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Copyright On the Bubble

By Robert W. Clarida and Thomas Kjellberg

"ON THE BUBBLE:
In a state of uncertainty between two possible outcomes. This phrase is often used in reference to sports teams." www.idioms.thefreedictionary.com

With the Stanley Cup just around the corner, this month's column deals with a recent case from the Eastern District of Pennsylvania, *Grondin v. Fanatics, Inc.,* 2023 U.S. Dist. LEXIS 65897 (E.D. Pa. Apr. 14. 2023), which involves an item of hockey memorabilia called "Slice of the Ice," a "Lucite sculpture in the approximate shape of the Stanley Cup, with a hockey puck–shaped piece in the center filled with melted ice gathered from the rink used in a prominent hockey game." The plaintiff in *Grondin* alleged that defendant's competing puck-shaped, water-filled hockey memento infringed his registered copyright in "Slice of the Ice." In January, the Court dismissed a first amended complaint with leave to replead, because plaintiff failed to identify a "non-utilitarian, non-commonplace feature of the puck-shaped cavity." Plaintiff filed a Second Amended Complaint, alleging in paragraph 22 that the cavity in defendant's item contained the same amount of water as did his Lucite puck, "such that shifting the position of the puck yields the same wave motion of the water inside." Defendant again moved to dismiss, and on April 14 the Court granted that motion with prejudice.

Applying Third Circuit law, the Court noted that commonplace elements that are inherent to the idea being expressed may not give rise to a finding of infringement. Here, because hockey pucks are a commonplace feature of hockey, the puck shape "flows predictably from the general idea of making a piece of hockey memorabilia," and is not sufficient to support an inference of material appropriation. The Court also held that the transparency and hollowness of the "Slice of

the Ice" puck are unprotectable because they are utilitarian: the puck must be hollow in order to contain water, and must be transparent "to realize the idea of a puck containing visible melted ice." The Court's analysis then turned to whether the *amount* of water inside the parties' respective pucks is or is not utilitarian; defendant argued that it was necessary to leave some air in the puck to convey the idea that it contains water. Plaintiff disagreed, contending that the presence of water inside the puck could be conveyed without leaving any air space, because water refracts and absorbs light. For the Court, however, the parties were both wrong. Citing *Silvertop Associates Inc. v. Kangaroo Manufacturing Inc.*, 931 F.3d 215 (3d Cir. 2019), the Court framed the issue differently:

> The parties' disagreement hinges on whether having an air bubble inside a puck is necessary to realize the idea of a hockey puck filled with water, or whether this idea could be conveyed by some other means—i.e., a completely filled puck or a puck containing a greater or lesser amount of water. But whether a particular feature of a work is utilitarian depends on whether it is *useful*, not whether it is indispensable.

(emphasis original)

In *Silvertop,* the Third Circuit had addressed an infringement claim involving a full-body banana costume, in which plaintiff asserted *inter alia* that the placement of holes for the wearer's arms, legs and face was not utilitarian because alternative placements were possible, and such different placements would alter the aesthetic effect of the costume. The Third Circuit found that the placement of the holes was utilitarian, whether or not the "utilitarian aims could have been achieved by different means, or even that these different means might produce different aesthetic consequences for the wearer. What mattered was only that the holes served the utilitarian purpose of wearability and the fact that any aesthetic differences bore only on that same wearability purpose."

Applying *Silvertop* to "Slice of the Ice," the *Grondin* Court concluded that

> Placing an air bubble in a water-filled hockey puck serves the utilitarian feature of making the water inside visible. That same utilitarian purpose might be achieved using larger or smaller air bubbles, and these different proportions of water and air might produce different aesthetic consequences, such as the wave pattern created when a puck is shifted. But those aesthetic differences, like the different holes in a banana costume, have no artistic aspect except in relation to conveying that there is water inside the puck. It is also irrelevant that the puck's utilitarian purpose might be achieved through a means other than an air bubble, such as a completely-filled puck that refracts and absorbs light. The face hole in *Silvertop* was utilitarian because it was useful to make the suit wearable, not because it was the *only* way to achieve that goal.

Grondin at *7 (emphasis original).

Grondin's reliance on *Silvertop* is arguably misplaced, however, because *Silvertop* concerned a wearable costume, which courts have long recognized as a form of "useful article," as that term is defined in the Copyright Act: "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." The utilitarian function of any costume, as with any article of clothing, is to cover the wearer. *See Silvertop* at 221 (defining "wearability" as the "non-appearance related utility" of the costume). *Silvertop's* analysis thus explicitly relied on the Supreme Court's most recent ruling on useful articles, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 137 S. Ct. 1002 (2017), and turned on the degree to which the graphic or sculptural features of the plaintiff's work were conceptually separable from its utilitarian function, *i.e.*, wearability.

Grondin makes no mention of *Star Athletica* or the separability doctrine, nor does it consider whether "Slice of the Ice" is a "useful article" under the statutory definition. It almost certainly is not, because it has no discernable function other than to "portray the appearance of the article or to convey information." The Court at *7 equates the aesthetic differences caused by various-sized air bubbles in *Grondin* with those caused by the differently-placed holes in the *Silvertop* costume, but there is a significant difference: the holes in the banana costume served a

utilitarian purpose, as the statute defines it, but the air bubble in "Slice of the Ice" does not. The Court concluded that Grondin's bubble has "no artistic aspect except in relation to conveying that there is water inside the puck" – but "conveying" that information is *not* a utilitarian purpose that warrants the same analysis the Third Circuit applied in *Silvertop*. In other words, the *Grondin* court analyzed "Slice of the Ice" as if it had a function other than to look the way it looks and convey information, but it doesn't. It is a sculptural object. Like any sculpture, it might make a useful paperweight, but the puck shape, the Lucite, the water, and the air bubble would all appear to be separable from that function.

Perhaps aware that it was on thin statutory ice with this broad notion of "utilitarian purpose," the *Grondin* Court concluded that even if the air bubble were deemed non-utilitarian, the plaintiff could not establish infringement because no reasonable jury could find substantial similarity between the works in their entireties based on such a *de minimis* similarity. Due to the small size of a hockey puck and the limited range of possible air bubble sizes, the Court found that a lay observer would be unlikely to detect that the air quantity and wave effect were the same. As to the qualitative value of this feature, the Court found no evidence indicating that the air bubble was significant in the plaintiff's work, noting that "neither the volume of the air bubble nor the wave pattern it produces are detailed in the registration of Mr. Grondin's work." Consequently, the court dismissed the plaintiff's claim for infringement, and because plaintiff had already been given an opportunity to rectify the defects in his earlier pleadings, the Court concluded that further amendment would be futile.

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