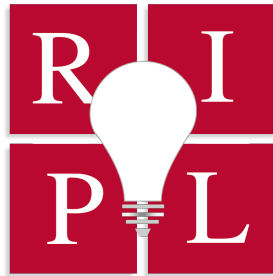


# UIC REVIEW OF INTELLECTUAL PROPERTY LAW



## THE YEEZY BOOST 350 COPYRIGHT REGISTRATIONS: DID KANYE WEST TURN JUSTICE BREYER'S FEAR INTO A REALITY?

DORIEN CLARK

### ABSTRACT

In the world of fashion, few have been able to gain copyright protection for their most ambitious and intricate designs. The useful article prohibition has long haunted designers and has left them with less desirable forms of protection, such as design patent or trade dress protections. Sympathetic to the artistic nature of many useful article designs, courts crafted varying standards to allow copyright protection for artistic aspects separable from the useful article. The Supreme Court articulated a new separability standard in *Star Athletica v. Varsity Brands*, which introduced a new chapter of copyright protection for useful articles. Although the standard sought to clarify the wide-spread disagreement over the separability doctrine, it has been shown to have low practical application. In 2018, Kanye West brought his notorious shoe, the Yeezy® Boost 350, to the Copyright Office to gain protection under *Star Athletica*. After a few attempts, he was able to convince the Copyright Office that his “2-D and sculptural claims” were copyrightable subject matter and not just an attempt to copyright a shoe. The registration of the two Yeezy® Boost 350 designs show the inherent inaptitude of *Star Athletica* and highlight the concerns professed by Justice Breyer.

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## THE YEEZY BOOST 350 COPYRIGHT REGISTRATIONS: DID KANYE WEST TURN JUSTICE BREYER'S FEAR INTO A REALITY?

DORIEN CLARK \*

### I. INTRODUCTION

"I'm the 2-Pac of fashion . . ."<sup>1</sup> To many, this quote by Kanye West is just another addition to the long list of outlandish statements made by the artist. Considering the likes of Christian Louboutin, Coco Chanel, and Miuccia Prada, it seems very unlikely that Kanye's impact on fashion has reached the same heights of 2-Pac's impact on hip-hop. However, putting any opinion of the star's controversial past aside, his fashion designs may have made a significant impact on the fashion and legal industry.

In 2018, the Yeezy<sup>®</sup> brand, a subset of Adidas, secured copyright protection for two of its popular shoes under the Supreme Court's new separability standard.<sup>2</sup> Kanye West and Yeezy<sup>®</sup>'s new president, Jon Wexler<sup>3</sup>, will be one of the first to see a substantial benefit from the new chapter of protecting useful article designs with copyright law. The new chapter began with *Star Athletica v. Varsity Brands*,<sup>4</sup> where the Supreme Court attempted to solve the puzzle surrounding the separability doctrine and copyrighting useful articles.<sup>5</sup> A notable opponent of the decision, Justice Breyer, cautioned that the new standard abandons many foundational principles.<sup>6</sup>

Because of the standard set in *Star Athletica*, Adidas successfully copyrighted elements of its Yeezy<sup>®</sup> Boost 350 "Turtle Dove"<sup>7</sup> and "V2 Beluga"<sup>8</sup> designs.<sup>9</sup> Nonetheless, fashion law enthusiasts should be hesitant about obtaining copyright protection under *Star Athletica* because even the Yeezy<sup>®</sup> Boost 350 registrations show

\* © 2020 Dorien Clark. Juris Doctorate Candidate, May 2021, at UIC John Marshall Law School, B.S. in Chemical Engineering, University of Cincinnati (2018).

<sup>1</sup> Interview by Big Boy with Kanye West, in Los Angeles, Cal. (Oct. 25, 2019), [https://www.youtube.com/watch?v=t568Nd7k\\_Yk](https://www.youtube.com/watch?v=t568Nd7k_Yk).

<sup>2</sup> See Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to Joseph Petersen, Counsel, Kilpatrick Townsend & Stockton, LLP (May 8, 2019) (on file with the United States Copyright Office) [hereinafter *Letter from Karyn A. Temple (May 8, 2019)*].

<sup>3</sup> See Riley Jones, *Adidas' Jon Wexler Is the New Head of Yeezy*, SOLE COLLECTOR (Dec. 11, 2019), <https://solecollector.com/news/2019/12/Adidas-jon-wexler-new-head-yeezy-brand>.

<sup>4</sup> 137 S. Ct. 1006 (2017).

<sup>5</sup> *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

<sup>6</sup> *Id.* at 1030-36 (Breyer, J., dissenting).

<sup>7</sup> Yeezy Boost 350 Version 1, Copyright Registration No. VA0002180485 (published Feb. 12, 2015) (granted May 02, 2017); see also *Letter from Karyn A. Temple, supra* note 2, at 4-6. The attached exhibits show the Yeezy Boost 350 V2 "Turtle Dove" sneaker from multiple angles and perspectives.

<sup>8</sup> Yeezy Boost 350 Version 2, Copyright Registration No. VA0002180486 (published Feb. 12, 2016) (granted May 2, 2017); see also *Letter from Karyn A. Temple, supra* note 2, at 7-9. The attached exhibits show the Yeezy Boost 350 V2 "Beluga" sneaker from multiple angles and perspectives.

<sup>9</sup> *Letter from Karyn A. Temple, supra* note 2, at 3.

the low applicability of the standard. The Yeezy® Boost 350 registrations reveal a new set of problems and highlight the fears professed by Justice Breyer.<sup>10</sup>

Part II of this Comment provides background on protecting useful articles with copyright law and the effects of *Star Athletica*. Part III will analyze the Yeezy® Boost 350 registrations under the new separability doctrine and the dissent from Justice Breyer. Part IV proposes a change to the *Star Athletica* standard, focusing on the designer's exact expression submitted to the Copyright Office. Part V of the comment will re-emphasize why this issue is more prevalent than ever and why there is a need for change.

## II. BACKGROUND

### A. Copyright Law & its Role in Fashion Designs

Copyright law protects “original works of authorship fixed in any tangible medium of expression.”<sup>11</sup> Copyright protection is desirable to many fashion designers because it provides for relatively quick<sup>12</sup> and cheap prosecution<sup>13</sup> while also being subject to enforcement by the International Trade Commission.<sup>14</sup> A Copyright also protects designs for the lifetime of the designer, plus seventy years.<sup>15</sup> Further, only an “overt act” indicating forfeiture of rights can eliminate the protection provided by copyright law.<sup>16</sup> The benefits may be ideal for designers and companies, such as those in fashion, who implement staggered marketing campaigns or are unsure about trends of certain products.<sup>17</sup> Another benefit of copyright protection for fashion designs is that

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<sup>10</sup> *Star Athletica*, 137 S. Ct. at 1036. (“I fear that, in looking past the three-dimensional design inherent in Varsity's claim . . . the majority has lost sight of its own important limiting principle. One may not ‘claim a copyright in a useful article merely by creating a replica of that article in some other medium,’ . . . [and] one cannot obtain a copyright that would give its holder ‘any rights in the useful article that inspired it.’”).

<sup>11</sup> 17 U.S.C. § 102 (2018); see also *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 157 (2010); *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 517 (7th Cir. 2009) (“The Copyright Act provides that ‘[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise wised communicated, either directly or with the aid of a machine or device.’”) (quoting 17 U.S.C. § 102(a)).

<sup>12</sup> See *Registration Processing Times*, U.S. COPY. OFF., <https://www.copyright.gov/registration/docs/processing-times-faqs.pdf> (last visited Oct. 6, 2019).

<sup>13</sup> See AM. INTELL. PROP. L. ASS'N, 2019 REPORT OF ECONOMIC SURVEY 44 (2019) [hereinafter AIPLA ECONOMIC REPORT].

<sup>14</sup> 19 U.S.C. § 1337(a)(1)(B) (2018); Steve Vondran, *ITC Section 337 Investigations and International Copyright Infringement Claims*, VONDRAN LEGAL (Mar. 17, 2016), <https://www.vondranlegal.com/itc-section-337-investigations-copyright-infringement-claims>.

<sup>15</sup> 17 U.S.C. § 302(a) (2018) (“Copyright in a work . . . endures for a term consisting of the life of the last surviving author and 70 years after the author's death.”).

<sup>16</sup> *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1019 (9th Cir. 1985).

<sup>17</sup> See Rachel Askinasi, *Photos Show the Rise and Fall of Nike's Iconic Air Jordan Sneakers – and How the Shoes are Making a Comeback 15 Years After Michael Jordan's Retirement*, BUSINESS INSIDER (Jul. 30, 2019, 8:26 AM), <https://www.businessinsider.com/nike-jordan-brand-rise-and-fall-history-2019-5> (“Nike also took action toward getting its original Michael Jordan-loving clientele back by reviving new versions of retros that resonated with them.”).

protection begins at the conception of the expression,<sup>18</sup> unlike other IP protections available.<sup>19</sup> Although copyright protection seems ideal, several doctrines have hindered its effective use in fashion.

### 1. *The Idea-Expression Dichotomy*

One major limitation of copyright protection is the idea-expression dichotomy.<sup>20</sup> A copyright only protects the expression of an idea, and never the idea itself.<sup>21</sup> Typically for designs, the expression is the exact arrangement or location of shapes, colors, lines or other features.<sup>22</sup> This dichotomy limits the ability to consider uncopyrightable elements when asserting rights against potential infringers.<sup>23</sup> Therefore, copyright registrations must properly define the scope of protection based on the submitted expression.<sup>24</sup> This doctrine, in combination with the useful article doctrine, has severely limited the copyrightability of complex designs, such as those found in fashion.<sup>25</sup>

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<sup>18</sup> *JCW Inves., Inc. v. Novelty, Inc.*, 482 F.3d 910, 914 (7th Cir. 2007).

<sup>19</sup> 35 U.S.C. § 173 (2018) (“Patents for designs shall be granted for the term of 15 years from the date of grant.”); *Gen. Healthcare Ltd. v. Qashat*, 364 F.3d 332, 335 (1st Cir. 2004) (holding that “[t]rademark rights may arise under either the Lanham Act or under common law, but in either circumstance, the right is conditioned upon use in commerce”).

<sup>20</sup> *See Mazer v. Stein*, 347 U.S. 201, 217 (1954) (“Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea-not the idea itself.”).

<sup>21</sup> 17 U.S.C. § 102(b); *see also Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 557 (1985) (“[N]o author may copyright facts or ideas. § 102. The copyright is limited to those aspects of the work . . . that display the stamp of the author’s originality.”).

<sup>22</sup> *See Intervest Constr., Inc. v. Canterbury Estate Homes, Inc.*, 554 F.3d 914, 919 (11th Cir. 2008) (“The work includes the overall form as well as the arrangement and combination of spaces and elements in the design.”); *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994) (“Thus, any claim of infringement that Apple may have against Microsoft must rest on the copyright of Apple’s *unique selection and arrangement* of all of these features.”) (emphasis added).

<sup>23</sup> *See Tanksley v. Daniels*, 902 F.3d 165, 173 (3d Cir. 2018) (recognizing that only the “protectable expression may be considered” when accessing misappropriation of a copyright work); *Sid & Marty Kroft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (recognizing that for copyright infringement, not only do the ideas need to be the same, but also “the expressions of those ideas as well”).

<sup>24</sup> *See PaySys Int’l, Inc. v. Atos Se, Worldline SA, Atos IT Services Ltd.*, 226 F. Supp. 3d 206, 216 (S.D.N.Y. 2016) (holding that the registration deposit and application seeks “to prevent confusion about which work the author is attempting to register”); *Data Gen. Corp. v. Grumman Sys. Support Corp.*, 36 F.3d 1147, 1162 (1st Cir. 1994) (abrogated on other grounds) (recognizing that appropriate specimen is needed so that the Copyright Office can assess the work and determine if it contains copyrightable subject matter).

<sup>25</sup> *See Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 913 (2d Cir. 1980) (“Just as copyright protection extends to expression but not ideas, copyright protection extends only to the artistic aspects, but not the mechanical or utilitarian features, of protected work.”); *Ultraflo Corp. v. Pelican Tank Parts, Inc.*, 845 F.3d 652, 657 (5th Cir. 2017) (“Congress’s exercise of its power under the Copyright Clause to not provide protection for the embodiment of ideas in useful article is entitled to preemptive force.”).

## 2. The Useful Article Doctrine

The Copyright Act provides a long list of acceptable mediums for the copyrightable subject matter, among which is not fashion.<sup>26</sup> Courts have noted copyright protection as ill-fitting for many fashion designs, mainly due to the useful article doctrine.<sup>27</sup> The doctrine states that copyright protection does not extend to “an object having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>28</sup> The doctrine was devised to prevent designs more suited for patent protection from receiving a more desirable copyright registration.<sup>29</sup> More specifically, the legislators of the Copyright Act wanted to limit the ability for designers to protect functional aspects of a design with a copyright when it should be protected with a design patent.<sup>30</sup> The cut dress or the shape of a shoe are common examples of fashion designs that are considered uncopyrightable elements.<sup>31</sup>

Inherently, many useful articles have both utilitarian and artistic features.<sup>32</sup> Courts have recognized that some designs, such as jewelry<sup>33</sup> or ballerina-shaped lamps<sup>34</sup>, have both utilitarian and artistic functions.<sup>35</sup> Courts have also recognized that those artistic aspects should not be divulged of copyright protection because they are

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<sup>26</sup> 17 U.S.C. § 102(a) (“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.”); *see also* Brian T. Yeh, *Copyright Protection for Fashion Designs: A Legal Analysis of Legislative Proposals in the 111<sup>th</sup> Congress*, Congressional Research Service Sept. 2010, at 9 (emphasizing that there are many “viewpoints on the need for and desirability of legislation granting copyright protection to fashion design”); *Copyright Law, THE FASHION LAW* (Oct. 7, 2016) <http://www.thefashionlaw.com/learn/copyright-law> (“Congress included an un-exhaustive list of eight works of authorship within the Copyright Act . . .”).

<sup>27</sup> *See, e.g., Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. App’x 42, 45 (2d Cir. 2012) (holding that certain features of a prom dress, namely the “arrangement of decorative sequins and crystals . . . satin ruching at the dress waist . . . and layers of tulle on the skirt,” were not subject to copyright protection).

<sup>28</sup> 17 U.S.C. § 101 (2018); *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414-15 (2d Cir. 1985).

<sup>29</sup> *See* 17 U.S.C. § 102(b); *Smith & Hawken, Ltd. v. Gardendance, Inc.*, No. C 04-1664 SBA, 2005 WL 1806369, at \*3 (N.D. Cal. 2005) (“The useful article doctrine serves the important policy of keeping patent and copyright separate by preventing parties from using copyright to obtain a ‘backdoor patent’ on a functional article that cannot be patented.”).

<sup>30</sup> *See* *Smith & Hawken*, 2005 WL 1806369, at \*3.

<sup>31</sup> *See, e.g., Jovani Fashion*, 500 Fed. App’x at 45 (ruching of prom dress not protectable under copyright law); *Olem Shoe Corp. v. Washington Shoe Co.*, No. 09-23494-CIV, 2011 WL 6202282, at \*14 (S.D. Fla. Dec. 1, 2011) (recognizing that “only non-copyrightable elements of Washington Shoe’s works” were involved in the infringement analysis, not the entire shoe itself).

<sup>32</sup> *See* *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at \*3 (W.D. Tenn. Mar. 1, 2014) (acknowledging that the “shape, style, cut, and dimensions” are purely functional qualities).

<sup>33</sup> *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109 (2d Cir. 2001).

<sup>34</sup> *See* *Mazer v. Stein*, 347 U.S. 201, 202 (1954) (“This case involves the validity of copyrights obtained by respondents for statuettes of male and female dancing figures made of semivitreous china.”).

<sup>35</sup> *See* *Varsity Brands*, 2014 WL 819422, at \*3 (“Clothing possesses both utilitarian and aesthetic value.”).

attached to a useful article.<sup>36</sup> Therefore, courts crafted the separability doctrine as a side-kick to the useful article doctrine, allowing for protection of some, but not all, aspects of the design.<sup>37</sup> The doctrine protects pictorial, graphical, or sculptural (“PGS”)<sup>38</sup> works that are attached to (or incorporated into) a useful article as long as the design is sufficiently separable from the article itself.<sup>39</sup>

Initially, the separability doctrine consisted of about nine different tests.<sup>40</sup> Courts, commentators, and scholars were divided on the appropriate standard to determine separability, but more-or-less fell into two major groups.<sup>41</sup> One group looked at physical separation and found copyrightable subject matter if the design could exist independently of the useful article.<sup>42</sup> The other group focused on the motivation of the designer and gave copyright protection when the aesthetic qualities outweighed the functional qualities.<sup>43</sup> Although the multitude of tests shared many similarities, the

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<sup>36</sup> See *Mazer*, 347 U.S. at 212-13 (recognizing that patent qualities of the ballerina-shaped lamp did not bar the artistic qualities from copyright protection).

<sup>37</sup> See Ian Clemens, *Useful Articles And Conceptual Separability Doctrine: Preserving The Free Flow of Ideas While Incentivizing Creative Endeavors*, WHARTON PUBLIC POLICY INITIATIVE (Nov. 13, 2018), <https://publicpolicy.wharton.upenn.edu/live/news/2688-useful-articles-and-conceptual-separability> (“[T]he definition of ‘useful articles’ and the related doctrine of conceptual separability are highly ambiguous, so a large and growing body of case law has sprung up to help . . .”).

<sup>38</sup> 17 U.S.C. § 101; see also *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 416 (5th Cir. 2005) (recognizing that the Copyright Act allows for copyright protection for a useful article to the extent that the design incorporates a PGS work).

<sup>39</sup> See John B. Fowles, *The Utility of a Bright-Line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in Leicester v. Warner Bros.*, 12 UCLA ENT. L. REV. 301, 309-10 (2005) (quoting 17 U.S.C. § 101).

<sup>40</sup> Lili Levi, *The New Separability*, 20 VAND. J. ENT. & TECH. L. 709, 712 (2018).

<sup>41</sup> Brief of Amicus Curiae New York Intellectual Property Law Association in Support of Neither Party at 17-18, *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866), 2016 WL 8118846, at \*13 (outlining the different approaches to the separability doctrine before the *Star Athletica* decision).

<sup>42</sup> See Compendium of U.S. Copyright of Office Practices § 924.2(b) (3d ed. 2014) (recognizing separability when “the artistic feature and the useful article could both exist side by side and perceived as fully realized, separate work”); *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting) (recognizing separability when an ordinary observer could imagine “two different concepts that are not inevitably entertained simultaneously”); *Pivot Point Int’s Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 934 (7th Cir. 2004) (Kanne, J., dissenting) (focusing on whether the article can be used for its purpose “once the copyrightable material is separated”); WILLIAM F. PATRY, 2 PATRY ON COPYRIGHT §§ 3-145-46 (2007) (focusing on whether the design is separable from the utilitarian features of the useful article); 1 PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW & PRACTICE § 2.5.3, at 2:67 (1989) (finding separability when the design “can stand alone as a work of art” and “the useful article in which it is embodied would be equally useful with [the design]”).

<sup>43</sup> See *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993-94 (2d Cir. 1980) (recognizing separability when “the primary ornamental aspect . . . is conceptually separable from their subsidiary utilitarian function”); *Carol Banhart*, 733 F.2d at 419 (recognizing separability when the ornamental aspects are not necessary to perform the utilitarian function”); *Pivot Point*, 372 F.3d at 931 (7th Cir. 2004) (“If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists.”); *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (finding separability when aesthetical qualities could be “marketable to some significant segment of the community”); Brief of Amicus Curiae Intellectual Property Law Association of Chicago in Support of Neither Party at 10, *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866), 2016 WL 4056090 (recognizing an academic approach identifying the objective and subjective aspects).



application of the tests caused sporadic and inconsistent results.<sup>44</sup> The Supreme Court took notice of the issue and attempted to create a new comprehensive standard for the separability of PGS works from its useful article.

### *B. Star Athletica & Its Aftermath*

In *Star Athletica v. Varsity Brands*,<sup>45</sup> the Supreme Court granted certiorari on a copyright infringement suit to clarify the appropriate standard for separability.<sup>46</sup> Varsity Brands, owner of “more than 200 copyright registrations for two-dimension designs appearing on the surface of their [cheerleading] uniforms and other garments,”<sup>47</sup> filed a complaint seeking to enforce its copyrights against Star Athletica’s allegedly infringing uniforms.<sup>48</sup>



*Image 1. Copyrighted and Accused Designs Discussed in Star Athletica*

The District Court ruled in favor of Star Athletica, holding that the designs were merely useful articles and not subject matter warranting copyright protection.<sup>49</sup> Oddly enough, the District Court reasoned that the designs were useful articles because they identified the uniforms as cheerleading uniforms not because it sought to protect the shape or cut of the uniform.<sup>50</sup> In any event, the Sixth Circuit disagreed with the rationale and found the designs copyrightable.<sup>51</sup>

<sup>44</sup> Brief of Amicus Curiae New York Intellectual Property Law Association in Support of Neither Party at 17-18, *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866), 2016 WL 8118846, at \* 13.

<sup>45</sup> *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1002-36 (2017).

<sup>46</sup> *Id.* at 1007 (“We granted certiorari to resolve widespread disagreement over the proper test for . . . independent-existence requirements.”).

<sup>47</sup> *Id.* at 1007, 1016-17.

<sup>48</sup> *Star Athletica*, 137 S. Ct. at 1007.

<sup>49</sup> *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at \*9 (W.D. Tenn. Mar. 1, 2014).

<sup>50</sup> *Id.* at \*8.

<sup>51</sup> *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 492 (6th Cir. 2015) (holding that the determination that the designs were copyrightable subject matter “is faithful to statutory text of the Copyright Act and consistent with other courts’ treatment of the protectability of clothing”).

### 1. *Majority Opinion & Concurrence*

The Supreme Court found that Varsity Brands' designs were separable and copyrightable.<sup>52</sup> The main takeaway from the case was the clarification regarding the separability doctrine.<sup>53</sup> First, the Court abandoned the idea of physical separability, holding that it is unnecessary given legislative intent.<sup>54</sup> Second, the court established a new two-prong test for separability, eliminating the previous Circuit splits.<sup>55</sup> The Court decided that a separable design:

(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.<sup>56</sup>

The Court further provided an example for future application of the standard: if a design can be imagined on a blank canvas or blank piece of an acceptable medium, it is sufficiently separable and subject to copyright protection.<sup>57</sup> In all, *Star Athletica* allows for copyright protection of any original and separable PGS work of art.<sup>58</sup>

Many judges, scholars, and commentators have noted that the new standard raises additional questions as to how this will be applied to more complex cases.<sup>59</sup> Justice Ginsburg concurred in the case, claiming that the cheerleading designs were an un-ideal vehicle to address the complex separability doctrine.<sup>60</sup> Ginsburg stressed that this case only involved designs replicated onto a useful article and therefore it was unnecessary to separate.<sup>61</sup>

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<sup>52</sup> *Star Athletica*, 137 S. Ct. at 1007.

<sup>53</sup> See George Thuronyi, *U.S. Supreme Court Clarifies Separability Analysis in its Ruling of Star Athletica, LLC v. Varsity Brands, Inc.*, LIBRARY OF CONGRESS (Apr. 6, 2017), <https://blogs.loc.gov/copyright/2017/04/u-s-supreme-court-clarifies-separability-analysis-in-its-ruling-on-star-athletica-llc-v-varsity-brands-inc/>

<sup>54</sup> *Star Athletica*, 137 S. Ct. at 1014 (“The statutory text indicates that separability is a conceptual undertaking. Because separability does not require the underlying useful article to remain, the physical-conceptual distinction is unnecessary.”).

<sup>55</sup> *Id.* at 1007.

<sup>56</sup> *Id.*

<sup>57</sup> *Id.* at 1012.

<sup>58</sup> *Star Athletica*, 137 S. Ct. at 1012 (defining separability standard); see 17 U.S.C. § 102.

<sup>59</sup> Lee Burgunder, *Does Star Athletica Raise More Questions Than it Answers?*, IP WATCHDOGS (Apr. 13, 2017), <https://www.ipwatchdog.com/2017/04/13/star-athletica-raise-questions-answers/id=81977/> (“I sympathize with the concurrence . . . who believed that this case, with its rather simple facts, was not the best vehicle to address the conceptual separability test.”).

<sup>60</sup> *Star Athletica*, 137 S. Ct. at 1018 (Ginsburg, J., concurring) (“I would not take up in this case the separability test appropriate under 17 U.S.C. § 101. Consideration of that test is unwarranted because the designs at issue are not designs of useful articles. Instead, the designs are themselves copyrightable pictorial or graphic works reproduced on useful articles.”);

<sup>61</sup> *Id.*

## 2. Justice Breyer's Dissenting Opinion

Justice Breyer took a very different approach to the case and held that the specimen submitted to the Copyright Office was not sufficient to warrant copyright protection.<sup>62</sup> Breyer emphasized that the designs could not be imagined as anything but a useful article and should have been denied protection.<sup>63</sup> Additionally, Breyer disagreed with the majority and believed that physical separability is a sufficient process to separate a copyrightable design from its useful article.<sup>64</sup> In all, Breyer's dissent proposes separability aligned with the majority but focuses on the specimen and exact expression submitted to the Copyright Office.<sup>65</sup>

### C. The Yeezy Boost 350 Registration

In 2018, Adidas began its quest for copyright protection and applied for the registration of its popular Yeezy® Boost 350 shoes.<sup>66</sup> Adidas specifically sought protection for two of its more popular Yeezy® Boost 350 colorways: the "Turtle Dove"<sup>67</sup> and the V2 "Beluga."<sup>68</sup> Although the Yeezy® brand features around twenty shoes<sup>69</sup> and an extensive set of colorways for each<sup>70</sup>, Adidas pursued protection only on these two designs under the veil of *Star Athletica*.

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<sup>62</sup> *Id.* at 1030 (Breyer, J., dissenting) ("But I do not agree that the designs that Varsity Brands, Inc., submitted to the Copyright Office are eligible for copyright protection.").

<sup>63</sup> *Id.* at 1033 (Breyer, J. dissenting) ("If the claimed feature could be extracted without replicating the useful article of which it is a part . . . then there is a separable design. But if extracting the claimed features would necessarily bring along the underlying useful article, the design is not separable from the useful article.").

<sup>64</sup> *Star Athletica*, 137 S. Ct. at 1031 (Breyer, J., dissenting).

<sup>65</sup> *Id.* at 1036 (Breyer, J., dissenting).

<sup>66</sup> *Letter from Karyn A. Temple, supra* note 2, at 1 (acknowledging Adidas's attempt "to register 2-D artwork and sculptural claims" of two of its sneakers).

<sup>67</sup> *See Letter from Karyn A. Temple, supra* note 2, at 4-6. The attached exhibits show the Yeezy Boost 350 "Turtle Dove" sneaker from multiple angles and perspectives.

<sup>68</sup> *See Letter from Karyn A. Temple, supra* note 2, at 7-9. The attached exhibits show the Yeezy Boost 350 V2 "Beluga" sneaker from multiple angles and perspectives.

<sup>69</sup> *See Ema, Ultimate Yeezy History Guide – Everything You Ever Wanted to Know*, AIO BOT (Sept. 5, 2017), <https://www.aiobot.com/yeezy/> (describing the extensive history of the Yeezy® brand and the different variations of the shoes).

<sup>70</sup> *See Ema, supra* note 69.

1. Yeezy® Boost Version 1 & Version 2



Image 2. Side View of Yeezy Boost 350 “Turtle Dove” Shoe

The Yeezy® Boost 350 “Turtle Dove” design has been a long staple of the Yeezy® Boost 350 line of shoes.<sup>71</sup> Adidas specifically noted in its application several distinct elements incorporated into the shoe that warrant copyright protection.<sup>72</sup> Adidas recognized that the shoe’s design “consisted of irregular black lines of various lengths and shapes on a gray fabric with a black semi-circle in the arch and an orange dotted stripe on an off-white heel loop.”<sup>73</sup> Among this description of the shoe, many of its two- and three-dimensional designs were taken together to form the copyrightable design incorporated into the shoe.<sup>74</sup>

The Yeezy® Boost 350 V2 “Beluga” is another popular colorway of the Yeezy’s second version of the shoe.<sup>75</sup> Adidas noted that the design “includes several grey lines in a wave pattern with a thick orange stripe on the outsole that fades toward the heel of the sneaker.”<sup>76</sup>



Image 3. Side View of Yeezy Boost 350 V2 “Beluga” Shoe

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<sup>71</sup> See Riley Jones, *These Yeezys Aren’t Restocking After All*, SOLE COLLECTOR (Aug. 16, 2018), <https://solecollector.com/news/2018/08/Adidas-yeezy-boost-350-turtle-dove-2018-restock> (claiming the Yeezy 350 “Turtle Dove” shoes to be “coveted”).

<sup>72</sup> *Letter from Karyn A. Temple, supra note 2*, at 1.

<sup>73</sup> *Letter from Karyn A. Temple, supra note 2*, at 1.

<sup>74</sup> *Letter from Karyn A. Temple, supra note 2*, at 2 (“[T]he Board’s decision relates only to the Works as a whole, and does not extend individually to any of the standard and common elements depicted in the Works such as lines, stripes, or swirl designs.”).

<sup>75</sup> *Here’s How Much Your Yeezys Are Worth*, COMPLEX (Apr. 27, 2018), <https://www.complex.com/sneakers/2018/04/heres-how-much-your-yeezys-are-worth/Adidas-yeezy-boost-350-v2-beluga> (recognizing that the Yeezy Boost 350 V2 ‘Beluga’ was the design that “extended the life of Kanye’s second Yeezy shoe”).

<sup>76</sup> *Letter from Karyn A. Temple, supra note 2*, at 1.

It also noted a second layer of fabric underneath the top layer that showcases “intermittent” orange spots throughout the top layer.<sup>77</sup> Under *Star Athletica*, Adidas petitioned that these elements are separable and represent “2-D and structural claims” that warrant copyright protection.<sup>78</sup> The Copyright Office did not discuss any other notable features of the shoe that appear in the copyright, such as the grooved rubber sole.<sup>79</sup>

## 2. Initial Reviews of Yeezy® Boost Designs

The initial application for the Yeezy® Boost 350 designs was rejected by the Copyright Office for several reasons.<sup>80</sup> After a few bites at the apple, Adidas was able to convince the Copyright Office that its shoes deserved protection.<sup>81</sup> Initially, the Copyright Office believed that Adidas’ application was an attempt to copyright a shoe.<sup>82</sup> The Copyright Office noted that the designs “were useful articles that did not contain any copyrightable authorship needed to sustain a claim to copyright.”<sup>83</sup> Many post-*Star Athletica* copyright registrations have consistently echoed this understanding and application of the *Star Athletica* standard.<sup>84</sup>

Upon reconsideration, the Copyright Office attacked the originality, not the separability of the designs.<sup>85</sup> The Copyright Office found that the arrangement of shapes in both designs were simple and unoriginal designs.<sup>86</sup> This basis of refusal has

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<sup>77</sup> Letter from Karyn A. Temple, *supra* note 2, at 1 (recognizing “an inner orange layer [of cloth] that add intermittent orange coloring” as an element of the design).

<sup>78</sup> Letter from Karyn A. Temple, *supra* note 2, at 1.

<sup>79</sup> Letter from Karyn A. Temple, *supra* note 2, at 1; Yeezy Boost 350 Version 1, Copyright Registration No. VA0002180485 (published Feb. 12, 2015) (granted May 2, 2017) (claims “bumps/waves on the side of the rubber sole”); Yeezy Boost 350 Version 2, Copyright Registration No. VA0002180486 (published Feb. 12, 2016) (granted May 5, 2015) (“The design also includes bumps/waves on the sides of the rubber sole.”).

<sup>80</sup> Letter from Karyn A. Temple, *supra* note 2, at 1 (acknowledging the past refusals based on the useful article doctrine and the originality doctrine).

<sup>81</sup> Letter from Karyn A. Temple, *supra* note 2, at 3 (“For the reasons stated herein, the Review Board of the United States Copyright Office reverses the refusal to register the copyright claim in the Works.”).

<sup>82</sup> Letter from Karyn A. Temple, *supra* note 2, at 1 (citing Letter from P. Gilasspie, Registration Specialist, to Joseph Petersen, Kilpatrick Townsend & Stockton LLP 1 (Feb. 14, 2018)).

<sup>83</sup> Letter from Karyn A. Temple, *supra* note 2, at 1.

<sup>84</sup> See, e.g., Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to Isabelle Jung, Counsel, CRGO Intellectual Property Law (Feb. 27, 2019) (applying *Star Athletica* to design of work gloves); Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to John Stringham, Counsel, Workman Nydegger (June 3, 2019) (applying *Star Athletica* to children’s clothing); Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to Jennifer Bailey, Counsel, Erise IP, P.A. (Jan. 22, 2019) (applying *Star Athletica* to watch wristband).

<sup>85</sup> Letter from Karyn A. Temple, *supra* note 2, at 1.

<sup>86</sup> Letter from Karyn A. Temple, *supra* note 2, at 1 (citing Letter from Stephanie Mason, Attorney-Advisor, to John Petersen, Kilpatrick Townsend & Stockton LLP 2-3 (Oct. 25, 2018)).

also been a common point of emphasis for the Copyright Office.<sup>87</sup> Adidas, however, argued that its arrangement was unique, creative and deserved protection.<sup>88</sup>

### 3. Approval of Yeezy® Boost Designs

The third review of the application was more favorable for Adidas; the Copyright Office agreed that both Yeezy® Boost 350 designs were copyrightable.<sup>89</sup> The Copyright Office applied *Star Athletica* and found the “2-D and structural claims” separable<sup>90</sup> and further found that the designs contained a “sufficient amount of original and creative two- and three-dimensional authorship”<sup>91</sup> under *Feist Publications v. Rural Telephone Service Co.*<sup>92</sup> However, the analysis provided by the Copyright Office did not shed much light on why they decided to grant copyright protection to the Yeezy® Boost 350 shoes.<sup>93</sup>

Unlike many other decisions implicating a separability analysis,<sup>94</sup> the Copyright Office gave a brief application of *Star Athletica* to these intricate designs.<sup>95</sup> Its two-sentence acknowledgment did not specify the elements that were separable as two-dimensional claims and those which were considered three-dimensional claims.<sup>96</sup> The detail deficient analysis has left open many questions concerning the protected elements of the sneaker and how *Star Athletica* guided the Copyright Office’s decision.<sup>97</sup>

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<sup>87</sup> See, e.g., Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to Edward E. Vassallo, Counsel, Venable LLP 3-6 (Mar. 15, 2019); Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to Anil George, NBA Properties 4-8 (May 30, 2019); Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to John Stringham, Workman Nydegger 3-6 (June. 3, 2019).

<sup>88</sup> Letter from Karyn A. Temple, *supra* note 2, at 1-2.

<sup>89</sup> Letter from Karyn A. Temple, *supra* note 2, at 1 (“After reviewing the application . . . along with the arguments in the second request for reconsideration, the Board finds that the Works exhibit copyrightable authorship and thus may be registered.”).

<sup>90</sup> Letter from Karyn A. Temple, *supra* note 2, at 2 (providing the new separability standard under *Star Athletica*).

<sup>91</sup> Letter from Karyn A. Temple, *supra* note 2, at 2 (providing details about originality set out in the Supreme Court’s *Feist Publications* decision).

<sup>92</sup> *Feist Publ’ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 351-55 (1991).

<sup>93</sup> Letter from Karyn A. Temple, *supra* note 2, at 2 (providing a one-sentence analysis of the separability issue and a three-sentence analysis of the originality issue).

<sup>94</sup> Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to Jacob Holt, Counsel, Dorsey & Whitney LLP 4-5 (Sept. 24, 2019) (one and a half page analysis of works); Letter from Chris Weston, U.S. Copyright Office Review Board, to Amy Brozenic, Counsel, Lathrop & Gage LLP 5-7 (Feb. 10, 2017) (two-page analysis of works).

<sup>95</sup> Letter from Karyn A. Temple, *supra* note 2, at 2 (giving little depth to the analysis and only stating that “[t]he Board agrees that the Works can be perceived as two- or three-dimensional works of art separate from the useful article, that is, the sneaker”).

<sup>96</sup> Letter from Karyn A. Temple, *supra* note 2, at 1.

<sup>97</sup> See Letter from Karyn A. Temple, *supra* note 2, at 1-9 (registering the copyright application but omitting key facts needed to more fully understand the application of *Star Athletica*); Bill Donahue, *Adidas Wins Copyright on Kanye’s Yeezy Sneakers*, LAW 360 (May 15, 2019, 2:48 PM), [https://www.law360.com/articles/1159977?utm\\_source=LexisNexis&utm\\_medium=LegalNewsRoom&utm\\_campaign=articles\\_search](https://www.law360.com/articles/1159977?utm_source=LexisNexis&utm_medium=LegalNewsRoom&utm_campaign=articles_search) (“The extent to which that new standard clarified the law, or whether it either extended or restricted protection for such useful objects, remains up for debate.”).

## III. ANALYSIS

In the realm of fashion, several registrations and cases have stretched the bounds of copyright law and tested the applicability of *Star Athletica* to fashion and other areas of design.<sup>98</sup> The recent registration of the Yeezy® Boost 350 shoe provides an illuminating example of why *Star Athletica* does not clean up the separability doctrine.

The registration raises many questions about the proper application of the *Star Athletica* standard, namely how it will apply to more complicated designs.<sup>99</sup> Specifically, whether two- and three-dimensional elements should be separated together or as distinct features, each of which needs to meet copyrightability burdens on their own. Although this seemed to be the concern of Justice Ginsburg and Justice Breyer, it has yet to be fully answered by copyright decisions or case law.<sup>100</sup> Second, the majority opinion of *Star Athletica* does not address how the specimen submitted to the Copyright Office will control the scope of protection for designs involving useful articles.<sup>101</sup>

It has become apparent that *Star Athletica* does not equip courts or the Copyright Office with the necessary tools to analyze more complex designs. Ultimately, the Yeezy® Boost 350 designs should have been denied copyright protection based on *Star Athletica*. The separability doctrine should be reconsidered under the context of an intricate design, like the Yeezy® Boost 350, to provide a more full-proof standard in line with the concerns expressed in Justice Breyer's Dissent.

A. *Star Athletica's* Applicability to Complex Designs

As expressed by Justice Ginsburg in her concurrence, the *Star Athletica* decision seemed to be a bit misplaced given the simple nature of the designs at hand.<sup>102</sup> Ginsburg noted that the designs were merely designs printed or "reproduced" on a useful article, not incorporated into it.<sup>103</sup> With this in mind, the copyright application of the Yeezy® Boost 350 design provides an illuminating example of the concern when *Star Athletica* is applied to more intricate designs.<sup>104</sup> Justice Ginsburg's concerns are highlighted by the registration of the Yeezy® Boost 350 shoes because Adidas does not

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<sup>98</sup> See, e.g., *Silvertop Assocs. Inc. v. Kangaroo Mfg. Inc.*, 931 F.3d 215, 222 (3d Cir. 2019) (banana costume); *Puma SE v. Forever 21, Inc.*, No. CV17-2523 PSG Ex, 2017 WL 4771004, at \*6-7 (C.D. Cal. June 29, 2017) (fur-covered sandal).

<sup>99</sup> See *Star Athletica*, 137 S. Ct. at 1033 (Breyer, J., dissenting) ("To ask this kind of simple question . . . will not provide an answer in every case, for there will be cases where it is difficult to say whether a picture of the design is, or is not, also a picture of the useful article.").

<sup>100</sup> *Id.* at 1018 (Ginsburg, J., concurring); *id.* at 1035 (Breyer, J., dissenting).

<sup>101</sup> *Id.* at 1013 (recognizing that the two-dimensional design is "*fixed* in the tangible medium" but failing to acknowledge the appropriate standard when a two-dimensional tangible medium is incorporated in a useful article).

<sup>102</sup> *Id.* at 1018 (Ginsburg, J., concurring) ("Consideration of [the separability test] is unwarranted because the designs at issue are not designs of useful articles [but]...copyrightable pictorial and graphic works reproduced on useful articles.").

<sup>103</sup> *Star Athletica*, 137 S. Ct. at 1018.

<sup>104</sup> See *id.* at 1036 (Breyer, J., dissenting)(J. Breyer noting his fear that "in looking past the three-dimensional design inherent in Varsity's claim by treating it as if it were no more than a design for a bolt of cloth, the majority [] lost sight of its own important limiting principle.").

attempt to copyright a design reproduced on a useful article, but rather seeks to protect the actual design of the shoe and several of its elements.<sup>105</sup>

Post-*Star Athletica* copyright decisions, both in the Copyright Office and district courts, have yet to shed light on the complex analysis of the separable elements in fashion designs.<sup>106</sup> *Star Athletica* provides a relatively strong standard to apply to designs that do not incorporate both two- and three-dimensional elements. Works with either two-dimensional or three-dimensional elements (but not both), are relatively easy to separate under the current standard.<sup>107</sup> Until now, many fundamental questions, such as whether the design should be separated as a whole, were easily answered because of the simple nature of the designs analyzed under *Star Athletica*.<sup>108</sup> However, the Yeezy® Boost 350 designs show how this separability analysis can become more complex, especially when multiple dimensions are involved.

Case law suggests that design elements incorporated into a useful article should be taken as a whole.<sup>109</sup> Therefore, one disadvantage to *Star Athletica* is the unknown treatment of complex designs that may incorporate two- and three-dimensional designs that must be taken as a whole under the current state of the law. The separation as a whole would create a paradox that either protect the useful article itself or leaves the design without known bounds or scope.

The Yeezy® Boost 350 registrations provide a perfect example of this conundrum. Allowing Adidas to protect the two- and three-dimensional designs as a whole under the new standard highlights the disadvantages. Adidas is limited to its expression of the design.<sup>110</sup> Therefore, the placement of two- and three-dimensional elements are considered a part of the copyright's scope.<sup>111</sup> Proper registration or enforcement of these designs would have to consider the placement of elements in the design when considering separability or risk overriding other principles of copyright law.<sup>112</sup> With this registration, the Copyright Office chose to overlook the expression submitted and

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<sup>105</sup> *Letter from Karyn A. Temple, supra* note 2, at 1-2.

<sup>106</sup> *See, e.g.,* Silvertop Assocs. Inc. v. Kangaroo Mfg. Inc., 931 F.3d 215, 221-22 (3d Cir. 2019) (determining copyrightability of claims for banana suit more tailored to originality); Puma SE v. Forever 21, Inc., No. CV17-2523 PSG Ex, 2017 WL 4771004, at \*6-7 (C.D. Cal. June 29, 2017) (recognizing copyright claim but not discussing copyrightability of the sandal in question).

<sup>107</sup> *See, e.g.,* Day to Day Imps., Inc. v. FH Grp. Int'l, Inc., No. 18-14105, 2019 WL 2754996, at \*5 (D.N.J. July 2, 2019) (two-dimensional design on car seat cover); Design Ideas, LTD. V. Meijer, Inc., No. 15-cv-03093, 2017 WL 2662473, at \*3 (C.D. Ill. Jun. 20, 2017) (three-dimensional bird design on clothespin).

<sup>108</sup> *Design Ideas*, 2017 WL 2662473, at \*3 (recognizing that the three-dimensional design was separable, conceptually and physically, from the clip without two-dimensional elements);

<sup>109</sup> *See* Chosum Int'l Inc. v. Chricha Creations, Ltd., 413 F.3d 324, 328 (2d Cir. 2005) (“[W]hile ‘useful articles’, taken as a whole, are not eligible for copyright protection, the individual design elements comprising these items may, viewed separately meet the Copyright Act’s requirements.”); Inhale, Inc. v. Starbuzz Tobacco, Inc., No. 2:11-cv-03939-ODW, 2017 WL 4163990, at \*3 (C.D. Cal. May 08, 2017) (recognizing that *Star Athletica* did not abandon the notion that individual design elements, not the useful article itself, are subject to copyright protection).

<sup>110</sup> *See* Mazer v. Stein, 347 U.S. 201, 217-18 (recognizing that a copyright only protects “the expression of the idea” and things that are copies of the protected subject matter).

<sup>111</sup> *See* Intervest Constr., Inc. v. Canterbury Estate Homes, Inc., 554 F.3d 914, 919 (11th Cir. 2008) (“The work includes the overall form as well as the arrangement and combination of spaces and elements in the design.”).

<sup>112</sup> *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994) (“Thus, any claim of infringement that Apple may have against Microsoft must rest on the copyright of Apple’s *unique selection and arrangement* of all of these features.”) (emphasis added).



the bounds of the design itself. Adidas's submitted its expression as the particular combination of elements (which form the design of a shoe), which would inherently take into account the contour, cut or shape of the shoe.<sup>113</sup>

It may not be clear at first, but *Star Athletica* seems to expand the scope of protection for certain designs.<sup>114</sup> Here, Adidas could have easily applied for copyright protection for fabric design and solved its problem with competitors or copycats.<sup>115</sup> However, under *Star Athletica*, Adidas was able to sweep in other elements of the design and protect otherwise unprotectable elements.<sup>116</sup> This side of *Star Athletica* combats the constitutional purpose of copyright laws: "to promote . . . the useful arts."<sup>117</sup>

### *B. Separability in line with Justice Breyer's dissent Provides a more Effective Standard*

A separability standard that takes into account the individual elements of the designs and the exact expression submitted to the Copyright Office aligns more soundly with foundational principles in copyright law.<sup>118</sup> This understanding of separability corresponds closely with Justice Breyer's dissent in *Star Athletica*.<sup>119</sup> Although the outcome of the case may have been correctly decided, Breyer recognized that the new standard may produce inappropriate outcomes when viewed in terms of a design incorporating both two-dimensional and three-dimensional aspects.<sup>120</sup>

More specifically, Breyer hinted that insight into the expression submitted to the Copyright Office should determine whether separability is achievable without overriding the idea/expression dichotomy.<sup>121</sup> The benefits of a standard centered around Justice Breyer's dissent lie with the compatibility of the two doctrines when more complex designs are at issue. The burden of proving copyrightable subject matter

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<sup>113</sup> See Anne Kearns, *Copyrights in the Fashion Business? It All Depends . . .*, MAKER'S ROW (Feb. 20, 2018), <https://makersrow.com/blog/2018/02/copyrights-in-the-fashion-business-it-all-depends/>.

<sup>114</sup> See *Star Athletica*, 137 S. Ct. at 1035-36 (Breyer, J., dissenting) (recognizing that the scope of the separability doctrine under the majority's opinion should be limited to conform which traditional notions of copyright law, relating specifically to the fashion industry).

<sup>115</sup> See Susan Neuberger Weller, *It's a Material IP World: Trademarks, Copyrights, Design Patents and Fabric Designs*, MINTZ (Nov. 5, 2014), <https://www.mintz.com/insights-center/viewpoints/2251/2014-11-its-material-ip-world-trademarks-copyrights-design-patents>.

<sup>116</sup> See *Feist Publ'n, Inc., Inc.*, 499 U.S. at 348 ("The mere fact that a work is copyrighted does not mean that every element of the work may be protected.")

<sup>117</sup> U.S. CONST. art. I, § 8, cl. 8; see also *Atari Games Corp. v. Nintendo of Am. Inc.*, 975 F.2d 832, 842 (Fed. Cir. 1992) ("The Constitution sets forth the purpose of copyright protection as the promotion of "the Progress of Science", not the rewarding of authors.")

<sup>118</sup> 17 U.S.C. § 102(b); see also *McCall v. Johnson Pub. Co.*, 680 F. Supp. 46, 47-48 (D.D.C. 1988) ("Because the scope of copyright protection extends no further than the form of an author's expression, the same idea may be expressed in innumerable ways without giving rise to a claim for infringement.")

<sup>119</sup> *Star Athletica*, 137 S. Ct. at 1030-36 (Breyer, J., dissenting).

<sup>120</sup> *Id.* at 1036 ("I fear that, in looking past the three-dimensional design inherent in Varsity's claim by treating . . . the majority has lost sight of its own important limiting principle . . . . That is to say, one cannot obtain a copyright that would give its holder "any rights in the useful article that inspired it.")

<sup>121</sup> *Id.* at 1030-31 (Breyer, J., dissenting) (recognizing that the specimen submitted to the Copyright Office were merely expressions of cheerleading uniforms and not a qualified PGS work).

should be on the applicant, including the burden of providing an appropriate specimen that can be imagined separately from the useful article.<sup>122</sup> Without this type of burden shift, the Copyright Office risks granting registrations without a defined scope. Although a downside to this type of standard would be increased pressure on applicants, it may be helpful to determine the exact expression and whether it is a qualified copyrightable work.

The designs here implicate that exact situation.<sup>123</sup> The Yeezy® Boost 350 designs are hard to imagine without imagining the shoe or focusing on the exhibits submitted to the Copyright Office, which depict a shoe.<sup>124</sup> The incorporation of two- and three-dimensional designs inherently will take into account the location of the elements and the shape of the shoe.<sup>125</sup> Therefore, without an accurate specimen of the designer's expression, the design is merely a useful article and should have been denied copyright protection.

Without a more defined approach, it is hard to imagine how separability can be properly applied under the current *Star Athletica* standard. Re-examining the Yeezy® Boost 350 designs under the dissenting opinion in *Star Athletica* will properly limit the scope of protection.<sup>126</sup> If Adidas is limited to only its expression that it submitted to the Copyright Office, it will receive proper protection under copyright law and will allow more creative designs to foster from it without risking liability.<sup>127</sup>

These complications in the current separability standard emphasize Justice Breyer's concerns with *Star Athletica*.<sup>128</sup> The new standard may need time to develop, but it is becoming clear that some copyright registrations, like the Yeezy® Boost 350 designs, prove that *Star Athletica* is not equipped to take on some areas of design, like fashion. Kanye has proved that the separability doctrine needs a new outlook.

#### IV. PROPOSAL

##### *A. The New Separability Standard is Ineffective*

The registration of the Yeezy® Boost 350 designs shows the inherent problems with *Star Athletica* and the new separability doctrine. Although the standard sought to clarify the copyrightability of useful articles,<sup>129</sup> it is ineffective for the complex

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<sup>122</sup> See, e.g., *CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc.*, 97 F.3d 1504, 1513 (1st Cir. 1996) (discussing the copyright holder's ultimate burden of proving copyrightability during infringement proceedings).

<sup>123</sup> See *Letter from Karyn A. Temple, supra* note 2, at 1 (considering "2-D artwork and sculpture claims in the works").

<sup>124</sup> See *Letter from Karyn A. Temple, supra* note 2, at 4-9.

<sup>125</sup> *Intervest Constr., Inc. v. Canterbury Estate Homes, Inc.*, 554 F.3d 914, 919 (11th Cir. 2008) ("The work includes the overall form as well as the arrangement and combination of spaces and elements in the design.").

<sup>126</sup> *Star Athletica*, 137 S. Ct. at 1035 (Breyer, J., dissenting).

<sup>127</sup> See *id.*

<sup>128</sup> *Id.* at 1036 (Breyer, J., dissenting) ("I fear that, in looking past the three-dimensional design inherent in Varsity's claim by treating it as if it were no more than a design for a bolt of cloth . . .").

<sup>129</sup> *Id.* at 1007 ("We granted certiorari to resolve the widespread disagreement over the proper test for implementing § 101's separate identification and independent-existence requirements.").

nature inherent in many designs.<sup>130</sup> The designs analyzed in *Star Athletica* were an inefficient vehicle to define separability<sup>131</sup> and created problems that will haunt many copyright practitioners.

The new standard fails to take into account many foundational principles of copyright law, such as the idea/expression dichotomy, and therefore must be reanalyzed. More specifically, *Star Athletica* does not sufficiently limit the separability process and is not flexible to the complex nature of many designs.<sup>132</sup> Without a proper limitation, the application of the standard will be overrun by erroneous registrations of useful articles.

### *B. A “Breyer’s Dissent” Focused Standard Would Provide Effective Application of the Separability Doctrine*

A full force departure from the standard set in *Star Athletica* may be necessary to effectively protect complex designs, such as in fashion, which benefit from separability the most.<sup>133</sup> The approach defined in *Star Athletica* is ill-fitting for many designs and seems to abandon foundational principles needed to properly protect the design.<sup>134</sup> Therefore, in reimagining the standard, the Supreme Court should highlight the argument made by Justice Breyer,<sup>135</sup> which considers the exact expression provided to the Copyright Office.<sup>136</sup>

Justice Breyer’s dissent idealizes a standard focused on the expression provided by the applicant.<sup>137</sup> Therefore, the first question to be asked should be whether the specimen provided to the Copyright Office is a useful article or the expression of a qualified PGS work that form parts of the useful article.<sup>138</sup> If the exact expression is unclear, the Copyright Office should ask whether the claims can be conceptually

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<sup>130</sup> See, e.g., *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. App’x 42, 45 (2d Cir. 2012) (discussing copyrightability of dress with several elements); *Puma SE v. Forever 21, Inc.*, No. CV17-2523 PSG Ex, 2017 WL 4771004, at \*6-7 (C.D. Cal. June 29, 2017) (fur-covered sandal).

<sup>131</sup> See *Star Athletica*, 137 S. Ct. at 1019 (Ginsburg, J., concurring) (“Consideration of that test is unwarranted because the designs at issue are designs of useful articles. Instead, the designs are themselves copyrightable pictorial or graphic works reproduced on useful articles.”).

<sup>132</sup> See *id.* at 1036 (Breyer, J., dissenting) (recognizing that the designs cannot be simply referred to as “a bolt of cloth” and have more elements).

<sup>133</sup> See Sharon K. Sandeen, *The Myth of Uniformity in IP Laws*, 24 J. INTELL. PROP. L. 277, 297 (2017) (recognizing that many IP laws are fact-dependent and require flexible standards and approaches).

<sup>134</sup> See *Star Athletica*, 137 S. Ct. at 1037 (Breyer, J., dissenting) (recognizing that the majority’s standard loses sight of limiting principles); *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954) (noting that the idea-expression dichotomy precludes individuals from copyrighting a useful article and limits it only to their expression).

<sup>135</sup> *Star Athletica*, 137 S. Ct. at 1030-36 (Breyer, J., dissenting) (arguing that the holding of *Star Athletica* was erroneous because the specimen submitted to the Copyright Office only pictured a cheerleading uniform which did not have a separable two-dimensional design).

<sup>136</sup> See *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991) (recognizing the fact “that only the expression of an idea and not the idea itself is protectable”).

<sup>137</sup> See *Star Athletica*, 137 S. Ct. at 1030-31 (Breyer, J., dissenting) (emphasizing that the exhibits submitted to the Copyright Office were “only pictures of cheerleader uniforms” and therefore were an uncopyrightable specimen under the useful article doctrine).

<sup>138</sup> See *id.* at 1018-19 (Ginsburg, J., concurring) (recognizing that mere reproductions of a PGS work on the useful article did not warrant a separability analysis).

pictured as a qualified PGS work without taking into account the useful article and without broadening the scope of the expression that the applicant created.<sup>139</sup>

If it is not possible to do either of those exercises, then it is merely an attempt to protect a useful article not subject to copyright protection.<sup>140</sup> Additionally, the physical separability of a qualified PGS work from the useful article should be sufficient to show qualified subject matter.<sup>141</sup> The new standard should allow for either conceptual or physical separation to determine the expression that the applicant seeks to protect.

This type of standard has the potential to be an effective solution but places a greater burden on the applicant. Every application under the proposed standard requires exhibits that accurately display what is sought to be protected. If the applicant wishes to show the useful article itself, it needs to also show that the claimed subject matter can be visualized or pictured on its own. Whole-sale isolation, color contrasting, or any other method capable of distinguishing the elements from the useful article would suffice as appropriate specimen.<sup>142</sup> Any application without proper exhibits should be denied with leave to amend. With an application for registration of a design incorporated on a useful article, the Copyright Office needs to emphasize that exhibits are representations of the expression sought to be protected, not the useful article itself.<sup>143</sup>

The Copyright Office also needs to require that the description of the design be fully detailed to give proper notice to future applicants or designers about the scope of the copyrighted work. This would involve a claim-by-claim description of the work, how it is classified, or how it is intended to protect. Any vague description that blurs the lines between claims should be outright rejected by the Copyright Office.

The Yeezy® Boost 350 registrations give a great example of how the new proposed standard could be applied. All of the exhibits provided to the Copyright Office only show the expression of a shoe.<sup>144</sup> Its elements are detailed but would be hard to imagine without picturing the shoe itself. When analyzed individually, some elements, such as the fabric, are separable and qualify as a PGS work.<sup>145</sup> However, Adidas applied for and received wholesale protection for its shoe.

This granted copyright protection over its expression of the shoe and any design featuring similar elements.<sup>146</sup> Under the proposed standard, the application would be

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<sup>139</sup> See *Star Athletica*, 137 S. Ct. at 1033 (Breyer, J., dissenting) (“If the claimed feature could be extracted without replicating the useful article of which it is a part, and the result would be a copyrightable artistic work standing alone, then there is a separable design.”).

<sup>140</sup> See *id.* (Breyer, J., dissenting) (recognizing that designs which “necessarily bring along the underlying utilitarian object” are not subject to copyright protection).

<sup>141</sup> See *id.* at 1031 (Breyer, J., dissenting) (“[The words of the Copyright Act of 1976] suggest two exercises, one physical, one mental.”).

<sup>142</sup> See *id.* at 1017 (showing colored version of the design that is not reproduced on the useful article).

<sup>143</sup> See *id.* at 1032-33 (Breyer, J. dissenting) (providing examples of designs that can and cannot be pictured without “necessarily bring[ing] along the underlying utilitarian object”).

<sup>144</sup> See *Letter from Karyn A. Temple, supra* note 2, at 4-9. The attached exhibits show the Yeezy Boost 350 “Turtle Dove” and Yeezy Boost 350 V2 “Beluga” sneakers from multiple angles and perspectives.

<sup>145</sup> See *Letter from Karyn A. Temple, supra* note 2, at 1 (recognizing the fabric pattern in both designs as an element of the claimed subject matter).

<sup>146</sup> See *Letter from Karyn A. Temple, supra* note 2, at 4-9. The attached exhibits do not show any other conceivable way that their claimed elements of the shoe can be pictured in any way but the shoe itself.

denied because Adidas's attempt to copyright several two- and three-dimensional elements as one takes into account the inherent shape of the shoe and other non-copyrightable features. Without a denial, copyright protection for Adidas's designs is beyond its expression.

## V. CONCLUSION

The prohibition of copyright protection for a useful article has been a hurdle that many designers, including those in fashion, have yet to conquer.<sup>147</sup> Very few had a proper grasp on the useful article and separability doctrines which led to quite different tests used throughout the country.<sup>148</sup> The Supreme Court attempted to clarify the separability standard in *Star Athletica*,<sup>149</sup> but created a defective standard. As expressed in Justice Ginsburg's concurrence<sup>150</sup> and Justice Breyer's dissent,<sup>151</sup> the majority relied on a far too simple case and created a standard that departs from fundamental notions of copyright law. The copyright registration of the Yeezy® Boost 350 designs shows why the standard does not work.

The Supreme Court should reconsider the ruling of *Star Athletica* and re-imagine the separability doctrine in line with Justice Breyer's dissent.<sup>152</sup> Given the complex nature of many fashion designs, the standard should focus on determining the exact expression that the applicant wishes to protect. If the expression cannot be

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<sup>147</sup> 17 U.S.C. § 102(a); *see, e.g.*, *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. App'x 42, 45 (2d Cir. 2012) (holding that certain features of a prom dress, namely the "arrangement of decorative sequins and crystals . . . satin ruching at the dress waist...and layers of tulle on the skirt," were not subject to copyright protection); Brian T. Yeh, *supra* note 26, at 9 (recognizing the lack of protection for fashion under the Copyright Act).

<sup>148</sup> *See* COMPENDIUM OF U.S. COPYRIGHT OFF. PRACTICES § 924.2(b) (3d ed. 2014) (recognizing separability when "the artistic feature and the useful article could both exist side by side and perceived as fully realized, separate work"); *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting) (recognizing separability when an ordinary observer could imagine "two different concepts that are not inevitably entertained simultaneously"); *Pivot Point Int's Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 934 (7th Cir. 2004) (Kanne, J., dissenting) (focusing on whether the article can be used for its purpose "once the copyrightable material is separated"); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993-94 (2d Cir. 1980) (recognizing separability when "the primary ornamental aspect . . . is conceptually separable from their subsidiary utilitarian function"); *Galliano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (finding separability when aesthetical qualities could be "marketable to some significant segment of the community").

<sup>149</sup> *Star Athletica*, 137 S. Ct. at 1007 (finding separability when the design "(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression . . .").

<sup>150</sup> *See id.* at 1018-20 (Ginsburg, J., concurring) (arguing that the case was not an ideal vehicle to address the separability doctrine because the submitted designs were merely reproductions on a useful article).

<sup>151</sup> *See id.* at 1030-36 (Breyer, J., dissenting) (arguing that the standard should emphasize whether the claimed design can be physically or conceptually pictured independently of the useful article).

<sup>152</sup> *See id.* at 1031 (Breyer, J. dissenting) (recognizing copyright protection for designs that could be physically separated or pictured separately of the useful article it is incorporated onto).

conceptually or physically pictured as anything but a useful article, the work should be denied copyright protection.

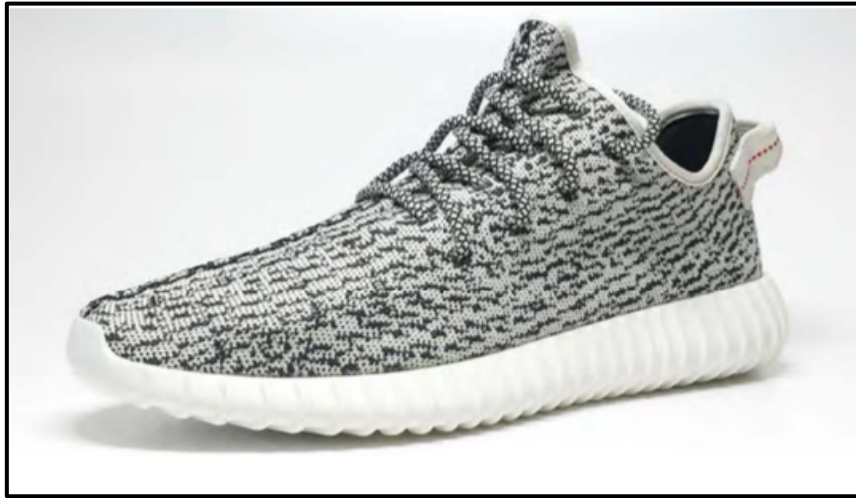
A standard focused on artistic expression will give designers and courts proper notice of the full scope of copyright protection and adhere to principles of copyright law. Under *Star Athletica*, Adidas was effectively able to gain protection for a shoe along with any work that could be imagined with similar artistic elements. Although Adidas provided descriptions of copyrightable elements, it was able to protect “2-D artwork and sculptural claims” together which encompasses more than its expression.<sup>153</sup> This erroneous registration provides an ideal vehicle for the Supreme Court to create an effective and useful separability doctrine.

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<sup>153</sup> See *Letter from Karyn A. Temple, supra* note 2, at 1 (identifying “2-D artwork and sculptural claims” that were present in the application).

VI. APPENDIX

YEEZY BOOST 350 VERSION 1<sup>154</sup>



*Image 4. Top View of Yeezy Boost 350 Version 1.*



*Image 5. Outside View of Yeezy Boost 350 Version 1.*

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<sup>154</sup> Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to Joseph Petersen, Counsel, Kilpatrick Townsend & Stockton, LLP, 4-6 (May 8, 2019) (on file with the United States Copyright Office).



*Image 6. Inside View of Yeezy Boost 350 Version 1.*



*Image 7. Back View of Yeezy Boost 350 Version 1.*



*Image 8. Front View of Yeezy Boost 350 Version 1.*



YEEZY BOOST 350 VERSION 2<sup>155</sup>



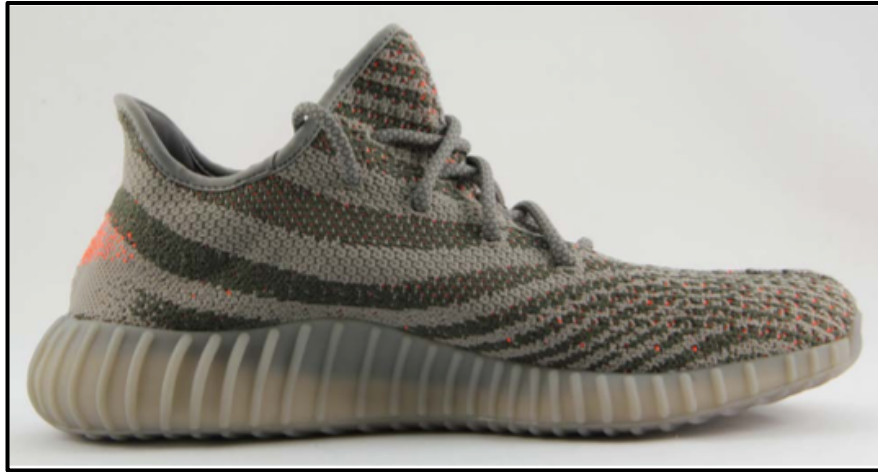
*Image 9. Top View of Yeezy Boost 350 Version 2.*



*Image 10. Outside View of Yeezy Boost 350 Version 2.*

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<sup>155</sup> Letter from Karyn A. Temple, Register of Copyrights, U.S. Copyright Office Review Board, to Joseph Petersen, Counsel, Kilpatrick Townsend & Stockton, LLP, 7-9 (May 8, 2019) (on file with the United States Copyright Office).



*Image 11. Outside View of Yeezy Boost 350 Version 1.*



*Image 12. Back View of Yeezy Boost 350 Version 2.*