

**IN SUMMARY**

- Existing copyright protections for fashion designs are in many ways stronger than the copyright bill introduced by the US House of Representatives last year, which is just as well considering that Congress ended without a vote on the bill
- However, while designers have had some success in protecting key elements of designs, the current available IP laws have failed to protect fashion designers from wholesale “knock-off” copies



# In vogue

 *IP protection for fashion design*

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**Lisa Pearson, Lauren Estrin and Ling Zhong of Kilpatrick Stockton LLP discuss the existing pockets of protection for fashion design in the US and examine the additional protection that would be afforded by the Design Piracy Protection Act...if it ever passes Congress**

**F**ashion has been characterized as a low intellectual property protection regime. A copyright bill introduced in the US House of Representatives in March 2006, the Design Piracy Protection Act (“DPPA”), attempted to fill this void by providing limited copyright protection for fashion designs. Yet there are already a number of pockets of intellectual property protection available to fashion designers under US law, and creative fashion

designers – and their creative lawyers – have found ways to use them to their advantage. In some cases, these existing protections are far stronger and provide a longer period of protection than the copyright bill.

The three primary forms of intellectual property protection in the US are copyright, patent, and trademark. Different elements of fashion design may be protected under each system.

**Copyright**

US copyright law protects certain “original works of authorship fixed in any tangible medium of expression.”<sup>1</sup> Section 102 of the Copyright Act lists those works that are currently eligible for copyright protection, which include, *inter alia*, “pictorial, graphic, and sculptural works.”<sup>2</sup> Copyrightable works of “visual art,” as this category

However, the copyright protection available to works of visual art is subject to an important limitation. If a work is considered a “useful article” (defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”<sup>3</sup>), protection is limited to the aesthetic features of the work to the extent

*article of clothing for swimming or any other utilitarian purpose. We are also unable to determine merely by looking at Poe’s creation whether a person wearing this object can move, walk, swim, sit, stand, or lie down without unwelcome or unintended exposure.”<sup>8</sup>*



Album cover displaying Acquaint No. 5, bathing suit at issue in *Poe v. Missing Persons*

that these features can be separated from the work’s utilitarian function.<sup>6</sup> Unfortunately for fashion designers, clothing and fashion accessories are prototypical useful articles. This carve-out may lead to the anomalous result that a fashion sketch is copyrightable, but the highly original garment it depicts is not.

Of course, the lines between art and utilitarian articles are not immutable; Meret Oppenheim’s

While it is tempting to conclude that US copyright law only protects fashion that has no commercial viability – the unwearable extremes of couture runways and artwear galleries – certain components of fashion design are clearly protectible under existing copyright law. For example, an original Pucci or Liberty of London print is copyrightable. Original artwork on a graphic t-shirt is copyrightable. So too is a sculptural element, such as a Barry Kieselstein-Cord belt buckle.<sup>9</sup>

**Trademark**

US trademark and unfair competition law – including, appropriately enough, the protection available for so-called “trade dress” – protects much more than brand names. Under the Lanham Act, federal law protects “any word, name, symbol, or device, or any combination thereof” that is used in commerce to identify the source of goods or services.<sup>10</sup> The Act also protects

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is often referred, covers protectable fashion designs.

If a work is copyrightable under the existing law, the copyright owner has the right to copy, adapt, distribute, and display the work publicly.<sup>3</sup> Although not required for protection, acquiring a copyright registration from the US Copyright Office is a relatively straightforward process, involving submitting a simple application and copies of the work with the Copyright Office and paying a nominal fee.

The ease and generally inexpensive process of seeking copyright protection makes this an attractive option for many fashion designers. Further, the duration of copyright protection is quite long: for works created after January 1, 1978, a copyright subsists for 70 years after the author’s death, and for 100 years after the date of creation of a work made for hire.<sup>4</sup>

fur-covered teacup and Marcel Duchamp’s signed urinal are generally recognized as art, notwithstanding their detractors. By the same token, fashion can and does cross the line into art. The US Copyright Office and courts are undoubtedly not the best arbiters of the age old question “What is art?” In *Poe v. Missing Persons*,<sup>7</sup> for example, the plaintiff, an artist and fashion designer, argued that a clear plastic bikini filled with crushed rock, which had been shown at the Los Angeles Museum of Contemporary Art, was conceptual art, not a swimsuit. The Court of Appeals remanded the case for trial, saying:

*“nothing in our legal training qualifies us to determine whether [the work] Acquaint No. 5 can be worn as an*

“trade dress,” that is, product designs and the overall appearance of certain products or services that serve to identify their source. The Lacoste crocodile, Louis Vuitton insignia and Chanel interlocking CC buttons are just some examples of elements of fashion designs that enjoy trademark protection.

The Lanham Act provides a wide scope of protection to names, logos, and other insignia that many designers put on clothing and accessories, and can protect other elements of fashion design as well. For protection, an owner must prove that a mark or trade dress is “distinctive” and identifies the source of the goods or services.<sup>11</sup> A designer seeking trademark protection for a fashion design itself must

also prove that its design is non-functional under recent US Supreme Court decisions.<sup>12</sup> The standard test for infringement asks whether there is a likelihood that ordinary consumers in the marketplace would be confused by an allegedly infringing use.<sup>13</sup>

Although a trademark owner need not register a mark for protection, there are substantial evidentiary benefits that flow from a federal registration.<sup>14</sup> Unlike copyright or patent protection, which endures for a limited term, trademark protection can last indefinitely; trademark rights exist as long as the mark or design is being used in commerce to designate the source of the good or service.

Many designers are challenging the current boundaries of trademark law protection, seeking protection over non-traditional components of their designs. Levi Strauss vigorously enforces the trademark rights it has established in the tab and stitching designs on the rear pockets of its jeans. Adidas similarly fights others who come too close to its three-stripe design. Perhaps taking a cue from Levi Strauss, The North Face recently applied for a US trademark registration seeking trademark rights in the unique placement of its logo on the back shoulder of its jackets and tops, and Dooney & Burke has sought and registered a US trademark for the “relative position” of its logo “in the middle section of the side panel” of its handbags.

Since the Supreme Court opened the door to trade dress protection over color, (subject to proving secondary meaning),<sup>15</sup> many registrants have included color elements in their trade dress applications. For example, Burberry owns a registered trademark for its signature “red, brown, gray, black, and white plaid pattern,” which covers, *inter alia*, handbags and clothing.<sup>16</sup>

Fashion designers have led the fight against trademark counterfeiting, individually and collectively; indeed, Harper’s Bazaar now sponsors an annual anti-counterfeiting summit to stop fashion fakes. But for those designers who employ recurring “signature” elements in their designs, trademark and unfair competition law can also be a powerful weapon against other, less egregious forms of knocking off.

**Patents**

Fashion designers may also be able to take advantage of the patent laws, and not just for miracle fibers such as Gore-Tex® and Lycra®. More than a century ago, Levi

Strauss obtained a utility patent for “Improvement in Fastening Pocket-Openings,” which gave it a monopoly over riveted pants pockets for almost two decades.<sup>17</sup> Shoe designers running the gamut from Jimmy Choo to Nike frequently obtain design patents to ward off copycats. L.A. Gear has sued numerous defendants, including popular stores such as Wal-Mart and Montgomery Ward, for infringement of its patent for light-up athletic shoes.<sup>18</sup>

The US patent law grants inventors a limited monopoly over their “discoveries” by giving patent owners the *exclusive* right to manufacture, use, and sell their inventions. There are two categories of patents: utility patents, which last for a term of 20 years, and design patents, which last for a term of 14 years.<sup>19</sup> Utility patents generally protect processes, products, machines, and articles of manufacture,<sup>20</sup> and have three general prerequisites: 1) usefulness, which requires that the invention is functional, 2) novelty, which means that the invention is new and different from prior art,<sup>21</sup> and 3) non-obviousness, which means that, considering what has been done before in the same area, the invention is not an obvious development or improvement on something that already exists.<sup>22</sup> If these prerequisites are met, the invention is then disclosed in a patent that contains a written description of the invention called “claims.”

Fashion designers can take advantage of utility patents to protect functional features related to fashion designs (such as garment materials, fabric finishing methods and garment dyeing processes) and the underlying technology of various designs. However, utility patent protection is not

generally available to protect the overall outward appearance of a design.

In contrast, design patents protect the appearance of products, specifically the non-functional elements of an “ornamental design.”<sup>23</sup> In addition to the novelty and non-obvious prerequisites of utility patents, the US Patent Act requires that the design “serve a primarily ornamental



Levi Strauss – Utility Patent for “Fastening Pocket-Openings”

purpose.”<sup>24</sup> A design may include some functional elements, as long as “the appearance of the claimed design is ‘dictated by’ the use or purpose of the article.”<sup>25</sup>

Many fashion designers have obtained design patents to protect the appearance of fabric, dresses or garments, handbags, watches, eyeglass frames and shoes. For example, Burberry has obtained a design patent for a trench coat, Gucci for its signature GG fabric design, and Christian Dior for its popular saddle bags.

Although the patent laws offer strong protection, the lengthy and expensive application process limits their usefulness for many fashion designers. By the time a designer navigates the application process, which is costly and can take several years,



Burberry – U.S. Utility Patent No. 5,669,072 for coat construction

the popularity of the design itself may have become fashion history.

**The proposed legislation**

Missing from the mix of the available forms of US intellectual property protection for fashion is a clear-cut remedy for a line-by-line knock-off of a new and original fashion design. In other contexts courts routinely find infringement where someone “rides on another’s coat-tails” or “reaps where he has not sown” – to use two hackneyed phrases from the decisions. In contrast, many in the fashion industry have built entire businesses on copying the latest runway fashions and selling them at a fraction of their original price. ABS by Allan Schwartz and Joel Paris of anyknockoff.com, among others, make no bones about it; to the contrary, they tout it.

As mentioned earlier, in response to cries from the fashion world, the Design Piracy Protection Act (“DPPA”), a bill proposing amendments to the US Copyright Act to protect fashion design, was presented to the House Judicial Committee last year. The

DPPA would grant limited protection to specified fashion designs under a *sui generis* provision of the Copyright Act that currently protects the designs of boat hulls.<sup>26</sup> The DPPA would extend the “boat hull” provision, which protects “the original design of a useful article which makes the article attractive or distinctive in appearance,” to protect fashion designs – specifically, i) clothing, including undergarments, outerwear, gloves, footwear, and headgear; ii) handbags, purses, and tote bags; iii) belts; and iv) eyeglass frames.<sup>27</sup>

The Council of Fashion Designers of America (“CFDA”), a non-profit trade group, and many prominent designers lobbying for the bill point to widespread, unregulated copying in the US and the need to bring US copyright law more in line with the European Union and Japan, which afford copyright protection to fashion designs.<sup>28</sup> Critics of the DPPA question whether copyright protection provides a workable system, given the constantly changing fashion milieu.

Because of the historical antipathy to protecting “useful articles” under the US copyright and trademark laws, the protection offered to boat hulls, and potentially to fashion designs under the DPPA, is far more limited than the protection available to more conventional “works of authorship.” Under the DPPA, fashion design copyrights would last for only three years, beginning on the date of publication of the registration, or the date the design is first made public, whichever is earlier.<sup>29</sup> Registration is a prerequisite to an infringement action and must be sought within two years after the design is made public.<sup>30</sup>

The DPPA did not pass. The last Congressional session ended before the bill went to a vote. This marks the 89th failed attempt since 1914 to adopt US copyright legislation to protect fashion designs.

**Conclusion**

Savvy fashion designers can certainly protect many elements of their designs under the existing bodies of intellectual property protection in the US. Yet they frequently have no remedy for line-by-line knock-offs of their highly original designs. The ill-fated DPPA was no doubt an imperfect product of compromise, and its

chances of passage in the near future are low. But it remains hard to reconcile why the US copyright law so clearly protects a photograph of an imaginative new fashion design, but not the fashion design itself. Certainly, fashion design contributes more to the overall US economy, and frequently embodies more originality and creativity, than boat hulls. ☹

**Notes**

- 1 17 U.S.C. § 102(a).
- 2 17 U.S.C. § 102(a)(5).
- 3 17 U.S.C. § 106.
- 4 17 U.S.C. § 302(a).
- 5 17 U.S.C. § 101.
- 6 *Id.*
- 7 745 F.2d 1238 (9th Cir. 1984).
- 8 *Id.* at 1242.
- 9 See Barry Kielselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980).
- 10 15 U.S.C. § 1125(a)(1).
- 11 See *Two Pesos, Inc. v. Taco Cabana*, 505 U.S. 763, 769 (1992); see also 15 U.S.C. § 1052(f).
- 12 See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210 (2000).
- 13 See, e.g. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (setting forth the test for trademark mark infringement under the likelihood of confusion factors).
- 14 See 15 U.S.C. § 1115(a).
- 15 See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995).
- 16 See Reg. No. 2022789, registered on December 17, 1996.
- 17 See Lynn Downey, *Levi’s at Tillys.com!*, <http://www.tillys.com/tillys/brandpage.aspx/leviis/30/0/0>.
- 18 See *L.A. Gear v. E.S. Originals*, 35 U.S.P.Q.2d 1497, 1996 WL 91846 (C.D. Cal. 1995); see also *L.A. Gear v. E.S. Originals*, 35 U.S.P.Q.2d 1497, 1996 WL 91839 (C.D. Cal. 1995).
- 19 5 U.S.C. §§ 154(a)(2), 173.
- 20 5 U.S.C. § 101.
- 21 The phrase “prior inventions” has been replaced with “prior art” because novelty is determined in view of both inventive and non-inventive prior art.
- 22 35 U.S.C. §§ 101-03.
- 23 35 U.S.C. § 171.
- 24 *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).
- 25 *Id.*
- 26 17 U.S.C. § 1301.
- 27 See H.R. 5055, § 1(a)(9).
- 28 See Elizabeth Woyke, *Fashion’s Bid to Knock Out Knockoffs*, BUSINESSWEEK, Apr. 10, 2006, at 16.
- 29 H.R. 5055, § 1(c) (Mar. 30, 2006); see also 17 U.S.C. § 1304.
- 30 17 U.S.C. §§ 1307, 1310(a).