

INTELLECTUAL PROPERTY LITIGATION

Expert Analysis

Courts Begin Applying Test for Copyright Eligibility of Design of a Useful Article

In *Star Athletica v. Varsity Brands*, the U.S. Supreme Court articulated a two-part test for determining whether the design of a useful article is eligible for copyright protection. 137 S. Ct. 1002 (2017). We report here on the subsequent cases applying this test.

Design of a Useful Article

The Copyright Act protects “original works of authorship fixed in any tangible medium of expression.” 17 U.S.C. §102(a). This includes “pictorial, graphic, and sculptural works.” Id. §102(a)(5).

Section 101 of the Act, in turn, defines “pictorial, graphic, and sculptural works” to include:

two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions,



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maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.

This definition, however, does not necessarily provide protection for the design of a useful article: the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

The Act defines “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. An article that is normally a part of a useful article is considered a ‘useful article.’” 17 U.S.C. §101.

Two-Part ‘Star Athletica’ Test

In *Star Athletica*, the Supreme Court granted certiorari to “resolve

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widespread disagreement over the proper test for implementing §101’s separate-identification and independent-existence requirements.” *Star Athletica*, 137 S. Ct. at 1007. Under the two-part test established by the Court, a design of a useful article is eligible for copyright protection if it:

(1) can be perceived as a two- or three-dimensional work of art

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separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.

Id.

Part 1 of the test, according to the court, is “not onerous”: “[t]he decisionmaker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities. Id. at 1010.

Part 2, on the other hand, “is ordinarily more difficult to satisfy.” The “feature must be able to exist as its own pictorial, graphic or sculptural work ... Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature itself cannot be a useful article or ‘an article that is normally part of a useful article.’” Id.

Star Athletica itself concerned the designs of surface decorations on cheerleading uniforms. The court affirmed the Sixth Circuit’s holding that the designs are copyrightable. According to the court, application of the test is “straightforward” in this case: Under part 1, the designs can be identified as having pictorial, graphic, or sculptural qualities; under part 2, the arrangement of the

colors, shapes, stripes, and chevrons of the designs would qualify as a two-dimensional work of art if separated from and applied to another medium. Id. at 1012.

Application of the ‘Star Athletica’ Test

Thus far, two district courts have applied the *Star Athletica* test. Both courts have found the designs at issue in those cases to be copyright eligible.

Design Ideas, Ltd. v. Meijer involved clothespins with a silhouetted sparrow design on the top. See No. 15-cv-03093, 2017 WL 2662473 (C.D. Ill. June 20, 2017). The district court held that the sparrow portion of Design Ideas’ clothespins is copyright-eligible.

Application of the *Star Athletica* test was also straightforward in this case. Under part 1, the court determined that the sparrow portion of the clothespins “can be perceived as a three-dimensional work of art separate from the useful article.” Id. at *2. Under part 2, the sparrow portion would qualify as a protectable sculptural work on its own had it been originally fixed in some other tangible medium. Id. at *3.

Meijer argued that the sparrow portion itself had utility, because it could hang from a rod or string by its beak. The court analyzed that argument by imagining the sparrow separate from the clothespin,

and asked “once the bird portion is removed from the clothespin, what is the usefulness of hanging the bird from a rod or hanging the bird on a string by its beak?” Id. The court also found that copyright protection existed even if Design Ideas intended the clothespin to be hung on a rod from the sparrow element, or that the sparrow element be intended to fulfill some other useful purpose. Id.

Jetmax, Ltd. v. Big Lots involved decorative covers that surround each light in a string of ornamental lights. See No. 15-cv-9597, 2017 WL 3726756 (S.D.N.Y. Aug. 28, 2017). The covers comprised an iridescent-glass, tear-drop-shaped bulb, a wire frame encompassing the bulb, and a stone hanging from the end of the wire frame. The court held that the decorative covers are copyright-eligible under the *Star Athletica* test.

Acknowledging the Supreme Court’s guidance that part 1 is “not onerous,” the *Jetmax* court found that the decorative covers of the Tear Drop Light Set satisfy part 1 because they “can be identified separately from, and are capable of existing independently of, the utilitarian aspects” of the Tear Drop Light Set. Id. at *6. The decorative covers also satisfy part 2, the court found, because they are “sculptural works that are capable of existing apart from the utilitarian aspect of

the light set, i.e., the light bulbs and other components that cause the Tear Drop Light Set to light a room.” Id.

Other Ongoing Litigation

The *Star Athletica* test is also being litigated in at least one other matter: *Halo Creative Design Ltd. v. Comptoir Des Indes* involves asserted copying by Comptoir Des Indes of a line of furniture and lighting fixtures designed by Halo and sold in, among other places, Restoration Hardware stores. See No. 1:14-cv-08196, [D.I. 127, 132, 137, 147] (E.D. Ill.). The parties have cross-moved for summary judgment, with Comptoir arguing that the design features of Halo’s products are not conceptually separable from the utility of those products, and Halo arguing that *Star Athletica* “once and for all destroyed any requirement for conceptual separability.” [D.I. 147 at 2].

The parties also disagree about the ease of separating the design of a piece of furniture or a lamp from its utility. Halo argues that, for example, its intricate crystal chandeliers could be removed from their light bulbs and power sources and used as sculptures, and that the artistic arms can be removed from a chair designed to evoke the cockpit of a World War II-era British Spitfire fighter plane, leaving behind a seat portion that

would still function as a chair. [D.I. 132 at 13–15]. Comptoir argues that those decorative elements are also functional, and that they are therefore either useful articles or “[a]n article that is normally a part of a useful article.” [D.I. 137 at 17 (quoting *Star Athletica*, 137 S.Ct. at 1010)].

Guidance for Practitioners

Star Athletica was decided while all three of these cases were pending. In *Design Ideas*, the court applied the *Star Athletica* test on a motion for reconsideration, having already adjudicated

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summary judgment before the decision came down. The court reconfirmed its prior holding under the new test. Likewise, in *Jetmax*, both parties agreed that the outcome of the case should be the same under the new *Star Athletica* test (while, of course, disagreeing about what that outcome should be).

Halo is thus the only one of these cases in which there seems to be a live dispute about whether *Star Athletica* changed the law and about

whether that change would be outcome-determinative.

Notably, *Design Ideas* and *Jetmax* each involved products in which the design element was found to be easily perceived as a separate two- or three-dimensional element apart from the useful article itself, in line with the Supreme Court’s expectation that the first step of the analysis would be “not onerous.” The intricacy and size of the products at issue in *Halo* raises the possibility that this step will be more onerous with larger products where the design features are more integral to the function, and therefore more difficult to perceive as a separate two- or three-dimensional work.