

Beyond Cheerleaders and Shovels: Leveraging Copyright Protection for Design Features

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Why Pick This Topic?

- **The United States Supreme Court issued its decision in *Star Athletica, L.L.C. v. Varsity Brands, Inc.* in March 2017 (137 S.Ct. 1002).**
- **The Court set forth a test for determining whether the design of a useful article can be protected under copyright law**
- **The decision is important for companies that make useful articles which also have aesthetic features**

Tension Between Design and Copyright

- **Companies produce articles that are necessary for everyday life (e.g., chairs, silverware)**
- **These companies also create designs that are unique and set their useful articles apart from others**
- **How do we protect these aesthetic features without inadvertently granting a monopoly on the utilitarian features**

Copyright Versus Design Patent

Copyright

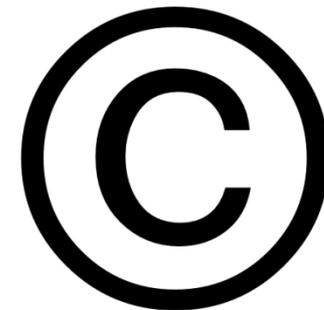
- Protects creative expression
- Life + 70 for individual works; 95 or 120 years for corporate owned works
- Protected immediately upon fixation

Design Patent

- Protect aesthetics (“look”)
- 15 years
- 1 to 2 years to issue
- Less expensive to obtain and enforce than utility patents

Advantages of Copyright Registration

- **Key to the courthouse door for U.S. works**
- **If registration sought within 3 months of publication or prior to infringement, availability of statutory damages and possible recovery of attorney's fees and costs**
- **Establishes prima facie validity of the copyright if registered within 5 years of publication**
- **Ability to record copyright registration with U.S. Customs and Border Protection**



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



The Court held that the design of the lamp base could be protected under copyright law independent of the fact that the design formed a lamp base.

“[R]espondents may not exclude others from using statuettes of human figures in table lamps; they may only prevent use of copies of their statuettes as such or as incorporated in some other article.”

Copyright Office Regulation Adopted

- ***“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. 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.”***

37 C.F.R. § 202.10(c) (1960) (as quoted in *Star Athletica*)

Statutory Framework – 1976 Act

- 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. An article that is normally a part of a useful article is considered a “useful article”.
- “Pictorial, graphic, and sculptural works” include 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. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; 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.

17 U.S.C. § 101

Pre-Star Athletica Case Law

- **The Primary-Subsidiary Approach**



“A pictorial, graphic, or sculptural feature is conceptually separable if the artistic features of the design are ‘primary’ to the ‘subsidiary utilitarian function.’”

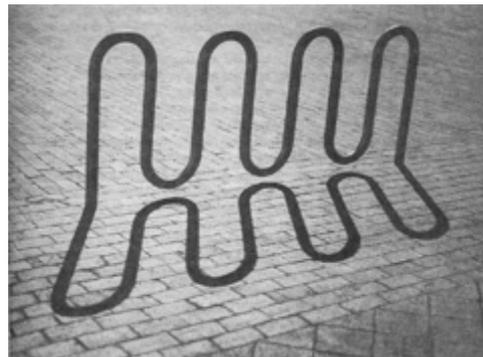
Kieselstein-Cord v. Accessories by Pearl, Inc.,
632 F.2d 989, 993 (2d Cir. 1980).

Pre-*Star Athletica* Case Law

- **The Design-Process Approach**

“A pictorial, graphic, or sculptural feature is conceptually separable if the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences.”

Brandir Int'l v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987); see also *Pivot Point Int'l, Inc. v. Charlene Prods.*, 372 F.3d 913, 930-31 (7th Cir. 2004).



Pre-Star Athletica Case Law

- **The Likelihood-of-Marketability Approach**



“A pictorial, graphic, or sculptural feature is conceptually separable if “there is 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.”

Galiano v. Harrah's Operating Co., 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 NIMMER ON COPYRIGHT § 2.08[B][3]).

Pre-*Star Athletica* Case Law

- **Other tests:**
 - **The Objectively-Necessary Approach**
 - **The Ordinary-Observer Approach**
 - **The Stand-Alone Approach**
 - **Academic Approaches (e.g., Patry and Keyes)**

Star Athletica – The Uniforms



Design 0815
Registration No. VA 1-675-905



← Varsity

Star →



***Star Athletica* – The Test**

“[A]n artistic feature of the design of a useful article is eligible for copyright protection if the feature:

(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and

(2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article.”

Star Athletica – The Dissent (Justices Breyer & Kennedy)

“A separable design feature must be "capable of existing independently" of the useful article as a separate artistic work that is not itself the useful article. If the claimed feature could be extracted without replicating the useful article of which it is a part, and the result would be a copyrightable artistic work standing alone, then there is a separable design. But if extracting the claimed features would necessarily bring along the underlying useful article, the design is not separable from the useful article.”

Where in the world did we get our title?

Majority Opinion Footnote 2:

“The dissent suggests that our test would lead to the copyrighting of shovels. But a shovel, like a cheerleading uniform, even if displayed in an art gallery, is “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” It therefore cannot be copyrighted. A drawing of a shovel could, of course, be copyrighted. And, if the shovel included any artistic features that could be perceived as art apart from the shovel, and which would qualify as protectable pictorial, graphic, or sculptural works on their own or in another medium, they too could be copyrighted. But a shovel as a shovel cannot.”
(internal citations omitted)



A Subsequent Case

- ***Design Ideas, Ltd. v. Meijer, Inc.*, No. 15-cv-03093 (C.D. Ill. Jun. 20, 2017)**



“First, the bird portion can be perceived as a three-dimensional work of art separate from the useful article.”

“Second, the bird portion would qualify as a protectable sculptural work on its own if it were imagined separately from the useful article into which it is incorporated.”

U.S. Copyright Office

U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 924 (3d ed. 2017):

“The U.S. Copyright Office is developing updated guidance on the registration of pictorial, graphic, and sculptural features incorporated into the design of useful articles. The Compendium will be updated once this guidance is finalized.”

Copyright Office Review Board

- **Application for “Pizza Slice Pool Float” filed by BigMouth, Inc. (July 11, 2017)**

- Though the work is a useful article, the Copyright Office held that the imprinted two-dimensional artwork is separable.
- *“While it is conceivable that some two-dimensional artwork of a pepperoni pizza slice could be copyrightable, in this case, the depiction is a very common version – triangle slice, yellow cheese, brown crust, and circular red pepperonis. . . . This garden-variety representation of a pizza slice in the Work does not raise the amount of creative expression to a level warranting copyright registration.”*



Questions?



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