

Trademark & Copyright Supreme Court Decisions (2016-2017 term)

- *Matal v. Tam* (the Slants)
- *Star Athletica, L. L. C. v. Varsity Brands, Inc.* (designs on cheerleader uniforms)

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Matal v. Tam - Trademark

Trademarks are indicators of source:



SOUTHWEST
AIRLINES



CHEERIOS



JUST DO IT





Matal v. Tam

THE SLANTS

- Lanham Act prevents registration of a mark that consists of immoral, deceptive, or scandalous matter; or matter which may **disparage** persons, institutions, beliefs...
- PTO refused to register because likely to disparage Asian people.



Goal to “reclaim” word and drain its denigrating force





Matal v. Tam

- Disparagement clause unconstitutional.
 - Offends bedrock 1st Amendment principle:
 - *“speech may not be banned on the ground that it expresses ideas that offend.”*





Matal v. Tam

- Disparagement clause = forbidden “viewpoint” discrimination.
 - TMs are private speech (not gov’t speech).
 - Gov’t speech allowed to favor certain viewpoints.
 - What’s disparaging/offensive depends on someone’s point of view.





Matal v. Tam

- Disparagement clause fails even relaxed scrutiny:
 - Restriction (1) must serve a substantial interest and (2) be narrowly drawn.
 - 4 say: disparagement clause not narrowly drawn.
 - “Happy-talk clause.”
 - 4 say: heightened scrutiny should always apply if there’s viewpoint discrimination.
 - By mandating positivity, the law might silence dissent.
 - Danger: gov’t removing ideas from broader debate.





Matal v. Tam

- Does *Tam* invalidate prohibition on “immoral” or “scandalous” marks? (ex. - FUCTION mark)

– Signs point to:

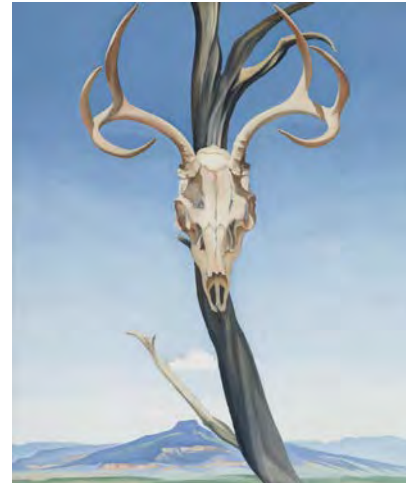


P.S. Washington Redskins marks now saved from cancellation.



Star Athletica - Copyright

Copyright protects literary and artistic works:

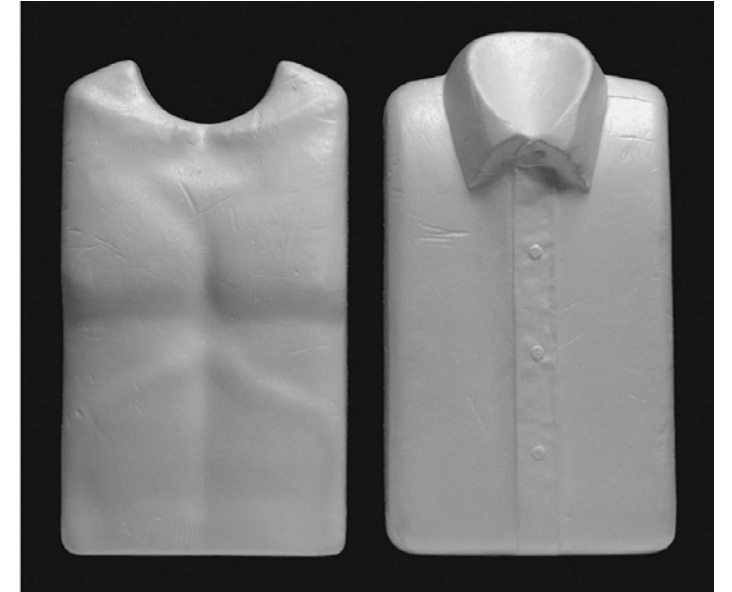
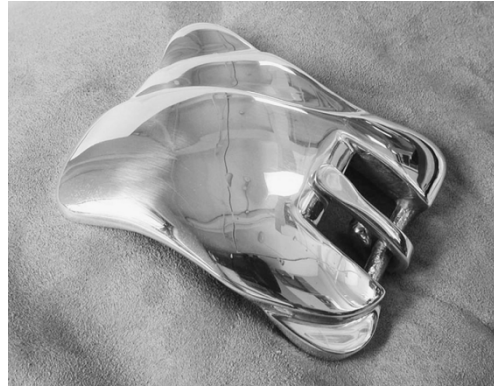


Copyright in “Useful Articles”?

- Useful articles are not eligible for copyright protection.
 - Ex. – utensils, cars, clothes, shoes, furniture
- BUT decorative aspects of useful articles are copyrightable:



Hard Cases Regarding Useful Articles



Mara



Liza





Star Athletica, L. L. C. v. Varsity Brands, Inc.

- Attempt to untangle area of law where courts have “twisted themselves into knots.”





Star Athletica, L. L. C. v. Varsity Brands, Inc.

- Copyright does not protect industrial design.
- HOWEVER pictorial, graphic, or sculptural features of a useful article are ©able if:
 - They can be identified **separately** from, and are capable of existing independently of, the **utilitarian** aspects. 17 U.S.C. § 101.
- How to apply this “separability” rule?
 - Past tests:
 - Feature is marketable?
 - Designer considered function?
 - Artistic features dominant?





Separability Test

- Held: Feature incorporated in useful article **©able** if:
 1. It's **artsy**:
 - It can be perceived as a 2-D or 3-D work of art separate from useful article.
 - AND
 2. Can **exist independently**:
 - It would qualify as a protectable work, either on its own or if fixed in another medium of expression, if imagined separately from the useful article.



Star Athletica, L. L. C. v. Varsity Brands, Inc.

This case:

1. Yes, you can identify the decorations as having pictorial, graphic, or sculptural qualities, and
2. Yes, if colors, shapes, stripes, chevrons applied in another medium (ex.-painter's canvas), they'd be 2-D art.

Yes & yes, so eligible for ©:





Further Explanation

- Irrelevant whether feature originally designed as freestanding art or designed to go on useful article.
- Even if useful article is less useful w/o design feature, feature can qualify for ©.
 - Focus on extracted features.
- Separability analysis is exclusively “conceptual.”
 - “Physical” separability is dead.





Star Athletica, L. L. C. v. Varsity Brands, Inc.

NOT DECIDED:

- That these designs are copyrighted.
 - Merely eligible – still need sufficient originality.
- That the uniforms are ©able.
 - Clothes still not ©able.

ALSO:

- If separable feature is itself a useful article, no ©.
- Can't use © in one medium to get © in useful article itself.
 - Cardboard model of a car ©able, but doesn't confer © in car itself.



Star Athletica Not Unanimous

- **Concurrence** – no separability test needed.
 - These designs just standard artistic works that are reproduced on useful articles.
- **Dissent** – doesn't object to test but says these designs can't be perceived separately from useful article.

