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## ESSAY

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### THE SUM IS MORE PUBLIC DOMAIN THAN ITS PARTS?: US COPYRIGHT PROTECTION FOR WORKS OF APPLIED ART UNDER *STAR ATHLETICA'S* IMAGINATION TEST

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In *Star Athletica v. Varsity Brands*,<sup>1</sup> the Supreme Court granted certiorari to resolve confusion in the lower courts regarding the “separability” predicate to copyright protection of decorative features of useful articles. Adopting the Gordian imagery evoked by other appellate courts, the Sixth Circuit in *Varsity Brands* lamented “[c]ourts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article’s utilitarian function.”<sup>2</sup> *Star Athletica* involved the “surface decorations” of stripes, chevrons, and color blocks applied to cheerleader uniforms.<sup>3</sup> While the Supreme Court clarified the meaning and application of the “separability” standard for decorative

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<sup>1</sup> 137 S. Ct. 1002 (2017).

<sup>2</sup> *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 478 (6th Cir. 2015) (quoting *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041-42 n.2 (9th Cir. 2014), *aff’d*, 137 S. Ct. 1002 (2017)).

<sup>3</sup> *Star Athletica*, 137 S. Ct. at 1012.

elements of the kind at issue in that case, the decision leaves the knots as tangled as ever when a claim of copyright concerns the entire form of a useful article.

### I. THE STATUTORY STRUCTURE

The U.S. Copyright Act protects pictorial, graphic, and sculptural works (PGS works), including applied art, but distinguishes the designs of “useful articles” from nonutilitarian works. The latter includes those lacking “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>4</sup> While the statute classifies the design of a useful article a PGS 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,”<sup>5</sup> nonutilitarian works are PGS works in themselves, and there is no need to undertake an inquiry into the “separability” of aesthetic and useful elements. Such works need not be devoid of purpose, but their potential informational, depictive, or even affective utility—such as a religious painting’s stimulation of spiritual contemplation<sup>6</sup>—is not the kind of usefulness the statute renders ineligible for copyright.

Similarly, a two- or three-dimensional depiction of a useful article, such as a drawing of a bottle or a model airplane, is not itself a useful article. The law does not “excommunicate the paintings”<sup>7</sup> of Giorgio Morandi simply because they depict useful articles.<sup>8</sup>

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<sup>4</sup> 17 U.S.C. § 101 (2012) (defining “useful article”).

<sup>5</sup> *Id.*

<sup>6</sup> *See, e.g.,* *Masquerade Novelty v. Unique Indus.*, 912 F. 2d 663, 671 (3d Cir. 1990) (“When hung on a wall, a painting may evoke a myriad of human emotions, but we would not say that the painting is not copyrightable because its artistic elements could not be separated from the emotional effect its creator hoped it would have on persons viewing it. The utilitarian nature of an animal nose mask or a painting of the crucifixion of Jesus Christ inheres solely in its appearance, regardless of the fact that the nose mask’s appearance is intended to evoke mirth and the painting’s appearance a feeling of religious reverence.”).

<sup>7</sup> *Cf. Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“A rule cannot be laid down that would excommunicate the paintings of Degas”).

<sup>8</sup> Giorgio Morandi, *Natura Morta*. Photo source: Alfonso Feola, *Giorgio Morandi in mostra al Vittoriano*, *GAZZETTA REGIONALE* (Feb. 25, 2015) <https://www.gazzettaregionale.it/notizie/giorgio-morandi-in-mostra-al-vittoriano> [<https://perma.cc/L-497-4HHW>].



heirs enjoy the exclusive right in the USA to reproduce the pipe image on a variety of two- or three-dimensional merchandizing properties. Similarly, a sculptor can authorize or prohibit the incorporation of her work into a paperweight or to ornament fireplace andirons. Under § 113(a), if a work starts out as a painting or a sculpture, its subsequent adaptation into a useful article does not deprive the underlying PGS work of copyright protection. Suppose, for example, that Magritte had licensed the production of a coatrack with hooks in the shape of his depiction of a pipe.<sup>13</sup>



Section 113(a) makes clear that a third party's unlicensed reproduction of the coatrack hooks will violate Magritte's copyright in the painting.

If, by virtue of § 113(a), a preexisting PGS work does not lose protection when subsequently incorporated into a useful article, does the statute nonetheless require a different result if the work was created for the purpose of being a useful article? Suppose Magritte had never painted *The Treachery of Images*, but instead designed

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<sup>13</sup> Coatrack design by Nathalie Russell.

coat hooks in the shape of pipes. When the design is a useful article *ab initio*, several variants of the separability test applied by lower courts before *Star Athletica* would have excluded copyright protection. Those approaches revealed a “birth order distinction,”<sup>14</sup> in which the availability of copyright protection for the overall shape of an object depended on whether the design debuted as a nonuseful PGS work or instead was incorporated into a useful article from the start. To avoid copyright-disqualifying outcomes, designers might adopt a two-step strategy, fixing the design first in a PGS work, and later in a useful article.<sup>15</sup> The useful article would not have been the subject of copyright, but would effectively have enjoyed protection by virtue of the copyright in the underlying design because reproducing the article that incorporates the PGS work would violate the copyright in the PGS work. The divergent outcomes seem the product of pure formalism.

The Supreme Court has now adopted an analysis that might abolish this birth order distinction, for the Court now inquires whether the claimed feature of the useful article could be imagined as an independent PGS work. Under this inquiry, it does not matter whether the ornamental element was born as a PGS work and subsequently incorporated into a useful article, or was created to be part of a useful article. Nonetheless, as we shall see, application of the “imagination test” to the three-dimensional form of the useful article as a whole is likely to produce a skein no less tangled than the “twisted knots” with which lower courts previously contended.

## II. SEPARABILITY: THE “MIRROR IMAGE” APPROACH

Eschewing distinctions applied by lower courts and the Copyright Office between “physical” and “conceptual” separability (a distinction derived from the House Report to the 1976 Copyright Act),<sup>16</sup> the *Star Athletica* Court turned to the statutory text, which defines a useful article’s “pictorial, graphic, or sculptural features” as PGS works if [1] they “can be *identified separately* from, and [2] are capable of *existing independently* of, the utilitarian aspects of the article.”<sup>17</sup> The Court stated:

The first requirement—separate identification—is not onerous. The decisionmaker need only be able to look at the useful article and spot some

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<sup>14</sup> See Jane C. Ginsburg, “Courts Have Twisted Themselves into Knots”: *US Copyright Protection for Applied Art*, 40 COLUM. J.L. & ARTS 1, 4 (2016) (coining and discussing the term “birth order distinction”).

<sup>15</sup> See, e.g., *Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc.* 618 F. 3d 417, 434 (4th Cir. 2010) (reflecting judicial approval of a variant of this process wherein the designer first designed the useful parts of the furniture, and then, in a separate step, designed the artistic flourishes subsequently applied to the furniture).

<sup>16</sup> *Star Athletica LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1014 (2017). See H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 55 (1976).

<sup>17</sup> 17 U.S.C. § 101 (2012) (emphasis added).

two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.

The independent-existence requirement is ordinarily more difficult to satisfy. The decisionmaker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article. In other words, the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in §101 once it is imagined apart from the useful article. If the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.

Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or “[a]n article that is normally a part of a useful article” (which is itself considered a useful article).<sup>18</sup>

As construed by the Supreme Court, the statutory text best fits the kind of pictorial, graphic, or sculptural design elements exemplified by the statuette lamp base at issue in the Supreme Court’s seminal 1954 decision in *Mazer v. Stein*,<sup>19</sup> recognizing copyright coverage of the sculptural form of the lamp base as a “work of art” despite its incorporation into a useful article. Sculptural elements of *Mazer*’s kind clearly can be “identified separately from” and can be imagined as “existing independently of” the useful article’s functional elements; indeed, the lamp bases were also sold as freestanding statuettes.<sup>20</sup>

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<sup>18</sup> *Star Athletica*, 137 S. Ct. at 1010 (citations omitted).

<sup>19</sup> 347 U.S. 201 (1954).

<sup>20</sup> Zvi S. Rosen, *Curved Ballet Dancer—Female, H 1723, Mazer and the Balinese Dancer*, MOSTLY IP HISTORY (Mar. 23, 2017), <http://www.zvirosen.com/2017/03/23/mazer-and-the-balinese-dancer/> [<https://perma.cc/RW9M-URMF>] (statuette of ballet dance, left); Rebecca Tushnet, *That’s Where the Light Is*, REBECCA TUSHNET’S 43(B)LOG, (Sept. 12, 2012) <http://tushnet.blogspot.com/2012/09/thats-where-light-is.html> [<https://perma.cc/YQV2-Q46M>] (photograph of lamp advertisement, right).



Interpreting the statutory phrase “*capable of existing independently*” to extend to the imaginary removal of the feature as a predicate to its existing independently from the article meets the dual statutory requirements of separate identifiability and independent existence. This conceptual effort in effect imagines the design feature as a preexisting PGS work reproduced on or in the useful article. Interpreting separability as the mirror image of § 113(a) is consonant with the statutory text: if notwithstanding its application to or incorporation in a useful article, the design element could have been a freestanding PGS work, then it is both separately identifiable, and *capable* of separate existence.

The Supreme Court elaborated further:

The Copyright Act provides “the owner of [a] copyright” with the “exclusive right [t] . . . to reproduce the copyrighted work in copies.” §106(1). The statute clarifies that this right “includes the right to reproduce the [copyrighted] work in or on any kind of article, whether useful or otherwise.” §113(a). Section 101 is, in essence, the mirror image of §113(a). Whereas §113(a) protects a work of authorship first fixed in some tangible medium other than a useful article and subsequently applied to a useful article, §101 protects art first fixed in the medium of a useful article. The two provisions make clear that copyright protection extends to pictorial, graphic, and sculptural works regardless of whether they were created as freestanding art or as features of useful articles. The ultimate separability question, then, is whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had

it originally been fixed in some tangible medium other than a useful article before being applied to a useful article.<sup>21</sup>

*So Far So Good, But . . .*

It is not clear how far the Court's application of the reverse § 113(a) imagination test goes. In the case before it,

Applying this test to the surface decorations on the cheerleading uniforms is straightforward. First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium—for example, on a painter's canvas—they would qualify as “two-dimensional . . . works of . . . art,” §101. And imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself. Indeed, respondents have applied the designs in this case to other media of expression—different types of clothing—without replicating the uniform. The decorations are therefore separable from the uniforms and eligible for copyright protection.<sup>22</sup>

By contrast, had the separated features “replicate[d] the uniform,” then it appears the features would not have been separable because “the [extracted] feature cannot itself be a useful article.”<sup>23</sup> “Replication” does not mean “representation.” The Court analogized to a design that covers the full surface of a guitar: if the designs are lifted off, their contours will depict the shape of the guitar, but they will not *be* a guitar.<sup>24</sup> By the same token, the Varsity stripes were “surface decorations”: they followed the cut of the uniforms, but did not shape them (as evidenced by the interchangeability of the team-designating designs on the same basic—unadorned—uniform).<sup>25</sup>

The announced rule that “to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article” appears to preclude PGS status for the full shape of most useful articles.<sup>26</sup> Indeed,

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<sup>21</sup> *Star Athletica*, 137 S. Ct. at 1010.

<sup>22</sup> *Id.* at 1012 (internal references omitted).

<sup>23</sup> *Id.* at 1010.

<sup>24</sup> *Id.* at 1012.

<sup>25</sup> See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 491 (6th Cir. 2015) (“The five Varsity designs are examples of how a cheerleading uniform still looks like a cheerleading uniform no matter how different the arrangement of the stripes, chevrons, colorblocks, and zigzags appear on the surface of the uniform. All of Varsity’s graphic designs are interchangeable. Varsity’s customers choose among the designs in the catalog, including the five designs at issue, select one of the designs, and then customize the color scheme. The interchangeability of Varsity’s designs is evidence that customers can identify differences between the graphic features of each design, and thus a graphic design and a blank cheerleading uniform can appear “side by side”—one as a graphic design, and one as a cheerleading uniform.” (citations omitted))

<sup>26</sup> *Star Athletica*, 137 S. Ct. at 1010.



“features” suggests aspects or components of the design, not the entirety of the form of the useful article. If the claim of copyright resides in the form of the article as a whole, then there is no “feature” separable from the whole. Furthermore, the Court appears to exclude from PGS status even some portion of the shape of the article less than its entirety because “the feature cannot itself be . . . ‘[a]n article that is normally a part of a useful article’ (which is itself considered a useful article).”<sup>27</sup>

Are there nonetheless circumstances in which the “imagination test” approach to separability would embrace the full form of a three-dimensional useful article (or some substantial portion of it)? For example, were the complete abstraction of the article’s form from its function possible, and the shape could stand on its own as a work of art, perhaps the overall shape might be a “feature.”<sup>28</sup> In fact, the Court’s separability standard may not require that the form be completely unnecessary to the article’s function: the Court rejected a proposed requirement “that the statute protects only ‘solely artistic’ features that have no effect whatsoever on a useful article’s utilitarian function.”<sup>29</sup> Thus, it appears that the useful article’s separable form may even “make [the article] more useful.”<sup>30</sup> Consider the crocodile salad tongs pictured below.<sup>31</sup>



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<sup>27</sup> *Id.*

<sup>28</sup> See Paul Goldstein, GOLDSTEIN ON COPYRIGHT, § 2:79, 2.5.3 (3d ed. 2016) (applying a “stand alone” test to construe “conceptual separability” generally, and citing the example of a slipper in the shape of a bear paw).

<sup>29</sup> *Star Athletica*, 137 S. Ct. at 1014.

<sup>30</sup> *Id.*

<sup>31</sup> Jenni Chasteen, *Crocodile Salad Tongs*, INCREDIBLE THINGS, <http://incrediblethings.com/home/crocodile-salad-tongs/> [<https://perma.cc/9FRX-DVDR>].

One could imagine the toothy jaws as a sculpture of a crocodile, even if their particular configuration was designed for optimal salad-seizing. The *Star Athletica* court rejected the design process approach to separability adopted by some lower courts, an analysis that would have excluded any features for which functional considerations influenced the form.<sup>32</sup> Thus, it would not matter if the crocodile's head had been created to serve salad, rather than merely to represent a crocodile. If one could imagine the crocodile's head as a stand-alone sculpture, then its incorporation into salad tongs would not disqualify it from the copyright it would have enjoyed as a merely representational item.

Similarly, the Court disapproved the Copyright Office requirement that the conceptual separation of the PGS features from the useful article must result in two intact objects, the extracted PGS work on the one hand, and the remaining utilitarian article on the other<sup>33</sup>:

The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.<sup>34</sup>

It is correct that the statutory text requires only that the PGS feature be capable of existing independently without the useful article; the Copyright Office interpolated the reverse proposition that the useful article should be capable of existing independently without the design element. If the conceptual extraction of the PGS features does not require that the remainder still be capable of serving as the useful article that it was preextraction (the crocodile-headless salad tongs would not be very useful), then the Court might appear to be opening the way to widening the universe of protectable shapes of useful articles.

That said, the Court did pose some limit to the extraction approach: "Of course, because the removed feature may not be a useful article—as it would then not qualify as a pictorial, graphic, or sculptural work—there necessarily

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<sup>32</sup> See, e.g., *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) ("[I]f design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.").

<sup>33</sup> See U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* §101, 924.2(B) (3d ed. 2014).

<sup>34</sup> *Star Athletica*, 137 S. Ct. at 1013.

would be some aspects of the original useful article ‘left behind’ if the feature were conceptually removed.”<sup>35</sup> If “some aspects of the original useful article” must be “left behind,” then perhaps the extraction approach necessarily stops short of extending to the useful article’s entire form.<sup>36</sup>

The Court also declined to find in Congress’ frequent failure to enact a sui generis industrial design right a congressional “intent to entirely exclude industrial design from copyright.”<sup>37</sup> Rather, “Congress has provided for limited copyright protection for certain features of industrial design,”<sup>38</sup> that the separability test should accommodate. On the other hand, the Court stressed that “our test does not render the shape, cut, and physical dimensions of the cheerleading uniforms eligible for copyright protection.”<sup>39</sup> The Court’s enumeration of what its separability test does not protect echoes the nonreplication rule, and thus suggests a narrow scope of copyright coverage. If the listed features (“shape, cut, and physical dimensions”) are not copyrightable per se because their duplication “replicates” the useful article, then the Court has implicitly rejected an approach to separability that inquires whether other designs could achieve the utilitarian aspects of the article. After all, many different shapes, cuts or physical dimensions could permit a cheerleading uniform to attain its characteristic objectives to “cover the body, wick away moisture, and withstand the rigors of athletic movements.”<sup>40</sup> But, unlike the stripes, chevrons, and color blocks at issue in *Star Athletica*, whose reproduction would not “replicate” the uniforms, “shape, cut, and physical dimensions” do constitute the article itself. That the article may be one example of many different variations of uniforms does not matter; “shape, cut, and physical dimensions” define the particular resulting uniform, and that is all that is needed to produce a copyright-excluded “useful article.”

Applying the nonreplication rule to three-dimensional design “features” of useful articles should similarly result in a very limited universe of copyright-protectable forms constituting the object as a whole. The claimed shape, after all, will “replicate” the object (or a part of it), and the object will have “an intrinsic utilitarian function.”<sup>41</sup> Consider an amoeba-shaped tabletop.<sup>42</sup>

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<sup>35</sup> *Id.* at 1013-14.

<sup>36</sup> *Id.* at 1014.

<sup>37</sup> *Id.* at 1015.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.* at 1016.

<sup>40</sup> *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015).

<sup>41</sup> *Star Athletica*, 137 S. Ct. at 1008.

<sup>42</sup> See, e.g., F2F Amoeba Table, MIEN COMPANY, <http://www.miencompany.com/shop/by-category/tables—desks/classroom-tables-and-desks/item/F2-Amoeba-Table> [<https://perma.cc/AWY7-58L5>].



A table is a useful article, and its top “is normally a part of” it.<sup>43</sup> Accordingly, is its shape not separable? That tabletops can come in many shapes would matter no more than the availability of alternative cheerleader uniform configurations. Which shapes are “normally a part of a useful article”?<sup>44</sup> The answer would turn on the statutory definition of a useful article as an object that has “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>45</sup> If the shape has no utilitarian function (as might be the case for carvings that follow the edges of the table<sup>46</sup>), then separating the shape would not “replicate” a “useful article.” But if the shape does have an intrinsic utilitarian function, then its extraction would “replicate” a “useful article.” An amoeba shape for a table top might at first blush seem arbitrary and devoid of utility. But amoeba-shaped conference tables in fact exist and serve the utilitarian purpose of dividing the larger group sitting around the whole table into smaller discussion groups. As a result, the three-dimensional form of the table top, even if it might be perceived as a sculptural work, would not pass the second step of the *Star Athletica* analysis.

Application of the Supreme Court’s new test will probably yield the same representational art-favoring results as those obtained under most prior interpretations of the statutory standard: Courts more easily perceive

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<sup>43</sup> *Star Athletica*, 137 S. Ct. at 1010.

<sup>44</sup> *Id.*

<sup>45</sup> 17 U.S.C. § 101 (2012).

<sup>46</sup> See, e.g., *Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010) (finding that certain designs, such as leaves, columns, and carvings, can be “‘identified separately from’ the utilitarian aspects of . . . furniture.”).

figurative designs as “separable” than abstract forms. A federal district court found the bear-paw-shape of a slipper separable.<sup>47</sup>



Similarly, the sheep-shaped seat of a stool (image below)<sup>48</sup> may readily be identified separately and conceived as existing independently of the rest of the stool (even though a seat is a part of a stool).<sup>49</sup>

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<sup>47</sup> *Animal Fair, Inc. v. AMFESCO Indus., Inc.*, 620 F. Supp. 175, 188 (D. Minn. 1985), *aff'd without opinion*, 794 F.2d 678 (8th Cir. 1986) (finding the bear-depictive sculptural features of the slippers separable from and “wholly unrelated” to the footwear function). *See generally* Beer Paw Slippers, MYBOOTHANG, <https://www.myboothang.com/bear-paw-slippers/> [https://perma.cc/HV8H-RJRG] (depicting the image of bear-paw-slippers, which may not have been the ones at issue in *Animal Fair*, but provide a potential depiction). *See also* Steve Coulter, *Animal Fair to Close Its Doors After 15 Years in Business*, RIDGEFIELD PRESS (Apr. 1, 2015), <http://www.theridgefieldpress.com/44570/animal-fair-to-close-its-doors-after-15-years-in-business/> [https://perma.cc/U6VE-58TW] (noting that the company producing the slippers in the aforementioned case ceased operations 2015).

<sup>48</sup> County Engraving, *Children's Wooden Step or Stool Sheep Design Personalized*, COUNTY ENGRAVINGS ONLINE (2015), [www.countyengraving.co.uk/childrens-wooden-step-or-stool-sheep-design-personalised-109-p.asp](http://www.countyengraving.co.uk/childrens-wooden-step-or-stool-sheep-design-personalised-109-p.asp) [https://perma.cc/7YS8-6V6X].

<sup>49</sup> The *Star Athletica* ruling brings the sheep stool even more comfortably within the zone of separability because the court has clarified that the extraction of the PGS feature need not leave a “fully functioning” useful article behind. *Star Athletica*, 137 S.Ct. at 1013-14. A stool without a seat is not fully functional, but that no longer appears to be an impediment to the “separability” of the design of the seat.



In *Mazer v. Stein*, while the placement of the bulb and shade atop the dancer<sup>50</sup> may have facilitated ruling the ballerina sculpture protectable despite its incorporation in the lamp, one might predict that even were the lighting elements fully integrated into the sculpture—for example, were the illumination to emanate from the ballerina’s tutu—<sup>51</sup> a court would still find the sculpture separable from the useful article of the lamp.



<sup>50</sup> See *supra* image accompanying note 20.

<sup>51</sup> Sophie Mouton-Perrat and Frédéric Guibrinet, *Papiers à êtres, poésies sculptées*, series of bright sculptures, *Le sacre du Printemps*, Model created exclusively for La Galerie de l’Opéra Garnier 2010 (height 35-40cm), [http://www.papieraetres.com/sculptures\\_lumineuses.php?id=28](http://www.papieraetres.com/sculptures_lumineuses.php?id=28). The artists’ website distinguishes sculptures lumineuses (bright sculptures) from luminaires (lamps). Image source : <https://www.pinterest.com/pin/13201183279765062/> [<http://perma.cc/UCN7-JSKY>].

By contrast, the abstract form of the lighting fixture in *Esquire v. Ringer* did not elicit a perception of the object as a distinct sculpture.<sup>52</sup> Moreover, the simpler or sleeker the shape, the less likely courts may be to identify separate PGS features, much less perceive them as capable of existing independently of the article's utilitarian aspects. The *Star Athletica* Court opined that "there necessarily would be some aspects of the original useful article 'left behind' if the feature were conceptually removed"<sup>53</sup>, but the more the form follows the article's function, the less will be "left behind" after the extraction exercise. Indeed, The Court's statement that

[t]he ultimate separability question, then, is whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article<sup>54</sup>

appears to assume that the "tangible medium" in which the work is fixed is something to or on which the artwork is applied, as the chevrons are applied to the cheerleading uniforms, rather than forming a single whole with the artwork.

Thus, even if the overall form of a useful article (or parts of it) can be "identified" as a sculptural work, its ability to exist independently of the utilitarian aspects of the article will now be assessed under the nonreplication rule. If the shape of the object as a whole is a useful article, then it is not separable, even if other articles of similar utility might be differently shaped (just as cheerleader uniforms may come in many shapes, cuts or proportions). So long as the form is not gratuitous relative to the function, just about any three-dimensional shape of a useful article (or parts of it) will enable "an intrinsic utilitarian function."<sup>55</sup>

This understanding of the nonreplication rule yields a near-prophylactic barrier to copyright protection for the entire form of most useful articles. While, on the one hand, the court allowed (in dictum) that the contested design "feature" could affect the functioning of the useful article,<sup>56</sup> it also ruled that the design could not *be* the useful article.<sup>57</sup> And, as we have seen,

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<sup>52</sup> 591 F. 2d 796 (D.C. Cir. 1978).

<sup>53</sup> *Star Athletica*, 137 S. Ct. at 1014.

<sup>54</sup> *Id.* at 1011.

<sup>55</sup> 17 U.S.C. § 101 (2012).

<sup>56</sup> See *Star Athletica*, 137 S. Ct. at 1010 (undertaking the inquiry of separability even though the feature may be incorporated into the useful design).

<sup>57</sup> See *id.* ("Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article").

the statute defines useful article very broadly.<sup>58</sup> So understood, *Star Athletica* takes an Alexandrian swipe<sup>59</sup> at the knotty problem of design protection.

But this analysis may slash too deeply. The Court emphasized that Congress included “applied art” within the category of PGS works; it thus intended that *some* designs or “features” of useful articles qualify for copyright.<sup>60</sup> Assuming the entire form of a useful article can sometimes be considered a “feature,” then perhaps the “imagination test” requires an ability not only to see the contested article as a stand-alone PGS work, but also to ignore any of its utilitarian capacities.<sup>61</sup> And indeed, some courts’ pre-*Star Athletica* perception of representational shapes as separable suggests a tendency to overlook the role the shape may play in the attainment of the article’s functional objectives. For example, much of the fish pitcher, depicted below,<sup>62</sup> bears a relationship to its function; the open mouth serves as the spout and the curved tail furnishes the handle. But the pitcher is also “capable” of serving as a purely decorative object.<sup>63</sup>

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<sup>58</sup> See 17 U.S.C. §101 (2012).

<sup>59</sup> Plutarch recounts that Alexander the Great untied the intractable Gordian knot by “cut[ting] it asunder with his sword.” Plutarch, *Life of Alexander*, in 4 PLUTARCH’S LIVES, THE TRANSLATION CALLED DRYDEN’S 180-81 (A.H. Clough, ed. 1859).

<sup>60</sup> See *Star Athletica*, 137 S. Ct. at 1014 (noting that § 101 includes “applied art,” defined in the dictionary as “those arts or crafts that have a *primarily utilitarian function*”).

<sup>61</sup> In which case, the “imagination test” resembles Judge Newman’s “separate concept” test proposed in dissent in *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985). See *Carol Barnhart*, 773 F.2d at 422 (explaining that feature “must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”).

<sup>62</sup> Glug Jug Pitcher - Ceramic Golden Fish, ETSY, <https://www.etsy.com/listing/84000688/glug-jug-pitcher-ceramic-golden-fish> [<https://perma.cc/Ry24-ZEQ5>].

<sup>63</sup> Despite the Court’s contrary assertion, this understanding of the “imagination test” is consistent with another pre-*Star Athletica* variant, which inquired whether there was a market for the article as a purely decorative (otherwise useless) object. See *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989, 993-94 (2d Cir. 1980) (finding that belt buckle designs were separable from their utilitarian function because they could be used as ornamentation for other parts of the body). See also 1 MELVILLE B. NIMMER AND DAVID NIMMER, NIMMER ON COPYRIGHT, § 2A.08(B)(4) (2017) (“[C]onceptual separability exists when 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.”); cf. *Star Athletica*, 137 S. Ct. at 1015 (“[n]othing in the statute suggests that copyrightability depends on market surveys. Moreover, asking whether some segment of the market would be interested in a given work threatens to prize popular art over other forms, or to substitute judicial aesthetic preferences for the policy choices embodied in the Copyright Act.”).





Yet, if the article's capacity to serve as a purely decorative object is what allows us to distinguish separable from nonseparable forms (the latter disqualified from PGS status), then the "imagination test" could also embrace some abstract forms, for example the iconic Alvar Aalto vase (pictured below),<sup>64</sup> or indeed just about any other attractively designed useful article, for example, the outdoor lighting fixture refused registration in *Esquire, Inc. v. Ringer*<sup>65</sup> could have served purely as a decorative object during daylight hours.



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<sup>64</sup> Alvar Aalto Collection Gift set 95 mm, 160 mm, IITTALA, <https://www.iittala.com/interior/alvar-aalto-collection-gift-set-95-mm-160-mm-clear-2-pcs/p/k950516> [<https://perma.cc/59ZF-XFC4>].

<sup>65</sup> 591 F.2d 796 (D.C. Cir. 1978).

### III. LIMITS TO THE IMAGINATION?

A generous appreciation of the “imagination test,” or reverse § 113(a) approach, would bring within the scope of PGS works any detachable components that can separately be imagined as PGS works, despite their utility, such as the crocodile head salad tongs. But the test should encompass the entire shape of a useful article only if the article can be imagined as having no intrinsic utilitarian function (other than to inform or to depict). The test thus could include useful articles susceptible to purely decorative uses, such as the vases pictured above.<sup>66</sup> But there must be a limit to the imagination, lest every attractively-designed useful article be reimagined as a PGS work. If, to paraphrase Gertrude Stein, “a chair is a chair is a chair,”<sup>67</sup> so that the shapes of most useful articles should resist re-imagination as nonuseful PGS works, the universe of forms that effective advocates might conceptually convert to decorative “sculptures,” could nonetheless prove ever-expanding. Consider the following items, all on display in the Design Museum Danmark.<sup>68</sup> It does not require great labor of the imagination to conceive of some of these chairs as sculptures, particularly were one not first informed that they are chairs.



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<sup>66</sup> The test would also include the belt buckles in *Kieselstein-Cord*, which some purchasers wore “around the neck or elsewhere on the body rather than around the waist.” *Kieselstein-Cord*, 632 F.2d at 991.

<sup>67</sup> Cf. GERTRUDE STEIN, *GEOGRAPHY AND PLAYS* 187 (1972) (“Rose is a rose is a rose is a rose”).

<sup>68</sup> Photos by Jane C. Ginsburg (May 17, 2017).





Other examples likely abound, some more, some less obviously at first blush a useful article, but all of them arguably capable of being imagined as nonuseful works of art. The following principles could help avert a slide down that slippery slope when the claim of copyright concerns the entire form of a useful article:

1. A prophylactic nonreplication rule would preclude claims of copyright in the entire form of a useful article because the form replicates the article, and because nothing would be left behind once the PGS work was imaginatively extracted from the useful article.

While this rule would be easy to administer, and may well hew most closely to *Star Athletica's* analysis,<sup>69</sup> it may also so restrict the universe of protectable designs of useful articles as to be in tension with other aspects of the majority opinion.<sup>70</sup>

Moreover, the rule in operation might not effect the clean break to which the prophylactic rule aspires: manipulation of the article's birth order could still result in de facto protection of the useful article; for example, the purveyor of the fish pitcher could first create a solid fish sculpture in the shape of the pitcher and

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<sup>69</sup> See, *supra* note 26 and accompanying text (noting that the Court prohibits the feature from itself being the useful article).

<sup>70</sup> See, *supra* notes 26-28 and accompanying text (considering scenarios in which the shape of the object is only a feature).

register it for copyright as a PGS work, then make a hollow mold of the sculpture to serve as a pitcher. The reproduction of the sculpture “in or on a useful article” comes within the exclusive rights of the PGS work copyright owner.<sup>71</sup>

Birth order manipulation, however, will likely not result in de facto copyright protection for useful articles less susceptible to re-imagination as PGS works. The exclusive right to reproduce a PGS work “in or on a useful article” does not extend to reproduction of the useful article that the PGS work portrays.<sup>72</sup> The scope of copyright in a sculpture of a chair extends to reproducing the image of the sculpted chair in two-dimensional useful articles such as wall paper or fabric designs, or in three-dimensional useful articles such as paperweights and bookends,<sup>73</sup> but not in the useful article “so portrayed;” i.e., not in an actual chair.

2. Alternatively, the design of the entire three-dimensional shape of a useful article may be a PGS work under the “imagination test” if the design can be identified as a PGS work (a sculpture) and is “capable of existing independently of [] the utilitarian aspects of the article.”<sup>74</sup> Capacity for independent existence means capacity to be perceived (and exploited?) as an article lacking an intrinsic utilitarian function other than to portray or to inform. If one function of the article is representative or decorative, that function is not “utilitarian,” and therefore the article would be “capable” of independent nonutilitarian existence, even if it is also in fact used for utilitarian purposes.

For example, while both the fish pitcher and the Arvar Aalto vase are containers for water, both can also be used as decorative objects. A dual perception or utilization, as both a useful and a nonuseful article, would not disqualify the work from copyright coverage so long as the perceived “sculpture” were not a representation of the useful article itself (a “sculpture of a chair” and a chair *qua* chair).<sup>75</sup>

The second limiting principle may produce results consonant with some of the *Star Athletica* dicta, but seems in tension with the statute and with the “nonreplication” rule. The statute defines a useful article as one having “an”

<sup>71</sup> 17 U.S.C. § 113(a) (2012).

<sup>72</sup> 17 U.S.C. § 113(b) (2012) (“This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law . . .”).

<sup>73</sup> *Cf.*, *supra* image accompanying note 13.

<sup>74</sup> 17 U.S.C. § 101 (2012).

<sup>75</sup> Unlike Judge Newman’s test, *supra* note 61, it would not be necessary for the aesthetic character of the form to “displace” the identification of the form as utilitarian. This approach more closely resembles a duality approach. *See, e.g.*, Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC’Y U.S.A. 339, 377-78 (1989) (advocating a “duality” over a “displacement” approach to conceptual separability).

intrinsic utilitarian function. The definition casts a wider net over useful articles than the predecessor version set out in pre-1976 Act Copyright Office regulations, which had limited the useful article category to designs whose “sole intrinsic function is its utility.”<sup>76</sup> But the proposed principle would turn the final definition on its head, by finding the design separable if, despite its utilitarian function, the useful article also has a nonutilitarian function.

*Star Athletica*’s internal contradictions leave the meaning of “separability” very much in doubt with respect to the three-dimensional form of useful articles. The imagination test, or reverse section 113(a) approach, may work well for two-dimensional ornaments, and for three-dimensional features that are easily “extracted” from the useful article. However, as to the useful article in its entirety, even the prophylactic nonreplication rule that emerges as the most consistent reading of the decision remains for some designs vulnerable to birth order circumvention. Thus, the Supreme Court has failed to untie the “knots” into which lower courts have “twisted themselves.”

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<sup>76</sup> 37 CFR § 202.10(c) (1960).