
ESSAY

KNOWING SEPARABILITY WHEN WE SEE IT

MARK P. MCKENNA†

According to the majority in *Star Athletica v. Varsity Brands*, features that are incorporated into a useful article are separable, and thus potentially copyrightable, if they “(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 [their] own or fixed in some other tangible medium of expression—if [they] were imagined separately from the useful article.”¹

This formulation has not been well received, primarily because it seems to allow copyright protection for many more features of useful articles than was permitted by pre-*Star Athletica* doctrine, notwithstanding the wide range of tests previously used and the doctrine’s well-recognized conceptual incoherence. I share the concern about over-protection, even though the Supreme Court’s test bears some similarity to the one my co-authors and I proposed in an amicus brief in the case.² As we demonstrated in our brief, Congress intended the useful articles doctrine to distinguish applied art from industrial design, making the former eligible for copyright protection but excluding the latter. Courts, we argued, should operationalize that distinction by deeming features separable only when they “(1) can be extracted from the article, even if doing so would destroy the article, and (2) once extracted, would stand alone as an original pictorial, graphic, or sculptural work (PGS work) that is not a useful article.”³

Despite the apparent similarity of this formulation and the one adopted by the majority, in my view the Court missed the mark because its test is

† Professor of Law and Notre Dame Presidential Fellow, Notre Dame Law School. Thanks to Mark Lemley and Rebecca Tushnet for comments on an earlier draft.

¹ *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

² Brief for Intellectual Property Professors as Amici Curiae Supporting Petitioner, *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866).

³ Brief for Intellectual Property Professors, *supra* note 2, at 2-3.

disconnected from the purpose of the useful articles doctrine and its requirement of separability. Specifically, despite acknowledging that “Congress has provided copyright protection for original works of art, but not for industrial designs,”⁴ the majority failed to keep that critical distinction at the fore when it applied its separability standard to Varsity’s designs. That failure was probably at least in part a consequence of a conceptual mistake: the majority contrasted protectable “art” and unprotectable “industrial design,” whereas Congress distinguished between “*applied art*” and “industrial design.”⁵

That distinction might seem insignificant, but in fact the majority’s characterization reflects a serious misunderstanding of the channeling function of the useful articles doctrine. The majority’s juxtaposition of art and design leads naturally to the view that design is distinct from art because, unlike art, design lacks aesthetic qualities. But in fact, “industrial designs, like copyrightable works, have aesthetic qualities and might be perceived as ‘art’ by patrons thereof.”⁶ Congress did not exclude industrial design from copyright protection only when it lacks aesthetic value; it excluded design *even when* it has aesthetic qualities because it meant for industrial design to be protected, if at all, by design patent. Indeed, only a court that misunderstood the applied art/industrial design distinction could have been so blasé about the likelihood that its test would result in overlapping copyright and design patent protection.⁷

Having mischaracterized the distinction at the heart of the separability requirement, the majority abstracted away from the central examples Congress used to elucidate the concept of separability, namely a “carving on the back of a chair” and a “floral relief design on silver flatware.”⁸ Those examples of separable features, Congress explained, are to be distinguished from the shapes of industrial products, which are not copyrightable even if they are aesthetically satisfying and valuable. As the House Report said plainly, “[u]nless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial

4 *Star Athletica*, 137 S. Ct. at 1007.

5 See H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668 (noting that the statutory language was intended “to draw as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design”).

6 Brief for Intellectual Property Professors, *supra* note 2, at 16.

7 See *Star Athletica*, 137 S. Ct. at 1015 (“[W]e have long held that design patent and copyright are not mutually exclusive. Congress has provided for limited copyright protection for certain features of industrial design, and approaching the statute with presumptive hostility toward protection for industrial design would undermine Congress’ choice.” (quoting *Mazer v. Stein*, 347 U.S. 201, 217 (1954))). Congress’ choice, however, was explicitly to exclude industrial design from copyright protection.

8 See H.R. REP. NO. 94-1476, at 55 (“And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.”).

product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted”⁹ The Copyright Office’s examples of separable features in its Compendium—“an engraving on a vase,” “[a]rtwork printed on a t-shirt,” “[a] colorful pattern decorating the surface of a shopping bag,” “[a] drawing on the surface of wallpaper,” and “[a] floral relief decorating the handle of a spoon”—all follow the same theme.¹⁰

What these examples have in common is that they treat conceptual separability as a coda to physical separability. All of them involve features that one could easily identify as copyrightable works if they were physically extracted from the useful articles to which they were applied, but it happens that physically extracting them is impossible because extraction would destroy the articles. Features of industrial design differ because they make sense only as parts of the useful articles or are integrated into the articles’ overall form. Hence, our brief argued,

if one could extract the claimed features and use them on their own in another context without replicating the useful article of which they are part, and the result would be a copyrightable PGS work standing alone, then there is separable matter. On the other hand, if extracting the claimed features would necessarily bring along the underlying useful article, the design is inseparable from the useful article.¹¹

Because the majority in *Star Athletica* did not work outward from Congress’s core examples, it ignored the possibility that some features, when imagined separately, “would necessarily bring along the underlying useful article.”¹² That is a problem because, in light of copyright’s capacious originality standard, *any* feature of a useful article, described with sufficient particularity, could be “imagined” as a separate work.¹³ Thus the majority had no adequate response to the dissent’s invocation of Marcel Duchamp’s shovel to demonstrate that anything can be understood as art, if one “[j]ust imagine[s] a frame surrounding the design, or its being placed in a gallery.”¹⁴

⁹ *Id.*

¹⁰ U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2(B) (3d ed. 2014) [hereinafter COMPENDIUM (Third)].

¹¹ Brief for Intellectual Property Professors, *supra* note 2, at 9.

¹² *Id.*

¹³ See *Feist Publ’ns, Inc. v. Rural Tel. Co., Inc.*, 499 U.S. 340, 345 (1991) (“Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. . . . To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.” (citation omitted)).

¹⁴ *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1033 (2017) (Breyer, J., dissenting).

According to the majority, “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.’”¹⁵ As a result, a shovel as such is not copyrightable, even if a drawing of a shovel or “artistic features that could be perceived as art apart from the shovel” could be.¹⁶ But of course the whole dispute in *Star Athletica* was about whether Varsity’s design was of a cheerleading uniform or instead of “artistic feature[s] that could be perceived as art apart from” the cheerleading uniform. The majority made no attempt to explain its implicit conclusion that Duchamp’s shovel lacked artistic features that could be perceived as art apart from the shovel. Like obscenity, the Court apparently just knows artistic features when it sees them.¹⁷

The dissent’s approach is better because its formulation can explain why there was nothing copyrightable about the designs at issue in prior cases involving measuring spoons shaped like heart-tipped arrows, candleholders shaped like sailboats, and wire spokes on wheel covers:

The designs [of those articles] cannot be physically separated because they themselves make up the shape of the spoon, candleholders, or wheel covers of which they are a part. And spoons, candleholders, and wheel covers are useful objects, as are the old shoes depicted in Van Gogh’s painting. More importantly, one cannot easily imagine or otherwise conceptualize the design of the spoons or the candleholders or the shoes *without that picture, or image, or replica being a picture of spoons, or candleholders, or wheel covers, or shoes*. The designs necessarily bring along the underlying utilitarian object.¹⁸

In the dissent’s view, the appropriate question in all of those cases was not simply whether one could imagine separately any features of the spoons, candleholders, or wheel covers, but whether, when viewed separately, those features would still have “br[ought] along the underlying utilitarian object.”¹⁹ Applying that test to Varsity’s designs, the dissent concluded that the designs were not separable because no one could look at the chevrons and stripes as they were arranged and fail to see cheerleading uniforms.²⁰ The designs necessarily brought along the uniforms.

¹⁵ *Id.* at 1013 n.2 (quoting 17 U.S.C. § 101).

¹⁶ *Id.*

¹⁷ *Cf.* *Jacobellis v. Ohio*, 378 U.S. 184, 198 (1964) (Stewart, J., concurring) (“I shall not today attempt further to define the kinds of material I understand to be embraced within that shorthand description; and perhaps I could never succeed in intelligibly doing so. But I know it when I see it, and the motion picture involved in this case is not that.”).

¹⁸ *Star Athletica*, 137 S. Ct. at 1032-33 (Breyer, J., dissenting) (emphasis in original).

¹⁹ *Id.*

²⁰ *See id.* at 1035 (“Looking at all five of Varsity’s pictures, I do not see how one could conceptualize the design features in a way that does not picture, not just artistic designs, but dresses as well.”).

Importantly, the majority did not really dispute that Varsity's so-called surface designs depicted cheerleading uniforms when they were imagined separately. It simply rejected the idea that two-dimensional depictions of useful articles are uncopyrightable, even when they depict useful articles. To illustrate the point, the majority used the example of "a design etched or painted on the surface of a guitar."²¹ According to the Court,

[i]f that entire design is imaginatively removed from the guitar's surface and placed on an album cover, it would still resemble the shape of a guitar. But the image on the cover does not 'replicate' the guitar as a useful article. Rather, the design is a two-dimensional work of art that corresponds to the shape of the useful article to which it was applied.²²

This way of conceiving the protectability of Varsity's designs might not be a problem if it were clear that the resulting rights were correspondingly narrow—specifically if it were clear that rights in Varsity's two-dimensional depictions could not be asserted against a party that made a three-dimensional useful article embodying that design. But while the majority indicated as much elsewhere when it described the limited rights in a cardboard model of a car (noting that the rights in the cardboard model would not extend to the actual car that inspired it),²³ its discussion of the guitar design muddied the water considerably. In fact, the majority's disparate treatment of the model car and guitar examples suggests an implicit distinction between surface ornamentation and configuration. The design *on* the guitar is protectable (and presumably enforceable against other parties that use that same design on an actual guitar) even if, when imagined separately, the design still depicts a guitar. The design *of* the cardboard model of a car, by contrast, is protectable only as a model; it cannot be enforced against an actual car that uses the same configuration depicted in the model.

This discussion highlights the extent to which the majority's formulation puts pressure on claiming in cases involving useful articles. The question of whether Varsity's designs consisted of surface ornamentation (design *on*) or instead depicted the configuration *of* cheerleading uniforms divided courts at every level of the litigation. Indeed, each of the three opinions in the Supreme Court reflected a different understanding of Varsity's claimed design.

²¹ *Id.* at 1012.

²² *Id.*

²³ *Id.* at 1010. The majority cited no authority for this proposition, but presumably it is a result of § 113(b), which, by most interpretations, prevents one from enforcing rights in depictions of a useful article against the making of the useful article itself. See *Forest River, Inc. v. Heartland Recreational Vehicles, LLC*, 753 F. Supp. 2d 753, 758-59 (N.D. Ind. 2010) (applying § 113(b)); WILLIAM F. PATRY, PATRY ON COPYRIGHT § 11:13 (2016) ("[C]opyright in a drawing of a boiler, cabinet, or automobile would not prohibit unauthorized manufacture from drawings of those objects." (footnote omitted)).

According to the majority, Varsity claimed “surface designs” consisting primarily of “combinations, positionings, and arrangements of elements’ that include ‘chevrons . . . lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring, and shapes,’”²⁴ designs that simply “correspond[ed] to the shape of the useful article[s]” (the cheerleading uniforms).²⁵ Justice Ginsburg took the “surface decoration” theme even further in her concurrence, describing the designs as “standalone pictorial and graphic works that [Varsity] reproduce[d] on cheerleading uniforms”—works that didn’t even require separability analysis because they were not designs of useful articles.²⁶ Justice Breyer’s dissent, on the other hand, viewed the designs as inescapably depicting cheerleading uniforms, since Varsity didn’t merely claim a series of chevrons and stripes but instead claimed chevrons and stripes “as they [were] arranged on the neckline, waistline, sleeves, and skirt of each uniform.”²⁷

That variation in understanding of the relevant design matters enormously, because notwithstanding the majority’s insistence that “two-dimensional artistic features on the surface of useful articles” are not “inherently separable,”²⁸ it is hard to resist the conclusion that its characterization of Varsity’s design as surface ornamentation was dispositive. Yet it is entirely unclear why that characterization is the most natural one. Among other things, the correct understanding of Varsity’s claims turns in significant part on whether we focus on the image in the deposit copy or Varsity’s characterization of that design.

Here are the designs Varsity registered:

Image 1: Varsity’s Registered Designs²⁹



²⁴ *Star Athletica*, 137 S. Ct. at 1007 (alteration in original).

²⁵ *Id.* at 1012.

²⁶ *Id.* at 1018 (Ginsburg, J., concurring).

²⁷ *Id.* at 1035 (Breyer, J., dissenting) (emphasis omitted).

²⁸ *Id.* at 1009.

²⁹ *Id.* at 1016 (appendix to opinion of the court).

The majority's description of Varsity's designs as drawings of various features in some arrangement³⁰ seems to me, as it seemed to Justice Breyer, to ignore the reality of the images submitted to the Copyright Office. Those images do not simply depict chevrons and lines; they depict cheerleading uniforms with particular design features. That, of course, does not necessarily mean that Varsity claimed every aspect of the designs shown in the deposit copy images, but uncertainty about what the images reflect is precisely the problem. Copyright registration does not require visual demarcation of the claimed features, nor does it require a clear verbal identification of those features. As a result, one cannot simply look at the registration and determine the nature or scope of Varsity's claim.³¹

This is a potentially significant concern in the context of useful articles, because the same visual image in a deposit copy could reflect at least two different types of claims. One might, for example, make a model of a car and submit an image of that model to claim rights in the model.³² As the *Star Athletica* majority noted, the model of the car would be copyrightable even if it could not be enforced against a party that makes an actual car with the same design.³³ But one could also submit an image of the model car and claim features depicted in the image in the same way Varsity claimed the features depicted in the images of its cheerleading uniforms—as features that might be “applied to” the car itself.³⁴ That is to say that the very same deposit copy could form the basis of a claim to a particular depiction of a car, but not the design of an actual car, or to features of an actual car, at least as long as those features could be “imagined” separately from the car. Indeed, this is true on the majority's test even if those features necessarily conform to the shape of the car.³⁵

³⁰ See *id.* at 1008-09 (“In this case, our task is to determine whether the arrangements of lines, chevrons, and colorful shapes appearing on the surface of respondents' cheerleading uniforms are eligible for copyright protection as separable features of the design of those cheerleading uniforms.”)

³¹ See Jeanne Fromer, *Claiming Intellectual Property*, 76 U. CHI. L. REV. 719, 745 n.136 (2009) (“To register, an applicant must complete a form with information about the applicant and the work's title, completion date, and publication date (if any), but nothing about the work's content or the set of works protected by the copyright.” (citation omitted)).

³² One could, of course, also claim copyright in the image of the model itself, distinct from the model. But that image would not be a useful article, so it would not be subject to separability analysis.

³³ See *Star Athletica*, 137 S. Ct. at 1010 (“Nor could someone claim a copyright in a useful article merely by creating a replica of that article in some other medium—for example, a cardboard model of a car.”).

³⁴ See *id.* at 1005 (“§ 113(a) . . . protects art first fixed in a medium other than a useful article and subsequently *applied to* a useful article.” (emphasis added)).

³⁵ One could argue that the features of a model car could never be imagined separately to the extent they are just aspects of configuration (the design *of* a car rather than design *on* the car)—citing the Court's implicit distinction between Duchamp's shovel and the surface design of the guitar. That argument, however, only emphasizes how critical it is to determine whether the design at issue is one that goes *on* a useful article or is instead the design *of* the article.

Such a multiplicity of potential claims might be tolerable if ordinarily the copyright registration process forced a party to delineate its claim, identifying which features of the submitted work it claimed and for what purpose. But because the registration process does not require any verbal or visual delineation, the putative copyright owner will only really define its claim in litigation. That is a problem because the majority opinion makes separability turn on whether features of a useful article can be imagined separately as a work of authorship that is not itself a useful article.³⁶ What features are we to “imagine” separately, and how do we know whether those features can be recognized as a work of authorship or instead simply depict the useful article?

The majority had very little to offer on either of those questions; it simply accepted that Varsity’s design consisted of a combination of chevrons and other lines arranged in some format. If we are to assume that separability implies evaluation of something less than the entirety of the design, however, then clearly the first step in the separability analysis must be identification of the purportedly separable features. And, in fact, the Court made it clear that independent existence requires the decision-maker to “determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article.”³⁷

By what process are features “separately identified” so that their independent existence can be evaluated? According to the majority, “[t]he first requirement—separate identification—is not onerous. The decisionmaker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.”³⁸ It is possible that courts will take that statement literally and simply look at useful articles and decide whether they can identify any “separate” two- or three-dimensional elements of the articles. But it seems much more likely that the question will turn on which features the plaintiff *claims* should be imagined separately. Here, the lack of claiming methodology in copyright is likely to pose a significant problem.³⁹

Recall that the Supreme Court described Varsity’s designs quite abstractly, as “surface designs” consisting primarily of “‘combinations, positionings, and arrangements of elements’ that include ‘chevrons . . . [,] lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring, and shapes.’”⁴⁰ The Sixth Circuit’s characterization was equally abstract, referring

³⁶ See *Star Athletica*, 137 S. Ct. at 1010.

³⁷ *Id.*

³⁸ *Id.*

³⁹ For a thorough discussion of the challenges of claiming design, see Jeanne Fromer & Mark P. McKenna, *Claiming Design* (Sept. 20, 2017) (unpublished manuscript) (on file with authors).

⁴⁰ *Star Athletica*, 137 S. Ct. at 1007 (alteration in original).

to the “graphic features of Varsity’s designs—the arrangement of stripes, chevrons, zigzags, and color-blocking.”⁴¹

But when Varsity described its designs to the Copyright Office in order to overcome the Office’s initial rejection, its descriptions were *much* more particular. Here’s one example:

Design 538 . . . has a central field of black bordered at the bottom by a gray/white/black multistripe forming a shallow “vee” of which the left-hand leg is horizontal, while the right-hand leg stretches “northeast” at approximately a forty-five degree angle. Below the upward-angled leg of the shallow “vee” is a similarly angled wider white stripe, succeeded by an area of black. The central field of black is bordered on top by an “X” figure formed of the same gray/white/black multistripe that appears at the bottom, with the colors reversed. Above the “X” is a field of white; the wedges at either side of the “X” are subdivided horizontally into approximately equal-sized wedges of black over white.⁴²

The descriptions of the designs at issue are likely to matter in separability cases because at different levels of abstraction the purportedly separable features are going to look more like works of authorship that can be imagined separately—or, conversely, more like aspects of the platonic form of the useful article. In other words, the level of abstraction of the description is going to influence whether a court regards the design simply as that of “a shovel as a shovel,” or instead as one that consists, at least in part, of “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.”⁴³

As difficult as it may be to develop a consistent claiming methodology in copyright, the alternative is for courts simply to engage in artistic evaluation, as the majority did with respect to Duchamp’s shovel. Indeed, the only way the Court could confidently have concluded that there were no separable features of the shovel was to determine (implicitly, and without the benefit of any claim to particular features) that none of the features of that shovel were sufficiently artistic to “be perceived as art apart from the shovel.”⁴⁴ This is risky business, since we have long been told that it is “a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [artistic expression], outside of the narrowest and most obvious limits.”⁴⁵ The

⁴¹ Varsity Brands, Inc. v. Star Athletica, LLC, 799 F.3d 468, 491 (6th Cir. 2015).

⁴² Joint Appendix at 140, *Star Athletica, LLC v. Varsity Brands, Inc.*, 799 F.3d 468 (6th Cir. 2015) (No. 15-866).

⁴³ *Star Athletica*, 137 S. Ct. at 1013 n.2.

⁴⁴ *Id.*

⁴⁵ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

majority's test at least flirts with that undertaking; divorcing separability from any particular claim leaves courts with essentially no other option.

Preferred Citation: Mark P. McKenna, *Knowing Separability When We See It*, 166 U. PA. L. REV. ONLINE 127 (2017), <http://www.pennlawreview.com/online/166-U-Pa-L-Rev-Online-127.pdf>.