ESSAY

FORGETTING FUNCTIONALITY

CHRISTOPHER BUCCAFUSCO† & JEANNE C. FROMER††

In *Star Athletica, LLC v. Varsity Brands, Inc.*,[1] the U.S. Supreme Court had an opportunity to clarify copyright law's treatment of product designs that incorporate functionality. Its opinion failed to do so in a host of different ways. In this Essay, we address just one of the opinion's shortcomings: its failure to adequately define and distinguish between a design's functional and expressive features. Not only does the Court's neglect produce uncertainty for creators, litigants, and judges, the opinion makes it substantially easier for copyright claimants to obtain protection for utilitarian aspects of designs, contrary to copyright statute and policy.

The case involved the application of copyright law's "useful article" doctrine, which applies to certain "pictorial, graphic, and sculptural works".[2] The plaintiff, Varsity Brands, claimed copyrights in various designs of stripes, chevrons, and color-blocking that were incorporated into its cheerleading uniforms.[3] Because the uniforms have an "intrinsic utilitarian function,"[4] copyright law treats their designs as "useful articles" and subjects them to an additional hurdle to establish valid rights. By statute, the design of a useful article is copyrightable "only if, and only to the extent that, such design incorporates pictorial, graphic, or

† Professor of Law, Director of the Intellectual Property and Information Law Program, Benjamin N. Cardozo School of Law, Yeshiva University.

†† Professor of Law, New York University School of Law; Co-Director, Engelberg Center on Innovation Law & Policy. Jeanne Fromer gratefully acknowledges support from the Filomen D'Agostino and Max E. Greenberg Research Fund.

1 137 S. Ct. 1002 (2017).

2 17 U.S.C. § 101 (2012).

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

4 *Id.* at 1009 (quoting 17 U.S.C. § 101).

sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."[5]

The useful articles doctrine thus imposes separability criteria on intrinsically functional designs. It asks whether the work exhibits any "pictorial, graphic, or sculptural features" that are separate from its "utilitarian aspects." Clearly, this is an exercise in sorting.[6] The statute distinguishes between two classes of design components, and it asks the decisionmaker to decide whether the claimed work demonstrates one set of components (pictorial, graphic, or sculptural features, or, more generally, "expressive" features) that can be identified separately from and exist independently of another set of components (utilitarian aspects).[7]

Most prior appellate court opinions on the useful articles doctrine recognized the nature of this sorting.[8] The first task for a court is to analyze the claimed design and to sort its components into the correct doctrinal bucket. The second task then requires the court to determine whether any of the components in the first bucket are separable from those in the second bucket.

This is how both the majority and dissent in *Varsity Brands, Inc. v. Star Athletica, LLC* at the U.S. Court of Appeals for the Sixth Circuit understood the doctrine. Their disagreement was over which components should go in the two buckets. According to the majority opinion, the only utilitarian aspects of the uniforms' designs were those that contributed to wearability, warmth, and modesty.[9] Because the stripes, chevrons, and color-blocking did not affect these aspects of the uniform, they were expressive features and could be separated from the uniforms' functional aspects.[10] To the dissent, however, the stripes, chevrons,

---

5 17 U.S.C. § 101.

6 *See* Christopher Buccafusco & Jeanne C. Fromer, *Fashion's Function in Intellectual Property Law*, 93 NOTRE DAME L. REV. (forthcoming 2017) (concluding, after analyzing copyright statute and policy, that copyright law requires a separate delineation of a design's "pictorial, graphic, or sculptural features" and "utilitarian aspects" to decide whether a design feature is only expressive, only utilitarian, or both expressive and utilitarian (or dual-nature)).

7 *Id.*

8 *See, e.g.*, Pivot Point Int'l, Inc. v. Charlene Prods., Inc., 372 F.3d 913, 932 (7th Cir. 2004) (Kanne, J. dissenting) ("[T]he statute requires, on its face, that sculptural features must be separately identified from the utilitarian aspects of the article."); Brandir Int'l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987) (separating the components, but asking "whether the aesthetic design elements are significantly influenced by functional considerations"); Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 992 (2d Cir. 1980) ("The 1976 copyright statute does not provide for the copyrighting of useful articles except to the extent that their designs incorporate artistic features that can be identified separately from the functional elements of the articles.").

9 Varsity Brands, Inc. v. Star Athletica, LLC, 799 F.3d 468, 492 (6th Cir. 2015) (noting that "the utilitarian aspects of clothing" include "to cover, protect, and warm the body").

10 *See id.* at 493 ("Because we believe that the graphic features of Varsity's cheerleading-uniform designs are more like fabric design than dress design, we hold that they are protectable subject matter under the Copyright Act.").

and color-blocking actually contributed to the uniforms' functionality.[11] These aspects of the designs functioned to identify the wearers as cheerleaders.[12] In addition, the dissent argued that they served a "decorative function," relying on a series of cases from the Second Circuit that had blocked copyright protection for external features of garment design that enhanced the wearer's attractiveness.[13]

This sorting issue was squarely before the Supreme Court, because it should have had to address it as a statutory prerequisite to the separability question. First, then, the Court should have determined which components of the uniforms designs copyright law treats as pictorial, graphic, or sculptural features, and which it treats as utilitarian aspects. Justice Thomas's opinion for the majority seems to conclude that the prerequisite issue is, in fact, a very simple one. He first asks whether the decisionmaker can "spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities."[14] He describes this requirement as "not onerous,"[15] and his application of the test to the uniforms demonstrates as much. He explains: "[O]ne can identify the decorations as features having pictorial, graphic, or sculptural qualities."[16] That's it. That is his full analysis of this point.

Not onerous, indeed. According to the majority, an element of a design counts as a pictorial, graphic, or sculptural feature if it looks like something. Considering that this is the area of copyright law that applies to pictorial, graphic, and sculptural works, it is impossible that the claimed works would not have some such features.

Next, Justice Thomas's opinion asks whether the identified pictorial, graphic, or sculptural feature can exist apart from the utilitarian aspects of the article.[17] He explains that the feature "must be able to exist as its own pictorial, graphic, or sculptural work . . . once it is imagined apart from the useful article."[18] Finally, he notes that "[i]f 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."[19]

We admit to being deeply flummoxed as to what this last sentence means. Nonetheless, we will attempt to parse the test the majority imposes. Given that the work contains some pictorial, graphic, or sculptural qualities that

---

11 *See Varsity Brands*, 799 F.3d at 494-97 (McKeague, J., dissenting).

12 *See id.* at 495 ("[T]he designers' aesthetic considerations merged with functional concerns: . . . to identify the wearer as a member of a particular cheerleading squad.").

13 *Id.* (quoting Jovani Fashion, Ltd. v. Fiesta Fashions, 500 Fed. Appx. 42, 44 (2d Cir. 2012)).

14 Star Athletica LLC v. Varsity Brands, Inc., 137 S. Ct. 1002, 1010 (2017).

15 *Id.*

16 *Id.* at 1012.

17 *Id.* at 1010.

18 *Id.*

19 *Id.*

were spotted in the first step, the second step of the analysis asks whether they could be fixed in some form other than the useful article itself. In effect, the majority's test for separability amounts to: Could you draw it on a sheet of paper?[20] Here, because the designs for the uniforms could have been, and actually were, reproduced on other (presumably non-useful) media, they were separable from the useful article and, thus, copyrightable.[21]

There are a number of problems with the Court's approach to separability. We address two of these problems here, both involving the Court's absolute neglect of the critical issue of functionality.

USEFUL WHAT?

First, the Court is confused about the nature of the separation that is supposed to take place. In its interpretation of the "ordinary, contemporary, common meaning"[22] of the statute, the Court asks whether the spotted pictorial, graphic, or sculptural features can be "imagined apart from the useful article."[23] But this is not what the statute says. The law asks whether the work's pictorial, graphic, or sculptural features can be separated from "the utilitarian aspects of the article."[24] The difference may seem slight, but it is far from trivial.

The Court's misreading of the statute rendered the test substantially easier for plaintiffs to pass. Rather than distinguish between and separate the uniform design's pictorial, graphic, or sculptural features from its utilitarian aspects, the Court only asked whether the pictorial, graphic, or sculptural features were distinct and separate from the uniform itself. This mistake allowed Varsity Brands to claim the stripes, chevrons, and color-blocking because, once they were imaginatively removed from the uniform, a uniform could still exist. That is a different exercise from asking whether the uniform's pictorial, graphic, or sculptural features could be separated from its utilitarian aspects.

Had the Court read the statute plainly, as it purported to do, it would have had to determine which components of the design it should treat as utilitarian

---

20 More generously, the Court may be asking if you could draw it on a sheet of paper and it would look not entirely like the useful article as such, whatever that would be. For example, if you drew the pictorial, graphic, and sculptural features of a shovel on a piece of paper, it would simply look identical to the shovel.

21 *See id.* at 1012 ("[I]f 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 . . . . Indeed, respondents have applied the designs in this case to other media of expression—different types of clothing—without replicating the uniform." (internal marks and citation omitted)).

22 *Id.* at 1010 ("We thus begin and end our inquiry with the text, giving each word its 'ordinary, contemporary, common meaning.'" (quoting Walters v. Metro. Educ. Enters., Inc., 519 U.S. 202, 207 (1997))).

23 *Id.*

24 17 U.S.C. § 101 (2012).

aspects and which it should treat as pictorial, graphic, or sculptural features, something it never considered under the test it conceived. As the majority and dissenting opinions at the Sixth Circuit had, the Supreme Court's opinion would have had to take a stand on which components of the design should be treated as pictorial, graphic, or sculptural features and which as utilitarian aspects. We do not know what the Court would have done, though its opinion mentions the argument that we raised in our amicus brief and in a separate law review article that components of a design that "enhanc[e] the wearer's physical appearance" are functional.[25] Ultimately, the Court gave designers, litigants, and lower courts no guidance on which components of designs to treat as utilitarian aspects.[26]

Strikingly, the Court that expressly committed itself to rule "solely [based on] statutory interpretation" and to "look to the provisions of the whole law to determine [the statute's] meaning,"[27] nonetheless failed to discuss or rely on the copyright statute's definition in § 101 of a "useful article." The statutory definition provides the most pertinent explanation of what the Act considers to be a utilitarian aspect, as contrasted with a pictorial, graphic, or sculptural feature: something is utilitarian in this context when it exists "not merely to portray the appearance of the article or to convey information."[28] This statutory provision suggests that "utilitarian" should be given a broad interpretation and incorporate any aspects of a design that do more than *merely* portray appearances or convey information.[29] Only when components of an article are purely expressive should they be treated as pictorial, graphic, or sculptural features rather than utilitarian aspects. We think this statutory provision plainly manifests Congress's desire to limit copyright protection in useful articles, channeling possible protection of their large set of utilitarian features to patent law instead.[30]

Furthermore, the Court's misreading of the copyright statute lowers copyright's functionality bar, because it allows designers to claim protection for design components that are simultaneously functional and expressive. We have referred to these components as "dual-nature" components, and Congress adopted the useful articles doctrine precisely to avoid protecting them through

---

25 *Star Athletica*, 137 S. Ct. at 1013. *See generally* Buccafusco & Fromer, *supra* note 6.

26 Reading the Court's opinion charitably, perhaps the Court silently and implicitly decided that the useful article was a cheerleading uniform, rather than a cheerleading uniform that flatters and accentuates the wearer's shape. On the former understanding, one might be able to equate separation of the pictorial, graphic, or sculptural features from the useful article as a whole to the correct statutory reading. That all said, we assume the Court probably did not intend such an understanding, because it likely would have felt compelled to articulate this analysis expressly.

27 *Star Athletica*, 137 S. Ct. at 1010 (internal marks omitted).

28 17 U.S.C. § 101 (2012).

29 Buccafusco & Fromer, *supra* note 6, at Sections II.B–C.

30 *Id.* at Sections II.A (setting out Congress's manifest intent to carve separate spheres for copyright and patent law, in particular for useful articles' utilitarian features).

copyright law.[31] Because the Court was concerned only with separating pictorial, graphic, or sculptural features from the useful article and not from its utilitarian aspects, the Court determined that such features were separable even though imaginatively removing them impaired the article's functionality. As we argue elsewhere, this conclusion makes no sense in light of the statute.[32] The Copyright Act explains that copyright protection for a useful article extends only "to the extent" of the separable expressive, yet also non-functional, features of the design.[33] Thus, while the separable expressive features may receive protection, copyright should never cover the utilitarian aspects of the design.[34] As a matter of logic, the Copyright Act cannot both protect the expressive features of the uniforms and preserve from protection their functional aspects when those expressive features and functional aspects are one and the same.[35]

FIXATION AND FUNCTIONALITY

The second perplexing and troublesome component of the Court's treatment of copyright separability is its "Can you draw it?" test. The intuitions behind Justice Thomas's approach make some sense. The designs at issue were first fixed in or on cheerleading uniforms. If, instead, they had first been fixed on canvas or paper, they would be presumptively copyrightable—if original—because Justice Thomas assumes that they would not, then, be functional. This approach treats the designs equivalently, regardless of their (arbitrary) initial fixation. If they could be fixed non-usefully on paper or canvas, then the mere fact that they were first fixed on or in useful articles should be irrelevant.

These intuitions, however, rapidly disintegrate upon inspection. Consider first the notion that fixing the designs on paper would make them non-useful. While it seems like a drawing of a pair of shoes is not useful in the way that a pair of shoes is,[36] to use an example from Justice Breyer's dissent,[37] this isn't necessarily true for all drawings. In fact, the majority opinion had already rejected the claim put forward by Varsity Brands and by Justice Ginsburg's

---

31 *Id.* at Section II.B (quoting 17 U.S.C. § 101).

32 *Id.* at Sections II.B-C.

33 *Id.* at Sections II.B-C (quoting 17 U.S.C. § 101).

34 These will always remain free to copy unless protected by another intellectual property regime, such as patent law. *See id.* at Section II.A; Christopher Buccafusco & Mark A. Lemley, *Functionality Screens*, 103 VA. L. REV. (forthcoming 2017).

35 Buccafusco & Fromer, *supra* note 6, at Sections II.B–C.

36 *But see* CROCKETT JOHNSON, HAROLD AND THE PURPLE CRAYON (1955) (telling the story of a young boy equipped with a crayon who is able to create functional objects, like a boat and buildings, just by drawing them).

37 Star Athletica LLC v. Varsity Brands, Inc., 137 S. Ct. 1002, 1032-33 (2017) (Breyer, J., dissenting). A Van Gogh painting of shoes like the one to which Justice Breyer refers can be found at, Vincent Van Gogh, *Shoes*, MET, http://www.metmuseum.org/art/collection/search/436533 [https://perma.cc/H8SS-BZVZ].

concurring opinion that two-dimensional works are inherently separable because they are always non-useful.[38] The Copyright Act clearly anticipates that both two- and three-dimensional works can be useful articles. Justice Thomas's majority opinion even said as much.[39] Indeed, as we argue elsewhere, a camouflage pattern, for example, has an intrinsic utilitarian function even though it is reproduced in only two dimensions.[40] Thus, the Court's use of two-dimensional reproduction as a proxy for the separability of non-useful features makes little sense.

Furthermore, the Court's attempt to treat functionality as indifferent to the medium of fixation fails to provide consistently satisfactory results. Whether a design feature is functional may, in fact, turn on the medium of its fixation, but not in the way the Court thinks it does. Van Gogh's painting of a pair of shoes is not functional and is not a useful article in the way that an actual pair of shoes would be. But, as we have shown, just because something is fixed in two dimensions rather than three does not necessarily mean that it isn't functional. In fact, just because something is fixed in three dimensions doesn't mean that it is functional. The design for an airplane as fixed in life-sized flyable steel and fiberglass is unprotectable by copyright law, but the same design for a toy airplane *is* protectable and may not even be treated as a useful article.[41] Similarly, the design for a baseball bat, fixed in a thirty-four-inch piece of ash, has very different functionality from the same design fixed in a six-inch piece of foam or 101 feet of metal.[42]

Consider, now, the stripes, chevrons, and color-blocking in Varsity Brands' designs. To the Court, the fact that the designs could be—and had been—applied to objects other than cheerleading uniforms is strong evidence that they would "qualify as 'two-dimensional . . . works of . . . art.'"[43] Because these features could be reproduced on canvas or on a lunchbox, they must not have contributed to the uniforms' functionality. As our analysis shows, however, this is not necessarily true. Sometimes reproducing the same design in different media fundamentally alters its utility. The arrangement of shapes and colors in Varsity Brands' designs may continue to have the same direct visual appeal whether reproduced on

38 *Star Athletica*, 137 S. Ct. at 1009.

39 *See id.* ("The statute thus provides that the 'design of a useful article' can include two-dimensional 'pictorial' and 'graphic' features, and separability analysis applies to those features just as it does to three-dimensional 'sculptural' features.").

40 Buccafusco & Fromer, *supra* note 6, at Section II.C.

41 Gay Toys, Inc. v. Buddy L Corp., 703 F.2d 970, 973 (6th Cir. 1983) ("Other than the portrayal of a real airplane, a toy airplane, like a painting, has no intrinsic utilitarian function.").

42 *See generally* Seth S. King, *A Giant Baseball Bat Sculpture Dedicated in Chicago Ceremony*, N.Y. TIMES, Apr. 15, 1977, http://www.nytimes.com/1977/04/15/archives/a-giant-baseball-bat-sculpture-dedicated-in-chicago-ceremony.html [https://nyti.ms/1XW3OPQ] (describing the 101-foot-high baseball bat sculpture erected in Chicago).

43 *Star Athletica*, 137 S. Ct. at 1012 (ellipses in original).

cheerleading uniforms, sweaters, or posters. But they are likely to function differently in each of these cases. The precise arrangement of shapes and colors in particular locations on the uniforms affects the way the wearer is perceived.[44] The same effect would not happen when the shapes and colors are printed on a poster and hung on a wall. As in the airplane example, so too here the designer might be able to obtain a valid copyright in the nonfunctional poster, but that copyright would not extend to the use of the design in a functional way on uniforms or other garments.

Ultimately, the medium in which design features are fixed affects their functionality and thus their copyrightability. A court should not conclude that just because a design is non-functional in one medium it is necessarily non-functional in all media. Instead, the court should examine the use of the design in the claimed medium and decide whether or not it is functional. Copyright protection should extend only to reproductions of the design in media where it does not have a function.[45] The Supreme Court never grappled with this issue, and its failure to do so produced an erroneous outcome.

The Supreme Court did not address the essential issues of functionality in *Star Athletica*, impairing its statutory analysis and ultimately its decision. We hope future courts consider this failure to construe copyright law's treatment of functionality as leaving open questions that they can address to complete and correct the Supreme Court's analysis.

Preferred Citation: Christopher Buccafusco & Jeanne C. Fromer, *Forgetting Functionality*, 166 U. PA. L. REV. ONLINE 119 (2017), http://www.pennlawreview.com/online/166-U-Pa-L-Rev-Online-119.pdf.

---

44 Buccafusco & Fromer, *supra* note 6, at Part III.

45 *See* 17 U.S.C. §§ 113(a)–(b) (2012).