



COPYRIGHT ESSENTIALS

Wednesday, October 7, 2020
5:00PM - 6:30PM

Instructor: Laura Levin-Dando, Esq.
VLA Staff Attorney

Agenda:

- Introduction (5 minutes)**
- Copyright Basics (1 hour, 15 minutes)**
 - *What is Copyright?*
 - *Copyright Infringement*
 - *Issues in Copyright Ownership*
- Q&A (10 minutes)**

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Attorney Affirmation

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Copyright in Derivative Works and Compilations

A derivative work is a work based on or derived from one or more already existing works. Common derivative works include translations, musical arrangements, motion picture versions of literary material or plays, art reproductions, abridgments, and condensations of preexisting works. Another common type of derivative work is a “new edition” of a preexisting work in which the editorial revisions, annotations, elaborations, or other modifications represent, as a whole, an original work.

To be copyrightable, a derivative work must incorporate some or all of a preexisting “work” and add new original copyrightable authorship to that work. The derivative work right is often referred to as the adaptation right. The following are examples of the many different types of derivative works:

- A motion picture based on a play or novel
- A translation of a novel written in English into another language
- A revision of a previously published book
- A sculpture based on a drawing
- A drawing based on a photograph
- A lithograph based on a painting
- A drama about John Doe based on the letters and journal entries of John Doe
- A musical arrangement of a preexisting musical work
- A new version of an existing computer program
- An adaptation of a dramatic work
- A revision of a website

Compilations

Compilations of data or compilations of preexisting works (also known as “collective works”) may also be copyrightable if the materials are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes a new work. When the collecting of the preexisting material that makes up the compilation is a purely mechanical task with no element of original selection, coordination, or arrangement, such as a white-pages telephone directory, copyright protection for the compilation is not available. Some examples of compilations that may be copyrightable are:

- A directory of the best services in a geographic region
- A list of the best short stories of 2011
- A collection of sound recordings of the top hits of 2004
- A book of greatest news photos
- A website containing text, photos, and graphics

- An academic journal containing articles on a particular topic
- A newspaper comprised of articles by different journalists
- A catalog comprised of text and photographs

In the above examples, original authorship may be involved in deciding which were the best stories, the biggest hits, greatest photos, the appropriate article for the serial, and in what order to present the respective works within the compilation.

Copyright Protection in Derivative Works

The copyright in a derivative work covers only the additions, changes, or other new material appearing for the first time in the work. Protection does not extend to any preexisting material, that is, previously published or previously registered works or works in the public domain or owned by a third party.

As a result, it is not possible to extend the length of protection for a copyrighted work by creating a derivative work. A work that has fallen into the public domain, that is, a work that is no longer protected by copyright, is also an underlying “work” from which derivative authorship may be added, but the copyright in the derivative work will not extend to the public domain material, and the use of the public domain material in a derivative work will not prevent anyone else from using the same public domain work for another derivative work.

Copyright Protection in Compilations and Collective Works

The copyright in a compilation of data extends only to the selection, coordination or arrangement of the materials or data, but not to the data itself. In the case of a collective work containing “preexisting works” — works that were previously published, previously registered, or in the public domain — the registration will only extend to the selection, coordination or arrangement of those works, not to the preexisting works themselves. If the works included in a collective work were not preexisting — not previously published, registered, or in the public domain or owned by a third party — the registration may extend to those works in which the author of the collective work owns or has obtained all rights.

Right to Prepare Derivative Works

Only the owner of copyright in a work has the right to prepare, or to authorize someone else to create, an adaptation of that work. The owner of a copyright is generally the author or someone who has obtained the exclusive rights from the author. In any case where a copyrighted work is used without the permission of the copyright owner, copyright protection will not extend to any part of the work in which such material has been used unlawfully. The unauthorized adaptation of a work may constitute copyright infringement.

Notice of Copyright

Before March 1, 1989, the use of copyright notice was mandatory on all published works, and any work first published before that date should have carried a notice. For works published on or after March 1, 1989, use of copyright notice is optional.

Although not required by law, it is perfectly acceptable (and often helpful) for a work to contain a notice for the original material as well as for the new material. For example, if a previously registered book contains only a new introduction, the notice might be © 1941 John Doe; introduction © 2008 Mary Smith. For information about copyright notice, see Circular 3, *Copyright Notice*.

In addition, anyone interested in identifying a copyright owner of a preexisting work can search the online or physical records of the Copyright Office, or request the Office to conduct a search of its records for an hourly fee. For details, see Circular 22, *How to Investigate the Copyright Status of a Work*.

Copyright Registration of Derivative Works and Compilations

To register copyright claims in derivative works and compilations, information will be required regarding previous registrations of preexisting material, limitations of the claim, the material excluded, and a description of the new material added to the derivative work or compilation.

Unfortunately, registration is often delayed because of mistakes or omissions in completing copyright applications. The following points should be helpful for those registering derivative works. The categories specified appear on copyright applications.

Author · Name the author or authors of the copyrightable material being claimed. Ordinarily, the author is the person

who actually created the work. Where the work or any contribution to it is a work made for hire, the employer is considered the author. Do not name the author of previously published or registered work(s) or public-domain material incorporated into the derivative work unless that person is also the author of the new material. The application should name only the author(s) of the new material in which copyright is claimed.

Author Created · Specify what the author(s) created. Examples include “text,” “translation,” “music,” “lyrics,” “musical arrangement,” “photographs,” “artwork,” “compilation.”

Copyright claimant · The copyright claimant is either the author of the work or a person or organization who has obtained from the author all the rights the author initially owned. When the claimant named is not the author, a brief transfer statement is required to show how the claimant acquired the copyright. Examples are “by written agreement” and “by inheritance.” Do not send copies of documents of transfer with the application.

When the name of the claimant is not the name of the author, but the two names identify one person, the relationship between the names should be explained. Examples are “Doe Publishing Company, solely owned by John Doe” or “John Doe doing business as Doe Recording Company.”

Year of Completion · The year of completion is the year in which the completed new work—the particular version for which registration is sought—was fixed in a copy or phonorecord for the first time, even if other versions exist or if further changes or additions are planned. Do not confuse completion with publication.

Publication · Copyright law defines “publication” as “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.”

The following do not constitute publication: performing the work, preparing phonorecords, or sending the work to the Copyright Office.

The date of publication is the month, day, and year when the work for which registration is sought was first published. If the work has not been published, no date of publication should be given on the application.

Where someone, for example, an owner of an individual exclusive right or an agent of an author or owner, who is not a claimant (author or owner of all rights) is filing an application for a work that has never been registered, the applicant should list the author or owner of all rights as the claimant. The applicant can then explain their relationship to or interest in the copyright in the certification section of the application.

Previous registration · If no registration has been made for this version or an earlier version of this work, leave this portion of the application blank.

If a previous registration for this work or another version of it was completed and a certificate of registration was issued, give the requested information about the previous registration, if known.

Limitation of claim · Complete this portion of the application if the work being registered contains an *appreciable* amount of material that

- was previously published,
- was previously registered in the U.S. Copyright Office,
- is in the public domain, or
- is owned by a third party.

Material excluded · In this portion of the application, give a brief identification of any preexisting work or works that the work is based on or incorporates.

New material included · Briefly, in general terms, describe all new copyrightable authorship covered by the copyright claim for which registration is sought. See examples below. All elements of authorship described in “author created” should be accounted for in “new material included.”

If the claim is in the compilation only, state “compilation.” If the claim is in the compilation and new material, identify both, such as “compilation and forward” or “compilation of photographs, additional photography, and forward.”

Examples for “Material Excluded” and “New Material Included” entries for derivative works:

- Motion picture based on the novel *Little Women*
Material Excluded: Text
New Material Included: Entire motion picture
- New arrangement of preexisting music for piano
Material Excluded: Music
New Material Included: Musical arrangement

- Two-act play expanded to a three-act play
Material Excluded: Preexisting text
New Material Included: Text of third act
- Revision of a catalog that adds new text and photographs
Material Excluded: Text, photographs
New Material Included: Text, Photographs

For Further Information

By Internet

Circulars, announcements, regulations, application forms, and other related materials are available from the Copyright Office website at *www.copyright.gov*. To send an email communication, click on *Contact Us* at the bottom of the homepage.

By Telephone

For general information about copyright, call the Copyright Public Information Office at (202) 707-3000 or 1-877-476-0778 (toll free). Staff members are on duty from 8:30 AM to 5:00 PM, Monday through Friday, eastern time, except federal holidays. Recorded information is available 24 hours a day. To request paper application forms or circulars, call the Forms and Publications Hotline at (202) 707-9100 and leave a recorded message.

By Regular Mail

Write to:

*Library of Congress
Copyright Office—COPUBS
101 Independence Avenue SE
Washington, DC 20559*

The Office's policies and practices for the registration of derivative works and compilations have been superseded by the *Compendium of U.S. Copyright Office Practices (Third Edition)*. For more information, see <https://copyright.gov/comp3>.

Duration of Copyright

The provisions of copyright law dealing with duration are complex. Different standards apply depending on whether federal statutory copyright protection was secured before or on or after January 1, 1978, the date the current law—the Copyright Act of 1976—took effect. In addition, several amendments enacted since January 1, 1978, affect duration. This circular describes the changes to the law that affect duration and gives details about terms of protection for copyrights secured and renewed on certain dates.

Works First Securing Federal Statutory Protection on or after January 1, 1978

For works securing federal statutory protection for the first time on or after January 1, 1978, the Copyright Act of 1976, as amended in 1998, establishes a single copyright term and different methods for computing the duration of a copyright. Works of this kind fall into two categories.

Works Created on or after January 1, 1978

The law automatically protects a work that is created and fixed in a tangible medium of expression on or after January 1, 1978, from the moment of its creation and gives it a term lasting for the author's life plus an additional 70 years. For a "joint work prepared by two or more authors who did not work for hire," the term lasts for 70 years after the last surviving author's death. For works made for hire and anonymous and pseudonymous works, the duration of copyright is 95 years from first publication or 120 years from creation, whichever is shorter (unless the author's identity is later revealed in Copyright Office records, in which case the term becomes the author's life plus 70 years). For more information about works made for hire, see Circular 9, *Works Made for Hire under the 1976 Copyright Act*. For details about pseudonymous works, see FL 101, *Pseudonyms*.

Works in Existence but Not Published or Copyrighted on January 1, 1978

The law automatically gives federal copyright protection to works that were created but neither published nor registered before January 1, 1978. The duration of copyright in these works is generally computed the same way as for works created on or after January 1, 1978: life plus 70 years or 95 or 120 years, depending on the nature of authorship. However, all works in this category are guaranteed at least 25 years of statutory protection. The law specifies that in no case would copyright in a work in this category have expired before December 31, 2002. In addition, if a work in this category was published before that date, the term extends another 45 years, through the end of 2047.

Works Already Under Statutory Protection before 1978

For works that had already secured statutory copyright protection before January 1, 1978, the 1976 Copyright Act retains the system in the previous copyright law—the Copyright Act of 1909—for computing the duration of protection, but with some changes.

Duration under 1909 Act

Federal standards for copyright duration differ substantially under the 1909 act compared with the 1976 act because of the renewal term contained in the 1909 act. Under the 1909 act, federal copyright was secured on the date a work was published or, for unpublished works, on the date of registration. A copyright lasted for a first term of 28 years from the date it was secured. The copyright was eligible for renewal during the final, that is, 28th year, of the first term. If renewed, the copyright was extended for a second, or renewal, term of 28 years. If it was not renewed, the copyright expired at the end of the first 28-year term, and the work is no longer protected by copyright. The term of copyright for works published with a year date in the notice that is earlier than the actual date of publication is computed from the year date in the copyright notice.

Effect of 1976 Act on Length of Subsisting Copyrights

The 1976 Copyright Act carried over the system in the 1909 Copyright Act for computing copyright duration for works protected by federal statute before January 1, 1978, with one major change: the length of the renewal term was increased to 47 years. The 1998 Copyright Term Extension Act increased the renewal term another 20 years to 67 years. Thus the maximum total term of copyright protection for works already protected by January 1, 1978, has been increased from 56 years (a first term of 28 years plus a renewal term of 28 years) to 95 years (a first term of 28 years plus a renewal term of 67 years). Applying these standards, all works published in the United States before January 1, 1923, are in the public domain.

Automatic Extension for Works in Renewal Term

Works originally copyrighted after 1922 and renewed before 1978. These works were automatically given a longer copyright term. Copyrights that had already been renewed and were in their second term at any time between December 31, 1976, and December 31, 1977, inclusive, do not need to be renewed again. They have been automatically extended to last for a total term of 95 years (a first term of 28 years plus a renewal term of 67 years) from the end of the year in which

they were originally secured. For more information about renewal of copyright, see Circular 15, *Renewal of Copyright*.

Copyright Extensions before 1976 Act

Before passage of the 1976 Copyright Act, Congress enacted a series of nine acts that provided interim extensions for works whose copyright protection began between September 19, 1906, and December 31, 1918, if they were in their renewal terms. Without these interim extensions, copyrights commencing during that time would have expired after 56 years, at the end of their renewal terms, between September 19, 1962, and December 31, 1976.

Example: A work that first secured federal copyright protection on October 5, 1907, and was renewed in 1935, would have fallen into the public domain after October 5, 1963. The first act extended the copyright to December 31, 1965; the second act extended it to December 31, 1967; the third act extended it to December 31, 1968; the fourth act extended it to December 31, 1969; the fifth act extended it to December 31, 1970; the sixth act extended it to December 31, 1971; the seventh act extended it to December 31, 1972; the eighth act extended it to December 31, 1974; the ninth extended it to December 31, 1976; and the 1976 Copyright Act extended the copyright through the end of 1982 (75 years from the end of the year in which the copyright was originally secured).

Mandatory Renewal

Works originally copyrighted between January 1, 1950, and December 31, 1963. Copyrights in their first 28-year term on January 1, 1978, still had to be renewed to be protected for the second term. If a valid renewal registration was made at the proper time, the second term will last for 67 years. However, if renewal registration for these works was not made within the statutory time limits, a copyright originally secured between 1950 and 1963 expired on December 31 of its 28th year, and protection was lost permanently.

Automatic Renewal and Voluntary Registration

Works originally copyrighted between January 1, 1964, and December 31, 1977. Congress amended the copyright law on June 26, 1992, to automatically renew the copyright in these works and to make renewal registration for them optional. Their copyright term is still divided between a 28-year original term and a 67-year renewal term, but a renewal registration is not required to secure the renewal copyright. The renewal vests on behalf of the appropriate renewal claimant upon renewal registration or, if there is no renewal registration, on December 31 of the 28th year. For details about the benefits of making a renewal registration, see Circular 15, *Renewal of Copyright*.

Year-End Expiration of Copyright Terms

The 1976 Copyright Act provides that all terms of copyright will run through the end of the calendar year in which they expire. This provision affects the duration of all copyrights, including those in either their first or their second term on January 1, 1978. For works eligible for renewal, the renewal filing period begins on December 31 of the 27th year of the copyright term.

NOTE: Under the 1909 Copyright Act, terms of copyright and renewal filing periods corresponded with dates of publication or registration, not calendar years.

Restoration of Copyright in Certain Foreign Works

Under the provisions of the Uruguay Round Agreements Act (URAA), certain foreign works whose U.S. copyright protection had been lost because of noncompliance with formalities of U.S. law, were restored as of January 1, 1996. Among the informalities subject to restoration is failure to renew. Restoration occurs automatically, and the duration of the restored term is based on the term of protection the work would have had without the informality. For details, see Circular 38B, *Highlights of Copyright Amendments Contained in the URAA*.

For Further Information

By Internet

Circulars, announcements, regulations, all application forms, and other related materials are available from the Copyright Office website at www.copyright.gov.

By Telephone

For general information about copyright, call the Copyright Public Information Office at (202) 707-3000 or 1-877-476-0778 (toll free). Staff members are on duty from 8:30 AM to 5:00 PM, Monday through Friday, eastern time, except federal holidays. Recorded information is available 24 hours a day. To request paper application forms or circulars by postal mail, call (202) 707-9100 or 1-877-476-0778 and leave a recorded message.

By Regular Mail

Write to

*Library of Congress
Copyright Office-COPUBS
101 Independence Avenue SE
Washington, DC 20559-6304*

Works Not Protected by Copyright

To be copyrightable, a work must qualify as an original work of authorship under the copyright law. This circular highlights different types of works and subject matter that do not qualify for copyright protection.

It covers

- Ideas, methods, and systems
- Names, titles, and short phrases
- Typeface, fonts, and lettering
- Blank forms
- Familiar symbols and designs

To register a work with the U.S. Copyright Office, you must identify the copyrightable subject matter forming the basis of your claim. To be copyrightable, a work must qualify as an original work of authorship, meaning that it must have been created independently and contain a sufficient amount of creativity. Most works meet these conditions. Some works, however, contain elements that either lack the required creativity or are placed outside the bounds of copyright by the law. This circular highlights different types of noncopyrightable subject matter. For more information, see [chapter 300](#), section 313.3, of the *Compendium of U.S. Copyright Office Practices*.¹

Ideas, Methods, and Systems

Copyright law expressly excludes copyright protection for “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied.” The Office may, however, register a literary, graphic, or artistic description, explanation, or illustration of an idea, procedure, process, system, or method of operation, provided that the work contains a sufficient amount of original authorship. However, copyright protection will extend only to the original expression in that work and not to the underlying idea, methods, or systems described or explained.

Inventions

You can register a technical drawing or a written description of an invention when the drawing or description contains a sufficient amount of authorship. However, the registration extends only to the original expression contained in the drawing or description and does not apply to the underlying invention. Inventions meeting certain requirements may be patentable. For information about patent laws, visit the U.S. Patent and Trademark Office [website](#) or call 1-800-786-9199.

Example:

An author writes a book explaining a new system for food processing. The copyright in the book prevents others from copying or distributing the text and illustrations describing the author's system as expressed in the book, but it does not give the author the right to prevent others from employing the system or from using any procedures, processes, or methods described in the book.

Recipes

A recipe is a statement of the ingredients and procedure required for making a dish of food. A mere listing of ingredients or contents, or a simple set of directions, is uncopyrightable. As a result, the Office cannot register recipes consisting of a set of ingredients and a process for preparing a dish. In contrast, a recipe that creatively explains or depicts how or why to perform a particular activity may be copyrightable. A registration for a recipe may cover the written description or explanation of a process that appears in the work, as well as any photographs or illustrations that are owned by the applicant. However, the registration will not cover the list of ingredients that appear in each recipe, the underlying process for making the dish, or the resulting dish itself. The registration will also not cover the activities described in the work that are procedures, processes, or methods of operation, which are not subject to copyright protection.

Examples:

Jules Kinder submits an application to register a cookbook, *Pie in the Sky*. In the "Author Created" field of the application, Kinder asserts a claim in "text, photographs, and compilation of ingredients." Each recipe contains a list of ingredients, instructions for making a pie, and a photograph of the finished product. The claim in a "compilation of ingredients" will not be accepted because there is no copyrightable authorship in a mere listing of ingredients. Since this claim is not acceptable, the Office may communicate with Jules Kinder to limit the extent of the registration to the text and photographs only.

Paulina Neumann submits an application to register a recipe for caesar salad dressing. In the "Author Created" field, Neumann asserts a claim in "text." The work consists of a list of eleven ingredients with the following instructions: "(1) puree anchovies, garlic, Dijon, egg yolks; (2) drizzle oil in gradually to emulsify; (3) add lemon, parmesan cheese, salt, pepper, Worcestershire and tabasco sauce." The Office will refuse registration for this work, because the list of ingredients is uncopyrightable, and the instructional text contains an insufficient amount of creative authorship.

Names, Titles, Short Phrases

Words and short phrases, such as names, titles, and slogans, are uncopyrightable because they contain an insufficient amount of authorship. The Office will not register individual words or brief combinations of words, even if the word or short phrase is novel, distinctive, or lends itself to a play on words.

Examples of names, titles, or short phrases that do not contain a sufficient amount of creativity to support a claim in copyright include

- The name of an individual (including pseudonyms, pen names, or stage names)
- The title or subtitle of a work, such as a book, a song, or a pictorial, graphic, or sculptural work
- The name of a business or organization
- The name of a band or performing group
- The name of a product or service
- A domain name or URL
- The name of a character
- Catchwords or catchphrases
- Mottos, slogans, or other short expressions

Under certain circumstances, names, titles, or short phrases may be protectable under federal or state trademark laws. For information about trademark laws, visit the U.S. Patent and Trademark Office [website](#) or call 1-800-786-9199.

Typeface, Fonts, and Lettering

Copyright law does not protect typeface or mere variations of typographical ornamentation or lettering. A typeface is a set of letters, numbers, or other characters with repeating design elements that is intended to be used in composing text or other combinations of characters, including calligraphy. Generally, typeface, fonts, and lettering are building blocks of expression that are used to create works of authorship. The Office cannot register a claim to copyright in typeface or mere variations of typographic ornamentation or lettering, regardless of whether the typeface is commonly used or unique. There are some very limited cases where the Office may register some types of typeface, typefont, lettering, or calligraphy. For more information, see [chapter 900](#), section 906.4 of the *Compendium*. To register copyrightable content, you should describe the surface decoration or other ornamentation and should explain how it is separable from the typeface characters.

Layout and Design

As a general rule, the Office will not accept a claim to copyright in “format” or “layout.” The general layout or format of a book, page, book cover, slide presentation, web page, poster, or form is uncopyrightable because it is a template for expression. Copyright protection may be available for the selection, coordination, or arrangement of the specific content that is selected and arranged in a sufficiently creative manner. The claim, however, would be limited to the selection and arrangement of that specific content, not to the selection and arrangement of *any* content in that particular manner.

Blank Forms

Blank forms typically contain empty fields or lined spaces as well as words or short phrases that identify the content that should be recorded in each field or space. Blank forms that are designed for recording information and do not themselves convey information are uncopyrightable.

Similarly, the ideas or principles behind a blank form, the systems or methods implemented by a form, or the form’s functional layout are not protected by copyright. A blank form may incorporate

images or text that is sufficiently creative to be protected by copyright. For example, bank checks may be registered if they contain pictorial decoration that is sufficiently creative. Contracts, insurance policies, and other documents with “fill-in” spaces may also be registered if there is sufficient literary authorship that is not standard or functional. In all cases, the registration covers only the original textual or pictorial expression that the author contributed to the work, but does not cover the blank form or other uncopyrightable elements that the form may contain.

Examples of blank forms include

- Time cards
- Graph paper
- Account books
- Diaries
- Bank checks
- Scorecards
- Address books
- Report forms
- Order forms
- Date books and schedulers

Familiar Symbols and Designs

Familiar symbols and designs, or a simple combination of a few familiar symbols or designs, are uncopyrightable and cannot be registered with the Office. However, a work of authorship that incorporates one or more familiar symbols or designs into a larger design may be registered if the work as a whole contains a sufficient amount of creative expression.

Examples of familiar symbols and designs include but are not limited to

- Letters, punctuation, or symbols on a keyboard
- Abbreviations
- Musical notation
- Numbers and mathematical and currency symbols
- Arrows and other directional or navigational symbols
- Common symbols and shapes, such as a spade, club, heart, diamond, star, yin yang, or fleur de lys
- Common patterns, such as standard chevron, polka dot, checkerboard, or houndstooth
- Well-known and commonly used symbols that contain a minimal amount of expression or are in the public domain, such as the peace symbol, gender symbols, or simple emoticons
- Industry designs, such as the caduceus, barber pole, food labeling symbols, or hazard warning symbols
- Familiar religious symbols
- Common architecture moldings

Registration of Works with Copyrightable and Uncopyrightable Subject Matter

When completing an application for a work with a significant amount of uncopyrightable subject matter, you should focus your claim specifically on the copyrightable subject matter. When completing the “Author Created” field in the online application, use words identifying copyrightable subject matter such as “text,” “photograph,” or “drawing.” Avoid words referring to material that is not subject to copyright protection, such as “idea,” “device,” “process,” “format,” or “layout.” Also, avoid using vague language, such as “design” or “entire work.”

For more information on general registration procedures, see *Copyright Registration* (**Circular 2**).

NOTE

1. This circular is intended as an overview of works not protected by copyright. The authoritative source for U.S. copyright law is the Copyright Act, codified in Title 17 of the *United States Code*. Copyright Office regulations are codified in Title 37 of the *Code of Federal Regulations*. Copyright Office practices and procedures are summarized in the third edition of the *Compendium of U.S. Copyright Office Practices*, cited as the *Compendium*. The copyright law, regulations, and the *Compendium* are available on the Copyright Office website at www.copyright.gov.

For Further Information

By Internet

The copyright law, the *Compendium*, electronic registration, application forms, regulations, and related materials are available on the Copyright Office website at www.copyright.gov.

By Email

To send an email inquiry, click the *Contact Us* link on the Copyright Office website.

By Telephone

For general information, call the Copyright Public Information Office at (202) 707-3000 or 1-877-476-0778 (toll free). Staff members are on duty from 8:30 am to 5:00 pm, eastern time, Monday through Friday, except federal holidays. To request application forms or circulars by postal mail, call (202) 707-9100 or 1-877-476-0778 and leave a recorded message.

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Write to

Library of Congress
U.S. Copyright Office
Publications Section
101 Independence Avenue, SE #6304
Washington, DC 20559-6304



Syllabus

NOTE: Where it is feasible, a syllabus (headnote) will be released, as is being done in connection with this case, at the time the opinion is issued. The syllabus constitutes no part of the opinion of the Court but has been prepared by the Reporter of Decisions for the convenience of the reader. See *United States v. Detroit Timber & Lumber Co.*, 200 U. S. 321, 337.

SUPREME COURT OF THE UNITED STATES

Syllabus

FOURTH ESTATE PUBLIC BENEFIT CORP. v. WALL-STREET.COM, LLC, ET AL.**CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT**

No. 17–571. Argued January 8, 2019—Decided March 4, 2019

Petitioner Fourth Estate Public Benefit Corporation (Fourth Estate), a news organization, licensed works to respondent Wall-Street.com, LLC (Wall-Street), a news website. Fourth Estate sued Wall-Street and its owner for copyright infringement of news articles that Wall-Street failed to remove from its website after canceling the parties' license agreement. Fourth Estate had filed applications to register the articles with the Copyright Office, but the Register of Copyrights had not acted on those applications. Title 17 U. S. C. §411(a) states that “no civil action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.” The District Court dismissed the complaint, and the Eleventh Circuit affirmed, holding that “registration . . . has [not] been made” under §411(a) until the Copyright Office registers a copyright.

Held: Registration occurs, and a copyright claimant may commence an infringement suit, when the Copyright Office registers a copyright. Upon registration of the copyright, however, a copyright owner can recover for infringement that occurred both before and after registration. Pp. 3–12.

(a) Under the Copyright Act of 1976, as amended, a copyright author gains “exclusive rights” in her work immediately upon the work's creation. 17 U. S. C. §106. A copyright owner may institute a civil action for infringement of those exclusive rights, §501(b), but generally only after complying with §411(a)'s requirement that “registration . . . has been made.” Registration is thus akin to an administrative exhaustion requirement that the owner must satisfy before suing to enforce ownership rights. P. 3.

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(b) In limited circumstances, copyright owners may file an infringement suit before undertaking registration. For example, a copyright owner who is preparing to distribute a work of a type vulnerable to predistribution infringement—*e.g.*, a movie or musical composition—may apply to the Copyright Office for preregistration. §408(f)(2). A copyright owner may also sue for infringement of a live broadcast before “registration . . . has been made.” §411(c). Outside of statutory exceptions not applicable here, however, §411(a) bars a copyright owner from suing for infringement until “registration . . . has been made.” Fourth Estate advances the “application approach” to this provision, arguing that registration occurs when a copyright owner submits a proper application for registration. Wall-Street advocates the “registration approach,” urging that registration occurs only when the Copyright Office grants registration of a copyright. The registration approach reflects the only satisfactory reading of §411(a)’s text. Pp. 3–12.

(1) Read together, §411(a)’s first two sentences focus on action by the Copyright Office—namely, its registration or refusal to register a copyright claim. If application alone sufficed to “ma[ke]” registration, §411(a)’s second sentence—which permits a copyright claimant to file suit when the Register has refused her application—would be superfluous. Similarly, §411(a)’s third sentence—which allows the Register to “become a party to the action with respect to the issue of registrability of the copyright claim”—would be negated if an infringement suit could be filed and resolved before the Register acted on an application. The registration approach reading of §411(a) is supported by other provisions of the Copyright Act. In particular, §410 confirms that application is discrete from, and precedes, registration, while §408(f)’s preregistration option would have little utility if a completed application sufficed to make registration. Pp. 4–7.

(2) Fourth Estate primarily contends that the Copyright Act uses the phrases “make registration” and “registration has been made” to describe submissions by the copyright owner. Fourth Estate therefore insists that §411(a)’s requirement that “registration . . . has been made in accordance with this title” most likely refers to a copyright owner’s compliance with statutory requirements for registration applications. Fourth Estate points to other Copyright Act provisions that appear to use the phrase “make registration” or one of its variants to describe what a copyright claimant does. Fourth Estate acknowledges, however, that determining how the Copyright Act uses the word “registration” in a particular provision requires examining the “specific context” in which the term is used. The “specific context” of §411(a) permits only one sensible reading: The phrase “registration . . . has been made” refers to the Copyright Office’s act grant-

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ing registration, not to the copyright claimant's request for registration.

Fourth Estate's contrary reading stems in part from its misapprehension of the significance of certain 1976 revisions to the Copyright Act. But in enacting §411(a), Congress both reaffirmed the general rule that registration must precede an infringement suit and added an exception in that provision's second sentence to cover instances in which registration is refused. That exception would have no work to do if Congress intended the 1976 revisions to clarify that a copyright claimant may sue immediately upon applying for registration. Noteworthy, too, in years following the 1976 revisions, Congress resisted efforts to eliminate §411(a), which contains the registration requirement.

Fourth Estate also argues that, because "registration is not a condition of copyright protection," §408(a), §411(a) should not bar a copyright claimant from enforcing that protection in court once she has applied for registration. But the Copyright Act safeguards copyright owners by vesting them with exclusive rights upon creation of their works and prohibiting infringement from that point forward. To recover for such infringement, copyright owners must simply apply for registration and await the Register's decision. Further, Congress has authorized preregistration infringement suits with respect to works vulnerable to predistribution infringement, and Fourth Estate's fear that a copyright owner might lose the ability to enforce her rights entirely is overstated. True, registration processing times have increased from one to two weeks in 1956 to many months today. Delays, in large part, are the result of Copyright Office staffing and budgetary shortages that Congress can alleviate, but courts cannot cure. Unfortunate as the current administrative lag may be, that factor does not allow this Court to revise §411(a)'s congressionally composed text. Pp. 7–12.

856 F. 3d 1338, affirmed.

GINSBURG, J., delivered the opinion for a unanimous Court.

Cite as: 586 U. S. ____ (2019)

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Opinion of the Court

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SUPREME COURT OF THE UNITED STATES

No. 17–571

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER *v.* WALL-STREET.COM, LLC, ET AL.ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE ELEVENTH CIRCUIT

[March 4, 2019]

JUSTICE GINSBURG delivered the opinion of the Court.

Impelling prompt registration of copyright claims, 17 U. S. C. §411(a) states that “no civil action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.” The question this case presents: Has “registration . . . been made in accordance with [Title 17]” as soon as the claimant delivers the required application, copies of the work, and fee to the Copyright Office; or has “registration . . . been made” only after the Copyright Office reviews and registers the copyright? We hold, in accord with the United States Court of Appeals for the Eleventh Circuit, that registration occurs, and a copyright claimant may commence an infringement suit, when the Copyright Office registers a copyright. Upon registration of the copyright, however, a copyright owner can recover for infringement that occurred both before and after registration.

Petitioner Fourth Estate Public Benefit Corporation (Fourth Estate) is a news organization producing online journalism. Fourth Estate licensed journalism works to

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respondent Wall-Street.com, LLC (Wall-Street), a news website. The license agreement required Wall-Street to remove from its website all content produced by Fourth Estate before canceling the agreement. Wall-Street canceled, but continued to display articles produced by Fourth Estate. Fourth Estate sued Wall-Street and its owner, Jerrold Burden, for copyright infringement. The complaint alleged that Fourth Estate had filed “applications to register [the] articles [licensed to Wall-Street] with the Register of Copyrights.” App. to Pet. for Cert. 18a.¹ Because the Register had not yet acted on Fourth Estate’s applications,² the District Court, on Wall-Street and Burden’s motion, dismissed the complaint, and the Eleventh Circuit affirmed. 856 F. 3d 1338 (2017). Thereafter, the Register of Copyrights refused registration of the articles Wall-Street had allegedly infringed.³

We granted Fourth Estate’s petition for certiorari to resolve a division among U. S. Courts of Appeals on when registration occurs in accordance with §411(a). 585 U. S. ___ (2018). Compare, *e.g.*, 856 F. 3d, at 1341 (case below) (registration has been made under §411(a) when the Register of Copyrights registers a copyright), with, *e.g.*, *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F. 3d 612, 621 (CA9 2010) (registration has been made under §411(a) when the copyright claimant’s “complete application” for registration is received by the Copyright Office).

¹The Register of Copyrights is the “director of the Copyright Office of the Library of Congress” and is appointed by the Librarian of Congress. 17 U. S. C. §701(a). The Copyright Act delegates to the Register “[a]ll administrative functions and duties under [Title 17].” *Ibid.*

²Consideration of Fourth Estate’s filings was initially delayed because the check Fourth Estate sent in payment of the filing fee was rejected by Fourth Estate’s bank as uncollectible. App. to Brief for United States as *Amicus Curiae* 1a.

³The merits of the Copyright Office’s decision refusing registration are not at issue in this Court.

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I

Under the Copyright Act of 1976, as amended, copyright protection attaches to “original works of authorship”—prominent among them, literary, musical, and dramatic works—“fixed in any tangible medium of expression.” 17 U. S. C. §102(a). An author gains “exclusive rights” in her work immediately upon the work’s creation, including rights of reproduction, distribution, and display. See §106; *Eldred v. Ashcroft*, 537 U. S. 186, 195 (2003) (“[F]ederal copyright protection . . . run[s] from the work’s creation.”). The Copyright Act entitles a copyright owner to institute a civil action for infringement of those exclusive rights. §501(b).

Before pursuing an infringement claim in court, however, a copyright claimant generally must comply with §411(a)’s requirement that “registration of the copyright claim has been made.” §411(a). Therefore, although an owner’s rights exist apart from registration, see §408(a), registration is akin to an administrative exhaustion requirement that the owner must satisfy before suing to enforce ownership rights, see Tr. of Oral Arg. 35.

In limited circumstances, copyright owners may file an infringement suit before undertaking registration. If a copyright owner is preparing to distribute a work of a type vulnerable to predistribution infringement—notably, a movie or musical composition—the owner may apply for preregistration. §408(f)(2); 37 CFR §202.16(b)(1) (2018). The Copyright Office will “conduct a limited review” of the application and notify the claimant “[u]pon completion of the preregistration.” §202.16(c)(7), (c)(10). Once “preregistration . . . has been made,” the copyright claimant may institute a suit for infringement. 17 U. S. C. §411(a). Preregistration, however, serves only as “a preliminary step prior to a full registration.” Preregistration of Certain Unpublished Copyright Claims, 70 Fed. Reg. 42286 (2005). An infringement suit brought in reliance on pre-

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registration risks dismissal unless the copyright owner applies for registration promptly after the preregistered work’s publication or infringement. §408(f)(3)–(4). A copyright owner may also sue for infringement of a live broadcast before “registration . . . has been made,” but faces dismissal of her suit if she fails to “make registration for the work” within three months of its first transmission. §411(c). Even in these exceptional scenarios, then, the copyright owner must eventually pursue registration in order to maintain a suit for infringement.

II

All parties agree that, outside of statutory exceptions not applicable here, §411(a) bars a copyright owner from suing for infringement until “registration . . . has been made.” Fourth Estate and Wall-Street dispute, however, whether “registration . . . has been made” under §411(a) when a copyright owner submits the application, materials, and fee required for registration, or only when the Copyright Office grants registration. Fourth Estate advances the former view—the “application approach”—while Wall-Street urges the latter reading—the “registration approach.” The registration approach, we conclude, reflects the only satisfactory reading of §411(a)’s text. We therefore reject Fourth Estate’s application approach.

A

Under §411(a), “registration . . . has been made,” and a copyright owner may sue for infringement, when the Copyright Office registers a copyright.⁴ Section 411(a)’s

⁴Section 411(a) provides, in principal part: “[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringe-

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first sentence provides that no civil infringement action “shall be instituted until preregistration or registration of the copyright claim has been made.” The section’s next sentence sets out an exception to this rule: When the required “deposit, application, and fee . . . have been delivered to the Copyright Office in proper form and registration has been refused,” the claimant “[may] institute a civil action, if notice thereof . . . is served on the Register.” Read together, §411(a)’s opening sentences focus not on the claimant’s act of applying for registration, but on action by the Copyright Office—namely, its registration or refusal to register a copyright claim.

If application alone sufficed to “ma[ke]” registration, §411(a)’s second sentence—allowing suit upon refusal of registration—would be superfluous. What utility would that allowance have if a copyright claimant could sue for infringement immediately after applying for registration without awaiting the Register’s decision on her application? Proponents of the application approach urge that §411(a)’s second sentence serves merely to require a copyright claimant to serve “notice [of an infringement suit] . . . on the Register.” See Brief for Petitioner 29–32. This reading, however, requires the implausible assumption that Congress gave “registration” different meanings in consecutive, related sentences within a single statutory provision. In §411(a)’s first sentence, “registration” would mean the claimant’s act of filing an application, while in the section’s second sentence, “registration” would entail the Register’s review of an application. We resist this improbable construction. See, e.g., *Mid-Con Freight Systems, Inc. v. Michigan Pub. Serv. Comm’n*, 545 U. S. 440,

ment if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim”

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448 (2005) (declining to read “the same words” in consecutive sentences as “refer[ring] to something totally different”).

The third and final sentence of §411(a) further persuades us that the provision requires action by the Register before a copyright claimant may sue for infringement. The sentence allows the Register to “become a party to the action with respect to the issue of registrability of the copyright claim.” This allowance would be negated, and the court conducting an infringement suit would lack the benefit of the Register’s assessment, if an infringement suit could be filed and resolved before the Register acted on an application.

Other provisions of the Copyright Act support our reading of “registration,” as used in §411(a), to mean action by the Register. Section 410 states that, “after examination,” if the Register determines that “the material deposited constitutes copyrightable subject matter” and “other legal and formal requirements . . . [are] met, the Register shall register the claim and issue to the applicant a certificate of registration.” §410(a). But if the Register determines that the deposited material “does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration.” §410(b). Section 410 thus confirms that application is discrete from, and precedes, registration. Section 410(d), furthermore, provides that if the Copyright Office registers a claim, or if a court later determines that a refused claim was registrable, the “effective date of [the work’s] copyright registration is the day on which” the copyright owner made a proper submission to the Copyright Office. There would be no need thus to specify the “effective date of a copyright registration” if submission of the required materials qualified as “registration.”

Section 408(f)’s preregistration option, too, would have little utility if a completed application constituted regis-

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tration. Preregistration, as noted *supra*, at 3–4, allows the author of a work vulnerable to predistribution infringement to enforce her exclusive rights in court before obtaining registration or refusal thereof. A copyright owner who fears prepublication infringement would have no reason to apply for preregistration, however, if she could instead simply complete an application for registration and immediately commence an infringement suit. Cf. *TRW Inc. v. Andrews*, 534 U. S. 19, 29 (2001) (rejecting an interpretation that “would in practical effect render [a provision] superfluous in all but the most unusual circumstances”).

B

Challenging the Eleventh Circuit’s judgment, Fourth Estate primarily contends that the Copyright Act uses “the phrase ‘make registration’ and its passive-voice counterpart ‘registration has been made’” to describe submissions by the copyright owner, rather than Copyright Office responses to those submissions. Brief for Petitioner 21. Section 411(a)’s requirement that “registration . . . has been made in accordance with this title,” Fourth Estate insists, most likely refers to a copyright owner’s compliance with the statutory specifications for registration applications. In support, Fourth Estate points to Copyright Act provisions that appear to use the phrase “make registration” or one of its variants to describe what a copyright claimant does. See *id.*, at 22–26 (citing 17 U. S. C. §§110, 205(c), 408(c)(3), 411(c), 412(2)). Furthermore, Fourth Estate urges that its reading reflects the reality that, eventually, the vast majority of applications are granted. See Brief for Petitioner 41.

Fourth Estate acknowledges, however, that the Copyright Act sometimes uses “registration” to refer to activity by the Copyright Office, not activity undertaken by a copyright claimant. See *id.*, at 27–28 (citing 17 U. S. C. §708(a)). Fourth Estate thus agrees that, to determine

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how the statute uses the word “registration” in a particular prescription, one must “look to the specific context” in which the term is used. Brief for Petitioner 29. As explained *supra*, at 4–7, the “specific context” of §411(a) permits only one sensible reading: The phrase “registration . . . has been made” refers to the Copyright Office’s act granting registration, not to the copyright claimant’s request for registration.

Fourth Estate’s contrary reading of §411(a) stems in part from its misapprehension of the significance of certain 1976 revisions to the Copyright Act. Before that year, §411(a)’s precursor provided that “[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with.” 17 U. S. C. §13 (1970 ed.). Fourth Estate urges that this provision posed the very question we resolve today—namely, whether a claimant’s application alone effects registration. The Second Circuit addressed that question, Fourth Estate observes, in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F. 2d 637 (1958). Brief for Petitioner 32–34. In that case, in an opinion by Judge Learned Hand, the court held that a copyright owner who completed an application could not sue for infringement immediately upon the Copyright Office’s refusal to register. *Vacheron*, 260 F. 3d, at 640–641. Instead, the owner first had to obtain a registration certificate by bringing a mandamus action against the Register. The Second Circuit dissenter would have treated the owner’s application as sufficient to permit commencement of an action for infringement. *Id.*, at 645.

Fourth Estate sees Congress’ 1976 revision of the registration requirement as an endorsement of the *Vacheron* dissenter’s position. Brief for Petitioner 34–36. We disagree. The changes made in 1976 instead indicate Con-

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gress' agreement with Judge Hand that it is the Register's action that triggers a copyright owner's entitlement to sue. In enacting 17 U. S. C. §411(a), Congress both reaffirmed the general rule that registration must precede an infringement suit, and added an exception in that provision's second sentence to cover instances in which registration is refused. See H. R. Rep. No. 94-1476, p. 157 (1976). That exception would have no work to do if, as Fourth Estate urges, Congress intended the 1976 revisions to clarify that a copyright claimant may sue immediately upon applying for registration. A copyright claimant would need no statutory authorization to sue after refusal of her application if she could institute suit as soon as she has filed the application.

Noteworthy, too, in years following the 1976 revisions, Congress resisted efforts to eliminate §411(a) and the registration requirement embedded in it. In 1988, Congress removed foreign works from §411(a)'s dominion in order to comply with the Berne Convention for the Protection of Literary and Artistic Works' bar on copyright formalities for such works. See §9(b)(1), 102 Stat. 2859. Despite proposals to repeal §411(a)'s registration requirement entirely, however, see S. Rep. No. 100-352, p. 36 (1988), Congress maintained the requirement for domestic works, see §411(a). Subsequently, in 1993, Congress considered, but declined to adopt, a proposal to allow suit immediately upon submission of a registration application. See H. R. Rep. No. 103-338, p. 4 (1993). And in 2005, Congress made a preregistration option available for works vulnerable to predistribution infringement. See Artists' Rights and Theft Prevention Act of 2005, §104, 119 Stat. 221. See also *supra*, at 3-4. Congress chose that course in face of calls to eliminate registration in cases of predistribution infringement. 70 Fed. Reg. 42286. Time and again, then, Congress has maintained registration as prerequisite to suit, and rejected proposals that would

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have eliminated registration or tied it to the copyright claimant’s application instead of the Register’s action.⁵

Fourth Estate additionally argues that, as “registration is not a condition of copyright protection,” 17 U. S. C. §408(a), §411(a) should not be read to bar a copyright claimant from enforcing that protection in court once she has submitted a proper application for registration. Brief for Petitioner 37. But as explained *supra*, at 3, the Copyright Act safeguards copyright owners, irrespective of registration, by vesting them with exclusive rights upon creation of their works and prohibiting infringement from that point forward. If infringement occurs before a copyright owner applies for registration, that owner may eventually recover damages for the past infringement, as well as the infringer’s profits. §504. She must simply apply for registration and receive the Copyright Office’s decision on her application before instituting suit. Once the Register grants or refuses registration, the copyright owner may also seek an injunction barring the infringer from continued violation of her exclusive rights and an order requiring the infringer to destroy infringing materials. §§502, 503(b).

Fourth Estate maintains, however, that if infringement occurs while the Copyright Office is reviewing a registration application, the registration approach will deprive the owner of her rights during the waiting period. Brief for Petitioner 41. See also 1 P. Goldstein, Copyright §3.15,

⁵Fourth Estate asserts that, if a copyright owner encounters a lengthy delay in the Copyright Office, she may be forced to file a mandamus action to compel the Register to rule on her application, the very problem exposed in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F. 2d 637 (CA2 1958), see *supra*, at 8. But Congress’ answer to *Vacheron*, codified in §411(a)’s second sentence, was to permit an infringement suit upon refusal of registration, not to eliminate Copyright Office action as the trigger for an infringement suit.

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p. 3:154.2 (3d ed. 2018 Supp.) (finding application approach “the better rule”); 2 M. Nimmer & D. Nimmer, Copyright §7.16[B][3][a], [b][ii] (2018) (infringement suit is conditioned on application, while prima facie presumption of validity depends on certificate of registration). The Copyright Act’s explicit carveouts from §411(a)’s general registration rule, however, show that Congress adverted to this concern. In the preregistration option, §408(f), Congress provided that owners of works especially susceptible to prepublication infringement should be allowed to institute suit before the Register has granted or refused registration. See §411(a). Congress made the same determination as to live broadcasts. §411(c); see *supra*, at 4.⁶ As to all other works, however, §411(a)’s general rule requires owners to await action by the Register before filing suit for infringement.

Fourth Estate raises the specter that a copyright owner may lose the ability to enforce her rights if the Copyright Act’s three-year statute of limitations runs out before the Copyright Office acts on her application for registration. Brief for Petitioner 41. Fourth Estate’s fear is overstated, as the average processing time for registration applications is currently seven months, leaving ample time to sue after the Register’s decision, even for infringement that began before submission of an application. See U. S. Copyright Office, Registration Processing Times (Oct. 2, 2018) (Registration Processing Times), <https://www.copyright.gov/registration/docs/processing-times-faqs.pdf> (as last visited

⁶Further, in addition to the Act’s provisions for preregistration suit, the Copyright Office allows copyright claimants to seek expedited processing of a claim for an additional \$800 fee. See U. S. Copyright Office, Special Handling: Circular No. 10, pp. 1–2 (2017). The Copyright Office grants requests for special handling in situations involving, *inter alia*, “[p]ending or prospective litigation,” and “make[s] every attempt to examine the application . . . within five working days.” Compendium of U. S. Copyright Practices §623.2, 623.4 (3d ed. 2017).

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Mar. 1, 2019).

True, the statutory scheme has not worked as Congress likely envisioned. Registration processing times have increased from one or two weeks in 1956 to many months today. See GAO, *Improving Productivity in Copyright Registration 3* (GAO–AFMD–83–13 1982); *Registration Processing Times. Delays in Copyright Office processing of applications, it appears, are attributable, in large measure, to staffing and budgetary shortages that Congress can alleviate, but courts cannot cure.* See 5 W. Patry, *Copyright §17:83* (2019). Unfortunate as the current administrative lag may be, that factor does not allow us to revise §411(a)’s congressionally composed text.

* * *

For the reasons stated, we conclude that “registration . . . has been made” within the meaning of 17 U. S. C. §411(a) not when an application for registration is filed, but when the Register has registered a copyright after examining a properly filed application. The judgment of the Court of Appeals for the Eleventh Circuit is accordingly

Affirmed.

FOR PUBLICATION

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

NARUTO, a Crested Macaque, by and through his Next Friends, People for the Ethical Treatment of Animals, Inc.,

Plaintiff-Appellant,

v.

DAVID JOHN SLATER; BLURB, INC., a Delaware corporation; WILDLIFE PERSONALITIES, LTD., a United Kingdom private limited company,
Defendants-Appellees.

No. 16-15469

D.C. No.
3:15-cv-04324-
WHO

OPINION

Appeal from the United States District Court
for the Northern District of California
William Horsley Orrick, District Judge, Presiding

Argued and Submitted July 12, 2017
San Francisco, California

Filed April 23, 2018

Before: Carlos T. Bea and N. Randy Smith, Circuit Judges,
and Eduardo C. Robreno,* District Judge.

*The Honorable Eduardo C. Robreno, United States District Judge for the Eastern District of Pennsylvania, sitting by designation.

Opinion by Judge Bea;
Concurrence by Judge N.R. Smith

SUMMARY**

Copyright / Standing

Affirming the district court’s dismissal of claims brought by a monkey, the panel held that the animal had constitutional standing but lacked statutory standing to claim copyright infringement of photographs known as the “Monkey Selfies.”

The panel held that the complaint included facts sufficient to establish Article III standing because it alleged that the monkey was the author and owner of the photographs and had suffered concrete and particularized economic harms. The panel concluded that the monkey’s Article III standing was not dependent on the sufficiency of People for the Ethical Treatment of Animals, Inc., as a guardian or “next friend.”

The panel held that the monkey lacked statutory standing because the Copyright Act does not expressly authorize animals to file copyright infringement suits.

The panel granted appellees’ request for an award of attorneys’ fees on appeal.

Concurring in part, Judge N.R. Smith wrote that the appeal should be dismissed and the district court’s judgment

** This summary constitutes no part of the opinion of the court. It has been prepared by court staff for the convenience of the reader.

on the merits should be vacated because the federal courts lacked jurisdiction to hear the case. Disagreeing with the majority's conclusion that next-friend standing is nonjurisdictional, Judge Smith wrote that PETA's failure to meet the requirements for next-friend standing removed jurisdiction of the court.

COUNSEL

David A. Schwarz (argued), Irell & Manella LLP, Los Angeles, California, for Plaintiff-Appellant.

Andrew J. Dhuey (argued), Berkeley, California, for Defendants-Appellees David John Slater and Wildlife Personalities, Ltd.

Angela Dunning (argued), Jacqueline B. Kort, Kyle C. Wong, Jessica Valenzuela Santamaria, Cooley LLP, Palo Alto, California, for Defendant-Appellee Blurb, Inc.

Justin Marceau, Denver, Colorado; Corey Page, San Francisco, California; for Amicus Curiae Agustin Fuentes.

OPINION

BEA, Circuit Judge:

We must determine whether a monkey may sue humans, corporations, and companies for damages and injunctive relief arising from claims of copyright infringement. Our court’s precedent requires us to conclude that the monkey’s claim has standing under Article III of the United States Constitution. Nonetheless, we conclude that this monkey—and all animals, since they are not human—lacks statutory standing under the Copyright Act.¹ We therefore affirm the judgment of the district court.

FACTUAL AND PROCEDURAL BACKGROUND

Naruto was a seven-year-old crested macaque that lived—and may still live—in a reserve on the island of Sulawesi, Indonesia. In 2011, a wildlife photographer, David Slater, left his camera unattended in the reserve. Naruto allegedly took several photographs of himself (the “Monkey Selfies”) with Slater’s camera.

Slater and Wildlife Personalities, Ltd., (“Wildlife”) published the Monkey Selfies in a book that Slater created through Blurb, Inc.’s (“Blurb”) website in December 2014. The book identifies Slater and Wildlife as the copyright owners of the Monkey Selfies. However, Slater admits throughout the book that Naruto took the photographs at issue. For example, the book describes one of the Monkey Selfies as follows: “Sulawesi crested black macaque smiles at itself while pressing the shutter button on a camera.”

¹ 17 U.S.C. § 101 *et seq.*

Another excerpt from the book describes Naruto as “[p]osing to take its own photograph, unworried by its own reflection, smiling. Surely a sign of self-awareness?”

In 2015 People for the Ethical Treatment of Animals (“PETA”) and Dr. Antje Engelhardt filed a complaint for copyright infringement against Slater, Wildlife, and Blurb, as Next Friends on behalf of Naruto. The complaint alleges that Dr. Engelhardt has studied the crested macaques in Sulawesi, Indonesia for over a decade and has known, monitored, and studied Naruto since his birth. The complaint does not allege any history or relationship between PETA and Naruto.² Instead, the complaint alleges that PETA is “the largest animal rights organization in the world” and “has championed establishing the rights and legal protections available to animals beyond their utility to human beings”

Slater, Wildlife, and Blurb filed motions to dismiss under Fed. R. Civ. P. 12(b)(1) and 12(b)(6) on the grounds that the complaint did not state facts sufficient to establish standing under Article III or statutory standing under the Copyright Act. The district court granted the motions to dismiss. In its order the district court stated the following with respect to Article III standing:

The Ninth Circuit has stated that Article III
“does not compel the conclusion that a

² At oral argument Appellant’s counsel suggested that, upon remand, the complaint could be amended to state a significant relationship between PETA and Naruto. However, PETA and Engelhardt agreed not to seek amendment of the complaint, no doubt to procure our earlier hearing their appeal. Having procured the benefit of the bargain, we will hold them to their contract.

statutorily authorized suit in the name of an animal is not a ‘case or controversy.’” *Cetacean Cmty. v. Bush*, 386 F.3d 1169, 1175 (9th Cir. 2004). I need not discuss Article III standing further, because regardless of whether Naruto fulfills the requirements of Article III, he must demonstrate standing under the Copyright Act for his claim to survive under Rule 12(b)(6).

We are, of course, bound by the precedent set in *Cetacean Community* until and unless overruled by an en banc panel or the Supreme Court. *Miller v. Gammie*, 335 F.3d 889, 899 (9th Cir. 2003) (en banc).

The district court concluded that Naruto failed to establish statutory standing under the Copyright Act. PETA and Dr. Engelhardt timely appealed on Naruto’s behalf. However, after the appeal was filed, and with the permission of Appellees, Dr. Engelhardt withdrew from the litigation. Therefore, on appeal, only PETA remains to represent Naruto as his “next friend.”

STANDARD OF REVIEW

This court reviews *de novo* dismissals under Fed. R. Civ. P. 12(b)(1) and Fed. R. Civ. P. 12(b)(6). *See Rhoades v. Avon Prods., Inc.*, 504 F.3d 1151, 1156 (9th Cir. 2007). “All allegations of material fact are taken as true and construed in the light most favorable to the nonmoving party.” *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001).

DISCUSSION

I. Next Friend Standing

We gravely doubt that PETA can validly assert “next friend” status to represent claims made for the monkey both (1) because PETA has failed to allege any facts to establish the required significant relationship between a next friend and a real party in interest and (2) because an animal cannot be represented, under our laws, by a “next friend.”

First, “[i]n order to establish next-friend standing, the putative next friend must show: (1) that the petitioner is unable to litigate his own cause due to mental incapacity, lack of access to court, or other similar disability; and (2) the next friend has some significant relationship with, and is truly dedicated to the best interests of, the petitioner.” *Coalition of Clergy v. Bush*, 310 F.3d 1153, 1159–60 (9th Cir. 2002) (quoting *Massie ex rel. Kroll v. Woodford*, 244 F.3d 1192, 1194 (9th Cir. 2001)). Here, we are concerned with the second requirement. PETA does not claim to have a relationship with Naruto that is any more significant than its relationship with any other animal. Thus, PETA fails to meet the “significant relationship” requirement and cannot sue as Naruto’s next friend.³

³ We feel compelled to note that PETA’s deficiencies in this regard go far beyond its failure to plead a significant relationship with Naruto. Indeed, if any such relationship exists, PETA appears to have failed to live up to the title of “friend.” After seeing the proverbial writing on the wall at oral argument, PETA and Appellees filed a motion asking this court to dismiss Naruto’s appeal and to vacate the district court’s adverse judgment, representing that PETA’s claims against Slater had been settled. It remains unclear what claims PETA purported to be “settling,” since the court was under the impression this lawsuit was about Naruto’s claims,

But, even if PETA had alleged a significant relationship with Naruto, it still could not sue as Naruto's next friend. In *Whitmore v. Arkansas*, 495 U.S. 149 (1990), the Supreme Court discussed "next friend" standing in a habeas case in which a third-party litigant sought to challenge the death sentence of a capital defendant, Simmons, who had forsworn his right to appeal. In considering whether the third-party, Whitmore, had standing to sue on behalf of Simmons, the Court emphasized the limited nature of "next friend" standing and explained the rationale behind its limitations. For example, requiring a showing of incompetency and a "significant relationship" ensures that "the litigant asserting

and per PETA's motion, Naruto was "not a party to the settlement," nor were Naruto's claims settled therein. Nevertheless, PETA apparently obtained something from the settlement with Slater, although not anything that would necessarily go to Naruto: As "part of the arrangement," Slater agreed to pay a quarter of his earnings from the monkey selfie book "to charities that protect the habitat of Naruto and other crested macaques in Indonesia." See *Settlement Reached: 'Monkey Selfie' Case Broke New Ground For Animal Rights*, PETA, <https://www.peta.org/blog/settlement-reached-monkey-selfie-case-broke-new-ground-animal-rights/> (last visited Apr. 5, 2018). But now, in the wake of PETA's proposed dismissal, Naruto is left without an advocate, his supposed "friend" having abandoned Naruto's substantive claims in what appears to be an effort to prevent the publication of a decision adverse to PETA's institutional interests. Were he capable of recognizing this abandonment, we wonder whether Naruto might initiate an action for breach of confidential relationship against his (former) next friend, PETA, for its failure to pursue his interests before its own. Puzzlingly, while representing to the world that "animals are not ours to eat, wear, experiment on, use for entertainment, or abuse in any other way," see PETA, <https://peta.org> (last visited Apr. 5, 2018), PETA seems to employ Naruto as an unwitting pawn in its ideological goals. Yet this is precisely what is to be avoided by requiring next friends to have a significant relationship with, rather than an institutional interest in, the incompetent party—a point made by Chief Justice Rehnquist in *Lenhard v. Wolff*, 443 U.S. 1306, 1312 (1979). See *infra* page 9 for exact language.

only a generalized interest in constitutional governance” does not “circumvent the jurisdictional limits of Article III simply by assuming the mantle of ‘next friend.’” *Id.* at 164. In short, requirements of a significant interest in the subject party protect against abuses of the third-party standing rule. As the Court noted in a prior case, “however worthy and high minded the motives of ‘next friends’ may be, they inevitably run the risk of making the actual [party] a pawn to be manipulated on a chessboard larger than his own case.” *Lenhard v. Wolff*, 443 U.S. 1306, 1312 (1979). Based on the dangers inherent in any third-party standing doctrine, the Court declined to expand “next friend” standing beyond what was authorized by Congress in the habeas corpus statute. *Whitmore*, 495 U.S. at 164–165.

Here, we follow the Supreme Court’s lead in holding that “the scope of any federal doctrine of ‘next friend’ standing is no broader than what is permitted by the . . . statute.” *Id.* Although Congress has authorized “next friend” lawsuits on behalf of habeas petitioners, *see* 28 U.S.C. § 2242, and on behalf of a “minor or incompetent person,” *see* Fed. R. Civ. P. 17(c), there is no such authorization for “next friend” lawsuits brought on behalf of animals. Our precedent on statutory interpretation should apply to court rules as well as statutes: if animals are to be accorded rights to sue, the provisions involved therefore should state such rights expressly. *See Cetacean Cmty.*, 386 F.3d at 1179. Because we believe the Supreme Court’s reasoning in *Whitmore* counsels against court-initiated expansion of “next friend” standing, we decline to recognize the right of next friends to bring suit on behalf of animals, absent express authorization from Congress.

Even so, we must proceed to the merits because Naruto’s lack of a next friend does not destroy his standing to sue, as having a “case or controversy” under Article III of the Constitution. Federal Rule of Civil Procedure 17, which authorizes “next friend” lawsuits, obligates the court “to consider whether [incompetent parties] are adequately protected,” even where they have no “next friend” or “guardian.” *U.S. v. 30.64 Acres of Land*, 795 F.2d 796, 805 (9th Cir. 1986). Within this obligation, the court has “broad discretion and need not appoint a guardian ad litem [or next friend] if it determines the person is or can be otherwise adequately protected.” *Id.* (citing *Roberts v. Ohio Casualty Ins. Co.*, 2556 F.2d 35, 39 (5th Cir. 1958) (“Rule 17(c) does not make the appointment of a guardian ad litem mandatory.”)). *See also Harris v. Mangum*, 863 F.3d 1133, 1139 n.2 (9th Cir. 2017) (noting circumstances in which “appointing a guardian ad litem . . . could hinder the purpose of Rule 17(c),” and thus was not required). For example, “the court may find that the incompetent person’s interests would be adequately protected by the appointment of a lawyer.” *Krain v. Smallwood*, 880 F.2d 1119, 1121 (9th Cir. 1989) (citing *Westcott v. United States Fidelity & Guaranty Co.*, 158 F.2d 20, 22 (4th Cir. 1946). Indeed, courts have done just this, and the fact that those courts did not then dismiss the case proves that the lack of a next friend does not destroy an incompetent party’s standing. *See, e.g., Westcott*, 158 F.2d at 22 (affirming judgment against minor who was represented by an attorney but not a guardian ad litem).⁴

⁴ Here, we find that this case was briefed and argued by competent counsel who represented the legal interests of the incompetent party, but not a person, Naruto. Thus, his interests up to submission of the case following oral argument were adequately protected, notwithstanding any deficiencies in PETA’s “next friend” relationship.

Concluding otherwise would conflict with our precedent. In *Cetacean Community*, 386 F.3d at 1171, we held that a group of cetaceans could demonstrate Article III standing. There, the cetaceans had no purported “next friend.” Thus, were we to vacate the case we have before us now and remand with instructions to dismiss because of PETA’s failure to establish “next friend” standing, our jurisprudence would permit a case brought “directly” by animals without any allegation that the suit was brought by a “next friend”—as was the case in *Cetacean*—but would not permit a case brought by an organization as the “next friend” of the animal at issue if the organization failed to meet the relational requirements. That cannot be the law. We thus hold that Naruto’s Article III standing under *Cetacean* is not dependent on PETA’s sufficiency as a guardian or “next friend,” and we proceed to our Article III standing analysis.⁵

⁵ This is where we depart from the concurring opinion. First, Judge N.R. Smith seems to posit that we must restrict our inquiry into Article III standing and its effect on jurisdiction to an examination of the validity of the claimed Next Friend status, because that is how the complaint is stated. *See infra*, note 8 (Smith, J., concurring in part). In other words, since Naruto’s only stated basis for jurisdiction is Next Friend status, we can determine whether we have jurisdiction by examining only the validity of the Next Friend claim. But such a restriction is contrary to our long held and often restated duty to examine *sua sponte* whether jurisdiction exists, regardless how the parties have framed their claims. *See, e.g. Gonzalez v. Thaler*, 565 U.S. 134, 141 (2012) (“When a requirement goes to subject-matter jurisdiction, courts are obligated to consider *sua sponte* the issues that the parties have disclaimed or have not presented. Subject matter jurisdiction can never be waived or forfeited.”) (internal citations omitted). We therefore respectfully reject this suggested limitation.

Next, although Judge N.R. Smith agrees that an animal cannot sue by next friend, he nevertheless limits his analysis to cases involving next friend suits under statutes which contain particular next friend provisions. Under *Whitmore* and *Coalition*, he argues, we must dismiss based on

II. Article III Standing

The *Cetacean* court held that all of the world’s whales, dolphins, and porpoises (the “Cetaceans”), through their self-appointed lawyer, alleged facts sufficient to establish standing under Article III. 386 F.3d at 1175. The Cetaceans alleged concrete physical injuries caused by the Navy’s sonar systems in a suit brought by the “self-appointed attorney for

PETA’s insufficiency as a “next friend.” But if we all agree that suits by animals *cannot* be brought under FRCP 17, because the rule refers only to “persons,” not “animals,” why would we want to follow and be bound by habeas cases for humans for which the statute (§ 2242) expressly *provides* next friend standing? The concurrence does not explain this point.

In our view, the question of standing was explicitly decided in *Cetacean*. Although, as we explain later, we believe *Cetacean* was wrongly decided, we are bound by it. Short of an intervening decision from the Supreme Court or from an en banc panel of this court, *see Miller v. Gammie*, 335 F.3d 889, 899 (9th Cir. 2003), we cannot escape the proposition that animals have Article III standing to sue. With this as a starting premise, how could it be that PETA’s deficiency as Naruto’s representative could destroy Naruto’s otherwise valid Article III standing? Again, the concurrence fails to explain.

Judge N.R. Smith insightfully identifies a series of issues raised by the prospect of allowing animals to sue. For example, if animals may sue, who may represent their interests? If animals have property rights, do they also have corresponding duties? How do we prevent people (or organizations, like PETA) from using animals to advance their human agendas? In reflecting on these questions, Judge Smith reaches the reasonable conclusion that animals should not be permitted to sue in human courts. As a pure policy matter, we agree. But we are not a legislature, and this court’s decision in *Cetacean* limits our options. What we *can* do is urge this court to reexamine *Cetacean*. *See infra* note 6. What we *cannot* do is pretend *Cetacean* does not exist, or that it states something other, or milder, or more ambiguous on whether cetaceans have Article III standing.

all of the world's whales, porpoises, and dolphins." *Id.* at 1171. The Ninth Circuit made clear that the "sole plaintiff in this case" is the Cetaceans and did not discuss "next friend" or third-party standing. *Id.* Although the Ninth Circuit affirmed the district court's dismissal because the Cetaceans lacked statutory standing under the environmental statutes at issue in that case, the court stated that "Article III does not compel the conclusion that a statutorily authorized suit in the name of an animal is not a 'case or controversy.'"⁶ *Id.* at 1175.

Here, the complaint alleges that Naruto is the author and owner of the Monkey Selfies. The complaint further alleges

⁶ The use of the double negative here is problematic in that it creates unnecessary ambiguity in the court's holding. Better, we think, to say a petition is "timely" than that it is "not untimely," for example. Better here to have said the animal has Article III standing. "This type of litotes (the negation of an opposite) often makes language convoluted. George Orwell ridiculed it with this example: 'A not unblack dog was chasing a not unsmall rabbit across a not ungreen field.'" BRYAN GARNER, *GARNER'S MODERN AMERICAN USAGE* 545 (2003) (citing "Politics and the English Language" (1946), in *4 Collected Essays, Journalism and Letters of George Orwell* 127, 138 n.1 (1968)). But this language does not change our ultimate conclusion. If nothing about Article III *compels* the conclusion that animals lack standing, then it cannot also be true that animals lack standing simply by virtue of their being animals. In other words, *Cetacean* at the very least holds that it is *possible* for animals, like humans, to demonstrate the kind of case or controversy required to establish Article III standing. Although the claims in *Cetacean* sounded in physical harm to plaintiffs, and the claims in *Naruto* sound in economic harm to Naruto, that difference is not a point of distinction for Article III purposes. "Cases or Controversies" have described claims involving property interests, as well as claims involving personal injuries, since the Founding, and before, at common law. Thus, the sort of blanket exclusion of animals from Article III jurisdiction which Judge N.R. Smith advocates is, alas, fundamentally inconsistent with *Cetacean's* holding.

that Naruto has suffered concrete and particularized economic harms as a result of the infringing conduct by the Appellees, harms that can be redressed by a judgment declaring Naruto as the author and owner of the Monkey Selfies. Under *Cetacean*, the complaint includes facts sufficient to establish Article III standing. Therefore, we must determine whether Naruto has statutory standing⁷ to sue for

⁷ Mindful that the term “standing” carries with it jurisdictional connotations, we clarify that our use of the term “statutory standing” refers to Naruto’s ability to sue under the Copyright Act, not his ability to sue generally. Thus, as we have observed in previous cases, “[t]hrough lack of *statutory* standing requires dismissal for failure to state a claim, lack of Article III standing requires dismissal for lack of subject matter jurisdiction under Federal Rule of Civil Procedure 12(b)(1).” *Maya v. Centex Corp.*, 658 F.3d 1060, 1067 (9th Cir. 2011). The former is a determination on the merits, while the latter is purely jurisdictional.

While we believe *Cetacean* was incorrectly decided, it is binding circuit precedent that non-human animals enjoy constitutional standing to pursue claims in federal court. *See Cetacean*, 386 F.3d at 1175–76; *see also Ctr. for Auto Safety v. Chrysler Grp., LLC*, 809 F.3d 1092, 1106 (9th Cir.), cert. denied sub nom. *FCA U.S. LLC v. Ctr. for Auto Safety*, 137 S. Ct. 38, 196 L. Ed. 2d 26 (2016) (“While we have the authority to distinguish precedent on a principled basis, we are not free to ignore the literal meaning of our rulings, even when the panel believes the precedent is ‘unwise or incorrect.’”) (quoting *Hart v. Massanari*, 266 F.3d 1155, 1170 (9th Cir. 2001)). Although we must faithfully apply precedent, we are not restrained from pointing out, when we conclude after reasoned consideration, that a prior decision of the court needs reexamination. This is such a case.

Animals have neither constitutional nor statutory standing. Article III standing “often turns on the nature and source of the claim asserted.” *Warth v. Seldin*, 422 U.S. 490, 500 (1975). Other than *Cetacean*, no case has held that animals have constitutional standing to pursue claims in federal court. *See e.g., Tilkum ex rel. People for the Ethical Treatment of Animals, Inc. v. Sea World Parks & Entm’t, Inc.*, 842 F. Supp. 2d 1259 (S.D. Cal. 2012) (Thirteenth Amendment prohibition on slavery and

copyright infringement.

III. Statutory Standing under the Copyright Act

In *Cetacean*, this court stated the following with respect to statutory standing for animals:

We agree with the district court in *Citizens to End Animal Suffering & Exploitation, Inc.*, that “[i]f Congress and the President intended to take the extraordinary step of authorizing animals as well as people and legal entities to sue, they could, and should, have said so plainly.” *In the absence of any such statement* in the ESA, the MMPA, or NEPA, or the APA, we conclude that the Cetaceans do not have statutory standing to sue.

involuntary servitude applied only to humans, and thus whales lacked Article III standing to bring action against operator of theme park under Thirteenth Amendment). Prior to *Cetacean*, no court ever intimated that animals possess interests that can form the basis of a case or controversy. As to statutory standing, Congress has never provided that animals may sue in their own names in federal court, and there is no aspect of federal law (other than *Cetacean*) that has ever recognized that animals have the right to sue in their own name as a litigant. To that point, Rule 17(a) requires that the suit be brought in the name of the “party in interest”; and that next friend or guardian representation obtains only for a *person*. See Fed. R. Civ. P. 17(c). Because animals do not possess cognizable interests, it stands to reason that they cannot bring suit in federal court in their own names to protect such interests unless Congress determines otherwise.

Id. at 1179 (emphasis added).⁸ The court in *Cetacean* did not rely on the fact that the statutes at issue in that case referred to “persons” or “individuals.” *Id.* Instead, the court crafted a simple rule of statutory interpretation: if an Act of Congress plainly states that animals have statutory standing, then animals have statutory standing. If the statute does not so plainly state, then animals do not have statutory standing. The Copyright Act does not expressly authorize animals to file copyright infringement suits under the statute.⁹ Therefore,

⁸ In *Citizens to End Animal Suffering & Exploitation, Inc. v. New England Aquarium*, 836 F. Supp. 45, 49 (D. Mass. 1993), a dolphin and several animal-rights organizations filed suit against the United States Department of the Navy and the Department of Commerce under the Marine Mammal Protection Act (MMPA). The plaintiffs alleged that the dolphin’s transfer from the New England Aquarium to the Department of the Navy violated its rights under the MMPA. Without distinguishing between “statutory standing” and Article III standing, the district court granted the defendants’ motion for summary judgment because the dolphin lacked standing to sue under the MMPA. *Id.* (“This court will not impute to Congress or the President the intention to provide standing to a marine mammal without a clear statement in the statute.”). The plaintiffs did not file an appeal. *Id.*

⁹ PETA also argues that the Copyright Act contemplates statutory standing for animals because it permits statutory standing for corporations and unincorporated associations without express authorization for those non-human entities. That argument does not refute the requirement, established in *Cetacean*, that Congress plainly state any grant of statutory standing to animals. Also, the Supreme Court has held corporations to be “persons” for standing, both for constitutional and statutory purposes. *See, e.g., Citizens United v. Fed. Election Comm’n*, 558 U.S. 310, 341–42 (2010) (concluding that corporations—associations of persons—have speech rights under the First Amendment); *Burwell v. Hobby Lobby Stores, Inc.*, 134 S. Ct. 2751, 2768 (2014) (concluding that the plaintiff corporation was a “person” under the Religious Freedom Restoration Act of 1993). Moreover, corporations and unincorporated associations are formed and owned by humans; they are not formed or owned by animals.

based on this court's precedent in *Cetacean*, Naruto lacks statutory standing to sue under the Copyright Act.¹⁰

Several provisions of the Copyright Act also persuade us against the conclusion that animals have statutory standing to sue under the Copyright Act. *See Davis v. Mich. Dep't of Treasury*, 489 U.S. 803, 809 (1989) ("It is a fundamental canon of statutory construction that the words of a statute must be read in their context and with a view to their place in the overall statutory scheme."). For example, the "children" of an "author," "whether legitimate or not," can inherit certain rights under the Copyright Act. *See* 17 U.S.C. §§ 101, 201, 203, 304. Also, an author's "widow or widower owns the author's entire termination interest unless there are any surviving children or grandchildren of the author, in which case the widow or widower owns one-half of the author's interest." *Id.* § 203(a)(2)(A). The terms "children," "grandchildren," "legitimate," "widow," and "widower" all imply humanity and necessarily exclude animals that do not marry and do not have heirs entitled to property by law. Based on this court's decision in *Cetacean* and the text of the

See Bank of the U.S. v. Deveaux, 9 U.S. 61, 92 (1806) (looking to "the character of the individuals who compose the corporation" in recognizing for the first time the capacity of corporations to sue in federal court).

¹⁰ PETA also argues that *Cetacean* is distinguishable because the statutes at issue in *Cetacean* represented a waiver of the United States' sovereign immunity, and such waivers, unlike the Copyright Act, are narrowly construed. *See United States v. Nordic Vill., Inc.*, 503 U.S. 30, 34 (1992) ("[T]he Government's consent to be sued 'must be construed strictly in favor of the sovereign' . . .") (citation omitted). However this court never mentioned sovereign immunity in *Cetacean*, nor did it imply that it narrowly construed the statutory language of the four statutes at issue under the canon of construction described by PETA to reach its decision.

Copyright Act as a whole, the district court did not err in concluding that Naruto—and, more broadly, animals other than humans—lack statutory standing to sue under the Copyright Act.

IV. Attorneys' Fees

Counsel for Slater and Wildlife requests that the court grant him appellate-stage attorneys' fees and remand to the district court for the determination of the amount of those fees.¹¹ Counsel for Slater and Wildlife is entitled to attorneys' fees and costs for this appeal. *See Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 534 n.19 (1994). Thus, the request in the answering brief by Slater and Wildlife for an award of attorneys' fees on appeal is granted.¹² The determination of an appropriate amount of fees on appeal is transferred to the district court pursuant to Ninth Circuit Rule 39-1.8.

AFFIRMED.

¹¹ *See* 17 U.S.C. § 505 (“In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney’s fee to the prevailing party as part of the costs.”). By stipulation, the parties have deferred the determination of trial-stage attorneys’ fees until the resolution of this appeal.

¹² We do not speculate on the effect that any settlement agreement, such as that mentioned in the joint motion to dismiss and vacate, may have on Appellees’ ability to realize any such award. We note that the joint motion recited that Appellant Naruto was not a party to the settlement agreement.

N.R. SMITH, Circuit Judge, concurring in part:

I concur that this case must be dismissed. Federal courts do not have jurisdiction to hear this case at all. Because the courts lack jurisdiction, the appeal should be dismissed and the district court’s judgment on the merits should be vacated. *Coal. of Clergy, Lawyers, & Professors v. Bush*, 310 F.3d 1153, 1162–65 (9th Cir. 2002) (“Because we conclude that the Coalition lacks [next-friend or third-party] standing, we decline to reach the remaining questions addressed by the district court We therefore vacate those portions of the district court’s opinion which reached those questions.”). Indeed, where there is no standing, any further ruling “is, by very definition, for a court to act *ultra vires*.” *Id.* at 1165 (quoting *Steel Co. v. Citizens for a Better Env’t*, 523 U.S. 83, 101–02 (1998)). The Majority misses this point. I write to express my disagreement with the Majority’s conclusion that next-friend standing¹ is nonjurisdictional.²

¹ People for the Ethical Treatment of Animals, Inc. (PETA) grounded the jurisdiction for this suit in the next-friend standing doctrine. As pleaded: “[PETA] brings this action on behalf of, and as next friend[] to, Naruto, pursuant to Rule 17(b) of the Federal Rules of Civil Procedure, because Naruto’s rights cannot be effectively vindicated except through an appropriate representative.” Complaint at 3, *Naruto v. Slater*, No. 15-cv-04324 (N.D. Cal. Sept. 21, 2015).

Next-friend standing is an “alternative basis for standing” where the litigant pursues the action on behalf of the “real party in interest.” *Whitmore v. Arkansas*, 495 U.S. 149, 161–63 (1990). Next-friend standing requires (1) “an adequate explanation—such as inaccessibility, mental incompetence, or other disability—why the real party in interest cannot appear on his own behalf to prosecute the action”; and (2) “the ‘next friend’ must be truly dedicated to the best interests of the person on whose behalf he seeks to litigate, and it has been further suggested that a ‘next

As the Majority opinion highlights in its treatment of the merits, PETA brought a frivolous lawsuit here. The argument that animals have statutory standing to maintain a Copyright Act claim—or any property right claims—is an easy question. Under the holding in *Cetacean Community v. Bush*, 386 F.3d 1169 (9th Cir. 2004), the Copyright Act, and basic property law, animals have no such rights.

However, to reach its conclusion on the Copyright Act question, the Majority ignores its own conclusion regarding standing, instead determining that: (1) next-friend standing is nonjurisdictional; and (2) even if the elements of next-friend standing are not met, any third-party may still bring suit on behalf of anyone or anything—without the real party in interest’s permission—as long as (A) the real party in interest has an Article III injury; and (B) the real party in interest is “adequately protected” by the purported next friend’s (or self-appointed lawyer’s) representation. Maj. Op. at 9–11. That determination fails to follow United States Supreme Court or Ninth Circuit precedent. Let me explain.

friend’ must have some significant relationship with the real party in interest.” *Id.* at 163–64 (internal citations omitted).

² The Majority states that “Naruto’s Article III standing under *Cetacean* is not dependent on PETA’s sufficiency as a guardian or ‘next friend.’” Maj. Op. at 11. Put another way, the Majority simply says that lack of next-friend standing is nonjurisdictional, and (regardless of “PETA’s sufficiency” to advance Naruto’s claim) it may nonetheless resolve this case.

The Supreme Court was explicit:

The burden is on the “next friend” clearly to establish the propriety of his status and *thereby justify the jurisdiction of the court.*

These limitations on the “next friend” doctrine are driven by the recognition that “[i]t was not intended that the writ of habeas corpus should be availed of, as matter of course, by intruders or uninvited meddlers, styling themselves next friends.” Indeed, if there were no restriction on “next friend” standing in federal courts, *the litigant asserting only a generalized interest in constitutional governance could circumvent the jurisdictional limits of Art. III simply by assuming the mantle of “next friend.”*

Whitmore, 495 U.S. at 164 (emphasis added & internal citations omitted) (quoting *United States ex rel. Bryant v. Houston*, 273 F. 915, 916 (2d Cir. 1921)). We have also been explicit: failing to meet the standing requirements for next-friend standing removes jurisdiction of the court. *Coalition*, 310 F.3d at 1162–65 (dismissing case and vacating lower ruling which reached the merits, after finding there was no next-friend standing); *see also Massie ex rel. Kroll v. Woodford*, 244 F.3d 1192, 1198–99 (9th Cir. 2001) (per curiam) (dismissing emergency motion for a stay of execution because purported next friend failed to meet the standing requirements).

To buttress these conclusions, I (1) outline the basics of Article III standing and the next friend exception to Article

III standing; (2) summarize the Majority’s reasoning and decision; and (3) demonstrate the legal errors in the Majority opinion.

I. The basics of Article III standing and next-friend standing.

Article III of the United States Constitution limits the Federal Judiciary’s power to “cases” and “controversies.” U.S. Const. Art. III, § 2, cl. 1. The “doctrine of standing” is one of the “landmarks” that “set[s] apart the ‘Cases’ and ‘Controversies’ that are of the justiciable sort referred to in Article III—‘serving to identify those disputes which are appropriately resolved through the judicial process.’” *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (1992) (original alterations omitted) (quoting *Whitmore*, 495 U.S. at 155); *see also Warth v. Seldin*, 422 U.S. 490, 498 (1975) (“In its constitutional dimension, standing imports justiciability: whether the plaintiff has made out a ‘case or controversy’ between himself and the defendant within the meaning of Art. III.”); *Coalition*, 310 F.3d at 1157 (“At its constitutional core, standing is a manifestation of the Article III case-or-controversy requirement; it is the determination of whether a specific person is the proper party to *invoke the power of a federal court*.” (emphasis added)). “[T]he core component of standing is an essential and unchanging part of the case-or-controversy requirement of Article III.” *Lujan*, 504 U.S. at 560. Accordingly, the Supreme Court has “deduced a set of requirements that together make up the ‘irreducible constitutional minimum of standing.’” *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377, 1386 (2014) (quoting *Lujan*, 504 U.S. at 560).

Part of the Article III case-or-controversy requirement is the obvious derivative premise that “the plaintiff generally must assert his own legal rights and interests.” *Warth*, 422 U.S. at 499 (citing *Tileston v. Ullman*, 318 U.S. 44, 46 (1943); *United States v. Raines*, 362 U.S. 17, 21 (1960); *Barrows v. Jackson*, 346 U.S. 249, 255 (1953)); *see also Sessions v. Morales-Santana*, 137 S. Ct. 1678, 1689 (2017) (“Ordinarily, a party must assert his own legal rights and cannot rest his claim to relief on the legal rights of third parties.” (alterations, internal quotation marks, and citations omitted)); *Caplin & Drysdale, Chartered v. United States*, 491 U.S. 617, 623 n.3 (1989) (identifying that “whether the litigant suffered some injury-in-fact, adequate to satisfy Article III’s case-or-controversy requirement” is the first of two questions the Court asks “[w]hen a person or entity seeks standing to advance the constitutional rights of others”). “This Court, as is the case with all federal courts, ‘has no jurisdiction to pronounce any statute, either of a state or of the United States, void, because irreconcilable with the constitution, except as it is called upon to adjudge the legal rights of litigants in *actual controversies*.” *Raines*, 362 U.S. at 21 (emphasis added).

With only a single, narrow exception, a person filing a claim must assert a personal injury in fact³ to establish

³ Even in third-party standing (where a party has an Article III injury, but she must advance *someone else’s* rights to achieve redress), the plaintiff must have suffered an injury. *See, e.g., Kowalski v. Tesmer*, 543 U.S. 125, 129 n.2 (2004) (assuming without deciding that plaintiffs alleged an adequate individual injury to satisfy the “constitutional minimum of standing” before continuing to address the standards for permitting a third party “to assert the rights of another”); *Lexmark Int’l, Inc.*, 134 S. Ct. at 1387 n.3 (noting cases articulating that the Article III basis for third-party standing is “closely related to the question whether a

standing. *Lujan*, 504 U.S. at 560–61. This exception is next-friend standing, where a third-party—without alleging its own injury—is allowed to bring suit on behalf of the named-party, who is either (1) an incompetent or minor; or (2) unable to access the courts because of imprisonment. With next-friend standing, the party in interest has an Article III injury, but because of the disabling aspect (minority, incompetence, or imprisonment), the real party cannot advance the action, except where another person (the next friend) stands in and advances the cause on the actual party’s behalf. *Whitmore*, 495 U.S. at 161–66.

A. The basics of next-friend standing.

The Supreme Court considers next-friend standing an “alternative basis” for standing in federal courts. *Id.* at 161. Specifically, it has “long been an accepted basis for jurisdiction in certain circumstances.” *Id.* at 162. These “certain circumstances” are deeply rooted in history and narrowly limited to: (1) habeas corpus actions; and (2) “infants, other minors, and adult mental incompetents.” *Id.* at 163, 163 n.4.

Next-friend standing allows a third-party to singularly advance a cause of action on another’s behalf. “A ‘next friend’ does not himself become a party to the . . . action in which he participates, but simply pursues the cause on behalf

person in the litigant’s position will have a right of action on the claim.”) (quoting *Dep’t of Labor v. Triplett*, 494 U.S. 715, 721 n.** (1990))). In this case, PETA does not (nor could it) allege either individual or third-party standing. It does not have any cognizable Article III injury for the alleged Copyright Act violations against Naruto. Hence, I do not further address either of these bases for standing.

of the . . . real party in interest.” *Id.* at 163. To invoke next-friend standing, the purported next friend must establish: (1) “an adequate explanation—such as inaccessibility, mental incompetence, or other disability—why the real party in interest cannot appear on his own behalf to prosecute the action”; and (2) “the ‘next friend’ must be truly dedicated to the best interests of the person on whose behalf he seeks to litigate, and it has been further suggested that a ‘next friend’ must have some significant relationship with the real party in interest.” *Id.* at 163–64 (internal citations omitted). I agree with the Majority that there is no question PETA did not allege—in any way—sufficient facts to establish it could be Naruto’s next friend.

B. Next-friend standing cannot apply to animals.

I also agree with the Majority that animals cannot be represented by a next friend; I write to expand on the reasoning provided in the Majority opinion.

1. Next-friend standing for animals is barred by Supreme Court precedent.

The Supreme Court has clearly delineated the limits of next-friend standing: “[T]he scope of any federal doctrine of ‘next friend’ standing is *no broader than what is permitted by . . . the historical practice.*” *Id.* at 164–65; *cf. Town of Greece v. Galloway*, 134 S. Ct. 1811, 1818–19 (2014) (recognizing legislative prayer as a “historical” exception to the Establishment Clause); *District of Columbia v. Heller*, 554 U.S. 570, 626–27, 627 n.26, 626 (2008) (“[N]othing in our opinion should be taken to cast doubt on the *longstanding prohibitions* on the possession of firearms by felons and the mentally ill[.]” (emphasis added)). The Supreme Court noted

the two illustrations allowed by such “historical practice”: imprisoned individuals using habeas corpus and mental incompetents or minors. *Whitmore*, 495 U.S. at 161–63, 163 n.4; *see also* 28 U.S.C. § 2242 (codifying next-friend standing for habeas corpus actions; Fed. R. Civ. P. 17(c)(2) (permitting next-friend standing for a “minor or an incompetent *person* who does not have a duly appointed representative” (emphasis added))). However, there is no historical evidence that animals have ever been granted authority to sue by next friend and, absent an act of Congress,⁴ it would be improper to expand this narrow exception to the actual injury requirement of Article III.

2. There is no textual support in either the habeas corpus statute or Rule 17 for animal next friends.

Neither of the two existing grounds for next-friend standing allow animal next-friend standing. First, a writ for habeas corpus “shall be in writing signed and verified by the *person* for whose relief it is intended or by someone acting *in his behalf*.” 28 U.S. C. § 2242 (emphasis added). Therefore, textually, only a natural person can have a petition filed on her behalf. Further, any argument that animals are akin to “artificial persons” such as corporations, which are allowed to sue, *see e.g.*, *Cetacean*, 386 F.3d at 1176 (concluding that animals are no different from various “artificial persons” such as ships or corporations), makes no sense in the context of

⁴ Even if such a statute were enacted, such a statutory grant of standing would still need meet the Article III standing “case or controversy” requirement. Because it would lack the pre-constitutional historical use like habeas actions or actions on behalf of minors or incompetent persons, I have grave doubts this would succeed.

28 U.S.C. § 2242. Corporations cannot be imprisoned and, thus, there is no grounds to conclude “person” in 28 U.S.C. § 2242 could include anything other than natural persons.

Second, the Federal Rules only authorize next friend suits on behalf of “a minor or an incompetent *person*.” Fed. R. Civ. P. 17(c) (emphasis added). Per the text, this can only apply to human persons, not any “minor” or “incompetent” corporations or animals. Importantly, the historical background of Rule 17(c) limits the use of next friends to only human persons. Rule 17(c) incorporated Rule 70 of the Federal Equity Rules into the Federal Rules of Civil Procedure. Fed. R. Civ. P. 17(c), Note to Subdivision (c). Rule 70 specifically provided, “All infants and other persons so incapable may sue by their guardians, if any, or by their *prochei ami* [next friend].” Fed. Equity R. 70. Finally, the provisions for corporate capacity are articulated in Rule 17(b). Fed. R. Civ. P. 17(b). This separate enumeration of rules for non-human entities, Rule 17(b), is a clear textual indication that the use of the term “person” in Rule 17(c) does not include non-human entities, such as corporations or animals.

3. Allowing next-friend standing for animals would violate the public policy behind next-friend standing.

In addition to its historical limits, next-friend standing is narrowly tailored in light of the public policy concerns associated with expanding the doctrine. Next-friend standing “is by no means granted automatically to whomever seeks to pursue an action on behalf of another.” *Whitmore*, 495 U.S. at 163. “Indeed, if there were no restriction on ‘next friend’ standing in federal courts, the litigant asserting only a

generalized interest in constitutional governance could circumvent the jurisdictional limits of Art. III simply by assuming the mantle of ‘next friend.’” *Id.* at 164. The specific requirements to become a next friend are intended to keep “intruders or uninvited meddlers, styling themselves next friends” out of the courts. *Id.* at 164 (quoting *Houston*, 273 F. at 916). Moreover, as Chief Justice Rehnquist (writing as the sole justice for the Supreme Court on a stay of execution) similarly noted: “however worthy and high minded the motives of ‘next friends’ may be, they inevitably run the risk of making the actual defendant a pawn to be manipulated on a chessboard larger than his own case.” *Lenhard v. Wolff*, 443 U.S. 1306, 1312 (1979).

Animal-next-friend standing is particularly susceptible to abuse. Allowing next-friend standing on behalf of animals allows lawyers (as in *Cetacean*) and various interest groups (as here) to bring suit on behalf of those animals or objects *with no means or manner to ensure the animals’ interests are truly being expressed or advanced*. Such a change would fundamentally alter the litigation landscape. Institutional actors could simply claim some form of relationship to the animal or object to obtain standing and use it to advance their own institutional goals with no means to curtail those actions. We have no idea whether animals or objects wish to own copyrights or open bank accounts to hold their royalties from sales of pictures. To some extent, as humans, we have a general understanding of the similar interests of other humans.⁵ In the habeas corpus context, we presume other

⁵ I intentionally do not refer to the human-controlled entities such as corporations or ships, because those entities never have next-friend standing. They have corporate officers or owners to advance their claims. Indeed, a shareholder, who would likely meet the next-friend standing

humans desire liberty. Similarly, in actions on behalf of infants, for example, we presume the infant would want to retain ownership of the property she inherited. But the interests of animals? We are really asking what *another species* desires. Do animals want to own property, such as copyrights? Are animals willing to assume the duties associated with the rights PETA seems to be advancing on their behalf?⁶ Animal-next-friend standing is materially different from a competent person representing an incompetent person. We have millennia of experience understanding the interests and desire of humankind. This is not necessarily true for animals. Because the “real party in interest” can actually *never credibly articulate its interests or goals*, next-friend standing for animals is left at the mercy of the institutional actor to advance its own interests, which it *imputes* to the animal or object with *no accountability*. This literally creates an avenue for what Chief Justice Rehnquist feared: making the actual party in interest a “pawn to be

requirements, generally cannot even bring a suit on behalf of the corporation. *See e.g., Franchise Tax Bd. of Cal. v. Alcan Aluminium Ltd.*, 493 U.S. 331, 336 (1990) (holding that “generally . . . shareholders [are prohibited] from initiating actions to enforce the rights of the corporation”).

⁶ Participation in society brings rights and corresponding duties. The right to own property is not free from duties. One must pay taxes on profits from a royalty agreement for use of a copyrighted image. Are animals capable of shouldering the burden of paying taxes? Similarly, all people have a duty to obey the law and, for example, not commit intentional torts. Should animals liable for intentional torts as well? The concept of expanding actual property rights—and rights broadly—to animals necessitates resolving what *duties* also come with those rights and, because animals cannot communicate in our language, *who* stands in their shoes?

manipulated on a chessboard larger than his own case.” *Lenhard*, 443 U.S. at 1312.

II. The Majority opinion.

Although the Majority opinion recognizes these principles, it ignores them. The Majority opinion *states* that animals cannot have next-friend standing, but it nevertheless determines that, because Naruto has an Article III injury and he is “adequately protected,” the Majority may proceed to determine the merits of Naruto’s statutory standing claim under the Copyright Act. Maj. Op. at 9–15. In order to get there, the Majority concludes that next-friend standing is nonjurisdictional: “[W]e must proceed to the merits because Naruto’s lack of a next friend does not destroy his standing to sue, as having a ‘case or controversy’ under Article III of the Constitution,” and concludes that “Naruto’s Article III standing under *Cetacean* is not dependent on PETA’s sufficiency as a guardian or ‘next friend.’” Maj. Op. at 10, 11. I admit that the basis for the Majority’s conclusion is primarily grounded in its reading of *Cetacean*, in which a “self-appointed attorney” brought a suit on behalf of the world’s cetaceans. 386 F.3d at 1171–72. *Cetacean* concluded that animals may have an Article III injury—but, notably, did not examine whether next-friend standing was present. Given this analysis, the Majority concludes that, because the *Cetacean* panel allowed the case to go forward, it implicitly held that next-friend standing is nonjurisdictional. Maj. Op. at 11.

The Majority’s conclusion on the first point—animals can never have next-friend standing—is correct⁷ and should end

⁷ As such, I concur in the Majority’s opinion to that extent.

our inquiry. *See infra*. On the other hand, the second conclusion (that next-friend standing is nonjurisdictional) is not supportable. This conclusion is incorrect and the consequences associated with the Majority's holding are avoidable, if we follow precedent.

III. The Majority's conclusion that next-friend standing is nonjurisdictional is legally unsupportable.

A. The Majority's second conclusion violates Supreme Court and Ninth Circuit Precedent.

Both the United States Supreme Court and our Circuit have held next-friend standing is jurisdictional. In *Whitmore*, the petitioner brought suit on behalf of another death-row prisoner, Ronald Simmons. 495 U.S. at 152–54. *Whitmore* asserted both third-party standing and next-friend standing to justify the suit. *Id.* at 153–54. The Supreme Court held that *Whitmore* failed both standing tests and, ultimately held that “Jonas *Whitmore* lacks standing to proceed in this Court, and the writ of certiorari is dismissed *for want of jurisdiction.*” *Id.* at 166 (emphasis added). The Supreme Court also clearly held that any purported next friend bears the burden “clearly to establish the propriety of his status *and thereby justify the jurisdiction of the court.*” *Id.* at 164 (emphasis added) (citing *Mo. Pub. Def. Comm'n ex rel. Smith v. Armontrout*, 812 F.2d 1050, 1053 (8th Cir. 1987); *Grouseclose ex rel. Harries v. Dutton*, 594 F. Supp. 949, 952 (M.D. Tenn. 1984)); *see also Demosthenes v. Baal*, 495 U.S. 731, 737 (1990) (holding that “federal courts must make certain that an adequate basis exists for the exercise of federal power” and dismissing the suit for failure to demonstrate next-friend standing).

We have also held that next-friend standing is jurisdictional. In *Coalition*, a coalition of clergy, lawyers, and professors brought suit on behalf of the prisoners detained in Guantanamo, Cuba. 310 F.3d at 1156. The district court held that the Coalition did not have standing and, even if they did, no federal district court—including itself—could have jurisdiction over such a suit. *Id.* On appeal, we agreed that the Coalition could not establish next-friend standing. *Id.* However, we noted that “[t]he question before us is not the scope of the rights and privileges of the detainees themselves under either our Constitution or other international laws or agreements.” *Id.* at 1164. Rather, we “consider[ed] only the rights of the members of the Coalition *to assert standing on behalf of the detainees and to seek habeas review of their detention.*” *Id.* at 1165 (emphasis added). We then dismissed the suit *and* vacated the district court’s other holding that no court, or itself, may entertain a habeas action on behalf of a detainee held in Guantanamo, Cuba. *Id.* Additional Circuit precedent stands for the same proposition. *See Massie*, 244 F.3d at 1199 (affirming the district court’s conclusion that a litigant seeking a stay of execution on behalf of another person “lacked standing” as a next friend under *Whitmore*).⁸

⁸ The Majority argues that I err by using next-friend cases to conclude that we lack jurisdiction in this case. Maj. Op. at 11–12 n.5. But, next-friend standing is the only basis for jurisdiction PETA has alleged. Compl. at 3 (stating PETA “b[rough]t this action on behalf of, and as next friend[] to, Naruto”). Both the Majority and I agree that PETA does not have next-friend standing and that animals can never have next-friend standing. This should end our inquiry. Further, as a general rule, the proponent of a case must advance its own injury. *Warth*, 422 U.S. at 499. Next-friend standing is an exception to this rule. *Whitmore*, 495 U.S. at 161–63. Naruto did not bring his own claim, PETA does not assert its own injury, and both the Majority and I agree PETA cannot be Naruto’s next friend. There are no other jurisdictional bases on which to rest our authority to resolve this case.

B. Standing must be jurisdictional because of its preclusive effect.

Judgments are preclusive. *See, e.g., Owens v. Kaiser Found. Health Plan, Inc.*, 244 F.3d 708, 713 (9th Cir. 2001) (“Res judicata, also known as claim preclusion, bars litigation in a subsequent action of any claims that were raised or could have been raised in the prior action.” (citations omitted)). If the putative next friend is *not* the appropriate entity, but the case is allowed to go forward, an improper representative can create preclusive precedent that, forever, bars the real party in interest. This preclusive effect alone requires that the question of next-friend standing be decided before the merits question and, if there is no next-friend standing, the case must be dismissed so the proper party may bring the case if she so chooses.

C. *Cetacean* did not impliedly overrule *Coalition* or *Whitmore*.⁹

The Majority’s conclusion that *Cetacean* somehow makes next-friend standing nonjurisdictional tortures the case and legal reasoning to reach such a conclusion. First, both *Whitmore* and *Coalition* were decided *before Cetacean*.

⁹ The Majority accuses me of “pretend[ing] *Cetacean* does not exist, or that it states something other, or milder, or more ambiguous on whether cetaceans have Article III standing” and arguing for a “blanket exclusion of animals from Article III jurisdiction.” Maj. Op. at 11–12 n.5, 13 n.6. My conclusion does not “pretend *Cetacean* does not exist”; it simply requires *Cetacean* be applied within the legal framework that governs cases where a plaintiff’s claims are *brought by someone else*. Such claims may only be advanced by a next friend and, if one is not available or legally possible, those claims cannot be redressed. As I demonstrate in this section, *Cetacean* does not hold to the contrary.

Accordingly, those binding cases, which directly answer the question of whether next-friend standing is jurisdictional, were binding on the *Cetacean* panel as well.

Second, *Cetacean* is silent on next-friend standing. Indeed, even the briefing did not raise the issue. Rather, the *Cetacean* court seemed to conclude that animals may have Article III standing,¹⁰ and then examined the statutory standing questions before it. 386 F.3d at 1174–79. The *Cetacean* court did not (though it most certainly should have) examine whether it was appropriate for a “self-appointed attorney” to bring a case on behalf of the “Cetacean Community” and articulate “their” interests. *Id.* at 1171–72. There can be no reasonable argument that the lawyer in *Cetacean* spoke to, and received instructions from his client, the “Cetacean Community.” Rather, he functioned as a purported next friend, arguing that certain Navy sonar technology injured the members of the “Cetacean Community.” *Id.*

Third, it is simply incorrect to conclude that an implied holding from a case that did not even address the question—in any form—somehow overrules explicit prior United States Supreme Court and Ninth Circuit precedent. “[U]nstated assumptions on non-litigated issues are not precedential holdings binding future decisions.” *Sakamoto v. Duty Free Shoppers, Ltd.*, 764 F.2d 1285, 1288 (9th Cir. 1985); see also *Morales-Garcia v. Holder*, 567 F.3d 1058, 1064 (9th Cir. 2009) (stating that panels are bound by “prior decision[s],” but “the term ‘decision,’ however, encompasses only those issues that are raised or discussed” (citations

¹⁰ Although binding precedent, I agree with the Majority that granting Article III standing to animals was an incorrect conclusion.

omitted)). Indeed, *Cetacean* itself noted: “[W]here a panel confronts an issue germane to the eventual resolution of the case, and resolves it after reasoned consideration in a published opinion, that ruling becomes the law of the circuit, regardless of whether doing so is necessary in some strict logical sense.” *Cetacean*, 386 F.3d at 1173 (emphasis added) (quoting *United States v. Johnson*, 256 F.3d 895, 914 (9th Cir. 2001) (Kozinski, J., concurring)); see also *Brecht v. Abrahamson*, 507 U.S. 619, 630–31 (1993) (refusing to follow prior cases where the issue had not been “squarely addressed”). Rather, the appropriate reading of *Cetacean*, because a three-judge panel *cannot* overrule a prior panel, see *Miller v. Gammie*, 335 F.3d 889, 899 (9th Cir. 2003) (en banc), is that the *Cetacean* panel (1) ought not have reached the question it did; and (2) the fact that it seemed to conclude that an animal may have Article III standing does not remove the appropriate standing question that determines if the next friend may bring the action at all. It is simply unsupportable to conclude that a panel that *did not address an issue somehow overrules prior binding decisions that did address the issue*.

Fourth, the simple fact that *Cetacean* found that animals could have an Article III injury does not, automatically, create some form of right for third-parties to advance those claims (or, make next-friend standing nonjurisdictional and, as the Majority holds, simply inapplicable)! There are a multitude of Article III injuries that occur regularly, which people choose not to pursue. Because the individual with the injury opts *not* to pursue the claim does not somehow make the injury “public domain,” so any random entity may bring the claim. Next-friend standing serves as a bar to such meddling, and *Cetacean* did not impliedly eviscerate that conclusion.

Not only did *Cetacean* not address animal next-friend standing, but no court has ever done so. See *Mount Graham Red Squirrel v. Madigan*, 954 F.2d 1441, 1448 n.13 (9th Cir. 1992) (“No party has mentioned and, notwithstanding our normal rules, we do not consider, the standing of the first-named party [Mount Graham Red Squirrel] to bring this action.”); *Palila v. Hawaii Dep’t of Land & Nat. Res.*, 852 F.2d 1106, 1107 (9th Cir. 1988) (“As an endangered species . . . , the bird . . . also has legal status and wings its way into federal court as a plaintiff in its own right.” (emphasis added)), abrogated in part by, *Cetacean*, 386 F.3d at 1173 (9th Cir. 2004) (“*Palila IV*’s statements [regarding standing] are nonbinding dicta.”); *Citizens to End Animal Suffering & Exploitation, Inc. v. New England Aquarium*, 836 F. Supp. 45, 49–50 (D. Mass. 1993) (finding named dolphin, Kama, lacked standing because “[t]he MMPA does not authorize suits brought by animals,” and addressing the fact that Rule 17(b) would hold that animals lack “capacity” to be sued because they are property of their owners, concluding that “the MMPA and the operation of F.R.Civ.P. 17(b) indicate that Kama the dolphin lacks standing to maintain this action as a matter of law,” and allowing “the removal of Kama’s name from the caption of [the] case”); *Hawaiian Crow (‘Alala) v. Lujan*, 906 F.Supp. 549, 551–52 (D. Haw. 1991) (finding that in *Northern Spotted Owl*, *Palila*, and *Mount Graham Red Squirrel*, no party had challenged the named standing of the animal itself and the case had other parties in the litigation and ultimately concluding that “the cited cases do not directly support plaintiffs’ position here” and concluding that “the plain language of Rule 17(c) and section 1540(g) [did] not authorize the ‘Alala to sue” because it was “clearly neither a ‘person’ as defined in section 1532(13), nor an infant or incompetent person under Rule 17(c)”); *Northern Spotted Owl v. Lujan*, 758 F. Supp. 621

(W.D. Wash. 1991) (failing to address standing for named first-party); *Northern Spotted Owl v. Hodel*, 716 F. Supp 479 (W.D. Wash. 1988) (failing to address standing for named first-party).

D. The Majority’s reliance on both Rule 17 and cases discussing “adequate protection” in the context of Rule 17 are simply inapplicable.

There is a crucial distinction between the cases cited by the Majority for the proposition that the only requirement for next friend suits is to ensure the “[incompetent parties] are adequately protected,” Maj. Op. at 10 (quotation marks omitted and alterations in original), and the facts of *this* case and next-friend standing broadly. Each case cited is an example of an incompetent person bringing suit on his own behalf or such a person being sued by another party. I list the cases cited by the Majority to emphasize:

- *Krain v. Smallwood*, 880 F.2d 1119, 1121 (9th Cir. 1989) (“Lawrence Krain appeals the dismissal with prejudice of eight lawsuits *he filed, in pro se*, in the district court.” (emphasis added)).
- *United States v. 30.64 Acres of Land*, 795 F.2d 796, 797 (9th Cir. 1986) (“The United States *filed a complaint against Starr . . . to establish just compensation for 30.64 acres of Starr’s land taken by the government . . .*” (emphasis added)).
- *Harris v. Mangum*, 863 F.3d 1133, 1136 (9th Cir. 2017) (“Plaintiff-Appellant Jason

Harris, an Arizona state prisoner, *filed pro se a lawsuit* in state court that was subsequently removed” (emphasis added)).

- *Roberts v. Ohio Cas. Ins. Co.*, 256 F.2d 35, 37, 39 (5th Cir. 1958) (finding where “Ohio Casualty Insurance Company . . . *filed suit* to set aside a ruling . . . *against the claimants*—the children and their grandmother,” and children had not been represented by a guardian ad litem, the lower judgment granting relief to the plaintiff must be reversed and remanded for further proceedings (emphasis added)).
- *Westcott v. U.S. Fid. Guar. Co.*, 158 F.2d 20, 21 (4th Cir. 1946) (“The United States Fidelity & Guaranty Company . . . *brought a civil action* . . . seeking a declaratory judgment to the effect that it was not liable on a public liability policy The defendants in the civil action . . . were the insured, . . . George Mann, a minor.” (emphasis added)).

Quite simply, there is *no* Article III jurisdiction question in *any* of these cases. Of course, the court would ensure such incompetent *persons* were adequately represented. The parties sought either redress in court as plaintiffs (but were not competent, and thus needed to be protected), or were pulled into court as defendants (and, thus, the court was required to ensure they were protected).

These circumstances do not exist here. Our question is whether a third-party (PETA) has next-friend standing—such that it can invoke the authority of this court—to stand in Naruto’s shoes and advance his claims. It is not a question of whether Naruto was properly protected *or* was brought into this litigation as a defendant. Unlike the cases cited, Naruto (1) did not file this case himself; and (2) is not a defendant. PETA and Dr. Engelhardt initiated this suit on Naruto’s behalf. As such, the cases cited by the Majority are simply inapplicable.

IV. Conclusion

The question of PETA’s next-friend standing was squarely before our panel. It was briefed and argued. By both concluding that next-friend standing is nonjurisdictional *and* reaching the merits of the Copyright Act question, the Majority allows PETA (with no injury or relationship to the real party in interest) to sue on Naruto’s behalf, because it obtained legal counsel to allegedly represent Naruto. I cannot support this conclusion.¹¹

¹¹ Indeed, this case is a prime example of the abuse the Majority opinion would now allow. In 2011, Slater (a photographer) went to the Tangkoko Reserve in Indonesia and setup a camera. Naruto, a crested macaque, pushed the shutter. Slater and Wildlife Personalities subsequently included the photographs in a book published by Blurb. In 2015, PETA—with no evidence it has any relationship whatsoever to Naruto—brought the instant suit claiming that Slater, Wildlife Personalities, and Blurb had violated Naruto’s rights under the Copyright Act. PETA alleged that it “ha[d] a genuine concern for Naruto’s well-being and [was] dedicated to pursuing his best interests in this litigation” and that it “ha[d] the financial and operational resources and the professional expertise to administer and protect Naruto’s copyright in the Monkey Selfies.” Compl. at 4. PETA sought, *inter alia*, a court order

“[p]ermitting [PETA] to administer and protect Naruto’s authorship of and copyright in the Monkey Selfies.” *Id.* at 10.

PETA lost at the district court and appealed. When Dr. Engelhardt moved to be dismissed from the case, PETA twice affirmatively stated it would “fulfill the duties of a next friend.” *Notice of Withdrawal of Next Friend Antje Engelhardt* (May 4, 2016); *see also Motion to Correct Caption* (May 10, 2016) (“PETA shall remain responsible for maintaining this litigation and fulfilling the *duties* of a [n]ext [f]riend pursuant to Federal Rule of Civil Procedure 17(c).” (emphasis added)).

However, PETA quickly changed its tune after oral argument. On September 11, 2017, PETA and Defendants moved to dismiss the appeal and vacate the lower court’s judgment. *Joint Motion to Dismiss Appeal and Vacate the Judgment* (Sept. 11, 2017). But, unlike a normal settlement, the purported plaintiff, Naruto, *was not a party*. “Dismissal with vacatur is just and proper where, as here, the Plaintiff [Naruto] is *not a party to the settlement*.” *Id.* at 1 (emphasis added). Rather, his purported next friend, PETA, *settled its own claims*: “the settlement resolves all disputes arising out of this litigation *as between PETA and Defendants*.” *Id.* (emphasis added). It remains a mystery to me what “claims” PETA (a non-party) could settle. Nevertheless, even though PETA only settled its *own claims*, it maintained that “the settlement also renders moot the appeal filed on behalf of the Plaintiff Naruto.” *Id.* Indeed, PETA went so far as to claim “[t]here is thus no longer any live case or controversy before this Court.” *Id.* at 3.

Though it had previously attested it would “fulfill[] the duties of a next friend,” PETA forgot its self-appointed role. “A ‘next friend’ *does not [itself] become a party to the . . . action* in which [it] participates, but *simply pursues the cause on behalf of [the party in interest]*.” *Whitmore*, 495 U.S. at 163 (emphasis added). Whatever PETA did or did not do for Naruto (it only made representations to this court regarding what it obtained), PETA made sure to protect itself and with the *Joint Motion* sought to manipulate this court to avoid further negative precedent contrary to its institutional objectives. PETA cleverly argues that, because Naruto is not a party to the settlement and Defendants have maintained that PETA does not have next-friend standing, Naruto should not be bound by judgments entered because of PETA’s actions. But, clever arguments

hardly conceal what is really occurring and the flip by PETA is quite surprising. One day, PETA maintains it will advance Naruto's interests, the next it maintains that Naruto cannot be bound by PETA's actions. It is clear: PETA's real motivation in this case was to advance its own interests, not Naruto's. PETA began this case purportedly seeking not only an injunction, but also a judgment "[d]eclaring Naruto to be the author and copyright owner of the Monkey Selfies with all attendant rights and privileges under law" and disgorgement. Compl. at 9–10. After oral argument, none of those objectives are, apparently, worth pursuing. Rather, when it came down to a possible negative, precedential ruling from the panel, PETA quickly sought to protect the *institution*, not the claimed real party in interest. PETA used Naruto as a "pawn to be manipulated on a chessboard larger than his own case." *Lenhard*, 443 U.S. at 1312 (Rehnquist, J., writing for the full Supreme Court).

Unfortunately, PETA's actions could be the new normal under today's holding.

Syllabus

NOTE: Where it is feasible, a syllabus (headnote) will be released, as is being done in connection with this case, at the time the opinion is issued. The syllabus constitutes no part of the opinion of the Court but has been prepared by the Reporter of Decisions for the convenience of the reader. See *United States v. Detroit Timber & Lumber Co.*, 200 U. S. 321, 337.

SUPREME COURT OF THE UNITED STATES

Syllabus

**STAR ATHLETICA, L.L.C. v. VARSITY BRANDS, INC.,
ET AL.**

**CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR
THE SIXTH CIRCUIT**

No. 15–866. Argued October 31, 2016—Decided March 22, 2017

The Copyright Act of 1976 makes “pictorial, graphic, or sculptural features” of the “design of a useful article” eligible for copyright protection as artistic works if those features “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U. S. C. §101.

Respondents have more than 200 copyright registrations for two-dimensional designs—consisting of various lines, chevrons, and colorful shapes—appearing on the surface of the cheerleading uniforms that they design, make, and sell. They sued petitioner, who also markets cheerleading uniforms, for copyright infringement. The District Court granted petitioner summary judgment, holding that the designs could not be conceptually or physically separated from the uniforms and were therefore ineligible for copyright protection. In reversing, the Sixth Circuit concluded that the graphics could be “identified separately” and were “capable of existing independently” of the uniforms under §101.

Held: A feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (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. That test is satisfied here. Pp. 3–17.

(a) Separability analysis is necessary in this case. Respondents claim that two-dimensional surface decorations are always separable, even without resorting to a §101 analysis, because they are “*on* a useful article” rather than “*designs of* a useful article.” But this argu-

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ment is inconsistent with §101’s text. “[P]ictorial” and “graphic” denote two-dimensional features such as pictures, paintings, or drawings. Thus, by providing protection for “pictorial, graphical, and sculptural works” incorporated into the “design of a useful article,” §101 necessarily contemplates that such a design can include two-dimensional features. This Court will not adjudicate in the first instance the Government’s distinct argument against applying separability analysis, which was neither raised below nor advanced here by any party. Pp. 4–6.

(b) Whether a feature incorporated into a useful article “can be identified separately from,” and is “capable of existing independently of,” the article’s “utilitarian aspects” is a matter of “statutory interpretation.” *Mazer v. Stein*, 347 U. S. 201, 214. Pp. 6–10.

(1) Section 101’s separate-identification requirement is met if the decisionmaker is able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities. To satisfy the independent-existence requirement, the feature must be able to exist as its own pictorial, graphic, or sculptural work once it is imagined apart from the useful article. If the feature could not exist as a pictorial, graphic, or sculptural work on its own, it is simply one of the article’s utilitarian aspects. And to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot be a useful article or “[a]n article that is normally a part of a useful article,” §101. Neither could one claim a copyright in a useful article by creating a replica of it in another medium. Pp. 7–8.

(2) The statute as a whole confirms this interpretation. Section 101, which protects art first fixed in the medium of a useful article, is essentially the mirror image of §113(a), which protects art first fixed in a medium other than a useful article and subsequently applied to a useful article. Together, these provisions make clear that copyright protection extends to pictorial, graphic, and sculptural works regardless of whether they were created as freestanding art or as features of useful articles. P. 8.

(3) This interpretation is also consistent with the Copyright Act’s history. In *Mazer*, a case decided under the 1909 Copyright Act, the Court held that respondents owned a copyright in a statuette created for use as a lamp base. In so holding, the Court approved a Copyright Office regulation extending protection to works of art that might also serve a useful purpose and held that it was irrelevant to the copyright inquiry whether the statuette was initially created as a freestanding sculpture or as a lamp base. Soon after, the Copyright Office enacted a regulation implementing *Mazer*’s holding that anticipated the language of §101, thereby introducing the modern separa-

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bility test to copyright law. Congress essentially lifted the language from those post-*Mazer* regulations and placed it in §101 of the 1976 Act. Pp. 8–10.

(c) Applying the proper test here, the surface decorations on the cheerleading uniforms are separable and therefore eligible for copyright protection. First, the decorations can be identified as features having pictorial, graphic, or sculptural qualities. Second, if those decorations were separated from the uniforms and applied in another medium, they would qualify as two-dimensional works of art under §101. Imaginatively removing the decorations from the uniforms and applying them in another medium also would not replicate the uniform itself.

The dissent argues that the decorations are ineligible for copyright protection because, when imaginatively extracted, they form a picture of a cheerleading uniform. Petitioner similarly claims that the decorations cannot be copyrighted because, even when extracted from the useful article, they retain the outline of a cheerleading uniform. But this is not a bar to copyright. Just as two-dimensional fine art correlates to the shape of the canvas on which it is painted, two-dimensional applied art correlates to the contours of the article on which it is applied. The only feature of respondents' cheerleading uniform eligible for a copyright is the two-dimensional applied art on the surface of the uniforms. Respondents may prohibit the reproduction only of the surface designs on a uniform or in any other medium of expression. Respondents have no right to prevent anyone from manufacturing a cheerleading uniform that is identical in shape, cut, or dimensions to the uniforms at issue here. Pp. 10–12.

(d) None of the objections raised by petitioner or the Government is meritorious. Pp. 12–17.

(1) Petitioner and the Government focus on the relative utility of the plain white uniform that would remain if the designs were physically removed from the uniform. But the separability inquiry focuses on the extracted feature and not on any aspects of the useful article remaining after the imaginary extraction. The statute does not require the imagined remainder to be a fully functioning useful article at all. Nor can an artistic feature that would be eligible for copyright protection on its own lose that protection simply because it was first created as a feature of the design of a useful article, even if it makes that article more useful. This has been the rule since *Mazer*, and it is consistent with the statute's explicit protection of "applied art." In rejecting petitioner's view, the Court necessarily abandons the distinction between "physical" and "conceptual" separability adopted by some courts and commentators. Pp. 12–15.

(2) Petitioner also suggests incorporating two "objective" com-

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ponents into the test—one requiring consideration of evidence of the creator’s design methods, purposes, and reasons, and one looking to the feature’s marketability. The Court declines to incorporate these components because neither is grounded in the statute’s text. Pp. 15–16.

(3) Finally, petitioner claims that protecting surface decorations is inconsistent with Congress’ intent to entirely exclude industrial design from copyright. But Congress has given limited copyright protection to certain features of industrial design. Approaching the statute with presumptive hostility toward protection for industrial design would undermine that choice. In any event, the test adopted here does not render the underlying uniform eligible for copyright protection. Pp. 16–17.

799 F. 3d 468, affirmed.

THOMAS, J., delivered the opinion of the Court, in which ROBERTS, C. J., and ALITO, SOTOMAYOR, and KAGAN, JJ., joined. GINSBURG, J., filed an opinion concurring in the judgment. BREYER, J., filed a dissenting opinion, in which KENNEDY, J., joined.

Cite as: 580 U. S. ____ (2017)

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Opinion of the Court

NOTICE: This opinion is subject to formal revision before publication in the preliminary print of the United States Reports. Readers are requested to notify the Reporter of Decisions, Supreme Court of the United States, Washington, D. C. 20543, of any typographical or other formal errors, in order that corrections may be made before the preliminary print goes to press.

SUPREME COURT OF THE UNITED STATES

No. 15–866

STAR ATHLETICA, L. L. C., PETITIONER *v.* VARSITY
BRANDS, INC., ET AL.ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE SIXTH CIRCUIT

[March 22, 2017]

JUSTICE THOMAS delivered the opinion of the Court.

Congress has provided copyright protection for original works of art, but not for industrial designs. The line between art and industrial design, however, is often difficult to draw. This is particularly true when an industrial design incorporates artistic elements. Congress has afforded limited protection for these artistic elements by providing that “pictorial, graphic, or sculptural features” of the “design of a useful article” are eligible for copyright protection as artistic works if those features “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U. S. C. §101.

We granted certiorari to resolve widespread disagreement over the proper test for implementing §101’s separate-identification and independent-existence requirements. 578 U. S. ____ (2016). We hold that a feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protecta-

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ble 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. Because that test is satisfied in this case, we affirm.

I

Respondents Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc., design, make, and sell cheerleading uniforms. Respondents have obtained or acquired more than 200 U. S. copyright registrations for two-dimensional designs appearing on the surface of their uniforms and other garments. These designs are primarily “combinations, positionings, and arrangements of elements” that include “chevrons . . . , lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring, and shapes.” App. 237. At issue in this case are Designs 299A, 299B, 074, 078, and 0815. See Appendix, *infra*.

Petitioner Star Athletica, L. L. C., also markets and sells cheerleading uniforms. Respondents sued petitioner for infringing their copyrights in the five designs. The District Court entered summary judgment for petitioner on respondents’ copyright claims on the ground that the designs did not qualify as protectable pictorial, graphic, or sculptural works. It reasoned that the designs served the useful, or “utilitarian,” function of identifying the garments as “cheerleading uniforms” and therefore could not be “physically or conceptually” separated under §101 “from the utilitarian function” of the uniform. 2014 WL 819422, *8–*9 (WD Tenn., Mar. 1, 2014).

The Court of Appeals for the Sixth Circuit reversed. 799 F. 3d 468, 471 (2015). In its view, the “graphic designs” were “separately identifiable” because the designs “and a blank cheerleading uniform can appear ‘side by side’—one as a graphic design, and one as a cheerleading uniform.”

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Id., at 491 (quoting Compendium of U. S. Copyright Office Practices §924.2(B) (3d ed. 2014) (Compendium)). And it determined that the designs were “capable of existing independently” because they could be incorporated onto the surface of different types of garments, or hung on the wall and framed as art. 799 F. 3d, at 491, 492.

Judge McKeague dissented. He would have held that, because “identifying the wearer as a cheerleader” is a utilitarian function of a cheerleading uniform and the surface designs were “integral to” achieving that function, the designs were inseparable from the uniforms. *Id.*, at 495–496.

II

The first element of a copyright-infringement claim is “ownership of a valid copyright.” *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U. S. 340, 361 (1991). A valid copyright extends only to copyrightable subject matter. See 4 M. Nimmer & D. Nimmer, *Copyright* §13.01[A] (2010) (Nimmer). The Copyright Act of 1976 defines copyrightable subject matter as “original works of authorship fixed in any tangible medium of expression.” 17 U. S. C. §102(a).

“Works of authorship” include “pictorial, graphic, and sculptural works,” §102(a)(5), which the statute defines to include “two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans,” §101. And a work of authorship is “‘fixed’ in a tangible medium of expression when it[is] embodi[ed] in a” “material objec[t] . . . from which the work can be perceived, reproduced, or otherwise communicated.” *Ibid.* (definitions of “fixed” and “copies”).

The Copyright Act also establishes a special rule for copyrighting a pictorial, graphic, or sculptural work incor-

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porated into a “useful article,” which is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” *Ibid.* The statute does not protect useful articles as such. Rather, “the design of a useful article” is “considered a pictorial, graphical, 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.” *Ibid.*

Courts, the Copyright Office, and commentators have described the analysis undertaken to determine whether a feature can be separately identified from, and exist independently of, a useful article as “separability.” In this case, our task is to determine whether the arrangements of lines, chevrons, and colorful shapes appearing on the surface of respondents’ cheerleading uniforms are eligible for copyright protection as separable features of the design of those cheerleading uniforms.

A

As an initial matter, we must address whether separability analysis is necessary in this case.

1

Respondents argue that “[s]eparability is only implicated when a [pictorial, graphic, or sculptural] work is the ‘design of a useful article.’” Brief for Respondents 25. They contend that the surface decorations in this case are “two-dimensional graphic designs that appear *on* useful articles,” but are not themselves designs *of* useful articles. *Id.*, at 52. Consequently, the surface decorations are protected two-dimensional works of graphic art without regard to any separability analysis under §101. *Ibid.*; see 2 W. Patry, Copyright §3:151, p. 3–485 (2016) (Patry)

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(“Courts looking at two-dimensional design claims should not apply the separability analysis regardless of the three-dimensional form that design is embodied in”). Under this theory, two-dimensional artistic features on the surface of useful articles are “inherently separable.” Brief for Respondents 26.

This argument is inconsistent with the text of §101. The statute requires separability analysis for any “pictorial, graphic, or sculptural features” incorporated into the “design of a useful article.” “Design” refers here to “the combination” of “details” or “features” that “go to make up” the useful article. 3 Oxford English Dictionary 244 (def. 7, first listing) (1933) (OED). Furthermore, the words “pictorial” and “graphic” include, in this context, two-dimensional features such as pictures, paintings, or drawings. See 4 *id.*, at 359 (defining “[g]raphic” to mean “[o]f or pertaining to drawing or painting”); 7 *id.*, at 830 (defining “[p]ictorial” to mean “of or pertaining to painting or drawing”). And the statute expressly defines “[p]ictorial, graphical, and sculptural works” to include “two-dimensional . . . works of . . . art.” §101. The statute thus provides that the “design of a useful article” can include two-dimensional “pictorial” and “graphic” features, and separability analysis applies to those features just as it does to three-dimensional “sculptural” features.

2

The United States makes a related but distinct argument against applying separability analysis in this case, which respondents do not and have not advanced. As part of their copyright registrations for the designs in this case, respondents deposited with the Copyright Office drawings and photographs depicting the designs incorporated onto cheerleading uniforms. App. 213–219; Appendix, *infra*. The Government argues that, assuming the other statutory requirements were met, respondents obtained a copyright

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in the deposited drawings and photographs and have simply reproduced those copyrighted works on the surface of a useful article, as they would have the exclusive right to do under the Copyright Act. See Brief for United States as *Amicus Curiae* 14–15, 17–22. Accordingly, the Government urges, separability analysis is unnecessary on the record in this case. We generally do not entertain arguments that were not raised below and that are not advanced in this Court by any party, *Burwell v. Hobby Lobby Stores, Inc.*, 573 U. S. ___, ___ (2014), because “[i]t is not the Court’s usual practice to adjudicate either legal or predicate factual questions in the first instance,” *CRST Van Expedited, Inc. v. EEOC*, 578 U. S. ___, ___ (2016) (slip op., at 16). We decline to depart from our usual practice here.

B

We must now decide when a feature incorporated into a useful article “can be identified separately from” and is “capable of existing independently of” “the utilitarian aspects” of the article. This is not a free-ranging search for the best copyright policy, but rather “depends solely on statutory interpretation.” *Mazer v. Stein*, 347 U. S. 201, 214 (1954). “The controlling principle in this case is the basic and unexceptional rule that courts must give effect to the clear meaning of statutes as written.” *Estate of Cowart v. Nicklos Drilling Co.*, 505 U. S. 469, 476 (1992). We thus begin and end our inquiry with the text, giving each word its “ordinary, contemporary, common meaning.” *Walters v. Metropolitan Ed. Enterprises, Inc.*, 519 U. S. 202, 207 (1997) (internal quotation marks omitted). We do not, however, limit this inquiry to the text of §101 in isolation. “[I]nterpretation of a phrase of uncertain reach is not confined to a single sentence when the text of the whole statute gives instruction as to its meaning.” *Mara-cich v. Spears*, 570 U. S. ___, ___ (2013) (slip op., at 15).

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We thus “look to the provisions of the whole law” to determine §101’s meaning. *United States v. Heirs of Boisdoré*, 8 How. 113, 122 (1849).

1

The statute provides that a “pictorial, graphic, or sculptural featur[e]” incorporated into the “design of a useful article” is eligible for copyright protection if it (1) “can be identified separately from,” and (2) is “capable of existing independently of, the utilitarian aspects of the article.” §101. The first requirement—separate identification—is not onerous. The decisionmaker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities. See 2 Patry §3:146, at 3–474 to 3–475.

The independent-existence requirement is ordinarily more difficult to satisfy. The decisionmaker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article. See 2 OED 88 (def. 5) (defining “[c]apable” of as “[h]aving the needful capacity, power, or fitness for”). In other words, the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in §101 once it is imagined apart from the useful article. If the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.

Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or “[a]n article that is normally a part of a useful article” (which is itself considered a useful article). §101. Nor could someone claim a copyright in a useful article merely by creating a replica of that article in some other medium—for example, a cardboard model of a car. Al-

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though the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.

2

The statute as a whole confirms our interpretation. The Copyright Act provides “the owner of [a] copyright” with the “exclusive righ[t] . . . to reproduce the copyrighted work in copies.” §106(1). The statute clarifies that this right “includes the right to reproduce the [copyrighted] work in or on any kind of article, whether useful or otherwise.” §113(a). Section 101 is, in essence, the mirror image of §113(a). Whereas §113(a) protects a work of authorship first fixed in some tangible medium other than a useful article and subsequently applied to a useful article, §101 protects art first fixed in the medium of a useful article. The two provisions make clear that copyright protection extends to pictorial, graphic, and sculptural works regardless of whether they were created as free-standing art or as features of useful articles. The ultimate separability question, then, is whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article.

3

This interpretation is also consistent with the history of the Copyright Act. In *Mazer*, a case decided under the 1909 Copyright Act, the respondents copyrighted a statuette depicting a dancer. The statuette was intended for use as a lamp base, “with electric wiring, sockets and lamp shades attached.” 347 U. S., at 202. Copies of the statuette were sold both as lamp bases and separately as statuettes. *Id.*, at 203. The petitioners copied the statuette and

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sold lamps with the statuette as the base. They defended against the respondents' infringement suit by arguing that the respondents did not have a copyright in a statuette intended for use as a lamp base. *Id.*, at 204–205.

Two of *Mazer's* holdings are relevant here. First, the Court held that the respondents owned a copyright in the statuette even though it was intended for use as a lamp base. See *id.*, at 214. In doing so, the Court approved the Copyright Office's regulation extending copyright protection to works of art that might also serve a useful purpose. See *ibid.* (approving 37 CFR §202.8(a) (1949) (protecting “works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned”)).

Second, the Court held that it was irrelevant to the copyright inquiry whether the statuette was initially created as a freestanding sculpture or as a lamp base. 347 U. S., at 218–219 (“Nor do we think the subsequent registration of a work of art published as an element in a manufactured article, is a misuse of copyright. This is not different from the registration of a statuette and its later embodiment in an industrial article”). *Mazer* thus interpreted the 1909 Act consistently with the rule discussed above: If a design would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article.

Shortly thereafter, the Copyright Office enacted a regulation implementing the holdings of *Mazer*. See 1 Nimmer §2A.08[B][1][b] (2016). As amended, the regulation introduced the modern separability test to copyright law:

“If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial repre-

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sentation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.” 37 CFR §202.10(c) (1960) (punctuation altered).

Congress essentially lifted the language governing protection for the design of a useful article directly from the post-*Mazer* regulations and placed it into §101 of the 1976 Act. Consistent with *Mazer*, the approach we outline today interprets §§101 and 113 in a way that would afford copyright protection to the statuette in *Mazer* regardless of whether it was first created as a standalone sculptural work or as the base of the lamp. See 347 U. S., at 218–219.

C

In sum, a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.

Applying this test to the surface decorations on the cheerleading uniforms is straightforward. First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium—for example, on a painter’s canvas—they would qualify as “two-dimensional . . . works of . . . art,” §101. And imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself. Indeed, respondents have applied the designs in this case to other media of expression—different types of clothing—without replicating the uniform. See App. 273–279. The decorations are therefore separable from the

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uniforms and eligible for copyright protection.¹

The dissent argues that the designs are not separable because imaginatively removing them from the uniforms and placing them in some other medium of expression—a canvas, for example—would create “pictures of cheerleader uniforms.” *Post*, at 10 (opinion of BREYER, J.). Petitioner similarly argues that the decorations cannot be copyrighted because, even when extracted from the useful article, they retain the outline of a cheerleading uniform. Brief for Petitioner 48–49.

This is not a bar to copyright. Just as two-dimensional fine art corresponds to the shape of the canvas on which it is painted, two-dimensional applied art correlates to the contours of the article on which it is applied. A fresco painted on a wall, ceiling panel, or dome would not lose copyright protection, for example, simply because it was designed to track the dimensions of the surface on which it was painted. Or consider, for example, a design etched or painted on the surface of a guitar. If that entire design is imaginatively removed from the guitar’s surface and placed on an album cover, it would still resemble the shape of a guitar. But the image on the cover does not “replicate” the guitar as a useful article. Rather, the design is a two-dimensional work of art that corresponds to the shape of the useful article to which it was applied. The statute protects that work of art whether it is first drawn on the album cover and then applied to the guitar’s surface, or vice versa. Failing to protect that art would create an anomaly: It would extend protection to two-dimensional designs that cover a part of a useful article but would not protect the same design if it covered the

¹We do not today hold that the surface decorations are copyrightable. We express no opinion on whether these works are sufficiently original to qualify for copyright protection, see *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U. S. 340, 358–359 (1991), or on whether any other prerequisite of a valid copyright has been satisfied.

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entire article. The statute does not support that distinction, nor can it be reconciled with the dissent’s recognition that “artwork printed on a t-shirt” could be protected. *Post*, at 4 (internal quotation marks omitted).

To be clear, the only feature of the cheerleading uniform eligible for a copyright in this case is the two-dimensional work of art fixed in the tangible medium of the uniform fabric. Even if respondents ultimately succeed in establishing a valid copyright in the surface decorations at issue here, respondents have no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear. They may prohibit only the reproduction of the surface designs in any tangible medium of expression—a uniform or otherwise.²

D

Petitioner and the Government raise several objections to the approach we announce today. None is meritorious.

1

Petitioner first argues that our reading of the statute is missing an important step. It contends that a feature may exist independently only if it can stand alone as a copyrightable work *and* if the useful article from which it was extracted would remain equally useful. In other words,

²The dissent suggests that our test would lead to the copyrighting of shovels. *Post*, at 7; Appendix to opinion of BREYER, J., fig. 4, *post*. But a shovel, like a cheerleading uniform, even if displayed in an art gallery, is “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. It therefore cannot be copyrighted. A drawing of a shovel could, of course, be copyrighted. And, if the shovel included any artistic features that could be perceived as art apart from the shovel, and which would qualify as protectable pictorial, graphic, or sculptural works on their own or in another medium, they too could be copyrighted. But a shovel as a shovel cannot.

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copyright extends only to “solely artistic” features of useful articles. Brief for Petitioner 33. According to petitioner, if a feature of a useful article “advance[s] the utility of the article,” *id.*, at 38, then it is categorically beyond the scope of copyright, *id.*, at 33. The designs here are not protected, it argues, because they are necessary to two of the uniforms’ “inherent, essential, or natural functions”—identifying the wearer as a cheerleader and enhancing the wearer’s physical appearance. *Id.*, at 38, 48; Reply Brief 2, 16. Because the uniforms would not be equally useful without the designs, petitioner contends that the designs are inseparable from the “utilitarian aspects” of the uniform. Brief for Petitioner 50.

The Government raises a similar argument, although it reaches a different result. It suggests that the appropriate test is whether the useful article with the artistic feature removed would “remain] *similarly* useful.” Brief for United States as *Amicus Curiae* 29 (emphasis added). In the view of the United States, however, a plain white cheerleading uniform is “similarly useful” to uniforms with respondents’ designs. *Id.*, at 27–28.

The debate over the relative utility of a plain white cheerleading uniform is unnecessary. The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.

Of course, because the removed feature may not be a useful article—as it would then not qualify as a pictorial, graphic, or sculptural work—there necessarily would be some aspects of the original useful article “left behind” if the feature were conceptually removed. But the statute does not require the imagined remainder to be a fully

Opinion of the Court

functioning useful article at all, much less an equally useful one. Indeed, such a requirement would deprive the *Mazer* statuette of protection had it been created first as a lamp base rather than as a statuette. Without the base, the “lamp” would be just a shade, bulb, and wires. The statute does not require that we imagine a nonartistic replacement for the removed feature to determine whether that *feature* is capable of an independent existence.

Petitioner’s argument follows from its flawed view that the statute protects only “solely artistic” features that have no effect whatsoever on a useful article’s utilitarian function. This view is inconsistent with the statutory text. The statute expressly protects two- and three-dimensional “applied art.” §101. “Applied art” is art “employed in the decoration, design, or execution of useful objects,” Webster’s Third New International Dictionary 105 (1976) (emphasis added), or “those arts or crafts that have a *primarily utilitarian function*, or . . . the designs and decorations used in these arts,” Random House Dictionary 73 (1966) (emphasis added); see also 1 OED 576 (2d ed. 1989) (defining “applied” as “[p]ut to practical use”). An artistic feature that would be eligible for copyright protection on its own cannot lose that protection simply because it was first created as a feature of the design of a useful article, even if it makes that article more useful.

Indeed, this has been the rule since *Mazer*. In holding that the statuette was protected, the Court emphasized that the 1909 Act abandoned any “distinctions between purely aesthetic articles and useful works of art.” 347 U. S., at 211. Congress did not enact such a distinction in the 1976 Act. Were we to accept petitioner’s argument that the only protectable features are those that play absolutely no role in an article’s function, we would effectively abrogate the rule of *Mazer* and read “applied art” out of the statute.

Because we reject the view that a useful article must

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remain after the artistic feature has been imaginatively separated from the article, we necessarily abandon the distinction between “physical” and “conceptual” separability, which some courts and commentators have adopted based on the Copyright Act’s legislative history. See H. R. Rep. No. 94–1476, p. 55 (1976). According to this view, a feature is *physically* separable from the underlying useful article if it can “be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact.” Compendium §924.2(A); see also *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F. 3d 324, 329 (CA2 2005). *Conceptual* separability applies if the feature physically could not be removed from the useful article by ordinary means. See Compendium §924.2(B); but see 1 P. Goldstein, *Copyright* §2.5.3, p. 2:77 (3d ed. 2016) (explaining that the lower courts have been unable to agree on a single conceptual separability test); 2 Patry §§3:140–3:144.40 (surveying the various approaches in the lower courts).

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.

2

Petitioner next argues that we should incorporate two “objective” components, Reply Brief 9, into our test to provide guidance to the lower courts: (1) “whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influence,” Brief for Petitioner 34 (emphasis deleted and internal quotation marks omitted), and (2) whether “there is [a] substantial likelihood that the pictorial, graphic, or sculptural feature would still be marketable to some significant segment of the community without its utilitarian function,” *id.*, at 35 (emphasis deleted and internal quota-

Opinion of the Court

tion marks omitted).

We reject this argument because neither consideration is grounded in the text of the statute. The first would require the decisionmaker to consider evidence of the creator’s design methods, purposes, and reasons. *Id.*, at 48. The statute’s text makes clear, however, that our inquiry is limited to how the article and feature are perceived, not how or why they were designed. See *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1152 (CA2 1987) (Winter, J., concurring in part and dissenting in part) (The statute “expressly states that the legal test is how the final article is perceived, not how it was developed through various stages”).

The same is true of marketability. Nothing in the statute suggests that copyrightability depends on market surveys. Moreover, asking whether some segment of the market would be interested in a given work threatens to prize popular art over other forms, or to substitute judicial aesthetic preferences for the policy choices embodied in the Copyright Act. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits”).

3

Finally, petitioner argues that allowing the surface decorations to qualify as a “work of authorship” is inconsistent with Congress’ intent to entirely exclude industrial design from copyright. Petitioner notes that Congress refused to pass a provision that would have provided limited copyright protection for industrial designs, including clothing, when it enacted the 1976 Act, see *id.*, at 9–11 (citing S. 22, Tit. II, 94th Cong., 2d Sess., 122 Cong. Rec. 3856–3859 (1976)), and that it has enacted laws protecting

Opinion of the Court

designs for specific useful articles—semiconductor chips and boat hulls, see 17 U. S. C. §§901–914, 1301–1332—while declining to enact other industrial design statutes, Brief for Petitioner 29, 43. From this history of failed legislation petitioner reasons that Congress intends to channel intellectual property claims for industrial design into design patents. It therefore urges us to approach this question with a presumption against copyrightability. *Id.*, at 27.

We do not share petitioner’s concern. As an initial matter, “[c]ongressional inaction lacks persuasive significance” in most circumstances. *Pension Benefit Guaranty Corporation v. LTV Corp.*, 496 U. S. 633, 650 (1990) (internal quotation marks omitted). Moreover, we have long held that design patent and copyright are not mutually exclusive. See *Mazer*, 347 U. S., at 217. Congress has provided for limited copyright protection for certain features of industrial design, and approaching the statute with presumptive hostility toward protection for industrial design would undermine Congress’ choice. In any event, as explained above, our test does not render the shape, cut, and physical dimensions of the cheerleading uniforms eligible for copyright protection.

III

We hold that an artistic feature of the design of a useful article is eligible for copyright protection if the feature (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 in some other medium if imagined separately from the useful article. Because the designs on the surface of respondents’ cheerleading uniforms in this case satisfy these requirements, the judgment of the Court of Appeals is affirmed.

It is so ordered.

APPENDIX TO OPINION OF THE COURT



Design 299A



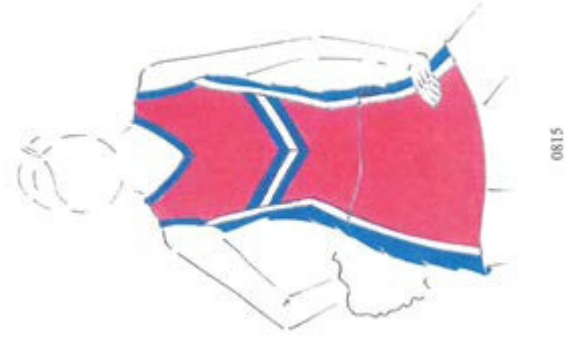
Design 299B



Design 074



Design 078



Design 0815

Cite as: 580 U. S. ____ (2017)

1

GINSBURG, J., concurring in judgment

SUPREME COURT OF THE UNITED STATES

No. 15–866

STAR ATHLETICA, L. L. C., PETITIONER *v.* VARSITY
BRANDS, INC., ET AL.ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE SIXTH CIRCUIT

[March 22, 2017]

JUSTICE GINSBURG, concurring in the judgment.

I concur in the Court’s judgment but not in its opinion. Unlike the majority, I would not take up in this case the separability test appropriate under 17 U. S. C. §101.¹ 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.²

¹Courts “have struggled mightily to formulate a test” for the separability analysis. 799 F. 3d 468, 484 (CA6 2015); see 2 W. Patry, Copyright §3:136, p. 3–420 (2016) (noting “widespread interpretative disarray” over the separability test); Ginsburg, “Courts Have Twisted Themselves into Knots”: U. S. Copyright Protection for Applied Art, 40 Colum. J. L. & Arts 1, 2 (2016) (“The ‘separability’ test . . . has resisted coherent application . . .”); 1 M. Nimmer & D. Nimmer, Copyright §2A.08[B][6], p. 2A–84 (2016) (separability is a “perennially tangled aspect of copyright doctrine”).

²Like the Court, I express no opinion on whether the designs otherwise meet the requirements for copyrightable subject matter. See *ante*, at 11, n. 1; 17 U. S. C. §102(a) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated.”). In view of the dissent’s assertion that Varsity’s designs are “plainly unoriginal,” *post*, at 11, however, I note this Court’s recognition that “the requisite level of creativity [for copyrightability] is extremely low; even a slight amount will suffice,” *Feist Publications, Inc. v. Rural*

GINSBURG, J., concurring in judgment

A pictorial, graphic, or sculptural work (PGS work) is copyrightable. §102(a)(5). PGS works include “two-dimensional and three-dimensional works of fine, graphic, and applied art.” §101. Key to this case, a copyright in a standalone PGS work “includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.” §113(a). Because the owner of a copyright in a pre-existing PGS work may exclude a would-be infringer from reproducing that work on a useful article, there is no need to engage in any separability inquiry to resolve the instant petition.

The designs here in controversy are standalone pictorial and graphic works that respondents Varsity Brands, Inc., et al. (Varsity) reproduce on cheerleading uniforms. Varsity’s designs first appeared as pictorial and graphic works that Varsity’s design team sketched on paper. App. 281. Varsity then sought copyright protection for those two-dimensional designs, not for cheerleading costumes; its registration statements claimed “2-Dimensional artwork” and “fabric design (artwork).” Appendix, *infra*, at 4–7, 9–10, 12–14. Varsity next reproduced its two-dimensional graphic designs on cheerleading uniforms, also on other garments, including T-shirts and jackets. See, e.g., App. 274, 276.³

Telephone Service Co., 499 U. S. 340, 345 (1991); see *Atari Games Corp. v. Oman*, 979 F. 2d 242 (CA DC 1992).

³That Varsity’s designs can be placed on jackets or T-shirts without replicating a cheerleader’s uniform supports their qualification as fabric designs. The dissent acknowledges that fabric designs are copyrightable, but maintains that Varsity’s designs do not count because Varsity’s submissions depict clothing, not fabric designs. *Post*, at 10–11. But registrants claiming copyrightable designs may submit drawings or photos of those designs as they appear on useful articles. See Compendium of U. S. Copyright Office Practices §1506 (3d ed. 2014) (“To register a copyrightable design that has been applied to the back of a useful article, such as a chair, the applicant may submit drawings of the design as it appears on the chair[.]”), online at

GINSBURG, J., concurring in judgment

In short, Varsity’s designs are not themselves useful articles meet for separability determination under §101; they are standalone PGS works that may gain copyright protection as such, including the exclusive right to reproduce the designs on useful articles.⁴

<https://www.copyright.gov/comp3/docs/compendium.pdf> (as last visited Mar. 8, 2017). And, as noted in text, Varsity’s registration statements claimed “2-Dimensional artwork” and “fabric design (artwork).” Appendix, *infra*, at 4–7, 9–10, 12–14.

The dissent also acknowledges that artwork printed on a T-shirt is copyrightable. *Post*, at 4. Varsity’s colored shapes and patterns can be, and indeed are, printed on T-shirts. See, *e.g.*, App. 274. Assuming Varsity’s designs meet the other requirements for copyrightable subject matter, they would fit comfortably within the Copyright Office guidance featured by the dissent. See *post*, at 4 (citing Compendium of U. S. Copyright Office Practices, *supra*, §924.2(B)).

⁴The majority declines to address this route to decision because, it says, Varsity has not advanced it. *Ante*, at 5–6. I read Varsity’s brief differently. See Brief for Respondents 25 (explaining that the Copyright Act “expressly provides that PGS designs do not lose their protection when they appear ‘in or on’ a useful article,” quoting §113(a)); *id.*, at 52 (disclaiming the need for separability analysis because the designs are themselves PGS works).

4 STAR ATHLETICA, L. L. C. v. VARSITY BRANDS, INC.

Appendix to opinion of GINSBURG, J.

APPENDIX

EXHIBIT 15

Certificate of Registration	Form VA
Additional certificate	For a Work of the
(17 U.S.C. 706)	Visual Arts
[Seal of the United States	UNITED STATES
Copyright Office 1870]	COPYRIGHT OFFICE
This Certificate issued	RE VA 1-417-427
under the seal of the	EFFECTIVE DATE
Copyright Office in	OF REGISTRATION
accordance with title 17,	<u>5 21 07</u>
<i>United States Code</i> ,	Month Day Year
attests that registration	Maria A. Pallante
has been made for the	Acting Register of
work identified below.	Copyrights, United
The information on this	States of America
certificate has been made	
a part of the Copyright	
Office records.	

**DO NOT WRITE ABOVE THIS LINE. IF YOU
NEED MORE SPACE, USE A SEPARATE CON-
TINUATION SHEET**

1 Title of This Work	NATURE OF THIS
<u>Design Number 078</u>	WORK See instructions
	<u>2-dimensional artwork</u> ←

Previous or Alternative Titles

Publication as a Contribution If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared. **Title of Collective Work**

Appendix to opinion of GINSBURG, J.

If published in a periodical or serial give:
Volume Number Issue Date On Pages

2 NOTE Under the law the “author” of a “**work made for hire**” is generally the employer, not the employee (see instructions). For any part of this work that was “made for hire” check “Yes” in the space provided, give the employer (or other person for whom the work was prepared) as “Author” of that part, and leave the space for dates of birth and death blank.

a **NAME OF AUTHOR**

Varsity Brands, Inc. _____

DATES OF BIRTH AND DEATH

Year Born _____

Year Died _____

Was this contribution to the work a “work made for hire”? Yes No

Author’s Nationality or Domicile

Name of Country _____

Citizen of _____

or

Domiciled in United States _____

Was this Author’s Contribution to the Work

Anonymous? Yes No

Pseudonymous? Yes No

If the answer to either of these questions is “Yes,” see detailed instructions.

Nature of Authorship Check appropriate box(es)

See Instructions

3-Dimensional sculpture

2-Dimensional artwork



6 STAR ATHLETICA, L. L. C. v. VARSITY BRANDS, INC.

Appendix to opinion of GINSBURG, J.

EXHIBIT 16

<p>Certificate of Registration Additional certificate (17 U.S.C. 706)</p> <p>[Seal of the United States Copyright Office 1870]</p> <p>This Certificate issued under the seal of the Copyright Office in accordance with title 17, <i>United States Code</i>, attests that registration has been made for the work identified below. The infor- mation on this certificate has been made a part of the Copyright Office records.</p> <p>Title _____</p> <p>Title of Work: 0815</p> <p>Nature of Work: 2-dimensional artwork ←</p> <p>Completion/Publication _____</p> <p>Year of Completion: 2007</p> <p>Date of 1st Publication: January 2, 2008</p> <p>Nation of 1st Publication: United States</p> <p>Author _____</p> <p>Author: Varsity Brands, Inc.</p> <p>Author Created: 2-dimensional artwork ←</p> <p>Work made for hire: Yes</p> <p>Domiciled in: United States</p> <p>Anonymous: No</p> <p>Pseudonymous: No</p> <p>Copyright claimant _____</p> <p>Copyright Claimant: Varsity Brands, Inc.</p>	<p>Registration Number: VA 1-675-905</p> <p>Effective date of registration: May 12, 2008</p> <p>Maria A. Pallante Acting Register of Copyrights, United States of America</p>
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Cite as: 580 U. S. ____ (2017)

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Appendix to opinion of GINSBURG, J.

EXHIBIT 17

Certificate of Registration Form VA
 Additional certificate (17 For a Work of the
 U.S.C. 706) Visual Arts
 [Seal of the United States UNITED STATES
 Copyright Office 1870] COPYRIGHT OFFICE
 RE VA 1-319-228
 This Certificate issued EFFECTIVE DATE
 under the seal of the Copy- OF REGISTRATION
 right Office in accordance April 29 2005
 with title 17, *United States* Month Day Year
Code, attests that registra-
 tion has been made for the Maria A. Pallante
 work identified below. The Acting Register of
 information on this certifi- Copyrights, United
 cate has been made a part States of America
 of the Copyright Office
 records.

**DO NOT WRITE ABOVE THIS LINE. IF YOU
 NEED MORE SPACE, USE A SEPARATE CON-
 TINUATION SHEET**

1 Title of This Work	NATURE OF THIS WORK See instructions
<u>299A</u>	<u>FABRIC DESIGN</u> <u>(ARTWORK)</u>



Previous or Alternative Titles

Publication as a Contribution If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared. **Title of Collective Work**

8 STAR ATHLETICA, L. L. C. v. VARSITY BRANDS, INC.

Appendix to opinion of GINSBURG, J.

If published in a periodical or serial give:
Volume Number Issue Date On Pages

2 NOTE Under the law the “author” of a “**work made for hire**” is generally the employer not the employee (see instructions) For any part of this work that was *made for hire* check “Yes” in the space provided, give the employer (or other person for whom the work was prepared) as “Author” of that part and leave the space for dates of birth and death blank.

a **NAME OF AUTHOR**
Varsity Spirit Fashions & Supplies Inc

DATES OF BIRTH AND DEATH

Year Born _____ Year Died _____

Was this contribution to the work a “**work made for hire**”? Yes No

Author’s Nationality or Domicile

Name of Country _____

Citizen of _____

or

Domiciled in United States

Was this Author’s Contribution to the Work

Anonymous? Yes No

Pseudonymous? Yes No

If the answer to either of these questions is “Yes,” see detailed instructions.

Nature of Authorship Check appropriate box(es)
See Instructions

3 Dimensional sculpture

Cite as: 580 U. S. ____ (2017)

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Appendix to opinion of GINSBURG, J.

- 2 Dimensional artwork
 Reproduction of work of art
 Map
 Photograph
 Jewelry design
 Technical drawing
 Text
 Architectural work

**b Name of Author**

Dates of Birth and Death

Year Born _____

Year Died _____

Was this contribution to the work a “work made for hire”? Yes No

Author’s Nationality or Domicile

Name of Country _____

Citizen of _____

or

Domiciled at _____

Was this Author’s Contribution to the WorkAnonymous? Yes NoPseudonymous? Yes No

If the answer to either of these questions is “Yes,” see detailed instructions.

Nature of Authorship Check appropriate box(es)
See Instructions

- 3 Dimensional sculpture


10 STAR ATHLETICA, L. L. C. v. VARSITY BRANDS, INC.

Appendix to opinion of GINSBURG, J.

EXHIBIT 18

Certificate of Registration	Form	VA	
Additional certificate (17	For a Work of the		
U.S.C. 706)	Visual	Arts	
[Seal of the United States	UNITED	STATES	
Copyright Office 1870]	COPYRIGHT OFFICE		
This Certificate issued	RE VA	1-319-226	
under the seal of the Copy-	EFFECTIVE	DATE	
right Office in accordance	OF	REGISTRATION	
with title 17, <i>United States</i>	Month	Day	Year
<i>Code</i> , attests that registra-	<u>April</u>	<u>29</u>	<u>2005</u>
tion has been made for the	Maria A. Pallante		
work identified below. The	Acting Register of		
information on this certifi-	Copyrights, United		
cate has been made a part	States of America		
of the Copyright Office			
records.			

**DO NOT WRITE ABOVE THIS LINE. IF YOU
NEED MORE SPACE, USE A SEPARATE CON-
TINUATION SHEET**

<u>1 Title of This Work</u>	NATURE OF THIS	
<u>299B</u>	WORK	See instructions
	<u>FABRIC DESIGN</u>	
	<u>(ARTWORK)</u>	

Previous or Alternative Titles

Publication as a Contribution If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared.

Cite as: 580 U. S. ____ (2017)

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Appendix to opinion of GINSBURG, J.

Title of Collective Work

If published in a periodical or serial give: **Volume Number Issue Date On Pages**

2 NOTE Under the law the “author” of a “**work made for hire**” is generally the employer not the employee (see Instructions) For any part of this work that was made for hire, check Yes in the space provided, give the employer (or other person for whom the work was prepared) as “Author” of that part and leave the space for dates of birth and death blank.

a **NAME OF AUTHOR**VARSAITY SPIRIT FASHIONS & SUPPLIES INC**DATES OF BIRTH AND DEATH**

Year Born

Year Died

Was this contribution to the work a “work made for hire”? Yes No

Author’s Nationality or Domicile

Name of Country

Citizen of _____

orDomiciled in USA**Was this Author’s Contribution to the Work:**Anonymous? Yes NoPseudonymous? Yes No

If the answer to either of these questions is “Yes,” see detailed instructions.

Nature of Authorship Check appropriate box(es)
See Instructions

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Appendix to opinion of GINSBURG, J.

- 3 Dimensional sculpture
 2 Dimensional artwork
 Reproduction of work of art
 Map
 Photograph
 Jewelry design
 Technical drawing
 Text
 Architectural work



b Name of Author

Dates of Birth and Death

Year Born _____ Year Died _____

Was this contribution to the work a “work made for hire”? Yes No

Author’s Nationality or Domicile

Name of Country _____

Citizen of _____

or

Domiciled in _____

Was this Author’s Contribution to the WorkAnonymous? Yes NoPseudonymous? Yes No

If the answer to either of these questions is “Yes,” see detailed instructions.

Nature of Authorship Check appropriate box(es)**See Instructions**

Cite as: 580 U. S. ____ (2017)

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Appendix to opinion of GINSBURG, J.

AMENDED EXHIBIT 19

Certificate of Registration	Form VA
[Seal of the United States Copyright Office 1870]	For a Work of the Visual Arts
This Certificate issued under the seal of the Copyright Office in accordance with title 17, <i>United States Code</i> ,	UNITED STATES COPYRIGHT OFFICE RE VA 1-411-535 [BARCODE]
attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.	EFFECTIVE DATE OF REGISTRATION <u>May 09 2007</u> Month Day Year
[Marybeth Peters] Register of Copyrights, United States of America	

RATE CONTINUATION SHEET:

1 Title of This Work	NATURE OF THIS
<u>Design Number 074</u>	WORK See instructions
	<u>2-dimensional artwork</u> ←
Previous or Alternative Titles	

Publication as a Contribution If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared. Title of Collective Work

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Appendix to opinion of GINSBURG, J.

If published in a periodical or serial give:
 Volume Number Issue Date On Pages

2 NOTE Under the law the “author” of a “work made for hire” is generally the employer, not the employee (see instructions). For any part of this work that was “made for hire” check “Yes” in the space provided, give the employer (or other person for whom the “work” was prepared) as “Author” of that part and leave the space for dates of birth and death blank

a NAME OF AUTHOR

Varsity Brands, Inc. _____

DATES OF BIRTH AND DEATH

Year Born _____

Year Died _____

Was this contribution to the work a “work made for hire”? Yes No

Author & Nationality or Domicile

Name of Country _____

Citizen of _____

or

Domiciled at United States

Was this Author a Contribution to the Work

Anonymous? Yes NoPseudonymous? Yes No

If the answer to either of these questions is “Yes,” see detailed instructions.

Nature of Authorship Check appropriate box(es)

See Instructions

 3 Dimensional sculpture 2 Dimensional artwork Reproduction of work of art

Cite as: 580 U. S. ____ (2017)

1

BREYER, J., dissenting

SUPREME COURT OF THE UNITED STATES

No. 15–866

STAR ATHLETICA, L. L. C., PETITIONER *v.* VARSITY
BRANDS, INC., ET AL.ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE SIXTH CIRCUIT

[March 22, 2017]

JUSTICE BREYER, with whom JUSTICE KENNEDY joins, dissenting.

I agree with much in the Court’s opinion. But I do not agree that the designs that Varsity Brands, Inc., submitted to the Copyright Office are eligible for copyright protection. Even applying the majority’s test, the designs *cannot* “be perceived as . . . two- or three-dimensional work[s] of art separate from the useful article.” *Ante*, at 1.

Look at the designs that Varsity submitted to the Copyright Office. See Appendix to opinion of the Court, *ante*. You will see only pictures of cheerleader uniforms. And cheerleader uniforms are useful articles. A picture of the relevant design features, whether separately “perceived” on paper or in the imagination, is a picture of, and thereby “replicate[s],” the underlying useful article of which they are a part. *Ante*, at 1, 10. Hence the design features that Varsity seeks to protect are not “capable of existing independently o[f] the utilitarian aspects of the article.” 17 U. S. C. §101.

I

The relevant statutory provision says that the “design of a useful article” is copyrightable “only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from,

BREYER, J., dissenting

and are capable of existing independently of, the utilitarian aspects of the article.” *Ibid.* But what, we must ask, do the words “identified separately” mean? Just when is a design separate from the “utilitarian aspect of the [useful] article?” The most direct, helpful aspect of the Court’s opinion answers this question by stating:

“Nor could someone claim a copyright in a useful article merely by creating a replica of that article in some other medium—for example, a cardboard model of a car. Although the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.” *Ante*, at 7–8.

Exactly so. These words help explain the Court’s statement that a copyrightable work of art must be “perceived as a two- or three-dimensional work of art separate from the useful article.” *Ante*, at 1, 17. They help clarify the concept of separateness. Cf. 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* §2A.08[A][1] (2016) (Nimmer) (describing courts’ difficulty in applying that concept). They are consistent with Congress’ own expressed intent. 17 U. S. C. §101; H. R. Rep. No. 94–1476, pp. 55, 105 (1976) (H. R. Rep.). And they reflect long held views of the Copyright Office. See *Compendium of U. S. Copyright Office Practices* §924.2(B) (3d ed. 2014), online at <http://www.copyright.gov/comp3/docs/compendium.pdf> (as last visited Mar. 7, 2017) (Compendium).

Consider, for example, the explanation that the House Report for the Copyright Act of 1976 provides. It says:

“Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, *physically or conceptually*, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted” H. R. Rep., at 55 (emphasis added).

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These words suggest two exercises, one physical, one mental. Can the design features (the picture, the graphic, the sculpture) be physically removed from the article (and considered separately), all the while leaving the fully functioning utilitarian object in place? If not, can one nonetheless conceive of the design features separately without replicating a picture of the utilitarian object? If the answer to either of these questions is “yes,” then the design is eligible for copyright protection. Otherwise, it is not. The abstract nature of these questions makes them sound difficult to apply. But with the Court’s words in mind, the difficulty tends to disappear.

An example will help. Imagine a lamp with a circular marble base, a vertical 10-inch tall brass rod (containing wires) inserted off center on the base, a light bulb fixture emerging from the top of the brass rod, and a lampshade sitting on top. In front of the brass rod a porcelain Siamese cat sits on the base facing outward. Obviously, the Siamese cat is *physically separate* from the lamp, as it could be easily removed while leaving both cat and lamp intact. And, assuming it otherwise qualifies, the designed cat is eligible for copyright protection.

Now suppose there is no long brass rod; instead the cat sits in the middle of the base and the wires run up through the cat to the bulbs. The cat is not physically separate from the lamp, as the reality of the lamp’s construction is such that an effort to physically separate the cat and lamp will destroy both cat and lamp. The two are integrated into a single functional object, like the similar configuration of the ballet dancer statuettes that formed the lamp bases at issue in *Mazer v. Stein*, 347 U. S. 201 (1954). But we can easily imagine the cat on its own, as did Congress when conceptualizing the ballet dancer. See H. R. Rep., at 55 (the statuette in *Mazer* was “incorporated into a product without losing its ability to exist independently as a work of art”). In doing so, we do not create

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a mental picture of a lamp (or, in the Court’s words, a “replica” of the lamp), which is a useful article. We simply perceive the cat separately, as a small cat figurine that could be a copyrightable design work standing alone that does not replicate the lamp. Hence the cat is *conceptually separate* from the utilitarian article that is the lamp. The pair of lamps pictured at Figures 1 and 2 in the Appendix to this opinion illustrate this principle.

Case law, particularly case law that Congress and the Copyright Office have considered, reflects the same approach. Congress cited examples of copyrightable design works, including “a carving on the back of a chair” and “a floral relief design on silver flatware.” H. R. Rep., at 55. Copyright Office guidance on copyrightable designs in useful articles include “an engraving on a vase,” “[a]rtwork printed on a t-shirt,” “[a] colorful pattern decorating the surface of a shopping bag,” “[a] drawing on the surface of wallpaper,” and “[a] floral relief decorating the handle of a spoon.” Compendium §924.2(B). Courts have found copyrightable matter in a plaster ballet dancer statuette encasing the lamp’s electric cords and forming its base, see *Mazer, supra*, as well as carvings engraved onto furniture, see *Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc.*, 618 F. 3d 417, 431–435 (CA4 2010) (*per curiam*), and designs on laminated floor tiles, see *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F. 3d 1404, 1412–1413 (CA11 2015). See generally Brief for Intellectual Property Professors as *Amici Curiae*.

By way of contrast, Van Gogh’s painting of a pair of old shoes, though beautifully executed and copyrightable as a painting, would not qualify for a shoe design copyright. See Appendix, fig. 3, *infra*; 17 U.S.C. §§113(a)–(b). Courts have similarly denied copyright protection to objects that begin as three-dimensional designs, such as measuring spoons shaped like heart-tipped arrows, *Bonazoli v. R. S. V. P. Int’l, Inc.*, 353 F. Supp. 2d 218, 226–227

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(RI 2005); candleholders shaped like sailboats, *Design Ideas, Ltd. v. Yankee Candle Co.*, 889 F. Supp. 2d 1119, 1128 (CD Ill. 2012); and wire spokes on a wheel cover, *Norris Industries, Inc. v. International Tel. & Tel. Corp.*, 696 F. 2d 918, 922–924 (CA11 1983). None of these designs could qualify for copyright protection that would prevent others from selling spoons, candleholders, or wheel covers with the same design. Why not? Because in each case the design is not separable from the utilitarian aspects of the object to which it relates. The designs cannot be physically separated because they themselves make up the shape of the spoon, candleholders, or wheel covers of which they are a part. And spoons, candleholders, and wheel covers are useful objects, as are the old shoes depicted in Van Gogh’s painting. More importantly, one cannot easily imagine or otherwise conceptualize the design of the spoons or the candleholders or the shoes *without that picture, or image, or replica being a picture of spoons, or candleholders, or wheel covers, or shoes*. The designs necessarily bring along the underlying utilitarian object. Hence each design is not conceptually separable from the physical useful object.

The upshot is that one could copyright the floral design on a soup spoon but one could not copyright the shape of the spoon itself, no matter how beautiful, artistic, or esthetically pleasing that shape might be: A picture of the shape of the spoon is also a picture of a spoon; the picture of a floral design is not. See Compendium §924.2(B).

To repeat: A separable design feature must be “capable of existing independently” of the useful article as a separate artistic work that is not itself the useful article. 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. But if extracting the claimed features would necessarily bring along the underlying useful arti-

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cle, the design is not separable from the useful article. In many or most cases, to decide whether a design or artistic feature of a useful article is conceptually separate from the article itself, it is enough to imagine the feature on its own and ask, “Have I created a picture of a (useful part of a) useful article?” If so, the design is not separable from the useful article. If not, it is.

In referring to imagined pictures and the like, I am not speaking technically. I am simply trying to explain an intuitive idea of what separation is about, as well as how I understand the majority’s opinion. So understood, the opinion puts design copyrights in their rightful place. The law has long recognized that drawings or photographs of real world objects are copyrightable as drawings or photographs, but the copyright does not give protection against others making the underlying useful objects. See, *e.g.*, *Burrow-Giles Lithographic Co. v. Sarony*, 111 U. S. 53 (1884). That is why a copyright on Van Gogh’s painting would prevent others from reproducing that painting, but it would not prevent others from reproducing and selling the comfortable old shoes that the painting depicts. Indeed, the purpose of §113(b) was to ensure that “copyright in a pictorial, graphic, or sculptural work, portraying a useful article as such, does not extend to the manufacture of the useful article itself.” H. R. Rep., at 105.

II

To ask this kind of simple question—does the design picture the useful article?—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. But the question will avoid courts focusing primarily upon what I believe is an unhelpful feature of the inquiry, namely, whether the design can be imagined as a “two- or three-dimensional work of art.” *Ante*, at 1, 17. That is because virtually any indus-

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trial design can be thought of separately as a “work of art”: Just imagine a frame surrounding the design, or its being placed in a gallery. Consider Marcel Duchamp’s “ready-mades” series, the functional mass-produced objects he designated as art. See Appendix, fig. 4, *infra*. What is there in the world that, viewed through an esthetic lens, cannot be seen as a good, bad, or indifferent work of art? What design features could not be imaginatively reproduced on a painter’s canvas? Indeed, great industrial design may well include design that is inseparable from the useful article—where, as Frank Lloyd Wright put it, “form and function are one.” F. Wright, *An Autobiography* 146 (1943) (reprint 2005). Where they are one, the designer may be able to obtain 15 years of protection through a design patent. 35 U. S. C. §§171, 173; see also McKenna & Strandburg, *Progress and Competition in Design*, 17 *Stan. Tech. L. Rev.* 1, 48–51 (2013). But, if they are one, Congress did not intend a century or more of copyright protection.

III

The conceptual approach that I have described reflects Congress’ answer to a problem that is primarily practical and economic. Years ago Lord Macaulay drew attention to the problem when he described copyright in books as a “tax on readers for the purpose of giving a bounty to writers.” 56 *Parl. Deb.* (3d Ser.) (1841) 341, 350. He called attention to the main benefit of copyright protection, which is to provide an incentive to produce copyrightable works and thereby “promote the Progress of Science and useful Arts.” U. S. Const., Art. I, §8, cl. 8. But Macaulay also made clear that copyright protection imposes costs. Those costs include the higher prices that can accompany the grant of a copyright monopoly. They also can include (for those wishing to display, sell, or perform a design, film, work of art, or piece of music, for example) the costs

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of discovering whether there are previous copyrights, of contacting copyright holders, and of securing permission to copy. *Eldred v. Ashcroft*, 537 U. S. 186, 248–252 (2003) (BREYER, J., dissenting). Sometimes, as Thomas Jefferson wrote to James Madison, costs can outweigh “the benefit even of limited monopolies.” Letter from Thomas Jefferson to James Madison (July 31, 1788), in 13 Papers of Thomas Jefferson 443 (J. Boyd ed. 1956) (Jefferson Letter). And that is particularly true in light of the fact that Congress has extended the “limited Times” of protection, U. S. Const., Art. I, §8, cl. 8, from the “14 years” of Jefferson’s day to potentially more than a century today. Jefferson Letter 443; see also *Eldred*, *supra*, at 246–252 (opinion of BREYER, J.).

The Constitution grants Congress primary responsibility for assessing comparative costs and benefits and drawing copyright’s statutory lines. Courts must respect those lines and not grant copyright protection where Congress has decided not to do so. And it is clear that Congress has not extended broad copyright protection to the fashion design industry. See, e.g., 1 Nimmer §2A.08[H][3][c] (describing how Congress rejected proposals for fashion design protection within the 1976 Act and has rejected every proposed bill to this effect since then); *Esquire, Inc. v. Ringer*, 591 F. 2d 796, 800, n. 12 (CA DC 1978) (observing that at the time of the 1976 Copyright Act, Congress had rejected every one of the approximately 70 design protection bills that had been introduced since 1914); e.g., H. R. 5055, 109th Cong., 2d Sess.: “To Amend title 17, United States Code, to provide protection for fashion design” (introduced Mar. 30, 2006; unenacted). Congress has left “statutory . . . protection . . . largely unavailable for dress designs.” 1 Nimmer §2A.08[H][3][a]; Raustiala & Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 Va. L. Rev. 1687, 1698–1705 (2006).

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Congress' decision not to grant full copyright protection to the fashion industry has not left the industry without protection. Patent design protection is available. 35 U. S. C. §§171, 173. A maker of clothing can obtain trademark protection under the Lanham Act for signature features of the clothing. 15 U. S. C. §1051 *et seq.* And a designer who creates an original textile design can receive copyright protection for that pattern as placed, for example, on a bolt of cloth, or anything made with that cloth. *E.g.*, Compendium §924.3(A)(1). “[T]his [type of] claim . . . is generally made by the fabric producer rather than the garment or costume designer,” and is “ordinarily made when the two-dimensional design is applied to the textile fabric and before the garment is cut from the fabric.” 56 Fed. Reg. 56531 (1991).

The fashion industry has thrived against this backdrop, and designers have contributed immeasurably to artistic and personal self-expression through clothing. But a decision by this Court to grant protection to the design of a garment would grant the designer protection that Congress refused to provide. It would risk increased prices and unforeseeable disruption in the clothing industry, which in the United States alone encompasses nearly \$370 billion in annual spending and 1.8 million jobs. Brief for Council of Fashion Designers of America, Inc., as *Amicus Curiae* 3–4 (citing U. S. Congress, Joint Economic Committee, *The New Economy of Fashion* 1 (2016)). That is why I believe it important to emphasize those parts of the Court's opinion that limit the scope of its interpretation. That language, as I have said, makes clear that one may not “claim a copyright in a useful article merely by creating a replica of that article in some other medium,” which “would not give rise to any rights in the useful article that inspired it.” *Ante*, at 7–8.

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IV

If we ask the “separateness” question correctly, the answer here is not difficult to find. The majority’s opinion, in its appendix, depicts the cheerleader dress designs that Varsity submitted to the Copyright Office. Can the design features in Varsity’s pictures exist separately from the utilitarian aspects of a dress? Can we extract those features as copyrightable design works standing alone, without bringing along, via picture or design, the dresses of which they constitute a part?

Consider designs 074, 078, and 0815. They certainly look like cheerleader uniforms. That is to say, they look like pictures of cheerleader uniforms, just like Van Gogh’s old shoes look like shoes. I do not see how one could see them otherwise. Designs 299A and 2999B present slightly closer questions. They omit some of the dresslike context that the other designs possess. But the necklines, the sleeves, and the cut of the skirt suggest that they too are pictures of dresses. Looking at all five of Varsity’s pictures, I do not see how one could conceptualize the design features in a way that does not picture, not just artistic designs, but dresses as well.

Were I to accept the majority’s invitation to “imaginatively remov[e]” the chevrons and stripes *as they are arranged* on the neckline, waistline, sleeves, and skirt of each uniform, and apply them on a “painter’s canvas,” *ante*, at 10, that painting would be of a cheerleader’s dress. The esthetic elements on which Varsity seeks protection exist only as part of the uniform design—there is nothing to separate out but for dress-shaped lines that replicate the cut and style of the uniforms. Hence, each design is not physically separate, nor is it conceptually separate, from the useful article it depicts, namely, a cheerleader’s dress. They cannot be copyrighted.

Varsity, of course, could have sought a design patent for its designs. Or, it could have sought a copyright on a

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textile design, even one with a similar theme of chevrons and lines.

But that is not the nature of Varsity’s copyright claim. It has instead claimed ownership of the particular “treatment and arrangement” of the chevrons and lines of the design as they appear at the neckline, waist, skirt, sleeves, and overall cut of each uniform. Brief for Respondents 50. The majority imagines that Varsity submitted something different—that is, only the surface decorations of chevrons and stripes, as in a textile design. As the majority sees it, Varsity’s copyright claim would be the same had it submitted a plain rectangular space depicting chevrons and stripes, like swaths from a bolt of fabric. But considered on their own, the simple stripes are plainly unoriginal. Varsity, then, seeks to do indirectly what it cannot do directly: bring along the design and cut of the dresses by seeking to protect surface decorations whose “treatment and arrangement” are *coextensive with that design and cut*. As Varsity would have it, it would prevent its competitors from making useful three-dimensional cheerleader uniforms by submitting plainly unoriginal chevrons and stripes as cut and arranged on a useful article. But with that cut and arrangement, the resulting pictures on which Varsity seeks protection do not simply depict designs. They depict clothing. They depict the useful articles of which the designs are inextricable parts. And Varsity cannot obtain copyright protection that would give them the power to prevent others from making those useful uniforms, any more than Van Gogh can copyright comfortable old shoes by painting their likeness.

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, 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,” such as in a

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picture. *Ante*, at 7. That is to say, one cannot obtain a copyright that would give its holder “any rights in the useful article that inspired it.” *Ante*, at 8.

With respect, I dissent.

APPENDIX TO OPINION OF BREYER, J.

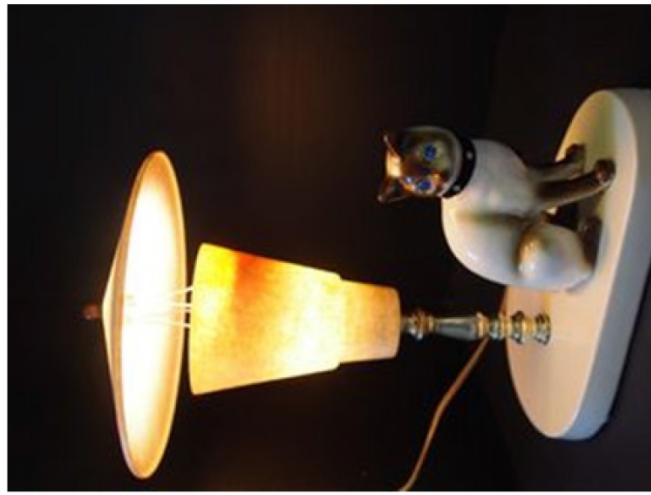


Fig. 1



Fig. 2

APPENDIX TO OPINION OF BREYER, J.



Fig. 3: Vincent Van Gogh, "Shoes"

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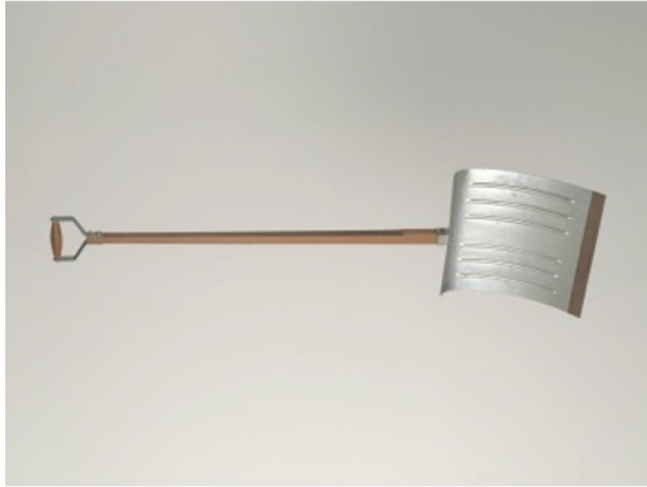


Fig. 4: Marcel Duchamp, "In Advance of the Broken Arm"