct. 1823 (2016).

²²⁰ See *id.* at 491.

²²¹ See *id.* at 491–92.

²²² See *id.* at 492 (quoting *Home Legend, L.L.C. v. Mannington Mills, Inc.*, 784 F.3d 1404, 1413 (11th Cir. 2015)).

²²³ *Id.* (quoting *Carol Barnhart*, 773 F.2d at 419).

a useful article is protectable under the Copyright Act because: (1) focusing the conceptual separability inquiry on the article’s design elements as opposed to its utilitarian features avoids inconsistent results; (2) the two-part inquiry draws from language of the Copyright Office, which in turn reflects agreement between the legislative and judicial branches; (3) the ordinary, reasonable observer standard is consistent with other aspects of copyright law; and (4) this Note’s proposed test is practical in its application.

1. An Initial Consideration of Design Rather than Utility Avoids Inconsistent Results

First, the proposed test refines the analysis of separability by focusing initially on the determination of an article’s design elements.²²⁴ In comparison, existing conceptual separability tests have created conflicts among courts and scholars,²²⁵ with many of these disputes a result of variable definitions of an article’s utilitarian function. For example, some believe that the inquiry of functionality is “particularly fraught in the case of clothing, whose function is so intimately linked with its aesthetic appeal that some courts have applied a presumption that anything adding to that appeal is not entitled to copyright protection.”²²⁶ Whether or not this is the case here, the mounting inconsistencies and inefficiencies among court decisions is a result of focusing the conceptual separability analysis on an article’s function. Thus, beginning the inquiry with the identification of design elements, as opposed to concentrating on utilitarian features, allows the fact finder to avoid such inconsistent results.

Some have argued that analyzing an article’s design elements opens the door for criticism directed toward judges that may make aesthetic judgments, which are outside the scope of their expertise.²²⁷ However, this proposed test avoids this potential for con-

²²⁴ See *supra* Section III.A.

²²⁵ See discussion *supra* Section II.B.

²²⁶ Carl Mazurek, *Fashion Copyright and the Muddle of the Useful Articles Doctrine*, NYU J. INTELL. PROP. & ENT. L. BLOG (Oct. 26, 2015), <http://blog.jipel.law.nyu.edu/2015/10/fashion-copyright-and-the-muddle-of-the-useful-articles-doctrine> [https://perma.cc/B3HD-XE35].

²²⁷ See, e.g., *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

cern because the proposed test does not ask the fact finder to analyze the quality or degree of the design elements but rather simply identify the claimed design. This identification process would be no different than applying the same language of the Copyright Act to determine if a “work of craftsmanship” meets the requirements of originality and fixed medium.²²⁸ Unlike other conceptual separability tests, which require extrinsic facts for their analysis, courts can apply the same methodology as Copyright Office personnel when they evaluate copyright applications—i.e., on the basis of the application and deposit material alone.²²⁹

2. The Proposed Test Uses Language of the Copyright Office, Which Is Consistent with the Legislative and Judicial Branches

This Note’s proposed test draws from the language of the Copyright Office, which is consistent with both the Copyright Act and case law precedent. The proposed test therefore already reflects the judgment of the legislative and judicial branches. Consistency in language is no mistake—the language of the Copyright Office and the Copyright Act trace its roots back to the Supreme Court’s decision in *Mazer*.²³⁰ It was the Supreme Court’s decision that introduced the notion of conceptual separability; the regulations of the Copyright Office were immediately amended to accommodate the Court’s holding in *Mazer*; and the copyright statute now reflects the same language.²³¹ Therefore, this Note’s proposed two-part test allows for an organic and interdependent application of a conceptual separability standard.

Furthermore, using the Copyright Office’s very own language will avoid the potential of providing determinations inconsistent with copyright experts. Specialists in the Copyright Office analyze and assist in the drafting of copyright legislation, and thus the Cop-

themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”).

²²⁸ See *supra* Section I.C.

²²⁹ See Brief of the Intellectual Property Law Association of Chicago as Amicus Curiae in Support of Neither Party at 17, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, No. 15-866 (U.S. July 22, 2016) [hereinafter IPLAC Brief].

²³⁰ See *id.* at 14–15.

²³¹ See *id.*; see also discussion *supra* Sections I.B, I.C.

yright Office’s opinion provides for a knowledgeable and qualified analysis of conceptual separability.²³² As such, Congress seriously considers the advice of the Copyright Office when codifying regulations,²³³ so it is beneficial for courts to respect the opinions of the Copyright Office.

3. The Ordinary, Reasonable Observer Standard Is Consistent with Other Areas of Copyright Law

This Note’s proposed test is advantageous because the ordinary, reasonable observer standard is consistent with other aspects of copyright law. For example, copyright law uses the ordinary, reasonable observer standard to decide similar conceptual issues of copyright law, including whether an allegedly infringing work is “substantially similar” to an allegedly infringed copyrighted work.²³⁴ Consistency breeds uniformity, which in turn encourages reliability: If courts uniformly apply copyright standards, society may rely on an efficient and predictable court system. Thus, this proposed test allows for a uniform and reliable application of a conceptual separability standard.

4. The Proposed Test Is Practical in Its Application

This Note’s proposed two-part test will be applicable not only to *Star Athletica v. Varsity Brands*, but also other conceptual separability cases moving forward. To illustrate its application, in the case before us, the Supreme Court would first determine the design elements of the cheerleading uniforms. The design elements are the two-dimensional graphic designs which are affixed to the uniforms—i.e., the stripes, chevrons, and color-blocking. Although protection and originality of these design elements is not a question currently before the Court, for purposes of this illustration, assume the design elements of Varsity’s uniforms meet the requirements of copyrightability.²³⁵

²³² See U.S. COPYRIGHT OFFICE, *supra* note 26.

²³³ See *supra* Section I.C.

²³⁴ See 2 PATRY, *supra* note 125, § 9:81.

²³⁵ In fact, on remand, it may be found that the scope of Varsity’s copyrights is so “thin” that *Star Athletica* does not infringe them. IPLAC Brief, *supra* note 229.

Next, the court moves to the second question of the proposed test: Can the graphic designs be “identified separately” and “exist independently” from the utilitarian aspects of the uniform? The Supreme Court, from the perspective of an ordinary, reasonable observer, could identify the stripes, chevrons, and color-blocking separate from the utilitarian aspects of the uniform and also find that the graphic designs did not enhance the uniforms’ functionality as clothing. To illustrate this identification, the Sixth Circuit noted that “a plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip.”²³⁶ To complete its analysis, the Supreme Court would determine whether Varsity’s designs “exist independently” of the utilitarian aspects of the cheerleading uniform. As the Sixth Circuit explained, it could envision Varsity “printing or painting its designs, framing them, and hanging the resulting prints on the wall as art.”²³⁷ Thus, consistent with this analysis and drawing from the language of the Copyright Office, the Supreme Court can conclude that “a graphic design and a blank cheerleading uniform can appear ‘side by side’—one as a graphic design, and one as a cheerleading uniform.”²³⁸

To promote longevity of application and provide for overall effective copyright law, the Supreme Court should consider a single conceptual separability test that may be practically applied by future courts to a variety of PGS works. To exemplify this proposed test’s application to other useful articles, consider a wearable technology that is designed as a bracelet but functions primarily as a step-counting device. If a court starts by identifying the design of the wearable technology, it should be clear that the design of the bracelet is entirely separable from the step-counting feature. In other words, there is no need to delve into the bracelet’s utility to identify the bracelet’s design. In contrast, if the court uses the Sixth Circuit’s hybrid approach (or any other conceptual separability test that focuses its initial analysis on the article’s utilitarian features), it would interrupt the inquiry by attempting to determine the utilitarian purpose of the device, which could very well include

²³⁶ Petition for Writ of Certiorari, *supra* note 1, at 45a.

²³⁷ *Id.* at 46–47a.

²³⁸ *Id.* at 46a.

a number of functional qualities.²³⁹ The court might therefore conclude that, to serve its purpose, the wearable technology must be a certain shape or size, and would thus mistakenly conclude the design is uncopyrightable. Therefore, to avoid such a result, and to allow for a uniform and practical application of the conceptual separability standard moving forward, the Supreme Court should adopt this Note’s two-part inquiry.

CONCLUSION

Distinguishing between copyrightable aesthetic features of a PGS work, and the non-protectable utilitarian aspects of an article, has proven to be an uncertain and effectively metaphysical task.²⁴⁰ Over the years, circuit courts and scholars have approached conceptual separability in a multitude of ways, without proper guidance from the Supreme Court or Congress. The result is as many as ten existing conceptual separability tests which, when taken together, have made copyright protection of useful articles an exceedingly unreliable and inconsistent area of copyright law. In today’s economy, garments, among other useful articles, continue to blur the boundaries between aesthetic and functional concerns. Given this reality, the current state of conceptual separability demands clarity and reform, which the Supreme Court can finally provide in its decision of *Star Athletica v. Varsity Brands*. Thus, this Note proposes a two-part test, which tailors the separability analysis to an article’s design elements, refers to an ordinary, reasonable observer, and derives from the language of the Copyright Office, to provide for a clearer and simplified application of conceptual separability under copyright law.

²³⁹ For example, the wearable technology device could achieve the utilitarian purposes of counting steps, tracking GPS locations, or generally monitoring an individual’s exercise.

²⁴⁰ See Maluf, *supra* note 20.