

Star Athletica Leaves Parties Weeping in Copyright Dispute over Tear Drop Design

September 7, 2017 – The TMCA

by J. Michael Keyes



In *Star Athletica v. Varsity Brands*, the U.S. Supreme Court clarified the proper test for determining when a useful article is subject to copyright protection. That new standard was recently brought to bear in *JetMax Limited v. Big Lots, Inc.*, a copyright dispute over a “tear drop” light design. Neither party is exactly cheering about the court’s decision. Read on if you would like further illumination.

JetMax manufactures strings of ornamental lights with covers shaped like tear drops. Each tear

drop has eight grooves, an iridescent color, and is surrounded by a wire frame. They aren’t exactly high art, but they were sufficiently original for the Copyright Office to grant a copyright registration to JetMax. Dark clouds formed for JetMax when Big Lots launched its own set of tear drop decorative lights that also contained grooves and a wire frame. (A side-by-side comparison of the parties’ lights can be seen [here](#).) JetMax sued for willful copyright infringement and both parties moved for summary judgment. Just in case the copyright light bulb has not turned on yet, the key issue at summary judgment was whether JetMax’s tear drop design was subject to copyright protection in light of the decision in *Star Athletica*.

The trial court noted that “pictorial, graphic, or sculptural features” of a useful article are subject to copyright protection only if those features “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” In assessing this issue in light of *Star Athletica*, the court noted that copyright protection

Related People

- J. Michael Keyes

Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

exists if: (1) the features can be perceived as two or three dimensional works of art separate from the useful article; and (2) the features would qualify as protectable works either on their own or fixed in some other medium if they were “imagined separately” from the useful article into which they are incorporated.

Applying this test, the trial court held the decorative tear drops have sculptural qualities that can be readily identified. And, these sculptural qualities of the tear drops can exist independently of the lights that they cover. Thus, plaintiff’s tear drops passed the *Star Athletica* test, which left defendant in a weepy state.

Then why, you ask, does the title to this post indicate that that *plaintiff* was also left distraught by the court’s decision? Because even though plaintiff zig-zagged past *Star Athletica*, that does not mean plaintiff’s utilitarian design is sufficiently original for purposes of copyright protection in the first instance (Justice Thomas told us as much in *Star Athletica*). On this issue, the trial court observed that although it appears plaintiff’s design is “likely original,” there are genuine disputes of material fact that need to be reserved for trial. The court did not explain what those disputes were, so we are all in the dark until the bright lights of the courtroom shine down on the parties at trial. May the best team win!