

No. 15-866

---

---

IN THE  
**Supreme Court of the United States**

---

STAR ATHLETICA, L.L.C., *Petitioner*,

v.

VARSITY BRANDS, INC., VARSITY SPIRIT CORPORATION,  
AND VARSITY SPIRIT FASHIONS & SUPPLIES, INC.,  
*Respondents.*

---

**On Writ Of Certiorari To The United States  
Court Of Appeals For The Sixth Circuit**

---

**REPLY BRIEF FOR THE PETITIONER**

---

STEVEN M. CROSBY	JOHN J. BURSCH
STEPHEN E. FELDMAN	<i>Counsel of Record</i>
THE FELDMAN LAW GROUP	BURSCH LAW PLLC
220 East 42nd St., Ste. 3304	9339 CHERRY VALLEY
New York, NY 10017	AVE SE, #78
	CALEDONIA, MI 49316
MICHAEL F. RAFFERTY	(616) 450-4235
EMILY HAMM HUSETH	jbursch@burschlaw.com
HARRIS SHELTON HANOVER	
WALSH, P.L.L.C.	MATTHEW T. NELSON
One Commerce Sq., Ste. 2700	CONOR B. DUGAN
Memphis, TN 38103-2555	WARNER NORCROSS &
	JUDD LLP
	900 Fifth Third Center
	111 Lyon Street, N.W.
	Grand Rapids, MI 49503
	(616) 752-2000

*Counsel for Petitioner*

---

---

**TABLE OF CONTENTS**

	<b>Page</b>
TABLE OF AUTHORITIES.....	iii
INTRODUCTION.....	1
ARGUMENT .....	3
I. This case is about separability, not about whether two-dimensional works can be copyrighted .....	3
II. Star Athletica’s approach offers more objective guidance than Varsity’s unadorned “side-by-side” analysis .....	9
III. Star Athletica’s test best effectuates Congressional intent as expressed in § 101 .....	12
A. An article’s utilitarian aspects must be identified consistent with § 101’s text.....	12
1. Varsity misconstrues the phrase “the utilitarian aspects of the [useful] article.” .....	12
2. “Utilitarian aspects” must be identified in the context of “the article.”.....	16
3. Section 113(a) does not change the result in this case .....	17
B. It is appropriate in close cases to apply the statutory general rule against copyright protection for useful articles .....	17

**TABLE OF CONTENTS—Continued**

	<b>Page</b>
C. Varsity’s additional criticisms of Star Athletica’s approach are unfounded.....	18
D. Star Athletica correctly draws a distinction between a garment with two-dimensional artwork printed on it, and a garment design.....	20
IV. Varsity’s cheerleader-uniform designs are not separable from the actual cheerleader uniforms.....	21
V. There is no need to create copyright protection for garments to promote innovation.....	24
CONCLUSION.....	28

## TABLE OF AUTHORITIES

	<b>Page(s)</b>
<b>Cases</b>	
<i>Baker v. Selden</i> , 101 U.S. 99 (1879).....	4
<i>Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.</i> , 834 F.2d 1142 (2d Cir. 1987) .....	11
<i>Carol Barnhart Inc. v. Economy Cover Corp.</i> , 773 F.2d 411 (2d Cir. 1985) .....	11
<i>Eltra Corp. v. Ringer</i> , 579 F.2d 294 (4th Cir. 1978).....	4
<i>Folio Impressions, Inc. v. Byer California</i> , 752 F. Supp. 583 (S.D.N.Y. 1990).....	7
<i>Folio Impressions, Inc. v. Byer California</i> , 937 F.2d 759 (2d Cir. 1991) .....	7
<i>Galiano v. Harrah’s Operating Co.</i> , 416 F.3d 411 (5th Cir. 2005).....	7, 11, 12
<i>Home Legend, LLC v. Mannington Mills, Inc.</i> , 784 F.3d 1404 (11th Cir. 2015).....	5
<i>Jack Adelman, Inc. v. Sonners &amp; Gordon, Inc.</i> , 112 F. Supp. 187 (S.D.N.Y. 1934).....	15
<i>Jovani Fashion, Ltd. v. Fiesta Fashions</i> , 500 F. App’x 42 (2d Cir. 2012) .....	23
<i>Knitwaves, Inc. v. Lollytogs Ltd.</i> , 71 F.3d 996 (2d Cir. 1995) .....	8
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	28
<i>Mazer v. Stein</i> , 347 U.S. 201 (1954).....	19

**TABLE OF AUTHORITIES—Continued**

	<b>Page(s)</b>
<i>Pivot Point International, Inc. v. Charlene Products, Inc.</i> , 170 F. Supp. 2d 828 (N.D. Ill. 2001).....	10
<i>Pivot Point International, Inc. v. Charlene Products, Inc.</i> , 372 F.3d 913 (7th Cir. 2004).....	10
<b>Statutes</b>	
17 U.S.C. § 101 .....	passim
17 U.S.C. § 113 .....	15, 17
<b>Rules</b>	
37 C.F.R. § 202.1 .....	4
37 C.F.R. § 202.10 .....	18
Registrability of Costume Designs, 56 Fed. Reg. 56,530 (1991).....	2, 8, 13
<b>Other Authorities</b>	
1 Paul Goldstein, <i>Goldstein on Copyright</i> .....	6
Compendium of U.S. Copyright Office Practices (3d. ed. 2014) .....	passim
Hilary Greenbaum & Dana Rubinstein, <i>The Stop Sign Wasn't Always Red</i> , N.Y. Times, Dec. 11, 2011.....	16
Kal Raustiala & Christopher Sprigman, <i>The Piracy Paradox Revisited</i> , 61 Stan. L. Rev. 1201 (2009) .....	24, 25

**TABLE OF AUTHORITIES—Continued**

	<b>Page(s)</b>
Kal Raustiala & Christopher Sprigman, <i>The Piracy Paradox: Innovation and            Intellectual Property in Fashion            Design</i> , 92 Va. L. Rev. 1687 (2006).....	24
Paul Harrison, <i>High conspicuity livery for            police vehicles</i> 4 (Police Scientific Dev. Branch, Publ'n No. 14/04, 2004).....	5
<i>Random House Webster's Unabridged            Dictionary</i> 2099 (2d ed. 2001).....	13
Robert C. Denicola, <i>Applied Art &amp; Indus.            Design: A Suggested Approach to            Copyright in Useful Articles</i> , 67 Minn. L. Rev. 707 (1983) .....	14
Toni Pfanner, <i>Military uniforms &amp; the            law of war</i> , Int'l Rev. of the Red Cross 93 (Mar. 2004).....	15

## INTRODUCTION

Unlike its position in the lower courts, Varsity now argues that because its cheerleader-uniform designs are two-dimensional, no separability analysis is necessary. Varsity Br. 1–2. That argument assumes two-dimensional designs cannot serve a utilitarian function. They clearly can. Consider a two-dimensional design that serves the utilitarian function of hiding the wearer:



In fact, Congress expressly recognized that two-dimensional pictorial and graphic features incorporated in a useful article can be utilitarian by subjecting *both* types of features to the separability analysis that 17 U.S.C. § 101 requires. Accordingly, Varsity's cheerleader-uniform designs are properly analyzed for separability.

Varsity similarly argues that a garment's pictorial or graphic features can never serve a useful function. Varsity Br. 43–44. Not so. As the Copyright Office recognizes, garments are useful articles that can serve functions in addition to clothing the body. Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,531 (1991) (“Costumes serve a dual purpose of clothing the body *and* portraying their appearance.” (emphasis added)). These functions include enhancing the attractiveness of the wearer. The placement of lines on the garment can make the wearer appear shorter and broader or taller and slimmer; other pictorial and graphic features on the garment can draw attention to, or away from, certain body parts. Amici Br. of Profs. Buccafusco & Fromer 18–24, 24–29. Uniforms, in particular, function to identify the wearer as part of a group (the army, healthcare workers, or a cheerleading squad) and portray a unified appearance. And the government concedes that if Star Athletica is correct that the chevrons and stripes on a cheerleader uniform have a utilitarian function, “then Section 113(a) would not protect the application of” those features. U.S. Br. 23; contra U.S. Br. 17–24.

In sum, two-dimensional features of useful articles must still be analyzed to ensure the features are separable. To conduct that analysis, Star Athletica has proposed a separability test that is faithful to the text of Copyright Act § 101 and the Congressional policy against copyright in industrial design, especially garment design. The Court should adopt Star Athletica's test and reject Varsity's invitation to provide a century of copyright protection for cheerleader-uniform designs.



## ARGUMENT

### **I. This case is about separability, not whether two-dimensional works can be copyrighted.**

Star Athletica agrees that copyright generally (though not always) protects two-dimensional works. But this case is not about whether two-dimensional works are copyrightable in the abstract. The case is about determining when a two-dimensional design feature is separable from the useful article into which the feature is incorporated. Two-dimensional features are not automatically separable, even if they can be transferred to a variety of media. *Contra Varsity Br. 26*. This is shown by the Copyright Act's text, the Copyright Office's guidance, and experience.

The Act anticipates that two-dimensional features can be functional. Section 101 says that “pictorial” and “graphic” features must be separable from the “utilitarian aspects of the article” for the design of a useful article to be protectable. 17 U.S.C. § 101. This demonstrates Congress understood that two-dimensional *and* three-dimensional features may be inseparable from the utilitarian aspects of a useful article. *Buccafusco & Fromer Amici Br. 19*.

Thus, copyright examiners apply a separability analysis to determine if two-dimensional pictorial and graphic features incorporated into the design of useful articles are separable. *Contra Varsity Br. 31–32*. The Copyright Office recommends that claimants use “[t]he term two-dimensional artwork . . . to describe two-dimensional artwork that has been applied to a useful article,” “*provided that* the artwork is . . . separable from the useful article.” Compendium III § 618.4(C) (emphasis added).

Everyday experience reinforces the point that pictorial or graphic designs can have utilitarian functions. For example, the military holds design patents and trademarks for two-dimensional camouflage designs which, when used on garments, serve a crucial function of concealing soldiers on the battlefield. In addition to camouflage, consider a few more examples:

1. Fonts: This brief uses the following two fonts:

AaBbCcDdEeFf

ÆaBbCcDdEeFf

Fonts are two-dimensional and contain elements of creative design. Yet, “because the creative aspects of the character (if any) cannot be separated from the utilitarian nature of that character,” fonts are industrial design and cannot be copyrighted. Compendium III § 906.4 (citing 37 C.F.R. § 202.1(a), (e)); *Eltra Corp. v. Ringer*, 579 F.2d 294, 298 (4th Cir. 1978).

2. Blank forms: Forms that record information but which do not themselves convey information are not copyrightable because the two-dimensional graphic features are not separable from the form’s utilitarian function. See 37 C.F.R. § 202.1(C); *Baker v. Selden*, 101 U.S. 99 (1879). This even though a blank baseball scorecard could be framed and hung on the wall, printed on wallpaper, or emblazoned on a notebook cover.

3. Battenburg livery designs: In the United Kingdom, governmental studies concluded that a pattern of large, carefully proportioned two-dimensional designs increases the conspicuity of emergency vehicles. Paul Harrison, *High conspicuity livery for police vehicles* 4 (Police Scientific Dev. Branch, Publ'n No. 14/04, 2004). To the same end, emergency services often add inverted-V chevron designs to the rear of vehicles.



In sum, as a matter of statutory construction, agency application, and practical experience, some two-dimensional pictorial and graphic features are not categorically separable from the useful articles incorporating them, even if two-dimensional features can be transferred to any surface. Accord Profs. Buccafusco & Fromer Br. 14–15.

To support its contrary conclusion, Varsity suggests that the Eleventh Circuit concluded that “it is ‘obviously true’ that ‘any two-dimensional image’ is separable from the useful article on which it appears.” Varsity Br. 25 (quoting *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404, 1413 (11th Cir. 2015)). But no court, including the Eleventh Circuit, has so supplanted § 101. The Eleventh Circuit merely observed that “nothing (save perhaps good taste)” prevents any two-dimensional image from being “printed, framed, and hung on the wall as art.” *Ibid.*

Likewise, Varsity's quotation from Professor Goldstein's treatise, Varsity Br. 25, omits his point that Congress and the courts prevent the use of a copyright in a two-dimensional image to bar the manufacture of a three-dimensional object portrayed therein. 1 Paul Goldstein, *Goldstein on Copyright* § 2.5.3, at 2:83 (3d ed. 2005). Goldstein's analysis actually condemns what Varsity is seeking to do in this very case:

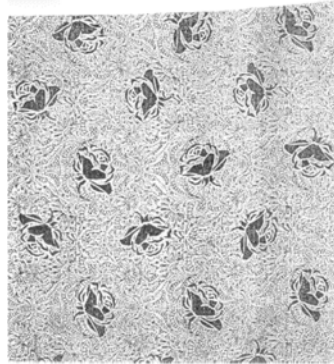
*Although it is relatively easy to obtain copyright protection for designs of useful articles appearing in two-dimensional rather than three-dimensional form, Congress and the courts have limited the rights granted to these works so that copyright control of the two-dimensional work will not confer control over the three-dimensional useful articles made from it. [Id. (emphasis added to language omitted by Varsity).]*

Only Professor Patry's treatise supports Varsity's position. And that position is inconsistent with § 101's text and the reality that two-dimensional images can have an intrinsic utilitarian function.

Varsity's new argument is a variation on its argument opposing the petition that this case is about fabric design, not separability. See Varsity Br. 28–31. This is not a case of “two-dimensional designs that are incorporated onto clothing,” Varsity Br. 28, but a case of clothing design. Varsity's arrangements of stripes, chevrons, and color blocks are not independent works that happened to be incorporated into cheerleader uniforms. Even when the uniform is removed, Varsity's arrangement of elements still looks exactly like a cheerleader uniform. See IP Profs. Amici Br. in Supp. of Pet'r 17.

Until its merits brief in this Court, Varsity saw it the same way, viewing its copyrights as protecting *cheerleading uniform designs*, J.A. 175–86, and threatening competitors for infringing copyrights in “certain garment designs,” J.A. 171. As Varsity acknowledges, Varsity Br. 52 n.17, the Sixth Circuit panel majority had no difficulty recognizing that Varsity was claiming copyright in “the designs of cheerleading uniforms and sportswear.” Pet. App. 42a. Indeed, when faced with similar claims and similar designs, see Pet. Reply Br. 7–8, the Fifth Circuit similarly recognized that the two-dimensional images at issue there were casino-uniform designs. *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 416–17 (5th Cir. 2005).

The difference between fabric design and garment design is illustrated by one of the fabric-design cases on which Varsity relies, *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (2d Cir. 1991). Varsity Br. 28. Contrary to Varsity’s account, the case did not involve graphic designs on clothing, it involved a design on fabric:



*Folio Impressions, Inc. v. Byer California*, 752 F. Supp. 583, 593 (S.D.N.Y. 1990). And unlike

Varsity's copyrights, Folio's fabric was not designed to follow the contours of the body of the person wearing garments made from the fabric. The placement and design of the roses were unconstrained by functional considerations of garment design.<sup>1</sup>

Varsity buttresses its fabric-design argument by citing the Copyright Office's statement that a two-dimensional design applied to the surface of clothing may be registered. Varsity Br. 31; see also U.S. Br. 9. But Varsity omits clarifying language demonstrating that the Copyright Office is referring to designs printed repeatedly or singly on fabric: "this claim [for a copyright in a two-dimensional design applied to the surface of clothing] *is generally made by the fabric producer rather than the garment or costume designer*. Moreover, this claim to copyright is ordinarily made when the two-dimensional design is applied to the textile fabric and before the garment is cut from the fabric." 56 Fed. Reg. at 56,531 (emphasis added). The Office also identifies its general policy *against* registering copyrights for garment designs, including uniforms. *Id.* at 56,532.

The Copyright Office correctly concludes that only Congress has the authority to extend copyright protection to garment designs. See *ibid.* Indeed, as Varsity's expert witness's *amici* brief acknowledges, this is what European Union member states and other countries have done. Fashion Law Inst. Amici

---

<sup>1</sup> Varsity also cites *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995), as an example of a court recognizing that graphic designs on clothing can be copyrighted. Varsity Br. 28. But the parties there did not dispute that leaf and squirrel designs on sweaters were protectable. 71 F.3d at 1002.

Br. 18. Congress has resolutely resisted that approach for more than a century, and this Court should not legislate a different policy.

**II. Star Athletica’s approach offers more objective guidance than Varsity’s unadorned “side-by-side” analysis.**

Star Athletica’s approach for the exists-independently prong of the statute proposes three distinct analytical tools—physical separability, design process, and marketability—to aid courts in applying it. Star Br. 33–36, 38. Varsity says Star Athletica’s approach “bears no resemblance to the Copyright Office’s ‘side-by-side’ test.” Varsity Br. 35. Not so. Star Athletica’s approach is not a departure from past practices in the courts or the Copyright Office. Rather, by relying on the objective facts about each work instead of idiosyncratic perceptions, Star Athletica’s approach guides the application of the “side-by-side” test so that separability determinations may be more consistent.

The “side-by-side” approach, though conceptually correct, offers little guidance for application. It requires the factfinder to “visualize[ ]” or “imagine[ ]” the artistic features and the useful article separately, and to find separability only when, in the person’s imagination, the former can exist as a “fully realized . . . artistic work” and the latter a “fully realized . . . useful article” without “[m]erely analogizing the general shape of a useful article to a work of modern sculpture.” Compendium III § 924.2(B).

Without additional guidance, the side-by-side approach is akin to a Rorschach test. Try applying it to the mannequin head and its features at issue in *Pivot Point International, Inc. v. Charlene Products, Inc.*, 170 F. Supp. 2d 828, 840 (N.D. Ill. 2001):



Mara

Varsity's "side-by-side" test asks the viewer to imagine the mannequin head and the hungry-look facial features separately and determine whether they can each be perceived as "fully realized." Not only did this issue evenly split the four Seventh Circuit judges who addressed it, but a similar mannequin issue confounded the Second Circuit, too. *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004) (2-1 decision reversing Judge Easterbrook in the district court); *Carol*



*Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985) (2-1 decision). Like beauty, utility is in the eye of the beholder.

Star Athletica turns this inquiry outward. Starting with the physical-separability tool gives the viewer something tangible to evaluate. See Compendium III § 924.2(A). There is no mental exercise of imagining the elements separately; each factfinder would look at the same feature and the same useful article separated from each other to determine whether each is capable of existing independently of the other.

Where physical separation is not possible, the design-process and marketability tools use objective evidence to assist this analysis. Instead of asking the metaphysical question of how a pictorial, graphic, or sculptural feature of a useful article and the useful article are “fully realized,” factfinders, aided by experts when helpful, may look to what a designer was engaged to design, see *Pivot Point*, 372 F.3d at 932 (artist given *carte blanche* to implement an idea for a “hungry look” mannequin); whether a designer altered his original sculpture to conform to the demands of a useful article, see *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987) (designer adapted original elements of a sculpture to accommodate and further the utilitarian purpose of a bicycle rack); or whether there is a market for the artistic feature without the useful article, see *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 421–22 (5th Cir. 2005). Courts need such a determinate base to assess separability.

Varsity mocks Star Athletica’s acknowledgment of a “sub-optimal” element in its test without noticing that the lack of guidance provided by its

side-by-side analysis is what led to the proliferation of separability tests. As the Fifth Circuit noted, a determinate separability analysis that is less than perfect is preferable to subjective analysis which leads reasonable jurists to opposite conclusions in near every case. See *Galiano*, 416 F.3d at 421–22.

### **III. Star Athletica’s test best effectuates Congressional intent as expressed in § 101.**

Varsity says Star Athletica’s approach “is divorced from the statutory text.” Varsity Br. 17. But Star’s test closely tracks § 101, giving each word meaning. Star Br. 26–36. Varsity distorts the text.

#### **A. An article’s utilitarian aspects must be identified consistent with § 101’s text.**

##### **1. Varsity misconstrues the phrase “the utilitarian aspects of the [useful] article.”**

Varsity acknowledges that Congress crafted § 101 to avoid providing copyright protection for works of industrial design. Varsity Br. 8. But Varsity tries to frustrate Congress’s intent by claiming the Court should not consider the functionality of useful articles when determining how to assess separability, then defining the utilitarian aspects of a useful article contrary to the statutory text.

1. To begin, Varsity is wrong that defining a useful article’s functionality is not within the scope of the question presented. Varsity Br. 41, 55 n.18. The question asks “what is the appropriate test to determine when a feature of the design of a useful article is protectable” by copyright. That test necessarily includes defining the utilitarian function of the useful article.

2. Section 101 defines 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.” 17 U.S.C. § 101. Congress thus considered portraying the article’s appearance and conveying information to be utilitarian functions, *contra* Varsity Br. 21; Congress simply made clear that if those are an article’s *only* intrinsic utilitarian functions (like a newspaper), the article can be copyrighted *notwithstanding those utilitarian functions*. The Copyright Office has recognized that a useful article can have such a utilitarian function and other intrinsic utilitarian functions, thus requiring a separability analysis. E.g., 56 Fed. Reg. at 56,531 (costumes have intrinsic utilitarian functions of clothing *and* masquerading).

The meaning of the word “utilitarian” does not exclude portraying an article’s appearance or conveying information. “Utilitarian” means “pertaining to or consisting in utility . . . having regard to utility or usefulness rather than beauty, ornamentation, etc.” *Random House Webster’s Unabridged Dictionary* 2099 (2d ed. 2001). “Utility” means “the state or quality of being useful.” *Ibid.* A sign has the utilitarian function of conveying information.

Varsity’s approach requires the conclusion that Congress intended “utilitarian aspects” in the separability analysis to have a narrower meaning than “utilitarian functions” in the useful-article definition. If so, the definition of pictorial, graphic, or sculptural work in § 101 would conclude:

[T]he design of a useful article . . . shall be considered a [protectable] work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that [are

separable from] the utilitarian aspects of the article *other than portraying the appearance of the article or conveying information*.

Varsity’s rewriting of § 101 undermines Congress’s acknowledged intent to preclude copyright protection for industrial designs—i.e., designs that optimize a useful article’s appearance.<sup>2</sup>

3. Varsity suggests that interpreting utilitarian aspects of a useful article to include conveying information and depicting the article’s appearance will result in the loss of copyright protection for logos and anything else printed on a t-shirt. Varsity Br. 44–45; accord U.S. Br. 24–25. Not so.

First, the statute requires consideration of “the utilitarian aspects of *the article*” at issue. Consider Varsity’s example of a t-shirt with a team logo on it. Varsity Br. 44. The shirt does not have the utilitarian function of identifying the wearer as a team’s fan; the logo performs that function. Likewise, adding a face, character, or landscape to a t-shirt might draw attention to the shirt, but it does nothing to advance the utilitarian function of accentuating or altering the appearance of the wearer’s body. That is why sports-team logos or Van Gogh paintings are

---

<sup>2</sup> “The dominant feature of modern industrial design is the merger of aesthetic and utilitarian concerns. It is the influence of nonaesthetic factors, the nexus between what the product must do and how it must look, that distinguishes true industrial design from other artistic endeavors. The industrial designer . . . is subject to the functional constraints inherent in each undertaking.” Robert C. Denicola, *Applied Art & Indus. Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 739 (1983).

separable from the t-shirt. Indeed, logos and paintings are typically registered as stand-alone works, not works incorporated into garments, as here.

Second, one can possess a copyright in a drawing of a useful article without possessing a copyright in the article. U.S. Br. 23. While a two-dimensional image of a tuxedo may be printed on a t-shirt, U.S. Br. 9–10, the image does not prevent a tailor from making the tuxedo. Only Varsity can print its sketches of cheerleaders wearing uniforms on t-shirts, but anyone can make the actual cheerleader uniforms. *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187 (S.D.N.Y. 1934) (copyright in the photograph of a dress does not create a copyright in the dress itself); see 17 U.S.C. § 113(b).

Third, uniforms *qua* uniforms have specific utilitarian functions. By nature, uniforms denote that the wearer belongs to a particular group and not others. Members of the armed services wear uniforms to distinguish themselves from civilians. Toni Pfanner, *Military uniforms & the law of war*, Int'l Rev. of the Red Cross 93–94, 123 (Mar. 2004). Likewise, cheerleading uniforms serve to identify wearers as cheerleaders.<sup>3</sup> See Pet. App. 55a–56a. That fact explains why the cheerleader-uniform designs depicted in the Norman Rockwell painting and the picture of SMU's 1950s cheerleaders are less effective as cheerleader uniforms than the designs at

---

<sup>3</sup> Varsity uses this intrinsic function of uniforms to increase its sales. Varsity Brands, Inc., Annual Report (Form 10-K), at 4 (Feb. 14, 2003).

issue here. Compare Varsity Br. 57; U.S. Br. 39; with Star Br. 4–5; J.A. 81–83, 192–94, 213–15.

That useful items change over time is neither surprising nor relevant. Stop signs were not always red and octagonal. Over time, a red octagon has become synonymous with the command to stop. Hilary Greenbaum & Dana Rubinstein, *The Stop Sign Wasn't Always Red*, N.Y. Times, Dec. 11, 2011, at MM30. So too, the development of cheerleader uniforms; the blank shell tops and skirts that Varsity created are unrecognizable today as *cheerleader* uniforms. Star Br. 45.

Finally, Varsity does not dispute that its uniforms are intended to enhance the attractiveness of the wearer. As explained in Star Athletica's opening brief, that is what Varsity's designs accomplish. Star Br. 54.

**2. “Utilitarian aspects” must be identified in the context of “the article.”**

Even though the government recognizes that Varsity's artwork is designed *for* cheerleader uniforms, U.S. Br. 16, the government insists on a separability analysis focused on the utilitarian aspects of the entire genre of “clothing.” U.S. Br. 17; see also Pet. App. 45a. Clothing encompasses everything from a parka to a bikini, and all clothing covers at least some of the body. But different kinds of clothing have different intrinsic functions. As noted above, uniforms—and in particular, cheerleader uniforms—have functions that parkas and bikinis do not. Congress requires courts to assess separability based on “the utilitarian aspects of *the article*.” 17 U.S.C. § 101 (emphasis added). It violates that

command to analyze utilitarian aspects of “clothing” generically rather than “the article” actually at issue here: cheerleader uniforms.

**3. Section 113(a) does not change the result in this case.**

The government argues at length that the question presented is subsumed by Copyright Act § 113(a). U.S. Br. 17–24. The government says that because Varsity has copyrighted pictorial or graphic works, 113(a) gives Varsity the right to reproduce the works on a cheerleader uniform or on any other article. But as explained above, the arrangement of stripes, chevrons, and color blocks is a utilitarian aspect of a cheerleader uniform. And the government concedes that if this is so, “then Section 113(a) would not protect the application of” those features. U.S. Br. 23. So § 113(a) does not change the analysis.

**B. It is appropriate in close cases to apply the statutory general rule against copyright protection for useful articles.**

Congress has long been concerned with the misuse of copyright law to prevent competition. *Star* Br. 10 (citations omitted). For that reason, it established a general rule that useful articles could not be copyrighted, subject to a narrow exception. The design of a useful article can be copyrighted “if, and only to the extent that” it contains pictorial, graphic, or sculptural features that can be identified separately from and exist independently of the utilitarian aspects of the useful article. 17 U.S.C. § 101. Even then, the design is protected “only to the extent” that the features are separately identifiable and capable of independent existence. *Ibid.* Indeed, Congress broadened the scope of unprotectable

useful articles from the Copyright Office's existing regulations, which limited useful articles to those things whose "sole intrinsic function . . . is its utility." 37 C.F.R. § 202.10(c) (1959); see IP Law Profs. Amici Br. in Supp. of Pet'r 5–6.

Given Congress's general policy against copyrighting useful articles, if a court cannot determine whether a design of a useful article can be copyrighted after applying a complete separability analysis, it is appropriate to rule that the article is in the public domain. *Contra Varsity Br.* 45–47.

**C. Varsity's additional criticisms of Star Athletica's approach are unfounded.**

1. Varsity contends that the Act does not require a useful article to retain its functionality without the artistic features.<sup>4</sup> *Varsity Br.* 21, 24 n.4, 34. But § 101 requires the features to "exist independently," which means that each article and feature stands on its own. Compendium III § 924.2(b) ("the artistic feature and the useful article could both exist side by side *and be perceived as fully realized, separate works*" (emphasis added)). If Varsity is correct, any artistic feature can be copyrighted, and there is no need for a separability test. That is why the government disagrees with Varsity: "If the work and the article can be visualized as two different things, *with the article remaining similarly useful (and the work non-useful)*, then the work can be 'identified separately' and 'exist[ ] independently' of the

---

<sup>4</sup> In fact, Varsity goes further and suggests a pictorial, graphic, or sculptural work can have some utilitarian contribution to the useful article and *still* be separable. *Varsity Br.* 21, 24 n.4.



article.”). U.S. Br. 29 (emphasis added); accord *id.* at 26. Here, the artistic or aesthetic features of Varsity’s designs “exist only as part of a cheerleader uniform,” and therefore Varsity is claiming protection in the design of a useful article. IP Law Profs. Amici Br. in Supp. of Pet’r 17.

2. Varsity criticizes Star Athletica’s use of a design-process analysis. Varsity Br. 35–38. Star preemptively addressed many of these criticisms, see Star Br. 34–35, 40–41. Varsity’s new complaint is that the analysis is “implausibly narrow because it provides no way to distinguish between industrial design and applied art.” Varsity Br. 36. Wrong. If a designer is adding a picture to a pre-existing useful article, that picture will be protected; if the designer is creating the design of the useful article, design features are unlikely to receive protection. That is consistent with Congress’s policy in § 101.

Varsity is also wrong to say that a design-process analysis would produce “the wrong result under the facts of *Mazer* [v. *Stein*, 347 U.S. 201 (1954)].” Varsity Br. 37. The analysis does not care that the *Mazer* statuette was primarily intended to be *used* as a lamp base. *Ibid.* The question is whether the statuette’s design reflects artistic judgment “exercised independently of functional influence.” Star Br. 34 (citation omitted). Lacking any objective evidence of functional influence, a court would conclude the statuette is protectable.

Varsity concedes the design-process approach can be useful to demonstrate that a designer “was not constrained in any way by functional concerns.” Varsity Br. 38. And of course the benefit of the design-process approach is that the opposite is also true—evidence that a designer was limited by

functional considerations strongly suggests the design at issue is functional.

3. Star Athletica also anticipated many of Varsity's criticisms of the marketability analysis. Compare Varsity Br. 38–41 with Star Br. 35–36, 41–42. In addition, Varsity misconstrues the marketability analysis's usefulness. The analysis does not turn on a "judge's personal taste," nor does it require an author to prove market popularity. Contra Varsity Br. 39. The analysis asks the objective question whether the design feature "would still be marketable to some *significant* segment of the community" without its utilitarian function. Star Br. 35 (citation omitted). The approach's usefulness is demonstrated here: a Van Gogh or Klimt painting (neither a useful article) would be marketable to a significant segment of the community on its own. U.S. Br. 18–21. The same cannot be said of Varsity's cheerleader-uniform designs. That reality is a useful data point.

**D. Star Athletica correctly draws a distinction between a garment with two-dimensional artwork printed on it, and a garment design.**

As Star Athletica explained in its initial brief, the statutory separability approach confirms that the Copyright Act does not provide a century's worth of monopoly protection to cheerleader uniforms, which are industrial designs. Star Br. 44–51. The same is not true of the two-dimensional examples proffered by Varsity's *amici*.

Consider the Van Gogh, Klimt, and Mondrian prints on dresses. U.S. Br. 18–21; Fashion Law Inst. Amici Br. 27. These prints can obviously be identified

“separately from . . . the utilitarian aspects of” the dress. And the designs are “capable of existing independently of [ ] the utilitarian aspects of” the dress.” The dresses do not depend on the paintings for their utility; the paintings were conceived entirely apart from any functionality of the dress, and there is a substantial market for the paintings themselves (i.e., as artwork, not as decorative features of a dress). Conversely, Varsity’s cheerleader uniforms do depend on Varsity’s designs for their utility.

“For the vast majority of clothing,” features “are not separable because, in general, most clothing designs are dictated by utilitarian considerations.” Gersel & Hemphill Amici Br. 19. That is particularly true of cheerleader uniforms, and this Court should not rewrite the Copyright Act to create new protections.

**IV. Varsity’s cheerleader-uniform designs are not separable from the actual cheerleader uniforms.**

Varsity’s cheerleader-uniform designs are not separable under either parties’ assessment of separability.

As Star Athletica demonstrated in its principal brief, Varsity’s designs are dictated by the intrinsic functions of a cheerleader uniform. Star Br. 44–51. Varsity claims that its “designers are not constrained when creating two-dimensional graphic designs.” Varsity Br. 62. Yet Varsity concedes that its designs were constrained by the edges of the uniforms. Varsity Br. 11. And it is undisputed that Varsity’s cheerleading uniform designers sketch their designs on the outline of a cheerleader. Star Br. 13. If

Varsity's designers were turning out uniform designs for Scottish Highlanders or the Tower of London's yeoman warders, they would soon be looking for other work. The design-process approach suggests that Varsity's cheerleader-uniform designs are not separable from the cheerleader uniforms.

The same is true of the marketability approach. There is no market for Varsity's arrangements of stripes, chevrons, and color blocks except as cheerleader uniforms. Varsity says that its drawings have been applied to "many other products," Varsity Br. 11, 62—but all of those products are cheerleading related, J.A. 242–43, 258, 261, 273–79, 281 (cheerleader jackets, practice wear, and warm-ups). Varsity relies on its expert, who thinks Varsity's designs could be applied to other objects, but the fact remains that there is no such market or Varsity would already be exploiting it. The marketability approach also suggests that Varsity's cheerleader-uniform designs are not separable.

Under Varsity's side-by-side approach, *Star Athletica* also prevails. That is because "the aesthetic elements of a cheerleader uniform exist only as part of a cheerleader uniform. There is nothing to extract; the claimant claims the design of a useful article." IP Profs. *Amici Br. in Supp. of Pet'r* 17.

In addition, the government concedes that “the use of fabric strips ‘to create style lines and to minimize the stretching of neck and waist openings while strengthening the neck and waist hems and hem stitching’ is the sort of design technique that cannot receive copyright protection.” U.S. Br. 33. That is the effect of Varsity’s designs, all of which were conceived and created as cut-and-sew garments. Star Br. 14.



R.176, Ex. BB, Goldaper Suppl. Decl. at Ex. F1; accord J.A. 361–63.

Until Star Athletica demonstrated that Varsity’s designs served these structural functions, Varsity only produced the designs at issue as cut-and-sew garments. *Id.* at 16; contra Varsity Br. 17, 22, 31, 46. The fact that Varsity later printed images on fabric is irrelevant for the same reason that the outcome in *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 F. App’x 42, 45 (2d Cir. 2012), would be no different if the designer had merely printed images of sequins and tulle on a prom dress—the designs are inseparable from the utilitarian aspects of garments.

Most compelling, consider Varsity's depiction of its cheerleading uniforms without the color blocks, stripes, and braid. Star Br. 45. The blank, white skirts and tops have reduced utilitarian functionality. They do not enhance the wearer's appearance. And they do not identify the wearer as a cheerleader or a member of a particular group of cheerleaders. Even the government concedes that if such utilitarian considerations are properly among "the utilitarian aspects of the [useful] article," 17 U.S.C. § 101, that must be evaluated when determining separability, Varsity's designs are not separable. U.S. Br. 23. Given that these functions must be considered, Star Athletica prevails even under Varsity's test.

**V. There is no need to create copyright protection for garments to promote innovation.**

Contrary to Varsity's and its *amici's* claims, the courts do not need to expand copyright protection to encourage innovation in the fashion industry. The current copyright regime—which does not protect fashion design from copying—has not deterred innovation or investment in the industry. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 Va. L. Rev. 1687, 1775 (2006); Kal Raustiala & Christopher Sprigman, *The Piracy Paradox Revisited*, 61 Stan. L. Rev. 1201, 1203 (2009). "Every season thousands of new designs are produced by the large number of firms competing in a market approaching \$200 billion in U.S. sales annually. And a significant portion of this output involves copying." 61 Stan. L. Rev. at 1203. The lack of copyright protection "speeds up the fashion cycle

by diffusing designs more quickly, and then driving them toward exhaustion.” *Id.* at 1207; *see id.* at 1208 (“copying is helpful” to the fashion industry which “helps explain why fashion design has never been subject to copyright protection”).

Varsity’s rise to market dominance is a coda on this point. Because fashion design is not protected by copyright, Varsity copied competitors’ designs to gain customers—cheerleading squads needing one or two additional uniforms identical to what the squad already had. J.A. 188. On the flip side, Varsity’s infringement-actions have prevented the same type of competition, inflating cheerleader-uniform prices. Star Br. 13.

Congress has specifically chosen not to extend copyright protection to fashion design. Instead, Congress provided intellectual-property protection to useful articles in those areas that most readily promote the public’s interest in the advancement of Arts and Sciences. This contrasts with the approach other countries have adopted. Fashion Law Institute Br. 18. Congress’s choice must be respected.

Finally, Varsity argues that Star Athletica’s concerns regarding copyright monopolies are misplaced because designers are free to use the same building blocks as Varsity, provided they do not copy any of Varsity’s selections and arrangements.<sup>5</sup>

---

<sup>5</sup> Varsity concedes that it is claiming a copyright in the “arrangement” of the various stripes, chevrons, zig-zags, and color blocks. Varsity Br. 50, 62. The actual colors of the designs are irrelevant because the elements act to carry the colors of the school or team to which the cheerleaders belong and are thus related to the cheerleader uniform’s identifying function.

[Footnote continued on next page]

Varsity Br. 50–51. Zigzags, chevrons, and stripes are the basic elements of cheerleading uniform designs. J.A. 294, 305. But a designer cannot place zigzags, chevrons, and stripes just anywhere; instead the features must trace the uniform's shape and accentuate certain aspects of the wearer, see generally, J.A. 324–38, or this might be the result:



---

[Footnote continued from previous page]

Thus, the colors in the deposits are unoriginal; Varsity's expression is an arrangement of empty blocks, i.e., the overall configuration of its uniforms.



Or this:



The cheerleader-uniform designs in the record have a rather banal sameness, see J.A. 324–38, precisely *because* the “building blocks” only perform their function if appropriately placed.

\* \* \*

The parties and the government share considerable common ground. Everyone agrees that the statutory text controls; that utilitarian features cannot be copyrighted; that pre-existing artwork printed onto clothing is usually separable; that two-dimensional works are more readily separable; and that the Sixth Circuit’s approach should be rejected. Star Athletica’s and Varsity’s differences flow primarily from Varsity’s refusal to follow the statutory text, especially with regard to the scope of a useful article’s utilitarian function. That is because if the arrangement of stripes, chevrons, and color blocks adds utilitarian functionality to a blank athletic

outfit, then Varsity cannot stop Star Athletica from competing. U.S. Br. 23. And honoring the copyright limitations Congress imposed on useful articles promotes the development of “extraordinary ideas” that solve problems and change lives. Amici Br. of Public Knowledge 7 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007)).

### CONCLUSION

For the foregoing reasons and those stated in our opening brief, the judgment of the court of appeals should be reversed.

Respectfully submitted,  
John J. Bursch  
*Counsel of Record*  
BURSCH LAW PLLC  
9339 CHERRY VALLEY  
AVE SE, #78  
CALEDONIA, MI 49316  
(616) 450-4235  
jbursch@burschlaw.com

Matthew T. Nelson  
Conor B. Dugan  
WARNER NORCROSS &  
JUDD LLP  
900 Fifth Third Center  
111 Lyon Street, N.W.  
Grand Rapids, MI 49503  
(616) 752-2000

Steven M. Crosby  
Stephen E. Feldman  
THE FELDMAN LAW GROUP  
220 East 42nd Street,  
Suite 3004  
New York, NY 10017

Michael F. Rafferty  
Emily Hamm Huseh  
HARRIS SHELTON HANOVER  
WALSH P.L.L.C.  
One Commerce Square,  
Suite 2700  
Memphis, TN 38103

OCTOBER 2016

*Counsel for Petitioner*