
Sixth Circuit Court of Appeals: Designs on Cheerleading Uniforms are Copyrightable Subject Matter

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Inc. v. Star Athletica, LLC, 799 F.3d 468 (6th Cir. 2015)

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The Court of Appeals for the Sixth Circuit recently addressed whether design patterns on cheerleading uniforms are copyrightable subject matter. The Sixth Circuit held that because the designs are separable from the cheerleading uniforms on which they appear, they are not “useful articles” and thus eligible for copyright protection.

Plaintiffs-Appellants Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashion & Supplies, Inc. (collectively, “Varsity”) design and manufacture cheerleading uniforms. See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 471 (6th Cir. 2015). Varsity’s designers create their designs without regard to the “functionality of the uniform or the ease of producing a full-sized uniform that looks like the sketch.” *Id.* Varsity owns several copyright registrations for the designs featured on its cheerleading uniforms, five of which were the subject of this litigation. *Id.* Defendant-Appellee Star Athletica, LLC (“Star”) markets and sells, among other things, cheerleading uniforms. *Id.* at 474. After noticing Star’s advertisements for cheerleading uniforms that looked similar to Varsity’s five

registered designs, Varsity brought this lawsuit for copyright infringement and various claims under Tennessee state law. *Id.* at 474-75.

At the close of discovery, both parties moved for summary judgment. Star argued that Varsity did not have a valid copyright in the five designs because the designs were for useful articles, and therefore not copyrightable. *Id.* at 475. Varsity, on the other hand, argued that its designs were protectable and that Star had infringed those designs. *Id.* The district court granted Star's motion for summary judgment, holding that Varsity's designs were not copyrightable subject matter because they were not separable from the utilitarian function of a cheerleading uniform. *Id.* That is, Varsity's designs, which consisted of colors, stripes, chevrons, and similar designs specifically associated with cheerleading, "[made] the garment recognizable as a cheerleading uniform," and therefore the aesthetic features of the "cheerleading uniform merge[d] with the functional purpose of the uniform." *Id.* (citation and internal quotation marks omitted).

Varsity appealed the district court's decision to the Sixth Circuit, who vacated the district court's decision and remanded for further proceedings.

Before turning to the parties' functionality arguments, the Sixth Circuit addressed Varsity's argument that the district court had not accorded appropriate deference to its copyright registrations. As the court noted, a certificate of registration "made before or within five years after the first publication of the work shall constitute prima facie evidence of the validity of the copyright." 17 U.S.C. § 410(c). Three of Varsity's five designs were registered within five years after first publication and thus were entitled to the statutory presumption of validity. *Varsity Brands*, 799 F.3d at 477. The question before the court, however, was how much deference to give the presumption of validity.

The Sixth Circuit distinguished between two types of deference that courts accord to agency decisions: Deference under *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984), and deference under *Skidmore v. Swift & Co.*, 323 U.S. 134 (1944). *Chevron* deference, the more deferential of the two, applies when Congress has expressly delegated to an agency "authority or responsibility to implement a particular provision or fill a particular gap," or when "the agency's generally conferred authority and other statutory circumstances [make apparent] that Congress would expect the agency to be able to speak with the force of law when it addresses ambiguity in the statute or fills a space in the enacted law." *Varsity Brands*, 799 F.3d at 477 (quoting *United States v. Mead Corp.*, 533

U.S. 218, 229 (2001)). In such circumstances, an agency’s regulation or interpretation is binding on courts unless it is “procedurally defective, arbitrary or capricious in substance, or manifestly contrary to the statute.” *Id.* at 478 (quoting *Mead*, 533 U.S. at 227). Conversely, when Congress has not expressly or impliedly delegated authority to an agency to promulgate rules with the power of law, *Skidmore* deference applies. *Id.* *Skidmore* deference recognizes that “agency interpretations of a statute deserve ‘respect proportional to [the interpretations’] power to persuade’ . . . when the agency has ‘specialized experience and broader investigations and information available’ than those available to the judiciary.” *Id.* (quoting *Mead*, 533 U.S. at 234-35). When applying *Skidmore* deference, factors to consider include “the thoroughness evident in the agency’s consideration, the validity of its reasoning, its consistency with earlier and later pronouncements, and all those factors which give it power to persuade.” *Id.* 480 (quoting *Mead*, 533 U.S. at 228).

The court concluded that certificates of copyright registration should be accorded *Skidmore* deference. *Id.* at 479. The court explained that the individual decisions concerning the copyrightability of works are not “rules carrying the force of law,” and thus did not deserve *Chevron* deference. *Id.* (quoting *Mead*, 533 U.S. at 226-27).

The court then turned to whether Star had overcome the presumption of validity afforded by Varsity’s copyright registrations. It explained that Section 102 of the Copyright Act protects “pictorial, graphic, and sculptural works.” 17 U.S.C. § 102. The definition of “pictorial, graphic, and sculptural works” in Section 101 of the Copyright Act provides that “the design of a useful article . . . 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.” 17 U.S.C. § 101. Section 101 also defines a “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” *Id.*

Taken together, these provisions require a two-part inquiry as to whether an article is protectable: First, whether the design for which copyright protection is sought is a “design of a useful article,” and if so, second, whether the design of the useful article is separable from its utilitarian aspects. *Varsity Brands*, 799 F.3d at 481. This appeal involved the second inquiry.

As this was a question of first impression before the Sixth Circuit, the court discussed its approach to determining whether the pictorial, graphic, or sculptural features of the design of a useful article are separable from the utilitarian aspects. The court began by noting that there are two different ways to determine separability — physical separability and conceptual separability. *Id.* at 481. The physical separability test, which asks whether the pictorial, graphic, or sculptural features can be physically separated from the article “by ordinary means while leaving the utilitarian aspects of the article completely intact,” has limitations, especially for two-dimensional objects. *Id.* at 482. Thus, the Sixth Circuit held, like other Circuits had before it, that designs are still protectable even if they are not physically separable from the useful article, as long as they are conceptually separable. *Id.* at 483.

The court observed that courts and scholars have struggled over the years to formulate a test for conceptual separability, with numerous approaches set forth by the Copyright Office, courts, and commentators. See *id.* at 484-85 (providing descriptions of nine tests for conceptual separability). After reviewing several cases from other Circuits, the Sixth Circuit adopted a hybrid of several tests that poses five questions: (1) Is the design a pictorial, graphic, or sculptural work? (2) If so, then is it a design of a useful article—“an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information?” 17 U.S.C. § 101. (3) What are the utilitarian aspects of the useful article? (4) Can the viewer of the design identify pictorial, graphic, or sculptural features separately from the utilitarian aspects of the useful article? (5) Can the pictorial, graphic, or sculptural features of the design of the useful article exist independently of the utilitarian aspects of the useful article? See *Varsity Brands*, 799 F.3d at 487-88.

Asking these questions in reference to Varsity’s uniform designs, the court held that Varsity’s designs are conceptually separable from the uniform:

- First, Varsity’s designs for which it owned copyright registrations are two-dimensional works of graphic art, and thus are “pictorial, graphic, or sculptural works.” *Id.* at 489.
- Second, Varsity’s designs are designs of useful articles because they are designs of cheerleading uniforms, which have “an intrinsic utilitarian function that is not merely to portray the appearance of [clothing] or to convey information.” *Id.* at 489-90 (quoting 17 U.S.C. § 101).
- Third, the utilitarian aspects of a cheerleading uniform are to “cover the body, wick away moisture, and withstand the rigors of athletic movements.” *Id.* at 490 (citation and internal quotation marks).

omitted). Star made two arguments on this point, both of which the court rejected. First, Star argued that the utilitarian aspects of a uniform are to identify the wearer as a cheerleader and as a member of a cheerleading team. *Id.* The court stated that this was an impermissible consideration under the Copyright Act's definition of "useful article." See 17 U.S.C. § 101 (providing that a "useful article" does not merely "convey information"). Second, Star argued that the design's decorative function is one of the utilitarian aspects of the uniform. *Varsity Brands*, 799 F.3d at 490. The court explained that to the extent Star was arguing that the uniform's decorative features were "inextricably intertwined with the utilitarian aspects of a cheerleading uniform because they serve a decorative function," it rejected that argument. *Id.* According to the court, taking this argument to its logical limit would mean that all artwork was unprotectable because it also has a decorative function, *i.e.*, decorating the room in which it hangs. *Id.* Thus, a work's "decorative function" could not render it uncopyrightable.

- Fourth, the graphic features of Varsity's design—the arrangement of stripes, chevrons, zigzags, and color-blocking—could be identified separately from the utilitarian aspects identified in the previous step. *Id.* at 491. The district court had held that these graphics could not be separately identified from the uniform because a uniform without these graphics would not be recognizable as a cheerleading uniform. *Id.* The Sixth Circuit, disagreed. To start, the designs did not enhance the utilitarian aspects of the uniform. *Id.* That is, a "plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip." *Id.* Moreover, the record showed that not all cheerleading uniforms must look the same to be cheerleading uniforms. *Id.*

- Fifth, the arrangement of stripes, chevrons, zigzags, and color-blocking could exist independently of the utilitarian aspects of the cheerleading uniform. *Id.* Indeed, they could be incorporated into other types of garments, or they could even be printed, framed, and hung on the wall as art. *Id.* at 491-92.

Because the designs could "be identified separately from, and [were] capable of existing independently of, the utilitarian aspects of [cheerleading uniforms]," the designs were copyrightable subject matter. *Id.* at 492 (quoting 17 U.S.C. § 101). The court concluded its opinion by stating that its holding was consistent with other decisions on the protectability of clothing; those decisions have allowed copyright protection for fabric designs but not dress designs, and here the designs at issue were more akin to fabric designs. *Id.* at 492-93.

The court thus entered summary judgment for Varsity on the issue of the protectability of its designs as pictorial, graphic, or sculptural works. *Id.* at 493. It remanded the case to the district court to address Star’s contention that the designs were ineligible for copyright protection because they lacked originality. *Id.*

The dissent generally agreed with the majority’s approach to conceptual separability, but would have defined the function of the uniforms—the third step in the majority’s five-step process—differently. *Id.* at 495. The majority had identified the function of the uniforms as covering the body, wicking away moisture, and withstanding the rigors of athletic movements, but the dissenting view was that this broad definition applied to all athletic gear. *Id.* Thus, it would instead define the utilitarian aspect of the uniform as identifying the wearer as a cheerleader. *Id.* Once the function was thus defined, it followed that the decorative elements were not separable from the function. *Id.*

The Sixth Circuit has granted Star’s motion to stay the court’s mandate so that Star can file a petition for writ of *certiorari* with the United States Supreme Court. It remains to be seen whether the Supreme Court will grant Star’s petition, but as the Sixth Circuit correctly observed, the lower courts have long struggled with the concept of separability, so the Supreme Court’s guidance in this area could be valuable.

—[EW](#)