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## ESSAY

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### *STAR ATHLETICA'S* FISSURE IN THE INTELLECTUAL PROPERTY FUNCTIONALITY LANDSCAPE

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In a perverse twist, the Supreme Court's 2017 *Star Athletica* copyright decision<sup>1</sup> might have more significant effects on *design patent* protection and the larger intellectual property landscape than it will on copyright law's useful article doctrine. As Professor Jane Ginsburg foretold, the works at issue in *Star Athletica* provided a poor vehicle for addressing the thorny problems bedeviling the useful article separability doctrine.<sup>2</sup> Unfortunately, in their zeal to nudge the Court toward tighter limits on *copyright* eligibility for useful articles, several intellectual property scholars and advocates mistakenly argued that *design patent* protection extended to functional features of articles of manufacture as a means to persuade the Court that it should tighten copyright law's useful article separability doctrine.<sup>3</sup> The gambit backfired.

In the end, the *Star Athletica* majority downplayed the functionality concern. The Court characterized the Petitioner's argument that "the statute protects only 'solely artistic' features that have no effect whatsoever on a useful article's utilitarian function" as "flawed"<sup>4</sup> and reasoned that "[a]n

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<sup>1</sup> *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).

<sup>2</sup> See Jane C. Ginsburg, "Courts Have Twisted Themselves Into Knots": *U.S. Copyright Protection For Applied Art*, 40 COLUM. J.L. & ARTS 1, 1 (2016) (noting that "the controversy before the Court does not concern the 'design of a useful article,' and therefore does not require the Court to resolve the meaning of 'separability'"); see also *Star Athletica*, 137 S. Ct. at 1018 (Ginsburg, J., concurring) (contending that consideration of the separability test was "unwarranted because the designs at issue are not designs of useful articles" but instead were "copyrightable pictorial or graphic works reproduced on useful articles"; and noting that 17 U.S.C. § 113(a) expressly provides that copyright in a standalone pictorial work "includes the right to reproduce the work in or on any kind of article, whether useful or otherwise").

<sup>3</sup> See *infra* Part II.

<sup>4</sup> *Star Athletica*, 137 S. Ct. at 1014.

artistic feature that would be eligible for copyright protection on its own cannot lose that protection simply because it was first created as a feature of the design of a useful article, even if it makes that article more useful.”<sup>5</sup> The majority concluded that “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.”<sup>6</sup>

This result ignores Congress’s clear intent for courts to “approach[] the statute with presumptive hostility toward protection for industrial design.”<sup>7</sup> The Court’s assertion to the contrary overlooks the text of the Copyright Act, its legislative history, and its seminal jurisprudence, all of which emphatically bar copyright protection for functional elements of expressive works. Section 102(b) of the Copyright Act declares that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”<sup>8</sup> The specific legislative history relating to copyright protection for “pictorial, graphic, and sculptural works” states that

[T]he Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design . . . . [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial 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 under the bill. The test of separability and independence from ‘the utilitarian aspects of the article’ does not depend upon the nature of the design—that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only

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<sup>5</sup> *Id.* This comment overlooks circumstances in which initially arbitrary text becomes functional because of de facto standardization. See Peter S. Menell, *Rise of the API Copyright Dead?: An Updated Epitaph for Copyright Protection of Network and Functional Features of Computer Software*, HARV. J. L. & TECH. (manuscript at 36) (forthcoming 2017-18), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2893192](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2893192), (providing examples of this de facto standardization and its impact); Peter S. Menell, *An Analysis of the Scope of Copyright Protection for Application Programs*, 41 STAN. L. REV. 1045, 1089-1102 (1989) (discussing the challenges of fitting computer-human interfaces—which combine expressive form with utilitarian purposes—within the intellectual property system).

<sup>6</sup> *Star Athletica*, 137 S. Ct. at 1015.

<sup>7</sup> *Id.*

<sup>8</sup> 17 U.S.C. § 102(b) (2012).

elements, if any, which can be identified separately from the useful article as such are copyrightable.<sup>9</sup>

The Supreme Court's seminal decision in *Baker v. Selden*, which the Copyright Act of 1976 fully embraces,<sup>10</sup> established that it would be a "surprise and a fraud upon the public" "[t]o give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made."<sup>11</sup>

Further contributing to this misapprehension of the landscape of intellectual property law, Justice Breyer's dissenting opinion in *Star Athletica*, joined by Justice Kennedy, unwisely took the design patent bait.<sup>12</sup> Dicta in that opinion potentially opens up unwarranted protection of designs that integrate form and function, including minimalist designs, under the design patent regime.<sup>13</sup> Taken together, the majority and dissenting opinions threaten substantial harm to the intellectual property system by recognizing protection for functionality outside of the strictures of *utility* patent law.

## I. COPYRIGHT'S USEFUL ARTICLE DOCTRINE

As a means to channel intellectual property protection between the utility patent and copyright regimes, the Copyright Act of 1976 authorizes copyright protection for "pictorial, graphic, or sculptural features" of the "design of a useful article" "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>14</sup> Courts have long struggled to delineate the separability line, and the Supreme Court granted certiorari in *Star Athletica* to resolve a messy circuit split.<sup>15</sup>

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<sup>9</sup> See H.R. REP. NO. 94-1476, at 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668 (emphasis added); see also *id.* at 57 ("Section 102(b) is intended, among other things, to make clear that the expression adopted by the programmer is the copyrightable element in a computer program, and that the actual processes or methods embodied in the program are not within the scope of the copyright law.")

<sup>10</sup> See H.R. REP. NO. 94-1476, at 56-57; see also NAT'L COMM'N ON NEW TECH. USES OF COPYRIGHTED WORKS, FINAL REPORT 18-19 (1978) (noting that the rule of *Baker v. Selden* is reflected in section 102(b) of the Copyright Act of 1976).

<sup>11</sup> 101 U.S. 99, 102 (1879). The Supreme Court was referring to novelty of the art and not the novelty of the expression. See *id.*, at 103 (distinguishing "ornamental designs" "addressed to the taste" from methods of operation and technological arts).

<sup>12</sup> See *infra* Part II.

<sup>13</sup> See *id.*

<sup>14</sup> 17 U.S.C. § 101 (defining "pictorial, graphic, and sculptural works").

<sup>15</sup> The Sixth Circuit's decision identified nine different tests. See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484-85 (6th Cir. 2015) (discussing the different tests).

The majority's textualist interpretation<sup>16</sup> does little to address the most challenging separability disputes—those relating to the integration of form and function, often manifest in minimalist designs for useful articles.<sup>17</sup>

Based on the definition of a “pictorial, graphic, or sculptural feature” incorporated into the “design of a useful article,” the Court in *Star Athletica* breaks the separability inquiry into two components: (1) *separate identification*—whether the feature “can be identified separately from . . . the utilitarian aspects of the article”; and (2) *independent existence*—whether the feature is “capable of existing independently of, the utilitarian aspects of the article.”<sup>18</sup> The Court summarized its rule in a deceptively simple manner: “a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.”<sup>19</sup>

The majority opinion skates around exclusion of functional features from copyright protection, noting that “[a] fresco painted on a wall, ceiling panel, or dome would not lose copyright protection, for example, simply because it was designed to track the dimensions of the surface on which it was painted.”<sup>20</sup> This arguably lends credence to the notion that copyright protection can extend to functional elements so long as they can be fixed in some other tangible medium.

## II. *STAR ATHLETICA'S* DESIGN PATENT DICTA

Of possibly greater concern, Justice Breyer's dissenting opinion confuses the intellectual property landscape by suggesting, erroneously, that when design is inseparable from a useful article, “the designer may be able to obtain

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16 *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017). (prefacing the Court's analysis by emphasizing that “[t]his is not a free-ranging search for the best copyright policy, but rather ‘depends solely on statutory interpretation.’ ‘The controlling principle in this case is the basic and unexceptional rule that courts must give effect to the clear meaning of statutes as written.’” (citations omitted)).

17 A case like *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987), involving the now ubiquitous ribbon bicycle rack, would have presented a far better vehicle for addressing whether pictorial, graphic, or sculptural features of a useful article “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article” than a case involving print designs for cheerleader uniforms. 17 U.S.C. § 101 (definition of “pictorial, graphic, and sculptural works”).

18 *Star Athletica*, 137 S. Ct. at 1010.

19 *Id.* at 1012.

20 *Id.* This statement leaves open the possibility that functional considerations could come into play through some other doctrine. *See, e.g.*, 17 U.S.C. § 102(b) (excluding several categories from copyright protection). Nonetheless, the majority's unwillingness to discuss whether the slimming appearance of some cheerleader uniform designs is functional — *see* Brief of Professors Christopher Buccafusco and Jeanne Fromer as Amici Curiae in Support of Petitioner at 7-35, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866), 2016 WL 3971299— suggests that the Court is open to monopolization of functional elements of clothing design under copyright law.

15 years of protection through a design patent.”<sup>21</sup> The apparent source of this dicta is surprising. In an effort to distinguish the subject matter of copyright and design patents, Star Athletica and several of the amici mischaracterize design patents as extending to functional features of useful articles. In several instances, the amici gloss over the differences between design and utility patents. Oblique references to industrial design as the intersection of form and function—a distinct design movement far post-dating the advent of design patent protection—further muddy the waters. Justice Breyer’s dissenting opinion takes these suggestions at face value.<sup>22</sup>

Professors Christopher Buccafusco and Jeanne Fromer argue that “[f]unctionality is more properly channeled to the design or utility patent systems.”<sup>23</sup> They support this conclusion by pointing to *Baker v. Selden*,<sup>24</sup> but they neglect to explain that this landmark decision focused on the delineation of *utility patent* subject matter from that of other intellectual property regimes. The “high inventive threshold and careful examination of the patent system”<sup>25</sup> invoked as a rationale for the Supreme Court’s *Baker v. Selden* decision undoubtedly referred to utility patent examination, not design patent examination. Unlike utility patent applications, design patent drawings<sup>26</sup> are not evaluated for novelty and

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<sup>21</sup> *Star Athletica*, 137 S. Ct. at 1034 (Breyer, J., dissenting) (citing 35 U.S.C. §§ 171, 173 and Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 STAN. TECH. L. REV. 1, 48-51 (2013)). Note that Professors McKenna and Strandburg do not claim in their article that design patent protection as currently interpreted covers functional features. *Id.* Rather, they advocate that such protection would promote “integration of form and function.” *Id.* As we contend in Part III, such a shift in design patent protection would be harmful to competition and innovation.

<sup>22</sup> See *Star Athletica*, 137 S. Ct. at 1034 (Breyer, J., dissenting) (“Where [form and function] are one, the designer may be able to obtain 15 years of protection through a design patent”). The majority likewise accepts a dubious parallel between design patents and other “industrial design statutes” such as sui generis copyright protection for semiconductor chips and vessel hulls, which include no ornamentality limitation. *Id.* at 1015. 17 U.S.C. §§ 901–914, 1301–1332 protect semiconductor chip and vessel hull designs specifically designed to prevent piracy of functional features. See *Electronic Piracy Hull Design Protection: Hearing Before the Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary*, 105th Cong. 1 (1997), 1997 WL 664843 (statement of Marybeth Peters, Register of Copyrights) (contending that “limiting protection to purely ornamental designs would so severely limit the coverage of the bill as to be self-defeating. Vessel hulls are not in themselves ornamental. It is our understanding that it is the overall design of the hull itself, not separate ornamental features that may appear in connection with the hull, for which protection is sought”).

<sup>23</sup> Brief of Professors Christopher Buccafusco and Jeanne Fromer, *supra* note 20, at 36. In its amicus brief supporting certiorari, Public Knowledge likewise erroneously contended that “patents (and particularly design patents) already protect utility.” Brief of Public Knowledge, the Royal Manticoran Navy, and the International Costumers Guild as Amici Curiae in Support of Petitioner at 6, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866), 2016 WL 492305.

<sup>24</sup> See Brief of Professors Christopher Buccafusco and Jeanne Fromer, *supra* note 20, at 3.

<sup>25</sup> *Id.*

<sup>26</sup> Design patent applications do not explain utilitarian advances of the claimed design. See U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE, § 1503.01, 37 C.F.R. 1.153(a) (“No description, other than a reference to the drawing, is ordinarily required.”).

nonobviousness of their *functionality*,<sup>27</sup> but for the *originality* of their *ornamental* design.<sup>28</sup> Whereas the subject matter of a utility patent is how the article works or is used, the subject matter of a design patent relates to how the article looks—the overall ornamental “appearance of an article of manufacture.”<sup>29</sup> Furthermore, as Judge Rich candidly observed, deciding obviousness in design patent cases is an “impossible” task.<sup>30</sup> Moreover, in the pages from *Baker v. Selden* immediately following the language cited by Professors Buccafusco and Fromer, the Supreme Court characterized “ornamental designs” and “the lines of the poet” alike as subject matter where “form [rather than function] is their essence.”<sup>31</sup> To suggest that “dual-nature elements of useful articles [may be protected] through the design *or* utility patent regimes”<sup>32</sup> mischaracterizes *Baker v. Selden*, which allows protection for functional innovations only insofar as they meet the strict requirements of *utility* patent system.

Other amicus briefs, including that of Professors Mark McKenna, Mark Lemley, Christopher Sprigman, and Rebecca Tushnet, further confuse the issue by arguing that the line between copyright and design patent subject matter is defined by the distinction between applied art and industrial design, with the latter category encompassing the unity of form and function.<sup>33</sup> Whether or not “modern designers think of what they do in terms of the integration of form and function”<sup>34</sup> is entirely extraneous to the question of what ornamental designs may be covered by design patents. These briefs nonetheless suggest that the mid-twentieth century formalization of the emerging field of industrial design defines the boundaries of the design patent regime formed more than a century ago. Citing modern conceptions of the industrial design field to distinguish design patents from copyrights

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<sup>27</sup> See 35 U.S.C. §§ 102–103.

<sup>28</sup> See 35 U.S.C. § 171.

<sup>29</sup> See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

<sup>30</sup> *In re Nalbandian*, 661 F.2d 1214, 1219 (C.C.P.A. 1981) (Rich, J., concurring).

<sup>31</sup> *Baker v. Selden*, 101 U.S. 99, 103–04 (1879).

<sup>32</sup> Brief of Professors Buccafusco and Fromer, *supra* note 20, at 32 (emphasis added).

<sup>33</sup> See Brief Amicus Curiae on Behalf of Intellectual Property Professors in Support of Petitioner at 4–6, *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15–866), 2016 WL 8118845 (“The new statutory language of the 1976 Act was intended ‘to draw as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design.’”); Brief of Public Knowledge, the International Costumers Guild, Shapeways, Inc., the Open Source Hardware Association, Formlabs Inc., Printrbot Inc., the Organization for Transformative Works, the American Library Association, the Association of Research Libraries, and the Association of College and Research Libraries as Amici Curiae in Support of Petitioner at 37–38, *Star Athletica, LLC v. Varsity brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15–866), 2016 WL 3965163 (same). Justice Breyer’s dissent specifically picked up Frank Lloyd Wright’s definition of industrial design, cited by the Brief on Behalf of Intellectual Property Professors, *supra*, at 22, as where “form and function are one.” *Star Athletica*, 137 S. Ct. at 1034 (Breyer, J., dissenting).

<sup>34</sup> Brief on Behalf of Intellectual Property Professors, *supra* note 33, at 22.

unjustifiably redefines the ornamentality limitation on design patent subject matter.<sup>35</sup> In fact, the core subject matter originally sought to be protected by design patents was material unambiguously covered by copyright today, including fabric prints and sculptural works.<sup>36</sup>

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35 The McKenna & Strandburg article, cited in Justice Breyer's dissent, argues for expanding design patent protection to cover the integration of form and function principally on the ground that otherwise design patent protection and copyright protection are redundant. It is disconcerting, therefore, to see the brief co-authored by Professor McKenna (and signed by seven professors, including Professor Strandburg) assert that "the union of form and function can readily be protected through the law of design patent, *as Congress intended.*" Brief Amicus Curiae on Behalf of Intellectual Property Professors, *supra* note 33, at 15 (citing McKenna & Strandburg, *supra* note 21, at 48-51 (emphasis added)). It is even more unsettling to see a Supreme Court opinion accepting this assertion at face value, apparently without cite-checking the source or design patent law. This is not the first time in recent memory that the Supreme Court has upended intellectual property law by relying on carelessly framed citations in an amicus brief. See Brief of Professors Jeffrey A. Lefstin & Peter S. Menell as Amici Curiae in Support of Petition for a Writ of Certiorari, *Sequenom, Inc. v. Ariosa Diagnostics, Inc.*, 4-14, No. 15-1182 (Apr. 20, 2016) (showing that the Supreme Court's drastic reinterpretation of the patent eligibility in *Mayo Collaborative Services v. Prometheus Laboratories* rests on a profound misreading of a nineteenth century case put forward in Brief of Nine Law Professors as Amici Curiae In Support Of Petitioners, *Mayo Collaborative Servs. v. Prometheus Labs., Inc.* (No. 10-1150) (citing 566 U.S. 66 (2012))).

36 In 1841, the Commissioner of Patents reported to Congress that:

The justice and expediency of securing the exclusive benefit of new and original designs for articles of manufacture, both in the fine and useful arts, to the authors and proprietors thereof, for a limited time are . . . presented for consideration.

Other nations have granted this privilege, and it has afforded mutual satisfaction alike to the public and to individual applicants. Many who visit the Patent Office learn with astonishment that no protection is given in this country to this class of persons. Competition among manufacturers for the latest patterns prompts to the highest effort to secure improvements, and calls out the inventive genius of our citizens. Such patterns are immediately pirated, at home and abroad. A pattern introduced at Lowell, for instance, with however great labor or cost, may be taken to England in 12 or 14 days, and copied and returned in 20 days more. If protection is given to designers, better patterns will, it is believed, be obtained, since the impossibility of concealment at present forbids all expense that can be avoided. It may well be asked if authors can so readily find protection in their labors, and inventors of the mechanical arts so easily secure a patent to reward their efforts, why should not discoverers of designs, the labor and expenditure of which may be far greater, have equal privileges afforded them?

The law, if extended, should embrace alike the protection of new and original designs for a manufacture of metal or other material, or any new and useful design for the printing of woollens, silk, cotton, or other fabric, or for a bust, statue, or bas-relief, or composition in alto or basso-relievo. All this could be effected by simply authorizing the Commissioner to issue patents for these objects, under the same limitations and on the same conditions as govern present action in other cases. The duration of the patent might be *seven* years, and the fee might be *one-half* of the present fee charged to citizens and foreigners, respectively.

Thomas B. Hudson, *A Brief History of the Development of Design Patent Protection in the United States*, 30 J. PAT. & TRADEMARK OFF. SOC'Y 380, 380-81 (1948) (quoting Commissioner of Patents Henry Leavitt Ellsworth, Report to the 27<sup>th</sup> Cong., 2d Sess. (1841)). Congress heeded this recommendation and passed design patent legislation in the following year that covered any new and original design for an article of manufacture. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-

### III. REINVIGORATING INTELLECTUAL PROPERTY'S FUNCTIONALITY DOCTRINES

It is disappointing, although not entirely surprising in view of the works at issue,<sup>37</sup> that *Star Athletica* did not forthrightly address the functionality elephant in the useful article room. More significantly, however, the Supreme Court unwittingly cast a cloud of uncertainty over the intellectual property system.

The utility patent system embodies Congress's determination of the appropriate bargain for when the public should afford an innovator protection for functional advancements—whether a process, machine, manufacture, or composition of matter.<sup>38</sup> “Articles of manufacture” and “useful articles” clearly fall within the scope of “manufacture.” Copyright protection, trademark protection, and design patent protection have been appropriately cabined by statute and jurisprudence so as to ensure that functional advances, which are critical to free market competition and cumulative creativity,<sup>39</sup> are not monopolized unless the inventor can meet the relatively higher thresholds (novelty, non-obviousness, and disclosure) of the utility patent system.<sup>40</sup> Furthermore, the relatively short duration of utility patent protection (twenty years from filing the application), compared to copyright protection

44 (1842). At that time, copyright protection did not extend to such works. Over time, however, the subject matter of copyright protection expanded to cover print and graphic designs on useful articles. The Act of July 8, 1870, defined copyrightable subject matter to include “statuary, and . . . models or designs intended to be perfected as works of the fine arts.” Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212. The 1909 Copyright Act provided that copyright protection could extend to all works of authorship. Act of March 4, 1909, ch. 320, § 4, 35 Stat. 1075, 1076. The Supreme Court confronted the overlap of design patent and copyright protection in *Mazer v. Stein* concluding that both regimes can cover pictorial, graphic, and sculptural elements of useful articles. 347 U.S. 201, 218-19 (1954).

This accretion of protection occurred without much attention to whether it made sense. That fact hardly justifies expanding the scope of design patent protection. It could just as well support eliminating it.

<sup>37</sup> See Ginsburg, *supra* note 2, at 1.

<sup>38</sup> See 35 U.S.C. § 101 (2012) (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146, 150-51 (1989) (noting that from the nation’s founding, “the federal patent laws have embodied a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy”; and that “[t]he federal patent system thus embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years”). Trade secrets can protect technological advances, but only against misappropriation by improper means or breach of a confidential relationship. Uniform Trade Secrets Act § 1(2), 14 U.L.A. 529 (1985). Unlike patents, they do not confer exclusive rights.

<sup>39</sup> See Peter S. Menell & Suzanne Scotchmer, *Intellectual Property Law*, in 2 HANDBOOK OF LAW AND ECONOMICS 1473, 1478-79, 1499-1500 (A. Mitchell Polinsky & Steven Shavell eds., 2007)(providing comparative overview of “patent, copyright, and trade secret law—the principal modes of intellectual property protection fostering innovation” and cumulative “creativity”).

<sup>40</sup> See *id.* at 1498, 1550 (discussing patent law’s “exacting validity requirements”).



(typically life of the author plus seventy years) and trademark protection (potentially perpetual), ensures that even patented technological advances are not controlled exclusively for an extremely long period of time.<sup>41</sup>

The functionality doctrines provide the logic governing the interplay of the intellectual property modes. These doctrines, manifest in statutory text,<sup>42</sup> legislative history,<sup>43</sup> and a rich body of jurisprudence,<sup>44</sup> ensure that competitors cannot gain unfair advantage in competitive markets by obtaining protection over technological advances through the backdoor of copyright, trademark, or design patent protection.<sup>45</sup>

In an effort to avoid redundancy among intellectual property modes, Professors McKenna and Strandburg advocate expanding the scope of design patent protection to encompass the shape of useful articles that integrate form and function.<sup>46</sup> A more appropriate starting point for this inquiry is to identify a good reason for departing from the core parsimonious economic principle undergirding U.S. intellectual property protection: that the state should only interfere with free competition when innovators would otherwise be unable to derive an adequate return from research and development.<sup>47</sup> It is far from clear that such works integrating form and function merit protection

41 Even 20 years of protection can be more than necessary for some inventions and fields of technology. See Menell & Scotchmer, *supra* note 39, at 1487-90 (discussing the “optimal duration of a patent or copyright”); Peter S. Menell, *Tailoring Legal Protection for Computer Software*, 39 STAN. L. REV. 1329, 1364-66 (1987) (discussing computer operating systems as an example of such a technology).

42 See 17 U.S.C. § 101 (2012) (definition of “pictorial, graphic, and sculptural works”); 17 U.S.C. § 102(b) (2012) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”); 35 U.S.C. § 171 (2012) (limiting design patent protection to ornamental works).

43 See *supra* note 9.

44 See, e.g., *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 28-35 (2001) (channeling between trade dress and utility patent protection); *Baker v. Selden*, 101 U.S. 99, 102-04 (1879) (channeling between copyright and utility patent protection); *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010) (holding that it was proper for the trial court to “factor[] out the functional aspects of [the claimed] design as part of its claim construction”); *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1566 (Fed. Cir. 1996) (explaining that “if the design claimed in a design patent is dictated solely by the function of the article of manufacture, the patent is invalid because the design is not ornamental”).

45 See Viva R. Moffat, *The Copyright/Patent Boundary*, 48 U. RICH. L. REV. 611, 620 & n.33 (2014) (asserting that the useful article doctrine is most obviously understood to police the patent/copyright boundary (quoting Robert P. Merges, Peter S. Menell, & Mark A. Lemley, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 491 (6<sup>th</sup> ed. 2012) (“Awarding protection for functional works through copyright law—with its low threshold for protection and much greater duration—would undermine the role of the patent system as the principal means for protecting utilitarian works and hinder the process of sequential innovation essential to technological progress. Does the useful article doctrine reflect a similar objective?”))).

46 See McKenna & Strandburg, *supra* note 21, at 48-51.

47 See Menell & Scotchmer, *supra* note 39, at 1476-78 (highlighting the focus on the optimal level of research and development and the virtues of competition).

for the functional elements beyond what is available under the utility patent regime and the relatively high requirements it imposes. In any case, the suggestion that Congress or the courts recognize such protection is misguided.

*Star Athletica's* suggestions that “approaching the [Copyright Act] with presumptive hostility toward protection for industrial design would undermine Congress’ choice,”<sup>48</sup> and that designers may be able to obtain design patent protection for functional features,<sup>49</sup> are fundamentally mistaken and send precisely the wrong message to lower courts dealing with copyright and design patent protection claims. The Supreme Court should have looked to the statutory basis for copyright and design patent protection, as well as clear legislative history and seminal cases—notably *Baker v. Selden*,<sup>50</sup> *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,<sup>51</sup> and *TrafFix Devices, Inc. v. Marketing Displays, Inc.*<sup>52</sup>—that wisely caution against affording protection to useful article features that come close to the functionality line outside the auspices of the utility patent system.

Such a prudent course best promotes robust competition and appropriate protection for expressive creativity and technological innovation.<sup>53</sup> The Supreme Court’s decisions in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*,<sup>54</sup> and *TrafFix Devices, Inc. v. Marketing Displays, Inc.*,<sup>55</sup> illustrate this constructive approach. In fashioning the threshold for trademark protection for trade dress, the Court in *Wal-Mart* reasoned that:

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48 *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1015 (2017). The majority’s superficial and selective textualism led the Court astray. The legislative history provided valuable insights into legislative intent regarding the separability inquiry. Such textualism has previously caused avoidable interpretive problems. See generally Peter S. Menell, *Forty Years of Wondering in the Wilderness and No Closer to the Promised Land: Bilski’s Superficial Textualism and the Missed Opportunity to Return Patent Law to its Technology Mooring*, 63 STAN. L. REV. 1289 (2011). See also Peter S. Menell, *The Mixed Heritage of Federal Intellectual Property Law and Ramifications for Statutory Interpretation*, in INTELLECTUAL PROPERTY AND THE COMMON LAW 63, 88 (Shyamkrishna Balganeshe ed., 2013) (arguing that courts should be especially careful to trace the provenance of copyright and patent provisions and doctrines to determine the proper interpretive lens in applying these laws).

49 See *Star Athletica*, 137 S. Ct. at 1034 (Breyer, J., dissenting).

50 101 U.S. 99 (1879) (arguing that the copyright protection for a book explaining a system or an art extends only to the author’s unique expression of it).

51 489 U.S. 141, 146 (1989) (observing that Art. I, § 8, cl. 8 of the U.S. Constitution “reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition without any concomitant advance in the ‘Progress of Science and useful Arts’”).

52 532 U.S. 23 (2001); see also *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) (discussing copyright merger doctrine, under which copyright protection cannot subsist when there is only one or a few ways of expressing an idea).

53 Cf. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (warning that allowing a cause of action under § 43(a) for reverse passing off “would create a species of mutant copyright law that limits the public’s ‘federal right to ‘copy and to use,’ expired copyrights” (quoting *Bonito Boats*, 489 U.S. at 165)).

54 529 U.S. 205 (2000).

55 532 U.S. 23 (2001).

The fact that product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematic; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests. Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness.<sup>56</sup>

Based on these considerations, the Court held that when it is difficult to draw lines between product-design—which is more likely to interfere with product competition—and product-packaging trade dress, courts “should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning” and making it more difficult to exclude competitors.<sup>57</sup> In *TrafFix Devices*, the Court imposed a heavy burden on the claimant for proving non-functionality of the asserted trade dress.<sup>58</sup> The same logic should apply to other intellectual property regimes that do not require examination for the novelty and nonobviousness of functional features.

To avoid undermining the structural foundation of the intellectual property system, lower courts should disregard the unsubstantiated dicta in *Star Athletica* and instead look to statutory requirements and limitations, legislative guidance, and the foundational principles undergirding the intellectual property system to assess copyright or design patent protection for useful articles integrating form and function. According copyright or design patent protection for functional features would indeed create “mutant species” of intellectual property law<sup>59</sup> that contravene existing law and sound policy. Such creatures can only be created through legislative action.

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<sup>56</sup> 529 U.S. at 213.

<sup>57</sup> *Id.* at 215.

<sup>58</sup> See *TrafFix Devices*, 532 U.S. at 30 (“Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.”).

<sup>59</sup> *Cf. supra* note 53.