Copyright Protection for Conceptually Separable Artistic Features Post-\textit{Star Athletica}: A Useful Article on Useful Articles

Daan G. Erikson

\textit{Husch Blackwell LLP.}

Follow this and additional works at: https://scholarship.kentlaw.iit.edu/ckjip

\textcolor{blue}{Part of the Intellectual Property Law Commons}

Recommended Citation


Available at: https://scholarship.kentlaw.iit.edu/ckjip/vol18/iss1/3

This Article is brought to you for free and open access by Scholarly Commons @ IIT Chicago-Kent College of Law. It has been accepted for inclusion in Chicago-Kent Journal of Intellectual Property by an authorized editor of Scholarly Commons @ IIT Chicago-Kent College of Law. For more information, please contact dginsberg@kentlaw.iit.edu.
COPYRIGHT PROTECTION FOR CONCEPTUALLY SEPARABLE ARTISTIC FEATURES POST-STAR ATHLETICA: A USEFUL ARTICLE ON USEFUL ARTICLES

DAAN G. ERIKSON*

ABSTRACT

In the wake of the U.S. Supreme Court’s ruling in Star Athletica v. Varsity Brands in 2017, U.S. federal district courts and the Copyright Office Review Board have grappled with the Supreme Court’s reimagined conceptual separability test for determining the copyrightability of artistic aspects of useful articles. An examination of the decisions in the first eighteen months post-Star Athletica reveals district courts have interpreted the Supreme Court’s guidance inconsistently, with some courts adding language to the test and even using overruled portions of previous tests. The author takes an empirical approach to evaluating such decisions and the trends that emerge from them. The examined range begins at the issuance of the Star Athletica decision in March 2017 and ends in mid-October 2018. Because courts continue to struggle to define protectable elements of useful articles despite the Supreme Court’s guidance, the author proposes that Congress should enhance the conceptual separability test in the Next Great Copyright Act. In the meantime, litigants may take some lessons from Star Athletica, such as to examine whether the object even constitutes a useful article and to disregard artistic judgment and the remainder of a useful object aside from the separable design. Also, litigants

* Associate, Husch Blackwell LLP. B.A., 2009, New York University, Gallatin School of Individualized Study; Visiting J.D. Student, 2011-2012, Fordham Law School; J.D., 2012, Loyola Law School, Los Angeles. The author wishes to thank Professor Hugh C. Hansen for giving him his first job after law school at the Fordham IP Institute and for imparting his copyright and legal realist wisdom. The views expressed in this article are those of the author and not necessarily those of his employer or its clients.
may consider the guidance that emerges from lower court cases, such as the “primary function” test from Judge Forrest of the Southern District of New York.

Table of Contents

I. INTRODUCTION .............................................................. 56

II. OVERVIEW OF THE STAR ATHLETICA DECISION ............. 61
   A. Background and Brief History of Conceptual Separability .............................................................. 61
   B. Back to the Statute? The Supreme Court’s Test ......... 62
   C. Concurrence and Dissent .............................................. 64
      1. Justice Ginsburg’s Concurrence .......................... 64
      2. Justice Breyer’s Dissent ........................................ 64
   D. Takeaways from the Supreme Court’s Holding ............. 65
   E. District Court Decision Dismissing Counterclaims and Complaint ......................................................... 65

III. FEDERAL COURT DECISIONS AFTER STAR ATHLETICA .... 66
   A. Inhale, Inc. v. Starbuzz Tobacco, Inc. ......................... 67
      1. Background .......................................................... 67
      2. Application of Star Athletica and Conceptual
         Separability Analysis ............................................. 68
   B. Design Ideas, Ltd. v. Meijer, Inc. ............................... 71
      1. Background .......................................................... 71
      2. Application of Star Athletica and Conceptual
         Separability Analysis ............................................. 72
   C. Triangl Group Limited v. Jiangmen City Xinhui District
      Lingzhi Garment Co. Ltd ........................................... 73
      1. Background .......................................................... 73
      2. Application of Star Athletica and Conceptual
         Separability Analysis ............................................. 74
   D. Jetmax Limited v. Big Lots, Inc. ................................. 76
      1. Background .......................................................... 76
      2. Application of Star Athletica and Conceptual
         Separability Analysis ............................................. 77
   E. Lego A/S v. Best-Lock Construction Toys, Inc. ............. 79
      1. Background .......................................................... 79
2. Application of Star Athletica and Conceptual Separability Analysis ........................................ 81

F. Silvertop Associates, Inc. v. Kangaroo Manufacturing, Inc. ..................................................... 82
   1. Background ......................................................................................................................... 82
   2. Application of Star Athletica and Conceptual Separability Analysis ................................ 83

G. Ross v. Apple, Inc. .................................................................................................................... 86
   1. Background ......................................................................................................................... 86
   2. Analysis of Star Athletica and Conceptual Separability ..................................................... 88

H. Glass Egg Digital Media v. Gameloft, Inc. ................................................................. 90
   1. Background ......................................................................................................................... 90
   2. Discussion of Star Athletica and Conceptual Separability .................................................. 91

IV. COPYRIGHT OFFICE REVIEW BOARD DECISIONS AFTER STAR ATHLETICA ........................................ 92

A. Overview and Background .................................................................................................... 92
   1. Procedure and Standards of the Copyright Office Review Board ........................................ 92
   2. Methodology of Decisions Reviewed ................................................................................. 93

B. Refusals Reversed in the First Eighteen Months After Star Athletica .................................... 94
   1. Trilliane Strand .................................................................................................................... 94
   2. Amaca ................................................................................................................................ 95
   3. Wanderer ............................................................................................................................ 96
   4. Pendant Lamp – 76 ............................................................................................................ 97
   5. Floor Liner .......................................................................................................................... 99

C. Refusals Affirmed in the First Eighteen Months After Star Athletica .................................... 101
   1. Pizza Slice Pool Float ......................................................................................................... 101
   2. UR5 .................................................................................................................................... 102
   3. Arlon FESPA/ISA 2014 Trade Show,” 12/14/2017 .......................................................... 103

V. CONCLUSION AND THE FUTURE OF CONCEPTUAL SEPARABILITY ........................................ 107
I. INTRODUCTION

In the wake of the U.S. Supreme Court’s ruling in *Star Athletica v. Varsity Brands* in 2017,1 U.S. federal district courts and the Copyright Office Review Board (“CORB”) have grappled with the Supreme Court’s reimagined conceptual separability test for determining the copyrightability of artistic aspects of useful articles. An examination of the decisions in the first eighteen months post-*Star Athletica* reveals that district courts have interpreted the Supreme Court’s guidance inconsistently, with some courts adding language to the test and even using overruled portions of previous tests.2

Lower courts do not always follow the Supreme Court in intellectual property cases.3 While the United States Supreme Court’s *Star Athletica* ruling directed courts on what not to consider in analyzing conceptual separability, in the first eighteen months after *Star Athletica*, with one exception, no district court’s issued decision follows the Supreme Court’s guidance to the letter of the law.4

The author’s empirical review of all relevant federal court decisions referencing the Supreme Court’s decision in the first eighteen months after *Star Athletica* reveals that some lower courts still use overruled tests or sua sponte embellishments. For example, some look to physical separability,5 at least one judge has used his own artistic judgment,6 another court has embellished the test and looked to whether the “primary purpose” of the separable design feature is functional or artistic,7 and another ties in scènes à faire analysis of the “genre” of a work.8

When federal courts and the CORB determine copyrightability, their originality analysis closely follows the conceptual separability analysis (i.e., is the conceptually separable part of a utilitarian object sufficiently original

---

2. See infra Section III.
4. See infra Section III.
to merit copyright protection?), 9 though courts can decide separability without deciding originality. 10

The Copyright Office typical sets the threshold of originality higher than federal courts. 11 The author’s empirical review of all relevant CORB decisions in the examined time frame post-Star Athletica (March 2017 to mid-October 2018) reveals that the CORB grants protection to sufficiently original artistic features that readily appear physically separable. 12 Cases concerning more integrated features present greater challenges to courts and the Copyright Office. 13 Such cases can result in muddled rulings that lean more heavily on the originality analysis than the question of whether the features are conceptually separable. 14 Also, courts and the CORB also seem challenged by two-dimensional, pictorial and graphic works that depict useful objects, sometimes mistakenly applying the separability analysis to such works. 15

Overall, the author’s analysis reveals that courts continue to struggle with conceptual separability despite any clarification from the U.S. Supreme Court in Star Athletica. Viewing the examples in the examined period, Congress may take up revisions in the Next Great Copyright Act, a development envisioned by former Register of Copyrights Maria Pallante, 16 to clarify the conceptual separability test and refine the definition of “useful article.” 17 The author suggests Congress may incorporate some of the

---

9. See infra Sections III and V.
11. See, e.g., Roberta Horton, The Threshold of Copyright Protection After American Airlines, LAW360 (Feb. 26, 2018, 2:17 PM), https://www.law360.com/articles/1013278/the-threshold-of-copyright-protection-after-american-airlines (“In our view, the courts have adopted more liberal standards for evaluating creativity than has the Copyright Office, reflecting a tension between the agency’s determinations and the courts’ more reasonable interpretations of ‘creativity.’”).
12. See, e.g., Trillane Strand, CORB Decision at 3 (July 27, 2017); Amaca, CORB Decision at 2 (July 27, 2017); Wanderer, CORB Decision at 2 (Nov. 28, 2017).
16. Maria A. Pallante, The Next Great Copyright Act, 36 Colum. J.L. & Arts 315 (2013) (the author notes he was present to hear Register Pallante deliver her address at the 2013 Horace S. Manges Lecture, transcribed in the cited law journal article); see also The Register’s Call for Updates to U.S. Copyright Law: Hearing before the H. Subcomm. on Courts, Intell. Prop. and the Internet of the H. Comm. on the Judiciary, 113th Cong. 4–38 (2013) (statement of Maria A. Pallante, Register of Copyrights, the U.S. Copyright Office).
17. See infra Section V.
language a district court judge found helpful to determine if a feature is “primarily” functional or artistic.\(^\text{18}\)

In the meantime, litigants may take some lessons from *Star Athletica*, such as to examine whether the object even constitutes a useful article and to disregard artistic judgment and the remainder of a useful object aside from the separable design.\(^\text{19}\) Also, litigants may consider the guidance that emerges from lower court cases, such as the “primary function” test from Judge Forrest of the Southern District of New York.\(^\text{20}\)

### II. OVERVIEW OF THE *STAR ATHLETICA* DECISION

#### A. Background and Brief History of Conceptual Separability

Copyright law allows protection for, among other kinds of works, pictorial, graphic, and sculptural works.\(^\text{21}\) However, copyright law does not protect useful articles.\(^\text{22}\)

The Copyright Act of 1976 codified the test for, broadly speaking, whether certain decorative features of useful articles could be copyrighted.\(^\text{23}\) The test codified the spirit of the Supreme Court’s decision in *Mazer v. Stein*,\(^\text{24}\) and included some language from the Copyright Office’s regulation it promulgated following *Mazer*.\(^\text{25}\)

By the time of *Star Athletica*, different circuit courts and scholars used at least nine different tests, with courts in the same circuit sometimes even

---


\(^{19}\) See infra Sections II and V.

\(^{20}\) See infra Section III(D).


\(^{22}\) Id. §§ 101, 113. Also, it remains an open question whether copyright law should protect such objects. That said, copyright law does provide *sui generis* protection for two kinds of useful article, boat hulls and semiconductor chip layouts. 17 U.S.C. §§ 1301 et seq. & 901 et seq. Also, when Congress revised the Copyright Act in 1976, it declined to enact *sui generis* protection for “industrial designs.” H.R. REP. NO. 94-1476, at 50, 54–55 (1976).


\(^{24}\) 347 U.S. 201, 217 (1954) (holding a statute of a dancer copyrightable notwithstanding the fact that it was used as the base of a lamp). In codifying the holding from *Mazer*, Congress sought to “encompass all original pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection.” H.R. REP. NO. 94-1476, at 54 (1976). Further discussion of other areas of intellectual property that may protect non-functional aspects of useful articles falls outside the scope of this article.

\(^{25}\) 37 C.F.R. § 202.10(c) (1960) (“If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representations, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.”).
diverging, as courts struggled with the best language to protect creators of various useful articles that featured decorative elements.\textsuperscript{26}

Congress and the Copyright Office have historically considered clothing a useful article.\textsuperscript{27} Accordingly, copyright law cannot protect the cut or style of clothing, though it can protect patterns.\textsuperscript{28}

\textit{Star Athletica} concerned whether the designs on cheerleading uniforms were conceptually separable from the useful article such that the designs could be protectable under copyright law. The United States Supreme Court granted certiorari to clarify the proper test.\textsuperscript{29}

B. Back to the Statute? The Supreme Court’s Test

Justice Thomas authored the opinion of the court, which also included Justices Roberts, Alito, Sotomayor, and Kagan.\textsuperscript{30} Justice Ginsburg concurred;\textsuperscript{31} Justice Breyer dissented and Justice Kennedy joined Justice Breyer’s dissent.\textsuperscript{32}

Writing for the majority, Justice Thomas held:

\begin{quote}
[A]n artistic feature of the design of a useful article is eligible for copyright protection 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 in some other medium if imagined separately from the useful article.\textsuperscript{33}
\end{quote}

Justice Thomas’s two-part test closely mirrors the language of the statute:

\begin{quote}
[T]he 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
\end{quote}

\textsuperscript{26} See Varsity Brands, Inc. v. Star Athletica, L.L.C., 779 F.3d 468, 484–85 (6th Cir. 2015) (discussing various tests).

\textsuperscript{27} See Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,531 (Nov. 5, 1991); U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICE § 311.1 (3d ed. 2017); see also 11 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 924.3(A) (2018).

\textsuperscript{28} COMPENDIUM (THIRD) § 618.4(C).


\textsuperscript{31} Id. at 1018 (Ginsburg, J., concurring).

\textsuperscript{32} Id. at 1030 (Breyer, J., dissenting).

\textsuperscript{33} Id. at 1016.
capable of existing independently of, the utilitarian aspects of the article.\textsuperscript{34}

The small differences in language are perhaps negligible, for example, Justice Thomas’s “can be perceived” as compared with the statute’s “can be identified.” The Supreme Court’s new test adds some language about the artistic feature qualifying as a “protectable” pictorial, graphic, or sculptural ("PGS")\textsuperscript{35} work if “imagined separately” rather than that the examined features merely must be “capable of existing independently” from “the utilitarian aspects of the article.”

Query whether and how a design could meet the second prong, qualifying as a “protectable” PGS work, and simultaneously not satisfy the statutory originality requirement.\textsuperscript{36} Apparently, the Supreme Court saw no confusion on the point since it declined to express an opinion on originality and “any other prerequisite of a valid copyright” in the case, indicating that the separability test does not contemplate such matters.\textsuperscript{37}

Also, as quoted above, one part of the Supreme Court’s opinion holds “an artistic feature of the design of a useful article is eligible for copyright protection if the feature [meets the two-part test],”\textsuperscript{38} while another part of the Supreme Court’s opinion prefaced its test with language that “a feature incorporated into the design of a useful article is eligible for copyright protection only if the feature . . . [meets the two-part test].”\textsuperscript{39} In other words, in the first instance, separability may be sufficient to an artistic aspect of a useful article’s qualifying for copyright protection, but in the second instance, separability is necessary, but not sufficient. In light of the Supreme Court’s comments on declining to express an opinion on other prerequisites of a valid copyright, notwithstanding the somewhat confusing and contradictory language, courts and litigants may consider separability necessary but not sufficient to copyrightability and may consider the originality analysis completely separate from the separability test.

In the author’s opinion, the most useful guidance in \textit{Star Athletica} lies in that the Supreme Court overruled previous tests and explicitly rejected certain considerations, as discussed below.\textsuperscript{40}

\begin{itemize}
  \item \textsuperscript{34} 17 U.S.C. § 101.
  \item \textsuperscript{35} The Supreme Court abbreviates “pictorial, graphic, or sculptural” as “PGS.”
  \item \textsuperscript{36} 17 U.S.C. § 102 (“Copyright protection subsists, in accordance with this title, in original works of authorship . . .”)\textsuperscript{40}
  \item \textsuperscript{37} \textit{Star Athletica, L.L.C.}, 137 S. Ct. at 1012 n.1.
  \item \textsuperscript{38} \textit{Id.} at 1016 (emphasis added).
  \item \textsuperscript{39} \textit{Id.} at 1007 (emphasis added).
  \item \textsuperscript{40} See infra Section II(D).
\end{itemize}
C. Concurrence and Dissent

Due to the complicated history of the conceptual separability test and the struggles courts continue to face, the Star Athletica concurrence and dissent merit brief discussion.

1. Justice Ginsburg’s Concurrence

Justice Ginsburg’s concurrence emphasized that the Court need not have opined on conceptual separability at all. She noted that the registered designs are two-dimensional works “reproduced on useful articles” not “designs of useful articles.” In other words, “[b]ecause the owner of a copyright in a pre-existing PGS work may exclude a would-be infringer from reproducing that work on a useful article, there is no need to engage in any separability inquiry to resolve” the case. To support her claim, Justice Ginsburg reproduced copies of Varsity Brands’s copyright applications as an appendix to her opinion, showing that Varsity Brands filed to register its designs as “2-dimensional artwork” and more specifically in some cases as “fabric design (artwork).”

Despite Justice Ginsburg’s keen observations, no lower court in the examined time period incorporated her analysis into an opinion. Yet her guidance reminds future litigants to consider the nature of the works at issue carefully. Courts should view her remarks as a reminder of the doctrine’s subject matter limitations.

2. Justice Breyer’s Dissent

Justice Breyer dissented, joined by Justice Kennedy, writing about cat lamps and shovels as art. Of course, in light of the majority’s new test, it does not matter if a cat lamp base statue holds up the lamp or not, because the clarified test ignores the remainder of the object left behind, and only looks at the registrability of the conceptually separable portion.

41. Star Athletica, L.L.C., 137 S. Ct. at 1018 (Ginsburg, J., concurring).
42. Id. (emphasis in original).
43. Id.
44. See id. at 1019–29.
45. See id. at 1019 (“In short, Varsity’s designs are not themselves useful articles meet for separability determination under § 101; they are standalone PGS works that may gain copyright protection as such, including the exclusive right to reproduce the designs on useful articles.”) But see, e.g., Glass Egg Dig, Media v. Gameloft, Inc., No. 17-cv-04165-MMC, 2018 WL 3659259 (N.D. Cal. Aug. 2, 2018) (referencing Star Athletica in connection with a computer model work); see infra Section III(H) for further analysis of Glass Egg Dig, Media; see also infra Sections III(G)(2), IV(C)(3).
46. Star Athletica, L.L.C., 137 S. Ct. at 1030 (Breyer, J., dissenting).
Some district courts do wrestle with Justice Breyer’s concerns about art anyway. However, the question is not whether a shovel can be art. Before performing the separability analysis involving an assessment of whether a feature “can be perceived as a two- or three-dimensional work of art,” the test requires examining only the “artistic feature” separate from the overall useful article. Relatedly, copyright law in its current form cannot protect many aesthetically pleasing articles where form and function cannot be separated even conceptually.

D. Takeaways from the Supreme Court’s Holding

The Supreme Court issued significant guidance about what courts, the Copyright Office, and litigants should and should not consider with regard to determining the copyrightability of decorative portions of useful articles. After removing the conceptually separable design, a useful article need not remain. Courts and the Copyright Office now need focus only on any separable part, not any “left behind” parts. Further, Justice Thomas abrogated any distinction between physical separability and conceptual separability, holding conceptual separability covers all considerations. Justice Thomas also confirmed that courts cannot consider artistic judgment (neither the artist’s purpose nor the judge’s view of marketability).

To be clear, the Supreme Court’s test reverberates far beyond the reaches of fashion law, though the Supreme Court made sure to confirm that the shape, cut, and physical dimensions of clothing are still not eligible for copyright.

E. District Court Decision Dismissing Counterclaims and Complaint

The Supreme Court did not express any opinion on the copyrightability of the cheerleading uniform designs, leaving any evaluation of originality to the district court. The district court reopened the case to resolve any

51. Id. at 1013.
52. Id. at 1015.
53. Id. at 1016.
54. Id. at 1012 n.1.
remaining issues, such as whether the designs at issue in the case were protected by copyright.55

In reopening the case, the district court avoided answering the question of originality.56 Star Athletica had counterclaimed that Varsity’s designs were unoriginal such that copyright law could not protect them.57 However, instead of determining whether such designs satisfied the originality requirement and could be protected, the district court characterized the counterclaim as an affirmative defense, which it could review in its discretion under precedent, but which it chose not to review.58

Therefore, the district court dismissed the remaining counterclaims without deciding if the designs on the cheerleading uniforms met the threshold of originality required to merit copyright protection.59 In an unusual move, the district court allowed the plaintiff to settle the case with the defendant’s insurance company, over the defendant’s objections.60 Accordingly, while we have a new test for conceptual separability, we do not have new guidance on whether such simple designs constitute copyrightable expression.

III. FEDERAL COURT DECISIONS AFTER STAR ATHLETICA

To review lower court interpretations in the first eighteen months post-Star Athletica, the author looked to those cases from March 2017 to mid-October 2018 that quoted the decision and involved at least a purported useful article, and also examined any later developments in the Star Athletica case specifically.

Eight relevant federal court opinions in the examined period post-Star Athletica cite the Supreme Court’s decision regarding its new test for the conceptual separability analysis. Of the eight relevant decisions, the first in time is dicta,61 the second mirrors the Supreme Court’s language,62 the third

---

56. Id. at *2.
57. Id.
58. Id. at *1–3.
59. Id. at *3.
60. Id. at *1–3; see also Bill Donohue, Weird Cheerleader Copyright Settlement Finalized, LAW360 (June 20, 2018, 10:29 PM), https://www.law360.com/ip/articles/1055819.
addresses the issue in a spoken order entering a default judgment, the fourth addresses conceptual separability but not originality at summary judgment, the fifth remains ongoing as of this writing and does not include significant substantive evaluation of conceptual separability, the sixth contains extensive separability analysis, the seventh contains a brief separability analysis, and the eighth cites Star Athletica as the lodestar for separability analysis but does not appear to involve a useful article and contains no substantive analysis of useful articles. In the examined time frame, five of the six issued opinions that do substantively evaluate conceptual separability include language not found in the Supreme Court’s test, perhaps indicating the need for courts to supplement or augment the Supreme Court’s guidance.

A. Inhale, Inc. v. Starbuzz Tobacco, Inc.

1. Background

Judge Wright of the Central District of California heard a motion to reconsider from plaintiff Inhale, Inc., requesting that the court reopen the case in light of the Supreme Court’s decision in Star Athletica.

Previously, the Central District of California and the Ninth Circuit found that the shape of the hookah water container and its function were not conceptually separable and thus the water container was not copyrightable: “the shape of a container is not independent of the container’s utilitarian function.” Subsequently, the U.S. Supreme Court denied certiorari.

On the motion for rehearing, Judge Wright denied the motion to reconsider. "At some point, all cases must end. Inhale does not seem to understand this, as it moves to reopen this proceeding five years after the Court’s initial case dispositive summary judgment order, and approximately three years after its unsuccessful appeals to the Ninth Circuit and the Supreme Court." The emphasized language indicates things did not look good for Inhale.

The court then indicated that Inhale did not cite any relevant, binding authority from non-habeas civil cases where the courts reopened the cases based on a change in the law years after a final decision and exhaustion of the appeals process. The court distinguished and was not persuaded by persuasive authority.

The court declined to reconsider the case under the rationale that to do so "would seriously undermine the finality of judgments and open the floodgates of litigation by encouraging any disgruntled litigant to file a Rule 60(b)(6) motion if they believe there has been even a tangentially-related change in law."

2. Application of Star Athletica and Conceptual Separability Analysis

Following Judge Wright’s denial of the motion to reconsider, Judge Wright authored significant conceptual separability analysis based on the Supreme Court’s test in Star Athletica. “Alternatively, the Court denies Inhale’s motion because application of the Star Athletica test would not change the outcome of the underlying proceeding.” However, all of his analysis amounts to dicta in light of his denial of the motion to reconsider.

Judge Wright correctly noted that the U.S. Supreme Court “explicitly abrogated a number of other tests, including the physical separability test and the designer’s perspective test, each of which factored into this Court’s original decision.” He went on to criticize Inhale for claiming copyright in the water container as a whole and not any subset of its features.

74. Id. at *2 (emphasis added).
75. Id. at *2.
76. Id.
77. Id. (emphasis added).
78. Id.
79. Id.
80. Id. at *3 ("Inhale fails to point out a sculptural feature of the water container or a subset of features of the water container that may serve as the predicate for application of the Star Athletica test; it
notwithstanding the fact that Inhale owned a copyright registration for the water container as a sculptural work. See Inhale’s hookah water container below on the left and those of Starbuzz Tobacco in the center and on the right.

The court noted, “Inhale lost the ability to claim that the water container as a whole constitutes a piece of ‘modern sculpture,’ a ‘museum piece’ or ‘standalone’ work of art when it agreed in the underlying proceeding that the water container was a useful article.” However, the U.S. Supreme Court held that artistic judgment and intent is irrelevant; therefore whether Inhale claimed the water container as a “modern sculpture” or “museum piece” appears irrelevant. Further, legislative history shows that Congress intended to disregard “factors such as mass production” and “commercial exploitation” in determining the availability of copyright protection for PGS works.

seeks protection not for any particular feature of the water container but for the way the features as a whole ‘are arranged to form [the] hookah water container.’”

82. Id. at Ex. C.
The court then stated it was left to determine if “any of the water container’s features individually, or a subset of those features” could be perceived as a two- or three-dimensional work of art separate from the useful article.86 Judge Wright wrote that they could not be, as “they are essentially geometric shapes of the most common type.”87

“Combining two or three of these common geometric shapes together does little to improve the situation—the components of the water container at issue are simply not works of art in even the broadest, most liberal sense.”88 Judge Wright cited to Copyright Office’s restrictive language in the Compendium II.89 However, while the Star Athletica test does include the wording “work of art,” the Supreme Court rejected artistic judgment as part of the separability analysis, implying the test targets instead the distinction between utilitarian and non-utilitarian features.90 Further, the author submits that it may be open for discussion whether the hookah water container is only a combination of common shapes, or whether nearly anything on the planet, for that matter, is arguably composed of a combination of common shapes.

Judge Wright went on to opine, “This is not to say that there are not some, if not many, useful articles composed of unique geometric shapes variations or unique combinations of geometric shapes that might pass muster under the Star Athletica test.”91 While Judge Wright cited to the Compendium II, his assessment still amounts only to dicta. “It is only to say that the water container at issue here is no Noguchi Table.”92 The judge inserted in his decision the image of a Noguchi table, reproduced below.93

87. Id.
88. Id.
89. See id. (citing U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 503.02(a) (2d ed. 1984) as “indicating that ‘common’ geometric shapes by themselves are not copyrightable”).
93. Id.
Query, what is conceptually separable about a Noguchi table apart from its useful parts? The author posits that the judge’s opinion smacks of high art artistic judgment, not allowed by *Star Athletica*, and that the judge rejected copyrightability here at least in part due to the pedestrian nature of the product.94

Judge Wright would do well to remember Justice Holmes’s wise words concerning another type of copyrightable work, quoted also by the Supreme Court in *Star Athletica*, “It would be a dangerous undertaking for persons trained only to the law to constitute themselves the final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”95

B. Design Ideas, Ltd. v. Meijer, Inc.

1. Background

Plaintiff Design Ideas, Ltd. brought suit against the various defendants in the Central District of Illinois, alleging copyright infringement of its “sparrow clip” clothespins.96 See plaintiff’s work below on top and defendants’ on the bottom.97

94. *Cf.* L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 488 (2d Cir. 1976) (affirming judgment of “Uncle Sam” toy bank as insufficiently original to merit copyright protection).

95. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903); *see also Star Athletica, L.L.C.*, 137 S. Ct. at 1015 (citing *Bleistein*, 188 U.S. at 251).

96. Design Ideas, Ltd. v. Meijer, Inc., No. 15-cv-03093, 2017 WL 2662473, at *1 (C.D. Ill. June 20, 2017). In the interest of full disclosure, the author notes that his law firm participated in representing the defendants in this case at the time of the June 20, 2017 decision. Accordingly, the author does not comment on the decision beyond the short factual description contained herein.

Before the Supreme Court decided *Star Athletica*, Judge Myerscough granted partial summary judgment in favor of the plaintiff. She found that the sparrow clip design qualified for copyright protection as it was original and that “the bird design was both physically and conceptually separable from the utilitarian aspect of the work.”

2. *Application of Star Athletica and Conceptual Separability Analysis*

Judge Myerscough’s decision here did not change in any material way after *Star Athletica*, finding that the bird portion of the sparrow clip met both prongs of the Supreme Court’s test, mirroring the language exactly.


100. Id. at *2–3 (“First, the bird portion can be perceived as a three-dimensional work of art separate from the useful article. One can identify the bird portion as having pictorial, graphic, or sculptural qualities. Second, the bird portion would qualify as a protectable sculptural work on its own if it were imaged separately from the useful article into which it is incorporated. The bird portion would be eligible for copyright protection as a pictorial, graphic, or sculptural work had it been originally fixed in some tangible medium other than attached to the clothespin.”)
Then, she rejected the defendants’ arguments that the bird portion of the sparrow clip is itself useful, stating poetically and rhetorically, “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?” She cited and quoted the Compendium III for the proposition that “a sculpture does not become a useful article simply because it could be used as a doorstop or a paperweight.”

C. Triangl Group Ltd. v. Jiangmen City Xinhui District Lingzhi Garment Co., Ltd.

1. Background

Triangl Group, a purveyor of women’s swimwear, filed suit in the Southern District of New York against the various defendants for copying the black T-shaped designs featured on bikini tops and black trim featured on the bikini tops and bottoms, alleging copyright, trademark, and trade dress infringement.

In fact, Triangl Group noted in its complaint that not only had the defendants copied its designs and sold nearly identical bikinis under a different mark and company name at a cheaper price, but the defendants also copied Triangl Group’s actual online catalog photographs and reproduced them on the website where they sold their infringing products. See below.

101. Id. at *3. The author credits Thomas Kjellberg of Cowan, Liebowitz & Latman, P.C. for his interpretation of Judge Myerscough’s words as beat poetry at the Copyright Society of the USA’s Annual Meeting in June 2018.


Plaintiff’s website with its bikini design appears above on the left and defendants’ website appears above on the right. The defendants essentially defaulted. In an order issued from the bench, Judge Gardephe granted plaintiff Triangl Group Limited’s application for default judgment and a permanent injunction based on copyright, trademark, and trade dress infringement.

2. Application of Star Athletica and Conceptual Separability Analysis

In finding copyright infringement, Judge Gardephe held:

Here plaintiffs have properly alleged that the images of their products at issue are copyrightable works owned by plaintiffs, and in light of Star Athletica, it appears most of plaintiffs’ designs are copyrightable because the decorative black trim and T-shape are physically separable and demonstrable as works of art as shown in Exhibits 2 and 10 to the Complaint.

The author finds two technical errors with the holding. First, the judge used the language “physically separable,” but, as discussed above, the Supreme Court abrogated the “physically separable” part of the test. Going forward, the test only inquires whether the feature is conceptually separable (though query whether any physically separable feature is not also conceptually separable).

105. Id. at 15–16.
107. Id. at *11.
108. Id. at *8 (emphasis added).
Second, the court never examined in detail whether the black trim and T-shape were sufficiently original to merit copyright protection. Perhaps misreading the *Star Athletica* decision, which never determined the originality of the cheerleading uniform designs (and even the district court did not, as discussed above), the court here presumed “most of plaintiff’s designs are copyrightable because the decorative black trim and T-shape are physically separable and demonstrable as works of art.”

However, as discussed above, just because a feature “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article” (i.e., meets the first prong) and “(2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article” (i.e., meets the second prong) does not mean it is copyrightable; it only means that it is separable.

Further, in using only the shorthand that Triangl Group’s designs were “demonstrable as works of art,” language that tracks closely to the first half of the Supreme Court’s test, the court’s analysis omitted the second half of the Supreme Court’s test.

Query, if defendants had not defaulted, could they have argued that the works were not original? Could they have argued that the works did not meet the threshold of originality because the designs were just “common geometric shapes,” using the language of the Compendium III?

Due to Triangl Group’s success on the trademark and trade dress claims, perhaps the outcome would not change. Moreover, the court could have heeded Justice Ginsburg’s view of the designs on the bikinis as copyrightable two-dimensional images (not “designs of useful articles” but rather “pictorial or graphic works reproduced on useful articles”), or found infringement based on copying just the photographs. In any event, the court granted a default judgment and permanent injunction. Finally, it is worth noting that in the judge’s efforts to do justice and stop free riders, the judge interpreted the Supreme Court’s test in a manner that favored plaintiffs at least in part due to his omission of any originality analysis.

---

109. See supra Section II(E).
111. See supra Section II(B).
D. Jetmax Ltd. v. Big Lots, Inc.

1. **Background**

In another case in the Southern District of New York, Jetmax Limited brought suit against Big Lots, Inc. and other defendants, alleging the defendants infringed Jetmax’s copyright in a strand of twinkle lights covered with wire-wrapped bulb covers (the “Tear Drop Light Set”). The defendants’ work (the “Advance Light Set”) also consisted of a strand of twinkle lights covered with wire-wrapped bulb covers, though it differed in some respects. “The Advance Light Set does not contain an ornamental dangly and the cover does not have an iridescent finish.” See below.

The plaintiff’s product appears on the left and the defendants’ on the right. Jetmax moved for summary judgment on its copyright infringement claim. Here, the defendants challenged Jetmax in arguing “that the Tear Drop Light Set is not copyrightable because it is a useful article and because it lacks originality.” Defendants filed a cross-motion for summary judgment.

---

116. *Id.* at *2.
117. *Id.*
118. *See id.* at *1.
119. *Id.*
120. *Id.*
Judge Forrest denied both Jetmax’s motion for summary judgment and the defendants’ cross-motion for summary judgment, ruling that Jetmax’s Tear Drop Light Set contained conceptually separable elements, though the court reserved judgment on whether such elements were sufficiently original.  

2. Application of Star Athletica and Conceptual Separability Analysis

In finding that Jetmax’s Tear Drop Light Set contained conceptually separable elements, Judge Forrest held:

Here, the parties do not dispute that the Tear Drop Light Set is a useful article insofar as it serves the ‘intrinsic utilitarian function’ of providing light to a room. Rather, the parties strongly disagree regarding whether the Tear Drop Light Set contains artistic elements that are sufficiently separable in order to merit copyright protection. Having carefully considered this question, the Court finds that the Tear Drop Light Set does contain artistic elements—the decorative covers—that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

Here, the court’s language duplicated the Supreme Court’s test from Star Athletica almost exactly, but the court substitutes language from the statute for part two instead of the language from the Supreme Court (in the court’s opinion, part one, “can be perceived,” is the Supreme Court’s language, while part two, “capable of existing independently,” comes from the statute).

While closely following the Supreme Court’s test, and also mirroring the statute, Judge Forrest added an enhancement to the test not found in either Star Athletica or the statute:

The decorative covers are sculptural works that are capable of existing apart from the utilitarian aspect of the light set, i.e, the light bulbs and other components that cause the Tear Drop Light Set to light a room. The primary purpose of the cover is artistic; once the

121. Id.
122. Id. at *4 (emphasis added).
covers are removed, the remainder is a functioning but unadorned light string.\textsuperscript{125}

The Supreme Court never required that the “primary purpose” of the conceptually separable feature be “artistic.” However, the Supreme Court’s test does include the term “artistic” in that it calls for analyzing an “artistic feature.”\textsuperscript{126}

The author notes that Judge Forrest’s “primary purpose” test evokes but does not replicate the “Primary-Subsidiary Approach” from \textit{Kieselstein-Cord},\textsuperscript{127} as the tests differ in significant respects. In \textit{Kieselstein-Cord}, the court ignored the functionality of the belt buckle as a whole and did not look to any separable aspects. Here, Judge Forrest examined the decorative covers as separate from the utilitarian light strand.

Where the decorative covers adorn a functional light strand that “serves the ‘intrinsic utilitarian function’” of “providing light to a room,” she identified the decorative covers as “capable of existing independently of” the utilitarian light strand.\textsuperscript{128} Judge Forrest’s language meshes nicely with that of the statute, which dictates, “[a]n article that is normally part of a useful article is considered a ‘useful article.’”\textsuperscript{129} Here, the decorative covers are not normally part of providing light to a room.

Further, the Supreme Court’s test holds no concern for the leftover portion of the useful article. Judge Forrest did explicitly recognize this part of the Supreme Court’s ruling in a footnote to her opinion:

Even if the covers reduce glare and serve some utilitarian function, the Supreme Court explained that the imagined remainder of the article “left behind” once the pictorial, graphical, or sculptural element is removed need not “be a fully functioning useful article at all, much less an equally useful one.”\textsuperscript{130}

\textsuperscript{125} \textit{Jetmax Ltd.}, 2017 WL 3726756, at *6 (emphasis added, footnote omitted).
\textsuperscript{126} \textit{Star Athletica, L.L.C.}, 137 S. Ct. at 1016 (“an artistic feature of the design of a useful article is eligible for copyright protection if . . .”).
\textsuperscript{127} \textit{See} Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) (holding “[the primary ornamental aspect of] the belt buckle works at issue “conceptually separable from their subsidiary utilitarian function”). The Sixth Circuit titled the \textit{Kieselstein-Cord} test as the “Primary-Subsidiary Approach” in Varsity Brands, Inc. v. Star Athletica, L.L.C., 799 F.3d 468, 484 (6th Cir. 2015).
\textsuperscript{128} \textit{Jetmax Ltd.}, 2017 WL 3726756, at *4.
\textsuperscript{129} 17 U.S.C. § 101 (2010).
\textsuperscript{130} \textit{Jetmax Ltd.}, 2017 WL 3726756, at *6 n.2 (citation omitted).
Though conceding that the decorative covers “serve some utilitarian function,” the court nevertheless held that they “can be identified separately from, and are capable of existing independently of, the utilitarian aspects” of the useful article.

After examining the conceptual separability issue, Judge Forrest wrote that the Tear Drop Light likely meets the threshold of originality, but reserved judgment on the issue of originality because she said genuine disputes of material fact existed.

While not strictly following the Supreme Court, Judge Forrest’s “primary function” language provides interesting and key guidance to creators, copyright owners, and future litigants. The test conjures a modified version of Carol Barnhart—the court interprets the artistic features as separate from the utilitarian function of the overall article—but in a twist, due to the Supreme Court’s guidance in Star Athletica, Judge Forrest’s test recognizes that a functioning useful article need not remain after separating the artistic features. Judge Forrest’s test in Jetmax provides that a decorative or artistic feature of a useful article may be conceptually separable, despite having some utilitarian function, so long as its primary function is not utilitarian, which may be evident by a utilitarian element left behind.


1. Background

Lego filed suit in the District of Connecticut against the defendants for copyright infringement of its figurines. See below.

131. Id.
132. Id. at *6 (quoting Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1007 (2017)).
134. Carol Barnhart Inc. v. Econ. Cover Corp., 773 F.2d 411 (2d Cir. 1985) (holding mannequins of partial human torsos to be utilitarian articles without any separable, copyrightable features). The Sixth Circuit titled the Carol Barnhart test the “Objectively Necessary Approach,” describing its holding as, “[a] pictorial, graphic, or sculptural feature is conceptually separable if the artistic features of the design are not necessary to the performance of the utilitarian function of the article.” Varsity Brands, Inc. v. Star Athletica, L.L.C., 799 F.3d 468, 484 (6th Cir. 2015).
Best-Lock’s figure is on the left and Lego’s figure is on the right in each image above. As of this writing, the case remains ongoing, though Judge Haight issued an opinion in a discovery dispute that references and interprets *Star Athletica*.


2. Application of Star Athletica and Conceptual Separability Analysis

The defendants moved to defer consideration of Lego’s motion for partial summary judgment and moved to compel production of documents, depositions, and supplemental interrogatory responses. In ruling on the discovery dispute, Judge Haight recognized that the Supreme Court’s ruling in Star Athletica means certain considerations do not apply in a conceptual separability analysis.

In denying defendants’ motion, Judge Haight wrote:

Best-Lock does not explain how discovery as to what Lego considered protectable is relevant to Lego’s motion for summary judgment on the copyright infringement claim. Indeed, Best-Lock’s position appears contrary to that expressed recently in Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1015 (2017), where the Supreme Court noted that in determining whether the design of a useful article is eligible for copyright, the “inquiry is limited to how the article and feature are perceived, not how or why they were designed.” (citing Brandir Int’l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142, 1152 (2d Cir. 1982)). Thus, Lego’s argument that the “scope” of the copyrights would be determined by the registrations and deposit materials, already in the record, is well founded. Best-Lock offers nothing persuasive to the contrary.

As in Star Athletica, artistic motivation does not influence copyrightability. How or why Lego designed its works does not matter. Going even further, Judge Haight held that what the plaintiff considered protectable does not matter. The court can decide what is protectable.

Judge Haight’s opinion differs somewhat from the Inhale case, where the judge there examined how the plaintiff claimed copyright in the hookah water container as a whole and the judge criticized the plaintiff for not identifying what features it considered conceptually separable from the work as a whole. Lego claimed the “copyrighted Minifigure comprises, in whole or in part, wholly original works of authorship that are copyrightable subject

138. Id. at *2.
139. See id. at *6 n.6; see also supra Section II(D).
141. See id. at *6.
142. See id. at *7 n.7.
matter” and that the defendant’s work “is strikingly and substantially similar to the Minifigure Copyrights.”\footnote{144} In other words, Lego did not claim the defendant infringed any particular subset of the figurine, though it noted the torso, head, arms, legs, and feet of the allegedly infringing figurine featured the same dimensions as the Minifigure, in essence claiming copyright in the whole and all of the parts.\footnote{145}

Interestingly, Judge Haight is not new to the conceptual separability analysis. Judge Haight served as the district court judge in the *Brandir* case, where the Second Circuit affirmed his opinion on the non-copyrightability of the bicycle rack (though the Second Circuit reversed his opinion on the trademark claim in that case). As shown above, Judge Haight even cited the Supreme Court’s citation of the *Brandir* case, specifically, the Second Circuit’s affirmance of his opinion.

**F. Silvertop Associates, Inc. v. Kangaroo Manufacturing, Inc.**

1. Background

Silvertop Associates, Inc. d/b/a Rasta Imposta filed suit in the District of New Jersey against defendant Kangaroo Manufacturing, Inc. for copyright infringement of its banana costume, among other causes of action.\footnote{146} See below.


145. Id. The author notes that toys, when they are not mere copies of a useful article, may be considered sculptural works. U.S. COPYRIGHT OFFICE, COMPREHEND OF U.S. COPYRIGHT OFFICE PRACTICES §§ 313.4(A), 503.1(B) (3d ed. revised Sept. 29, 2017). However, it may be an open question whether portions of a toy that fit together with other pieces might be considered useful.

The plaintiff’s work appears at left and the center and right images show the defendant’s works.\textsuperscript{147} By way of background, the court notes that the founder of Kangaroo previously worked for a company that had a business relationship with Rasta Imposta to sell Rasta Imposta’s banana costume.\textsuperscript{148} Rasta Imposta filed a motion for preliminary injunction.\textsuperscript{149}

2. Application of Star Athletica and Conceptual Separability Analysis

The court noted that it was the first in the Third Circuit to interpret the Supreme Court’s \textit{Star Athletica} ruling.\textsuperscript{150} As a preliminary matter, the court briefly described how costumes, including the costume at issue, are useful articles not generally protectable by copyright.\textsuperscript{151} However, as the court recognized, certain features of costumes can be protectable.\textsuperscript{152} The court quoted the \textit{Star Athletica} two-part test.\textsuperscript{153}

Turning to the banana costume at issue, the court acknowledged Rasta Imposta’s claims of certain “unique features of the banana design” as copyrightable: “the overall shape and cutout holes of the costume, the black ends of the banana, and the vertical lines running down the middle of the banana.”\textsuperscript{154} The court held that the costume’s armholes were not protectable, as they “perform a solely utilitarian function” of allowing a person to wear the costume.\textsuperscript{155}

Then, the court discussed how it found other features of the costume, taken as a whole and not dissecting into individual components, protectable under copyright law.\textsuperscript{156} Quoting a Third Circuit decision involving sculptural works resembling rocks or stones inscribed with a verse, Judge Hillman identified “the combination of texture, color, size and shape” as relevant.\textsuperscript{157} Unlike the armholes, Judge Hillman found that “the other features of the

\textsuperscript{148} Id. at 759.
\textsuperscript{149} Id. at 762 n.4.
\textsuperscript{150} Id. at 762 (quoting Masquerade Novelty, Inc. v. Unique Indus., 912 F.2d 663, 670–71 (3d Cir. 1990) (“[A] costume . . . may serve, aside from its appearance, to clothe the wearer . . . .”)).
\textsuperscript{151} See id. at 763.
\textsuperscript{152} Id. at 762–63.
\textsuperscript{153} Id. at 763.
\textsuperscript{154} Id. at 763.
\textsuperscript{155} Id. at 764.
\textsuperscript{156} Id. at 764–65.
\textsuperscript{157} Id. at 764 (quoting Kay Berry, Inc. v. Taylor Gifts, Inc., 421 F.3d 199, 207 (3d Cir. 2005)). The \textit{Kay Berry} decision contains no discussion of useful articles.
Banana Costume can be identified separately from and are capable of existing independently of the utilitarian aspects.”

The court found Rasta Imposta’s registration certificate persuasive, and further, the court stated it “can easily identify the features of the Banana Costume having a pictorial, graphic, or sculptural quality.” The court listed the numerous features:

- a) the overall length of the costume,
- b) the overall shape of the design in terms of curvature,
- c) the length of the shape both above and below the torso of the wearer,
- d) the shape, size, and jet black color of both ends,
- e) the location of the head and arm cutouts which dictate how the costume drapes on and protrudes from a wearer (as opposed to the mere existence of the cutout holes),
- f) the soft, smooth, almost shiny look and feel of the chosen synthetic fabric,
- g) the parallel lines which mimic the ridges on a banana in three-dimensional form, and
- h) the bright shade of a golden yellow and uniform color that appears distinct from the more muted and inconsistent tones of a natural banana.

Judge Hillman held that “if these features were separated from the costume itself and applied on a painter’s canvas, it would qualify as a two-dimensional work of art in a way that would not replicate the costume itself.” Query whether nearly anything applied on a painter’s canvas might become a “work of art.”

Next, the court discussed the merger and scènes à faire doctrines. The court found merger did not apply because Rasta Imposter provided twenty-one examples of banana costumes available in the marketplace “that are easily distinguished from Rasta Imposta’s design . . . .” The court listed numerous ways that banana costumes might differ in appearance.

As for scènes à faire, the court implied there is no such thing as scènes à faire with regard to banana costumes because there is no commonly recognized expression of a banana costume “genre.” In contrast, the court
implies the existence of a public consensus of what an American cheerleading costume looks like.\textsuperscript{166}

While acknowledging Rasta Imposta’s relatively limited scope of rights, the court granted the preliminary injunction due to Rasta Imposta’s “reasonable likelihood of providing ‘near identity’ of the costumes and that the copyright relates to protectable material.”\textsuperscript{167}

The defendant filed an appeal to the Third Circuit on June 11, 2018, which is still pending as of this writing.\textsuperscript{168}

The author submits that the appeal should address, at least, what or whether any “left behind” parts remain after separability. As currently envisioned by Judge Hillman, it appears that the only utilitarian features of the costume are the armholes.\textsuperscript{169} Yet the armholes, being holes, are not a physical part of the costume but merely an absence of fabric or essentially negative space. The author finds it difficult to consider negative space as a “left behind” part of a utilitarian object.

Without any left behind parts, the Third Circuit should find the entire costume functional as a whole. In \textit{Star Athletica}, the Supreme Court held that designs on the cheerleading uniform were separable from the underlying uniform.\textsuperscript{170} The author posits that it is difficult to see how the Third Circuit could affirm the district court’s holding using the district court’s reasoning, as the costume’s features Judge Hillman identified (color, shape, parallel lines, texture and appearance of the fabric) constitute the entire costume and accordingly are not separable from any underlying utilitarian object. However, if the Third Circuit would identify a more limited set of separable, copyrightable features, then the Third Circuit could potentially affirm the holding under different reasoning.

A prior version of the Compendium III, describing registration standards of the Copyright Office, precluded registration of costumes without “two- or three-dimensional design elements that are separable from the costume itself . . . .”\textsuperscript{171} The prior version of the Compendium III advised:

\textsuperscript{166} \textit{Id.} at 765 n.6 (describing “the iconic outfit of an American cheerleader”); \textit{but see} Brief for the United States as Amicus Curiae Supporting Respondents, \textit{Star Athletica, L.L.C. v. Varsity Brands, Inc.}, 137 S. Ct. 1002 (2017) (No. 15-866), 2016 WL 5116853 (discussing “decorations evocative of cheerleading are not immutable, but have evolved over time” and reproducing the Norman Rockwell image \textit{Cheerleaders} from 1952, showing three cheerleaders in outfits quite different from those produced by \textit{Star Athletica} and \textit{Varsity Brands}).

\textsuperscript{167} \textit{Silvertop Assocs., Inc.}, 319 F. Supp. 3d at 768.

\textsuperscript{168} \textit{Appeal of Petitioner-Appellant, Silvertop Assocs., Inc. v. Kangaroo Mfg., Inc.}, No. 18-2266 (3d Cir. June 11, 2018).

\textsuperscript{169} \textit{See Silvertop Assocs., Inc.}, 319 F. Supp. 3d at 764.


\textsuperscript{171} \textit{U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.3(B)} (3d ed. revised Dec. 22, 2014).
[t]he fact that a costume may be intended primarily for ornamentation and show, and secondarily for covering the body, does not change the fact that a costume is a useful article. Whole- or partial-body costumes are considered useful articles and are subject to the separability test, even if they depict a person or thing, or illustrate cultural, historical, or occupational garb or dress.\footnote{Id. § 924.3(A)(2).}

However, the present version of the Compendium III no longer contains the above guidance, including only a reproduction of the \textit{Star Athletica} test along with a note that the Copyright Office is developing updated guidance and will update the Compendium when it finalizes its guidance.\footnote{U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 924 (3d ed. revised Sept. 29, 2017). Interestingly, the same section now omits a blanket rule that the Copyright Office considers clothing uncopyrightable, though Section 311.1 of the current version of the Compendium III still references the Copyright Office’s policy against registering copyright protection in clothing. See also Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,531 (Nov. 5, 1991).}

While numerous other cases pre-\textit{Star Athletica} addressed the copyrightability of costumes, the author leaves aside further discussion of the copyrightability of costumes or aspects of costumes, awaiting word from the Copyright Office on Compendium III revisions and from the Third Circuit on the banana costume a-peel.

G. Ross v. Apple, Inc.

1. Background

Ross’s drawing appears at left and an image of an Apple iPhone device appears at right. Ross alleged that he created the above drawing and other similar plans for devices in 1992 and registered protection in the drawings in 2014. Some of his other copyright applications in suit refer to dual-screen devices that appear to open like a book. Ross “contended that Apple had systematically searched for abandoned and discarded ideas to patent and exploit,” and that Apple’s various products “were substantially similar to his drawings of the Device and embodied its ‘non-functional aesthetic look and feel.’” In the complaint, Ross included multiple reproductions of a quote attributed to the former chief executive officer of Apple, Steve Jobs, “Good artists copy, great artists steal. We have always been shameless about stealing great ideas.”

After the district court dismissed Ross’s claims and denied leave to amend his complaint, Ross appealed to the Eleventh Circuit, which issued a per curiam opinion falling within the author’s examined time frame,

---

175. Id. at 21.
176. Id. at 2.
177. See id. at 9–10.
affirming the lower court’s dismissal of Ross’s claims and briefly discussing
the conceptual separability analysis.182

2. Analysis of Star Athletica and Conceptual Separability

As a preliminary matter, the author submits this case adds little to the
discourse on Star Athletica given (1) the plaintiff’s lack of presenting much
direct comparison between specific works and due to his alleging general
infringement of his ideas and (2) the court’s mistaken application of the
conceptual separability analysis. On the first point, it is well-established that
copyright cannot protect ideas.183 In rejecting Ross’s claims, the Eleventh
Circuit wrote:

The idea for the Device was not subject to copyright protection; each
element of the drawing that he identified was purely functional and
inseparable from the idea of a handheld electronic reading device.
None of those elements can be conceived as a work of art separate
from the Device itself but are necessary parts of it.184

However, Apple owns design patents on some aesthetic features of its
devices, which demonstrates that electronic devices like Apple’s may have
non-functional features (as design patents cannot protect utilitarian features
any more than copyright law can).185 It is just that such aesthetic features,
even if separable, may not be sufficiently original to merit copyright
protection.186 Here, the court held no features were even conceptually
separable.187

Further, the Supreme Court’s test does not require examining whether
any elements of a work “are necessary parts of it,”188 as the Eleventh Circuit
here wrote, but rather whether any features “(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

183. 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship
extend to any idea. . . .”).
discussion of design patents falls outside the scope of this article.
186. See UR5, CORB Decision at 1 (Oct. 23, 2017) and discussion infra at Section IV(C)(2).
188. Id.
its own or in some other medium if imagined separately from the useful article."\textsuperscript{189}

Finally, the author submits that this case is another that falls through the trap door Justice Ginsburg identified—the court need not have addressed conceptual separability at all in this case. Similar to how in Star Athletica the cheerleader outfit designs were two-dimensional works "reproduced on useful articles” not “designs of useful articles,”\textsuperscript{190} here, the author posits that Ross’s works constituted drawings of useful articles, not useful articles themselves.

Query whether drawings can ever be useful articles. To examine the question and the importance of Justice Ginsburg’s distinction in this case, and in other cases discussed \textit{infra},\textsuperscript{191} the author invites the reader to refer to the statute’s definition of “pictorial, graphic, and sculptural works”:

"Pictorial, graphic, and sculptural works" 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.\textsuperscript{192}

While the definition of PGS works contemplates that a work separated from a useful article may be a PGS work, the author submits that a useful article may not be two-dimensional. The statute 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.’"\textsuperscript{193}

The author submits that a drawing of a useful article has no intrinsic utilitarian function aside from portraying the appearance of the article or

\textsuperscript{190}  Id. at 1018 (Ginsburg, J., dissenting) (emphasis in original).
\textsuperscript{191}  See Glass Egg Dig. Media v. Gameloft, Inc., No. 17-cv-04165-MMC, 2018 WL 3659259 at *1 (N.D. Cal. Aug. 2, 2018); see also \textit{infra} Section III(H); Arlon FESPA/ISA 2014 Trade Show, CORB Decision at 1 (Dec. 14, 2017); see also \textit{infra} Section IV(C)(3).
\textsuperscript{192}  17 U.S.C. § 101 (2010).
\textsuperscript{193}  Id.
conveying information. It follows that a drawing of a useful article is not itself a useful article, but only a drawing potentially eligible for copyright protection as a pictorial or graphic work. As in Star Athletica, “[b]ecause the owner of a copyright in a pre-existing PGS work may exclude a would-be infringer from reproducing that work on a useful article, there is no need to engage in any separability inquiry to resolve” the case.194

Accordingly, the court in Ross need only have examined whether Apple’s devices or two-dimensional depictions of its devices infringed Ross’s copyright rights in his drawings, to the extent the court found that Ross sufficiently stated a claim.

H. Glass Egg Digital Media v. Gameloft, Inc.

1. Background

As with the Ross case above, the author submits that Glass Egg Digital Media v. Gameloft, Inc. adds little to the discourse on Star Athletica. However, due to the Northern District of California’s citation of Star Athletica in its brief mention of separability,195 this case meets the author’s criteria for inclusion in this article.

Glass Egg Digital Media (“Glass Egg”) filed suit in the Northern District of California against the defendants, alleging copyright infringement of three-dimensional digital car models for use in a series of video games under the name Asphalt.196 Glass Egg did not include any images of the digital car models at issue in its complaint or any other filings before the court.

Essentially, Glass Egg alleged that its employees moonlighted for defendants to create the digital car models, using Glass Egg’s resources, and so Glass Egg claimed copyright ownership of the works under the work made for hire doctrine.197 However, Judge Chesney held that Vietnamese copyright law applied as to ownership of the works because the works were created by Vietnamese nationals in Vietnam (i.e., the Glass Egg employees).198 Vietnamese copyright law evidently differs from U.S. copyright law at least with regard to the work made for hire doctrine. Under Vietnamese law, “[a]n

194. Star Athletica L.L.C., 137 S. Ct. at 1018 (Ginsburg, J., dissenting).
198. Id. at *3.
organization that assigns a duty of creating a work to an author, who is its employee, shall be the owner of the [work].”

Here, because Glass Egg did not assign the duty to its employees, and rather alleged that its employees “clandestinely” created the works for defendants, Judge Chesney held that Glass Egg did not own the works as works made for hire.

As to Glass Egg’s conclusory statement that it also owned the works via written agreements, Judge Chesney held the pleading deficient, as Vietnamese law requires certain specified terms for a copyright assignment to be effective, and Glass Egg did not allege the requisite contractual terms. However, Judge Chesney allowed leave to amend.

Considering the possibility that Glass Egg might cure the deficient pleading, Judge Chesney continued her analysis on the infringement issue. The parties and the judge agreed United States law governed the scope of protection and therefore infringement. Glass Egg alleged infringement of two categories of works, “polygon arrangements” and “special effects.” Judge Chesney essentially dismissed the infringement of special effects claim as speculative, particularly in light of Glass Egg’s failure to include any images of the special effects and their use in the Asphalt games.

2. Discussion of Star Athletica and Conceptual Separability

As for the polygon arrangements, Glass Egg contended that they met the copyright law’s originality requirement and, citing Star Athletica, that they “can be separated from the shape and appearance of the cars.” Judge Chesney held that Glass Egg sufficiently alleged the polygon arrangements constituting cars were sufficiently original, “[a]ssuming the polygon arrangements can be separated from the shape and appearance of the cars . . .”

Glass Egg and Judge Chesney appear to have misapplied the Star Athletica language in an attempt to distinguish the present case from

199. Id.
200. Id.
201. Id.
202. Id. at *4.
203. Id.
204. Id.
205. Id. at *4–6.
206. Id. at *5–6.
207. See id. at *4 (citing Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017)).
Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.\textsuperscript{209} The Tenth Circuit in Meshwerks held that digital computer model replicas of Toyota cars, which “were two-dimensional wire-frame depictions of Toyota’s vehicles that appeared three-dimensional on screen,” were not sufficiently original because they did not depict any original expression like lighting, shading, or background.\textsuperscript{210} The Tenth Circuit in Meshwerks made no mention of conceptual separability and did not describe the computer models as useful articles.\textsuperscript{211}

Query whether computer models can be useful articles. As with the two-dimensional drawings in Ross, the author submits that the two-dimensional digital renderings of the cars in Glass Egg Digital Media did not constitute useful objects per se. The fact that the digital models appear to be three-dimensional on-screen does not change them from drawings into useful articles. The drawings have no intrinsic utilitarian function aside from portraying the appearance of the article or conveying information.\textsuperscript{212}

Therefore, the author posits that the court erred in citing Glass Egg’s brief arguing that the polygon arrangements “can be separated from the shapes and appearance of the cars” because computer models are not useful articles. They are drawings of useful articles, which the author submits lend themselves more to an originality analysis (as in Meshwerks) and not a conceptual separately analysis.

IV. COPYRIGHT OFFICE REVIEW BOARD DECISIONS AFTER STAR ATHLETICA

A. Overview and Background

1. Procedure and Standards of the Copyright Office Review Board

The CORB reviews second requests for reconsideration of rejected copyright applications.\textsuperscript{213} In other words, copyright claimants reach the CORB as a third stop in the application process.

First, procedurally, a copyright claimant files an application to register copyright in a work or collection of works. A Registration Specialist will examine and may reject the application. If rejected, the claimant may file an appeal, otherwise known as a request for reconsideration, following the

\begin{itemize}
\item \textsuperscript{209} Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc., 528 F.3d 1258 (10th Cir. 2008).
\item \textsuperscript{210} Id. at 1261, 1265–66 (analogizing to copyrightable aspects of matter contained in photographs).
\item \textsuperscript{211} See id.
\item \textsuperscript{213} U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 1704.2 (3d ed. 2017).
\end{itemize}
An Attorney-Advisor at the Copyright Office reviews the first appeal de novo. If the Attorney-Advisor maintains the Registration Specialist’s rejection of the claimant’s application, the claimant may file a second request for reconsideration, following the proper format. The CORB refers to the initial examination by the Registration Specialist and the first appeal as the “Registration Program.” The CORB reviews second requests for reconsideration de novo.

If applicants wish to review CORB rejections, they may do so in federal court. A federal court may review the CORB’s decision under the Administrative Procedure Act, determining whether it holds such decision to be “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.”

Commentators note the Copyright Office typically treats applications more harshly in its originality analyses as compared to courts. Accordingly, the below CORB decisions contrast with the federal court decisions above in certain respects. For example, the CORB decisions typically feature analysis of originality, whereas courts may rule on separability without reaching the issue of originality.

2. Methodology of Decisions Reviewed

The Copyright Office publishes decisions of the CORB on its website. To obtain the relevant results for this article, the author searched for decisions on the Copyright Office’s website, using the checkbox feature to limit results to those involving the category “useful article.” Next, the author reviewed only those decisions dated between March 22, 2017 and mid-October 2018 to examine those issued in the first eighteen months post-Star Athletica. The search revealed the following eight decisions. In these

---

215. Compendium (Third) § 1703.2.
216. 37 C.F.R. § 1704.1; Compendium (Third) § 1704.1.
217. See Compendium (Third) § 1704.1.
218. Id. § 1704.2.
221. See, e.g., Roberta Horton, The Threshold of Copyright Protection After American Airlines, Law360 (Feb. 26, 2018, 2:17 PM) https://www.law360.com/articles/1013278/the-threshold-of-copyright-protection-after-american-airlines (“In our view, the courts have adopted more liberal standards for evaluating creativity than has the Copyright Office, reflecting a tension between the agency’s determinations and the courts’ more reasonable interpretations of ‘creativity.’”).
222. See, e.g., Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1007 (2017); see also Section III supra.
eight decisions, the CORB reversed five refusals and affirmed three refusals of copyright applications.

B. Refusals Reversed in the First Eighteen Months After *Star Athletica*

1. Trilliane Strand

The present case and the following case involve Swarovski Lighting’s copyright applications for fixtures comprised of a light fixture with decorative crystal details. In *Trilliane Strand*, the CORB reversed the Registration Program’s refusal to register the crystal crown and a curtain of crystals on a lighting feature, determining the crystal crown and curtain of crystals constitute an artistic feature separable from the overall light fixture, which constituted a useful article. 224 See below. 225

Swarovski, for its part, did “not claim copyright in the overall shape or industrial design of the Trillane Strand,” as it excluded “the internal wiring,

225. *Id.* at 2.
ceiling mounting mechanism, [and] lighting component or light bulbs,” and it did claim copyright in the “artistic expression reflected in the sculptural features of the work.” Accordingly, the CORB reversed the Registration Program’s refusal to register the crystal crown and curtain of crystal strands, finding the three-dimensional features “can be perceived as a freestanding work of art that does not recreate the light fixture when imaginatively removed from the useful article” and finding the work sufficiently original under Feist.227

2. Amaca

As in Trillane Strand, the CORB in Amaca reversed the Registration Program’s refusal to register Swarovski’s crystal mesh hammocks on a lighting fixture, determining the crystal mesh hammocks adorning a lighting fixture constituted an artistic feature separable from the overall lighting fixture, which the CORB determined was a useful article.228 See below.229

---

226. Trillane Strand, CORB Decision at 2; Letter from Shanna Sanders, Rothenberg Farley & Mesiti P.C. to U.S. Copyright Office at 2 (Mar. 9, 2016); Letter from Shanna Sanders, Rothenberg Farley & Mesiti P.C. to U.S. Copyright Office at 3 (Oct. 6, 2016) (emphasis in original).
229. Id. at 1.
Swarovski sought only to protect the separable “crystal mesh hammocks” on the lighting fixture. The CORB found such features “can be perceived as a freestanding work of art that does not recreate the light fixture when imaginatively removed from the useful article” and found the work sufficiently original under *Feist*.

3. Wanderer

In *Wanderer*, the CORB reversed the Registration Program’s refusal to register a complex placement of lace patternwork on a kimono, determining that such lacework can be identified as a two-dimensional work of art separate from the kimono.

Specifically, the design consisted of “the placement of vertical strips of lace, ‘the use of three different flower designs,’ ‘the arrangement of one row of one flower design, followed by six rows of another flower design, all interspersed with a third, smaller flower design,’ and ‘the inconsistency in the shape of the bottom trim of the kimono.’”

The CORB noted the applicant “Sisco does not seek copyright protection for the overall kimono . . . .” In contrast, consider the owner of the copyright registration for the hookah water container, Inhale, which failed to identify any particular aspect of its work and instead claimed copyright in the work as a whole. However, it is well established that clothing is a useful article. Therefore, it follows that copyright can only protect separable elements and not the clothing item as a whole.

The CORB held that the “relatively complex placement of lace patternwork can be identified as a two-dimensional work of art separate from the kimono; it is thus separable.” Then, the CORB cited to *Star Athletica* in further noting that the separable features “do not recreate the kimono when

---

230. *Id.*
231. *Id.; see also Feist Publ’ns, Inc.*, 499 U.S. at 363.
233. *Id.* (quoting Letter from Andrew Simpson, Knobbe, Martens, Olson & Bear LLP, to U.S. Copyright Office at 3 (July 25, 2016) accord Letter from Juliana M. Simon, Knobbe, Martens, Olson & Bear, LLP, to U.S. Copyright Office at 2–3 (May 2, 2017)). Note the decision did not include a picture of the work.
234. Wanderer, CORB Decision at 1.
237. Wanderer, CORB Decision at 2.
so imaginatively removed,””238 and as in *Star Athletica*, “imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself.””239

After analyzing the separability issue, the CORB addressed originality. The CORB clarified that the individual elements in the lacework, such as flowers and honeycomb patterns, “are preexisting elements not individually protectable under copyright law” and are “standard elements.””240 Accordingly, the CORB held that the combination of features in the work merited thin protection.”241

4. Pendant Lamp – 76

In *Pendant Lamp – 76*, the CORB reversed the Registration Program’s refusal to register a glass, bisected globe lamp with two imbedded filaments as a sculptural work.”242 The lamp housed an LED bulb that the CORB deemed utilitarian.”243 See below.”244

---

238. _Id._
240. Wanderer, CORB Decision at 2.
241. _Id._ See also *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) (discussing that “thin” copyright protection protects against only virtually identical copying).
243. _Id._ at 3.
244. _Id._ at 1-2.
The applicant could not convince the Registration Program in its initial appeal letters that the rest of the lamp contained separable authorship. The CORB noted that “the second rejection letter pre-dated the Supreme Court’s Star Athletica decision by three weeks.” In analyzing the work, even though the CORB reversed the Registration Program’s determination, the CORB emphasized that “[t]he Star Athletica decision did not change the fact that copyright law does not protect useful articles as such,” but stated the Supreme Court’s decision “clarifies” the test. The CORB then reproduced the two-part test in its entirety.

Applying the test, the CORB found the “glass sculpture and imbedded filaments meet the test” and “the Work’s three-dimensional design of glass formed into a half globe and imbedded with filament wires can be perceived as a standalone work of art without the internally mounted LED that makes the Work a useful article.” Then, “significantly,” the CORB found the separable elements sufficiently original to merit copyright protection.

The author agrees with the CORB’s decision except with regard to the filaments, where the author submits that the CORB should have obtained additional information from the applicant. The CORB noted that the “internally-mounted LED is included to illuminate the globe and filaments,” which presents the query whether the filaments themselves light up along with the LED bulb, such as with fiber optic cables.

If the filaments do light up, are they useful, or decorative? The court in Jetmax held the string lights were functional, aside from the decorative covers, because they provide light to a room. But, fiber optic cables only light up if a light shines through them. Accordingly, the author submits that the better view is that the filaments, if like the fiber optic kind, are more like the potentially protectable decorative covers than the unprotectable light bulb, and should not be considered functional.

However, if the filaments do not light up but simply constitute exposed wiring to power and light the LED bulb, the CORB should have considered the wiring functional and ineligible for copyright protection, as the wiring provides the utilitarian function of delivering electricity to the LED bulb.

245. *Id.* at 2.
246. *Id.*
247. *Id.* at 2–3.
248. *Id.* at 3.
249. *Id.*
250. *Id.* at 1.
Therefore, the author submits that the CORB should have requested additional information from the applicant about the filaments.

5. Floor Liner

In *Floor Liner*, the CORB reversed the Registration Program’s refusal to register a black floor liner shaped to fit the floor of a vehicle as a sculptural work. The CORB described the floor liner as a quadrilateral with a top surface as “embossed with a pattern of various raised, non-standard geometric shapes.” See below.

The applicant did not seek copyright protection for “the overall floor liner,” which it acknowledged as a useful article, but rather sought to register the “decorative raised pattern comprising various shapes and orientations,” which it asserted served no useful function. The CORB seemed to consider quite important and took pains to emphasize that, in making its decision, it

253. *Id.* at 1.
254. *Id.* at 2.
255. *Id.*
took the applicant at its word that the particular pattern served no useful function.\textsuperscript{256}

Confusingly, although the applicant applied to register a sculptural (i.e., three-dimensional) claim in the work, the CORB applied the \textit{Star Athletica} test and declared that “the Work’s raised, decorative pattern of various shapes can be identified as a \textit{two-dimensional work of art} separate from the floor liner.”\textsuperscript{257} Further, the CORB found the design sufficiently original as to merit copyright protection.\textsuperscript{258}

Query what it means for the applicant’s registration that the CORB found only the raised, decorative pattern separable as a two-dimensional work of art. Did the CORB mean three-dimensional? Does the work become registered as a two-dimensional work or a three-dimensional sculptural work? The author’s search on the Copyright Office website yielded a registration record VA0002101719 for a work of the visual arts titled “Floor Liner” and having the copyright claimant Quadratec, Inc., the same entity appealing the rejection here.\textsuperscript{259} While it appears to the author that the CORB transformed the applicant’s sculptural claim into a claim for solely the two-dimensional pattern, it also appears to the author that the Registration Policy and Practice division registered three-dimensional sculptural features of the work, if the registration record refers to the same work. The Copyright Office’s notes in the registration record state, “Basis for Registration: Sculptural features identified separately from and capable of existing independently of the utilitarian aspects of a useful article.”\textsuperscript{260}

On the one hand, the applicant acknowledged that “grooves and lines on the surface of a floor liner, in general, do serve the useful function of trapping dirt and water,”\textsuperscript{261} and yet on the other hand, the CORB found that the particular pattern here served no useful purpose.\textsuperscript{262} Query whether the three-dimensional grooves serve a useful function but the two-dimensional pattern does not.

\textsuperscript{256} \textit{Id.} at 3 (“On the basis of Quadratec’s representation that this pattern serves a purely aesthetic purpose, the Board concludes that the decorative pattern is a separable, non-useful work.”).  
\textsuperscript{257} \textit{Id.} (emphasis added).  
\textsuperscript{258} \textit{Id.}  
\textsuperscript{259} Copyright Office Public Catalog, https://cocatalog.loc.gov/ (search for “Floor Liner” as Title) (last visited Jan. 11, 2019).  
\textsuperscript{260} \textit{Id.}  
\textsuperscript{261} \textit{Id.} at 2.  
\textsuperscript{262} See Floor Liner, CORB Decision at 3.
C. Refusals Affirmed in the First Eighteen Months After Star Athletica

1. Pizza Slice Pool Float

In *Pizza Slice Pool Float*, the CORB affirmed the Registration Program’s refusal to register a two-dimensional design of a slice of pepperoni pizza on a three-dimensional inflatable pool float as not sufficiently original.\(^{263}\) See below.\(^{264}\)

The applicant initially applied for the Pizza Slice Pool Float as a sculptural work, noting the raised crust in the float and divots across the float itself, but in the course of prosecution, appears to have amended its claims to simply the two-dimensional design itself.\(^{265}\) While not specifically holding that the pizza design was separable from the three-dimensional utilitarian pool float, the CORB focused on the originality analysis, holding, “[t]he level of creative authorship involved in its configuration of elements is, at best, *de minimis*, and too trivial to enable copyright registration.”\(^{266}\)

The CORB acknowledged that the Copyright Office and the courts have considered combinations of simple shapes, “when combined in a distinctive manner indicating some ingenuity,” to be protectable.\(^{267}\) Still, in this case, the CORB found the work “a very common version” of a pepperoni pizza slice, and as such, the work was not original, noting further, “the fact that

\(^{263}\) *Pizza Slice Pool Float*, CORB Decision at 1 (July 11, 2017).

\(^{264}\) *Id.* at 2.

\(^{265}\) *Id.* at 5.

\(^{266}\) *Id.* at 8.

\(^{267}\) *Id.* (quoting Atari Games Corp. v. Oman, 888 F.2d 878, 883 (D.C. Cir. 1989)).
BigMouth had many stylistic choices and design alternatives open to it does not factor into the calculus of originality. 

However, the author queries whether a federal court would have allowed the separable two-dimensional pizza design to receive “thin” protection; the author posits that the Copyright Office should have allowed “thin slice” protection, though perhaps not “deep dish” protection.

2. UR5

In UR5, the CORB affirmed the Registration Program’s refusal to register a robotic arm as a sculptural work, determining the arm did not contain any separable, copyrightable features that contain the requisite originality. The robotic arm consisted of two metal tubes with blue plastic caps at the joints. The joints featured the Universal Robots logo. See an image of the arm below.

Universal Robots offered, among other arguments, that it was inspired by the Danish Modern artistic movement. In contrast to some courts, the CORB reiterated, “[t]he attractiveness of a design, the espoused intentions

268. Pizza Slice Pool Float, CORB Decision at 6. See also U.S. COPYRIGHT OFFICE, COMPRENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 310.8 (3d ed. 2017) (discussing design alternatives). But see COMPRENDIUM (THIRD) § 313.3(B) (discussing the merger doctrine, which prohibits protecting expression that “would effectively accord protection to the idea, procedure, process, system, method of operation, concept, principle, or discovery itself”). Generally, design alternatives appear relevant for the infringement analysis as related to merger, but not for the copyrightability analysis. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03(B)(3) (2018) (discussing the merger doctrine; Nimmer and many courts take the view that the merger doctrine applies as a defense to infringement rather than as part of the copyrightability analysis).

269. See Satava v. Lowry, 323 F.3d 805, 811 (9th Cir. 2003) (discussing that “thin” copyright protection protects against only virtually identical copying).

270. UR5, CORB Decision at 1 (Oct. 23, 2017).

271. Id.
of the author, the design’s visual effect or its symbolism, the time and effort it took to create, or the design’s commercial success in the marketplace are not factors in determining whether a design is copyrightable.”

Such language mirrors guidance from *Star Athletica* and its list of do’s and don’ts. The CORB expressed doubts that the plastic caps and T-shaped piece “could be visualized as works of authorship separate and independent from the Work’s utility.” In other words, the caps themselves were functional. In addition, the CORB stated that even if the CORB considered the plastic caps and T-shaped piece artistic and separable, they were not sufficiently original. The caps themselves consisted of simple shapes and the logo on the caps consisted of simple shapes and letters.

The Copyright Office’s refusal to register many designs based on its considering simple shapes not copyrightable has wide-reaching repercussions for copyright claimants’ ability to prevent unauthorized copying. This case demonstrates the important interplay between the conceptual separability analysis and the originality analysis.

3. Arlon FESPA/ISA 2014 Trade Show

In *Arlon FESPA/ISA 2014*, the CORB affirmed the Registration Program’s refusal to register a three-dimensional trade show booth applied for by Team One Display Services Inc. (“Team One”). In the CORB’s words, the work consisted of “a three-dimensional trade show booth comprised of multiple display elements, including two kiosks, two seating areas, and a vehicle-display platform.” The decision showed multiple images from the application, depicting the trade show booth from multiple angles, as shown below.
Team One had argued that “the design or appearance of the trade show booth is a 3-dimensional work of artistic craftsmanship’ that is conceptually separable from the utilitarian aspects of the trade show booth” and that “the overall trade show booth could be ‘visualized as a free-standing sculpture or statuette . . . ’”

However, the CORB highlighted that Team One “repeatedly suggest[ed]” in its appeals “that the trade show booth [was] a ‘useful article,’” though it did “not identify any particular three-dimensional features that could stand on their own as works of art apart from the trade show booth.” Moreover, Team One never responded to a letter from the CORB asking to clarify whether Team One sought to protect a “full-size three dimensional version of the trade show booth,” a model replica, or the two-dimensional images submitted as the deposit copy. Accordingly, the CORB proceeded to evaluate the work as a full-size three-dimensional display and reviewed whether it contained any conceptually separable portions that could qualify for copyright protection.

The CORB disregarded the logos and designs on the trade show booth, stating that Team One did not seek to register “any two-dimensional authorship in the graphics applied to the surface of the trade-show booth structure.” Interestingly, the CORB appears to have reviewed (apparently sua sponte) Team One’s website, “which advertises the ability to apply ‘custom graphics’” to its displays. Based on the CORB’s review of Team One’s website, the CORB noted that Team One’s client and not Team One appeared to own the two-dimensional graphics depicted in the deposit material, and suggested Team One would not be able to claim copyright in material it did not own.

Further, the CORB stated the Copyright Office “must focus on the fixed, expressive elements” of the work to be registered. Confusingly, the CORB decision highlighted that Team One “made clear that it is attempting to claim the work as a single work, rather than a collection of component works” in its application, but later, the CORB quoted Team One as stating,

---

280. Id. at 3 (quoting Letter from Daniel Bliss to U.S. Copyright Office (May 20, 2016)).
281. Id. at 9 (quoting Letter from Daniel Bliss to U.S. Copyright Office, at 2 (May 20, 2016)).
282. Arlon FESPA/ISA 2014 Trade Show, CORB Decision at 8.
283. Id. at 3–4.
284. Id. at 7.
285. Id. at 7 n.2.
286. Id.
287. Id. at 7.
288. Id. at 1.
“[t]he design concept consists of original combinations, positioning, and arrangement of materials . . . .”

The CORB rejected any possible protection for ideas or “unprotectable interior design concepts” as insufficiently fixed to merit copyright protection. Query whether the outcome may have been different if Team One described or defined “design concepts” instead as “concrete expressions of design concepts.” In the author’s view, the CORB interpreted “concepts” to mean “ideas,” and it is well-established that ideas are unprotectable under copyright law.

Finally, applying the Supreme Court’s test from Star Athletica, the CORB held that the three-dimensional trade show booth did not contain any conceptually separable, copyrightable features. For example, “[t]he kiosks, if removed from the overall trade show booth, are still useful articles. . . . The same is true of the Work’s vehicle display platform, television monitors, stanchions, and seating areas.” The CORB left open the possibility that some of the work’s details could be copyrightable. Without more information, because Team One had not responded to the CORB’s inquiry about certain features, the CORB presumed that all features were “utilitarian aspects of the useful article itself.”

What strikes the author as somewhat strange is that the work at issue here does not look like a physical structure but instead looks like a two-dimensional computer-generated display that appears as three-dimensional on screen. The CORB noted that it interpreted the work as a “full-size three-dimensional display” in the absence of any clarifying information from the applicant. However, again it strikes the author that the CORB could have rejected the application as incorrectly describing the work as three-dimensional, or alternatively could have interpreted the application as a claim to register the work as a collection of two-dimensional images of the trade show booth setup.

289. Id. at 7 (quoting Letter from Daniel Bliss to U.S. Copyright Office at 1–2 (May 20, 2016)).
291. 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea [or] . . . concept . . . .”).
293. Id. at 8.
294. Id. at 9.
295. Id.
296. Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc., 528 F.3d 1258, 1260 (10th Cir. 2008) (holding computer model replicas of Toyota vehicles not sufficiently original to merit copyright protection; no discussion of conceptual separability); see also discussion supra Sections III(G)–(H).
297. See Floor Liner, CORB Decision at 2–3 (Apr. 19, 2018) (apparently transforming the applicant’s application to register a sculptural claim in a work into a claim for a two-dimensional design) and discussion supra Section IV (B)(5).
The author submits that the CORB should have rejected the applicant’s characterization of the computer model as a “useful article.” The statute 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.” Here, the computer model performs the function of portraying the appearance of the article, the trade show booth, and accordingly should not be considered a useful article. Instead, as the author submits should have been the case as well in *Ross* and *Glass Egg Digital Media*, the CORB should only consider whether the computer model was sufficiently original.

V. CONCLUSION AND THE FUTURE OF CONCEPTUAL SEPARABILITY

What analyses and trends provide useful guideposts for applicants and litigators? First, despite some subsequent lower courts ignoring the Supreme Court’s instructions, the U.S. Supreme Court opinion specifically abrogates any tests incorporating physical separability, the usefulness of any “left behind” part of the object, and consideration of artistic judgment or marketability. Lower courts and the CORB indicate it is helpful (but generally not necessary) when litigants identify particular features to be protected.

Pulling together decisions from the first eighteen months post-*Star Athletica*, we see the judge can make an independent determination about the features to be protected, some part of the utilitarian object must be left behind after separability, and physical separability rules the day as perhaps


299. *See Meshwerks, Inc.*, 528 F.3d at 1258; *see also supra* Sections III(G)–(H). *Cf.* U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 919 (3d ed. revised Sept. 29, 2017) (discussing copyrightability of physical models).


more easily, conceptually graspable.\textsuperscript{304} It follows that if a feature is physically separable, it is also conceptually separable (e.g., black trim on bikinis, light covers and sconces on lights). The trickier cases involve conceptual separability of more integrated designs.\textsuperscript{305} In a sense, the prohibition on registering copyright in useful articles, though prohibited by statute,\textsuperscript{306} is a kind of “merger.”\textsuperscript{307}

Copyright owners and litigants may consider Judge Forrest’s “primary purpose” test to help demonstrate that a feature is “primarily” decorative or artistic rather than functional, though the test is not binding on the CORB or any court at this point.\textsuperscript{308} The “primary purpose” test may help to protect some decorative features that also provide some utility. However, such a test will not protect anything courts or the CORB consider useful as a whole, like the Brandir bike rack or Inhale’s hookah water container,\textsuperscript{309} or with potentially separable portions they consider not sufficiently original, like the UR5 robot arm.\textsuperscript{310} Alternatively or in addition, litigants may enter Judge Myerscough’s rhetorical realm of beat poetry by asking “once the [decorative feature] / is removed from the [functional portion] / what is the usefulness / of [e.g., hanging the bird on a string by its beak]?”\textsuperscript{311}

While litigants must currently look elsewhere to protect useful articles without conceptually separable parts, it is worth mentioning that copyright law does protect some types of works we may consider useful, if not constituting true “useful articles.”\textsuperscript{312} For example, copyright can protect dictionaries, computer programs, and architecture.\textsuperscript{313} However, copyright

\begin{itemize}
\item \textsuperscript{305} See Silvertop Assocs. Inc., 319 F. Supp. 3d at 760; Floor Liner, CORB Decision at 2–3 (Apr. 19, 2018).
\item \textsuperscript{306} 17 U.S.C. §§ 101 & 113.
\item \textsuperscript{307} See 4 MELVILLE B. Nimmer & DAVID Nimmer, Nimmer on Copyright § 13.03(B)(3) (2018) (discussing the merger doctrine, which prohibits protecting expression inseparably tied to an idea, though Nimmer and many courts take the view that the merger doctrine applies as a defense to infringement rather than as part of the copyrightability analysis).
\item \textsuperscript{308} See Jetmax Ltd., 2017 WL 3726756, at *6. See supra Section III(D) for further discussion.
\item \textsuperscript{309} See Brandir Int’l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142 (2d Cir. 1987); Inhale Inc., 2017 WL 4163990, at *3.
\item \textsuperscript{310} UR5, CORB Decision at 1 (Oct. 23, 2017).
\item \textsuperscript{311} See Design Ideas, Ltd. v. Meijer, Inc., No. 15-cv-03093, 2017 WL 2662473, at *3 (C.D. Ill. June 20, 2017) (virgules added). As above, the author credits Thomas Kjellberg of Cowen, Liebowitz & Latman for his interpretation of Judge Myerscough’s words as beat poetry at the Copyright Society of the USA’s Annual Meeting in June 2018.
\item \textsuperscript{312} See 17 U.S.C. § 101 (emphasis added) (defining “useful article”).
\item \textsuperscript{313} See 17 U.S.C. §§ 101 & 102. Credit to Joshua Simmons of Kirkland & Ellis LLP for his observation about the protectability of some “useful” works, which he made on a panel where the author also presented at the Fordham IP Conference in April 2018.
\end{itemize}
law treats PGS works differently.\textsuperscript{314} When the Copyright Office and Congress consider the Next Great Copyright Act,\textsuperscript{315} they should consider why, and take the opportunity to clarify the conceptual separability test to include Judge Forrest’s “primary purpose” language to more clearly delineate what artistic features copyright owners may expect copyright law to protect.

Two-dimensional works and two-dimensional computer models that appear on screen as three-dimensional works present special problems, but the author submits litigants and copyright applicants may better analyze them outside of the conceptual separability framework. Such works can reproduce the appearance of useful articles but are not themselves useful articles.\textsuperscript{316} Congress should also clarify the definition of “useful article” in the statute in this regard and the Copyright Office may address the issue in its next revision of the Compendium as well. In the meantime, and for works of all kinds, litigants should heed Justice Ginsburg’s implied guidance to carefully consider the nature of the work at issue to determine, as a threshold matter, whether the work constitutes a useful article at all.\textsuperscript{317}

Finally, litigants will do well to remember the originality analysis, though courts may elect to rule only on separability without considering originality.\textsuperscript{318} Also, the CORB and the Copyright Office certainly consider originality in determining registrability. As mentioned above, the Copyright Office appears to hold applicants to a higher standard of originality as compared to federal courts.\textsuperscript{319} Of course, sometimes courts, particularly those inclined towards high art artistic judgment, use high standards for originality as well.\textsuperscript{320}

\textsuperscript{314} 17 U.S.C. §§ 101 & 113.
\textsuperscript{315} See Maria A. Pallante, The Next Great Copyright Act, 36 COLUM. J.L. & ARTS 315 (2013); see also The Register’s Call for Updates to U.S. Copyright Law: Hearing before the H. Subcomm. on Courts, Intell. Prop. and the Internet of the H. Comm. on the Judiciary, 113th Cong. 4–38 (2013) (statement of Maria A. Pallante, Register of Copyrights, the U.S. Copyright Office).
\textsuperscript{316} See supra Sections III(G)–(H), IV(C)(3).
\textsuperscript{317} See Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1018–19 (2017) (Ginsburg, J., concurring); see also supra Section II(C)(1). In the author’s opinion, Justice Ginsburg was smart to concur rather than dissent so her opinion carries more persuasive authority for future cases.
\textsuperscript{318} See, e.g., Jetmax Ltd., 2017 WL 3726756, at *6.
\textsuperscript{319} See, e.g., Roberta Horton, The Threshold of Copyright Protection After American Airlines, LAW360 (Feb. 26, 2018, 2:17 PM) https://www.law360.com/articles/1013278/the-threshold-of-copyright-protection-after-american-airlines ("In our view, the courts have adopted more liberal standards for evaluating creativity than has the Copyright Office, reflecting a tension between the agency’s determinations and the courts’ more reasonable interpretations of ‘creativity.’").
Decisions coming out of the CORB indicate that the originality analysis closely follows, though is separate from, analyzing a useful article’s separable parts for separability considerations. Congress and the Copyright Office should clarify that the conceptual separability test does not incorporate the originality analysis, as at least one court has conflated the two, perhaps due to the particular language of the Supreme Court’s new test. While courts have not consistently applied the Supreme Court’s guidance, cases from the first eighteen months post-Star Athletica offer useful guideposts and guardrails for addressing the copyrightability of artistic features of useful articles. Litigants and courts can look at what Star Athletica explicitly mandated courts and litigants not consider and can review how the CORB implements the separability and originality analyses. Also, courts and litigants may look to new tests from lower courts that expand upon the Supreme Court’s return to the statutory test, such as Judge Forrest’s “primary purpose” test, in order to determine what is “useful” post-Star Athletica.

321. See, e.g., Pendant Lamp – 76, CORB Decision at 3 (Apr. 4, 2018); cf. supra Section II(B) (questioning how a work could simultaneously meet the second part of the Supreme Court’s new conceptual separability test for the feature to “qualify” as a PGS work and at the same time not satisfy the statutory originality requirement).

322. See Triangl Grp. Ltd. v. Jiangmen City Xinhui Dist. Lingzhi Garment Co., Ltd., No. 16 Civ. 1498 PGG, 2017 WL 2829752, at *8 (S.D.N.Y. June 22, 2017); see also discussion at Section II(B) supra.