FOREWORD

CLARIFYING THE "CLEAR MEANING" OF SEPARABILITY

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Speaking of the Copyright Act of 1909, noted copyright scholar Benjamin Kaplan had this to say about the role of judges therein:

> [T]he statute, like its predecessors, leaves the development of fundamentals to the judges. Indeed the courts have had to be consulted at nearly every point, for the text of the statute has a maddeningly casual prolixity and imprecision throughout. . . .
>
> Judges, however, who in recent times have inclined against brutality, have run the risk of appearing slightly ridiculous in their tortuous interpretations.[1]

The Copyright Act of 1976 was designed to avoid this imprecision and overt reliance on judicial creativity.[2] Supposedly comprehensive in its coverage, and the result of delicate compromises, its provisions were crafted to avoid the problems that had brought its predecessors into disrepute.[3]

Nevertheless, an examination of the Supreme Court's recent copyright jurisprudence—most of which has involved its *interpreting* the statute's directives[4]—leaves one with the impression that the Act has had little success in

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1 BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 40-41, 81 (1967).

2 *See* Melville B. Nimmer, *Preface to the 1978 Comprehensive Treatise Revision*, *in* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (Matthew Bender, Rev. Ed. 2017) (noting how the new Act was a "departure from the flexibility and pristine simplicity of a corpus of judge-made copyright law" and that it "has now been replaced with a body of detailed rules reminiscent of the Internal Revenue Code").

3 *See* Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 859 (1987) (describing the Act as a "detailed comprehensive code, chock-full of specific, heavily negotiated compromises").

4 *See, e.g.*, Am. Broad. Cos., Inc. v. Aereo, Inc., 134 S. Ct. 2498 (2014) (interpreting the definition of a "public performance" in § 101 of the Act); Petrella v. Metro-Goldwyn-Mayer, Inc.,

achieving its objectives of textual clarity and precision. And the Court for its part, has played an important role in supplementing the statute with its decisions, in an effort to offer litigants and lower courts operating in the area sufficient direction.[5]

All the same, the Court's copyright jurisprudence, self-styled for the most part as an interpretive exercise, is not without its own significant shortcomings. In an effort to interpret the statute (and its accompanying legislative intent), the Court's holdings are often themselves the source of immense ambiguity, which has only served to further compound the underlying problem of textual imprecision. Leaving aside the theoretical problems with the ambiguities in the Court's jurisprudence, these decisions have done little to produce a nationally "uniform" copyright jurisprudence, one of the motivating goals of the 1976 copyright regime.[6] Laudable as the Court's foray into squelching the imprecision of the statute may have been, its copyright jurisprudence has unfortunately begun to entrench an additional layer of interpretive ambiguity and confusion. And in the last two decades, only *once* has the Court directly revisited the ambiguity generated by its own decision,[7] meaning that much of the uncertainty has fallen to lower courts and litigants to resolve in their everyday application and invocation of copyright law.

The Court's foray into the protectability criteria for "designs of useful articles" under the Act represents its most recent effort in this direction.[8] Called upon to examine the circumstances under which a design embodies "pictorial, graphic, or sculptural features" that are *separable* from the useful aspects of the design,[9] the Court entered into murky waters characterized by nine plausible alternatives to choose from(!).[10] The Court's solution was to

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134 S. Ct. 1962 (2014) (interpreting the statute of limitations provision contained in § 507(b) of the Act); Kirtsaeng v. John Wiley & Sons, Inc., 133 S. Ct. 1351 (2013) (interpreting the first sale doctrine as applied to importations under § 109(a) of the Act); Reed Elsevier, Inc. v. Muchnick, 130 S. Ct. 1237 (2010) (interpreting the terms of § 411(a) to assess whether its requirements are jurisdictional); N. Y. Times Co. v. Tasini, 533 U.S. 483 (2001) (interpreting § 201(c) of the Act to determine the rights of contributors to a collective work); Feltner v. Columbia Pictures Television, Inc., 523 U.S. 340 (1998) (interpreting § 504(c) of the Act relating to the use of juries in infringements claims involving statutory damages).

5 *See supra* note 4.

6 *See* H.R. REP. NO. 94-1476, at 129 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5745 ("By substituting a single Federal system for the present anachronistic, uncertain, impractical, and highly complicated dual system, the bill would greatly improve the operation of the copyright law and would be much more effective in carrying out the basic constitutional aims of uniformity and the promotion of writing and scholarship.").

7 Kirtsaeng v. John Wiley & Sons, Inc., 136 S. Ct. 1979, 1985 (2016) (revisiting its interpretation of § 505 of the Act from the case of *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994), and "seeing a need for some additional guidance").

8 Star Athletica, LLC v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017).

9 17 U.S.C. § 101 (2012) (defining "pictorial, graphic, or sculptural work").

10 *See* Varsity Brands, Inc. v. Star Athletica, LLC, 799 F.3d 468, 484-85 (6th Cir. 2015).

offer its own reading of the statute, and with it an altogether new test for the question—one that none of the lower courts had previously adopted.

While prior efforts to understand the test of separability had self-consciously engaged the policy goals of the copyright regime and related factors,[11] the Court's majority opinion in *Star Athletica* took an altogether different tack. Announcing that the matter had to be resolved without a "free-ranging search for the best copyright policy,"[12] it made clear that the issue was "solely" a matter of "statutory interpretation,"[13] where the Court had to give effect to "the clear meaning of [the] statute[] as written."[14] And from there, Justice Thomas, the author of the majority opinion, proceeded to derive the Court's test as though it flowed seamlessly from the words of the statute in self-evident terms: first, "look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities," and second, "determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article."[15] Simple enough. With its new test, the Court also jettisoned the distinction between "physical" and "conceptual" separability, a distinction that most lower courts had used, relying on the legislative history accompanying the statute.[16] To the Court, since the "text of the statute" made no reference to this distinction, it was altogether irrelevant regardless of what the legislative history said.[17]

Thus, in one fell swoop the Court undid the jurisprudence of separability that courts around the country had developed in common law fashion over the last four decades, all in the name of interpreting the clear and plain textual meaning of the statute. Of course, the Court didn't stop there, but proceeded to apply its own test to the rather uncomplicated set of facts in the case before it, only to conclude that the test had indeed been satisfied.[18] While the Court's seemingly straightforward test was tailor-made for the unduly simple set of facts that had motivated the case before it, a point that the concurring opinion of Justice

11 *See, e.g.*, Pivot Point Int'l, Inc. v. Charlene Prods., Inc., 372 F.3d 913, 930 (5th Cir. 2004) (noting how "cases exhibit a progressive attempt to forge a workable judicial approach capable of giving meaning to the basic Congressional policy decision to distinguish applied art from uncopyrightable industrial art or design"); Brandir Int'l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1142-45 (2d Cir. 1987).

12 *Star Athletica*, 137 S. Ct. at 1010.

13 *Id.* (quoting Mazer v. Stein, 347 U.S. 201, 214 (1954)).

14 *Id.* (quoting Estate of Cowart v. Nicklos Drilling Co., 505 U.S. 469, 476, (1992)).

15 *Id.*

16 *See id.* at 1014 ("Because we reject the view that a useful article must remain after the artistic feature has been imaginatively separated from the article, we necessarily abandon the distinction between 'physical' and 'conceptual' separability.").

17 *Id.* at 1015.

18 *Id.* at 1012-13.

Ginsburg emphasized,[19] the majority opinion spent little time thinking through how its test might apply to future—and more complicated—scenarios. It therefore did scantily little to *guide* courts and litigants on future applications and extensions of its clear meaning approach to separability. Much like its other copyright opinions, the Court's ruling is therefore likely to put significant pressure on lower courts to understand, apply, extend, and "interpret" its holding for future circumstances.

It is with this recognition that the *University of Pennsylvania Law Review Online* invited a renowned group of copyright and intellectual property scholars to reflect on the Court's reasoning in the opinion. The objective at hand was not to provide an academic/theoretical commentary on the Court's test and holding, but instead to assess the practical import of the opinion across a range of questions and dimensions, unique to each author's interests and expertise. Put simply, the goal here was to *translate*, *guide*, and *clarify* the content of the Court's opinion in *Star Athletica* for courts, and future litigants.

This Online Symposium is the first in a series of similar efforts that will endeavor to capitalize on the *Law Review*'s online presence to produce timely and relatively short commentary on prominent Court opinions and legal topics in order to aid the legal profession. As such, it represents an intervention in the domain of what Judge Harry Edwards termed "practical scholarship,"[20] an idea that others have further developed.[21] The effort endeavors to provide timely scholarship that will be of "particular help" and "interest to the members of the practice of the bar or judges."[22]

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19 *See id.* at 1018-19 (Ginsburg, J., concurring) ("The designs here in controversy are standalone pictorial and graphic works that respondents [Varsity] reproduce on cheerleading uniforms.").

20 Harry T. Edwards, *The Growing Disjunction Between Legal Education and the Legal Profession*, 91 MICH. L. REV. 34, 42-43 (1992) (internal quotations omitted) (lamenting the decline of practical legal scholarship and providing an understanding of the idea).

21 For a recent account, see RICHARD A. POSNER, DIVERGENT PATHS: THE ACADEMY AND THE Judiciary 261 (2016) who devotes a section of his book "to constructive suggestions aimed at law schools and law professors, beginning . . . with thoughts on how legal scholarship might better contribute to the improvement of the judiciary."

22 *See A Conversation with Chief Justice Roberts, Fourth Circuit Court of Appeals Annual Conference*, C-SPAN (June 25, 2011), https://www.c-span.org/video/?300203-1/conversation-chief-justice-roberts [http://perma.cc/5Y2W-ZLN4].