

# A TRI-PARTITE CLASSIFICATION SCHEME TO CLARIFY CONCEPTUAL SEPARABILITY IN THE CONTEXT OF CLOTHING DESIGN

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## INTRODUCTION

Copyright protection for clothing design in the United States is a complex, hotly debated, but often misunderstood issue.<sup>1</sup> The 1976 Copyright Act extends protection to "pictorial, graphic, and sculptural works" (PGS works),<sup>2</sup> but the Act only provides protection against unauthorized reproduction of certain artistic expressions within the *design* of an article of clothing; it does not protect the *functional* aspects of clothing.<sup>3</sup> More often than not, this dichotomy requires that a person

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<sup>1</sup> See, e.g., Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1689 (2006); Alissandra Burack, Comment, *Is Fashion an Art Form That Should Be Protected or Merely a Constantly Changing Media Encouraging Replication of Popular Trends?*, 17 VILL. SPORTS & ENT. L.J. 605 (2010); Allison DeVore, Note, *The Battle Between the Courthouse and the Fashion House: Creating a Tailored Solution for Copyright Protection of Artistic Fashion Designs*, 35 T. JEFFERSON L. REV. 193 (2013); Jennifer Mencken, *A Design for the Copyright of Fashion*, B.C. INTELL. PROP. & TECH. F., December 12, 1997, at 1; Whitney Potter, Comment, *Intellectual Property's Fashion Faux Pas: A Critical Look at the Lack of Protection Afforded Apparel Design Under the Current Legal Regime*, 16 INTELL. PROP. L. BULL. 69 (2011) (proposing that copyright protection for fashion design does not require sacrificing the underlying objective of the Copyright Act).

<sup>2</sup> 17 U.S.C. § 102 (2012).

<sup>3</sup> The 1976 Copyright Act excludes useful articles from copyright protection. 17 U.S.C. § 101. Because clothing is considered a useful article, the physical rendering of a two-dimensional clothing design (i.e., a dress or a blazer rather than an illustration of one) is ineligible for copyright. H.R. REP. NO. 94-1476, at 55, *reprinted in* 1976 U.S.C.C.A.N. 5659,

or entity seeking protection must meet the exceedingly difficult standard of proving a clear distinction between fashion and function.

According to Congress, clothing is a useful article—it keeps you warm and covers your body<sup>4</sup>—which means that one must obtain intellectual property protection for clothing from a patent rather than from a copyright. For example, the cut and silhouette of a dress are not protectable artistic expressions because they are considered the functional design elements of the article that clothes you. The Copyright Act does, however, protect two dimensional prints, such as unique flower drawings or original variations of plaid, applied to fabric from which an article of clothing is constructed,<sup>5</sup> by providing an exception to its bar against copyrighting useful articles.<sup>6</sup> According to the exception, if a garment features highly artistic components, such as a distinct pattern or a unique three-dimensional shape, those isolated expressions of art are elements that may potentially be eligible for copyright protection.<sup>7</sup> Although this distinction may appear simple in the abstract, courts and scholars have adopted or advocated at least ten different approaches to conceptual separability.<sup>8</sup>

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5668 (stating the shapes of “ladies’ dress[es]” are not copyrightable).

<sup>4</sup> Congress excluded designs of useful articles from copyright eligibility to establish a boundary between copyrightability and patentability. See discussion *infra* Section I.A.

<sup>5</sup> See discussion *infra* Section II.A.

<sup>6</sup> 17 U.S.C. § 113(b).

<sup>7</sup> See discussion *infra* Section I.A.

<sup>8</sup> See, e.g., *Pivot Point Int’l. Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 929–31 (7th Cir. 2004) (purporting to adopt the Denicola test but looking to availability of alternative designs that could serve the same utilitarian function as the article at issue); *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985) (stating the test for separability is whether the aesthetic features are required by the utilitarian features); *id.* at 421–23 (Newman, J., dissenting) (stating that the “requisite ‘separateness’ exists whenever the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously”); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (stating that the test for separability is whether artistic features are “primary” and utilitarian features “subsidiary”); 1 PAUL GOLDSTEIN, *GOLDSTEIN ON COPYRIGHT* § 2.5.3 (3d ed. 2005) [hereinafter *GOLDSTEIN ON COPYRIGHT*] (suggesting that the test for separability is whether the design “can stand on its own as a work of art traditionally conceived, and if the useful article in which it is embodied would be equally useful without it”); 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2A.08[B][3] (2016) [hereinafter *NIMMER ON COPYRIGHT*] (stating that the test for conceptual separability exists when the design of a useful article, even if it served no utilitarian function, would still be marketable to a significant share of consumers because of its aesthetic qualities); 1 WILLIAM F. PATRY, *COPYRIGHT LAW AND PRACTICE* 285 (1994) [hereinafter *PATRY, COPYRIGHT LAW*] (suggesting that the test is whether alternative design choice was available); Thomas M. Byron, *As Long as There’s Another Way: Pivot Point v. Charlene Products as an Accidental Template for a Creativity-Driven Useful Articles Analysis*, 49 *IDEA* 147, 170–71 (2009) (stating that the test is whether alternatives were available at time the work was created); Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 *MINN. L. REV.* 707, 741 (1983) (stating that the test for separability is whether the design has features that reflect “artistic expression uninhibited by functional considerations”); Barton R. Keyes, Note, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American*

The United States Court of Appeals for the Sixth Circuit, for one, recently analyzed this issue in a complex case that addressed the copyrightability of cheerleader uniform designs.<sup>9</sup> In *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, the court identified the functional elements of the uniform as those that constitute its athletic components: the coverage of the body, the sweat wicking fabric, and the skirt's ability to permit the necessary range of motion to execute a kick or flip.<sup>10</sup> When the court analyzed these functional components independent of the graphic designs at issue, such as the colors, chevrons, and stripes of the uniforms, it concluded that the functional elements of the cheerleading uniform were not affected by incorporating the graphic designs. Specifically, the graphic designs on Varsity Brands's uniforms did not affect a cheerleader's ability to employ the functional aspects of the article of clothing. Therefore, the designs were conceptually separable from the PGS works applied to it. As a result of this analysis, the court held that the ornamental and aesthetic aspects of the uniform designs were eligible for copyright protection.<sup>11</sup>

The *Varsity Brands* decision underscores the lack of judicially discoverable, yet consistent, standards for applying the obscure and often misunderstood test of conceptual separability<sup>12</sup> to the design of clothing. The irritant of the doctrine in the context of clothing design lies within the classification of the clothing's "function."<sup>13</sup> The zig-zags, chevrons, and colorblocking<sup>14</sup> designs on the chest, back, and covering the seams along the edges, are two-dimensional and are similar to fabric patterns. However, these elements should not be observed in a static vacuum; they command attention when worn by a cheerleader who kicks, flips, and jumps. When viewed on a human body, the PGS designs

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*Copyright Law*, 69 OHIO ST. L.J. 109, 141–42 (2008) (proposing a two-factor balancing test in which courts balance the degree to which the designer's subjective process is motivated by aesthetic concerns and the degree to which the design is objectively dictated by its utilitarian function).

<sup>9</sup> *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 471–75 (6th Cir. 2015), *cert. granted*, 136 S. Ct. 1823 (2016). The court's opinion includes images of Varsity Brands's registered cheerleading uniform design sketches. *Id.*

<sup>10</sup> *Id.* at 491.

<sup>11</sup> *Id.* at 493.

<sup>12</sup> See *supra* note 8.

<sup>13</sup> Although this Note discusses functional aspects of aesthetic design elements in clothing, the discussion should not be confused with term "aesthetic functionality," which is a doctrine unto itself in trademark law. For a discussion of the aesthetic functionality doctrine, see Justin Hughes, *Cognitive and Aesthetic Functionality in Trademark Law*, 36 CARDOZO L. REV. 1227, 1228 (2015).

<sup>14</sup> The term "colorblock" in fashion denotes a design characterized by contrasting blocks or panels of solid colors. *Colorblock*, OXFORD DICTIONARIES: US ENGLISH, [http://www.oxforddictionaries.com/us/definition/american\\_english/colorblock](http://www.oxforddictionaries.com/us/definition/american_english/colorblock) (last visited Jan. 10, 2016).

create a trim silhouette shape of the cheerleader,<sup>15</sup> disguise the fabric seams and edges, and comprise basic arrangements of geometric shapes.<sup>16</sup> In other words, the PGS designs on the uniforms serve a well-designed, deliberate, and useful purpose, and should not have been regarded by the court as fabric pattern designs.

To help resolve this issue, this Note proposes a tri-partite classification scheme that can be uniformly applied by courts when analyzing the copyrightability of clothing design. Instead of embarking upon a new metaphysical journey in every case, courts should classify a clothing design as falling into one of three categories: “fabric pattern design,” which should be treated as presumably copyrightable; “fabric graphic design,” which should be subject to the conceptual separability analysis using the design process approach;<sup>17</sup> and “garment design,” which should be considered as presumably not eligible for copyright protection.<sup>18</sup> In most cases, conceptual separability would only apply to the “fabric graphic design” category, as it encompasses the gray area of those designs applied to clothing that serve functions beyond portraying their own appearance. These designs generally are intended to interact with the human form to influence the perception of the wearer’s body. Such a design categorization scheme clarifies the muddled standard for copyrightability of clothing design, increases predictability within the fashion and garment industries, and promotes judicial economy by limiting the number of cases that require the court to invoke the confusing separability doctrine as applied to clothing design.

Part I of this Note reviews the history of the Copyright Act, the purpose of the useful articles doctrine, and summarizes the foundational cases of the conceptual separability doctrine. Part II summarizes and analyzes the conflicting conceptual separability analyses circuit courts have used to determine the copyrightability of two and three-dimensional PGS designs that are incorporated into articles of clothing, explains the weaknesses and ambiguities of certain approaches, and then

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<sup>15</sup> Looking at the designs, the chevrons and stripes are arranged so that the edge of the chevron’s “V” frames the cheerleader’s chest. The panels immediately outside the “V” use colors that sharply contrast the color within the “V,” which creates a visual effect in the viewer of an hourglass body shape. See discussion *infra* Section III.A.3.

<sup>16</sup> For a photo of the cheerleading uniform design, see *infra* note 209 and accompanying Figure 2.

<sup>17</sup> See discussion *infra* Section II.B.3 for an explanation of the design process approach.

<sup>18</sup> This presumption of uncopyrightability is rebuttable. See *Poe v. Missing Perss.*, 745 F.2d 1238 (9th Cir. 1984) (reversing summary judgment and remanding the case to the district court to determine whether a swimsuit design made of clear vinyl and rocks, which was intended to be a sculpture, was a useful article); *Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F. Supp. 175 (D. Minn. 1985) (holding that a slipper depicting a bear’s foot was entitled to copyright protection because it was essentially a fanciful artistic rendition of a bear’s foot); see also *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005) (plush animal costume designs may be conceptually separable).

discusses the latest Sixth Circuit decision in *Varsity Brands*. Part III proposes a tri-partite classification scheme for clothing design intended to aid courts in determining when to apply the conceptual separability test. Part III then goes on to apply this classification scheme to select cases that were previously discussed in Part II, and analyzes the strengths and weaknesses of such an approach.

### I. THE USEFUL ARTICLES DOCTRINE AND CONCEPTUAL SEPARABILITY

The Intellectual Property clause of the U.S. Constitution empowers Congress to grant limited protection to qualifying works of artistic craftsmanship.<sup>19</sup> The Framers granted Congress this power to “promote the Progress of Science and useful Arts”<sup>20</sup> because without assurance that the fruits of authors’ labors could obtain sufficient protection from piracy<sup>21</sup> or unauthorized reproduction, there would be no incentive to innovate new or improved design concepts.<sup>22</sup> Copyright allows artists and authors to actively participate in a market designed for the creation and distribution of artistic works, while at the same time entitling them to legal protection against unauthorized exploitation.<sup>23</sup> The right of control provides the incentive for artists to continue creating and challenging conventional forms and mediums of creative expression, thus carrying out the Framers’ intention of progressing the development of useful arts.<sup>24</sup> That said, excessively broad protection

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<sup>19</sup> U.S. CONST. art. I, § 8, cl. 8. (“The Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .”). All works protected under the Copyright law are “writings”; those protected by patent law are “discoveries.” Victoria Elman, Note, *From the Runway to the Courtroom: How Substantial Similarity Is Unfit for Fashion*, 30 CARDOZO L. REV. 683, 715 n.24 (2008) (providing reasons substantial similarity is counterintuitive in the context of fashion, particularly because the art form requires frequent trend repetition and improvement).

<sup>20</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>21</sup> The issue of fashion piracy is beyond the scope of this Note, but for a fascinating discussion of how piracy may actually help fashion design innovation see Raustiala & Sprigman, *supra* note 1.

<sup>22</sup> JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 6 (4th ed. 2015).

<sup>23</sup> *Id.* at 7 (“Copyright law exists to provide a marketable right for the creators and distributors of copyrighted works, which in turn creates an incentive for production and dissemination of new works.”).

<sup>24</sup> Pierre N. Leval, Commentary, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1107 (1990). (“[Copyright law] is designed . . . to stimulate activity and progress in the arts for the intellectual enrichment of the public.”).

would stifle rather than advance Copyright law's objective.<sup>25</sup> Congress addressed this concern in the 1976 Act when it included language that formed the basis of the useful articles doctrine.<sup>26</sup>

### A. *The Useful Articles Doctrine*

The 1976 Act protects the majority of expressive works, such as novels,<sup>27</sup> music,<sup>28</sup> films,<sup>29</sup> and even computer programming codes,<sup>30</sup> but generally clothing apparel remains unprotected.<sup>31</sup> Congress grants copyright protection to original fixed works of authorship,<sup>32</sup> including "pictorial, graphic, and sculptural works."<sup>33</sup> The statutory definition provides specific examples of PGS works, such as maps and globes, but also contains the broader subcategory of "two-dimensional and three-dimensional works of fine, graphic, and applied art."<sup>34</sup> The definition further states that the "design of a useful article" is not protectable as a PGS work under the 1976 Act, unless the PGS design elements "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."<sup>35</sup> Consequently, certain artistic or aesthetic elements applied to, or incorporated within, useful articles may qualify for protection.<sup>36</sup> Finally, a "useful article," according to the statute, is an object that serves a utilitarian purpose beyond portraying its own appearance or conveying information.<sup>37</sup> In other words, a useful

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<sup>25</sup> *Id.* at 1109 ("Notwithstanding the need for monopoly protection of intellectual creators to stimulate creativity and authorship, excessively broad protection would stifle, rather than advance, the objective.").

<sup>26</sup> See discussion *infra* Section I.A.

<sup>27</sup> 17 U.S.C. § 102(a)(1) (2012).

<sup>28</sup> *Id.* § 102(a)(2).

<sup>29</sup> *Id.* § 102(a)(6).

<sup>30</sup> H.R. REP. NO. 94-1476, at 54 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5667.

<sup>31</sup> Registrability of Costume Designs, 56 Fed. Reg. 56,530 (Nov. 5, 1991) ("The Copyright Office has generally refused to register claims to copyright in three-dimensional aspects of clothing or costume design on the ground that articles of clothing and costumes are useful articles that ordinarily contain no artistic authorship separable from their overall utilitarian shape.").

<sup>32</sup> 17 U.S.C. § 102(a).

<sup>33</sup> *Id.* ("Works of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.").

<sup>34</sup> *Id.* § 101.

<sup>35</sup> *Id.*

<sup>36</sup> See *id.*

<sup>37</sup> *Id.* ("A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article.'"); *id.* § 113(b) ("This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater

article is any object created for a purpose other than providing information or exhibiting its aesthetic expression.<sup>38</sup>

The language used to define PGS works and useful articles was Congress's attempt to codify the standard set forth by the Supreme Court in *Mazer v. Stein*.<sup>39</sup> In *Mazer*, the Court addressed the copyrightability of dancing figurine statues manufactured as lamp bases.<sup>40</sup> The Court repudiated the defendant's argument that mass-produced works of art were barred from copyright protection, and instead introduced the notion that the "dichotomy of protection for the aesthetic" was not simply "beauty and utility."<sup>41</sup> Rather, the Court explained, the dichotomy of aesthetic protection required "art" for copyright protection, and an "invention of original and ornamental design for design patents"; however, the two protections were not mutually exclusive.<sup>42</sup> Because the statues were works of art in addition to, and separate from, their function as lamp bases, the Court held they were eligible for copyright protection.<sup>43</sup> Following the Court's decision in *Mazer*, Congress reacted, and with that the separability doctrine was born.

In amending the Copyright Act in 1976, Congress attempted to clarify the *Mazer* separability standard.<sup>44</sup> The House Report accompanying the 1976 amendment<sup>45</sup> (House Report) explained the Act's treatment of "applied art" and "uncopyrightable works of industrial design."<sup>46</sup> Congress included a useful article exception<sup>47</sup> in the

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or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law . . . .").

<sup>38</sup> *Id.*

<sup>39</sup> 347 U.S. 201 (1954); H.R. REP. NO. 94-1476, 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5667 ("A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art.").

<sup>40</sup> *Mazer*, 347 U.S. at 216.

<sup>41</sup> *Id.* at 218.

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 218-19.

<sup>44</sup> H.R. REP. NO. 94-1476, at 54 ("The Committee has added language to the definition of 'pictorial, graphic, and sculptural works' in an effort to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection. The declaration that 'pictorial, graphic, and sculptural works' include 'works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned' is classic language: it is drawn from Copyright Office regulations promulgated in the 1940's and expressly endorsed by the Supreme Court in the *Mazer* case.").

<sup>45</sup> *Id.*

<sup>46</sup> *Id.* at 55 ("In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.").

<sup>47</sup> 17 U.S.C. § 101 (2012) ("'Pictorial, graphic, and sculptural works' include two-dimensional and three-dimensional works of fine, graphic, and applied art . . . . [T]he design of



Act's definition of PGS works to effectively deny copyright protection to the shape of an industrial product—notwithstanding any aesthetic quality or value—but concomitantly left open the opportunity for copyrightable PGS elements of such products.<sup>48</sup> Such copyrightable PGS works of “applied art,” are usually the aesthetic elements of a useful article, provided the elements are identifiable as “physically or conceptually” separate from the purpose and utilitarian functions of the useful article.<sup>49</sup> But what exactly does that mean? How is separability determined? Is it a multi-factor balancing test or a totality of circumstances approach? In interpreting the Act's language, courts often considered the legislative purpose behind the useful article exception to better understand its intended application<sup>50</sup>; however, faced with such a broad and vague concept, courts struggled to align their interpretations.<sup>51</sup>

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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.”).

<sup>48</sup> The useful article exception of PGS work copyrightability, i.e., the separability requirement, was embedded in the Act's definition of “pictorial, graphic, and sculptural work[s]” to provide “as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.” H.R. REP. NO. 94-1476, at 55. The House Report further stated,

[a] two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill.

*Id.*

<sup>49</sup> *Id.* (“Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from ‘the utilitarian aspects of the article’ does not depend upon the nature of the design—that is, even if the appearance of an article is determined by [a]esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.”).

<sup>50</sup> See *infra* note 52 and accompanying text.

<sup>51</sup> See *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 670 (3d Cir. 1990) (“Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function.”); GOLDSTEIN ON COPYRIGHT, *supra* note 8 (“Courts have had less consistent success defining the test of conceptual separability than they have had with the test of physical separability.”).

Congress created the useful article doctrine to prevent manufacturers from monopolizing the production of useful articles by applying for copyright protection of the PGS elements of the useful article.<sup>52</sup> For instance, the House Report's examples of three-dimensional objects included the elaborate carving on the back of a wooden chair, and the floral relief pattern on the handle of flatware.<sup>53</sup> In those cases, Congress explained, copyright protection only extends to the floral relief or elaborate carving, not the configuration of the entire chair or whole piece of flatware.<sup>54</sup> Additionally, the useful article doctrine enforced the boundary line between patent and copyright, as the utilitarian aspects of a useful article must satisfy the more stringent standards of patent law.<sup>55</sup> The limiting principle prevented owners from obtaining the longer-term protection offered by copyright, circumventing the shorter-term protection offered under the Patent Act.<sup>56</sup>

Clothing is an example of a useful article.<sup>57</sup> It provides many functions in addition to portraying its own appearance and conveying

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<sup>52</sup> *Esquire, Inc. v. Ringer*, 591 F.2d 796, 801 n.15 (D.C. Cir. 1978). In *Esquire*, the court outlined three economic considerations Congress weighed in denying copyright protection to the design of shapes of utilitarian articles. *Id.* "First, in the case of some utilitarian objects, like scissors or paper clips, shape is mandated by function. If one manufacturer were given the copyright to the design of such an article, it could completely prevent others from producing the same article." *Id.* Second, because consumer preference may dictate uniformity of shape for certain useful articles, for example a stove, granting one manufacturer the copyright of such a design would be anticompetitive. *Id.* Third, because there are a limited number of basic geometric shapes (i.e., circles, rectangles, squares), such shapes are decisively in the public domain, "no matter how aesthetically well it was integrated into a utilitarian article." *Id.*

<sup>53</sup> H.R. REP. NO. 94-1476, at 55 ("And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.").

<sup>54</sup> *Id.*

<sup>55</sup> H.R. REP. NO. 94-1476, at 55 ("In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design."); GOLDSTEIN ON COPYRIGHT, *supra* note 8, § 2.5.3 (3d ed. Supp. 2016) ("[T]he difficulty [of drawing the boundary between the proper domains of copyright law and patent law, respectively] stems neither from logic nor policy but rather from the limits of legal language in expressing a line that will effectively serve the competing policies of copyright and patent law.").

<sup>56</sup> Congress intended to prevent intellectual property owners from shifting from one type of intellectual property protection to another because it would permit the owner to extend protection beyond what Congress determined was appropriate. *See Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 n.2 (2d Cir. 2005).

<sup>57</sup> U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.3(A) (3d ed. 2014) [hereinafter COMPENDIUM (THIRD)] ("Clothing such as shirts, dresses, pants, coats, shoes, and outerwear are not eligible for copyright protection because they are considered useful articles. This is because clothing provides utilitarian functions, such as warmth, protection, and modesty.").

information.<sup>58</sup> Fundamentally, clothing provides warmth, preserves modesty, and protects the body from the elements.<sup>59</sup> In 1991 the Copyright Office issued a policy decision clarifying its practices regarding clothing designs.<sup>60</sup> It explained that although garment designs were not protectable as useful articles, separately identifiable representations of PGS designs imposed on the garment were eligible for copyright protection.<sup>61</sup> That is, if the PGS elements of a costume pass the separability requirement.<sup>62</sup>

### B. *The Separability Requirement: Reading Between the Lines*

Although Congress introduced the separability requirement<sup>63</sup> to articulate the Court's *Mazer* standard, it soon proved difficult to apply in practice.<sup>64</sup> Using a two-step inquiry to determine whether a useful article's PGS elements qualify as separable, courts ask (1) whether the design for which the author seeks protection is connected to, or is a part of, the design of a "useful article"; and if so, (2) whether the design incorporates PGS features that can be identified separately from, or independently of, the mechanical and utilitarian aspects of the useful article.<sup>65</sup> The House Report's elaboration on the statutory language of

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<sup>58</sup> 17 U.S.C. § 101 (2012) ("A 'useful article' is an article having an intrinsic utilitarian function that is *not merely to portray the appearance of the article* or to convey information." (emphasis added)).

<sup>59</sup> See WILLIAM F. PATRY, 2 PATRY ON COPYRIGHT § 3:151 [hereinafter PATRY ON COPYRIGHT] (interpreting the Ninth Circuit's decision in *Mattel, Inc. v. MGA Entm't, Inc.*, 616 F.3d 904 (9th Cir. 2010) as concluding doll clothes were not useful articles because dolls do not feel cold or worry about modesty, thus they were eligible for copyright protection).

<sup>60</sup> Registrability of Costume Designs, 56 Fed. Reg. 56,530 (Nov. 5, 1991).

<sup>61</sup> *Id.* at 56,532 ("Garment designs (excluding separately identifiable pictorial representations of designs imposed upon the garment) will not be registered even if they contain ornamental features, or are intended to be used as historical or period dress. Fanciful costumes will be treated as useful articles, and will be registered only upon a finding of separately identifiable pictorial and/or sculptural authorship.").

<sup>62</sup> *Id.*

<sup>63</sup> 17 U.S.C. § 101 ("[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 capable of existing independently of, the utilitarian aspects of the article.").

<sup>64</sup> See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 992–93 (2d Cir. 1980) (agreeing with *Nimmer on Copyright* that "none of the authorities—the *Mazer* opinion, the old regulations, or the [1976 Act]—offer any 'ready answer to the line-drawing problem inherent in delineating the extent of copyright protection available for works of applied art.'" (citation omitted)).

<sup>65</sup> *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 481 (6th Cir. 2015), *cert. granted*, 136 S. Ct. 1823 (2016).

the separability requirement revealed that separability could be satisfied one of two ways: (1) physically or (2) conceptually.<sup>66</sup>

Physical separability is rather self-explanatory: when the PGS aspects of a useful article are physically separated from the article, but the utilitarian elements remain completely intact, the PGS works are physically separable.<sup>67</sup> The Copyright Office offers the example of a sufficiently creative decorative hood ornament on an automobile, which can be removed without destroying either the utilitarian function of the car, or the value of the hood ornament itself.<sup>68</sup> In practice, however, courts have been reluctant to rely exclusively on the physical separability test because it has limitations.<sup>69</sup> Physical separability works better when analyzing three-dimensional useful articles that feature PGS elements, such as the *Mazer* statue lamp bases.<sup>70</sup>

### C. *The Conceptual Separability Doctrine: A Metaphysical Journey*

Although more ambiguous and complicated of a process,<sup>71</sup> conceptual separability is a more suitable approach for useful articles that feature three-dimensional PGS elements.<sup>72</sup> For the PGS element of a useful article to be conceptually separable, the Copyright Office

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<sup>66</sup> The terms “physical” and “conceptual” separability do not appear in the statute, but rather came from the House Report accompanying the 1976 Act. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668 (“Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from ‘the utilitarian aspects of the article’ does not depend upon the nature of the design—that is, even if the appearance of an article is determined by [a]esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.”).

<sup>67</sup> COMPENDIUM (THIRD), *supra* note 57 § 924.2(A) (“Physical separability means that the useful article contains pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact.”).

<sup>68</sup> *Id.*

<sup>69</sup> *See Varsity Brands*, 799 F.3d at 482 (“Few scholars or courts embrace relying on the physical-separability test without considering whether the pictorial, graphic, or sculptural features of an article are conceptually separable because the physical-separability test has limitations.”).

<sup>70</sup> *See Mazer v. Stein*, 347 U.S. 201 (1954); *see also supra* Section I.A.

<sup>71</sup> *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 547–48 (S.D.N.Y. 2011) (“Of the two forms of separability, physical separability is somewhat easier to analyze[,] . . . [c]onceptual separability . . . is more abstract and less readily understood . . .”).

<sup>72</sup> Scholars disagree as to whether fabric designs should be subject to a conceptual separability analysis at all. *See infra* note 231 and accompanying text.

requires the design be discernible as a work of authorship that can be imagined or envisioned independently from the overall shape of the useful article.<sup>73</sup> Although this version of the conceptual separability test seems workable in theory, judicial development of the doctrine has revealed the difficulty of applying a singular test to analyze various mediums of art.<sup>74</sup> Courts,<sup>75</sup> scholars,<sup>76</sup> and students<sup>77</sup> alike have endeavored to articulate a sufficiently uniform approach to conceptual separability, yet many circuit courts of appeal continue to use different, and at times conflicting, approaches.<sup>78</sup>

Although the three-dimensional design of garments is considered a design of a useful article, and thus ineligible for copyright protection,<sup>79</sup> the expressive and artistic aspects of an article of clothing,<sup>80</sup> such as

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<sup>73</sup> COMPENDIUM (THIRD), *supra* note 57, § 924.2(B) (“Conceptual separability means that a feature of the useful article is clearly recognizable as a pictorial, graphic, or sculptural work, notwithstanding the fact that it cannot be physically separated from the article by ordinary means. This artistic feature must be capable of being visualized—either on paper or as a free-standing sculpture—as a work of authorship that is independent from the overall shape of the useful article. In other words, the feature must be imagined separately and independently from the useful article without destroying the basic shape of that article.”).

<sup>74</sup> See generally Darren Hudson Hick, *Conceptual Problems of Conceptual Separability and the Non-Usefulness of the Useful Articles Distinction*, 57 COPYRIGHT SOC’Y U.S. 37 (2010).

<sup>75</sup> See *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468 (6th Cir. 2015) (cheerleading uniforms), *cert. granted*, 136 S. Ct. 1823 (2016); *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411 (5th Cir. 2005) (fanciful casino employee costumes; vegetable shaped chef hats); *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004) (cosmetology mannequin heads); *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) (sculptural bike rack); *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411 (2d Cir. 1985) (clothing mannequins); *Poe v. Missing Perss.*, 745 F.2d 1238 (9th Cir. 1984) (bathing suit made of vinyl and rocks); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir.1980) (ornate belt buckles).

<sup>76</sup> See, e.g., GOLDSTEIN ON COPYRIGHT, *supra* note 8; NIMMER ON COPYRIGHT, *supra* note 8; PATRY, COPYRIGHT LAW, *supra* note 8; Byron, *supra* note 8; Denicola, *supra* note 8; Samson Vermont, *The Dubious Legal Rationale for Denying Copyright to Fashion*, 21 TEX. INTELL. PROP. L.J. 89, 94 n.36 (2013).

<sup>77</sup> DeVore, *supra* note 1; Keyes, *supra* note 8; Mencken, *supra* note 1; Sonja Wolf Sahlsten, Note, *I’m a Little Treepot: Conceptual Separability and Affording Copyright Protection to Useful Articles*, 67 FLA. L. REV. 941 (2015).

<sup>78</sup> See discussion *infra* Part II.

<sup>79</sup> *Fashion Originators Guild v. FTC*, 114 F.2d 80, 84 (2d Cir.1940) (holding that ladies’ dresses are useful articles not covered by the Copyright Act); *Registrability of Costume Designs*, 56 Fed. Reg. 56,530 (Nov. 5, 1991) (“The Copyright Office has generally refused to register claims to copyright in three-dimensional aspects of clothing or costume design on the ground that articles of clothing and costumes are useful articles that ordinarily contain no artistic authorship separable from their overall utilitarian shape.”); COMPENDIUM (THIRD), *supra* note 57, § 924.3(A) (“Clothing such as shirts, dresses, pants, coats, shoes, and outerwear are not eligible for copyright protection because they are considered useful articles.”).

<sup>80</sup> PGS aspects that are sufficiently conceptually separable from the utilitarian aspects of the clothing must meet the other standards required by the Act to receive copyright protection. COMPENDIUM (THIRD), *supra* note 57, § 924.3(A)(1) (“Although the copyright law does not protect the shape or design of clothing, and although fabric and textiles have useful functions (e.g., providing varying degrees of warmth and protection), designs imprinted in or on fabric are considered conceptually separable from the utilitarian aspects of garments . . .”).

appliqués,<sup>81</sup> fabric patterns,<sup>82</sup> lace fabric designs,<sup>83</sup> ornate belt buckles,<sup>84</sup> and the sculptural aspects of costumes<sup>85</sup> have been held eligible for copyright protection. These examples resulted from the evolution of the conceptual separability doctrine, the foundation of which comes from the Second Circuit in three cases following the 1976 amendment: *Kieselstein-Cord*,<sup>86</sup> *Barnhart*,<sup>87</sup> and *Brandir*.<sup>88</sup> The courts' interpretations of the new statutory language in these cases demonstrated the exceedingly difficult task of articulating a comprehensive approach to determining conceptual separability.<sup>89</sup>

### 1. Ornate Belt Buckles and Clothing Mannequins

In *Kieselstein-Cord v. Accessories by Pearl, Inc.*,<sup>90</sup> the Second Circuit considered whether the sculptural aspects of ornate belt buckles were copyrightable.<sup>91</sup> The works at issue were belt buckle designs influenced by art nouveau, Spanish architecture, and antique firearms.<sup>92</sup> Because buckles were so commercially successful on belts,<sup>93</sup> one of the models was sold in a smaller size and marketed as jewelry accessories (i.e.,

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<sup>81</sup> Appliqué designs are the result of a needlework technique using pieces of fabric stitched onto a base cloth to create a design. See CLIVE HALLETT & AMANDA JOHNSON, *FABRIC FOR FASHION: THE COMPLETE GUIDE* 42 (2014) [hereinafter *FABRIC FOR FASHION*].

<sup>82</sup> Also known as textile patterns, fabric patterns are generally two-dimensional PGS artistic works imprinted onto fabric that generally feature repetitive artistic design. See *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759 (2d Cir. 1991). Thus, in *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142, 143 (S.D.N.Y. 1959), the court held that a design printed on a dress fabric was eligible for copyright protection under the 1909 Act as both a work of art under section 5(g), and as a print under section 5(k).

<sup>83</sup> *Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484 (S.D.N.Y. 1997) (holding lace designs used for bridal dresses were eligible for copyright infringement; fabric design patterns are protectable as writings, even though clothes are not copyrightable).

<sup>84</sup> *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 990–91 (2d Cir. 1980).

<sup>85</sup> See *Nat'l Theme Prods., Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348 (S.D. Cal. 1988).

<sup>86</sup> *Kieselstein-Cord*, 632 F.2d at 990.

<sup>87</sup> *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985).

<sup>88</sup> *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

<sup>89</sup> *Kieselstein-Cord*, 632 F.2d at 990–91, 93 (“This case is on a razor’s edge of copyright law. . . . We say ‘on a razor’s edge’ because [it] requires us to draw a fine line under applicable copyright law and regulations. . . . This problem is particularly difficult because, according to the legislative history explored by the court below, such separability may occur either ‘physically or conceptually.’” (citing H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668)).

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> *Id.* at 991. The profits from the buckles amounted to more than ninety-five percent of the designer’s jewelry sales in 1979. *Id.* They were primarily sold at high fashion and jewelry stores, fostering recognition within the fashion industry, including an election to the Council of Fashion Designers of America. *Id.*

necklaces, bracelets, etc.).<sup>94</sup> Rejecting the argument that the buckles were useful articles, the court concluded the buckle designs were conceptually separable from the belt's utilitarian function because consumers wore them as ornamental accents in addition to wearing them as belt buckles.<sup>95</sup> The opinion suggested that conceptual separability is alone sufficient to confer copyright protection,<sup>96</sup> but failed to either identify which considerations carried the most weight, or articulate a clear and limited index of factors to determine conceptual separability.

Because the *Kieselstein-Cord* decision was the first conceptual separability case of its kind, the Second Circuit understandably did not adequately consider the potential consequences of the test as precedent. For example, the court only considered the ornamental use of the belt buckle instead of its limited, but still existent, utilitarian function.<sup>97</sup> The court simply concluded that if *any* customers wore the belt buckle as jewelry, the buckle had *a* primary ornamental usage, but it might not have been *the* primary ornamental aspect.<sup>98</sup> One Second Circuit judge later suggested that the primary/subsidiary inquiry should focus on frequency of ornamental usage in comparison to utilitarian usage, otherwise the approach might unfairly deny copyright protection to deserving works because, although a minority of consumers display the work as art, the majority use it as a useful article.<sup>99</sup> In other words, the outcome of this test depended too heavily on the eventual consumer's use to be reliable as a legal standard.

The Second Circuit took another swing at conceptual separability five years later in *Carol Barnhart v. Economy Cover Corp.*<sup>100</sup> where the court held that the designs of clothing mannequins, albeit expertly designed and intensely detailed, were not eligible for copyright protection because the design of the human body was not separable from its function as a human body model for clothing. The dissenting

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<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* at 993–94.

<sup>97</sup> *Id.* at 993 (“We see in appellant’s belt buckles conceptually separable sculptural elements, as apparently have the buckles’ wearers who have used them as ornamentation for parts of the body other than the waist. The primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function.”).

<sup>98</sup> *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 421 (Newman, J., dissenting) (“[The *Kieselstein-Cord*] approach apparently does not focus on frequency of utilitarian and non-utilitarian usage since the belt buckles in that case were frequently used to fasten belts and less frequently used as pieces of ornamental jewelry displayed at various locations other than the waist. The difficulty with this approach is that it offers little guidance to the trier of fact, or the judge endeavoring to determine whether a triable issue of fact exists, as to what is being measured by the classifications ‘primary’ and ‘subsidiary.’”).

<sup>99</sup> *Id.*

<sup>100</sup> *Id.* at 411 (2d Cir. 1985) (majority opinion).

opinion in *Barnhart* criticized existing conceptual separability tests before offering up his own.<sup>101</sup> Under Judge Newman's test, the PGS aspects of a useful article were copyrightable if they conjured in the observer a concept separate from the one conjured by the article's utilitarian functions.<sup>102</sup> Judge Newman referred to this notion—the ability to displace the concept conjured by the utilitarian aspects while still holding the concept engendered by the artistic aspects—as the “temporal sense of separateness.”<sup>103</sup> The viewer's conjuring of a distinct aesthetic concept, known temporal displacement,<sup>104</sup> did not need to happen immediately upon viewing the object; it could have occurred after reasonable visual inspection and consideration of all evidence, including expert testimony and survey evidence.<sup>105</sup> Judge Newman used the example of an artistically designed chair to illustrate the test's application<sup>106</sup>; even if the chair was so artistically designed that it was worthy of display in a museum, the reasonable observer could not have

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<sup>101</sup> *Id.* at 421 (Newman, J., dissenting). Judge Newman articulated four tests. The first was “usage,” which denied copyrightability to an article that primarily existed to serve a utilitarian function “even though [] design elements rendered it usable secondarily solely as an artistic work.” *Id.* The second test, derived from *Kieselstein-Cord*, upheld copyright protection “whenever the decorative or aesthetically pleasing aspect of the article can be said to be ‘primary’ and the utilitarian function can be said to be ‘subsidiary.’” *Id.* at 421. Newman warned that the problem with this and the usage approach above was that they depended on how and why the majority of people use an article; copyright protection should not be withheld “just because a majority of people use it as something [other than a solely artistic work].” Keyes, *supra* note 8, at 126. The third approach was Professor Nimmer's marketability test. See discussion *infra* Section II.B.2. Judge Newman criticizes this approach by pointing out that “various sculpted forms would be recognized as works of art by many, even though those willing to purchase them for display in their homes might be few in number and not a ‘significant segment of the community.’” *Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting). The fourth test finds conceptual separability “whenever the design of a form has sufficient aesthetic appeal to be appreciated for its artistic qualities.” *Id.* Judge Newman contends Congress rejected this test in the House Report because even though the PGS features of a useful article may be the reason for the aesthetic value of the piece, they are not copyrightable if they cannot be identified separately. *Id.*

<sup>102</sup> *Id.* (“For the design features to be ‘conceptually separate’ from the utilitarian aspects of the useful article that embodies the design, the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”).

<sup>103</sup> *Id.* at 423.

<sup>104</sup> WILLIAM F. PATRY, *LATMAN'S: THE COPYRIGHT LAW* 44 (6th ed. 1986) [hereinafter PATRY, *LATMAN'S*].

<sup>105</sup> *Id.* (“This displacement need not turn on the immediate reaction of the ordinary observer but on whether visual inspection of the article and consideration of all pertinent evidence would engender in the observer's mind a separate non-utilitarian concept that can displace, at least temporarily, the utilitarian concept.”).

<sup>106</sup> *Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting). Judge Newman did not provide an example of such a chair, but to view images that exemplify the multitude of ways chairs are designed see generally STUART LAWSON, *FURNITURE DESIGN: AN INTRODUCTION TO DEVELOPMENT, MATERIALS AND MANUFACTURING* (2013).



envisioned a concept separate from the one engendered by the chair's function of providing a place to sit.<sup>107</sup>

Judge Newman's temporal displacement test probably best articulates the legislative intent of the conceptual separability requirement,<sup>108</sup> but it has been heavily criticized as too obscure and difficult to use in practice.<sup>109</sup> The *Barnhart* majority pointed out that almost any useful article can be considered art if displayed in a particular way, such as Marcel Duchamp's<sup>110</sup> the *Fountain*, an infamous piece of art comprising a porcelain urinal displayed on its side and signed with the pseudonym "R. Mutt 1917."<sup>111</sup> Congress has been very clear, however, to only grant copyright protection for the object displayed in such a case, not the object as displayed in a clever manner.<sup>112</sup>

## 2. Ribbon Rack: *Brandir International v. Cascade Pacific Lumber Co.*

The Second Circuit attempted to determine conceptual separability a third time in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*<sup>113</sup> At issue was the infamous Ribbon Rack, a bicycle rack made of

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<sup>107</sup> *Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting) ("A chair may be so artistically designed as to merit display in a museum, but that fact alone cannot satisfy the test of 'conceptual separateness.' The viewer in the museum sees and apprehends a well-designed chair, not a work of art with a design that is conceptually separate from the functional purposes of an object on which people sit.").

<sup>108</sup> PATRY, LATMAN'S, *supra* note 104, at 45 ("Judge Newman's temporal displacement test is believed to offer the most persuasive approach to what is, admittedly, a perplexing issue.").

<sup>109</sup> The majority pointed out that Judge Newman's admitted "uncertainty as to whether the styrene mannequin chests clothed with a shirt or blouse could be viewed by the ordinary observer as art only serves to underscore the bottomless pit that would be created by such a vague test." *Carol Barnhart*, 773 F.2d at 419 n.5. At least one person has suggested the vulnerability of Judge Newman's chair by describing a chair that "has a large spike protruding from the top of the seat, or one that has no seat at all." Keyes, *supra* note 8, at 127 n.121.

<sup>110</sup> Marcel Duchamp is a famous French artist associated with the conceptual art and Dada movement. *Dada: Marcel Duchamp and the Readymade*, MOMA LEARNING: THEMES, [https://www.moma.org/learn/moma\\_learning/themes/dada/marcel-duchamp-and-the-readymade](https://www.moma.org/learn/moma_learning/themes/dada/marcel-duchamp-and-the-readymade) (last visited Jan. 7, 2016).

<sup>111</sup> The piece was highly controversial and the exhibit's board of directors initially rejected it in violation of the Society's mandate that all works be accepted provided the artist pays the necessary fee. See Sophie Howarth, *Marcel Duchamp: Fountain 1917, replica 1964*, TATE, <http://www.tate.org.uk/art/artworks/duchamp-fountain-t07573/text-summary> (last updated Aug. 2015). The readymade movement endeavors to use mass-produced, commercially available utilitarian objects and designate them as art by displaying them with a title. MOMA LEARNING: THEMES, *supra* note 110. The movement "disrupted centuries of thinking about the artist's role as a skilled creator of original handmade objects," as well as "def[y]ing the notion that art must be beautiful." *Id.*

<sup>112</sup> *Carol Barnhart*, 773 F.2d at 419 n.5.

<sup>113</sup> 834 F.2d 1142 (2d Cir. 1987).

bent tubing material that originated from a wire sculpture.<sup>114</sup> Adopting a new theory advanced by Professor Denicola in a Minnesota Law Review article,<sup>115</sup> the *Brandir* court articulated a new test it believed would clarify any remaining confusion following the *Barnhart* decision two years earlier.<sup>116</sup> The premise of the test, commonly referred to as the “design-process” approach,<sup>117</sup> is that artistic and utilitarian aspects are not mutually exclusive in useful articles, but rather exist on a continuum.<sup>118</sup> Professor Denicola argued that the statutory language intended to delineate between, on the one hand, designs of useful articles that were heavily constrained by utilitarian concerns; and on the other hand, PGS works incorporated into useful articles that were designed independent of such utilitarian concerns.<sup>119</sup> The court rephrased the approach as barring copyrightability for the design of a PGS work that merged aesthetic and utilitarian concerns.<sup>120</sup> In other words, when analyzing a PGS design element created for incorporation into a useful article, if the PGS author’s expression was at all influenced by the inevitable utilitarian functions of the article, the work is not conceptually separable.<sup>121</sup> Applying its version of Professor Denicola’s test,<sup>122</sup> the court found the Ribbon Rack was chiefly influenced by utilitarian concerns because, although it originated as a wire sculpture, the artist modified the original design to optimize the curves and width of the loops to better accommodate bikes.<sup>123</sup> Thus, the court held the ribbon sculpture design was not conceptually separable from the bike rack’s function of providing convenient and well-sized spaces to store a bike.<sup>124</sup>

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<sup>114</sup> *Id.*

<sup>115</sup> Denicola, *supra* note 8.

<sup>116</sup> *Brandir*, 834 F.2d at 1145 (“Perhaps the differences between the majority and the dissent in *Carol Barnhart* might have been resolved had they had before them the Denicola article on *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*.”).

<sup>117</sup> *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 484 (6th Cir. 2015).

<sup>118</sup> Denicola, *supra* note 8, at 741 (“[T]here is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.”).

<sup>119</sup> *Id.* at 742. Denicola describes the latter category of designs as “elements whose form and appearance reflect the unconstrained perspective of the artist.” *Id.*

<sup>120</sup> *Brandir*, 834 F.2d at 1145 (“To state the Denicola test in the language of conceptual separability, if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”).

<sup>121</sup> *Id.*

<sup>122</sup> Denicola, *supra* note 8, at 741.

<sup>123</sup> *Brandir*, 834 F.2d at 1146–47. The *Brandir* plaintiff’s friend, “a bicycle buff and author of numerous articles about urban cycling,” was the first to suggest that his wire sculpture “would make excellent bicycle racks, permitting bicycles to be parked under the overloops as well as on top of the underloops.” *Id.* at 1146.

<sup>124</sup> *Id.* at 1146–47.

The dissent argued the design-process test flagrantly disregarded the Act's legislative history because it did not focus on the final fixed expression of the work, but rather the process by which the designer arrived at the final expression.<sup>125</sup> One treatise author has further stated that the approach undermined the legislative intent of the doctrine by mistakenly conflating conceptual separability with the idea/expression doctrine.<sup>126</sup> The process by which the final design was executed should not have been considered a relevant factor of the test because all designs consider, at the very least, a modicum of utilitarian function.<sup>127</sup>

These cases represent the provenance of what has become an extremely complicated and nuanced doctrine of various analytical approaches attempting to solve an increasingly metaphysical quandary that applies to boundless ubiquitous objects.<sup>128</sup> Recently over ten approaches<sup>129</sup> have been identified, but none have definitively prevailed as the clear majority test used among circuit courts of appeal; in fact, multiple tests have been used within one circuit to determine conceptual separability,<sup>130</sup> leading to further confusion and discord in this area of the law.

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<sup>125</sup> *Id.* at 1152 (Winter, J., dissenting) (“I cannot agree that copyright protection for the Ribbon Rack turns on whether [plaintiff] serendipitously chose the final design of the Ribbon Rack during his initial sculptural musings or whether the original design had to be slightly modified to accommodate bicycles. Copyright protection, which is intended to generate incentives for designers by according property rights in their creations, should not turn on purely fortuitous events. For that reason, the Copyright Act expressly states that the legal test is how the final article is perceived, not how it was developed through various stages.”).

<sup>126</sup> PATRY ON COPYRIGHT, *supra* note 59, § 3:141 (“[The] requirement that the designer’s artistic judgment be exercised ‘independently of functional influences’ is without any basis in the statute or the legislative history . . . it resurrects a requirement abandoned by the Copyright Office in 1959 after three disastrous years of experience. The 1956 regulation protected shapes of useful articles only if the shape was not ‘dictated by, or necessarily responsive to, the requirements of its utilitarian function.’ The Copyright Office concluded that the regulation was an abysmal failure and ‘practically unworkable.’ . . . [A]ll designers of applied art create with functional limitations in mind.”). The idea/expression doctrine dictates that *ideas* cannot be copyrighted, only the *expressions* of them. 17 U.S.C. § 102(b) (2012) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

<sup>127</sup> PATRY ON COPYRIGHT, *supra* note 59, § 3:141.

<sup>128</sup> *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468, 495 (6th Cir. 2015) (McKeague, J., dissenting).

<sup>129</sup> *See Varsity Brands*, 799 F.3d at 484–87 (summarizing nine tests that have been used to analyze conceptual separability of PGS works embodied in useful articles before creating its own); Vermont, *supra* note 76 at 94 n.36 (citing cases and scholarship literature that serve the basis of these ten or so tests); *supra* note 8.

<sup>130</sup> *Compare Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 323 (2d Cir. 1996) (holding that even though a fish mannequin used by taxidermists to mount skins of trophy fish has the useful function of portraying “their” appearance, it was copyrightable because it was meant to be viewed), *with Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 F. App’x 42 (2d Cir. 2012) (holding the design of a prom dress was not copyrightable because its function was to enhance appearance of the wearer; thus it served a “decorative” function distinct from the

## II. CONCEPTUAL SEPARABILITY DOCTRINE IN THE CONTEXT OF CLOTHING DESIGN

Discussion of copyright protection for clothing designs often involves blurred semantics as clothing design vocabulary allows words to carry multiple meanings.<sup>131</sup> The leading treatise on copyright law, *Nimmer on Copyright*,<sup>132</sup> contends that although scholars and fashion designers alike often use the terms “fabric design” and “dress design” interchangeably, these terms should refer to distinctive design concepts.<sup>133</sup> According to *Nimmer*, the term “dress design” (garment design<sup>134</sup>) should exclusively be used to describe a design that comprises the “shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment.”<sup>135</sup> Alternatively, the term “fabric design” should exclusively refer to an original design, such as a unique rendition of a rose that is printed in a repetitive and consistent pattern throughout the dress fabric, or appears “but once” on the final dress product.<sup>136</sup> Although garment designs are not uncopyrightable per se, few have satisfied separability.<sup>137</sup> Fabric designs, on the other hand, rarely face the obstacles posed by the useful articles doctrine.<sup>138</sup>

### A. *Fabric Design: The Copyrightable Crowd Favorite*

Courts regarded pictorial illustrations printed onto or incorporated within fabric (i.e., fabric designs) as copyrightable works of art even before the 1976 Act was implemented.<sup>139</sup> Fabric, woven fibers that comprise a tangible sheet of cloth used to make clothing, is a useful

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function of “portraying its own appearance”). For further discussion of the *Jovani Fashion* case, see *infra* Section II.B.3.

<sup>131</sup> See NIMMER ON COPYRIGHT, *supra* note 8 § 2A.08[H][1]. Professor Nimmer notes that the terms “fabric design” and “pattern design” are often used interchangeably to describe an aesthetic pattern or functional shape of clothing. *Id.*

<sup>132</sup> *Id.*

<sup>133</sup> *Id.*

<sup>134</sup> To avoid confusion as to whether the designs referenced are of actual dresses—and to sidestep gender conventions—this Note refers to the term “dress design” as “garment design.”

<sup>135</sup> See NIMMER ON COPYRIGHT, *supra* note 8 § 2A.08[H][1].

<sup>136</sup> *Id.*

<sup>137</sup> *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 419 n.17 (5th Cir. 2005).

<sup>138</sup> *Langman Fabrics, Inc. v. Graff Californiawear, Inc.*, 160 F.3d 106, 114 (2d Cir. 1998) (“[T]he question is not whether the design itself is useful, but whether the fabric on which the design is printed is useful.”).

<sup>139</sup> See, e.g., *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092 (2d Cir. 1974); *Millworth Converting Corp. v. Slifka*, 276 F.2d 443 (2d Cir. 1960); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960); *Irving J. Dorfman Co. v. Borlan Indus., Inc.*, 309 F. Supp. 21 (S.D.N.Y. 1969).

article;<sup>140</sup> but two-dimensional pictorial designs or aesthetic embellishments applied to or incorporated within<sup>141</sup> fabric are “writings”<sup>142</sup> entitled to copyright protection.<sup>143</sup> Courts have afforded copyright protection to fixed patterns comprising original compilations of graphic images,<sup>144</sup> ornamental puffy appliqué artwork affixed to a sweater,<sup>145</sup> and elaborate lace patterns made for wedding dresses.<sup>146</sup> This is because fabric designs, two-dimensional renderings of expressive PGS works, are distinguishable from garment designs, the three-dimensional renderings of expressive PGS works.<sup>147</sup> Determining the copyrightability of garment design, however, is far more complicated than determining the copyrightability of fabric design.<sup>148</sup>

### B. *Garment Design: The Uncopyrightable Underdog*

With few exceptions,<sup>149</sup> the circuit courts of appeal generally agree garment designs are not eligible for copyright protection.<sup>150</sup> And while garment designs are distinguishable from fabric patterns,<sup>151</sup> many courts still struggle to determine when the aesthetic elements of clothing

<sup>140</sup> *Langman Fabrics*, 160 F.3d at 114 (“If any ‘fabric’ is useful, fabric that is made to be worn as clothing surely is.”).

<sup>141</sup> For example, area rugs provide warmth from a cold floor, but a pictorial design or graphic incorporated into the rug—by dyeing certain fibers to create the overall aesthetic effect—is not a design of a useful article. See PATRY ON COPYRIGHT, *supra* note 59, § 3:151 (elaboration of rug example).

<sup>142</sup> U.S. CONST. art. 1, § 8, cl. 8 (“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .”).

<sup>143</sup> *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996, 1002 (2d Cir.1995) (“[F]abric designs, such as the artwork on [plaintiff’s] sweaters, are considered ‘writings’ for purposes of copyright law and are accordingly protectible [sic.]”); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 763 (2d Cir. 1991) (“Among those forms of ‘writings’ now recognized as entitled to copyright protection are fabric designs . . .”).

<sup>144</sup> See *Folio Impressions*, 937 F.2d at 765 (fabric design pattern featuring uniquely arranged clip art roses copyrightable).

<sup>145</sup> *Knitwaves*, 71 F.3d at 1002 (holding an original arrangement of fall-themed appliqués copyrightable).

<sup>146</sup> *Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484, 489 (S.D.N.Y. 1997) (designs of lace used for wedding dresses copyrightable as a fabric design).

<sup>147</sup> *Folio Impressions*, 937 F.2d at 763.

<sup>148</sup> See discussion *infra* Section II.B.

<sup>149</sup> See *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005) (plush animal costume designs may be conceptually separable); *Poe v. Missing Perss.*, 745 F.2d 1238 (9th Cir. 1984) (reversing summary judgment and remanding the case to the district court to determine whether a swimsuit design made of clear vinyl and rocks, which was intended to be a sculpture, was a useful article); *Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F. Supp. 175 (D.C. Minn. 1985) (holding a slipper depicting a bear’s foot was entitled to copyright protection because it was essentially a fanciful artistic rendition of a bear’s foot).

<sup>150</sup> See, e.g., *Fashion Originators Guild of Am. v. FTC*, 114 F.2d 80 (2d Cir. 1940).

<sup>151</sup> See *supra* Section II.A.

articles deserve copyright protection. This Section discusses four cases that exemplify how various circuits have determined the copyright eligibility of three-dimensional aspects of clothing design: plush animal costumes, employee uniforms, prom dresses, and cheerleading uniforms.

### 1. Animal Costumes: *Chosun International v. Chrisha Creations*

Costumes are an ostensible exception to the 1976 Act's clothing exclusion. The cases that occupy the conceptual separability gray area concern the design of full body costumes, such as Halloween costumes.<sup>152</sup> In *Chosun International, Inc. v. Chrisha Creations, Ltd.*,<sup>153</sup> the issue facing the court was whether the design elements of plaintiff's plush, animal-themed Halloween costumes—composed of a bodysuit and an attachable sculpted hood—were copyrightable.<sup>154</sup>

While declining to answer whether the costumes were useful articles, the court implicitly rejected the defendant's argument that because the costumes were used to "masquerade" as animals, they were "useful" within the meaning of § 101 of the 1976 Act.<sup>155</sup> To "masquerade" in this context was to allow the costume wearer to portray the appearance of an animal.<sup>156</sup> Masks serve the same purpose, but they are copyrightable so long as they feature an original PGS work of authorship.<sup>157</sup> Accordingly, although the *Chosun* court acknowledged uncopyrightable elements existed in the costume that performed the "clothing" function—such as the two cylinders of cloth forming the costume's pants<sup>158</sup>—there were other three-dimensional sculptural

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<sup>152</sup> See *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005).

<sup>153</sup> *Id.*

<sup>154</sup> *Id.* at 329–30.

<sup>155</sup> *Id.* at 229 n.3.

<sup>156</sup> *Id.*

<sup>157</sup> See *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586 (7th Cir. 2003) (novelty fake teeth protected); *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 670 (3d Cir. 1990) (holding that the utilitarian nature of animal nose masks was to portray its appearance and was exempt from the useful articles doctrine under 17 U.S.C. § 102(a)(5) and thus copyrightable); *Registrability of Costume Designs*, 56 Fed. Reg. 56,530 (Nov. 5, 1991) ("In general, cases have not treated masks as useful articles, and, as a result, copyrightability can be supported by a mere finding of pictorial or sculptural authorship.").

<sup>158</sup> Professor Patry believes that no part of a costume should be classified as performing a "clothing" function because people generally wear them over clothes. PATRY ON COPYRIGHT, *supra* note 59, § 3:153 ("Costumes, including those for mascots, should be treated like masks; their sole purpose is imaginative and only to convey their appearance. Even in the case of full body costumes, such costumes can easily be worn over actual clothing. Any rule of law that is based on the mere possibility that one may flit around naked with a costume functioning as the 'real' clothing is so silly it should not be seriously entertained but for the fact that the Copyright Office and most, but not all courts, have adopted it." (footnotes omitted)). However, this view is misguided, not every costume allows one to wear clothing underneath. In fact, many costume

elements of the design that concomitantly performed the “masquerading” function of portraying the appearance of an animal.<sup>159</sup> The Second Circuit concluded the plaintiff could reasonably have made a showing that certain “masquerading” elements of the costumes were neither necessarily designed nor intended to enhance the functionality of the costume qua clothing.<sup>160</sup> Thus, when PGS design elements of a garment do not enhance the “clothing” function of the article, but do enhance the “masquerading” function, the PGS elements might be conceptually separable and thus eligible for copyright protection.<sup>161</sup> Although the court did not endorse a single test or express an opinion that was dispositive of conceptual separability, it analyzed the issue using Judge Newman’s temporal displacement test<sup>162</sup> from the *Barnhart* dissent, and the *Brandir* design process test.<sup>163</sup>

## 2. Employee Uniforms: *Galiano v. Harrah’s Operating Co.*

The same year as *Chosun*, the Fifth Circuit decided a similar issue using a markedly different hybrid test in *Galiano v. Harrah’s Operating Co.*<sup>164</sup> In *Galiano*, the plaintiff, founder and owner of Gianna, Inc., sued Harrah’s Entertainment Inc. (Harrah’s) for copyright infringement of its casino uniform design collection.<sup>165</sup> The collection included: uniform jackets with front and back princess line seams; chef hats shaped like vegetables; chef uniforms with unique bib fronts and colorblocked<sup>166</sup>

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designs envision the person not wearing anything underneath the costume. For instance, costumes of the “sexy” variety are worn with little regard for warmth, modesty, or coverage, and provide no room for a layer of clothing underneath the costume. *See, e.g., Moonlight Bat*, LEG AVENUE <http://www.legavenue.com/costumes/spooky-classics/moonlight-bat.html> (last visited Dec. 21, 2015). Similarly, costumes designed to look like regular clothes in order to masquerade as a celebrity require the person to not wear anything underneath the costume. *See, e.g., Workout Video Star Costume*, AMAZON: FUN COSTUMES, <http://www.amazon.com/Fun-Costumes-Workout-Video-Costume/dp/B008MQBLT8> (last visited Dec. 21, 2015) (Richard Simmons).

<sup>159</sup> *Chosun*, 413 F.3d at 329 n.3.

<sup>160</sup> *Id.* at 330. (“Chosun may be able to show that they invoke in the viewer a concept separate from that of the costume’s ‘clothing’ function, and that their addition to the costume was not motivated by a desire to enhance the costume’s functionality qua clothing.”).

<sup>161</sup> *Id.* at 329 n.3.

<sup>162</sup> *See supra* Section I.C.1.

<sup>163</sup> *See supra* Section I.C.2.

<sup>164</sup> 416 F.3d 411 (5th Cir. 2005).

<sup>165</sup> Gianna, Inc. and Harrah’s had entered into an agreement whereby Gianna, Inc. was to design uniforms for various Harrah’s Casino employees. *Id.* at 413. Gianna, Inc. then engaged two regular suppliers for Harrah’s to discuss manufacturing; one of the manufacturers created prototypes of Gianna’s designs for Harrah’s approval. *Id.* After the agreement between Gianna, Inc. and Harrah’s expired and the parties did not extend it, Harrah’s continued to use the suppliers to manufacture the Gianna, Inc. designs. *Id.* at 413–14.

<sup>166</sup> *See supra* note 14.

mandarin collars; and jacquard fabric that concealed button or snap plackets.<sup>167</sup>

In addition to asking whether the design elements were conceptually separable, the court asked whether they were marketable in their own right.<sup>168</sup> In other words, the court asked whether the useful article would still be marketable, in light of its value as a work of art, even if it had no utilitarian function.<sup>169</sup> This is known as Professor Nimmer's "likelihood of marketability" approach.<sup>170</sup> The court found additional support for its position in the Ninth Circuit case *Poe v. Missing Persons*.<sup>171</sup> In *Poe*, the court held a bikini sculpture could have been eligible for copyright protection because it was created and originally marketed as a work of art.<sup>172</sup>

The *Galiano* court held that the plaintiff effectively failed to show that these design elements were independently marketable without their utilitarian function and accordingly denied copyright protection.<sup>173</sup> Although the court recognized the marketability test should not apply to the spectrum of applied art, as the test unfairly favored conventional commercial forms of art,<sup>174</sup> the court held that it was sufficient for *this* case because it was limited to the context clothing design as an art medium.<sup>175</sup> The marketability approach has been widely criticized for viewing conceptual separability through the scope of commercial viability because it relies on current market demand for the PGS design element at issue.<sup>176</sup> Justice Holmes has repeatedly admonished this

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<sup>167</sup> *Galiano*, 416 F.3d at 413 n.3.

<sup>168</sup> *Id.* at 414.

<sup>169</sup> *Id.*

<sup>170</sup> NIMMER ON COPYRIGHT, *supra* note 8, § 2A.08[B][4].

<sup>171</sup> 745 F.2d 1238 (1984).

<sup>172</sup> *Id.* at 1242 (holding a clear vinyl and rock swimsuit *may* copyrightable as it was "artwork and not a useful article of clothing").

<sup>173</sup> *Galiano*, 416 F.3d at 422.

<sup>174</sup> *Id.* at 421 n.26.

<sup>175</sup> *Id.* ("[That the test might unduly favor more conventional forms of art] is a salient concern only if we apply the marketability test across the spectrum of applied artwork; here we apply it only to one art form.")

<sup>176</sup> *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting) ("This 'market' approach risks allowing a copyright only to designs of forms within the domain of popular art, a hazard Professor Nimmer acknowledges. However, various sculpted forms would be recognized as works of art by many, even though those willing to purchase them for display in their homes might be few in number and not a 'significant segment of the community.'" (internal citation omitted)); GOLDSTEIN ON COPYRIGHT, *supra* note 8, § 2.5.3 (3d ed. 2015-1 Supp.) ("Care must be taken in applying marketability as an index of separability—even in the case of garments, and especially in the case of two-dimensional appliqué—for a design should not be denied protection if it can be removed without impairing a garment's utility to efficiently clothe the wearer. . . . The danger of the marketability test is that, in cases where marketability turns exclusively on superficial appearances, the test will deny protection to creative work, yet do nothing to serve the avowed function of the useful article doctrine to withhold copyright from useful articles that fail to qualify for patent protection."); *Keyes*, *supra* note 8, at 136 ("While the test may reduce the amount by which judges' personal



method of analysis in copyright,<sup>177</sup> urging the principle that copyright law should not only protect works of art a judge may be able to identify or value.<sup>178</sup> Copyrightability should be determined by the statutory requirements of a work of copyrightable authorship.<sup>179</sup>

### 3. Prom Dresses: *Jovani Fashion v. Fiesta Fashions*

Seven years after *Chosun*, the Second Circuit decided *Jovani Fashion, Ltd. v. Fiesta Fashions*,<sup>180</sup> which addressed the conceptual separability of a prom dress design.<sup>181</sup> At the trial court level,<sup>182</sup> the defendant Fiesta Fashions moved to dismiss the infringement claim on the ground that the prom dress style was not copyrightable.<sup>183</sup> Jovani argued the copyright protection afforded the sketches of the dress's aesthetic design style extended to three-dimensional renderings because the original artwork incorporated the following copyrightable elements: the selection of sequins and their arrangement in original patterns on the bust; the ruched satin fabric at the waist; and finally, the wire-edged tulle fabric added to the lower portion of the dress.<sup>184</sup> In short, Jovani argued its registered style copyright protected the compilation,

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opinions of the nature of art influence outcomes, the test significantly increases the influence of the personal opinions of other people.”).

<sup>177</sup> See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value—it would be bold to say that they have not an aesthetic and educational value—and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change.”).

<sup>178</sup> 17 U.S.C. § 102(a) (2012) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”); 37 C.F.R. § 202.10(a) (2016) (“In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form. The registrability of such a work is not affected by the intention of the author as to the use of the work or the number of copies reproduced.”).

<sup>179</sup> *Id.*

<sup>180</sup> 500 F. App'x 42 (2d Cir. 2012).

<sup>181</sup> *Id.*

<sup>182</sup> *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542 (S.D.N.Y. 2011).

<sup>183</sup> See *id.* at 546.

<sup>184</sup> *Id.* For a photo of the original dress design, see Figure 1. The same photo, featured side-by-side with the allegedly infringing dress, can be found in Jovani's Second Circuit brief. Brief for Plaintiff-Appellant at 9, *Jovani Fashion, Ltd.*, 500 F. App'x 42 (No. 12-598-cv) 2012 WL 1494884, ECF No. 45, at 14.

selection, coordination, and arrangement of all these original elements when rendered in a manufactured dress.<sup>185</sup>



FIGURE 1:  
Jovani Prom Dress Design

Applying numerous conceptual separability tests from various circuits, the district court held the designs were not copyrightable.<sup>186</sup> Most notably, the designs did not pass Judge Newman's temporal displacement test<sup>187</sup> because the dress did not conjure a concept separate from the dress's covering function.<sup>188</sup> Additionally, the court found the designs failed the *Brandir* design process test<sup>189</sup> because the PGS elements identified by the plaintiff were designed for the purpose of adhering to the specific functional and dimensional aspects of a prom dress shape.<sup>190</sup> The sequins contained in the cloth formed the bust of the dress, the satin fabric formed the waistband, and the tulle layers served as the skirt of the dress, thus the PGS design elements were heavily influenced by the functional considerations of the dress and not conceptually separate.<sup>191</sup> For instance, the sequin arrangement that created a design on the bust of the dress was necessarily constrained by the form of the sweetheart neckline; to achieve the desired aesthetic effect, the designer's artistic expression was constrained by the boundary of the dress shape and seams.<sup>192</sup> The dress also failed the Fifth Circuit's *Nimmer/Poe* test from *Galiano*<sup>193</sup> because the designer did not

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<sup>185</sup> *Id.*

<sup>186</sup> *Jovani Fashion, Ltd.*, 808 F. Supp. 2d at 549–51.

<sup>187</sup> *See supra* Section I.C.1.

<sup>188</sup> *Jovani Fashion, Ltd.*, 808 F. Supp. 2d at 550. The only concept the district court believed the dress conjured was a “vague association with the aquatic.” *Id.*

<sup>189</sup> *See supra* Section I.C.2.

<sup>190</sup> *Jovani Fashion, Ltd.*, 808 F. Supp. 2d at 550.

<sup>191</sup> *Id.*

<sup>192</sup> *Id.*

<sup>193</sup> *See supra* Section II.B.2.

create something novel and marketable apart from features that adorned a dress; the individual design elements had no meaningful independent marketable worth.<sup>194</sup> Finally, it failed the *Kieselstein-Cord* primary/subsidiary test<sup>195</sup> because in the district court's opinion, the primary role of each decorative element was to contribute to the dress's overall aesthetic appeal.<sup>196</sup> The court reasoned that in light of this primary purpose, the decorative elements do not outweigh the utilitarian function of enhancing the wearer's appearance.<sup>197</sup>

The Second Circuit affirmed the district court's dismissal using only two approaches.<sup>198</sup> The court held the aesthetic and functional elements of the prom dress were not separable under the design process test, and did not conjure in the observer a concept other than clothing under the temporal displacement test.<sup>199</sup> Thus, although *Jovani Fashion* held copyright in the two-dimensional styles of its dresses, this protection did not extend to the manipulation of the fabric, the various embellishment used with its fabric, or the arrangement, selection, and configuration of the original elements.<sup>200</sup>

The district court and Second Circuit's identification of the utilitarian function of the dress as of "aesthetically appealing" or "decorative" is puzzling. Did the courts mean that when one wears a prom dress, she exhibits a work of art with the purpose of appearing aesthetically pleasing to others? Or, by identifying the primary utilitarian function of the dress as enhancing the wearer's attractiveness, did the courts mean this function ran parallel to—or trumped—clothing's usual covering function?<sup>201</sup> Should aesthetic appeal even be considered a utilitarian function within the meaning of § 101 of the 1976 Act?

Both *Jovani Fashion* opinions suggested the prevailing utilitarian function of dresses is to enhance the aesthetic appeal of the wearer, not to display the aesthetic appeal of the dress.<sup>202</sup> In other words, the sequin arrangement on the sweetheart neckline bodice, the width and placement of the ruched satin waistband, and wire framed molded edges of the skirt were all designed with the purpose of making the wearer

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<sup>194</sup> See *supra* Section II.B.2.

<sup>195</sup> *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, (2d Cir. 1980); see also *supra* Section I.C.1.

<sup>196</sup> *Jovani Fashion, Ltd.*, 808 F. Supp. 2d at 550.

<sup>197</sup> *Id.*

<sup>198</sup> *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 F. App'x 42, 44 (2d Cir. 2012).

<sup>199</sup> *Id.*

<sup>200</sup> *Id.* at 45.

<sup>201</sup> *Jovani Fashion, Ltd.*, 808 F. Supp. 2d at 550 ("Aesthetic appeal is a core purpose of a prom dress. Given the purpose of a prom dress, a design element's decorative or aesthetic qualities will generally not suffice to trump its utilitarian function of enhancing the wearer's attractiveness.").

<sup>202</sup> *Id.*

more attractive.<sup>203</sup> When the court considered why people wore certain articles of clothing, the court did not ask whether the object was originally marketed as a work of art, as in *Poe v. Missing Persons*.<sup>204</sup> Instead, the courts asked whether the dress served one of many clothing functions: to cover the body, to provide warmth, to maintain modesty, or to be aesthetically appealing or decorative.<sup>205</sup> This approach was misguided. Accounting for such different utilitarian functions of clothing confuses the original rationale for denying copyright to garment design in the first place. Courts effectively place redundant hurdles in the way of obtaining copyright protection for garment design, rather than advancing a convincing legal argument, by denying protection to an aesthetic work that has a concomitant utilitarian function.

If the shape of the dress or shirt cannot be copyrighted, but fabric design patterns may be eligible provided they are conceptually separable, the outcome in *Jovani Fashion* would likely have been different had the company screen-printed<sup>206</sup> images of the sequin arrangement, the satin waistband, and the curve of the tulle onto a whole cloth fabric, then cut the fabric into the form of the dress design. Does this mean the three-dimensional aspect of the design, or the purpose behind the placement of each design component, precludes copyright protection only for clothing? This issue resembles the most recent garment conceptual separability case in the Sixth Circuit.

#### 4. Cheerleading Uniforms: *Varsity Brands v. Star Athletica*

The Sixth Circuit Court of Appeals recently addressed the conceptual separability of cheerleader uniform designs in *Varsity Brands v. Star Athletica, L.L.C.*<sup>207</sup> The plaintiff, Varsity Brands, registered copyrights for multiple graphic designs that adorn the cheerleading uniforms and warm ups they sold.<sup>208</sup> The company employed designers who sketched original designs that included varying arrangements of stripes, chevrons, and color blocking patterns.<sup>209</sup> In

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<sup>203</sup> *Id.*

<sup>204</sup> See *supra* notes 171–72.

<sup>205</sup> *Jovani Fashion, Ltd.*, 500 F. App'x at 45.

<sup>206</sup> Printing is a process by which an artist creates a design on fabric through various color application methods. FABRIC FOR FASHION, *supra* note 81, at 36–37.

<sup>207</sup> 799 F.3d 468 (6th Cir. 2015), *cert. granted*, 136 S. Ct. 1823 (2016).

<sup>208</sup> *Id.* at 471.

<sup>209</sup> *Id.* (“[D]esign concepts [include] ‘original combinations, positionings, and arrangements of elements which include V’s (chevrons), lines, curves, stripes, angles, diagonals, inverted V’s, coloring, and shapes . . . .’”). To see a photo of one of the Varsity Brands registered designs, see Figure 2; see also *Varsity Brands*, 799 F.3d at 471–74 (containing photos of all registered designs).

manufacturing the uniform from the sketched design, Varsity Brands's production crew used four methods of production: (1) cutting and sewing panels of fabric and braid<sup>210</sup> together; (2) sublimation;<sup>211</sup> (3) embroidery; and (4) screen-printing.<sup>212</sup>



FIGURE 2:  
Example of a Varsity Brands  
Cheerleader Uniform Design

After noticing that the defendant Star Athletica was marketing and selling similar cheerleading uniforms, Varsity Brands alleged infringement of five of its registered designs.<sup>213</sup> Star Athletica denied any liability, arguing the copyrights were invalid.<sup>214</sup> Star Athletica's assertions were twofold: (1) the designs were of useful articles and (2) the pictorial, graphic, and sculptural elements of the designs were not physically or conceptually separable from their utilitarian aspects, rendering the designs ineligible for copyright protection.<sup>215</sup> The district court agreed, holding that absent the designs, the cheerleading uniforms

<sup>210</sup> Braiding is a technique used to form a pattern where three or more panels of fabric are intertwined in a zigzag pattern. For a visual example of the way the uniform design utilizes fabric braiding in cheerleader uniform catalog intertwining striped panels, see *2016 Varsity Spirit Fashion*, VARSITY 75 (2016) [hereinafter 2016 VARSITY SPIRIT CATALOG], <http://www.varsity.com/publications/Varsity-Spirit-Fashion-2016.html#1/z> (“Opt for metallic fabric panels, braid, & lettering . . .”).

<sup>211</sup> Sublimation is when the design is printed directly onto the fabric; the ink is heated to a gaseous state and then infused into the fabric in the intended design. *Id.* at 471 n.1. The production team then cuts the fabric according to the design and then sews the pieces together. *Id.*

<sup>212</sup> See *supra* note 206.

<sup>213</sup> *Varsity Brands*, 799 F.3d at 475. Varsity Brands also contended Star Athletica violated Tennessee state laws against unfair competition, inducement of breach of contract, inducement of fiduciary duty, and civil conspiracy, *id.*, the discussion of which are beyond the scope of this Note.

<sup>214</sup> *Id.* at 471.

<sup>215</sup> *Id.* at 475.

lost their functional purpose of “cloth[ing] the body in a way that evokes the concept of cheerleading,”<sup>216</sup> concluding that the designs were not protected by copyright.

The Sixth Circuit disagreed, holding that the designs were more similar to fabric design than clothing design, and thus sufficiently separable from the utilitarian aspects of the uniform to warrant copyright protection.<sup>217</sup> In arriving at its conclusion, however, the court embarked on a detailed overview of the confusing state of this area of the law; specifically, with respect to the question of conceptual separability.<sup>218</sup> The court identified nine different approaches that have been used throughout the circuit courts to provide guidance, before forming its own hybrid test, which borrowed elements from the aforementioned tests.<sup>219</sup> According to the majority, the uniform’s primary utilitarian function was to provide the cheerleader with the ventilation and range of motion necessary to execute a rigorous cheerleading routine, thus the designs were purely aesthetic and irrelevant to that functional capability.<sup>220</sup> The interchangeability of the designs demonstrated their independence from the useful article’s function because the garment served the same purpose with the design as without it.<sup>221</sup>

In his dissent, Judge McKeague exhibited deeper dissatisfaction with the state of the law,<sup>222</sup> and disagreed with the majority’s portrayal of the cheerleader uniform’s primary function.<sup>223</sup> Rather, he argued, the uniform’s design was to identify the wearer as part of a team and the

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<sup>216</sup> *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, No. 10-2508, 2014 WL 819422, at \*8 (W.D. Tenn. Mar. 1, 2014).

<sup>217</sup> *Varsity Brands*, 799 F.3d at 493. See *supra* Section II.A for a discussion of fabric pattern design copyright protection.

<sup>218</sup> *Varsity Brands*, 799 F.3d at 484 (“Courts have struggled mightily to formulate a test to determine whether ‘the pictorial, graphic, or sculptural features’ incorporated into the design of a useful article ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article’ when those features cannot be removed physically from the useful article.” (alterations in original) (citation omitted)).

<sup>219</sup> *Id.* at 484–87.

<sup>220</sup> *Id.* at 491 (disagreeing with district court finding that a garment’s function was to identify the wearer as part of a team because “[a] plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip”).

<sup>221</sup> *Id.* at 491–92. Professor Patry believes the conceptual separability analysis was entirely unnecessary at the district court level because the court concluded the PGS works at issue were two-dimensional designs, which should never undergo a conceptual separability analysis. PATRY ON COPYRIGHT, *supra* note 59, § 3:151 (suggesting the *Varsity Brands* district court was misled by Professor Nimmer’s view that two-dimensional articles are only copyrightable if they withstand a conceptual separability analysis).

<sup>222</sup> *Varsity Brands*, 799 F.3d at 496–97 (McKeague, J., dissenting) (“It is apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design. The law in this area is a mess—and it has been for a long time.”).

<sup>223</sup> *Id.* at 495.

designs were integral to that function.<sup>224</sup> Without the stripes, zig-zags, and chevrons, Judge McKeague argued, the outfit ceased to be a uniform in that it didn't identify the wearer as part of a team.<sup>225</sup> In other words, the uniform's aesthetic design merged with its utilitarian "identifying" function, making the two conceptually inseparable, and thus copyright protection was inappropriate.<sup>226</sup>

The majority and dissent in *Varsity Brands* both offer strong analyses, but they obfuscate the fundamental issue of whether the aesthetic design is considered a two-dimensional or three-dimensional PGS work.<sup>227</sup> The classification of a PGS design element as two-dimensional or three-dimensional affects whether a court will choose to treat it as a fabric pattern and presume copyrightability,<sup>228</sup> or treat it as a garment design subject to a conceptual separability analysis.<sup>229</sup>

### C. *The Grey Area Between "Fabric Pattern Design" and "Garment Design"*

#### 1. When to Apply Conceptual Separability to Clothing Design

In determining the copyrightability of clothing, courts employ a classification dichotomy to identify if the clothing's design is a "fabric design" or a "dress design."<sup>230</sup> This distinction is usually informed by whether the artistic work at issue is a pattern-based design or a silhouette design. Many scholars and courts disagree over the distinction's importance to determining when the conceptual separability test should be applied at all.<sup>231</sup> Professor Patry believes the

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<sup>224</sup> *Id.* ("Clothing provides many functions, but a uniform at its core identifies its wearer as a member of a group. It follows that the stripes, braids, and chevrons on a cheerleading uniform are integral to its identifying function.").

<sup>225</sup> *Id.*

<sup>226</sup> *Id.* at 496. ("Varsity's designs enhance the garment's utility. The claimed artistic choices thus cannot be separated from that function.").

<sup>227</sup> This distinction is fundamental because it usually dictates whether the design is a fabric design, and likely copyrightable, or a garment design, and thus likely uncopyrightable. See *supra* notes 131–38 and accompanying text.

<sup>228</sup> See *Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484, 489 (S.D.N.Y. 1997) ("Because lace designs are a form of fabric designs, I find that plaintiffs' lace designs are copyrightable.").

<sup>229</sup> See *infra* note 231 and accompanying text.

<sup>230</sup> See *supra* Part II.

<sup>231</sup> Compare PATRY ON COPYRIGHT, *supra* note 59, § 3:150 (explaining that when a two dimensional PGS work is applied to a useful article, it does not function as the design of the useful article; rather, it is superficially applied to it, rendering the conceptual separability test inappropriate), with NIMMER ON COPYRIGHT *supra* note 8 § 2A.08[H][1]–[3] (concluding fabric designs are copyrightable because they are generally capable of independent existence, in contrast to a dress design, which is not).

conceptual separability analysis was unnecessary at the district court level in *Varsity Brands* because the court concluded the designs at issue were two-dimensional designs.<sup>232</sup> Professor Nimmer contends two-dimensional fabric patterns are conceptually separate from the fabric's function of clothing, and thus generally copyrightable.<sup>233</sup> Both scholars agree fabric designs should generally obtain copyright protection, but disagree as to whether copyrightability is assumed or earned through conceptual separability.<sup>234</sup>

## 2. The Stella McCartney "Octavia" Dress: Example of the Grey Area

Consider the Stella McCartney "Octavia" dress that Kate Winslet wore on the red carpet at the 2011 Venice Film Festival.<sup>235</sup> The dress features a colorblock<sup>236</sup> design that includes black panels that track a woman's bodily curves, drawing the viewer's attention to the navel and chest while detracting from the black side panels, in effect creating the illusion of a smaller waist.<sup>237</sup> The chest area of the design contains white fabric with rounded edges following the form of breasts, creating the illusion the wearer has an ample but perky bosom. The remaining panels—covering the stomach, thighs, back, and derriere—are beige. The dress was manufactured in various colors, but the side panels were almost always black.<sup>238</sup>

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<sup>232</sup> PATRY ON COPYRIGHT, *supra* note 59, § 3:150.

<sup>233</sup> NIMMER ON COPYRIGHT, *supra* note 8, § 2A.08[H][1]–[3].

<sup>234</sup> *See supra* note 231.

<sup>235</sup> To view a photo of the dress, see Figure 3; *see also* Kirsten Fleming, *The Miracle Dress*, N.Y. POST: FASHION (Sept. 28, 2011, 4:00 AM), <http://nypost.com/2011/09/28/the-miracle-dress>.

<sup>236</sup> *See supra* note 14.

<sup>237</sup> *See* Fleming, *supra* note 235 ("The figure-flattering number—one of the 'optical illusion' dresses from the designer's fall collection—focuses the eye with a contoured front panel while its black sides seem to disappear, creating a deceptively smaller waistline."); Kate Hogan, *Steal That Style: Get Your Own 'Miracle' Dress*, PEOPLE STYLE, <http://site.people.com/style/steal-that-style-get-your-own-miracle-dress> (last updated July 29, 2016, 1:19 PM) (quoting a celebrity stylist saying, "[i]t's like retouching your body with a frock" or wearing "a girdle" because it "gives you that svelte silhouette").

<sup>238</sup> *See* Kate Hogan, *Kate Winslet Really Loves Stella McCartney's 'Miracle' Dresses*, PEOPLE STYLE (Nov. 11, 2011, 5:00 PM), <http://stylenews.peoplestylewatch.com/2011/11/21/kate-winslet-really-loves-stella-mccartneys-miracle-dresses> ("The stretch cotton sheath is so nicknamed because its black side panels seriously flatter the figure.").





FIGURE 3:  
Stella McCartney Octavia Dress

The illusive effect portrays a smaller waist, and is somewhat akin to *trompe l'oeil*, an artistic technique that depicts three-dimensional objects on a two-dimensional surface.<sup>239</sup> A human form must be wearing the dress in order to achieve the intended effect; the dress would not create the illusion of an hourglass figure when displayed limply on a hanger.<sup>240</sup> This is because the illusionary effect relies heavily on the specific cut for which the fabric graphic design was intended;<sup>241</sup> it would not achieve the same objective if the design were applied to a pair of pants or painted onto a canvas. Because the dress is a useful article with PGS elements that heavily rely on the three-dimensional form of the dress, but theoretically could be conceptualized as separate from the dress as three distinct colored shapes that form a column, this dress resides squarely in the grey area between with the current dichotomous classification of clothing design.<sup>242</sup>

Hypothetically, if the Octavia dress design were the object of copyright litigation, a court would first determine whether it constituted a fabric or garment design.<sup>243</sup> Because the separately colored panels are cut into shapes that—when sewn together in one particular way—form

<sup>239</sup> *Trompe l'oeil* is a French phrase that means “trick of the eye” and is used to describe realistic two-dimensional imagery created to give the illusion that depicted objects or perspectives exist in three-dimensional form. MELANIE BOWLES & CERI ISAAC, *DIGITAL TEXTILE DESIGN* 17 (2d ed. 2012). Such styles incorporated into clothing have proliferated in recent years with the advent of digital textile design. *Id.* at 16–17.

<sup>240</sup> To view the Octavia dress in a similar condition, see Roseanne, *Real vs. Steal—Stella McCartney Octavia Tri-Tone Sheath Dress*, *INTHEIRCLOSET* (Apr. 6, 2015), <http://intheircloset.com/stella-mccartney-octavia-tri-tone-sheath-dress>.

<sup>241</sup> See Fleming, *supra* note 235.

<sup>242</sup> The dichotomous classification pertains to the two categories of “fabric designs” versus “garment designs.” See discussion *supra* Part II.

<sup>243</sup> See discussion *supra* Part II.

the silhouette creating the optical illusion, they may be considered components of garment design, as in *Jovani Fashion*.<sup>244</sup> Similar to the sequins and ruched satin waistband in that case, the panels are not marketable to consumers as standalone fabric cuts. They require the corresponding pieces and the human body to form an aesthetic PGS work; without each other, they are simply colored cloth. Thus, the *Jovani Fashion* court would likely not find the design copyrightable.

Alternatively, if the court in *Varsity Brands*<sup>245</sup> were to preside over the trial, the outcome may differ. The overall aesthetic design is two-dimensional, and thus the court could consider it a fabric design. As with the fabric panels that created the chevrons, zig-zags, and colorblocking<sup>246</sup> that comprised the cheerleading uniform design,<sup>247</sup> the colored panel arrangements on the Octavia dress are interchangeable, evidenced by the alternative colors in which the Octavia dress sold.<sup>248</sup> Thus, the court in *Varsity Brands* could find such a design copyrightable.

The conflicting outcomes in the above hypothetical exemplify the grey area between fabric design and garment design, underscoring the need for further clarification regarding the difference. When a dress features a two-dimensional design that can activate a third dimension when worn by a human body, the line between copyright and patent subtly blurs. The design becomes functional as it changes the perceived shape or appearance of the wearer's body, testing the boundaries of traditional fabric design protection.

### III. TRI-PARTITE CLASSIFICATION SCHEME FOR CLOTHING DESIGN

Courts should classify clothing design as falling into one of three categories: "fabric pattern design," "fabric graphic design," or "garment design." The term "fabric pattern design," which describes designs that feature repetitive and consistent patterns incorporated into fabric without consideration of the shape of the eventual garment design it will

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<sup>244</sup> See discussion *supra* Section II.B.3.

<sup>245</sup> See discussion *supra* Section II.B.4.

<sup>246</sup> See *supra* note 14.

<sup>247</sup> *Varsity Brands, Inc. v. Start Athletica, L.L.C.*, 799 F.3d 468, 470–71 (6th Cir. 2015), *cert. granted*, 136 S. Ct. 1823 (2016).

<sup>248</sup> See *supra* note 238 and accompanying text. Although the black side panels remained the same, the court in *Varsity Brands* did not specify whether the alternative designs available to Varsity Brands's customers involved completely new designs or different color options. The 2016 Varsity Brands catalog suggests the alternative design options for a particular copyrighted uniform design allowed the designer to choose the colorblocking color options. 2016 VARSITY SPIRIT CATALOG, *supra* note 210, at 62–63 ("How to Customize Your Own Varsity Shell").

form, carries a presumption of copyrightability.<sup>249</sup> For example, the designer Miu Miu featured prominent patterns in its 2015 Fall Collection, which introduced contemporary versions of traditional designs.<sup>250</sup> One blouse in particular featured a uniform pattern of simple robin-egg blue horizontal stripes, interspersed with thicker white strips of graphic floral designs.<sup>251</sup> This fabric pattern is presumably copyrightable because it does not depend on the structure of the garment to achieve a purpose beyond portraying the appearance of the design.

Adversely, garment design carries a presumption—albeit rebuttable<sup>252</sup>—of uncopyrightability.<sup>253</sup> Diane von Furstenberg became a household name in the 1974 when she debuted her famous wrap dress.<sup>254</sup> Yet the legendary<sup>255</sup> wrap dress design—jersey fabric with opposite panels connected to a sash that wraps around the body like a kimono<sup>256</sup>—remains uncopyrightable to this day.<sup>257</sup>

Between these two concepts resides “fabric graphic design,” where PGS designs comprise an aesthetic design applied to fabric that is not uniform or printed on whole cloth. These designs populate the grey area where fashion meets function. The nuances of design in this category exist on a spectrum spanning between fabric pattern design and garment design. Those designs closest to the presumed copyrightable side of the spectrum are graphic designs that portray a scene, or feature irregular but isolated images of expression that can exist anywhere on

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<sup>249</sup> Presuming copyrightability of fabric pattern designs does not affect the current jurisprudence in this area of the law, as most courts already view “fabric designs” with a similar presumption. See *supra* notes 139–64 and accompanying text. Furthermore, the presumption of copyrightability for fabric pattern designs will allow courts to focus more on issues of substantial similarity with fabric pattern designs. See Elman, *supra* note 19, at 701–04 (arguing that substantial similarity is unsuitable in the context of fashion design).

<sup>250</sup> Jo-Ann Furniss, *Fall 2015 Ready-to-Wear: Miu Miu*, slide 2 of 41, VOGUE (Mar. 11, 2015), <http://www.vogue.com/fashion-shows/fall-2015-ready-to-wear/miu-miu>.

<sup>251</sup> *Id.*

<sup>252</sup> See *supra* note 149 and accompanying text.

<sup>253</sup> See *supra* Section II.B.

<sup>254</sup> Contemporary fashion journalists regard the Diane von Furstenberg wrap dress as “the very symbol of women’s liberation and sexual freedom.” Alex Kuczynski, *Diane von Furstenberg*, W (Nov. 2012), <http://www.wmagazine.com/fashion/2012/11/diane-von-furstenberg-icon-1970s>.

<sup>255</sup> GIOIA DILIBERTO, DIANE VON FURSTENBERG: A LIFE UNWRAPPED 105–22 (2015) (“The wrap dress hit America like a tsunami in matte jersey. Thousands of women of all ages, sizes, occupations, and ethnicities bought the dress. You couldn’t enter a restaurant or walk down an avenue or go to a PTA meeting anywhere in America without seeing a flattering ‘Diane’ dress in bold, printed jersey.”).

<sup>256</sup> *Id.* at 107 (“It wrapped around the body like a kimono and molded to the individual woman’s shape. The movement of the print enhanced a woman’s curves.”).

<sup>257</sup> See Complaint, *Diane von Furstenberg Studio, L.P. v. Target Brands, Inc.*, 2008 WL 887353 (S.D.N.Y. 2008) (No. 1:08cv00866). This case was subsequently dismissed after the parties settled, but the lack of meritorious litigation denotes the weakness of the complaint’s arguments.

the garment without compromising the expression. On the opposite end of the spectrum, the graphic designs applied to the garment do not achieve their intended expression without the functional elements—or silhouette—of the clothing article. These designs are guided by the three-dimensional structure of the dress in order to modify the appearance about the wearer, such as the Octavia dress.

By redefining the categories of clothing design, this approach reduces the number of cases in which a court must necessarily conduct a conceptual separability analysis and promotes predictability of copyright protection. If courts were to use this Note's tri-partite classification scheme, the Second, Sixth, and Fifth Circuit jurisprudence would align.

#### A. *Application of the Tri-Partite Classification Scheme for Clothing Design*

To demonstrate the potential effect on the current state of conceptual separability of clothing design, the Note will apply the tri-partite classification scheme to the facts of select cases discussed above: *Galiano*,<sup>258</sup> *Jovani Fashion*,<sup>259</sup> and *Varsity Brands*.<sup>260</sup>

##### 1. Employee Uniforms: *Galiano v. Harrah's Operating Co.*

In *Galiano*, there were many PGS designs at issue, including vegetable shaped chef hats, colorblock<sup>261</sup> mandarin collars, uniform jackets with princess line seams, and jacquard fabric that concealed button or snap plackets.<sup>262</sup> Under the tri-partite classification scheme, the vegetable shaped hats and the uniform jacket princess lines would be garment designs. The hats could arguably be conceptually separate because they conjure an image of vegetables as separate from their function as hats, similar to the plush animal costume elements that could have portrayed animals in *Chosun*.<sup>263</sup> But the different shape of the exterior of a hat would likely be subject to the same constraint as various cuts of fabric; for example, the length and shape of a cape—even a very clever one—would probably not be subject to copyright. The function of the hat is to cover the hair of the chef to promote hygienic kitchen

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<sup>258</sup> See *supra* Section II.B.2.

<sup>259</sup> See *supra* Section II.B.3.

<sup>260</sup> See *supra* Section II.B.4.

<sup>261</sup> See *supra* note 14 and accompanying text.

<sup>262</sup> *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 413 n.3 (5th Cir. 2005).

<sup>263</sup> See *supra* Section II.B.1.

practices, which is apparent even when not worn.<sup>264</sup> Although the vegetable shape of the chef hat is clever, the proportions of the vegetable are determined by the shape of a human head, using the face of the wearer to complete the vegetable. The princess lines are classic garment design as they form the seam structure of the three-dimensional garment. They emphasize the form of the wearer's body, and perform the same structural design concepts as the Octavia dress, thus they should not be protected because they are dictated by three-dimensional elements of the garment. The jacquard fabric itself would be considered a fabric pattern design and would obtain copyright protection provided it was sufficiently original. However, the design of the fabric covering the snap plackets and buttons would fall under fabric graphic design. Because the placement and shapes are dictated by the utilitarian function of clasping the uniform, the design of the placement of these elements would not be conceptually separate and thus not copyrightable.

## 2. Prom Dresses: *Jovani Fashion, Ltd. v. Fiesta Fashions*

In *Jovani Fashion*,<sup>265</sup> the PGS design elements at issue were the sequin arrangement, the wire-edged tulle, and the ruched satin waistband.<sup>266</sup> The wire-edged tulle and the ruched satin waistband constitute garment designs and are not copyrightable because they are three-dimensional and do not denote an original PGS design beyond a bell skirt and gathered fabric, which are conventional clothing elements and thus not copyrightable. The sequin arrangement could theoretically be considered a fabric graphic design, and potentially conceptually separate because the sweetheart neckline boundary does not necessarily dictate the undeviating design. Because the consistent pattern of the sequin placement, and the design of the sequins as they are sewn to the bustier and displayed throughout, are elements not dictated by the neckline, they may be protectable. However, this design would run afoul of the originality requirement, as the arrangement appears unoriginal on the dress, and there are likely only so many ways to incorporate identical sequins across fabric.<sup>267</sup> Thus the tri-partite classification approach would not be inconsistent with the holding in *Jovani Fashions* as it would not render any of the elements copyrightable.

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<sup>264</sup> No pictures are readily discoverable of the designs at issue. But given the court's description, *see id.*, this seems likely.

<sup>265</sup> 500 F. App'x 42 (2d Cir. 2012).

<sup>266</sup> *Id.* at 45.

<sup>267</sup> This concept implicates the idea/expression dichotomy and would render the design non-copyrightable. *See discussion supra* note 126.

### 3. Cheerleading Uniforms: *Varsity Brands v. Star Athletica*

The court in *Varsity Brands*<sup>268</sup> failed to consider the placement of the chevrons, zig-zags, and colorblocking<sup>269</sup> design elements. Under this Note's approach, these design elements would constitute fabric graphic design because they were determined by the three dimensional structure of the garment. For example, the pleats of the skirt dictated the stripes of the seams, which were intended to emphasize the thigh of the wearer. A simple slit would have served the same purpose, or the skirt would have been designed without the striped border, but its placement drew attention to the thigh and, consequently, dictated the cut of the skirt. The same stripes adorning the crop top<sup>270</sup> serve the same structural function. The chevron graphics effectively drew attention to the chest and detracted attention from the side panels, creating the illusion of an hourglass figure, as was the case with the Octavia dress.<sup>271</sup> The same design or configuration of colors and panels would not have the same effect if applied to the skirt or a sleeve. Therefore, the overall design depends on placement and the structure of the garment. Thus, these basic shapes, colors, and seam covering concepts should not be eligible for copyright protection because their arrangement and placement on the body purposely emphasize particular areas of the body. This external effect of modifying one's appearance should be considered a function beyond portraying the appearance of the design. The graphics are inseparable from this function because they dictate the method by which the function operates. Thus the PGS elements of the cheerleading uniforms should not be copyrightable. To hold otherwise would run the risk of monopolizing chevron placement on cheerleader uniforms, which would run counter to Congressional intent.<sup>272</sup>

#### B. Support for the Tri-Partite Classification Scheme

Because the tri-partite classification scheme this Note proposes relies heavily on principles expounded by Professor Denicola in his

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<sup>268</sup> 799 F.3d 468 (6th Cir. 2015), *cert. granted*, 136 S. Ct. 1823 (2016).

<sup>269</sup> See *supra* note 14.

<sup>270</sup> The "crop top" part of the uniform design is called the "shell." See VARSITY SPIRIT CATALOG, *supra* note 210. This term references the short nature of the uniform top, akin to the fashionable "crop top" that reveals the wearer's midsection. See Sheila Marikar, *Defying Tradition, and Working Out, to Wear Bridal Crop Tops*, N.Y. TIMES (Aug. 27, 2015), <http://www.nytimes.com/2015/08/30/fashion/weddings/defying-tradition-and-working-out-to-wear-bridal-crop-tops.html>.

<sup>271</sup> See discussion *supra* Section II.C.2.

<sup>272</sup> See discussion *supra* Section I.A.

design-process approach to conceptual separability,<sup>273</sup> criticisms of his approach may apply to this clothing apparel specific approach. The design-process approach focuses on the process by which the author makes the work, concluding that any aspects of the expressive work dictated by the physical shape of the useful article to which it is applied are more properly protected under patent law rather than copyright law.<sup>274</sup> One skeptic of the design-process approach, Professor Patry, argues that the test obfuscates the purpose of the Act<sup>275</sup> and wrongfully denies copyright protection to aesthetic elements dictated by function.<sup>276</sup> Although Patry is correct that the Act does not protect concepts or design processes, it must be conceded that focusing on the author's decision to apply aesthetic elements to a functional article should be examined closely when conducting a separability analysis. The conceptual separability doctrine polices the boundary between copyright and patent protection to prevent works from unfairly obtaining a longer term of intellectual property protection. Thus does a dress design that is both aesthetically pleasing *and* visually slimming—but only when worn—constitute “industrial design” more so than “applied art”? If so, does that mean it should exclusively obtain protection under a patent rather than copyright? Permitting Stella McCartney to protect her Octavia dress design concept would unfairly monopolize all future dress designs that utilize colorblocking to slenderize the wearer's form in the same way, which would greatly affect competition within the clothing apparel market. While the Act does not explicitly consider competitive effects in its provision of copyright protection, it logically follows that aesthetically structural innovations and conceptual designs are what the useful article doctrine aims to regulate.

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<sup>273</sup> Denicola, *supra* note 8 at 709 (“A good portion of the difficulty arises from the tendency to focus exclusively on the *results* of the creative effort. This Article suggests that it is the *process* of creation that distinguishes industrial design from applied art and other forms of authorship traditionally recognized by copyright law.”); *see also* notes 136–48 and accompanying text.

<sup>274</sup> Denicola, *supra* note 8 at 743 (“A model emphasizing the influence of utilitarian factors frees the judicial analysis from its unfortunate fixation on appearance alone. If the ultimate aim is to distinguish applied art from industrial design, theories focusing only on appearances cannot achieve the desired end. It is the *process* more than the result that gives industrial design its distinctive character.”).

<sup>275</sup> PATRY ON COPYRIGHT, *supra* note 59, § 3:141 (“Congress’ purpose in the 1976 Act was to distinguish between ‘copyrightable works of applied art and uncopyrighted works of industrial design,’ yet Denicola recharacterizes this into a ‘distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear,’ again without the slightest support in the statute or its well-documented legislative history.” (citations omitted)).

<sup>276</sup> *Id.* (“It should go without saying that the statute does not require the protected design to be uninhibited by functional considerations, only that the pictorial, graphic, or sculptural elements be separable.”).

## CONCLUSION

The proliferation of so many approaches to conceptual separability has caused more problems than it has solved. While the recent *Varsity Brands* decision seemed to open a back door to copyrightability for PGS designs that straddle the boundary between two-dimensional and three-dimensional works, the tri-partite classification scheme assigns a boundary of copyrightability that follows existing jurisprudence within each circuit. Providing copyright protection to two-dimensional PGS design elements, the placement or arrangement of which is predetermined by the shape of the garment, would allow a retail manufacturer to furtively monopolize a generic design style.<sup>277</sup> Although many critics of the design process test contend that the approach undermines the objective of copyright law by focusing on the design process instead of the final expression of the design, the test actually furthers Congressional intent by preventing manufacturers from controlling the clothing design production process.<sup>278</sup>

Fashion design may be a verifiable art form;<sup>279</sup> but as with all other useful articles, the copyrightable elements must remain purely aesthetic in order to obtain copyright protection. The tri-partite classification scheme, by narrowing the forum for conceptual separability analysis of fabric graphic clothing designs and providing an explanation of when a design is “intrinsically utilitarian,”<sup>280</sup> helps achieve this objective.

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<sup>277</sup> See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 801 n.15 (D.C. Cir. 1978) (“If one manufacturer were given the copyright to the design of such an article, it could completely prevent others from producing the same article. . . . [T]here are only a limited amount of basic shapes, such as circles, squares, rectangles and ellipses. These shapes are obviously in the public domain and accordingly it would be unfair to grant a monopoly on the use of any particular such shape, no matter how aesthetically well it was integrated into a utilitarian article.”); discussion *supra* note 52.

<sup>278</sup> See *supra* note 52 and accompanying text.

<sup>279</sup> Susan Elizabeth Ryan, *What is Wearable Technology Art?*, 8 INTELLIGENT AGENT 4 (2008), [http://www.intelligentagent.com/archive/ia8\\_1\\_SocialFabrics\\_WearableTechnologyArt\\_Ryan.pdf](http://www.intelligentagent.com/archive/ia8_1_SocialFabrics_WearableTechnologyArt_Ryan.pdf) (noting that although fashion design has long been pervasive in the art world, it has long been misconstrued as separate and distinct because society is either guilty of “aesthetic sleepwalking,” or suffers from “collective amnesia”).

<sup>280</sup> 17 U.S.C. § 101 (2012) (defining 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”).