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The New Separability

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The New Separability

Lili Levi*

ABSTRACT

In Star Athletica v. Varsity Brands, the Supreme Court recently unveiled a new approach to separability. Because copyright law protects expression, not function, aesthetic features of useful articles are eligible for copyright protection only if they are separable from the functional work in which they are incorporated. But the Copyright Act does not define separability, and Star Athletica is the latest judicial effort to try to fill that void. Unfortunately, the new separability is open to a wide range of critiques. Relatively low-hanging fruit are the vagueness and indeterminacy of the new test, the Court's unsatisfactory attempts to avoid defining "function," the threat of overprotection resulting from the opportunistic litigation the Court invites, and the uncertainty regarding the deterrent effects on overprotection of copyright's other limiting doctrines.

But there is a deeper, less visible problem as well. By focusing only on the protectability of the particular designs at issue in an infringement case, neither Star Athletica's new separability test nor copyright's other limiting doctrines address the elephant in the room: the possible market impact of an aggregation of copyright registrations of design features with slight variations. Varsity Brands registered two hundred copyrights in variations of its similar uniform designs. Should this be considered a problem in its market? A strategy of covering the design field can have powerful foreclosure effects on markets for useful works, particularly in markets featuring standardization and high switching costs. Thus, perhaps the most significant threat today to what Congress sought to protect by adopting the separability requirement lies not in the individual copyright registration for an aesthetic design or the individual infringement suit

* Professor of Law, University of Miami School of Law. I am grateful to Jon Baumgarten, Jodi Rush, Andres Sawicki, Steve Schnably, and Ralph Shalom for illuminating conversations about *Star Athletica* and comments on prior drafts. Aspects of this argument were presented at the Intellectual Property Scholars Conference in August 2017, and I thank those conference participants who commented in response. Samantha Finkel deserves gratitude for able research assistance at the last minute. All remaining errors are my own.

but in the business strategy of copyright aggregation for aesthetic elements of functional works in some types of markets.

*A saving grace of the vagueness and indeterminacy of the Court's new approach to separability is that it punted the question of artistic functionality to lower courts. They can apply downstream copyright doctrines—originality, exclusion doctrines (such as merger doctrine, scenes à faire, and the prohibition on copyright for processes, systems, and methods of operation), and infringement analysis—in ways that limit the potential overreach of the Court's new take on the useful articles doctrine in individual cases. But the problem is that such limiting readings ignore the broader-frame issue of aggregative registration strategies. Instead of opting for illusory simplicity, the Court could have gone further to resolve the difficult problem of functionally integrated expression had it defined function through the lens of aggregate anticompetitive effects and developed a workable theory of copyright abuse. While it did not do so, however, its new separability doctrine does not preclude lower courts from addressing those issues with a view to Copyright Act goals of protecting communicative expression, channeling creative works to the right intellectual property domains, and promoting competition in functional works markets. Doing so could lead lower courts to expand the kinds of function deemed to make aesthetic features inseparable for useful articles cases—thereby ensuring a more realistic conception of function. Thus, pursuant to the middle-ground approach recommended here, pictorial, graphic, or sculptural elements with objectively definable perceptual and neurological impacts when integrated into useful articles could be considered analytically inseparable because of those impacts. By contrast, a presumption of separability could attach to more subjective and culturally grounded types of function. In turn, concerns about anticompetitive effects of aggregative copyright registration practices could be addressed by the development of a workable copyright abuse defense to deter such practices where called for. Courts engaging in this interpretation of the new separability could well blunt the most worrisome consequences of the Supreme Court's approach in *Star Athletica*.*

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I. INTRODUCTION

Many useful articles constitute beautiful examples of industrial design, but Congress's intent in enacting the Copyright Act of 1976 (the "Copyright Act")¹ was to ensure that copyright would not protect those articles' utility. At the same time, Congress did not wish to exclude pictorial, graphic, or sculptural (PGS) works otherwise meriting copyright protection simply because the works were incorporated into functional articles. Thus, the statute adopted a compromise position: allowing PGS features of useful articles to be eligible for copyright protection if and to the extent they are separable from the utilitarian functions of the articles.² Congress stated its intention to hinge protection on the distinction between copyrightable applied art and uncopyrightable industrial design.³ Judicial attempts to draw that line, however, led to a multiplicity of often-inconsistent and widely criticized separability tests.⁴ With upwards of ten conceptual separability tests deployed singly or in combination by different circuits⁵ after the Court's iconic decision granting protection to dancer statuettes used as lamps in *Mazer v. Stein* in 1954,⁶ courts effectively "twisted themselves into knots"⁷ in trying to draw the line between uncopyrightable industrial design and protectable applied art.

Enter the Supreme Court's recent decision in *Star Athletica v. Varsity Brands*,⁸ which sought to "resolve widespread disagreement"⁹ over separability by unveiling a new approach that explicitly rejected several important lines of precedent. In the context of cheerleading

1. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified as amended in scattered sections of 17 U.S.C.)

2. 17 U.S.C. § 101 (2012).

3. See H.R. REP. NO. 94-1476, at 55 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5668.

4. See, e.g., Jane C. Ginsburg, "Courts Have Twisted Themselves into Knots": U.S. Copyright Protection for Applied Art, 40 COLUM. J.L. & ARTS 1, 2 (2016); Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y U.S.A. 339, 340-41 (1990).

5. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484-85, 487 (6th Cir. 2015) (identifying nine prior tests and adding a tenth), *aff'd*, 137 S. Ct. 1002 (2017); see also Shubha Ghosh, *Remapping Copyright Functionality: The Quixotic Search for a Unified Test for Severability for PGS Works*, 39 EUR. INTEL. PROP. REV. 90, 97 (2017); Ginsburg, *supra* note 4, at 18; Sepehr Shahshahani, *The Design of Useful Article Exclusion: A Way Out of the Mess*, 57 J. COPYRIGHT SOC'Y U.S.A. 859, 871-72 (2010) (describing 11 tests).

6. *Mazer v. Stein*, 347 U.S. 201, 202, 217 (1954).

7. See *Varsity Brands*, 799 F.3d at 478 (quoting *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (9th Cir. 2014)).

8. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

9. *Id.*

uniform designs that featured optical illusions to make their wearers look thin and athletic, the Court offered a two-step test, holding that

a feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (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 its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.¹⁰

A desire for consistency in legal doctrine is understandable, as is the intuition that work otherwise fully eligible for copyright protection should not be punished simply because of its incorporation into a useful article—especially as one of the rights granted to a copyright owner by statute is the right to reproduce her work in any medium whatsoever.¹¹ Contrary to its goal, however, *Star Athletica* has not eliminated the complexity entailed by hybrid, artistically functional works. In addition to the elusiveness of the case in its own context,¹² the vagueness and indeterminacy of the new separability inquiry are self-evident. This is particularly problematic because of the Court's decision to reject the major pre-*Star Athletica* benchmarks, leaving no other jurisprudential tools available to subsequent courts.

Although it need not be read this way, the *Star Athletica* approach will likely lead to extensive overprotection of useful works through strategic deployment of copyright in incorporated expressive designs.¹³ Indeed, the one certainty is that the case will invite opportunistic litigation attempting to expand copyright protection for fashion and other contexts of attractive design. For example, many in

10. *Id.*

11. 17 U.S.C. § 113(a) (2012) (“[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.”).

12. Even in its own context, *Star Athletica* is an elusive decision. Depending on how one frames it, the Court's new standard can reasonably be read in three different ways—as a narrow and unexceptionable case that comes out the way it would have under application of traditional doctrine regarding copyrightability of fabric designs, see Ginsburg, *supra* note 4, at 21–24 and sources cited therein; as a significant but generally beneficial alternative to separability's doctrinal “mess,” see Shahshahani, *supra* note 5, at 871; or as a major shift inviting extensive overprotection of functional works in ways contrary to the overall structure of the intellectual property (IP) regime. See, e.g., Christopher Buccafusco & Jeanne C. Fromer, *Forgetting Functionality*, 166 U. PA. L. REV. ONLINE 119, 119 (2017) [hereinafter Buccafusco & Fromer, *Forgetting Functionality*]; Christopher Buccafusco & Mark A. Lemley, *Functionality Screens*, 103 VA. L. REV. 1293, 1296–97 (2017) (identifying filtering, exclusion, and threshold functionality screens used in IP doctrines); see also Christopher Buccafusco & Jeanne C. Fromer, *Fashion's Function in Intellectual Property Law*, 93 NOTRE DAME L. REV. 51, 53 (2017) [hereinafter Buccafusco & Fromer, *Fashion's Function*].

13. See, e.g., Buccafusco & Lemley, *supra* note 12, at 1360.

the traditional fashion industry see the Court's approach as an invitation to significantly expanded copyright protection for apparel.¹⁴ They have already taken to the courts in order to cripple the multimillion-dollar knockoff design industry.¹⁵ Whatever the outcome of particular litigation, the lack of clarity in the standard will undoubtedly lead to chilling effects and de facto overprotection. The recent dismissal of the *Star Athletica* case on remand as a result of a settlement agreement between Varsity Brands and Star Athletica's insurance company—*over Star Athletica's own objections*—is itself an object lesson in that regard.¹⁶

Admittedly, a finding of separability does not necessarily lead to copyright protection, and the *Star Athletica* Court explicitly stated that it did not hold the Varsity Brands designs copyrightable.¹⁷ Mentioning that it “express[ed] no opinion on whether these works are sufficiently original to qualify for copyright protection . . . or on whether any other prerequisite of a valid copyright has been satisfied,”¹⁸ the Court effectively invited copyright's other limiting doctrines to guard against extensive overprotection in the useful articles context. Such limits include, *inter alia*, exclusion doctrines such as originality, merger, *scenes à faire*, and the prohibition of

14. See, e.g., Helen M. Freeman, *A Big Cheer for Cheerleader Uniforms*, FASHION INDUSTRY L. BLOG (Mar. 22, 2017), <https://fashionindustrylaw.com/2017/03/22/a-big-cheer-for-cheerleader-uniforms/> [<https://perma.cc/KRN4-TQJ4>]; Michael Madison, *Two Cheers for Copyright*, MADISONIAN (Mar. 27, 2017), <http://madisonian.net/2017/03/27/two-cheers-for-copyright/> [<https://perma.cc/GM6K-CC8D>]; Steff Yotka, *What the Supreme Court's First Ruling on Fashion Copyrights Means for the Runway*, VOGUE (Mar. 23, 2017, 3:42PM), <https://www.vogue.com/article/supreme-court-star-athletica-varsity-brands-ruling-fashion-industry> [<https://perma.cc/4WAC-YZSY>].

15. See, e.g., *Puma Files Patent, Copyright, Trade Dress Suit Against Forever 21 over Rihanna Shoes*, FASHION L. (Apr. 3, 2017) [hereinafter *Puma Files Suit Against Forever 21*], <http://www.thefashionlaw.com/home/puma-files-design-patent-copyright-trade-dress-suit-against-forever-21-over-rihanna-footwear> [<https://perma.cc/WJN8-EG82>]. Puma's recent copyright infringement lawsuit against Forever 21 over a line of celebrity-branded footwear is only the beginning. See *id.* Wearable technology and 3-D printing will also offer new opportunities for testing the copyrightability of hybrid works. See, e.g., Jacqueline Lefebvre, Note, *The Need for “Supreme” Clarity: Clothing, Copyright, and Conceptual Separability*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 143, 178–79 (2016); Roy S. Kaufman, *Is the US Supreme Court Decision Regarding Uniforms Worth Cheering for?*, TECHCRUNCH (July 26, 2017), <https://techcrunch.com/2017/07/26/is-the-us-supreme-court-decision-regarding-uniforms-worth-cheering-for/> [<https://perma.cc/VC3A-Z3AT>].

16. See Varsity Brands, Inc. v. Star Athletica, LLC, No. 10-02508, 2017 WL 3446292, at *1, *3 (W.D. Tenn. Aug. 10, 2017); see also Bill Donahue, *Cheerleader Uniform IP Case Ends with Unusual Settlement*, LAW360 (Aug. 10, 2017, 1:41 PM) <https://www.law360.com/articles/953048/cheerleader-uniform-ip-case-ends-with-unusual-settlement> [<https://perma.cc/V4VB-PP77>].

17. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1012 n.1 (2017).

18. *Id.*

copyright for systems, processes, and methods of operation; the availability of thin copyright protection; and the use of filtering when assessing substantial similarity in infringement inquiries.¹⁹ How effective these doctrines will be in the aesthetic useful works context is an open question. Framing will be outcome determinative. Elements of the doctrines are themselves contested and have led to inconsistent results; they too require normative theories to justify the lines they draw. The *Star Athletica* Court provided no guidance as to their comparative appropriateness in foreseeably different kinds of useful articles cases. We cannot predict whether, and to what extent, lower courts will successfully use limiting doctrines to promote intellectual property (IP) balance. Still, they represent useful constraints on possibly runaway interpretations of *Star Athletica*.

Nevertheless, *Star Athletica* presents a deeper and less visible problem that neither the new separability test nor copyright's other limiting doctrines can resolve. Both the new test and the other copyright doctrines are applied on an article-by-article basis in specific cases. The new separability test encourages courts to hone in on the specific aesthetic characteristics of the useful articles at issue. But this particularistic focus means that neither *Star Athletica* nor copyright's other limiting doctrines address the elephant in the room: the possible market impact of an *aggregation* of multiple copyright registrations covering virtually all variations in particular styles of design features to be integrated in useful articles. A strategy of aggregative copyright registration (designed to cover virtually all variations of PGS features in particular simple styles) raises the question of how to deal with possible overall anticompetitive effects of multiple individually justifiable copyright grants. Such a strategy could have powerful foreclosure effects in the market for useful works, particularly in markets featuring standardization and high switching costs. Even if *Star Athletica*'s new separability test can properly distinguish protectable aesthetics in an individual case, it completely misses the issue of the deployment of aggregative copyright strategies to erect barriers to entry in markets for functional works.

Although the Court noted that Varsity Brands registered two hundred copyrights in variations of its similar uniform designs,²⁰ it

19. See 17 U.S.C. § 102(b) (2012); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991); Buccafusco & Lemley, *supra* note 12, at 1311, 1325; Michael D. Murray, *Copyright, Originality, and the End of the Scènes à Faire and Merger Doctrines for Visual Works*, 58 BAYLOR L. REV. 779, 784–93, 804 (2006). Although not discussed here, fair use and flexibility as to remedies (such as limiting injunctions) are also potentially available limiting requirements. See 17 U.S.C. §§ 107, 502–505.

20. *Star Athletica*, 137 S. Ct. at 1007 (“Respondents have obtained or acquired more than 200 U.S. copyright registrations for two-dimensional designs appearing on the surface of

did not even inquire into whether that would create aggregate effects making it difficult for other entrants in the cheerleading uniform market to compete effectively with Varsity Brands. To be sure, not every instance of a design-focused branding strategy reliant on multiple copyright registrations will pose a copyright-relevant competitive threat. Was *Star Athletica* itself an example of anticompetitive abuse of copyright to entrench market power, or simply a setting in which one market player's reasonable, style-based branding strategies would not realistically create barriers to entry for competitors?²¹ Beyond the particulars of the case, the *Star Athletica* Court's major error was its failure to see that the real threat today to the PGS features Congress was trying to protect by enacting the separability requirement lies not in the individual copyright registration for an aesthetic design, but in the business strategy of copyright aggregation.²²

The Court's blindness to the issue meant that it did not assess possible solutions. Had it done so, it could well have concluded that an administrative approach is not likely to succeed. The procedures of the US Copyright Office are not sensitive to the aggregate effects of registration, and there is little reason to defer to the Office's registration decisions.²³ On the litigation side, however, the Court could have explored the possibility of copyright abuse claims as a

their uniforms and other garments. These designs are primarily 'combinations, positionings, and arrangements of elements' that include 'chevrons . . . , lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring, and shapes.'").

21. For example, in *Star Athletica* itself, it is quite possible that the nature of the cheerleading uniform market is such that Varsity Brands' two hundred copyright registrations would *not* have a material anticompetitive effect—because there is no reason to believe that customers would not switch from the Varsity Brands style of uniform design to aesthetically different alternatives if contractual constraints were not a factor. *See id.*

22. Admittedly, the Court was careful to assert that the new separability will not allow monopoly in functional works or entail "backdoor patents." *Id.* at 1013 ("Even if respondents ultimately succeed in establishing a valid copyright in the surface decorations at issue here, respondents have no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear."); *see also* Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1476, 1499–1500 (2004) (discussing channeling to avoid backdoor patents obtained through copyright-patent overlaps). The problem, though, is that the Court's reasoning does not specify how to avoid such consequences in markets with standardization in consumer expectations and high switching costs. *See generally Star Athletica*, 137 S. Ct. 1002. This blinders-on approach meant that the Court's separability standard does not address the policy concern that moved Congress to adopt the separability criterion in the first place.

23. *See infra* Part V.C. (addressing the Copyright Office's processes and the statutory presumption accorded by the Copyright Act to Copyright Office registration certificates.).

potential redress.²⁴ Still, as such claims would be brought on a case-by-case basis, it is not clear whether a copyright abuse approach alone would be a reliable guard against overprotection.

Another missed opportunity would have been to address head-on the question of how to define “function” for separability purposes, given the broad spectrum of possible functions.²⁵ Without even recognizing other alternatives, the *Star Athletica* Court implicitly accepted the narrowest, most mechanical interpretation of function. This unexamined choice opened the door to overprotection of industrial design. By contrast, had the Court gone to the opposite extreme and adopted the broadest, most abstract conception of function, as recommended by some amici,²⁶ it would have excluded from copyright even those aesthetic elements that would have clearly been copyrightable had they not been applied to useful articles. That approach, in turn, opens the door to underprotection of applied art. Between the two extremes, however, is the possibility of crafting a reasonable middle ground consistent with the statute and congressional intent. *Star Athletica*’s biggest failure may be that it missed the opportunity to explore whether it could combat the anticompetitive use of aggregative copyright registration strategies by adopting an alternative definition of functionality and crafting a workable notion of copyright abuse to address such circumstances.

The middle-ground option, as applied in *Star Athletica*, would have expanded the Court’s approach to copyright-preclusive functionality by including objectively and scientifically grounded perceptual impacts of aesthetic elements embedded in useful articles. This would deter overprotection, whether through individual cases or by limiting the effectiveness of aggregative registration strategies. At the same time, by not going to the extreme of characterizing all visual appeal as functional and therefore uncopyrightable, the middle-ground approach would protect against underprotection of artistic features simply because they were incorporated in functional objects.

The Article proceeds as follows. Part II describes the history of *Star Athletica v. Varsity Brands* and the Supreme Court’s decision. Part III sketches the Court’s rejection of prior separability

24. Such claims could be brought under the doctrine of copyright misuse, although its contours are unclear and its legitimacy contested. See discussion *infra* Part V.B.

25. Instead, the Court engaged in the ineffective gambit of trying to avoid defining function by shifting the analytic focus to whether the art can be *non-functional* on its own. See *Star Athletica*, 137 S. Ct. at 1013.

26. See, e.g., Buccafusco & Fromer, *Fashion’s Function*, *supra* note 12, at 55–60 (asserting that aesthetic elements in clothing which make the wearer look good are thereby functional and therefore dual-nature features).

jurisprudence and criticizes the new separability test for its vagueness, indeterminacy, and inconsistency with the Copyright Act. Part III then raises the threat of opportunistic litigation pushing toward overprotection. As an object lesson, that Part engages in a thought experiment: attempting to apply the new test to iconic prior conceptual separability cases and to fashion design. Part IV addresses the *Star Athletica* majority's strategy for disciplining overprotection by punting to other copyright limiting doctrines, such as the exclusion doctrines of originality, merger, *scenes à faire*, and the prohibition on copyrighting systems and processes; the grant of thin copyright; and the use of filtering methodology in substantial similarity analysis for infringement. Part IV also argues that although all these doctrines are viable alternatives for constraining a headlong rush to copyright in attractive useful works, they too are uncertain in application and require normative choices that *Star Athletica* does not confront. Part V expands the frame and identifies the less visible but even more serious post-*Star Athletica* threat: the multiple registration problem for designs in the same style and the possible anticompetitive effects of aggregative registration strategies in some markets for useful works. Part V also addresses copyright abuse and reliance on the Copyright Office as possible responses. Finally, Part VI criticizes the Court's refusal to define function in the useful works context, explains why its attempt to focus on the PGS articles' non-functionality does not work, and suggests a middle-ground approach that expands the kinds of functions that should preclude copyright protection without undermining Congress's desire to include applied art under the copyright umbrella. The Part argues that such a middle-ground approach would be the most fruitful general response to the anticompetitive threats posed by aggregative registration strategies.

II. THE STORY OF *STAR ATHLETICA V. VARSITY BRANDS*

Under the Copyright Act of 1976, two- and three-dimensional PGS works are copyrightable to the extent they also meet the other requirements of copyrightability.²⁷ But useful articles—defined as an “article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”—are not copyrightable.²⁸ To the extent that useful articles contain PGS

27. 17 U.S.C. § 102(a)(5) (2012) (“Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . [including] pictorial, graphic, and sculptural works[.]”); see *id.* § 101 (“Pictorial, graphic, and sculptural works’ include two-dimensional and three-dimensional works of fine, graphic, and applied art . . .”).

28. *Id.* §§ 101–02.

features, “the design of a useful article . . . shall be considered 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.”²⁹ In making these distinctions, Congress was trying to police the boundaries between uncopyrightable works of industrial design and copyrightable works of applied art.³⁰ The difficulty? The statute did not define either term—or separability. Furthermore, the Copyright Act was designed to have two separate sections—Title I for copyright and Title II for a separate type of protection for industrial design.³¹ The Act was adopted only with Title I, however, and the only separate protection for industrial design addressed by later versions of the legislation was limited to semiconductor chip³² and boat hull³³ designs.

Varsity Brands is now the largest manufacturer of cheerleading uniforms.³⁴ The company has registered hundreds of designs for cheerleading uniforms with the Copyright Office.³⁵ The designs represent many variations of color blocking, chevrons, and stripes.³⁶ Star Athletica, helmed by a former Varsity Brands employee,³⁷ is a sports apparel manufacturer and a competitor to Varsity Brands in the manufacture of cheerleading uniforms.³⁸ The

29. *Id.* § 101.

30. See H.R. REP. NO. 94-1476, at 55 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5668; see also Ginsburg, *supra* note 4, at 2.

31. For a history, see Ginsburg, *supra* note 4, at 9 & nn.33–44. Title II of the copyright reform bill sought to protect “ornamental designs of useful articles.” *Id.* The House rejected Title II of the Senate bill, explaining that Title II could not properly be considered copyright protection within the ambit of the copyright revision process. *Id.*; see also Pamela Samuelson, *Evolving Conceptions of Copyright Subject Matter*, 78 U. PITT. L. REV. 17, 46 (2016) (noting the hope that a proposed design regime which the Copyright Office supported “would prevent industrial designers from trying to stretch the concept of applied art to get copyright protection”).

32. 17 U.S.C. § 902; see also Samuelson, *supra* note 31, at 71–77.

33. 17 U.S.C. § 1301; see also Samuelson, *supra* note 31, at 77–79.

34. Erin Geiger Smith, *Who Owns Cheerleader Uniform Designs? It's up to the Supreme Court*, N.Y. TIMES (Oct. 29, 2016), <https://www.nytimes.com/2016/10/30/sports/who-owns-cheerleader-uniform-designs-its-up-to-the-supreme-court.html> [<https://perma.cc/F6KK-ZYLF>]; see also *Petition for Writ of Certiorari at 12, Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866).

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

36. *Id.* (describing the designs as “primarily ‘combinations, positionings, and arrangements of elements’ that include ‘chevrons . . . , lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring, and shapes’”).

37. Ahiza Garcia, *Give Me a ©! Supreme Court Rules Cheerleader Uniforms Can Be Copyrighted*, CNN: MONEY (Mar. 22, 2017, 7:00 PM), <http://money.cnn.com/2017/03/22/news/companies/varsity-cheerleaders-supreme-court/index.html> [<https://perma.cc/MS7Y-KKG5>].

38. *Id.*

Star Athletica lawsuit began when Varsity Brands noticed that its new competitor Star Athletica's catalogue was marketing similar cheerleading uniforms.³⁹ In its petition for certiorari, Star Athletica accused Varsity Brands of either litigating against new market entrants or acquiring its successful competitors in order to "protect its cheer empire."⁴⁰ Varsity Brands sued Star Athletica for, *inter alia*, copyright infringement in connection with five cheerleading uniform designs.⁴¹

Star Athletica won at the trial level because the court found Varsity Brands' designs served the utilitarian function of identifying garments as "cheerleading uniforms." Therefore, the court reasoned, they could not be "physically or conceptually" separated under Section 101 of the Copyright Act "from the utilitarian function" of the uniform: "Without the kind of ornamentation familiar to sports (or cheerleading) fans, the silhouette no longer evokes the utilitarian concept of a cheerleading uniform, a garment that is worn by a certain group of people in a specific context."⁴²

The US Court of Appeals for the Sixth Circuit vacated and remanded, adopting a purportedly new standard for separability. The court identified the useful aspects of the Varsity Brands uniforms as limited to wearability and coverage.⁴³ Because the chevron, stripe, and color blocking designs were unnecessary to the function of covering the body modestly, the court treated them as separable and therefore copyrightable expressive features.⁴⁴ By contrast, the dissent saw the PGS features as performing other functions—namely, identifying the wearers as cheerleaders and serving decorative functions that would enhance the wearers' attractiveness.⁴⁵ Thus,

39. See *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at *1 (W.D. Tenn. Mar. 1, 2014), *vacated*, 799 F.3d 468 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002, 1007 (2017).

40. Petition for Writ of Certiorari, *supra* note 34, at 13.

41. *Varsity Brands*, 2014 WL 819422, at *2.

42. *Varsity Brands*, 2014 WL 819422, at *8–9.

43. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 487, 491–94 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002, 1007 (2017).

44. *Id.* at 491–93. As the Supreme Court in *Star Athletica* described the Sixth Circuit's reasoning:

[T]he "graphic designs" were "separately identifiable" because the designs "and a blank cheerleading uniform can appear 'side by side'—one as a graphic design, and one as a cheerleading uniform." . . . And [the Sixth Circuit] determined that the designs were "capable of existing independently" because they could be incorporated onto the surface of different types of garments, or hung on the wall and framed as art.

Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1007, 1008 (2017) (quoting *Varsity Brands*, 799 F.3d at 491–92).

45. *Varsity Brands*, 799 F.3d at 494–97 (McKeague, J., dissenting).

inseparability resulted from the fact that the surface designs were “integral” to the cheerleader identification function.⁴⁶

Varsity Brands successfully sought certiorari on the question, “What is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act?”⁴⁷ In a 5-1-2 decision, with the majority opinion written by Justice Thomas, the Supreme Court affirmed the Sixth Circuit and held the Varsity Brands designs at issue to constitute separable graphic features of useful articles. Justice Ginsburg concurred in the result, and Justice Breyer, joined by Justice Kennedy, wrote in dissent.⁴⁸ The majority opinion adopted a textualist approach focused on statutory language and explicitly rejected consideration of copyright policy.⁴⁹

Rejecting prior lower court precedent, the Court held that

[a] feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (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 its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article in which it is incorporated.⁵⁰

The first step requires the court to “spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.”⁵¹ According to the majority, that burden is “not onerous”⁵²—although the Court did not provide any benchmarks for guiding that visualization exercise. The second step requires a finding 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.”⁵³ If the PGS 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.”⁵⁴

46. *Id.* at 495–96.

47. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 136 S. Ct. 1823 (2016) (granting certiorari on Question 1); Petition for Writ of Certiorari, *supra* note 34, at i. The Court did not grant certiorari on the second question, which was “[w]hether, in determining a copyright registration’s validity, a court should give any judicial deference in addition to the statutory deference articulated in 17 U.S.C. § 410(c).” See *Star Athletica*, 136 S. Ct. at 1823; Petition for Writ of Certiorari, *supra* note 34, at i.

48. *Star Athletica*, 137 S. Ct. at 1006–07.

49. *Id.* at 1010.

50. *Id.* at 1007.

51. *Id.* at 1010.

52. *Id.*

53. *Id.*

54. *Id.*

The Court contended that “[a]pplying this test to the surface decorations on the cheerleading uniforms [was] straightforward.”⁵⁵ Without explanation, it deemed the first prong met: “[O]ne can identify the decorations as features having pictorial, graphic, or sculptural qualities.”⁵⁶ As to the second prong, the majority found that “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.’”⁵⁷ In fact, the cheerleading uniform designs had been applied to other objects without replicating the uniforms themselves.⁵⁸ The majority framed the question through the use of a dual “zooming in” methodology—having zoomed in on the function of the article by defining it effectively as a dress, the majority then also zoomed in on the design, thereby distinguishing it from the overall functional outline of the cheerleader uniform as garment.⁵⁹

Although the dissent did not reject the majority’s test as such, it disagreed with the majority on independent existence and concluded that the designs were inseparable because they necessarily replicated the underlying useful items.⁶⁰ Thus, Justice Breyer suggested that if the arrangement of chevrons, lines, and color blocking in the cheerleading uniforms could not be “conceive[d] of . . . separately without replicating a picture of the utilitarian object,” or if separating out the aesthetic elements would not leave a “fully functioning utilitarian object in place,” they could not be considered separable.⁶¹

55. *Id.* at 1012.

56. *Id.*

57. *Id.* The Court also asserted that “imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself.” *Id.*

58. *Id.* The majority rejected the dissent’s argument that imaginatively removing the designs from the uniforms and placing them in another medium of expression would necessarily replicate the cheerleader uniforms. *Id.*

59. *Id.*

60. *Id.* at 1030 (Breyer, J., dissenting) (“I agree with much in the Court’s opinion. But . . . [e]ven applying the majority’s test, the designs *cannot* be perceived as . . . two- or three-dimensional work[s] of art separate from the useful article.” (quoting *id.* at 1007 (majority opinion))).

61. *Id.* at 1031, 1033. In sum, Justice Breyer said:

[I]f extracting the claimed features would necessarily bring along the underlying useful article, the design is not separable from the useful article. In many or most cases, to decide whether a design or artistic feature of a useful article is conceptually separate from the article itself, it is enough to imagine the feature on its own and ask, “Have I created a picture of a (useful part of a) useful article?” If so, the design is not separable from the useful article. If not, it is.

Id. at 1033.

Justice Breyer also cautioned that Varsity Brands “seeks to do indirectly what it cannot do directly: bring along the design and cut of the dresses by seeking to protect surface decorations whose ‘treatment and arrangement’ are *coextensive with that design and cut*.”⁶² In other words, Varsity Brands was trying to use copyright to “prevent its competitors from making useful three-dimensional cheerleader uniforms by submitting plainly unoriginal chevrons and stripes as cut and arranged on a useful article.”⁶³ Justice Breyer insisted that this would be contrary to congressional intent and impermissible on the correct reading of the majority’s test.⁶⁴

Justice Ginsburg concurred in the result but did not deem it necessary to take up the question of the appropriate separability test because “the designs at issue are not designs *of* useful articles. Instead, the designs are themselves copyrightable pictorial or graphic works *reproduced on* useful articles.”⁶⁵

Because the Supreme Court had not addressed the overall copyrightability and infringement issues in *Star Athletica*,⁶⁶ the case went back to the trial court. Recently, *Star Athletica* was dismissed in accordance with the terms of a confidential settlement agreement between Varsity Brands and Star Athletica’s insurer.⁶⁷ Star Athletica’s lawyers opposed the settlement and objected—unavailingly—to the dismissal of the case.⁶⁸ The district court’s opinion offered no reasoning for the dismissal.

III. THE COURT’S ABOUT-FACE AND ITS DANGERS

The full meaning and consequences of *Star Athletica* are not yet clear. It is possible to read the case narrowly, as a relatively unimportant instance in which the Court simply “zoomed in”⁶⁹ on the PGS elements in the cheerleader uniforms and applied traditional law

62. *Id.* at 1036 (emphasis in original).

63. *Id.*

64. *Id.* at 1033, 1035.

65. *Id.* at 1018 (Ginsburg, J., concurring in the judgment) (emphasis in original). For a similar argument, see Ginsburg, *supra* note 4, at 17.

66. *Star Athletica*, 137 S. Ct. at 1012 n.1 (majority opinion).

67. See Varsity Brands, Inc. v. Star Athletica, LLC, No. 10-02508, 2017 WL 3446292, at *1, *3, (W.D. Tenn. Aug. 10, 2017); see also Donahue, *supra* note 16.

68. Donahue, *supra* note 16.

69. In a very helpful analysis, Professors Kaminski and Rub recently identified a persistent framing problem affecting virtually all aspects of judicial applications of copyright doctrine. In doing so, they noted that courts virtually unconsciously toggle between zooming in or zooming out in their applications of copyright principles. Margot E. Kaminski & Guy A. Rub, *Copyright’s Framing Problem*, 64 UCLA L. REV. 1102, 1104–05, 1138–39 (2017).

on the copyrightability of fabric designs.⁷⁰ If later courts interpret the case as simply about the copyrightability of surface designs on fabric, then *Star Athletica* is not likely to move the jurisprudential needle very much. It is far more likely, however, that the case will be seen as having made significant changes in copyright law by (1) rejecting prior separability doctrine, and (2) offering its own new separability standard.

The big dispute will be over whether these changes are desirable or detrimental. Some observers might see *Star Athletica* as providing a relatively benign resolution to a jurisprudential mess, focusing as it should on art rather than function and leaving room for other, better-situated copyright doctrines to guard against overprotection.⁷¹ For others taking the contrary view, *Star Athletica* invites extensive overprotection of inseparable aesthetic elements and extends de facto protection to useful articles for which no utility patent would otherwise issue.⁷² Whatever one thinks of the new separability as applied in *Star Athletica* itself, however, one

70. Such a narrow interpretation of the meaning of *Star Athletica* would be consistent with Justice Ginsburg's approach. See *Star Athletica*, 137 S. Ct. at 1018 (Ginsburg, J., concurring in the judgment). For a discussion of the copyright utility rule, see Pamela Samuelson, *CONTU Revisited: The Case Against Copyright Protection for Computer Programs in Machine-Readable Form*, 1984 DUKE L.J. 663, 729–36 (1984). See also Charles E. Colman, *The History and Doctrine of American Copyright Protection for Fashion Design: Managing Mazer*, 7 HARV. J. SPORTS & ENT. L. 150, 162–79 (2016) (describing protection for fabric designs).

71. For an article criticizing pre-*Star Athletica* separability jurisprudence and calling for the useful articles doctrine to be seen as a device to channel the protection of functional ideas from copyright to patent, see Shahshahani, *supra* note 5. Those who see *Star Athletica* this way might believe that even if the textualist approach is imperfect, it has decided advantages—not the least of which is the likely effect of reducing reliance on design patents. Scholars of design patent have argued recently that judicial interpretations have overly expanded a protectionist approach in design patent doctrine. For a view of design patent as reflecting the product differentiation goals of sumptuary law rather than IP goals of promoting progress, see Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 862–64 (2010). For a wholesale critique of the current design patent system, see, for example, Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 STAN. TECH. L. REV. 1, 31, 51 (2013) (arguing that unless design patent can be justified with respect to the integration of aesthetics and function, there can be no sensible design patent system). As a practical matter, the availability of copyright protection under *Star Athletica* could diminish the role of increasingly protectionist design patent law in favor of more balanced copyright law.

72. For a critique of *Star Athletica* arguing that it invites overprotection and undermines IP boundaries, see, for example, Mark P. McKenna, *Knowing Separability When We See It*, 166 U. PA. L. REV. ONLINE 127, 127, 131 (2017); Mark P. McKenna & Christopher Jon Sprigman, *What's In, and What's Out: How IP's Boundary Rules Shape Innovation*, 30 HARV. J.L. & TECH. 491, 493 (2017); Peter S. Menell & Daniel Yablon, *Star Athletica's Fissure in the Intellectual Property Functionality Landscape*, 166 U. PA. L. REV. ONLINE 137, 139 (2017) (“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.”).

fundamental problem with the Court's approach is that its clear rejection of prior doctrine will leave courts with nothing to turn to when faced with fact patterns that confound the Court's new test. By contrast to the clarity of that aspect of the decision, the *Star Athletica* Court adopted a supposedly simple, unified—but quite vague—test for separability. Having taken away whatever clarity there was in the jurisprudence, the new separability replaces it with uncertainty and no guidance for subsequent courts.

A. Jettisoning Prior Separability Doctrine

Star Athletica altered the law in three ways: (1) by shifting the focus of separability entirely to the extracted features of the useful article, (2) by rejecting prior creator-focused and consumer-focused conceptual separability tests, and (3) by expressly discarding the physical-conceptual separability distinction.

First, the Court shifted the locus of separability analysis. The Copyright Office and some scholars had evaluated conceptual separability by assessing whether after separation the extracted PGS elements would stand on their own as works of art and the useful work would remain equally useful without those features.⁷³ The *Star Athletica* majority explicitly rejected any assessment of the remaining utility of the useful article; it chose instead to focus only on the independent existence of the PGS features as works of art.⁷⁴ It rejected the notion that the only protectable PGS elements should be

73. See, e.g., 1 PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE § 2.5.3, at 109 (1989); U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2B (3d ed. 2014) [hereinafter U.S. COPYRIGHT OFFICE, 2014 COMPENDIUM], [https://law.resource.org/pub/us/compendium/ch900.html#s924.2\(B\)](https://law.resource.org/pub/us/compendium/ch900.html#s924.2(B)) [<https://perma.cc/G8G8-H43N>]; Ginsburg, *supra* note 4, at 12–13.

74. *Star Athletica*, 137 S. Ct. at 1013–14 (majority opinion). As the majority put it:

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. . . . [T]he statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one.

Id.

The majority was concerned about the arbitrariness of birth order in determining separability, so it sought to “interpret[] §§ 101 and 113 in a way that would afford copyright protection to the statuette in *Mazer* regardless of whether it was first created as a standalone sculptural work or as the base of the lamp.” *Id.* at 1012; see also Ginsburg, *supra* note 4, at 36–37 (describing the formalism of the birth order paradox and suggesting a reverse § 113(a) approach by which courts would ascertain separability “by inquiring whether the [relevant feature] could be conceptualized as a preexisting PGS work reproduced ‘in or on’ a useful article”).

those that “play absolutely no role in an article’s function[.]”⁷⁵ It also reiterated, however, that copyright protection for separable PGS elements does not provide a monopoly in the manufacture of the underlying useful work and noted that separability is only one of the hurdles a claimant would need to pass in order successfully to assert infringement of a copyrighted work.⁷⁶

Second, the Court explicitly rejected the two major approaches to separability previously developed by the circuits. As described by the appellate court in *Star Athletica*, separability analysis since *Mazer v. Stein* generated many tests.⁷⁷ Although they can be lumped in various ways,⁷⁸ one useful taxonomy could divide the predominant pre-*Star Athletica* separability jurisprudence into consumer-oriented tests and creator- or design process-oriented tests.⁷⁹ The *Star Athletica* majority rejected both of those types of

75. *Star Athletica*, 137 S. Ct. at 1014 (“An 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. . . . Were we to accept petitioner’s argument that the only protectable features are those that play absolutely no role in an article’s function, we would effectively abrogate the rule of *Mazer* and read ‘applied art’ out of the statute.”).

76. The majority insisted that:

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). 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. Although the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.

Id. at 1010 (citations omitted) (quoting 17 U.S.C. § 101 (2012)); see also *id.* at 1013 (explaining that even if Varsity Brands had “a valid copyright in the surface decorations at issue here, [it] ha[s] no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear”).

77. Numerous separability tests can be teased out of the various circuits’ cases on useful works separability and commentary offered by scholars. See Ghosh, *supra* note 5, at 97 (listing nine separability tests gleaned from cases and literature); Perlmutter, *supra* note 4, at 340–41. The Sixth Circuit in *Varsity Brands* identified nine and added its own tenth. See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484–85, 487 (6th Cir. 2015), *aff’d*, 137 S. Ct. 1002 (2017).

78. See, e.g., Ghosh, *supra* note 5, at 97–100 (grouping nine identified separability tests into three categories: (1) those requiring examination of the work, (2) those focusing on the observer or audience of the work, and (3) those that focus on the creator’s motivations).

79. This approach to categorizing pre-*Star Athletica* separability tests looks at the vantage point from which the tests were to be applied. Some—the consumer-oriented tests—principally focused on consumer reactions: What was the primary appeal of the work as gleaned from customer use? Would the work be marketable even if it did not perform its function? Others—particularly the creator-oriented separability tests—looked at the impact of functional considerations on the design, seeking to determine whether artistic or functional considerations influenced the choice of aesthetic features of a given useful item during the creative process. See *id.* at 99.

approaches—choosing to focus solely on the work itself.⁸⁰ Thus, going forward, the separability inquiry will not focus on whether the aesthetic elements of a useful work constituted the primary appeal of the object to purchasers, or would be marketable to consumers regardless of function, or were dictated by functional considerations.

Finally, the Court also explicitly rejected the distinction between physical and conceptual separability, adopting what it described as a conceptual instead of a physically focused inquiry.⁸¹ The Court did not choose to limit the separability inquiry to physical separability alone.

Admittedly, the cacophony of conceptual separability tests had exasperated scholars and courts.⁸² One response could have been to limit copyrightability to physically separable PGS elements. In light

80. *Star Athletica*, 137 S. Ct. at 1007. In his taxonomy, Professor Ghosh describes some of the prior conceptual separability tests (such as the Copyright Office test, the primary/subsidiary approach, the objective necessity approach, the stand-alone approach, and the Patry dictated-by-function approach) as focusing on the work itself. See Ghosh, *supra* note 5, at 97. In other interpretations, these tests could be sorted into the consumer-focused and creator-focused categories, if interpreted broadly enough. See *id.*

81. *Star Athletica*, 137 S. Ct. at 1014. Although the majority's standard, as phrased, would not necessarily foreclose a physical separability interpretation, the Court did not, in fact, apply its new standard that way. A group of prominent IP law professors filed an amicus brief (the "McKenna et al. Brief") in the case and offered a separability standard not very differently expressed than that adopted by the Court. However, the amici saw their proposed test as one that focused on physical separability, with conceptual separability described as a "coda" to physical separability. See Brief for Intellectual Property Professors as Amici Curiae Supporting Petitioner at 2, 4, 8, 9–11, *Star Athletica*, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017) (No. 15-866). The brief took the position that one must keep one's eye on Congress's intent to distinguish between applied art and industrial design as the goal of the separability analysis and that, therefore, the key distinction should be whether the artistic elements applied onto a useful article would exist as copyrightable works on their own, even if the useful work into which they were integrated was destroyed. *Id.* at 2. This seems very close to the separability test adopted by the Court in *Star Athletica*. See *Star Athletica*, 137 S. Ct. at 1007. But the amici would interpret it as a way to reduce the extent to which industrial design would be protected as applied art. This is because the amici assumed that a replica of the overall shape of a useful article replicates the article. See Brief for Intellectual Property Professors, *supra*, at 2, 14. This is also the dissent's position in *Star Athletica*. See *Star Athletica*, 137 S. Ct. at 1030–36 (Breyer, J., dissenting). But the majority and the dissent split over whether the attempt to apply the new separability test necessarily ended up replicating the useful article. The majority focused on the separability of the graphic elements within the outside frame of the uniform and found that Varsity Brands did not replicate the uniform shape any more than a fresco on a ceiling replicates the useful ceiling. See *Star Athletica*, 137 S. Ct. at 1012 (majority opinion). The McKenna et al. Brief asserts that under its proposed standard (which is close to the one that the majority adopted), the aesthetic elements of the cheerleader uniform existed only as part of the uniform because the coordination and arrangement of the common elements in the design constituted the cut of the uniform. Brief Amicus Curiae on Behalf of Intellectual Property Professors in Support of Petitioner, *supra*, at 3, 10, 17. But that is not how the majority saw it.

82. See, e.g., Ginsburg, *supra* note 4, at 2; Perlmutter, *supra* note 4, at 339 and sources cited therein.

of the preference of modern design for seamless melding of form and function, such an approach would likely have entailed much less copyright protection for aesthetic elements integrated into useful works.⁸³ Having rejected such an approach, however, the Court did not pick among the alternatively available conceptual separability tests—because it did not see them as properly grounded in the text of the statute.⁸⁴ Instead, it chose a scorched-earth policy in their regard.⁸⁵ Thus, the Court’s clean slate in *Star Athletica* has effectively deprived subsequent courts of policy-based choices in assessing the copyrightability of PGS elements in useful articles.⁸⁶ They now have

83. See Alice Rawsthorn, *The Demise of ‘Form Follows Function’*, N.Y. TIMES (May 30, 2009), <http://www.nytimes.com/2009/06/01/arts/01iht-DESIGN1.html> [<https://perma.cc/26C6-SDPX>].

84. See *Star Athletica*, 137 S. Ct. at 1014–15. Other alternatives, such as Professor Ginsburg’s “reverse § 113(a)” approach were not addressed. See Ginsburg, *supra* note 4, at 37. On that approach, even if a useful article’s aesthetic feature could be conceptualized as a preexisting PGS work reproduced in or on a useful article, the independent existence criterion would preclude copyright for “aesthetically pleasing designs in which the form affects the function[.]” *Id.* at 47. Even if the first prong of the Court’s new test is consistent with the first part of the Ginsburg approach, its decision not to look at whether the form affects the function is an implicit rejection of the Ginsburg option.

85. See *Star Athletica*, 137 S. Ct. at 1014–15. Despite their flaws, however, neither branch of the prior conceptual separability doctrine was irrational. Many scholars simply argued in support of consumers or creators as their preferred reference points (although more criticized the creator-focused approaches). See Ghosh, *supra* note 5, at 93. Still others focused on the evidentiary use of the various standards as proxies for the function of aesthetics in a given article. For an article interpreting copyright doctrine through the lens of its evidentiary uses, see Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683 (2003). Some, including Professor Yen, argued that the apparent conflict among the circuits as to conceptual separability resulted from judicial reliance on different—and incommensurable—theories of art. See Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247, 250 (1998); see also Robert Kirk Walker & Ben Depoorter, *Unavoidable Aesthetic Judgments in Copyright Law: A Community of Practice Standard*, 109 NW. U. L. REV. 343, 347–49 (2015). This might have made the Court wonder about the extent to which a unitary (but vague) test would simply replicate those differences even if under a different name. The Court did not address the ways in which methodologically oriented analyses might have helped rationalize the use of alternative approaches to conceptual separability. For example, would greater self-consciousness about zooming in and out in separability analysis have allowed courts focusing on consumers or creators to discover the underlying normative goals they were trying to approximate with their interpretive methodologies? Would that have dispensed with *Star Athletica*’s scorched-earth approach to alternative separability standards? See *Star Athletica*, 137 S. Ct. at 1015.

86. See *Star Athletica*, 137 S. Ct. at 1015; see also *Jetmax Ltd. v. Big Lots, Inc.*, No. 15-CV-9597 (KBF), 2017 U.S. Dist. LEXIS 138041, at *2 (S.D.N.Y. Aug. 28, 2017) (rejecting defendant’s argument because of the *Star Athletica* ruling). In an analysis of the issue after the Court granted certiorari in *Star Athletica* but before it decided the case, Professor Ghosh predicted that “[a] unified test . . . is unlikely.” Ghosh, *supra* note 5, at 91. Instead, he concluded, “the Court might clarify the principles and policies lower courts should look to in resolving specific disputes.” *Id.* That is precisely what the Court’s opinion in *Star Athletica* did not do. That leaves one to wonder whether any of the available pre-*Star Athletica* separability jurisprudence could deal better with the potential problems of aggregate anticompetitive effects

nothing to rely on in such cases beyond the Court's abstract new separability definition. This is likely to tilt courts toward overprotection.

B. The Indeterminate New Separability Test

Having overturned prior law, the Court offered a conceptual new test. That two-pronged inquiry in PGS cases involving useful works is uncertain both in *Star Athletica* itself and as a guide in future useful works cases.⁸⁷ Each of the two prongs of the new test is problematically indeterminate.

1. The Identification Prong

Without any explanation, the Court in *Star Athletica* found the first prong of its analysis satisfied. This inquiry seems not to require the identification of any kind of work of fine art; recognition of a PGS element is enough.⁸⁸ If that is enough, though, most attractive works of industrial design these days will likely satisfy that identification standard.⁸⁹ The new identification step seems less like a hurdle than a bump. What work does the first prong really do?⁹⁰ How many

of multiple copyright registrations over similar designs than does the new separability approach. See discussion *infra* Part V.A.

87. See *Star Athletica*, 137 S. Ct. at 1007; Shyamkrishna Balganes, *Clarifying the "Clear Meaning" of Separability*, 166 U. PA. L. REV. ONLINE 79, 82 (2017) (criticizing the opinion's lack of guidance for lower courts); Jane C. Ginsburg, *The Sum Is More Public Domain than Its Parts?: US Copyright Protection for Works of Applied Art Under Star Athletica's Imagination Test*, 166 U. PA. L. REV. ONLINE 83, 83–84 (2017) ("While the Supreme Court clarified the meaning and application of the 'separability' standard for decorative 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.").

88. *Star Athletica*, 137 S. Ct. at 1007, 1012. "Work of art" seems like a high standard, one that implicitly incorporates a high art originality component. But the Court did not define the phrase "work of art," and in other parts of the opinion, the majority's language suggests a much more prosaic inquiry. See *id.* For a history of the work of art standard under prior copyright law, see Ginsburg, *supra* note 4, at 5–11. Despite the Court's own application of the identification prong in *Star Athletica*, is it likely that some courts will address "what is art?" at this point—the very question apparently ruled off-limits by Justice Holmes in *Bleistein's* famous aesthetic nondiscrimination directive? See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250–52 (1903). Those courts that acknowledge the need for a variety of aesthetic judgments in copyright cases, despite *Bleistein's* warning, might especially find that inquiry unexceptionable. How they interpret the first prong of the new test might depend on whether they attend in isolation to what the Court said or what it did.

89. See *Star Athletica*, 137 S. Ct. at 133 (Breyer, J., dissenting). As Justice Breyer in dissent mused: "[V]irtually any industrial design can be thought of separately as a 'work of art': Just imagine a frame surrounding the design, or its being placed in a gallery." *Id.*

90. The identification prong might also be considered irrelevant from the point of view of those who believe that only purely expressive—and not in any way functional—PGS features

designs incorporated in a useful object would *not* satisfy the first prong?⁹¹

How the fact-finder is to “spot” the PGS work is not explained in *Star Athletica*; the Court seems to assume that this kind of envisioning is somehow natural and obvious. But the process of envisioning is complex; it requires all sorts of choices as to starting point, vantage point, and focus. Thus, might the level of specificity at which a court envisions a design influence the outcome of this part of the inquiry? And, at least in two-dimensional cases, will the exercise of imagination plausibly lead to different results depending on how closely one looks at the item? In the case of cheerleading uniforms, if one zooms in on the prints, then it is easy to imagine that they are akin to traditionally copyrightable fabric designs. If one zooms out and looks at the whole item, then one might plausibly imagine the overall shape in which the designs are embedded. The step of determining whether the arrangement would qualify as a two-dimensional work of art could be narrowly or broadly interpreted.⁹² Moreover, the identification of PGS elements requires some degree of prior decision as to how to define the useful work in which the PGS features inhere.

Additionally, a fundamental difficulty of the identification prong of the test is that the starting point determines what one can imagine. For example, with respect to the iconic *Brandir* bike rack,⁹³ if it were not in use by bikes, it might well look like a curvy, albeit basic, sculpture. On the other hand, in use as a bike rack, it cannot help but look like a bike rack, and its separable PGS elements are hard to imagine. This makes the first part of the standard far less straightforward and determinate than the majority seems to wish.

Similarly, as Professor McKenna recently pointed out, the *Star Athletica* “majority’s formulation puts pressure on claiming in cases

should be copyrightable. See, e.g., Buccafusco & Fromer, *Forgetting Functionality*, *supra* note 12, at 121–22.

91. See McKenna, *supra* note 72, at 129–30 (“[I]n light of copyright’s capacious originality standard, any feature of a useful article, described with sufficient particularity, could be ‘imagined’ as a separate work. . . . Like obscenity, the Court apparently just knows artistic features when it sees them.”).

92. So, on a narrow interpretation, copyright examiners and courts would have to ask whether they could in their imaginations “see” an array of chevrons, color blocking, and stripes that are not the same thing as the shape of the dress. If so, those features would be protectable PGS elements. On a broader interpretation, the Copyright Office personnel and courts would find separable PGS features if the aesthetic elements are either preexisting works of art or could be rendered onto two-dimensional canvas or paper. See *id.*

93. *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1146 (2d Cir. 1987) (exploring the copyrightability of the RIBBON bike rack).

involving useful articles.”⁹⁴ Although “it is hard to resist the conclusion that” the majority’s implicit acceptance of Varsity Brands’ designs “as surface ornamentation was dispositive[,]”⁹⁵ whether that characterization was “the most natural one” depends on whether courts focus on the images “in the deposit copies or on Varsity Brands’ characterizations of” those designs.⁹⁶ “[T]he level of abstraction of the description” of the designs is likely to influence the outcome of the identification prong.⁹⁷ Thus, in the absence of a “consistent claiming methodology[,]” courts attempting to identify PGS elements will be engaging in “artistic evaluation[,]” a “risky business” inconsistent with the aesthetic nondiscrimination principle.⁹⁸

Finally, the “imaginative” first prong (the identification inquiry) leads to a procedural question as well: Who makes the identification, and when? One of the things that complicates the imaginative inquiry of prong one is the fact that the initial decision on copyrightability is made by examiners in the Copyright Office at the moment of registration. If courts defer to the Copyright Office’s registration decisions, then the first prong of the new standard will nearly always lead to a finding of separability given the apparent tendency of the Copyright Office examiners to err on the side of registration.⁹⁹ If so, then the procedure will be outcome determinative—and likely very copyright maximalist.

2. The Independent Existence Prong

The second prong of the new separability inquiry is ordinarily more difficult to satisfy, as the Court acknowledges.¹⁰⁰ Yet the majority blithely assumes its effectiveness despite the diametrically contradictory results reached by the dissent in applying it in *Star Athletica* itself. Unfortunately, rather than straightforward and consistent application, the second prong of the test will likely lead to inconsistent and contradictory results. One of the problems is that the

94. McKenna, *supra* note 72, at 131 (“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.”).

95. *Id.* at 132.

96. *Id.* at 132, 135.

97. *Id.* at 135.

98. *Id.*

99. For a description of Copyright Office examiner practices and a recommendation that the level of deference should be very low in the useful works context, see discussion *infra* Part V.C.

100. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017).

second prong is susceptible to both narrow and broad interpretations. Unmoored by the *Star Athletica* majority and without the option to pick among the pre-*Star Athletica* separability doctrines, courts will apply the test either liberally or with constraint—depending on their own unexamined methodologies and the stances from which they choose to examine the matter. That unpredictability will prove problematic not only for the development of copyright doctrine but presumably also for practical issues such as litigation, licensing, investment decisions, and innovation.

The second prong of the new separability test requires the fact-finder to determine whether the identified PGS features could exist in a fixed form either on their own or in another medium than the useful article in which they appear. Does this simply ask whether the design could be drawn separately on a piece of paper?¹⁰¹ If so, virtually every element of industrial design is equally capable of being drawn separately from the useful work in which it appears. This would mean that effectively all attractive graphic features gracing a utilitarian object could be characterized as applied art and protected. That would certainly blur the distinction Congress asserted as clear, and it would dramatically expand the copyrightability of useful works with attractive decorative features. Additionally, the Court specifically rejected Varsity Brands' argument that two-dimensional works are inherently nonuseful and therefore inherently separable.¹⁰²

On an alternative interpretation, the second prong requires the fact-finder to ask whether the PGS features, when drawn on a separate piece of paper, necessarily replicate the useful work as a whole. This second interpretation would make more sense but for one thing: Elsewhere in the opinion, Justice Thomas asserts that birth order should not affect the separability decision and argues that the mere replication of the outer boundary of the useful item in a separated drawing does not replicate the underlying useful work.¹⁰³ As Justice Breyer points out, a drawing of the PGS features of Varsity

101. See Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 90–91 & n.198 (taking this interpretation, although noting a more charitable option as well, pursuant to which “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”).

102. *Star Athletica*, 137 S. Ct. at 1012 (“Just as two-dimensional fine art corresponds to the shape of the canvas on which it is painted, two-dimensional applied art correlates to the contours of the article on which it is applied.”).

103. *Id.* In other words, Justice Thomas is concerned that it would be arbitrary to say that a PGS work would be separable if it preexisted the useful item into which it was incorporated but not separable if it were created as part of the useful article. *Id.* at 1010–11; see also Ginsburg, *supra* note 4, at 37 (discussing the birth order point and suggesting that birth order could be a distinguishing matter).

Brands' designs as they are arrayed on the uniform will in many instances replicate the outer outline or shape of the uniform design.¹⁰⁴ Of course, whether and to what extent that will happen will depend on whether (and to what degree) one zooms in or zooms out when attempting to draw the PGS features.

The second prong is also confusingly phrased. It purports to focus entirely on the aesthetic elements of the integrated work and seeks to avoid assessment of the functional article. Indeed, it does not prohibit copyrightability even when the aesthetic elements of the useful object improve or enhance the function of the useful article—and may therefore have a competitive influence in the market for the useful work.¹⁰⁵ As a result of this, in one reasonable reading, the case opens the door to significant overprotection of functional works. Nevertheless, despite the Court's insistence that the test focuses only on the extracted design elements and not on the useful article, it still requires an inquiry into whether the separable PGS features are *themselves* useful articles or parts of useful articles.¹⁰⁶ Taking that language seriously would imply that even separable PGS features cannot be protected if, when separated, they are at least part of a useful work—if, in other words, they have an intrinsic nonexpressive and utilitarian purpose.¹⁰⁷ On this view, *Star*

104. *Id.* at 1035 (Breyer, J., dissenting). Justice Breyer seems to assume that the whole shape of the uniform will inevitably be replicated by an independent drawing of the PGS design features. *See id.* That is not necessarily true. For example, as the majority pointed out, the designs had been reproduced by Varsity Brands not only on uniforms but on different kinds of useful works (such as jackets). *Id.* at 1018 (majority opinion). Still, depending on how closely one zooms in or zooms out, it is possible to imagine many instances in which the outer outline of the useful work will come along with a drawing of the PGS features. *Id.* at 1033 (Breyer, J., dissenting).

105. For a critique on this ground, see, for example, Buccafusco & Fromer, *Forgetting Functionality*, *supra* note 12, at 120; Buccafusco & Lemley, *supra* note 12, at 1314–15. Indeed, the Court implicitly suggests that the reason for all the complexity and inconsistency in prior separability tests was their focus either on the functional work's characteristics or its relationship to the incorporated artistic features. *See Star Athletica*, 137 S. Ct. at 1009 (majority opinion).

106. *Id.* at 1010 (“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).” (quoting 17 U.S.C. § 101 (2012))).

107. The second prong is also different from the statutory language. The majority says that the second prong requires inquiring whether the PGS features can be “imagined apart from” the useful article. *Id.* By contrast, the statutory language requires an assessment of whether the PGS features are separable from “the utilitarian aspects of the article.” 17 U.S.C. § 101 (2012). The import of this difference is not clear, however. In one view, this difference is material because the statutory language does not necessarily require a focus on the integrated useful work. Professors Buccafusco and Fromer have argued that this difference reduces the burden on the plaintiff. Buccafusco & Fromer, *Forgetting Functionality*, *supra* note 12, at 122 (“The Court’s misreading of the statute rendered the test substantially easier for plaintiffs to pass.”). While the

Athletica's second prong does require an inquiry into functionality and the PGS elements' relationships to the useful article in which they are incorporated.¹⁰⁸ Thus, one way of reading the decision is that it upends settled jurisprudence that hybrid features—what Professors Buccafusco and Fromer have called “dual-nature” elements of useful works¹⁰⁹—are not separable and therefore copyrightable. But to the extent that the second prong of the *Star Athletica* test requires an assessment that the PGS features are not themselves useful works, the Court may not be announcing a particularly radical departure. The real, underlying question, though, is how to define “function” for purposes of determining whether the PGS elements are expressive or have a hybrid, dual-nature character. Part VI below addresses the failures of the Court's assumption that it does not have to offer a theory of function.¹¹⁰ First, however, let us imagine the consequences of *Star Athletica* for future cases that present different kinds of designs associated with useful works.

C. *The New Separability in Application—Encouraging Opportunistic Litigation*

The abstract phrasing of the new separability test makes it much less predictable when applied to useful works other than two-dimensional fabric designs. Moreover, the degree to which the new standard is likely to channel creativity toward some kinds of works or aesthetic styles as opposed to others is also unpredictable.¹¹¹ Testing the new *Star Athletica* standard against the facts of prior iconic conceptual separability cases and the fashion protection cases that are doubtless in the litigation pipeline suggests not only

argument is attractive, the characterization of the Court as having made a “mistake” depends on an understanding of the statutory language that requires the separability inquiry to focus on the useful work and on whether one can peel away nonuseful PGS features from the useful work without affecting its function. But the Court is adopting a reading that seeks to focus on the aesthetic elements themselves, and it is not clear that the quoted statutory language necessarily prohibits that reading. The Court's statutory interpretation is subject to different critiques, however, *see infra* Part IV, and there is language in the opinion that presumably constrains plaintiffs when the aesthetic elements are themselves characterizable as useful works. *See Star Athletica*, 137 S. Ct. at 1010.

108. One could read this as requiring an inquiry into whether the extracted aesthetic work has any new type of utility other than its utility when incorporated into the useful article. However, this seems like much more of a stretch than interpreting the new standard as requiring some kind of assessment of the functionality of the PGS features as incorporated in the useful article.

109. Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 83–85.

110. *See infra* Part VI.

111. *See infra* note 128.

foreseeable uncertainty and inconsistency in application¹¹² but also a likely trend toward finding separability of PGS elements in more circumstances than under pre-*Star Athletica* law.¹¹³

1. A Thought Experiment Involving Fashion¹¹⁴

Fashion is an apt context in which to address future application of the *Star Athletica* standard.¹¹⁵ The US fashion industry

112. Of course, one might ask whether the new unitary standard will necessarily lead to more uncertainty than that which already exists as a result of the dueling circuit court separability tests. Although this is of course an empirical question to which there is no answer in the abstract, there are reasons to believe that the uncertainty would be greater. At a minimum, the fact that there is supposedly one standard will drive contestation underground and make it less easily identifiable. Moreover, some of the prior conceptual separability tests might have better served to limit the effectiveness of aggregative copyright registration strategies than the *Star Athletica* approach. See discussion *infra* Part V.

113. Recently, Professors Buccafusco and Fromer have argued that the *Star Athletica* separability test does not respect the traditional analytic distinction between useful articles and nonuseful articles. See Buccafusco & Fromer, *Forgetting Functionality*, *supra* note 12, at 119. In their view, courts will now effectively grant copyright to useful articles. See *id.* Congress specifically stated its intention that function not be copyrightable, reaffirming a long copyright history reflected in such iconic cases as *Baker v. Selden*, 101 U.S. 99 (1879). See 17 U.S.C. § 102 (2012).

114. On some interpretations, the new separability test would change the results in some of the iconic conceptual separability cases involving useful articles. Iconic separability cases have addressed an aesthetically designed belt buckle, *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 990 (2d Cir. 1980); a sculptural bike rack, *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1143 (2d Cir. 1987); clothing display mannequins, *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 412 (2d Cir. 1985); and the mannequin of a head for makeup application, *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 920 (7th Cir. 2004). In many, if not all, of these cases, reasonable viewers could disagree as to the new separability test's results when applied.

For example, as noted above, the bike rack in *Brandir* could be seen as a basic, modernist sinusoidal sculpture and therefore copyrightable (contrary to the result in *Brandir* itself). See *Brandir*, 834 F.2d at 1147–49. Or an alternative viewer could reasonably conclude (especially when seeing the item in use) that it would be difficult to imagine separable, non-functional PGS features because the entire shape would necessarily be replicated. See Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 67 (asserting that the *Brandir* bike rack has an intrinsic utilitarian function of holding bicycles securely). Similarly, those looking at the *Kieselstein-Cord* belt buckles found to be copyrightable in the Second Circuit early on could come out either way when applying the new separability test. See *Kieselstein-Cord*, 632 F.2d at 990. On the one hand, a viewer could look at the swooping curves of the belt buckle and see in them a sweeping design that could be reproduced in an artwork without the central pin designed to anchor the belt. See *id.* at 995 (depicting the belt buckle). An alternate viewer, though, might look at the belt buckle and have difficulty imagining the swooping curves as separate from their underlying incorporated utilitarian design. See *id.* Depending on how broadly the test is applied, even the anatomically accurate dress forms of *Carol Barnhart* could be considered separable. See *Carol Barnhart*, 773 F.2d at 425 figs.1 & 2. Similarly, the “hungry look” of the makeup instruction mannequin in *Pivot Point* could be imagined as a lifelike model sculpture—or not. See *Pivot Point*, 372 F.3d at 915, 931.

is a \$370 billion enterprise involving 1.8 million jobs.¹¹⁶ The availability of new copying technology has prompted the development of a robust knockoff or copycat industry as well as literal copying of trending fashion designs.¹¹⁷ Whether literally duplicating a design or simply aping its style in a copycat or knockoff version, the parasitic copying industry sells its designs at much lower cost than the original designers. Despite recent assertions that the low-protection IP environment for fashion has allowed the development of a rich and innovative fashion industry,¹¹⁸ proponents of additional legal protection for fashion designs have thus far (unsuccessfully) sought

115. For pre-*Star Athletica* discussions of copyrightability and fashion design, see, for example, Colman, *supra* note 70; Giovanna Marchese, Note, *A Tri-Partite Classification Scheme to Clarify Conceptual Separability in the Context of Clothing Design*, 38 CARDOZO L. REV. 375 (2016).

New technologies and new subjects and forms of form-function hybridity (including wearable technology) are also likely to present new types of contexts in which to assess separability.

Beyond the context of fashion, there is some question as to whether *Star Athletica* will open the door to enhanced copyright protection for attractive aspects of traditionally functional works. So, for example, the Court made it clear that shovels as shovels would not warrant copyright protection, even if they had separable and copyrightable sculptural aspects that would. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1013 n.2 (2017). But what about the shovel's aesthetically appealing, modernist shape that makes the shovel look sleek and streamlined, but also simultaneously makes it function more smoothly or efficiently in use as a shovel? Because of the vagueness and the particular two-dimensional context of the *Star Athletica* test, the consequences for traditional utilitarian industrial design beyond fashion are not clear either. See Jonathan E. Moskin, Commentary, *C-O-P-Y-R-I-G-H-T: What Does That Spell? Star Athletica v. Varsity Brands Reimagines Protection for Useful Articles*, 107 TRADEMARK REP. 776, 777 (2017).

116. *Star Athletica*, 137 S. Ct. at 1035 (Breyer, J. dissenting) (citing Brief for Council of Fashion Designers of America, Inc. as Amicus Curiae in Support of Respondents at 3–4, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866)).

117. See, e.g., C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1171 (2009); Courtney Daniels, Note, *Made in America: Is the IDPPPA the Answer to the United States Fashion Industry's Quest for Design Protection?*, 20 U. MIAMI BUS. L. REV. 113, 126–27 (2011); Alexandra Manfredi, Note, *Haute Copyright: Tailoring Copyright Protection to High-Profile Fashion Designs*, 21 CARDOZO J. INT'L & COMP. L. 111, 117–22 (2012).

118. See *Star Athletica*, 137 S. Ct. at 1035 (“The fashion industry has thrived against this backdrop.”). Professors Raustiala and Sprigman have persuasively argued that “piracy is paradoxically beneficial to the fashion industry” (even if that is not the case for individual designers) because the pressure of copycat designs fuels trends and leads to quick innovation. Kal Raustiala & Christopher Sprigman, Response, *The Piracy Paradox Revisited*, 61 STAN. L. REV. 1201, 1203 (2009) [hereinafter Raustiala & Sprigman, *Piracy Paradox Revisited*]; see also Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1717–35 (2006) (arguing that design copying contributes to induced obsolescence and helps anchor trends). But see Hemphill & Suk, *supra* note 117, 1170–1184 (adopting a different approach to fashion trends and arguing that a degree of copyright protection is helpful to emerging designers); Susan Scafidi, *F.I.T.: Fashion as Information Technology*, 59 SYRACUSE L. REV. 69, 87–90 (2008).

sui generis fashion IP.¹¹⁹ Although fabric designs have historically been considered copyrightable, and although some elements of fashion could achieve copyright protection¹²⁰ under prior separability standards, it is likely that fashion lawyers will see *Star Athletica*'s standard as offering enhanced copyright protection for fashion. Fashion lawyers have dismissed design patents as too expensive and lengthy a process for realistic protection at a time of instantaneous copying of fashion designs and have also doubted copyright's ability to solve the problem of fashion copying under pre-*Star Athletica* interpretations of the separability standards.¹²¹ For them, *Star Athletica* could be seen as a godsend. During oral argument in the case, Justice Sotomayor suggested the conclusion that finding separability there would "kill" the knockoff industry.¹²² The majority opinion did not even address that eventuality or whether such a result would be a good or bad thing. Justice Breyer in dissent asserted that "a decision by this Court to grant protection to the design of a garment would grant the designer protection that Congress refused to provide [and] would risk increased prices and unforeseeable disruption in the clothing industry."¹²³

Star Athletica does not necessarily dictate broad protection of fashion design, of course. The Court's standard would not automatically make any common combination of sewing elements copyright eligible. Moreover, the analogy to cheerleading uniforms is not apt enough to entail systematic overprotection on the analytic grounds that led to the majority's result in *Star Athletica*.¹²⁴ Still,

119. See, e.g., Dan Hunter & Suzannah Wood, *The Laws of Design in the Age of Mechanical Reproduction*, 37 ADELAIDE L. REV. 403, 406 & n.22 (2016); Raustiala & Sprigman, *Piracy Paradox Revisited*, *supra* note 118, at 1204–06; see also Charles E. Colman, *The History and Principles of American Copyright Protection for Fashion Design: A Strange Centennial*, 6 HARV. J. SPORTS & ENT. L. 225, 226 (2015).

120. See U.S. COPYRIGHT OFFICE, 2014 COMPENDIUM, *supra* note 73, §§ 924.3(A)(1)–(3).

121. See Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. 107, 123, 148 (2016); Elizabeth L. Rosenblatt, *A Theory of IP's Negative Space*, 34 COLUM. J.L. & ARTS 317, 352 (2011); see also Ralph D. Clifford & Richard J. Peltz-Steele, *The Constitutionality of Design Patents*, 14 CHI-KENT J. INTELL. PROP. 553, 591–92 (2015) ("[D]esign patents are cumbersome and expensive to prosecute, a matter up front for patent attorneys and product experts.").

122. Transcript of Oral Argument at 35, *Star Athletica*, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002 (No. 15-866), ("Justice Sotomayor: You're killing . . . knock-offs with . . . copyright. You haven't been able to do it with trademark law. You haven't been able to do it with patent designs. We are now going to use copyright law to kill the . . . knockoff industry. I don't know that that's bad. I'm just saying.").

123. *Star Athletica*, 137 S. Ct. at 1035 (Breyer, J. dissenting).

124. Fashion design is not really the same as cheerleading uniform design. Professors Hemphill and Suk, although they are on the other side of that debate, describe the ways in which fashion design enables individuals to simultaneously follow a trend and express their individuality. Hemphill & Suk, *supra* note 117, at 1164–68. Uniform designs, however, are

responses by lower courts are likely to vary. Some will doubtless read the separability test to protect many more elements of industrial design than would have been protected at least under some separability tests heretofore. The new separability could reverse the outcomes in some notable fashion cases. For example, the new standard could open up the possibility of copyright protection for the fabric draping of prom dresses found inseparable in cases like *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*¹²⁵ An examination of historic red-carpet dresses also demonstrates the possibility of expanded copyright protection.¹²⁶

different. They are designed to minimize the wearer's individuality and reflect a group aesthetic. Each cheerleader is a representative—an agent—of the school for which she or he cheers. Cheerleading uniforms, therefore, can benefit most not from change but from standardization and continuity. That continuity and standardization permits the building and dissemination or distribution of the school's brand over time. The school's identity is what is associated with the uniforms.

125. *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 549–50 (S.D.N.Y. 2011). In *Jovani Fashion*, the court had found that the dresses were not protectable because they served the function of enhancing the aesthetic appeal of the wearer. *Id.* at 550. (“Aesthetic appeal is a core purpose of a prom dress. Given the purpose of a prom dress, a design element’s decorative or aesthetic qualities will generally not suffice to trump its utilitarian function of enhancing the wearer’s attractiveness.”); see also *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 422 (5th Cir. 2005) (holding that creatively designed casino uniforms had no conceptually separable elements that would be marketable as such). It is of course possible that even courts concluding that the particular ruching or sequin arrangement of the prom dress designs in cases like *Jovani* would satisfy the first prong of the *Star Athletica* test might find that the second prong of the test is too high a hurdle. For a recent argument that the Court’s new test is unlikely to “make much of a difference” in most fashion cases but could change results in some prior mannequin and three-dimensional article cases and generate an increase in product shape copyright infringement claims, see David E. Shipley, *All for COPYRIGHT Stand Up and Holler! Three Cheers for Star Athletica and the U.S. Supreme Court’s Perceived and Imagined Separately Test*, 35 CARDOZO ARTS & ENT. L.J. (forthcoming 2018), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3032666 [<https://perma.cc/SU27-854S>].

126. Although Björk’s iconic Oscars swan dress would likely have passed muster under pre-*Star Athletica* separability jurisprudence, query whether the new separability test might lead to protection of other dresses as well. See Linda Sharkey, *Bjork’s Infamous Swan Dress Now Honoured at Moma Museum—Almost 15 Years Later*, INDEPENDENT (Mar. 16, 2015, 12:45 PM), <http://www.independent.co.uk/life-style/fashion/features/bjork-s-infamous-swan-dress-is-now-honoured-at-moma-museum-almost-15-years-later-10110915.html> [<https://perma.cc/6JPP-ERZR>]. Stella McCartney’s Octavia dress, worn by Kate Winslet at a film festival in 2011 and consisting of a *trompe l’oeil* hourglass figure design, might be copyrightable under the new standards, while probably uncopyrightable under a *Jovani* approach. See Marchese, *supra* note 115, at 399–408. Critics argue that permitting McCartney to protect the Octavia design with copyright would “monopolize all future dress designs that utilize colorblocking to slenderize the wearer’s form in the same way, which would greatly affect competition within the clothing apparel market.” *Id.* at 413. What about the beaded fringe in Emma Stone’s Givenchy dress or the chiffon design on the upper body and fringe at the calves in Halle Berry’s Versace Oscars gown? See Edward Barsamian, *Halle Berry Shut Down the Oscars Red Carpet in Custom Atelier Versace*, VOGUE (Feb. 27, 2017, 4:30 AM), <https://www.vogue.com/article/halle-berry-atelier-versace-lindsay-flores-oscars-2017-celebrity-red-carpet-fashion-style> [<https://perma.cc/BSE5->

Realistically, it is likely that the ultimate impact of *Star Athletica* in fashion litigation will be most evident in edge cases. But this does not mean that it will not have a major economic impact on the fashion world as a practical matter. The possibility of going to court for copyright infringement under a malleable standard adopted by a Court that rejects copyright policy as an interpretive tool means that fashion designers will likely deter copycats much more easily than heretofore. The degree of deterrence—or the extent of new licensing markets—is unknown, of course. Uncertain as well are speculations about which types of fashion designers and what sorts of designs will engage in copy-detering litigation.¹²⁷ There is a significant amount of uncertainty about the potential impact of the new separability test on designer incentives, and we should be careful not to attribute too much directive effect to *Star Athletica*. Creativity in design is likely to shift one way or the other for a variety of reasons, including—but not likely centrally—in response to legal rules. At a minimum, this is because *Star Athletica* does not articulate a principle with inevitable certainty in application. Still, the adoption of the *Star Athletica* standard will undoubtedly have an impact on the fashion participants' bargaining positions and the configuration of the industry.¹²⁸

Whatever its benefits in its factual context, a deceptively simple and uncertain unitary test creates incentives for opportunistic litigation, which is likely to expand the doctrine's boundaries over time. This push has already started in the fashion context with a pending lawsuit by Puma against Forever 21 over Rihanna's footwear designs.¹²⁹ The Puma case shows that what is at stake is not the

HZ5C]; *Oscars 2017: The Best Dressed Celebrities on the Red Carpet*, VOGUE (Feb. 27, 2017), <https://www.vogue.com/slideshow/oscars-2017-best-dressed-red-carpet-celebrity-fashion#5> [<https://perma.cc/7SG6-YKAM>].

127. Will it be the major fashion houses or the smaller, emergent designers who will benefit from the *Star Athletica* approach? See Madison, *supra* note 14.

128. Another concern with the Court's new test goes to whether it will have *sub-rosa* effects in channeling creativity in particular substantive directions in the types, genres, and characteristics of design in integrated works that will be created in the future. For example, will the possibility of copyright protection lead to less modernist and more baroque designs with more easily imagined stand-alone PGS elements? Will it lead the major fashion houses to reduce their reliance on logos and branding protected by trademark because they have a better protective alternative? See Susan Scafidi, *Intellectual Property and Fashion Design*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 115, 121 (Peter K. Yu ed., 2006) (arguing that the availability of trademark protection for logos increased their use in design). To the extent that fashion functioned with a low level of copyright protection until now, what impact will the availability of some additional (though uncertain) level of copyright protection have on the operations of the fashion industry? See Kaminski & Rub, *supra* note 69, at 1172–73.

129. See, e.g., *Puma Files Suit Against Forever 21*, *supra* note 15. Thus far, there are few post-*Star Athletica* cases citing the Supreme Court's decision. *But see*, e.g., *Design Ideas, Ltd. v.*

copyrightability of surrealist sculptural elements as in Elsa Schiaparelli's iconic hats and dresses.¹³⁰ Rather, today's claims are about bows or strips of fake fur applied to rubber slides. Whatever happens in the Puma case, it opens the door for other litigation pushing the doctrine to the extreme. When the separability test skews so much toward the protection of a fashion item's aesthetic features (regardless of their visual function), it changes the risk calculation with respect to litigation in this context.¹³¹

Even if aggressive readings of the new separability test will not inevitably lead to massive overprotection in application, there is the concern about how courts will in fact apply the unitary test outside of surface ornamentation contexts. All that is needed is a few courts to apply the *Star Athletica* standard to expand protection for attractive fashion or industrial design that would not have received copyright protection under prior doctrine. If they do so at an early stage, those decisions will potentially establish the outer—and more expansive—protection boundaries as the new normal.

IV. *STAR ATHLETICA*'S SAVING STRATEGY—PUNTING TO COPYRIGHT'S OTHER LIMITING PRINCIPLES

Before overreading *Star Athletica* and imagining its worst possible consequences, however, it is important to remember that the Court explicitly punted the ultimate questions about copyright protection downstream to other copyright doctrines. The *Star*

Meijer, Inc., No. 15-cv-03093, 2017 WL 2662473, at *1 (C.D. Ill. June 20, 2017). In *Design Ideas*, which involved the copyrightability of the Sparrow Clip (a clothespin with a silhouette bird design at the top), the court affirmed the summary judgment it had previously granted the plaintiff on the ground that the bird silhouette satisfied the *Star Athletica* standard for copyrightability. *Id.* Responding to the defendant's argument that the bird silhouette itself had a function because it could be hung from a rod or a string by its beak, the court asked "once the bird portion is removed from the clothespin, what is the usefulness of hanging the bird from a rod or hanging the bird on a string by its beak?" *Id.* at *3; see also *Jetmax Ltd. v. Big Lots, Inc.*, No. 15-cv-9597 (KBF), 2017 WL 3726756, at *1 (S.D.N.Y. Aug. 28, 2017) (finding that the decorative metal covers of decorative tear drop light sets satisfied *Star Athletica*'s separate identification and independent existence requirements as sculptural works); *Triangl Grp. Ltd. v. Jiangmen City Xinhui Dist. Lingzhi Garment Co.*, No. 16 Civ. 1498 (PGG), 2017 WL 2831025, at *1 (S.D.N.Y. June 22, 2017) (finding decorative black trim shaped like a "T" on bikinis to be copyrightable).

130. See *Elsa Schiaparelli: Fashion Meets Surrealism*, ZOOWITHOUTANIMALS, (May 14, 2013), <https://zoowithoutanimals.com/2013/05/14/elsa-schiaparelli-fashion-meets-surrealism/> [<https://perma.cc/C75W-FBAB>]. For some images of fashion designer Elsa Schiaparelli's surrealist clothing, see *id.*

131. See Vishwanath Kootala Mohan, *Star Athletica v. Varsity Brands: SCOTUS Cheers for Broader Copyright Protection*, ORANGE COUNTY LAW., July 2017, at 36, 40; Moskin, *supra* note 115, 786.

Athletica Court made clear that it was not ruling on the originality of the Varsity Brands designs but only on their separability.¹³² This indicates that the majority did not see itself as simply rubber-stamping a separability end run in order to invite a century of protection for banal functional articles. Query then whether copyright doctrines beyond separability serve to discipline the potential negative consequences of the Court's new separability test. Copyright policy strongly supports the proposition that copyright's limiting doctrines should be read to limit expansive protection of aesthetically designed functional works such as cheerleading uniforms.¹³³ But guideposts for how to do that are not provided in *Star Athletica*.

A. Exclusion Doctrines

A variety of limiting approaches are possible.¹³⁴ Originality could be interpreted more strictly in the context of useful works with aesthetic features. The exclusion doctrines of merger and *scènes à faire* as well as the prohibition on copyright protection for “idea[s], procedure[s], process[es], system[s], method[s] of operation, concept[s], principle[s], or discover[ies]”¹³⁵ could conceivably help stave off

132. See *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1012 n.1 (2017).

133. Legislative history indicates Congress's desire to keep even beautiful industrial design out of the realm of copyright. See, e.g., H.R. REP. NO. 94-1476, at 55 (1976), as reprinted in 1976 U.S.C.A.N. 5659, 5668; see also McKenna, *supra* note 72, at 128 (arguing that the Court in *Star Athletica* lost sight of the channeling function of the useful article doctrine).

134. See, e.g., Ghosh, *supra* note 5; cf. Buccafusco & Lemley, *supra* note 12, at 1296 (identifying filtering, exclusion, and threshold functionality screens used in IP doctrines); see also Pamela Samuelson, *Functional Compilations*, 54 HOUS. L. REV. 321, 324–26 (2016) (arguing that functionality does and should limit the copyrightability of compilations and that courts have used limiting doctrines such as those described in this Part to achieve that result).

There are also remedy-focused avenues potentially available as a guard against overprotection of function post-*Star Athletica*. A flexible approach that would reduce the issuance of injunctions in hybrid useful works cases might be fruitful. See Peter Lee & Madhavi Sunder, *The Law of Look and Feel*, 90 S. CAL. L. REV. 529, 585, 588–89 (2017) (suggesting that courts should not grant injunctions against competitors who use stock designs and should apportion damages); see also Orit Fischman Afori, *Flexible Remedies as a Means to Counteract Failures in Copyright Law*, 29 CARDOZO ARTS & ENT. L.J. 1, 2 (2011) (counseling flexibility as to remedy). In fact, since the Supreme Court affirmed that the traditional four-part test should apply to the issuance of injunctions in patent cases in *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006), the issuance of injunctions in IP cases has slowed. See H. Tomás Gómez-Arostegui, *Prospective Compensation in Lieu of a Final Injunction in Patent and Copyright Cases*, 78 FORDHAM L. REV. 1661, 1663, 1677 (2010) (noting this development but arguing that courts' substitution of prospective compensation for post-judgment copyright infringements in place of injunctions is not legislatively authorized); Christopher B. Seaman, *Permanent Injunctions in Patent Litigation After eBay: An Empirical Study*, 101 IOWA L. REV. 1949, 1952–53 (2016). Further elaboration of the remedy question is beyond the scope of this Article.

135. 17 U.S.C. § 102(b) (2012).

negative effects of overprotection in the separability context. Scope doctrines such as thin copyright—common in the compilation context—could step in as well. Filtering methodology used in assessing substantial similarity for infringement purposes in some functional contexts—such as computer software—would be easily adaptable to PGS elements in useful works. It is also worth exploring whether an enriched doctrine of copyright abuse or misuse could better address the anticompetitive concerns discussed above.¹³⁶ Finally, there is also the procedural issue of the level of deference courts should pay to Copyright Office registration decisions in the useful works context.¹³⁷

1. Originality

Copyright only attaches to “original works of authorship.”¹³⁸ The *Star Athletica* majority specifically reminded us that its opinion did not address whether Varsity Brands’ designs should be considered sufficiently original to be copyrightable.¹³⁹ The first question is whether copyright’s requirement of originality would limit copyright protection for functional items. Will lower courts apply originality standards more restrictively in order to avoid overprotection of PGS elements in useful articles?

The key issue will be whether courts will grant protection for original combinations of uncopyrightable visual elements for these kinds of common geometric shapes and color combinations. One could argue that Varsity Brands’ designs should not be deemed to contain sufficient originality because they consist of common geometric shapes and colors traditionally considered uncopyrightable. On the other hand, the Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co.* established a low standard of originality, at least in the context of factual compilations.¹⁴⁰ Although *Feist* requires some “creative spark,” compilations of very banal material were subsequently deemed to satisfy *Feist*’s requirements.¹⁴¹ Query

136. See *supra* text accompanying note 21 and *infra* Part V.B.

137. See discussion *infra* Part V.C.

138. 17 U.S.C. § 102(a).

139. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1012 n.1 (2017) (“We do not today hold that the surface decorations are copyrightable. We express no opinion on whether these works are sufficiently original to qualify for copyright protection, or on whether any other prerequisite of a valid copyright has been satisfied.” (citation omitted)).

140. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

141. *Id.* at 345. In *Feist*, the Supreme Court chose to reject the “sweat of the brow” doctrine and to assert the need for some level of creativity as a constitutional requirement. *Id.* at 359–60. *Feist* required some “creative spark[,]” but noted that “the requisite level of creativity is extremely low; even a slight amount will suffice.” *Id.* at 345, 359, 363. The Court did not find

whether the degree of creative spark in the cheerleader designs exceeds those precedents. There seems to be an implicit conflict between the views of the dissent and the concurrence as to this point, so the answer is unclear. The dissent confidently asserts that the Varsity Brands designs at issue would clearly be unoriginal.¹⁴² Yet Justice Ginsburg's concurrence responds to the dissent's assertion as to the lack of copyright originality in Varsity Brands' designs by reminding the Court of the low level of originality required for protection under *Feist*.¹⁴³

One possible argument for Star Athletica on originality would focus not on the creativity element of the requirement but on its origination aspect. Copyright will attach to works that owe their origin to the author and not to facts, discoveries, systems, or other things that do not trace their origins back to the author.¹⁴⁴ Thus, the argument would go, those aspects of Varsity Brands' designs that are dictated by the function of achieving optical illusions should not be considered elements that owe their origins to Varsity Brands. If the placement of triangles at the waist makes the wearer look like she has a thin waist and this audience perception results from something that does not owe its genesis to the author, then arguably it should not be considered sufficiently original—especially given the basic, building-block aspect of the visual elements. In other words, the designs are not original because they are dictated by function. Or in yet other words, is the work expressed “in the only way it *can* be expressed, where the choice is imposed on the author by necessity, not by any act of creativity”¹⁴⁵—as the result of determined causality? If designs are dictated by their biological effects on observers, should they be thought of as closer to discovered facts than authored works? In such circumstances, the features are arguably discovered, as are facts, rather than owing their existence to the author as originator. This

enough in the white pages at issue in *Feist* itself, largely because they were compilations of facts with commonplace arrangements (and perhaps because of their genesis in a state law requirement—not to mention their functionality). *Id.* at 362–63. By contrast, some post-*Feist* courts found yellow pages directories to be copyrightable as compilations. *See, e.g.*, *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters.*, 45 F.2d 509, 514 (2d Cir. 1991) (finding copyrightable plaintiff's classified business directory for New York's Chinatown).

142. *Star Athletica*, 137 S. Ct. at 1036 (Breyer, J., dissenting) (characterizing the design elements as “plainly unoriginal”).

143. *Id.* at 1018 n.2 (Ginsburg, J., concurring in the judgment).

144. *See* 17 U.S.C § 102 (2012); *Feist*, 499 U.S. at 347.

145. Dan L. Burk, *Method and Madness in Copyright*, 2007 UTAH L. REV. 587, 613 (2007) (emphasis added).

shifts the functionality issue from the separability context to the originality context.¹⁴⁶

2. Merger, *Scenes à Faire*, and the Prohibition on Copyright for Systems

Even if the designs are deemed sufficiently original not to be excluded for that reason, a variety of exclusion doctrines might provide overlapping techniques for limiting copyrightability of aesthetic elements in useful works. *Scenes à faire* doctrine, although variously articulated, deprives copyright protection from those “incidents, characters or settings which are . . . indispensable, or at least standard, in the treatment of a given topic.”¹⁴⁷ It places in the public domain “elements that are ‘necessary’ for expression, and necessity is defined by social practice.”¹⁴⁸ Under the merger doctrine, copyright protection is unavailable for expression when there are only one or a few ways of expressing an idea.¹⁴⁹ Also, Section 102(b) of the

146. Cf. Justin Hughes, *Created Facts and the Flawed Ontology of Copyright Law*, 83 NOTRE DAME L. REV. 43, 45 (2007) (addressing human-created facts and how merger doctrine should be amended to avoid rendering them uncopyrightable). There are, of course, significant drawbacks to this. For an elaboration of some constraints on the application of copyright’s other limiting doctrines to useful works contexts, see *infra* Part IV.C.

147. *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978); see also Leslie A. Kurtz, *Copyright: The Scenes a Faire Doctrine*, 41 FLA. L. REV. 79, 79–82 (1989) (describing history). Some of the other descriptions appear to narrow the scope of the doctrine beyond the breadth assumed in the above-quoted text. See, e.g., Murray, *supra* note 19, at 794 (describing the doctrine as one that denies copyright protection to “common elements of work that are essential to the presentation of the subject matter of a work”). Whatever the specific definition, the *scenes à faire* doctrine “relegates items to the public domain as they become stock and standard infrastructure.” Peter Lee, *The Evolution of Intellectual Infrastructure*, 83 WASH. L. REV. 39, 58–62 (2008).

148. Lee, *supra* note 147, at 84. The doctrine “recognizes that” however it starts, “expression[] can become basic infrastructure” and therefore shift into the public domain. *Id.* at 83.

149. Pamela Samuelson, *Reconceptualizing Copyright’s Merger Doctrine*, 63 J. COPYRIGHT SOC’Y U.S.A. 417, 417 (2016) (stating that under the merger doctrine, copyright will not protect the expression of an idea when “that idea is incapable of being expressed, as a practical matter, in more than one or a small number of ways”); see also Burk, *supra* note 145, at 589. Professor Samuelson’s survey of merger cases revealed that “[m]erger of idea and expression is usually found when courts become convinced that both the plaintiff and the defendant had few expressive alternatives when developing the works at issue.” Samuelson, *supra*, at 442. This can happen not only when the author of the first work has limited alternatives but also when her design choices thereafter constrained the expression available to the defendant. *Id.* at 443. Although merger and *scenes à faire* have similarities and sometimes overlap, Professor Samuelson has explained their fundamental difference. *Id.* at 447–48 (“With merger, the core issue is whether there are, practically speaking, more than a few alternative ways to express particular ideas or functions. The core issue in *scenes à faire* cases, by contrast, is whether certain elements in common between two works are indispensable in works of that kind, common in the industry, or otherwise to be expected in works of that kind.”).

Copyright Act affirms the consistent doctrine since *Baker v. Selden*¹⁵⁰ that systems, processes, and methods of operation are excluded from copyright.¹⁵¹

There are good arguments for why these doctrines could serve to police against overexpansion of protection in PGS-in-useful-works contexts. For example, Professor Samuelson has recently catalogued the merger doctrine in operation in copyright and argued that the doctrine serves as an important limiting principle in US copyright law.¹⁵² She found that merger defenses “met with considerable success in functional work cases.”¹⁵³ Her study led to the conclusion that the doctrine applies to copyrightability as well as scope,¹⁵⁴ and she urged courts not to construe the doctrine too narrowly. Professor Burk has similarly characterized separability in the useful article doctrine as “a type of merger rule for functionality.”¹⁵⁵ Merger might be particularly apt in circumstances—such as that in *Star Athletica* itself—in which one competitor has obtained so many copyright registrations covering a particular kind of style that very few other ways to express the idea are left for others to employ. Merger’s goal of promoting meaningful competition makes it an appropriate tool in the useful works context.¹⁵⁶

Similarly, *scenes à faire* doctrine could well apply when particular kinds of simple visual designs have become standard elements inevitably expected by the audience in a particular context.

Alternatively, if defendants in particular cases are persuasively able to argue that the elements at issue constitute a process, system, or method of operation, Section 102(b) of the Copyright Act can serve to limit their copyrightability.¹⁵⁷ Indeed, the prohibition of copyright for systems and “processes is intimately bound up with the prohibition on copyright for functional or useful articles.”¹⁵⁸ If, for example, the goal of the particular placement of visual elements on a garment is to

150. *Baker v. Selden*, 101 U.S. 99, 102–03 (1879).

151. See Pamela Samuelson, *Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection*, 85 TEX. L. REV. 1921, 1921–23 (2007).

152. Samuelson, *supra* note 149, at 418, 467.

153. *Id.* at 428; see also *id.* at 419 n.11, 438–42 (showing in caselaw that “idea/expression merger is not the only kind of merger”).

154. *Id.* at 437–38.

155. Burk, *supra* note 145, at 591. Indeed, Professor Burk suggests that “[t]he constraint on alternatives signals the presence of functionality.” *Id.*; see also Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493, 1524 n.175 (2017). For a reading of the merger doctrine that finds it at least partly motivated by evidentiary concerns, see Lichtman, *supra* note 85, at 737.

156. See Samuelson, *supra* note 149, at 459–61.

157. See 17 U.S.C. § 102(b) (2012).

158. Burk, *supra* note 145, at 592.

achieve a particular visual effect determined by scientifically defined optical illusions, then one might reasonably call that a process.

B. Infringement Doctrines—Thin Copyright and Filtration

If an infringement claim has not failed at the copyrightability or limiting doctrine stage, copyright's infringement doctrines could also be useful in deterring overprotection. For example, assuming that the PGS designs in a useful work have sufficient creative spark to be considered minimally original, it is still possible that—as in many functional compilation contexts—courts would grant them merely thin copyright protection. This would limit possible findings of infringement even if the defendant's works looked similar. In the context of copyrighted factual compilations, for example, the owner of the copyright is deemed to have thin protection; another use of the underlying facts, but not their exact compilation, will not lead to liability for infringement.¹⁵⁹ This essentially limits the derivative rights of the owner of a copyright in the compilation of facts. In cases like *Star Athletica*, where the plaintiff was effectively seeking copyright for compilations of otherwise basic and common shapes and lines—and where it had registered multiple copyrights for designs covering the field of such shapes in the cheer context¹⁶⁰—a finding of thin copyright protection could well have let *Star Athletica* off the hook for infringement.¹⁶¹ This is because most courts interpret the infringement standard in thin copyright cases as virtual identity.¹⁶²

159. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991). The Court in *Feist* explained that

facts themselves do not become original through association. . . . [T]he copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.

Id.

160. See discussion *infra* Part V.

161. See Samuelson, *supra* note 134, at 330–31 (noting that compilations have only a thin scope of protection and that arguments based on similarities in the look and feel of a second-comer's compilation are likely to fail).

Of course, Varsity Brands would argue that it was not simply compiling preexisting obvious and basic shapes but was exercising aesthetic discretion in placing surface designs in particular fashions. For a similar difference in opinion on the degree of originality in photographs, compare Terry S. Kogan, *How Photographs Infringe*, 19 VAND. J. ENT. & TECH. L. 353, 399 (2017), with Justin Hughes, *The Photographer's Copyright—Photograph as Art, Photograph as Database*, 25 HARV. J.L. & TECH. 339, 342 (2012).

162. For a critique of this understanding of thin copyright, see 3 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 9:95 (2017).

Moreover, particularly in certain contexts, courts will assess similarity between the plaintiff's and defendant's works after filtering out public domain elements. In infringement analysis involving functional compilations such as software programs, for example, standard elements or elements required by the technology or the market are often filtered out in the assessment of substantial similarity.¹⁶³ Admittedly, courts in non-functional works contexts have refused to filter out uncopyrightable elements and have sought to protect even the overall look and feel of the works at issue.¹⁶⁴ But in expressive works that are fundamentally functional, the functionality has led courts to adopt filtering infringement analyses.¹⁶⁵ Such filtering-based substantial similarity assessments would be particularly apt in useful works separability cases.

C. Constraints

Of course, questions remain both as to the application of such doctrines and as to selections among them. Each of the doctrines has its own limits. There are existing tensions and inconsistencies within the limiting doctrines themselves. Addressing those in turn requires normative judgments about what does and does not fit. Yet another challenge is the need to compare the various safety nets and calibrate them. Are there reasons to prefer one or another of these approaches in attempts to limit the potential consequences of the new separability? Do different limiting doctrines do better work in different sorts of useful works contexts? They may not all be equally advisable in every context involving aesthetic elements associated with useful works.¹⁶⁶ How and on what basis should courts choose the relevant limiting doctrines?

163. See, e.g., *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2d Cir. 1992); see also Samuelson, *supra* note 134, at 350; Pamela Samuelson, *Functionality and Expression in Computer Programs: Refining the Tests for Software Copyright Infringement*, 31 BERKELEY TECH. L.J. 1215, 1220 (2016). For a view that the process of filtration is similar to the separability analysis, see Ghosh, *supra* note 5, at 98.

164. See, e.g., *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970); see also Lee & Sunder, *supra* note 134, at 532.

165. See, e.g., *Altai*, 982 F.2d at 706–12 (articulating an “abstraction-filtration-comparison” test for software infringement cases).

166. Samuelson, *supra* note 151, at 1924, 1976 (recognizing the need to assess comparative doctrinal fit when explaining that even if merger and *scenes à faire* could be stretched to justify excluding copyright in particular contexts of functional expression, the prohibition of copyright for systems, processes, and methods of operation might be a better and more direct doctrinal route).

These doctrines will not necessarily be applied to forestall overprotection.¹⁶⁷ The argument as to lack of originality is probably the least likely to succeed given the low threshold required for originality. There are significant drawbacks to the origination argument, however, not the least of which is that it has no natural stopping point. This can be seen most clearly in the more extreme version of the argument: the claim here would be that courts should find a failure of origination when aesthetic elements are wholly dictated psychological characteristics of the audience or even cultural imperatives. This would be quite a stretch of the originality doctrine.¹⁶⁸

As for the merger doctrine, its applicability depends on how broadly or narrowly a court defines the idea or function and its possible expressive alternatives.¹⁶⁹ Once the doctrine is expanded beyond circumstances in which there is only one way to express an idea, a normative theory is needed to choose when there are too few expressive options to justify enclosing them in a property regime. Some merger cases explicitly avow that applying the doctrine depends on underlying policy decisions.¹⁷⁰ In addition, as Professor Ginsburg has recently pointed out, the separability threshold “will in most cases set a higher bar than the idea/expression ‘merger’ doctrine.”¹⁷¹

Similarly, *scenes à faire* doctrine depends on prior assessments of what makes something so stock or so standard that its ownership should not be granted to one author. Where in the line between abstract description and fully realized individuation do we draw the line as to standardized building blocks? Moreover, some courts use the merger and *scenes à faire* doctrines in determining copyrightability, whereas other courts conceive of them as defenses to

167. See Samuelson, *supra* note 149, at 446–47. It is beyond the scope of this Article to address the question of copyright doctrine overlaps more generally. Professor Samuelson’s study of merger indicates that “[c]ourts sometimes perceive the other doctrines as overlapping with merger, but in some cases, courts invoke multiple doctrines when seemingly unsure which doctrine would provide the soundest grounding for the court’s decision.” *Id.*

168. For an argument that “a definitive account of originality as a legal construct is not possible,” see Eva Subotnick, *Originality Proxies: Toward a Theory of Copyright and Creativity*, 76 BROOK. L. REV. 1487, 1490 (2011).

169. See Shahshahani, *supra* note 5, at 890 (“The merger doctrine itself is hardly a model of precision.”). The framing of the idea or function will determine the outcome. See *id.* at 890–91.

170. See *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678–79 (1st Cir. 1967). According to Professor Samuelson’s extensive study of merger cases, *Morrissey* has been “widely followed in subsequent case law.” Samuelson, *supra* note 149, at 427.

171. Ginsburg, *supra* note 4, at 2–3.

infringement claims.¹⁷² Consider also whether critiques of attempts to apply core copyright doctrines developed in literary contexts to visual works would also apply here.¹⁷³

As for Section 102(b), because the Copyright Act does not define the terms of the exclusion, much will depend on whether and how a court defines the useful article's PGS elements. For example, some courts might deem it too far a stretch of the Section 102(b) exclusion to conclude that designs that seek to affect audience perception by taking advantage of optical illusions should be considered systems, processes, or methods of operation precluded from copyright for *Baker v. Selden* reasons.¹⁷⁴

With respect to the infringement doctrines, although thin copyright and the use of a filtering approach to similarity would be helpful to limit infringement findings in useful works cases, the prospect of a lengthy and expensive infringement trial would surely have a chilling effect on potential defendants. So the major question here is whether courts would be disposed to grant summary judgment for defendants on infringement grounds before requiring the expense and uncertainty of a trial on infringement.

In addition, choices among these possible saving doctrines cannot be made acontextually or in the abstract. Obviously, the facts will matter. Even so, the distinctions will not be inevitable. In the cheer uniform context, for example, might the merger doctrine be a better fit than *scenes à faire* because there are only so many ways to make cheerleader uniforms that take advantage of perceptual tricks? Or is *scenes à faire* a more useful doctrine once a certain style of uniform has come to be expected by the audience?¹⁷⁵

The *Star Athletica* Court's apparently insouciant belief that any problems caused by its separability approach could easily be fixed elsewhere in the IP regime does not look hard enough at the question.

172. See Kogan, *supra* note 161, at 379 & nn.126–29; see also Samuelson, *supra* note 149, at 435–38 (citing cases in which merger was a copyrightability issue and not just an infringement defense).

173. See, e.g., Kogan, *supra* note 161, at 356, 388–89 & nn. 172–84 (citing judicial and scholarly doubts that core copyright doctrines such as the idea-expression dichotomy, *scenes à faire* doctrine, and merger fit when applied to visual works).

174. See Samuelson, *supra* note 151, at 1976 (“Without a richer conception of what § 102(b) excludes from copyright protection and why such exclusions are sound, there is a serious risk that courts will construe the scope of copyright too broadly . . .”); see also *Baker v. Selden*, 101 U.S. 99 (1879).

175. Samuelson argues that there are ways to channel different cases to merger or *scenes à faire*: “Merger is the more appropriate doctrine to apply when design choices are ‘dictated by’ . . . external factors. *Scenes à faire* is the doctrine that is most appropriate when common element similarities are to be expected in works of that kind.” Samuelson, *supra* note 149, at 450. Where *Star Athletica*'s facts fit in that characterization is not clear, however.

It would not be paranoid to be concerned that the judicial and legislative expansion of copyright protection in recent years on many fronts would suggest only equivocal interest in robust interpretations of copyright limits. Specifically, there are two competing doctrinal principles tending toward overprotection despite the limiting theories explored above: the judicial protection of total concept and feel,¹⁷⁶ and the availability of robust and expanding derivative works rights.¹⁷⁷ In practice, these doctrines can, in combination, lead to copyright protection of the underlying useful works through the device of protecting their incorporated PGS features. That is precisely what both the majority and the dissent disclaimed doing, and what Section 113 of the Copyright Act addresses,¹⁷⁸ but the majority's insensitivity to the ways in which separability analysis relates to the rest of copyright's doctrines invites such end runs.

In sum, a granular approach to assessing the practical usefulness of these saving doctrines will be necessary after the "new separability." But what doctrines lower courts should interpret in ways that promote the best aspects of *Star Athletica's* separability analysis while avoiding its greatest dangers is likely to be a complicated question in practice.

V. *STAR ATHLETICA'S* LEAST EVIDENT PERIL: THE MULTIPLE REGISTRATION PROBLEM

Even if the new *Star Athletica* standard would be reasonable in application to many individual PGS features applied to useful articles, and even if copyright's other limiting doctrines could successfully winnow out the most unoriginal of those designs, *Star Athletica* presents a deeper problem. Both the new separability test and copyright's other limiting doctrines will be applied to determine the copyrightability of *individual* designs in infringement cases. Regardless of how reasonably the new separability test will be applied

176. For a critique of copyrightability based on total concept and feel, see, for example, Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's 'Total Concept and Feel'*, 38 EMORY L.J. 393, 397–98 (1989).

177. See 17 U.S.C. § 106(2) (2012). This adaptation right, as defined, is extremely broad: "A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted." *Id.* § 101.

178. *Id.* § 113(a) ("Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise."); see also *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1012 & n.1; *id.* at 1036 (Breyer, J., dissenting).

in such future cases, and regardless of how well copyright's other limiting doctrines will be deployed to ward off overprotection in individual instances, the less visible but more challenging threat is now posed by strategies—like that of Varsity Brands¹⁷⁹—to register hundreds of variations in types of designs. At least in some markets, the *aggregate* effect of all those registrations may be to exhaust the design alternatives available to competitors in the manufacture of the useful works in which the designs are incorporated.¹⁸⁰ Such anticompetitive strategies are contrary to the congressional goal of using copyright to protect only applied art. Were copyright to protect industrial designs, no matter how attractive, Congress worried that competition in the markets for the useful works themselves could be diminished.

A. Competition and Aggregate Anticompetitive Effects

Scholars have identified one policy underlying the functionality doctrines in IP as the need to protect the domain of utility patent and to ensure that copyright not be used to obtain backdoor utility patents without patent examination.¹⁸¹ Yet another policy possibility

179. *Star Athletica*, 137 S. Ct. at 1007 (majority opinion) (noting that Varsity Brands had “obtained or acquired more than 200 U.S. copyright registrations for two-dimensional designs appearing on the surface of their uniforms and other garments.”).

180. Cf. Gideon Parchomovsky & R. Polk Wagner, *Patent Portfolios*, 154 U. PA. L. REV. 1, 77 (2005) (arguing that the value of patents today lies not in individual patents, but in “their aggregation into a collection of related patents—a patent portfolio”). Parchomovsky and Wagner explain that such patent portfolios give the holder the dual benefits of the right to exclude and the bounded diversity of the individual patents in the portfolio. *Id.* at 31. They also note that tailoring antitrust law might help “to curb the potential anticompetitive effects” on small firms of large patent portfolios held by large businesses. *Id.* at 71–72.

181. See, e.g., McKenna & Sprigman, *supra* note 72, at 492–93. “[E]very other area of IP understands its own domain to some extent in negative relation to utility patent.” *Id.* at 492. Otherwise, a useful work could have used its aesthetics to achieve over a hundred years of protection (instead of the far shorter protections under utility or design patent law) without having to go through any rigorous and substantive examination of its non-obviousness and novelty. Separability doctrine in copyright, then, can be interpreted as a channeling doctrine designed to shunt useful works toward utility patent and art toward copyright. See, e.g., *id.* at 492, 494, 498; Moffat, *supra* note 22, 1474–75; Samuelson, *supra* note 155, 1494–96 (addressing the ways courts have dealt with the copyright-utility patent overlap problem). Without that, overlapping IP protections could all too easily undermine the patent bargain adopted in the public interest.

Critics of *Star Athletica* worry that a separability standard focused on the integrity of PGS elements regardless of their contribution to the useful work's function will inevitably lead to material amounts of overprotection under copyright law and overblurring of the boundaries between copyright and patent. See, e.g., Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 89 (“Granting copyright protection to these designs would enable Varsity to monopolize functional aspects of garments without satisfying the exacting demands of patent law.”); Buccafusco & Lemley, *supra* note 12, 1295. On a critical view, because the Court focuses only on

applicable to PGS elements of useful articles is the Congressional concern about competition in the market for consumer goods and useful articles offers.¹⁸² One way to phrase the competition question is to ask whether competitors would be unable to compete fairly in the market for the underlying useful article if they could not use its PGS elements. Another is to ask whether the plaintiff's market dominance or its IP strategy would create material competitive barriers.

The Court in *Star Athletica* did not make anything out of the fact that Varsity Brands had registered two hundred designs representing variations on the theme of lines, zigzags, and chevrons as designs for cheerleader uniforms. When should a court conclude that the aggregate effect of multiple copyright registrations could undermine Congress's procompetitive rationale for prohibiting

the aesthetic elements and attempting to imagine them on their own, and does not address how those features—if they actually enhance the function of the underlying useful article—become functional as a result of their integration into the functional object, it misses what Congress was actually trying to do by insisting on the separation of applied art and industrial design.

To be sure, the channeling approach depends on each overlapping protective regime having a clear understanding of the domain of utility patents. See McKenna & Sprigman, *supra* note 72, at 494 (“Lack of a clear sense of utility patent law’s boundaries undermines the very idea of channeling.”). It has been criticized for a narrow interpretation of the scope of utility patent as focused on technological utility. *Id.* at 499. Moreover, the rationales for channeling are not necessarily the same with respect to all aspects of IP. In other words, if the worry is about avoiding the use of copyright to give useful works backdoor utility patents for the useful articles themselves—giving copyright to a beautiful shovel whose engineering does not deserve patent protection—how are courts to deal with the design patent regime? Are the bases for channeling between copyright and utility patent the same as the bases for channeling between copyright and design patent? The Court in *Star Athletica* reaffirmed that both protective regimes could be available for the same PGS work. *Star Athletica*, 137 S. Ct. at 1015.

Even with respect to utility patents, when will aesthetics perform certain kinds of functions that pose a significant threat of backdoor patents? Presumably, the backdoor patent problem arises if the design is necessary to the function and, therefore, using the design monopolizes the function even if the function could not properly have been granted utility patent protection. Justice Thomas might ask, “Why would giving copyright protection to separable PGS elements of useful works necessarily end up according patent-like protections to the useful work without the benefits of patent examination?” Both the Copyright Act and the Supreme Court clearly state that allowing copyright for separable PGS features of aesthetic articles does not bring along with it a copyright in the underlying, unseparated utility. 17 U.S.C. § 101; see *Star Athletica*, 137 S. Ct. at 1010. In *Star Athletica* itself, both the majority and the dissent fully agreed that considering a car model separably copyrightable would in no way grant the owner of that copyright a right to monopolize the manufacture of the underlying useful article—the car. It would only guard against reproduction of the design elements onto the car. *Id.* at 1010; *id.* at 1030 (Breyer, J., dissenting). So the intuition must be that sometimes, the integrated aesthetic elements will inevitably bring the useful work itself into the copyright fold. Even though that would not always be the case, the policy of policing the boundaries of the various IP regimes is a useful reminder to check.

182. Market dominance could lead to the predictable harms of monopoly in pricing and availability and, at a minimum, require competitors to engage in unnecessary variations in order to compete.

copyright in useful articles? In oral argument in *Star Athletica*, Justice Sotomayor asked whether protection would ensure that schools are “stuck with you [Varsity Brands] being their only supplier of their school colors for the rest of their existence.”¹⁸³ This issue too was not mentioned in the final opinion. Should it have been?

When a particular aesthetic style—particularly one that combines basic building block visual elements—has become associated with a particular product and manufacturer, and that style has come to be expected by the audience, then protecting the style by copyright can effectively give the manufacturer a monopoly in the manufacture of the items bearing the style. In such circumstances, by monopolizing the visual standards (whether it generated them or simply identified and deployed them),¹⁸⁴ one participant can create significant barriers to competitive entry and deter beneficial innovation.¹⁸⁵ Even if that has been allowed in the copyright context via the protection of authors’ styles,¹⁸⁶ it is more dangerous in the context of some kind of useful works because copyright of style in certain types of contexts and industries brings with it the protection of the underlying functional work. Indeed, the hybrid expressive elements may themselves be functional—if function is defined broadly to include affecting particular ways in which the user is perceived.¹⁸⁷ Restricting access to aesthetic features can sometimes inflict competitive harm.¹⁸⁸ In industries and contexts where standardization is common or useful, one participant can monopolize the standards (whether it generated

183. Transcript of Oral Argument, *supra* note 122, at 33; see also *id.* at 32 (“Does the university that contracts with you know that they have to buy their uniform . . . from you for 99 years plus whatever? Every university that you sell these cheerleading uniforms to, do they know that under your copyright, they are stuck with you forever?”).

184. On the relevance of the plaintiff’s own activities in the trademark context, see Justin Hughes, *Cognitive and Aesthetic Functionality in Trademark Law*, 36 CARDOZO L. REV. 1227, 1230 (2015) (recommending that aesthetic functionality only be found by courts in trademark cases “when the product feature at issue triggers a positive cognitive, psychological, or aesthetic response among a substantial composite of the relevant consumers and that response predate[s] the trademark owner’s activities”).

185. See Lee & Sunder, *supra* note 134, at 532 (arguing that even though design law should protect elements of look and feel, it should remain cognizant of the ways in which “expansive intellectual property protection of design . . . can in fact erode innovation, competition, and culture itself”).

186. *Id.* at 539–40 (describing the sometimes-expansive protection of total concept and feel in copyright and citing to relevant authority).

187. For this argument in the garment context, see Buccafusco & Fromer, *Fashion’s Function*, *supra* note 12, at 52–53.

188. Mark P. McKenna, *(Dys)functionality*, 48 HOU. L. REV. 823, 847 (2011); see McKenna & Strandburg, *supra* note 71, at 25.

them or simply identified and deployed them) and create barriers to entry and beneficial innovation.¹⁸⁹

The problem is that an acontextual, bright-line rule excluding copyright because of the inseparability of PGS features would overread the constraints on market entry in such circumstances. Where there are true network effects (such as in the classic case of telephony), or standardization is driven in large part by transactions and switching costs (as with computer software),¹⁹⁰ this kind of argument is very persuasive. Similarly, if audience or user expectations are clearly set for external reasons—cultural, religious, technological, or otherwise—and clearly hard to change, then it is reasonable to worry about the extent to which new entrants could realistically compete if they did not have permission to use what is competitively necessary.¹⁹¹ If, on the other hand, standardization is not fundamentally necessary and switching costs are low, then this argument for inseparability and exclusion is not persuasive. Customer expectations are changeable and people switch for reasons of cost and convenience in many circumstances.

It is worth trying to apply this notion to the uniform designs in *Star Athletica* itself because the facts invite competing narratives on the issue.¹⁹² On the one hand, Varsity Brands' aggregative copyright

189. Computer software is the paradigmatic example of an industry exhibiting network effects and switching costs. See, e.g., Samuelson, *supra* note 163, at 1237, 1284; see also *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 819–20 (1st Cir. 1995) (Boudin, J., concurring) (noting, in a case involving a claim of copyright in a computer program's menu command hierarchy, that the difficulty of switching from one program to another for users who have made an investment in learning the prior program and developed their own macros for it can pose a "concern with fencing off access to the commons in an acute form"), *aff'd by an equally divided Court*, 516 U.S. 233 (1996).

190. See *Lotus*, 49 F.3d at 810; see also Burk, *supra* note 145, at 591 (describing *Lotus* as an example of "functionality merger" because of standardization and switching costs); Samuelson, *supra* note 149, at 466.

191. The much-criticized aesthetic functionality doctrine in trademark law, see Hughes, *supra* note 184, at 1229 and sources cited therein, appears to be motivated by the same sort of competition-protecting concern. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 169 (1995) ("The functionality doctrine . . . protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely, their inability reasonably to replicate important non-reputation-related product features."). The typical non-reputation-related disadvantage has been described as a situation in which the product features in question amount to a "competitive need" with less favorable alternative options. *Id.* at 166; see also Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 96; McKenna, *supra* note 188, 829–30; McKenna & Strandburg, *supra* note 71 at 25.

192. Was *Star Athletica* a plucky new entrant trying to break the market leader's arbitrary and excessive pricing in the public interest? Or was it the poster child for infringers, helmed by a former employee of Varsity Brands determined to crush and replace its competitor by an offensive use of copyright-limiting doctrines? Conversely, was Varsity Brands a rapacious monopolist which bought out all its competitors, achieved market power in a multimillion-dollar

strategy could capture virtually all geometrically shaped and optical illusion-laden designs and diminish (if not eliminate) competitors' ability to use similar basic geometric and color forms in their uniforms. Competitors would have to come up with significantly different types of looks and shift the standardized aesthetic character expected by sports audiences. Such a result would seem directly contrary to congressional intent.

On the other hand, the cheerleading uniform market may be quite different from the computer software market with respect to network effects and high switching costs.¹⁹³ There is nothing that requires cheerleading to be exclusively identified by the Varsity Brands kind of uniform design style. Assuming schools or cheerleaders buy cheerleading uniforms yearly, the switching costs are likely to be minimal. Indeed, there may be reputational advantages to a school donning uniforms markedly distinguishable by factors other than the school colors themselves. Moreover, history reflects that over the years, cheerleader uniforms have changed (and at one point had no ornamentation or design other than the reference to the relevant school).¹⁹⁴ Still, it is possible that the cultural expectations of cheerleading today firmly reflect certain sorts of appearance requirements that can only be achieved by the use of certain kinds of visual tricks. And it is also possible that, cognitively and perceptually, there are a limited number of ways to achieve these visual effects. Under such circumstances of constraint and aesthetic scarcity, giving copyright protection to the underlying elements necessary to achieve those visual tricks could make it very difficult (if not impossible) for new entrants to compete. Obviously, a number of contestable assumptions underlie that conclusion. In addition to the gendered and mutable character of claims about appearance expectations, one might wonder at how firmly fixed in stone they are. Similarly, one might question the precise degree to which ways to achieve particular visual effects are truly limited.

This is not to weigh in on one side or the other in the particular context of cheerleading uniforms. It is, rather, to suggest that when the justification for rejecting copyright protection for otherwise copyrightable PGS features is based on concerns about competition policy, the wisest course would not be blanket exclusion in the

market, and sought to use copyright law to enforce its monopoly? Or was it a copyright owner properly fighting against in-your-face IP theft?

193. See *supra* notes 189–90 and sources cited therein.

194. See, e.g., Jessica, *The Evolution of Cheerleading Uniforms*, OMNI CHEER (Apr. 19, 2011), <http://www.omnicheer.com/blog/post/the-evolution-of-cheerleading-uniforms> [https://perma.cc/5XWY-QWZ9] (describing the uniforms' evolution).

abstract. Instead, a richly contextual account would be more likely to reveal the right balance in any given case. The question, then, should be whether the party seeking copyright protection in its PGS elements is actually deterring competition by monopolizing the look and feel of the relevant context. A case-by-case approach, with showings of actual anticompetitive effects and possible deployment of copyright misuse-type rules—rather than blanket exclusions assuming anticompetitive market harm—would be more likely to bear fruit. Ultimately, even with respect to concerns about anticompetitive uses of copyright to enhance market power in commodity markets, the most practical approach would be to call for granular, fact-specific inquiries into the impact of copyright protection on competition in cases involving separability questions. Such individualized, industry-by-industry inquiry was wholly missing from *Star Athletica*.

*B. Framing Aggregative Registration Strategies as Copyright Abuse?*¹⁹⁵

One way to address the threat of aggregate harm from use of multiple copyright registrations for similar designs on useful articles is with a theory of copyright abuse. But what should count as “abuse” of copyright? The Copyright Act is silent on the issue.¹⁹⁶

There is an existing judge-made doctrine of copyright misuse parallel to patent misuse and already recognized in numerous jurisdictions.¹⁹⁷ Could *this* be the appropriate vehicle to discipline aggregative registration strategies in useful works contexts? Copyright misuse is an equitable doctrine under which defendants can avoid infringement by pointing away from their own behavior to the inequitable conduct of the copyright owners.¹⁹⁸ However, “much uncertainty engulfs the ‘misuse of copyright’ defense[.]”¹⁹⁹ it is not

195. I use the term “abuse,” rather than “misuse,” because the specific type of copyright owner behavior addressed here has not, to my knowledge, been addressed explicitly in cases referring to the existing copyright misuse doctrine.

196. John T. Cross & Peter K. Yu, *Competition Law and Copyright Misuse*, 56 *DRAKE L. REV.* 427, 455 (2008).

197. See, e.g., Haris Apostopoulos, *The Copyright Misuse Doctrine on Computer Software: A Redundant Doctrine of U.S. Copyright Law or a Necessary Addition to E.U. Copyright Law?*, 24 *J. MARSHALL J. COMPUTER & INFO. L.* 571, 572–73 (2006); Neal Hartzog, *Gaining Momentum: A Review of Recent Developments Surrounding the Expansion of the Copyright Misuse Doctrine and Analysis of the Doctrine in Its Current Form*, 10 *MICH. TELECOMM. & TECH. L. REV.* 373, 378–99 (2004).

198. Laura A. Heymann, *The Trademark/Copyright Divide*, 60 *SMU L. REV.* 55, 90, 91 (2007).

199. *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 973 (4th Cir. 1990).

fully developed and has been criticized for lacking coherence.²⁰⁰ The doctrine's rationale and scope are contested. Should the scope be coextensive with antitrust, or should it apply in contexts in which antitrust law would not find any cognizable competitive harm?²⁰¹ If simply duplicative of antitrust, why is the doctrine even necessary? Even if the doctrine has a rational basis in the patent context in which it was born, does it have a rationale in the copyright area?

Further, the existing copyright misuse doctrine does not seem to have yet been applied in hybrid useful works contexts where an aggregative copyright strategy is used to constrain competition. *Should* it be considered copyright misuse to use the copyright registration process for anticompetitive purposes in product markets? The argument would be that copyright misuse claims should lie when what would in each individual instance constitute technically proper uses of copyright registration in fact end up, in the aggregate, posing threats to copyright policy and the balance of the copyright system. When the aggregate registration strategy can effectively lead to granting copyright to functional innovations, copyright misuse may well be an appropriate judicial safeguard.²⁰² Under this kind of approach, a court might find copyright misuse even if the conduct

200. Among scholarship addressing copyright misuse and taking contrasting positions on its standards, see, for example, 1 HERBERT HOVENKAMP ET AL., *IP AND ANTITRUST: AN ANALYSIS OF ANTITRUST PRINCIPLES APPLIED TO INTELLECTUAL PROPERTY LAW* § 3.04 (3d ed. 2016); Christina Bohannon, *IP Misuse as Foreclosure*, 96 IOWA L. REV. 475, 489–506 (2011); Thomas F. Cotter, *Misuse*, 44 HOUS. L. REV. 901, 925–26 (2007); Brett Frischmann & Dan Moylan, *The Evolving Common Law Doctrine of Copyright Misuse*, 15 BERKELEY TECH. L.J. 865, 868–871 (2000); Laura A. Heymann, *Overlapping Intellectual Property Doctrines: Election of Rights Versus Selection of Remedies*, 17 STAN. TECH. L. REV. 239, 269–70 (2013); see also Samuelson, *supra* note 149, at 454–55 (noting that judicial reference in merger cases to concerns about unwarranted monopolies suggests some degree of overlap between merger and copyright misuse, although the merger cases in the study did not rely explicitly on misuse).

201. See Bohannon, *supra* note 200, at 476–77 (describing misuse as a “schizophrenic doctrine that vacillates between IP and antitrust law”); Frischmann & Moylan, *supra* note 200, at 881 (describing two strands—public policy and antitrust—of copyright misuse circuit court jurisprudence). For an argument rejecting antitrust as a basis for copyright misuse, see, for example, David S. Olsen, *First Amendment Based Copyright Misuse*, 52 WM. & MARY L. REV. 537, 540 (2010) (arguing for the application of copyright misuse doctrine to uses of copyright designed to censor others’ speech).

The prime example of the public policy approach is *Lasercomb*, 911 F.2d at 978 (“[W]hile it is true that the attempted use of a copyright to violate antitrust law probably would give rise to a misuse of copyright defense, the converse is not necessarily true—a misuse need not be a violation of antitrust law in order to comprise an equitable defense to an infringement action. The question is not whether the copyright is being used in a manner violative of antitrust law (such as whether the licensing agreement is ‘reasonable’), but whether the copyright is being used in a manner violative of the public policy embodied in the grant of a copyright.”).

202. See Frischmann & Moylan, *supra* note 200, at 912 (discussing the analogous context of software).

would not clearly constitute violation of the antitrust laws. It would be enough to show interference with values of the IP system itself (including competition) or undermining channeling between the domains of copyright and patent.²⁰³ The question, of course, is how broadly to read those supra-antitrust and IP system goals. One possibility is a misuse claim for “any act by which a copyright owner attempts to expand its rights beyond the limits imposed by the Copyright Act should constitute misuse.”²⁰⁴ But this covers a potentially expansive category of conduct, and cautious scholars warn that although there is a place for copyright misuse doctrine, “assertions of misuse should be . . . rare.”²⁰⁵

Even if copyright misuse is expanded to cover aggregate effects of multiple copyright registrations in designs of useful articles, a theory of scope and limits will still be required. What kinds of competitive harms posed by the plaintiff's uses of the copyright registration system should be sufficient to trigger misuse claims? How many registrations should be deemed to trigger concern? At

203. See Bohannon, *supra* note 200, at 478 (arguing that copyright misuse should reach practices that undermine IP policies of encouraging innovation, promoting competition, and encouraging public access, regardless of whether such practices would violate antitrust law); Frischmann & Moylan, *supra* note 200, at 920–21 (focusing on the channeling issues at the copyright-patent interface); see also Cross & Yu, *supra* note 196, at 457 (noting that even if a copyright owner's activities might also satisfy antitrust law requirements, the behavior is considered copyright misuse if it is deemed an attempt to evade copyright policy).

Lasercomb might be seen as an analogy, though not a perfect one, to the useful works context. There, a copyright owner licensed its software, but its license contract prohibited the licensee from participating in any way in the development of any software that would compete with the licensor's software. *Lasercomb*, 911 F.2d at 978. Despite the *res ipsa* infringement revealed by the facts, the *Lasercomb* court found the plaintiff culpable under misuse doctrine and did not allow the plaintiff to prevail. *Id.* at 979. The copyright misuse resulted from the fact that the license agreement “essentially attempts to suppress any attempt by the licensee to independently implement the idea which [the licensor's program] expresses.” *Id.* at 978. The licensor abused its rights by “attempting to use its copyright in a manner adverse to the public policy embodied in copyright law.” *Id.* The *Lasercomb* court found the plaintiff at fault because it was attempting “to control competition in an area outside the copyright, *i.e.*, the idea of computer-assisted die manufacture,” by using contract to evade the idea-expression dichotomy central to the overall copyright scheme. *Id.* at 979.

204. Cross & Yu, *supra* note 196, at 457; see also Cotter, *supra* note 200, at 963 (suggesting that the trigger for copyright misuse should be whether the conduct broadens the scope of the grant of copyright); Frischmann & Moylan, *supra* note 200, at 889 (identifying misuse violating the public policy behind the IP grant as one, non-antitrust basis for per se copyright misuse rules). For those who are concerned about the potential breadth of the policy-based copyright misuse doctrine, an alternative that looks more directly at IP policy itself inquires whether “the IP holder engages in a practice that forecloses competition, future innovation, or access to the public domain.” Bohannon, *supra* note 200, at 478. While Bohannon claims these policies as IP policies, regardless of their role in antitrust, her examples do not reach the type of conduct at issue in *Star Athletica*.

205. Cotter, *supra* note 200, at 903.

what point will a copyright registrant be deemed to have effectively monopolized a style? According to what methodology does one determine whether the copyright owner's registration practices have tipped the balance toward misuse? The current doctrine has not yet addressed this issue.

It is also important to remember that copyright misuse is an equitable defense available on a case-by-case basis to defendants whose behavior should get a "pass" because the plaintiff's behavior abused the IP privilege.²⁰⁶ Therefore, its applicability will be case specific. For example, as noted above, a copyright misuse argument could come out either way as applied to the facts of *Star Athletica* itself.²⁰⁷

206. See Frischmann & Moylan, *supra* note 200, at 867; Hartzog, *supra* note 197, at 378.

207. As noted above, *see supra* notes 190–94 and accompanying text, a copyright abuse claim would first focus on the fact that Varsity Brands had obtained copyright registrations in hundreds of cheerleader uniforms with slight variations of chevrons, color blocking, and lines. Brief for Petitioner at 15, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866). Assuming that, as the preeminent manufacturer of cheer gear, Varsity Brands had established—or at least refined and reinforced—the particular look and feel of its geometrically designed uniforms as the standard in the field, *see id.* at 12–13, Varsity Brands' aggregate registration strategy would make it very difficult for other entrants like *Star Athletica* to compete with the same type of standardized uniform. Thus, the argument would conclude, Varsity Brands' tactic of locking up all the uniform designs that are effectively standard to and expected by all participants should be seen as a way of foreclosing competition in the designs of the underlying functional articles. This should be considered copyright misuse, on this argument, because the recognition of aesthetically separable elements would be used to monopolize competition in the manufacture of the underlying useful works, which copyright explicitly is not supposed to protect.

One of the problems with this argument, though, is that—unlike computer software—the standardization in designs of athletic uniforms is probably easily changeable. *See Frischmann & Moylan, supra* note 200, at 917–18 (discussing the standardization engendered by network effects with respect to software). To the extent that manufacturers like Varsity Brands charge high prices for cheer gear because of their dominant market positions, schools might be willing to change to a different kind of design for their uniforms if the alternatives were economical enough. Granted, there would be a transition period, and schools might have to replace all their uniforms if they wanted to switch to a different design style, but whether that would be a problem depends more on pricing than on copyright doctrine. The question of when and how to define standardization that effectively ties users' hands and grants the owner of the copyrightable work monopoly power is much easier in the context of computer works and other works whose use requires user investment. *See Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 821 (1st Cir. 1995) (Boudin, J., concurring), *aff'd by an equally divided court*, 516 U.S. 233 (1996) (describing switching costs when users have invested in learning as a particularly acute threat to public access to knowledge). The extent to which that is true in contexts like cheerleader uniforms is unclear. The question, then, would be whether Varsity Brands' aggregative registration strategy should be considered to be like the abusive license provisions attempting to evade the idea-expression distinction, or simply appropriate uses of their rights to copyright individual works under the Copyright Act and to engage in the perfectly appropriate business activity of branding. This is a harder question than that posed by the license provisions in *Lasercomb*. *See supra* note 203; *see also* Rebecca Tushnet, *Make Me Walk, Make Me Talk, Do*

Perhaps one way of addressing the issue is to ground the abuse argument not on the underlying IP policy but on the degree to which it invites and supports litigation abuse, that is, “overly aggressive assertions of IP rights which otherwise threaten to discourage lawful conduct[.]”²⁰⁸ Copyright registrations that cover most plausible combinations of basic visual forms could constitute a first step in a hyperaggressive copyright litigation strategy likely to have significant chilling effect on competitors.

Whether styled as an expanded type of copyright misuse or a species of litigation abuse, however, a doctrine of copyright abuse addressing aggregative registration strategies in useful works contexts cannot function as a general rule. Therefore, both its application and its chilling impact are much harder to calibrate than copyright’s exclusion doctrines discussed above. Still, despite the need for a clearer doctrinal footprint based on a well-articulated normative ground, the notion of copyright abuse offers courts a useful lens through which to assess anticompetitive effects of aggregative copyright registration strategies such as those employed by Varsity Brands.

C. The Administrative Alternative—What Deference Should Be Due to the Copyright Office’s Registration Decisions?

Another way in which *Star Athletica*’s potentially negative consequences could theoretically be averted is procedural and administrative. Under Section 410 of the Copyright Act, the Copyright Office is tasked with examining applications for registration and accepting or rejecting them.²⁰⁹ However, relying on the Copyright Office to control the effects of aggregate copyright registration strategies would not work. The problem is that, at least as a practical matter, the Copyright Office faces too many barriers to accomplish such a task. In fact, the realities of the Copyright Office’s procedures should dispose courts not to grant much weight to certificates of registration granted to PGS features of useful articles.

Whatever You Please: Barbie and Exceptions, in INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP 405, 405 (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2014) (noting that as creative material becomes branded, trademark can provide copyright owners “potentially perpetual rights,” just as copyright can help trademark owners to avoid limits applicable to commercial transactions).

208. Cotter, *supra* note 200, at 962; see also Thomas F. Cotter, *Fair Use and Copyright Overenforcement*, 93 IOWA L. REV. 1271, 1273 (2008) (discussing fair use as a response to copyright overclaiming); Ghosh, *supra* note 5, at 98 (mentioning how separability tests can be used to engage in anticompetitive litigation).

209. 17 U.S.C. § 410(a)–(b) (2012).

The Supreme Court did not grant certiorari on the question of deference to the Copyright Office.²¹⁰ The Sixth Circuit in *Star Athletica* held that decisions of the Copyright Office with respect to registration deserved *Skidmore* deference, with deference depending on the agency's thoroughness in consideration, validity of reasoning, consistency with prior decisions, and persuasiveness.²¹¹ Using that standard, the appellate court found that the district court had erred in "failing to give greater deference to the Copyright Office's" registrations of the Varsity Brands designs.²¹² The Sixth Circuit rested its deferential approach on the Copyright Office's consistency in registering Varsity Brands' other similar designs, its attempt to ground its decision on the statutory text with "sound legal reasoning,"²¹³ and on the observation that the Office's "expertise in identifying and thinking about the difference between art and function surpasses ours."²¹⁴ Although the court reiterated that the presumption of validity attaching to registration was rebuttable, its language indicated that it saw the defendant's burden as high indeed. Its rationale for deference was grounded on the thinnest of reeds and a less-than-zero examination of the Copyright Office's review process. It made no mention of the fact that the Copyright Office does not ordinarily provide reasoning or explanations for its decisions to issue a registration certificate, although such reasoning will ordinarily accompany registration rejections.²¹⁵

The history of how the Copyright Office has handled the registration of PGS elements of useful articles is an instructive response to the Sixth Circuit's assumption of consistency. Although the Office gives its examiners guidance (*inter alia*, through internal documents such as the *Compendium of U.S. Copyright Office Practices*),²¹⁶ the examiners are not required to be attorneys,²¹⁷ artists,

210. See *supra* note 47 and accompanying text.

211. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 479–80 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002 (2017) ("We . . . hold that the Copyright Office's determination that a design is protectable under the Copyright Act is entitled to *Skidmore* deference. Individual decisions about the copyrightability of a work are not like 'rules carrying the force of law,' which command *Chevron* deference."); see also *Skidmore v. Swift & Co.*, 323 U.S. 134 (1944) (adopting a multifactor test).

212. *Varsity Brands*, 799 F.3d at 480.

213. *Id.*

214. *Id.*

215. Robert Kasunic, *Copyright from Inside the Box: A View from the U.S. Copyright Office*, 39 COLUM. J.L. & ARTS 311, 323 (2016).

216. U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES (3d ed. 2017), <https://www.copyright.gov/comp3/docs/compendium-draft.pdf> [<https://perma.cc/W7HW-863C>] [hereinafter U.S. COPYRIGHT OFFICE, 2017 COMPENDIUM]; see also *Varsity Brands*, 799 F.3d at 480 (discussing the *Compendium*).

or art historians and do not need to coordinate with any other administrative agencies outside of the Copyright Office in the exercise of their duties. At the point of registration, the Copyright Office examiners

don't have the benefit of factual arguments, cross-examination, discovery, market effects, expert witnesses, or other evidence that may affect a court's determination. The registration process simply examines the claim and the deposit and seeks to ensure that the legal and formal requirements of a claim in copyright are met in accordance with our longstanding institutional expertise in these questions.²¹⁸

There is also no indication that the Copyright Office examiners routinely look to see whether a registrant's other copyright registrations appear to be capturing a particular style or look based on the combination of basic visual elements.²¹⁹ Even with respect to individual registrations of PGS elements in useful articles, the history of the Copyright Office is in fact inconsistent.²²⁰ Although the *Mazer*-era history suggests that the Copyright Office was hesitant to register functional works, recent history indicates that Copyright Office examiners have adopted a presumption of registrability for aesthetic elements of such works.²²¹ The Copyright Office practice of

217. Currently, all examiners are required to take "the equivalent of a complete law school copyright course as a refresher to ensure that everyone understands the concepts of copyright law." Kasunic, *supra* note 215, at 323.

218. Kasunic, *supra* note 215, at 318.

219. U.S. COPYRIGHT OFFICE, 2017 COMPENDIUM, *supra* note 216, § 602.4(D) ("The U.S. Copyright Office generally does not compare deposit copy(ies) to determine whether the work for which registration is sought is substantially similar to another work."). Indeed, it would be hard for the Copyright Office to give examiners guidance on how and when to identify such a threat and on how to decide when such a tipping point had been reached. Kasunic, *supra* note 215, at 322–23 (explaining the strain on copyright examiners).

220. See Colman, *supra* note 70, at 152–198 (explaining the history of the Copyright Office's interpretation of "useful article" in the fashion design context). Not that courts have fared much better, however. See *id.* at 194–97 (providing examples of courts having difficulty with the meaning of "utilitarian"). In any event, it is because the Sixth Circuit only looked at the registration decisions regarding all the rest of Varsity Brands' similar cheerleading designs that it could conclude that the Copyright Office's registration decisions were consistent. *Varsity Brands*, 799 F.3d at 480.

221. Colman, *supra* note 70, at 152. Associate Register Robert Kasunic admitted that "[i]n the past, the Copyright Office had a culture that we give the benefit of the doubt to the applicant, thereby defaulting to registration rather than refusal. Looking at this more, there is a persuasive case to be made to default in the opposite direction." Kasunic, *supra* note 215, at 321. *But cf.* Ginsburg, *supra* note 4, at 14–16 (noting that the Copyright Office did refuse to register a significant number of applications for useful articles). Many of those refusals may have been due to decisions on the part of Copyright Office personnel that the registration sought copyright for the overall shape or configuration of the articles, which the Office traditionally rejected. *Id.* at 16.

registering copyrights on a “Rule of Doubt” basis²²² as well as the routine of negotiating with applicants on registration suggests a skew toward liberal registration.²²³ There is no process of internal review at the Copyright Office to discipline examiners “when the Office issues a certificate of registration in close-calls[.]”²²⁴ Under these circumstances and in light of the congressional intent to limit the copyrightability of aesthetic elements of useful works, there is little reason for the courts to defer to Copyright Office registrations on separability.²²⁵

How Copyright Office examiners will apply the *Star Athletica* test in the future is unclear. The pending revision draft of the *Compendium of U.S. Copyright Office Practices* indicates that the office is developing “updated guidance on the registration” of PGS

222. See, e.g., U.S. COPYRIGHT OFFICE, 2017 COMPENDIUM, *supra* note 216, § 607 (describing the Rule of Doubt). Under the Rule of Doubt, “the Office may register a claim to copyright, even though the Office has reasonable doubt as to whether the material submitted for registration constitutes copyrightable subject matter or whether the other legal and formal requirements of the statute have been met.” *Id.* Although the *Compendium* asserts that registration will not be granted on the basis of the Rule of Doubt “simply because there is some uncertainty as to how that issue may be decided by a particular court,” and although it is unclear whether and to what extent the Copyright Office has granted Rule of Doubt registrations to PGS features incorporated in useful works, the fact that the Office has such a practice should cut against automatic, knee-jerk deference to the Office’s registration decisions without further inquiry into the administrative process. *Id.*

223. Indeed, in the *Star Athletica* case itself, the Copyright Office had engaged in correspondence with respect to some of Varsity Brands’ registration applications. Brief for Petitioner, *supra* note 207, at 15. *Star Athletica*’s brief and its brief in support of its petition for certiorari report that the Copyright Office had originally rejected many of Varsity Brands’ cheerleading uniform designs. *Id.*; Petition for Writ of Certiorari, *supra* note 34, at 13–14.

224. Kasunic, *supra* note 215, at 322 (“At present with the existing level of staffing of Copyright Examiners, it would be impossible to have peer review or supervisor review of all approved claims.”).

225. Admittedly, the Copyright Act contains a presumption of validity for registered copyrights. Section 410(c) provides that in judicial proceedings, a “certificate of registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” 17 U.S.C. § 410(c) (2012). This does not mean, however, that the statute requires courts simply to accept the copyrightability of the items registered by the Office without further examination. The statutory presumption is rebuttable. Thus, after the plaintiff introduces evidence of registration, the defendant can show that the plaintiff’s copyrights are invalid. See, e.g., *Fonar Corp. v. Domenick*, 105 F.3d 99, 104 (2d Cir. 1997).

Moreover, to the extent that the Copyright Office’s separability determinations were grounded on a particular test for separability, courts choosing a different test could not be thought to have deferred to the administrative decisions of the Office. For example, the Copyright Office’s approach to separability prior to *Star Athletica* required both the aesthetics and the functional aspects of the useful article to remain after separation. See Ginsburg, *supra* note 4, at 11–17. Courts varied in the degree to which they used the Copyright Office’s conceptual separability test, however. See sources cited *supra* note 77 (regarding the numerous separability tests used by various courts).

features incorporated into the designs of useful articles.²²⁶ Until that issues, the draft *Compendium* contains some suggestive language. Section 906.8 states that copyright law “does protect the *creative form* of a work of artistic craftsmanship” and that by contrast to a lamp, which is considered a useful article, “a three-dimensional floral design affixed to the base of a lamp . . . does not have an *intrinsic utilitarian function* [and] the U.S. Copyright Office may register those design features if they are separable from the functional aspects of the lamp and if they are *sufficiently original and creative*.”²²⁷ Does the italicized language suggest that a higher-than-usual level of originality and creativity will be required for the registration of such works? Will the Copyright Office examiners register overall aesthetic forms of useful articles if they are “creative”—a term that is nowhere defined? Will the examiners decide whether the PGS features *themselves* have “an intrinsic utilitarian function” (in addition to the intrinsic utilitarian function of the useful work in which they are embedded) in order to make the separability and registrability determination? If so, this could lead to more liberal registrations in practice. Particularly in light of the vagueness and imprecision of *Star Athletica*’s new separability test, Copyright Office examiners may end up liberalizing their registrations of PGS elements associated with useful articles. If that is the case, courts should not engage in an automatic, unquestioning acceptance of the Copyright Office’s approach. And as the registration decisions by Copyright Office functionaries do not necessarily track or make explicit the two-pronged analysis called for by *Star Athletica*, to what exactly the courts should defer becomes a nice question. In any event, the Copyright Office approach to individual registrations will ultimately say nothing about the aggregate registration strategy that may be the less obvious but more dangerous threat posed by *Star Athletica*’s approach.

VI. IS THE BROADEST DEFINITION OF FUNCTION THE ANSWER?

Perhaps one way to deal with the issue of aggregate registration effects is to adopt a generally applicable definition of “function” that could reduce the copyrightability of PGS elements once they are integrated into useful works. Even under the *Star Athletica* test, if the PGS elements *themselves* are functional, they would not be copyrightable regardless of their aesthetic appeal. But how should function be defined? The Court in *Star Athletica* eschewed any

226. U.S. COPYRIGHT OFFICE, 2017 COMPENDIUM, *supra* note 216, § 924.

227. *Id.* § 906.8 (emphasis added).

attempt to analyze how to draw the line between functional industrial design and non-functional applied art—effectively assuming an easily identifiable and binary distinction between the useful uniform and its separable decoration. The Court therefore implicitly—but without analysis or discussion—adopted a narrow and mechanical conception of function for separability purposes.²²⁸

Professors McKenna and Sprigman correctly suggest that functionality is not “a straightforward empirical question,” and they chide courts for failing to recognize “functionality’s essential normativity” while approaching the question “reductively and intuitively.”²²⁹ After all, in reality, the aesthetic and utilitarian are arrayed on a spectrum. Aesthetic elements can often serve a variety of functions, and even what appear to be purely mechanical objects can be seen as aesthetically appealing. Moreover, there are often great variations in the ratio of aesthetic to functional characteristics in attractive useful works. Some scholars have asserted an extremely broad conception of functionality and have suggested that aesthetic elements in useful articles should only be considered separable and copyrightable if they are completely non-functional in any context.²³⁰ One of the core failings of the *Star Athletica* decision is the Supreme Court’s asserted reliance on textualism as a way of rejecting those scholars’ argument and of sidestepping functionality’s normativity.

A. *The Court’s Thin Textualism*

Star Athletica does not parse the statutory language to determine whether cheerleading uniforms are useful articles and whether the same definition of function is to be applied to the separability analysis as to the identification of useful articles. Even though the majority purports to find its new separability standard in

228. See Tyler T. Ochoa, *What Is a “Useful Article” in Copyright Law After Star Athletica?*, 166 U. PA. L. REV. ONLINE 105, 110–11 (2017) (noting that “the majority opinion identified the utilitarian aspects of the cheerleading uniforms only implicitly” and suggesting that because “the Sixth Circuit’s five-question approach is consistent with the Supreme Court’s two-part approach[,] . . . a lower court should expressly consider the first three questions of the Sixth Circuit’s five-question approach, before turning to the Supreme Court’s modification of the last two questions of the Sixth Circuit’s approach.” (emphasis omitted)).

229. McKenna & Sprigman, *supra* note 72, at 516.

230. See, e.g., Buccafusco & Fromer, *Fashion’s Function*, *supra* note 12, at 53; Buccafusco & Fromer, *Forgetting Functionality*, *supra* note 12, at 119; see also McKenna, *supra* note 72, at 132.

the language of the Copyright Act itself,²³¹ its statutory interpretation is not the only plausible one.

The majority simply assumes that cheerleading uniforms are useful articles—presumably, as the Sixth Circuit had held, because they cover the body, wick away sweat, and withstand athletic movements.²³² Once having categorized the uniforms as useful in this way, though, the majority focused only on the PGS elements of the uniforms and not on any functional role played by those features when integrated in the useful work. But the statutory framework seems more complex than that. The focus of the statute could reasonably be said to be on the relationship of the PGS “features” to the useful work’s “utilitarian aspects.”²³³ In other words, the statute’s use of utility could be seen as a two-step rather than a one-step exercise. If so, a different analysis might result.

The distinction in the statutory language between work, feature, and article arguably makes a difference, even though the Court in *Star Athletica* did not focus on it. According to the statute, a PGS work is directly eligible for copyright protection if it is not incorporated in a useful article.²³⁴ If it is, however, then separability analysis must ensue. How does one know whether a PGS work—embodied in some kind of medium—is incorporated in a useful work? This first inquiry requires the fact-finder to determine whether the article as a whole is useful. This simply requires assessing

231. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (“This is not a free-ranging search for the best copyright policy, but rather ‘depends solely on statutory interpretation.’ . . . We thus begin and end our inquiry with the text, giving each word its ‘ordinary, contemporary, common meaning.’” (citations omitted)).

232. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 491 (6th Cir. 2015), *aff’d*, 137 S. Ct. 1002 (2017). The district court, unlike the Sixth Circuit, found that the function of the uniforms with their designs was to identify the wearers as cheerleaders. *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at *1, *8–9 (W.D. Tenn. Mar. 1, 2014), *vacated*, 799 F.3d 468 (6th Cir. 2015), *aff’d*, 137 S. Ct. 1002 (2017). The Sixth Circuit, rejecting this interpretation of their function, asserted that the uniforms served garment-like functions of covering the body. *Varsity Brands*, 799 F.3d at 492.

233. 17 U.S.C § 101 (2012).

234. *Id.* The Copyright Act defines PGS works to include

two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural 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.

Id. (emphases added).

whether the article has “an intrinsic utilitarian function.”²³⁵ The separability analysis has not yet started at this point; it is simply teed up if a useful article is identified. Once one concludes that the design is of a useful article, then one must look at the separability of its PGS features, if any. The separability definition refers to the separability of PGS features from “the utilitarian aspects” of the article. But those “utilitarian functions” are not statutorily defined and are not necessarily limited to the single intrinsic utility required to identify a useful article. Just because, as a triggering matter, something can be characterized as a useful article because it has *an* intrinsic utilitarian function does not mean that the same definition of function must be the only one to be applied for the rest of the statutory separability inquiry thereafter. Indeed, the statute, in its use of the plural tense, seems to contemplate the possibility of multiple utilitarian aspects.²³⁶ And it is reasonable to interpret it as requiring a determination of whether the identified PGS *features* can (each? together?) be separated from the various types of utility attributable to the useful article. Even when *a* utilitarian function can be identified, this does not mean that no other overlay functions also exist.

Despite the Court’s claim to be simply discovering its test in the text,²³⁷ the Court’s interpretation was not in fact dictated by the Copyright Act. The majority’s failure to analyze the text thus reflects an unhelpfully thin textualism. Although the Court did not explicitly define function, its analysis implicitly chose the narrow definition in the definition of useful articles to use in the separability part of the inquiry as well.²³⁸ This was a judicial, not a legislative, choice.

235. *Id.* The Act defines a useful article as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article.’” *Id.*

236. *Id.*

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

238. *See id.* at 1008. The Court tried to read utility out altogether (once it accepted the relevant item as a useful article) by defining its frame as copyright inclusion rather than functionality exclusion. *Id.* at 1013–14. Yet by avoiding situations where the integrated aesthetic elements help to enhance, improve, or distinguish the article’s functions from those of its competitors, the Court implicitly adopted a narrow and limiting definition.

As Professors Kaminski and Rub have noted, copyright has a persistent framing problem—a problem magnified by the fact that most courts do not recognize the choices they make in framing when they apply copyright doctrines. *See Kaminski & Rub, supra* note 69, at 1104–05. The fact that the Court chose a narrow definition of function had an unacknowledged impact on the outcome of its separability analysis. *See Star Athletica*, 137 S. Ct. at 1013–14. Effectively, what the majority did in *Star Athletica* was to limit the inquiry into function by narrowing its consideration of utility to one basic, core function of the overall designs at issue either that the parties agreed to or that could generally be agreed to be useful (and that the Copyright Office has affirmed through registration). This is not consistent with the goals of the statute (and even

B. Non-Functionality Instead of Functionality?

Perhaps the majority's avoidance of function in its statutory interpretation can be explained as a shift in focus from the functional to the *non*-functional. Historically, the key issue in copyrightability analysis was whether the aesthetic elements enhanced or amplified the useful article's function, and the lower court arguments in *Star Athletica* had focused on the functional role played by the graphic elements.²³⁹ *Star Athletica* switched the focus, looking not at the function of the PGS features when integrated in useful articles²⁴⁰ but at whether those features could be *non*-functional. In other words, in looking to imagine whether the PGS features in the useful work can stand alone as a PGS work, the *Star Athletica* majority could be signaling a need to focus not on the PGS features as they function but to ask whether they can exist *without* function. Even if PGS features are sometimes functional in some ways when integrated, can they ever be imagined as *non*-functional? Can they be separated without bringing along with them the functionalities of the underlying utilitarian work in which they appear?

This interpretation could explain why the case came out the way it did: to the extent that Varsity Brands' designs seek to use optical illusions to give the impression of thinner and more athletic wearers, these optical illusions in Varsity Brands' designs only work

its language). See 17 U.S.C. § 101. This approach is likely to lead to overly protective results in a potentially material number of cases.

239. See *Star Athletica*, 137 S. Ct. at 1007–08. For example, Professors Buccafusco and Fromer suggested in their amicus brief that optical illusion elements designed to allow the wearer to be perceived a certain way—as younger, leaner, more attractive—should be considered utilitarian features. See Brief for Professors Christopher Buccafusco and Jeanne Fromer as Amici Curiae Supporting Petitioner at 8–9, *Star Athletica*, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017) (No. 15-866); see also Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 56; Buccafusco & Fromer, *Forgetting Functionality*, *supra* note 12, at 126. The Court did not address this argument.

240. See *Star Athletica*, 137 S. Ct. at 1007. The majority in *Star Athletica* did not explicitly try to define function—refusing to address, for example, the argument that the cheerleading uniform designs at issue in the case contained aesthetic features that were designed to improve the uniforms' function. See *id.* at 1014. It simply assumed that the useful objects at issue were cheerleader uniforms. See Ochoa, *supra* note 228, at 106 (agreeing that both the parties and the Court “implicitly assumed, without analysis, that the cheerleading uniforms at issue were ‘useful articles.’”). It then simply sought to identify whether or not the decorations at issue should be conceived as applied art. See *Star Athletica*, 137 S. Ct. at 1014. Even Justice Ginsburg's concurrence appeared to assume that the useful articles were the cheerleading uniforms but argued that separability analysis was unnecessary because Varsity Brands was seeking protection for its two-dimensional fabric designs as reproduced in the registered drawings and photographs. See *id.* at 1018–19 (Ginsburg, J., concurring).

to give such impressions when worn on the body.²⁴¹ Their functions of making someone look thin, athletic, and good evaporate when the aesthetic designs are not integrated in use in a cheerleading uniform. They can then be viewed as art.

Still, focusing on *non*-function does not eliminate the need to address function. By definition, one has to adopt a definition of function that will be used to distinguish between the functional and the non-functional. Even reading *Star Athletica* as embracing a non-functionality focus does not eliminate attention to the relationship between the aesthetic and the functional aspects in a hybrid useful article. More troublingly, the focus on abstract non-function invites a narrow interpretation of function (such as the one implicitly adopted by the *Star Athletica* Court itself) and opens the door to expansive protections of PGS elements of useful articles—despite the clear intention of Congress to impose a “high threshold to copyrightability of useful articles.”²⁴²

Professors Buccafusco and Fromer have argued that “just because a design is non-functional in one medium it is necessarily non-functional in all media.”²⁴³ Beginning from the proposition that “[c]opyright protection should extend only to reproductions of the design in media where it does not have a function[,]”²⁴⁴ and adopting a broad definition of function, they would reject copyright protection for any aesthetic features that could be deemed to have a function in any context even if they could be non-functional in others. It is because of this that they assert the Court made a mistake and “produced an erroneous outcome.”²⁴⁵

But the *Star Athletica* decision essentially rejects that view, suggesting instead that the Court made a *choice* rather than a mistake. The *Star Athletica* Court effectively decided that if art could be non-functional when not incorporated in a useful work, it would be arbitrary not to provide it copyright protection. On the Buccafusco and Fromer view, copyright should be denied to otherwise protectable work simply because it might make a useful article more visually attractive. This seems to go much further than congressional intent, however, which sought to distinguish applied art and industrial

241. See also Marchese, *supra* note 115, at 378–79. Indeed, the placement of the design elements was “determined by the three dimensional structure of the garment.” *Id.* at 412.

242. Ginsburg, *supra* note 4, at 2.

243. Buccafusco & Fromer, *Forgetting Functionality*, *supra* note 12, at 126.

244. *Id.*

245. *Id.*

design.²⁴⁶ Allowing more and more abstract and socially determined notions of function to limit the copyrightability of otherwise original PGS features would be an indirect way of reining in copyright. Those who believe that copyright protection has metastasized might think this a good thing. On the other hand, without boundaries, this kind of approach could overly restrict the scope of copyright. It also focuses too much on medium rather than on context.²⁴⁷ As the *Star Athletica* majority worried, a boundless definition of function for purposes of justifying exclusion could eliminate copyright in applied art.²⁴⁸ One cannot reasonably say that function should be relegated only to the realm of patent, and then say that virtually anything that could be considered useful with respect to any definition of function cannot be copyrightable and must look only to patent. Function and form cannot be distinguished in a neutral—culturally and legally acontextual—way. To draw the line, an underlying policy must be developed. So the question is: Against what metric does one define the kind of functional use of aesthetics that triggers separability analysis?

If protecting the incorporated art would not necessarily replicate and therefore protect the underlying useful object, it is hard to see what policy would be furthered by refusing copyright protection—unless the designs themselves are deemed to function as useful articles.²⁴⁹ But a definition of function without limits would

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

247. It can reasonably be said that both art and function are perceived in context. If I were to see Marcel Duchamp’s famous urinal in a museum, I would interpret it as art, or at least as a comment on what society considers art. See J. Alex Ward, *Copyrighting Context: Law for Plumbing’s Sake*, 17 COLUM.-VLA J.L. & ARTS 159, 162 (1993). For an article describing the *Fountain* story, see, for example, Martin Gayford, *Duchamp’s Fountain: The Practical Joke That Launched an Artistic Revolution*, TELEGRAPH (Feb. 16, 2008, 12:01 AM), <http://www.telegraph.co.uk/culture/art/3671180/Duchamps-Fountain-The-practical-joke-that-launched-an-artistic-revolution.html> [https://perma.cc/RR3B-JKFP]. I would appreciate the urinal in its relationship to the context in which it is placed and in conversation with the other aesthetic objects with which it is displayed. My appreciation of the urinal would not be as a urinal, but as the urinal as an expressive or representational object. If, on the other hand, a man were to see the urinal *in situ* in a bathroom, he would focus on its usefulness and subconsciously primarily assess whether its design—the slope of its sides, the curvature and height of its bottom edge—efficiently accomplished its intended use as a urinary receptacle.

248. See *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1014 (2017) (“Were we to accept [Star Athletica’s] argument that the only protectable features are those that play absolutely no role in an article’s function, we would effectively abrogate the rule of *Mazer* and read ‘applied art’ out of the statute.”).

249. As discussed in Part V.A above, common policy rationales offered by scholars for denying copyright protection to useful works include channeling and avoidance of backdoor patents and protecting competition in the useful works market, itself.

lead to problematic underprotection. If any function at all, no matter how broadly defined, is sufficient to make the art itself inherently functional, then art will sometimes be copyrightable and sometimes not. This is likely to lead to a very confusing state of affairs. The *Star Athletica* Court worried that it would eliminate protection for applied art.²⁵⁰ Still, one does not have to go as far as Buccafusco and Fromer to criticize the Court's approach to function. This Article argues that the Court's real mistake in *Star Athletica* was its assumption that the only relevant function for separability purposes was the definition of useful article. This belief underlay the majority's refusal to articulate a theory by which to distinguish between those functions that should preclude copyright protections and those that should not. Even without agreeing with Buccafusco and Fromer's suggestion that PGS features should only be protected by copyright when they are "purely expressive"²⁵¹ and have no utility however defined, one can still criticize *Star Athletica* for refusing to provide the tools to separate its newly adopted categories of copyrightable function and noncopyrightable function.

C. What Kind of Functionality Should Count for Copyright Separability Purposes? A Middle-Ground Approach

Why is the majority incorrect in its implicit assessment of function in *Star Athletica*? First, as a matter of practical reality, one can imagine a spectrum of functions that aesthetic elements might enhance and that they may themselves accomplish. The multiple relevant functions of integrated aesthetic elements²⁵² can include

Professors Buccafusco and Fromer argue that "[a]s 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." Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 84. But if, for example, making a wearer look good can be characterized as an expressive use, then logic suggests that there is no end point to Buccafusco and Fromer's argument. Depending on framing, is it possible to characterize virtually any use of aesthetic elements as functional in one way or another? If so, what PGS elements are left to be copyrightable?

250. See *Star Athletica*, 137 S. Ct. at 1014.

251. Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 70.

252. The Court seems to begin from the proposition, as does the statute, that there are some PGS articles that have no intrinsic function (presumably other than artworks providing aesthetic enjoyment or appreciation). See 17 U.S.C. § 101 (2012); *Star Athletica*, 137 S. Ct. at 1008. This Article refers to those as "Function 0 works." With respect to items that do have intrinsic functions beyond aesthetic appreciation, one can identify and describe their functions at the most basic level—call these "Function 1 features." This is presumably what the Copyright Act means when it refers to useful articles as those that have "an intrinsic function" other than representation or communication. See 17 U.S.C. § 101. Presumably, that Function 1 characterization is the core utility that consensus would suggest is necessary as the basis for all

mechanical or technological functions (making the item work), marketing functions (enhancing the salable value), branding functions (identifying the source), expressive functions (communicating to the audience), and decorative functions (increasing the item's appeal). In turn, the mechanical functions can be broadly or narrowly construed. For example, as Professors Buccafusco and Fromer argued in their amicus brief in *Star Athletica*, the Varsity Brands designs took advantage of optical illusions to make the wearer look thinner and more attractive.²⁵³ Second, lived experience indicates that the

other possible overlay utilities for that particular article. So, as to Function 1 in connection with the items in *Star Athletica* itself, the basic function of a cheerleading uniform would be (as the lower courts described it) covering the body, allowing for movement, and wicking sweat. See *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at *1, *8-9 (W.D. Tenn. March 1, 2014), *vacated*, 799 F.3d 468 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002 (2017). If the decorative designs of chevrons and color blocking were removed from the underlying fabric, the overall shape of the article could still function as some kind of garment or dress and even as a type of cheerleading uniform. The decorations might improve its appeal as a cheerleading uniform, but it could still operate as a garment or a cheerleader uniform even if it had no decorative embellishments (which such uniforms did not have in the past). See, e.g., Brief of Respondents at 56-58, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866).

But there are doubtless many overlay functions one can imagine. Function 2 of cheerleading uniforms may include, in addition to Function 1, the function of slimming the body; making the wearer look taller, thinner, or curvier; or addressing some other appearance-related aspect suggesting strength, power, or agility. Function 3 could include identifying the school for which the cheerleader is cheering. Function 4 could be hiding sweat stains. Function 5 could relate to the look of all of the uniforms together from the distance of the bleachers. Function 6 could be the particular visual effects of the whole cheerleading squad working together to create moving images during a cheer. Admittedly, if one chose to look only at what might be called the more culturally defined or neurologically defined aspects of function—making the outfit look good—such elements would not themselves work as uniforms. The underlying uniform would be necessary for the secondary functional effects to work. Still, the fact that the basic scaffold is necessary to enable the upper level or overlay functions does not mean that those functions do not exist, and the fact that those functions depend on other levels of functionality does not mean they should be ignored.

In practice, if a fact-finder only looks at Function 1, it will frequently be easy to find that PGS elements are separable from Function 1-level descriptions of useful works. In *Star Athletica* itself, for example, if the Court had considered Function 2—meaning if it had noted that the particular configuration of the designs as applied onto the uniform had the effect, in addition to the Function 1 utilities, of making the wearers look thinner or more athletic through taking advantage of optical illusions—then separability from Function 2 would have been harder to find.

253. See Brief for Professors Christopher Buccafusco and Jeanne Fromer as Amici Curiae Supporting Petitioner, *supra* note 239, at 24. For example, Professors Buccafusco and Fromer argued both in an amicus brief in *Star Athletica* and in a separate law review article that components of a design that “enhanc[e] the wearer’s attractiveness” should be considered functional. Buccafusco & Fromer, *Fashion’s Function*, *supra* note 12, at 81-82 (quoting *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 550 (S.D.N.Y. 2011)) (arguing that aspects of fashion are functional when they affect the perception of the wearer’s body); see also Brief for Professors Christopher Buccafusco and Jeanne Fromer as Amici Curiae Supporting

functional importance of aesthetic features in a useful article varies on a spectrum as well. The aesthetic components can be important or not so central from a variety of vantage points.

If all original artistic features integrated in useful works should not be excluded from copyright if they accomplish *any* of those types of functions, however, then one must choose among them.²⁵⁴ In doing so, one must ask: (1) On what basis to select which of those functions should “count”²⁵⁵ for copyright purposes and which should not, and (2) Where function and aesthetics interpenetrate, how much functionality should shift the PGS features out of copyright?²⁵⁶ Should biologically, neurologically, and psychologically grounded functions of aesthetic elements count to prohibit copyright? On which side of the line should extrinsic, marketing-supportive functions such as attractiveness for salability purposes be placed?

Answering these questions requires appeal to underlying policy standards to help direct that choice.²⁵⁷ From where should those policies be recruited? One approach is to look at the goals of the Copyright Act in protecting communicative expression, channeling creative works to the right IP domains, and promoting competition in functional works markets. Those IP policies would not limit the types of functions leading to inseparability to the very narrow conception adopted by the Court in *Star Athletica*. Under the Copyright Act, an article can only be considered a useful article if its intrinsic function is

Petitioner, *supra* note 239, at 24; *cf.* Hughes, *supra* note 184, at 1285 (proposing, in the context of aesthetic functionality doctrine in trademark law, “a vigorous aesthetic functionality doctrine that prevents private parties from gaining market advantages that arise from exploiting widely-shared, preexisting cognitive, psychological, or aesthetic responses among consumers”).

254. It should be noted that the meaning of “function” is deemed to differ in trademark, utility patent, design patent, and copyright, even though the language used is the same. *See* Lee & Sunder, *supra* note 134, at 531.

255. *See* McKenna & Sprigman, *supra* note 72, at 523, 535–36.

256. *See id.* at 517–18 (“[C]opyright’s useful articles doctrine [like the other IP functionality doctrines] really has to determine the point at which the balance between ornamentality and functionality tips too strongly in the direction of function.”).

257. *See id.* at 544. Scholars have criticized copyright for failing to have a theory of usefulness that would rationalize the differential treatment of articles that appeal to consumers on the levels of both aesthetics and function. For example, Professors McKenna and Sprigman have argued that copyright lacks a theory of what usefulness means so that courts can exclude intrinsically useful articles from copyright. *Id.* at 536–39 (addressing failure of theory to explain copyright’s differential treatment of apparel and toys and noting that “although it is obvious that most articles appeal on both aesthetic and functional levels, copyright lacks a theory of how much function is sufficient to remove a particular article, or class of articles, from its domain. . . . The only consistency in copyright’s treatment of utility is its ad hoc nature.”). The *Star Athletica* Court implicitly adopted a theory of function quite inconsistent with these scholars’ vision of what a theory of usefulness could do to rationalize the treatment of applied art in useful works. *Compare* McKenna & Sprigman, *supra* note 72, at 535–39, *with Star Athletica*, 137 S. Ct. at 1010.

not “to portray the appearance of the article or to convey information.”²⁵⁸ The statute in its terms makes a distinction between mechanical function and expressive function; thus, it implicitly distinguishes between intrinsic and extrinsic functions.

As Professor Burk has put it, “utility in copyright is not concerned with . . . informational or aesthetic ‘uses;’ rather it is practical or operational ‘uses’ that are excluded from the copyright protection.”²⁵⁹ Admittedly, “conveying information” is not a predictable or self-defining standard. For example, functional works often convey some information. In the cheer context, uniforms convey, *inter alia*, numbers, colors, names, styles, schools, and optical illusions. As for aesthetic elements, there are many that convey little information while they effectuate various different functions of the sorts discussed above. Should it be said that PGS elements that make the wearer look thin are actually conveying information? Does the fact that these elements are used in an interactive way in response to the audience’s preexisting cognitive and perceptual biases make them communicative and therefore non-functional for separability purposes?²⁶⁰ Do they carry “an objective message about the physical world or its deterministic functions”?²⁶¹ Still, even if the outer contours of “conveying information” are not crystal clear, the statutory commitment to copyright protection for aesthetic features embodied in media intended to convey information provides one policy clue for thinking about the meaning of function for copyright.

As for the statute’s reference to “intrinsic” functions, this term too is susceptible of multiple interpretations. Still, on one reading, the “intrinsic” focus directs attention only to the characteristics and functions of the article itself. In the cheerleading uniform context,

258. 17 U.S.C § 101 (2012).

259. Burk, *supra* note 145, at 590.

260. Professors Buccafusco and Fromer answer “no,” asserting that it would be “an unnatural reading” of the statute to suggest that graphic visual designs on a garment convey information, rather than portray their appearance, and that such design elements do not merely convey information but also directly affect the appearance of the external thing whose appearance they are being used to change. Buccafusco & Fromer, *Fashion’s Function*, *supra* note 12, at 75 n.119. The statute itself does not clarify which reading is “right,” so an alternative reading is arguably available—one that would characterize the entire function of the placement of the design as communicating a particular visual image to the viewer. This would interpret conveying information more broadly, as something akin to a notion of communicative interaction. See also Ochoa, *supra* note 228, at 117 (“[T]he reason a blank cheerleading uniform is less useful than a colorful one is because it fails to convey information; but conveying information is a ‘utilitarian function’ that is excluded from the definition of a ‘useful article.’ A blank cheerleading uniform remains equally useful in all of the ways that matter to the statutory definition.”).

261. Burk, *supra* note 145, at 607 (describing the different kinds of information that can be conveyed in scientific literary work).

those intrinsic functions could reasonably include not only the body coverage functions of garments but also the fact that the designs used optical illusions to make their wearers look thinner or stronger.²⁶² Whether referring to cheerleading uniform designs or to camouflage, the designs in use serve specific visual functions whose perceptual impact would be predictable and clearly definable.²⁶³ In other contexts, features responsive to the visual or auditory needs of visually impaired or hearing-impaired users could also reasonably be considered intrinsic in this sense.²⁶⁴ By contrast, functions—other than those such as marketing or branding functions—could reasonably be considered extrinsic.²⁶⁵ Similarly, abstract statements of function—such as generally making the wearer “look good” or functioning to attract—would be understandable only by reference to external, changeable, variable, culturally-grounded assessments and

262. See, e.g., Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 56 (noting that many features of garment design—whether two- or three-dimensional—“exploit features of human visual perception and optical illusions to influence the way in which the wearer’s body is perceived”).

263. See, e.g., *id.* at 56–60 (describing such optical illusions and their effect on the perception of the wearer); Marchese, *supra* note 115, at 412 (arguing that the arrangement of basic shapes on the body in order to emphasize particular areas and to achieve an “external effect of modifying one’s appearance” should be considered an uncopyrightable function and that “[t]he graphics are inseparable from this function because they dictate the method by which the function operates”).

264. See Ghosh, *supra* note 5, at 98.

265. This may be where I depart from Professors Buccafusco and Fromer’s view that in a “dual-nature” context (in which design components are both expressive and utilitarian), any contribution of a PGS feature to viewers’ perception of a useful work should be considered intrinsically functional and therefore uncopyrightable. See Buccafusco & Fromer, *Fashion's Function*, *supra* note 12, at 83. This Article takes the position that there is a material difference between aesthetic elements making the wearer look “thin” by contrast to making her look “good” for purposes of separability. Optical illusions that achieve the former are more objectively identifiable (although, of course, there is bound to be debate over degrees of thinness and effectiveness). Extending functionality to design elements that simply make the wearer look “good,” though, which *Fashion's Function* can be read to do, seems to take the functionality of aesthetic elements too far. See *id.* at 55. To the extent that Buccafusco and Fromer only mean to characterize specific design choices that are responsive to perceptual tricks as functional, this Article agrees. See *id.* Beyond that, I believe an interpretation of function at a subjective level of “looking good” is too vague, abstract, and contestable. Professors Buccafusco and Fromer argue that whether a design feature should be considered solely expressive and therefore copyrightably non-functional should be assessed by the views of both consumers and designers or experts. *Id.* at 80. Perhaps if only an expert’s view were used—focusing on the employment of perceptual techniques designed to accomplish particular identifiable ends—the uncertainty of the subjective “looking good on’ function” could be mitigated. *Id.* at 103.

would thus be harder to identify as the kind of “intrinsic” function identified in the statute.²⁶⁶

The middle-ground approach to function would have the benefit of providing a generally applicable rule that would be implicitly responsive to the anticompetitive concerns raised by aggregate copyright registration strategies.²⁶⁷ If the PGS elements had objectively definable perceptual and neurological impacts of an identifiable sort, then they would be considered inseparable. Beyond those types of functions, however, the analysis becomes much more subjective, so a presumption of separability could be workable—subject to a copyright abuse defense.

VII. CONCLUSION

In the final analysis, *Star Athletica*'s new separability test promises illusory simplicity. The issues raised by hybrid works cannot simply be resolved by one vague and seemingly simple test (which is applied differently by the majority and the dissent even in its own context). Both steps of the new separability inquiry are dangerously indeterminate and could well be interpreted as opening the door to the routine copyrightability of useful articles with attractive designs—contrary to the Copyright Act and the congressional plan. Regardless of its elusive qualities, then, *Star Athletica* could end up being a radical step in the expansion of copyright. This is because instead of undemanding predictability, the new separability will invite extensive litigation pushing the boundaries of protectability with respect to functional works. Even if courts winnow out the worst of the opportunistic cases, there is a nonnegligible danger that the doctrine will veer from a rational track. This is particularly likely if early cases begin by overprotecting PGS elements in hybrid works. Fake simplicity in an environment of otherwise increasing IP property claims will tend toward overprotection, whatever its claimed limits.

266. Cf. Samuelson, *supra* note 134, at 357 (citing *Baker v. Selden*, 101 U.S. 99, 103–05 (1879) for identifying “ornamentality, appeal to taste, and explanation as characteristics of expressiveness in copyrighted works”).

Professors Lee and Sunder argue that when “look and feel” expresses the zeitgeist, extending principles of IP law undermines innovation and cultural cohesion. Lee & Sunder, *supra* note 134, at 534–35. I am not arguing here that exclusive rights should not be relaxed when dealing with design as zeitgeist. As Professors Lee and Sunder recognize, copyright seeks to deal with this issue through its prohibition on the copyrightability of *scenes à faire*. *Id.* The point in this Part is that cultural standardization seems too unpredictable and variable a basis to ground separability analysis.

267. Cf. Ghosh, *supra* note 5, at 99 (“Copyright protection that inhibits competition and innovation should be filtered out through functionality.”).

There is reason to worry that this presents a greater danger than the embarrassment of tests available under prior separability law.

All, of course, is not lost. The *Star Athletica* Court made sure to note that it had not opined on whether Varsity Brands' designs on its cheerleader uniforms, even though separable, would satisfy the rest of the copyrightability requirements.²⁶⁸ It therefore punted the question of artistic functionality to lower courts applying downstream copyright doctrines: originality, exclusion doctrines (such as merger doctrine, *scenes à faire*, and the prohibition on copyright for processes, systems, and methods of operation), and infringement analysis. Query whether lower courts will read originality more stringently in useful works cases; whether they will be quick to find merger, *scenes à faire*, or processes; or whether they will apply filtration analysis to substantial similarity inquiries for infringement in useful work cases because of the fundamental functionality they involve.

Still, even if the other doctrines can compensate for some of the indeterminacy of the new approach and push back against overprotection, both the new separability test and the other limiting doctrines focus on the copyrightability of *individual* designs. Even if finding separability and granting copyright is reasonable in any given individual case, it does not address the hidden issue regarding the *aggregate* effects of multiple copyright registrations for designs in a similar vein.

While the administrative solution of relying on the Copyright Office might have some surface appeal, it is not workable. Alternatively, it would be possible to craft a copyright abuse claim to capture problematic aggregate registration strategies. But this is not a general rule; at best it provides an equitable ground for excusing a defendant's copying in an individual case. One potential alternative ignored by *Star Athletica* could have been a definition of function that could reduce the likely success of aggregate design copyright registrations as anticompetitive tools in the underlying useful article markets. Aesthetic elements can have a variety of communicative and noncommunicative functions. Some of them—such as those in *Star Athletica* itself—can employ human perceptual quirks in order to affect the ways in which their users appear. So a binary distinction between aesthetic and functional vision does not in fact represent reality or properly ground policy. Still, some kind of line must be drawn along the broad spectrum of possible functionalities, lest

268. See *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1012 n.1 (2017) (“We do not today hold that the surface decorations are copyrightable. We express no opinion on whether these works are sufficiently original to qualify for copyright protection or on whether any other prerequisite of a valid copyright has been satisfied.” (citation omitted)).

aesthetic works lose too much protection. The *Star Athletica* Court could have attempted to define the relevant functionality line. A policy-infused interpretation of functionality grounded on statutory commitments would have allowed it to be sensitive to Congress's desires to forestall anticompetitive behavior in consumer product markets, to protect expressive works, and to maintain IP boundaries by channeling IP problems to their appropriate domains. Instead, the Court used a dessicated approach to textualism in order implicitly to adopt a narrow, mechanical, and unsatisfactory definition of utility. Had it chosen a middle ground based on congressional IP policy, the threat of overprotection would loom far less large.