



UNC  
SCHOOL OF LAW

NORTH CAROLINA LAW REVIEW

---

Volume 86 | Number 1

Article 5

---

12-1-2007

# Double-Edged Scissor': Legal Protection for Fashion Design

Emily S. Day

Follow this and additional works at: <http://scholarship.law.unc.edu/nclr>



Part of the [Law Commons](#)

---

## Recommended Citation

Emily S. Day, *Double-Edged Scissor': Legal Protection for Fashion Design*, 86 N.C. L. REV. 237 (2007).

Available at: <http://scholarship.law.unc.edu/nclr/vol86/iss1/5>

This Comments is brought to you for free and open access by Carolina Law Scholarship Repository. It has been accepted for inclusion in North Carolina Law Review by an authorized administrator of Carolina Law Scholarship Repository. For more information, please contact [law\\_repository@unc.edu](mailto:law_repository@unc.edu).

## Double-Edged Scissor<sup>1</sup>: Legal Protection for Fashion Design<sup>\*</sup>

INTRODUCTION .....	237
I. CURRENT PROTECTION FOR FASHION DESIGN .....	245
A. <i>Copyright of Decorative Elements Separable from Their Useful Function</i> .....	245
B. <i>Elements of Designs: Fabric Patterns and Dress Designs</i> .....	247
C. <i>Trademark</i> .....	248
D. <i>Trade Dress</i> .....	249
E. <i>Design Patents</i> .....	250
II. DESERT-BASED THEORY .....	252
III. ECONOMIC-BASED THEORY .....	259
A. <i>Recognizable Luxury Designers Limitation</i> .....	261
B. <i>Potential for Lower-Priced Bridge Lines</i> .....	262
C. <i>Clearly Inferior Copies Limitation</i> .....	264
IV. FASHION DESIGN PROTECTION: E.U. DIRECTIVE 98/71/EC AND H.R. 5055 .....	265
A. <i>E.U. Directive 98/71/EC</i> .....	266
B. <i>H.R. 5055</i> .....	268
V. PRIVATE FASHION DESIGN RIGHT .....	269
CONCLUSION.....	272

### INTRODUCTION

This, “stuff?” Oh, ok. I see, you think this has nothing to do with you. You go to your closet and you select out, oh I don’t know, that lumpy blue sweater, for instance, because you’re trying to tell the world that you take yourself too seriously to care about what you put on your back. But what you don’t know is that that sweater is not just blue, it’s not turquoise, it’s not lapis, it’s actually cerulean. You’re also blindly unaware of the fact that in 2002, Oscar De La Renta did a collection of cerulean gowns. And then I think it was Yves Saint Laurent, wasn’t it, who showed cerulean military jackets? And then cerulean quickly showed up in the collections of eight different designers. And then it filtered down through the department stores and then trickled on down into some tragic Casual Corner where you, no doubt, fished it out of some clearance bin. However, that blue represents millions of dollars and countless jobs

---

\* Copyright © 2007 by Emily S. Day.

1. Olivera Medenica, *Designers Seek To Prevent Cheaper Knockoffs*, NAT’L L.J., Aug. 28, 2006, at S1.

and it's sort of comical how you think that you've made a choice that exempts you from the fashion industry when, in fact, you're wearing the sweater that was selected for you by the people in this room. From a pile of "stuff."<sup>2</sup>

This memorable quote from the Academy Award-nominated film *The Devil Wears Prada* implies two major themes of the fashion design industry: the fashion design industry affects everyone, even if indirectly, and it exists in an environment of constant copying and counterfeiting.<sup>3</sup> Designers have long sought protection against copying, but it has been denied largely because fashion designs have been viewed as more closely related to useful articles—clothing<sup>4</sup>—than to creative works and because copying was described as economically beneficial to designers. This Comment suggests that those arguments are flawed or can be weakened by appropriately tailored protection and proposes a solution that would both protect fashion designers as well as satisfy the opponents of protection.

The numbers reinforce the theme illuminated by the quote from *The Devil Wears Prada*—the fashion industry affects everyone. The size of the international apparel industry is astonishing, producing more than \$750 billion in sales annually.<sup>5</sup> The U.S. fashion design industry alone is a \$350 billion industry.<sup>6</sup> According to the U.S. Chamber of Commerce, "[t]he production, distribution and sale of unauthorized goods has cost U.S. companies between \$200 and \$250 billion each year as well as 750,000 jobs to date."<sup>7</sup> More pertinently, losses due to counterfeiting in the clothing and footwear industries combined have been approximately \$12 billion annually.<sup>8</sup> This counterfeiting translates into lost revenues for both designers and the government; New York alone estimates its losses due to

2. *THE DEVIL WEARS PRADA* (20th Century Fox 2006).

3. In this Comment, "counterfeit" means a copy that is already illegal under the existing limited protection scheme for fashion designs, such as a handbag with the Louis Vuitton "LV" logo or a dress with a Diane von Furstenburg fabric pattern printed on it. A "copy" or "knockoff" means a copy of an original design sold by another producer such as the A.B.S. dresses appearing *infra* pages 240–41. See Eric Wilson, *The Knockoff Won't Be Knocked Off*, N.Y. TIMES (Week in Review), Sept. 9, 2007, at 5 (defining "counterfeits" and "knockoffs" in the same way).

4. See *infra* notes 39–41 and accompanying text (discussing the refusal of copyright protection for functional articles, which are distinguished from artistic items).

5. See Safia A. Nurbhai, Comment, *Style Piracy Revisited*, 10 J.L. & POL'Y 489, 489 (2002) (estimating total apparel sales of \$784.5 billion in 1999).

6. Jacqueline Palank, *Congress Considers Fashion's Copyrights*, WASH. TIMES, July 28, 2006, at C10.

7. *Id.*

8. *A Bill To Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. 2 (2006) [hereinafter *Hearing on H.R. 5055*] (statement of Rep. Howard L. Berman, Ranking Member, Subcomm. on Courts, the Internet, and Intellectual Property).

counterfeiting total more than \$1 billion in tax revenue annually.<sup>9</sup> Without protection, copying in the fashion industry is so prevalent that “knocking off big-name designers is as intrinsic to the global fashion industry as the two Cs in its logo are to Chanel.”<sup>10</sup>

The reason behind the unchecked copying in the U.S. fashion industry is the inability of fashion designers to seek legal protection for their creations. As a result, there are a number of American firms who generate a substantial part of their revenue from designs intentionally created to knock off the high-priced runway and red carpet fashions. For example, Allen B. Schwartz of A.B.S. has openly conceded that “he will watch fashion events such as the Academy Awards telecast, sketch the dresses that the stars parade down the red carpet, and ‘the next day decide which of the gowns will be adapted or interpreted.’”<sup>11</sup> Several A.B.S. dresses are included below, alongside their red carpet original designs, to illustrate the nearly identical nature of these entirely legal A.B.S. copies.<sup>12</sup>

---

9. Robin Givhan, *Congress May Knock Out Knockoffs*, NEWS & OBSERVER (Raleigh, N.C.), Aug. 13, 2007, at 3C. The statistics above likely do not include knockoffs since they are not illegal under current law and therefore do not represent the full economic harm felt by fashion designers under the current law. *Id.* (using “black market goods” in following sentence which seems to limit “counterfeiting” to its meaning in this Comment—already illegal copies—and therefore limiting the statistic in the same way).

10. Georgina Safe, *Fraudsters with Fabrics*, WEEKEND AUSTRALIAN, Jan. 22, 2005, at 26.

11. Samantha L. Hetherington, *Fashion Runways Are No Longer the Public Domain: Applying the Common Law Right of Publicity to Haute Couture Fashion Design*, 24 HASTINGS COMM. & ENT. L.J. 43, 45 (2001).

12. *Star Style: Golden Globes: Win a Look!*, US WEEKLY, Feb. 5, 2007, at 76–77 (pages from *Us weekly*, February 5, 2007, © Us weekly LLC 2007, All Rights Reserved, Reprinted by Permission and individual photographs reprinted with permission of Abaca (Jolie), John Paschal International (Barrymore), Landov (Cruz), and Splash (Hatcher)). These A.B.S. copies are sold directly alongside the original in stores such as Nordstrom and Neiman Marcus.

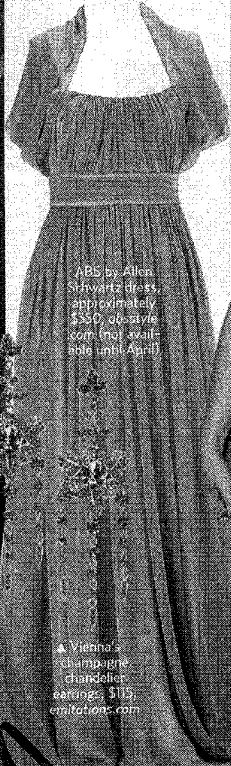
# STAR STYLE

# Golden Globes

Want award-winning elegance? Enter to score one



### ANGELINA JOLIE



ABS by Allen Schwartz dress, approximately \$330, [obsstyle.com](http://obsstyle.com) (not available until April)

Vienna's champagne chandelier earrings, \$115, [emutations.com](http://emutations.com)

Jolie looked lovely in St. John at the Golden Globes in Beverly Hills.

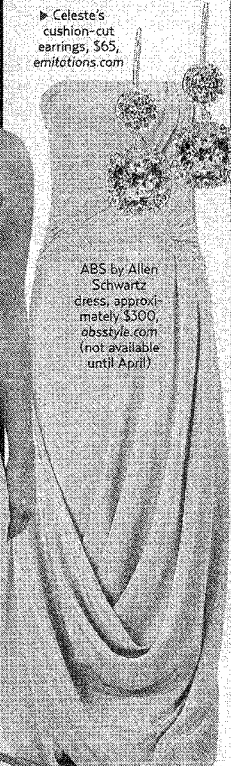


Laundry by Shelli Segal leather sandals, \$150, [piperlime.com](http://piperlime.com)



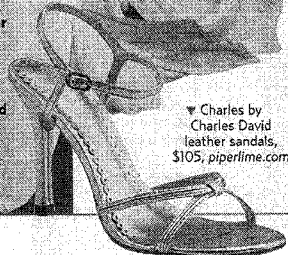
### DREW BARRYMORE

Celeste's cushion-cut earrings, \$65, [emutations.com](http://emutations.com)



ABS by Allen Schwartz dress, approximately \$500, [obsstyle.com](http://obsstyle.com) (not available until April)

Barrymore polished off her Dior Haute Couture by John Galliano gown with L'evy diamond earrings.



Charles by Charles David leather sandals, \$105, [piperlime.com](http://piperlime.com)

# es: Win a Look!

of these A-list ensembles that will leave you feeling red carpet ready



**PENELOPE CRUZ**

**TERI HATCHER**

ABS by Allen Schwartz dress, approximately \$350, [absstyle.com](http://absstyle.com) (not available until April)

ABS by Allen Schwartz dress, approximately \$325, [absstyle.com](http://absstyle.com) (not available until April)

▼ Dogwood flower gold-tone earrings, \$45, [emittations.com](http://emittations.com)

**Win It!**  
To enter, visit [tellusmagazine.com](http://tellusmagazine.com) by January 31.

▲ Mollie pearl earrings, \$39, [emittations.com](http://emittations.com)

Cruz wowed in Chanel Haute Couture's frothy ball gown.

▼ Max Studio T-strap leather sandals, \$140, [piperlime.com](http://piperlime.com)

Hatcher dazzled in Roberto Cavalli and David Yarman gold-and-pearl earrings.

◀ Charles David peep-toe leather sandals, \$225, [piperlime.com](http://piperlime.com)

Another knockoff example is the dress designed by Narcisco Rodriguez for Carolyn Bassette Kennedy. An estimated eight million copies were sold before Rodriguez could produce the dress for his own collection.<sup>13</sup> As a result, Rodriguez was only able to sell “maybe 45” because the dress “‘was already too widely distributed’ by copycats.”<sup>14</sup>

It is not only these couture and luxury designers—who, admittedly, are rather unsympathetic plaintiffs—whose creations are getting knocked off. Rather, copying extends not insignificantly to smaller, lower-price point designers as well. To repeat the example used in the House Committee Hearing on Fashion Design Protection and House Bill 5055 (“H.R. 5055”), Ananas, the handbag label of one out of more than 4,250 self-employed designers<sup>15</sup> and of a young wife and mother working from home, was knocked off. An identical design was offered at a lower price on the Internet.<sup>16</sup> As a direct result, a buyer cancelled his wholesale order and an independent individual customer bought the cheaper counterfeit version online instead.<sup>17</sup>

In another example, a buyer of the “City Tote,” a handbag created by Anna Corinna, a small New York designer and co-owner of a vintage store, began seeing inferior copies everywhere.<sup>18</sup> The buyer “finally went to one of [those] hated malls and saw that every *hoi polloi* store in there was selling copies” of the City Tote of “cheap” quality.<sup>19</sup> Although the buyer and author of the editorial argues against extending copyright protection to fashion designers, her experience with the City Tote and its knockoffs reinforces the reputational damage designers suffer due to inferior-quality knockoffs and loss of sales due to consumers abandoning their view of the design as a status-conferring good.<sup>20</sup> It is only because Ananas and Corinna survived that their stories are available to tell. Numerous other examples of “young, up and coming designer[s]” are lost because “having

---

13. Rosemary Feitelberg, *Schumer Touts Plan To Fight Design Theft*, WOMEN'S WEAR DAILY, Aug. 9, 2007, at 12.

14. *Id.* (quoting Rodriguez). See Givhan, *supra* note 9, for a picture of Rodriguez's design.

15. BUREAU OF LABOR STATISTICS, U.S. DEPT. OF LABOR, OCCUPATIONAL OUTLOOK HANDBOOK 240 (2006), available at <http://www.bls.gov/oco/ocos291.htm>.

16. *Hearing on H.R. 5055*, *supra* note 8, at 77 (testimony of Susan Scafidi, Visiting Professor, Fordham University, Associate Professor, Southern Methodist University).

17. *Id.* See *infra* Part III.A for a discussion of how these smaller designers create a flaw in the economic argument against copyright protection for fashion designs.

18. See Caille Millner, Editorial, *Call Off the Fashion Police*, S.F. CHRON., Sept. 10, 2007, at B4.

19. *Id.*

20. See *id.*; see also *infra* note 142 (defining “status-conferring good”).

an original work ripped off can be soul crushing and discourage them from following their dreams.”<sup>21</sup>

Although the fashion industry enjoys legal protection in Europe<sup>22</sup> and Australia<sup>23</sup> for registered designs, repeated attempts to change the American copyright statute<sup>24</sup> have been struck down,<sup>25</sup> the most recent being H.R. 5055, a bill to “amend Title 17 of the United States Code to provide protection for fashion design,”<sup>26</sup> introduced in 2006.<sup>27</sup> While there are limited protections for fashion designs in the United States under current copyright law,<sup>28</sup> this level of protection is not sufficient, especially as compared with protection available abroad.<sup>29</sup> This Comment argues that this insufficiency should be remedied and additional protection should be provided for American fashion designers because (i) fashion designs are

---

21. Press Release, Rep. Jerrold Nadler, Senator Schumer & Representative Nadler Reveal Gaping Hole in Piracy Law that Allows Cheap Imports To Flood NYC Market (Aug. 8, 2007), available at [http://www.house.gov/list/press/ny08\\_nadler/DesignPiracy080807.html](http://www.house.gov/list/press/ny08_nadler/DesignPiracy080807.html) (quoting Sen. Charles E. Schumer (NY)) (explaining the deterrent effect of copying on potential designers); see also Givhan, *supra* note 9 (describing the effect of knockoffs as “knock[ing] the wind out of young designers trying to establish identity in the marketplace”).

22. See Council Directive 98/71, 1998 O.J. (L 289) 28 (EC) (granting exclusive design rights to registered designs of “new and . . . individual character” for “up to a total term of 25 years”). The Design Directive mandated the Member States to implement it by October 28, 2001. *Id.* art. 19 § 1.

23. See Safe, *supra* note 10 (describing both Federal Court victory for Australian designer and more recent legislation, which limits design protection, but still provides legal protection to registered designs).

24. 17 U.S.C.A. §§ 101–1332 (West 2005 & Supp. 2007).

25. Hetherington, *supra* note 11, at 44 (“[A]pproximately 74 attempts since 1910, as of 1983” have been rejected by Congress).

26. *Hearing on H.R. 5055*, *supra* note 8, at 196 (statement of Rep. Maxine Waters, Member, Comm. on the Judiciary).

27. A new bill, the Design Piracy Prohibition Act, has recently been introduced in the Senate by Senator Charles E. Schumer (N.Y.) but had yet to be discussed or voted on before this Comment was published. See Design Piracy Prohibition Act, S. 1957, 110th Cong. (2007). See *infra* note 206 for a comparison of S. 1957 to H.R. 5055.

28. These limited protections include copyright for decorative elements separable from their useful function, protections for fabric patterns and dress designs, trademark, trade dress, and design patents described *infra* Part I.

29. Some opponents of granting any additional legal protection for fashion designs in the United States argue that existing schemes in Europe are not utilized by designers as evidenced by the slim number of registrations (registration being a prerequisite to protection under the E.U. Directive), and thus, that there is no competitive disadvantage. See, e.g., Kal Raustiala & Christopher Springman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1740 (2006) (asserting there has been “scant utilization thus far of the E.U.-wide system for fashion design registration”). However, this argument does not consider the designers’ use of the national law of the Member States, which is not preempted by the E.U. Directive. See *infra* note 195 and accompanying text. Nor does this current situation reflect the potential implications of the E.U. Directive on future competition since similar protection cannot be granted to U.S. designers overnight. Further, it is the American fashion designers themselves who are the proponents of H.R. 5055, as will be discussed *infra* Part V.



creative works deserving of protection,<sup>30</sup> and (ii) although fashion designers arguably enjoy benefits in the form of increased profits due to copies, these economic benefits result from only clearly inferior copies and not from virtually indistinguishable copies.<sup>31</sup> Since there is no practical way to draft a law distinguishing between *clearly inferior* copies and *virtually indistinguishable* copies, the most effective remedy is a private fashion design right enforced in civil actions by the infringed designer, which would allow selective enforcement by the fashion designers themselves.<sup>32</sup>

In support of this argument, Part I explores the existing limited framework for the legal protection of fashion designs, including (i) the copyright of decorative elements separable from their useful function, (ii) protection for fabric patterns and dress designs, (iii) trademark, (iv) trade dress, and (v) design patents. Part II discusses the “desert-based theory,” the idea that fashion designs by their very nature are deserving of legal protection. This part also summarizes the history of the struggle for fashion design protection. It describes how technological advances have enhanced the need for copyright protection for fashion designs today. Part III rebuts the economic argument that any additional copyright protection would actually be financially harmful to the fashion industry as a whole because luxury designers benefit from the existence of copies.<sup>33</sup> Finally, Part IV reviews the E.U. Directive for the Legal Protection of Designs and H.R. 5055, and Part V proposes an alteration of the American bill in order to ultimately minimize the possibility of any economic harm while still providing the level of legal protection for designs that the fashion industry deserves.

---

30. This theory is labeled the “desert-based theory.” See *infra* Part II for a detailed discussion.

31. This theory is labeled the “economic-based theory.” See *infra* Part III for a detailed discussion.

32. See *infra* Part V.

33. It should be noted that it has not yet been empirically proven that the existence of copies economically benefits luxury designers. This theory may never be proven without testing an environment of complete protection. Various indeterminate factors prevent such a conclusion. For example, it is unclear whether the luxury designers could capture the same economic benefits through their own lower-priced bridge lines and/or whether enough of those consumers who purchase copies in lieu of the original would purchase the original at the higher price if the copy was not available to compensate for the economic benefits lost from the loss of the copies. For completeness, the argument in Part III covers both situations: (i) where luxury designers do not economically benefit from copies; and (ii) where there are financial benefits for designers derived from copies.

I. CURRENT PROTECTION FOR FASHION DESIGN<sup>34</sup>

The level of protection for the fashion industry under current U.S. law has been described as a “low-IP equilibrium,” meaning that it provides very limited protection.<sup>35</sup> This limited protection is derived from a variety of sources, yet it is nonetheless insufficient, for “designers and manufacturers hardly have any protection when the design of a product is imitated without bearing the designer or manufacturer’s name.”<sup>36</sup>

A. *Copyright of Decorative Elements Separable from Their Useful Function*

Under Article I of the Constitution, Congress has the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>37</sup> The copyright doctrine covers a wide range of creative or artistic works, including “literary works, musical works (including lyrics), dramatic works (including accompanying music), pantomimes and choreographic works, pictorial, graphic and sculptural works, motion pictures and other audiovisual works, sound recordings, and architectural works.”<sup>38</sup> However, copyright does not extend to “useful articles,” defined as articles having “intrinsic utilitarian function[s] that [are] not merely to portray the appearance of the article[s] or to convey

---

34. For an example of a fashion designer’s arguments for finding a copier liable for copyright infringement under the existing protection scheme, see generally First Amended Complaint for Copyright Infringement, Unfair Competition and False Designation of Origin, Unlawful and Deceptive Acts and Practices, Demand for Jury Trial, Diane von Furstenberg Studio, L.P. v. Forever 21, Inc., No. 07CV2413 (S.D.N.Y. Apr. 12, 2007). This case settled out of court on September 7, 2007. See Conditional Order of Discontinuance at 1, Diane von Furstenberg Studio, L.P. v. Forever 21, Inc., No. 07CV2413 (S.D.N.Y. Sept. 7, 2007).

35. Raustiala & Springman, *supra* note 29, at 1699 (asserting “[t]oday the fashion industry operates in what we term a ‘low-IP equilibrium,’” meaning that “the three core forms of IP law—copyright, trademark, and patent—provide only very limited protection for fashion designs”) (emphasis added). It might be argued that the combination of the means of protection described in this Part—copyright of decorative elements separable from their useful function, protection for fabric patterns and dress designs, trademark, trade dress, and design patents—raises this IP equilibrium to a level higher than “low.” This calls into question Raustiala and Springman’s thesis that the “low-IP system may paradoxically serve the industry’s interests better than a high-IP system,” *id.* at 1718, due to the financial benefits of copies. Notwithstanding this possibility, it must be conceded that the increase would only be slight, and Raustiala and Springman’s thesis will be more directly refuted on economic terms in Part III.

36. Design Piracy Prohibition Act: Does a Designer and Apparel Manufacturer Protection Make Sense?, <http://www.ipphil.com/?cat=3> (Oct. 26, 2006, 03:16 EST).

37. U.S. CONST. art. I, § 8.

38. Fred Koenigsberg, *Copyrights, in UNDERSTANDING COPYRIGHT LAW 2007*, at 89, 94 (PLI Intellectual Property, Course Handbook Series No. G-901, 2007); see also 17 U.S.C. § 102 (2000) (listing works capable of being protected under copyright law).

information.”<sup>39</sup> Congress’s purpose for including this language in the Copyright Act was “to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.”<sup>40</sup> Thus, copyright protection is predominantly unavailable to fashion designs due to their utilitarian function of clothing, that is to “cover the wearer’s body and protect the wearer from the elements.”<sup>41</sup>

There is a narrow exception to the useful articles doctrine. Even if something is a useful article, it is still a proper subject for copyright protection if “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.”<sup>42</sup> This concept of “separability” has been divided into two primary approaches: physical and conceptual separability.<sup>43</sup> Physical separability tests “whether the feature to be copyrighted could be sliced off for separate display.”<sup>44</sup> For example, in *Celebration International, Inc. v. Chosun International, Inc.*, the court found that in a tiger costume the “tiger’s sculptural aspect (the head) is physically separable from the utilitarian function (the clothing garment) of the costume.”<sup>45</sup> Thus, because the clothing element is considered utilitarian, fashion designs by definition generally do not meet the physical separability test.

Conceptual separability exists “when the artistic aspects of an article can be conceptualized as existing independently of their utilitarian function.”<sup>46</sup> In theory, conceptual separability can exist in clothing designs “where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.”<sup>47</sup> On rare occasions, courts have found that separability does exist, and, therefore, fashion designs that contain decorative elements which are separable from their useful function are protected by copyright. For

---

39. 17 U.S.C. § 101 (2000); see also WILLIAM E. LEVIN, TRADE DRESS PROTECTION § 23:5 (2006) (“Copyright law prohibits protection of useful objects having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information, such as clothing.”).

40. H.R. REP. NO. 94-1476, at 55 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5668.

41. *Celebration Int’l, Inc. v. Chosun Int’l, Inc.*, 234 F. Supp. 2d 905, 912 (S.D. Ind. 2002).

42. § 101 (defining “pictorial, graphic, and sculptural works”).

43. See *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 922 n.8 (7th Cir. 2004) (“Although the district court was skeptical that the statutory language encompassed both physical and conceptual separability, circuits have been almost unanimous in interpreting the language of [17 U.S.C.] § 101 to include both types of separability.” (citations omitted)).

44. *Celebration Int’l, Inc.*, 234 F. Supp. 2d at 914 (citation omitted).

45. *Id.* Another example of physical separability is a belt buckle because the belt holds up a person’s pants with or without the ornamental design on the buckle. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980).

46. *Pivot Point Int’l, Inc.*, 372 F.3d at 931 (citation omitted).

47. *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

example, the Second Circuit Court of Appeals found the artistic design of a metal belt buckle was conceptually separable from the buckle itself and, therefore, a proper subject for copyright,<sup>48</sup> and the U.S. District Court for the District of Minnesota concluded that a plush bear's claw novelty slipper was conceptually separable from its useful function and, therefore, the designer was deserving of an injunction on the production of an imitation on the basis of copyright infringement.<sup>49</sup> However, this result is atypical. "[I]tems of clothing are unlikely to meet the physical or conceptual separability tests"<sup>50</sup> because most often the design itself, such as the cut of a sleeve, simultaneously serves its function as clothing to "cover the wearer's body and protect the wearer from the elements."<sup>51</sup>

### B. Elements of Designs: Fabric Patterns and Dress Designs

One aspect of fashion design that has been recognized by the copyright law is fabric design, meaning the actual color and print on a particular fabric. Although the Copyright Act's<sup>52</sup> list of works eligible for copyright protection does not include fabric designs explicitly,<sup>53</sup> it is now "well-settled" that fabric designs are protected by copyright.<sup>54</sup> For example, in *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*,<sup>55</sup> the U.S. District Court for the Southern District of New York held that a design printed on clothing fabric has long been protected by copyright, both as a work of art<sup>56</sup> and as a print.<sup>57</sup> Thus, while the courts believe fashion design

---

48. *Kieselstein-Cord*, 632 F.2d at 993.

49. *Animal Fair, Inc. v. AMFESCO Indus., Inc.*, 620 F. Supp. 175, 187 (D. Minn. 1985) *aff'd without opinion*, 794 F.2d 678 (8th Cir. 1986); *see also* Paul Goldstein, 1 COPYRIGHT § 2.5.3, at 2:79 (2006) ("A novelty slipper made to look like a bear's paw would be conceptually separable because a slipper would be equally useful without the bear's paw configuration and because the bear's paw can stand alone as a—albeit modest—work of art.").

50. *Medenica*, *supra* note 1, at S18; *see also* *Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 455 (2d Cir. 1989) ("[C]lothes are particularly unlikely to meet [the separability] test—the very decorative elements that stand out being intrinsic to the decorative function of the clothing."); *Raustiala & Springman*, *supra* note 29, at 1700 (asserting "very few fashion designs are separable in this way; the expressive elements in most garments . . . are instilled into the form of the garment itself").

51. *Celebration Int'l, Inc. v. Chosun Int'l, Inc.*, 234 F. Supp. 2d 905, 912 (S.D. Ind. 2002).

52. 17 U.S.C.A. §§ 101–1332 (West 2005 & Supp. 2007). The current version of the Copyright Act was first promulgated in 1976. Pub. L. No. 94-533, 90 Stat. 2541 (1976).

53. *See* §§ 101–02.

54. Allan L. Schwartz, Annotation, *Fabric and Dress Designs as Protected by Copyright Under Federal Copyright Act*, 26 A.L.R. FED. 408 (1976); *see also* *Irving J. Dorfman Co. v. Borlan Indus., Inc.*, 309 F. Supp. 21, 23 (S.D.N.Y. 1969) ("It is now settled that a textile design is a proper subject for copyright protection.").

55. *Peter Pan Fabrics v. Brenda Fabrics, Inc.*, 169 F. Supp. 142 (S.D.N.Y. 1959).

56. *Id.* at 143; *see also* § 102(a) (extending copyright protection to "pictorial, graphic, and sculptural works"); § 101 (defining "pictorial, graphic, and sculptural works" to include "works of . . . art").

itself may not be a proper subject for copyright, the courts have held fabric patterns, so long as they are sufficiently original, are deserving of such legal protection.<sup>58</sup> Similarly, although the actual garment itself is not a proper subject for copyright, protection is extended to drawings or pictures of dress designs under the “pictorial, graphic, and sculptural works” category of the Copyright Act.<sup>59</sup> The courts have made it clear, however, that such protection of the design drawing does not extend to the resultant garment created from it.<sup>60</sup> This protection for drawings of dresses provides very few practical benefits for fashion designers other than designers who are in the business of creating patterns such as the ones found in fabric stores.

### C. Trademark

A trademark is any word, phrase, symbol, or design or combination thereof that identifies and distinguishes a product and indicates its source.<sup>61</sup> Under the Lanham Act, a trademark can be used to “protect[] the elements of a design that indicate the source of the product,” such as a logo, “but does not provide general protection for designs.”<sup>62</sup> Popular examples of logos eligible for trademark protection include Louis Vuitton’s “LV,” Burberry’s plaid, Lacoste’s alligator, Chanel’s interlocking Cs, Nike’s “swoosh,” and Polo’s horse. Designers devote substantial resources to enforce their trademark protections by uncovering counterfeiting operations and then suing the copiers in civil court,<sup>63</sup> and as a result, trademark infringement cases regarding the illegal use of a fashion designer’s name or symbol are common.<sup>64</sup> Thus, to the extent that the designer’s logo is part of

---

57. *Peter Pan Fabrics*, 169 F. Supp. at 143; see also § 102(a) (extending copyright protection to “pictorial, graphic, and sculptural works”); § 101 (defining “pictorial, graphic, and sculptural works” to include “prints”); *Spectravest, Inc. v. Mervyn’s, Inc.*, 673 F. Supp. 1486, 1491–92 (N.D. Cal. 1987) (finding infringement of “Puzzle Teddy” fabric pattern by substantially similar pattern with insignificant additions).

58. See *Spectravest*, 673 F. Supp. at 1491.

59. §§ 101, 102(a)(5); *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 188 (S.D.N.Y. 1934) (“[I]t is the drawing which is assumed to be a work of art and not the dress. It follows that [the owner’s] copyright gives it the exclusive right to make copies or reprints of the drawing only, and that it gives the copyright owner no monopoly of the article illustrated.”).

60. See *Jack Adelman*, 112 F. Supp. at 189–90 (“A dress is not copyrightable. A picture of a dress is.”).

61. 15 U.S.C. § 1127 (2000) (stating the statutory definition of “trademark”).

62. *Hearing on H.R. 5055*, *supra* note 8, at 3 (statement of Rep. Howard L. Berman, Ranking Member, Subcomm. on Courts, the Internet, and Intellectual Property).

63. See Robert Galbraith, *Luxury Groups Battle a Wave of Counterfeit Goods*, INT’L HERALD TRIB. (Paris), Sept. 29, 2001, at 12 (stating that a majority of large Italian-based fashion houses employ counterfeiting experts full-time).

64. See, e.g., *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108 (2d Cir. 2006) (LV Monogram Multicolore Design); *Louis Vuitton Malletier v. Burlington Coat Factory*

the outward design, trademark provides considerable protection against copying.<sup>65</sup> However, “for the vast majority of apparel goods, the trademarks are either inside the garment or subtly displayed on small portions such as buttons,”<sup>66</sup> and in such cases, trademark provides little protection against illegal copying.<sup>67</sup>

#### D. Trade Dress

Not only does the Lanham Act cover trademarks, but it also protects the broader concept of trade dress.<sup>68</sup> Trade dress “involves the total image of a product” and may include “size, shape, color, color combinations, texture, graphics or even particular sales techniques.”<sup>69</sup> Beyond this oft-cited definition, it is difficult to fit trade dress concept into our existing legal framework. Courts have varied in their treatment of trade dress, some linking it to trademark infringement, others to unfair competition, and still others created a distinct doctrine of trade dress at common law.<sup>70</sup> Regardless of its source, “[m]ost courts now agree . . . ‘[w]hile trade dress traditionally referred to the packaging or labeling of a product, the term now includes the shape and design of the product itself.’ ”<sup>71</sup> Fashion designs would fall in the latter, product-configuration category. However, similar to copyright, one of the elements of trade dress is

---

Warehouse Corp., 426 F.3d 532 (2d Cir. 2005) (LV’s Toile Monogram design and Monogram Multicolore design); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229 (Fed. Cir. 2005) (two fashion houses competing over the Berkshire Label); *Gucci America, Inc. v. Daffy’s, Inc.*, 354 F.3d 228 (3d Cir. 2003) (Gucci label); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000) (Polo mark); *Chanel, Inc., v. Italian Activewear of Fla., Inc.*, 931 F.2d 1472 (11th Cir. 1991) (Chanel label); *Burberrys Wholesale Ltd. v. After Six, Inc.*, 122 Misc.2d 561 (N.Y. Sup. Ct. 1984) (Burberry-patterned raincoat).

65. See, e.g., *Louis Vuitton Malletier*, 426 F.3d at 538 n.3 (asserting “the handbags need not be identical, but only similar” when viewed sequentially, not simultaneously “for there to be a likelihood of confusion” created by the similarity of the logos and therefore a violation of the Lanham Act).

66. Raustiala & Springman, *supra* note 29, at 1701–02.

67. *Id.* at 1702.

68. See 15 U.S.C. § 1125(a) (2000).

69. *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983); see also J. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:4 (4th ed. 2007) (asserting “‘trade dress’ includes the total look of a product and its packaging”).

70. See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1128–29 (Fed. Cir. 1993) (relying on common law origin of trade dress to find that trade dress includes the overall combination of design elements); see, e.g., *Brown v. It’s Entm’t, Inc.*, 34 F. Supp. 2d 854, 858–59 (E.D.N.Y. 1999) (combining its discussion of trademark and trade dress into a single analysis to find the cartoon character was protected under trademark and/or trade dress concepts).

71. LEVIN, *supra* note 39, § 1:5 (quoting *Nelson/Weather-Rite, Inc. v. Leatherman Tool Group, Inc.*, 40 U.S.P.Q.2d (BNA) 1239, 1244 (N.D. Ill. 1995) (citations omitted)); see also MCCARTHY, *supra* note 69, § 8:4 (asserting trade dress “even includes the design and shape of the product itself”).

nonfunctionality,<sup>72</sup> although the element is much less strict in the context of trade dress than in the useful article exception to copyright.<sup>73</sup> Thus, theoretically, because copyright provides some protection for fashion designs in the limited context of decorative elements separable from their useful function, and the trade dress nonfunctionality threshold is lower, trade dress should provide an even greater amount of protection for fashion designs.<sup>74</sup> In other words, based solely on the words of the statute as well as theoretical extensions of that language, trade dress appears to be an ideal means for protection of fashion designs. However, the Supreme Court recently solidified the circuit courts' general hostility towards trade dress for product designs in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*<sup>75</sup> by directly denying trade dress protection for apparel designs.<sup>76</sup>

### E. Design Patents

Finally, protection for fashion designs is obtainable under current U.S. law in the form of design patents. A design patent protects "any new, original and ornamental design for an article of manufacture" for a term of fourteen years.<sup>77</sup> Design patents can be obtained in addition to copyright protection so long as the article of manufacture "discloses a high degree of uniqueness, ingenuity, and inventiveness."<sup>78</sup> Although design patents appear at first glance to be a perfect mechanism for the protection of

---

72. § 1125(a) (2000).

73. See Christine Magdo, Protecting Works of Fashion from Design Piracy 10–11, <http://leda.law.harvard.edu/leda/data/36/MAGDO.pdf> (last visited Sept. 23, 2007). For instance, the combination of functional features is one means to overcome the functionality hurdle within the trade dress doctrine. See LEVIN, *supra* note 39, § 24:3 ("[C]ourts have found combinations of unprotectable functional features to be protectable trade dress in combination in their overall appearance or configuration.").

74. See S. Priya Bharathi, *There Is More Than One Way To Skin a Copycat: The Emergence of Trade Dress To Combat Design Piracy of Fashion Works*, 27 TEX. TECH L. REV. 1667, 1668 (1996) (proposing that the Supreme Court's decision in *Two Pesos, Inc. v. Taco Cabana, Inc.* provided "conceptual tools to argue that trade dress protection applies to fashion works, especially with respect to the clothing's 'look and feel'" (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767–76 (1992))).

75. 529 U.S. 205 (2000).

76. *Id.* at 212. In *Wal-Mart Stores*, a children's clothing designer sued a retailer for its sale of knockoffs of the designer's clothes. *Id.* at 207. The Supreme Court found the retailer did not infringe on the designer's trade dress, reasoning that "design . . . is not inherently distinctive," and therefore is protected by trade dress only upon a showing that the design has developed a secondary meaning. *Id.* at 206, 216; see also *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1006 (2d Cir. 1995) ("[S]ince the primary purpose of [Plaintiff's] sweater designs is aesthetic rather than source-identifying, [Plaintiff's] sweater designs do not meet the first requirement under § 43(a) of the Lanham Act—that they be used as a mark to identify or distinguish the source.").

77. 35 U.S.C. §§ 171, 173 (2000).

78. Schwartz, *supra* note 54, § 2(b).

fashion designs, “clothing rarely meets the criteria of patentability.”<sup>79</sup> This is due to fashion’s inherently cyclical nature, which results in very few sufficiently novel and original designs.<sup>80</sup> Another limitation of the design patent’s application to fashion is temporal. Design patents take approximately eighteen months to obtain as compared to the short lifespan—one season or three to six months—of most fashion designs.<sup>81</sup> Thus, a typical fashion design would be revealed on the runway, sold to the public, copied extensively, and buried before a design patent could issue.<sup>82</sup> A further limitation on the use of design patents stems from the courts.<sup>83</sup> The courts have displayed hostility toward design patents for fashion works even if designers achieve approval in the Patent and Trademark Office, as the “courts often [either] find design patents invalid [or,] even if the design patent is deemed valid, patent infringement is found in only about half the cases brought to court.”<sup>84</sup> Thus, the protection available for fashion designs under design patents is limited, if not nonexistent, due to practical impossibilities, and the fact that courts do not enforce them. The end result is that certain aspects of fashion design are protected under the current

---

79. *Hearing on H.R. 5055*, *supra* note 8, at 4 (statement of Rep. Bob Goodlatte, Member, Subcomm. on the Courts, the Internet, and Intellectual Property)

80. *See* *Gold Seal Importers, Inc. v. Morris White Fashions, Inc.*, 124 F.2d 141, 142 (2d Cir. 1941) (“[I]t’s not enough for patentability to show that a design is novel, ornamental and pleasing in appearance,” rather “it must be the product of invention”; that is, the conception of the design must require some exceptional talent beyond the range of the ordinary designer familiar with the prior art.” (quoting *Nat Lewis Purses, Inc. v. Carole Bags, Inc.*, 83 F.2d 475, 476 (2d Cir. 1936))).

81. *See* *Magdo*, *supra* note 73, at 7–8; *Hearing on H.R. 5055*, *supra* note 8, at 2 (statement of Rep. Howard L. Berman, Ranking Member, Subcomm. on the Courts, the Internet, and the Judiciary).

82. There are some fashion designs which transcend the typical fashion season, such as Diane von Furstenberg’s wrap-dress or Louis Vuitton’s LV Monogram bag, both of which have remained “in style” for numerous consecutive seasons. *See, e.g.*, First Amended Complaint for Copyright Infringement, Unfair Competition and False Designation of Origin, Unlawful and Deceptive Acts and Practices, Demand for Jury Trial at 4, *Diane von Furstenberg Studio, L.P. v. Forever 21, Inc.*, No. 07CV2413 (S.D.N.Y. Apr. 12, 2007) (describing Diane von Furstenberg’s “iconic wrap dresses” as “symboliz[ing] female power and freedom to an entire generation”); *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 112 (2d Cir. 2006) (recounting that Louis Vuitton first created its LV toile Monogram in 1896). Although the temporal limitation is arguably not applicable to such designs, these designs nevertheless face the challenge of meeting the novelty and originality threshold required for patents. *See supra* notes 77–80 and accompanying text.

83. As early as 1958, “courts [were] in definite accord that most [fashion designs] do not meet the test” with respect to design patents. Stuart Jay Young, *Freebooters in Fashions: The Need for a Copyright in Textile and Garment*, 9 COPYRIGHT L. SYMP. (ASCAP) 76, 88 (1958).

84. *See* *Magdo*, *supra* note 73, at 8. *But see* *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1127 (Fed. Cir. 1993) (upholding design patent infringement of athletic shoes). The *L.A. Gear* case signals that design patents are a potential source of protection for fashion designers but does not undermine the practical restrictions on the use of design patents in the cyclical fashion industry.



legal system, but this protection exists in very narrow circumstances and is hardly sufficient.

## II. DESERT-BASED THEORY

The Constitution gives Congress the authority to protect “the Progress of Science and useful Arts.”<sup>85</sup> Fashion designs unquestionably fall in the “Arts” category, as the fashion industry is a “highly esteemed and developed area[] of human creativity”<sup>86</sup> Fashion designers have been dubbed “savvy colorist[s],”<sup>87</sup> “defiantly dandy, yet quirkily new,”<sup>88</sup> “cutting-edge,”<sup>89</sup> “fashion innovator[s],”<sup>90</sup> “some of the most creative minds,”<sup>91</sup> and “the artists of the apparel industry.”<sup>92</sup> As described, “fashion designers are comparable to artists, and as such, deserve comparable protection against infringement.”<sup>93</sup> The sole significant distinction between traditional art and fashion design is in the form of the final product—a design on a canvas, from a ball of clay, or on the page of a book versus a design from a bolt of fabric. This distinction in no way diminishes the equivalence on a creative and artistic scale of traditional artists and fashion designers. This theory that fashion designers are artists and their resultant designs are art is labeled the “desert-based theory,” so-called because, as art, fashion designs deserve some form of legal protection against copies.

The Ninth Circuit recognized the possibility that clothing, specifically a swimsuit, could be a work of art and not merely a “functional swimsuit” by reversing a summary judgment order against the designer in *Poe v. Missing Persons*.<sup>94</sup> Although cases following this 1984 decision did not further extend the Ninth Circuit’s recognition that fashion designs can be

85. U.S. CONST. art. I, § 8.

86. Asher Meir, *Cookyrighs and Foppyrights*, JERUSALEM POST, Sept. 15, 2006, at 1.

87. Godfrey Deeny, *Elise Overland: Arty Rocker Chic*, FASHION WIRE DAILY, Feb. 4, 2007, [http://www.fashionwiredaily.com/first\\_word/fashion/article.weml?id=916](http://www.fashionwiredaily.com/first_word/fashion/article.weml?id=916).

88. Godfrey Deeny, *Saint Laurent Does Eighties with a Twist*, FASHION WIRE DAILY, Jan. 28, 2007, [http://www.fashionwiredaily.com/first\\_word/fashion/article.weml?id=889](http://www.fashionwiredaily.com/first_word/fashion/article.weml?id=889).

89. Bobbie Thomas, *Bobbie’s Fashion Week Buzz*, MSNBC, Feb. 5, 2007, <http://www.msnbc.msn.com/id/16995874/from/RS.1/>.

90. Michiko Toyama, *Tokyo Touts New Design Center*, TIME, Spring 2007, at 32.

91. Kate Betts, *Editor’s Note: Full Speed Ahead*, TIME, Spring 2007, at 10.

92. Fashion and Clothing Industry Job Descriptions, [http://www.apparesearch.com/Employment/Job\\_Descriptions/Fashion\\_Designers.htm](http://www.apparesearch.com/Employment/Job_Descriptions/Fashion_Designers.htm) (last visited October 10, 2007).

93. Bharathi, *supra* note 74, at 1668; *see also* Julie P. Tsai, *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK L. REV. 447, 461 (2005) (“Fashion designers are artists and the medium they work with is clothing.”).

94. 745 F.2d 1238, 1243 (9th Cir. 1984). The court listed expert evidence concerning the usefulness of the product, evidence of the designer’s intent, testimony regarding the object’s custom and usage in the art world, and the clothing trade and the marketability of the object as a work of art as factors to be considered to distinguish between a work of art and a useful object. *Id.*

synonymous with works of art, less obviously “creative” works such as computer chips,<sup>95</sup> buildings,<sup>96</sup> and boat hulls<sup>97</sup> have recently been afforded protection under current copyright laws, notwithstanding their utilitarian function.<sup>98</sup> In short, American fashion designers, due to their status as tantamount to artists, the status of fashion design as a creative field, and the status of industries with inferior levels of creativity as copyrightable, are deserving of protection for their creative innovation.

There are several counterarguments to this desert-based theory for extending protection against counterfeits to the fashion industry. First, one of the primary justifications for copyright is to provide an economic incentive for artists to create and publish, achieved by granting them a limited monopoly.<sup>99</sup> Yet, the fashion industry exhibits an “empirical anomaly: the industry produces a huge variety of creative goods *without*

---

95. See Semiconductor Chip Protection Act of 1984, Pub. L. 98-620, § 902, 98 Stat. 3347, 2248 (codified as amended at 17 U.S.C. §§ 901–14 (2000)) (expanding the Copyright Act to include original “mask work[s]” fixed in a semiconductor or chip product).

96. See Architectural Works Copyright Protection Act, Title VII of the Judicial Improvements Act of 1990, Pub. L. 101-650, § 701, 104 Stat. 5089, 5133 (codified as amended at 17 U.S.C. § 101 (2000)) (broadening the Copyright Act to include “architectural work[s],” defined as “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings.”).

97. See Vessel Hull Design Protection Act, Pub. L. 105-304, § 1301, 112 Stat. 2860, 2906 (1998) (codified as amended at 17 U.S.C. § 1301 (2000)) (extending copyright protection to original “design[s] of a vessel hull, including a plug or mold” and including elements that are exclusively utilitarian).

98. See, e.g., H.R. REP. NO. 98-781, at 1 (1984), as reprinted in 1984 U.S.C.C.A.N. 5750, 5750 (describing one purpose of the act as a means to “encourage innovation, research and investment in the semiconductor industry”); see also *Hearing on H.R. 5055, supra* note 8, at 77 (testimony of Susan Scaffidi, Visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University) (“This is the constitutional intent of copyright law, to promote and protect the development of creative industries by ensuring that creators are the ones who receive the benefit of their own intellectual investments.”). A “limited monopoly” is achieved by copyright granting the innovator the exclusive right to use his innovation for a limited period of time. Naomi Jane Gray, *Overview of Copyright Basics and Basics of the Copyright Office, in UNDERSTANDING COPYRIGHT LAW 2007, supra* note 38, at 25, 31 (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984)).

99. The legislative histories of these acts, discussed *supra* notes 95–97, make it clear that protection for computer chips, buildings, and boat hulls stems from Congress’s Article 1 Section 8 power to promote creative works through copyright and *sui generis* protection. See H.R. REP. NO. 98-781, at 1 (“The purpose of the legislation is to protect semiconductor chip products in such a manner as to reward *creativity* . . .” (emphasis added)); H.R. REP. NO. 101-735, at 13, 21 (1990), as reprinted in 1990 U.S.C.C.A.N. 6935, 6944 (“[T]he Committee concluded that the design of a work of architecture is a ‘writing’ . . .” and therefore “the aesthetically pleasing overall shape of an architectural work could be protected . . .”); H.R. REP. NO. 105-436, at 13 (1998) (“Most importantly[,] . . . if manufacturers are not permitted to recoup at least some of their research and development costs, they may no longer invest in new, *innovative* boat designs that boaters eagerly await.” (emphasis added)). Since fashion designs would be protected under Congress’s power to protect innovative artistic works, the direct comparison of the level of creativity in fashion designs versus computer chips, buildings, and boat hulls is appropriate.

strong IP protection in one of its biggest markets (the United States), and without apparent *utilization* of nominally strong IP rights in another large market (the countries of the European Union).<sup>100</sup> In other words, even without legal protection, “[c]ompetition, innovation, and investment . . . remain vibrant” in the fashion industry.<sup>101</sup> The argument’s focus on the continued *financial* investment in the fashion industry *as a whole* is misguided. First, the sole motivation for creative expression through fashion design is not economic; rather, the industry is also a means through which creative individuals express themselves. The economic incentive created through copyright protection is secondary to this motivation. Thus, like other artists such as poets, novelists, and songwriters, fashion designers would create even if there were no protection because “[i]t is what humans do.”<sup>102</sup> Continued investment in the fashion industry does not establish that designers do not need or would not be motivated by further legal protection. Second, just because the financial investment level in the industry as a whole exhibits no change when designs are copied, this does not preclude significant shifts on the individual designer level from originators to copiers. Using the Ananas example described in the Introduction, if the Ananas designer were to quit producing her designs due to an inability to compete with the less expensive copies, the copier would continue to invest in manufacturing the copies. As a result, the financial investment in the industry as a whole would be unaffected by the replacement of the copier for Ananas, yet the creative designer would receive no financial benefit from her innovation. Thus, continued investment in the fashion industry as a whole is a poor indicator of the absence of harm caused by the lack of protection for designs. Unchecked piracy, however, not only affects the financial investment by stealing designers’ profits, but, because a majority of copies are cheaply made knockoffs, the piracy also damages the designers’ reputations.<sup>103</sup> Damage

---

100. Posting of Christopher Springman to the Faculty Blog, [http://uchicagolaw.typepad.com/faculty/2006/11/fashions\\_piracy.html](http://uchicagolaw.typepad.com/faculty/2006/11/fashions_piracy.html) (Nov. 3, 2006, 19:44 EST) (discussing his piece *The Piracy Paradox*).

101. Raustiala & Springman, *supra* note 29, at 1689.

102. *Hearing on H.R. 5055*, *supra* note 8, at 77 (testimony of Susan Scafidi, Visiting Professor, Fordham University, Associate Professor, Southern Methodist University) (“Of course, fashion designers create without the benefit of copyright law, but so would poets and songwriters if there were no copyright. It is what humans do.”)

103. See Press Release, Council of Fashion Designers of America, CFDA Applauds Design Prohibition Act (Aug. 8, 2007), [http://www.cfda.com/index.php?option=com\\_cfda\\_content&task=news\\_display\\_all](http://www.cfda.com/index.php?option=com_cfda_content&task=news_display_all) (“These duplicate versions . . . have the potential to flood the market and devalue the original by their . . . poor quality . . .”); Kristi Ellis, *Copyrighting a Dress: Congress Mulling Bill To Protect Designers*, WOMEN’S WEAR DAILY, Apr. 26, 2007, at 1, available at Gale General OneFile, Doc. No. A162887837 (“Design piracy denigrates the integrity of the style[.]” (quoting Nicole Miller, a designer)).

to reputation is not directly reflected in a dollar-for-dollar calculation of recoupment of investment. Thus, continued investment in the fashion industry is a poor indicator of the absence of harm to designers caused by the lack of protection for designs.<sup>104</sup>

Another counterargument to the desert-based theory is that, unlike computer chips, which were recently extended copyright protection through the Semiconductor Chip Protector Act,<sup>105</sup> fashion is not a new industry and has been around since the development of copyright.<sup>106</sup> Specifically, copyright protection was granted to three-dimensional objects in 1870,<sup>107</sup> a time at which fashion design existed. It is now over a century later and such protection still has never been extended to include the fashion industry, save in the limited instances outlined in Part I. The argument continues that if fashion is deserving of protection, it should have been eligible for it all along, and therefore, would have been instituted simultaneously with the copyright of three-dimensional objects.<sup>108</sup> This is basically a drafters' intent argument. The answer to this argument is simple: laws are amended and new laws are created constantly to keep up with our ever-evolving world. Admittedly, if this were the Constitution that was in debate, the original intent of the founders would carry much more clout, but it is not, and therefore the fact that the drafters in 1870 did not include fashion design in the protected category is a weak argument against protection today, over 130 years later. Lawmakers had no difficulty overcoming the drafters' intent in the context of boat hulls when, in 1998, they promulgated the Vessel Hull Design Protection Act<sup>109</sup> notwithstanding the existence of boat hulls in 1870 when copyright protection was granted to three-dimensional objects. In addition to the argument's weakness on a general level, (i) fashion designers have been attempting to secure protection for decades;<sup>110</sup> (ii) the progression of fashion design has led to its increased combination with art; and (iii) today's technological environment

---

104. This does not even address the significant difficulties associated with proving a negative or the absence of an occurrence. From a purely theoretical perspective, the idea that continued investment proves the absence of harm caused by the lack of legal protection thus stands on extremely unsteady ground at the outset.

105. Semiconductor Chip Protection Act of 1984, Pub. L. No. 98-620, § 902, 98 Stat. 3347, 3348 (codified as amended at 17 U.S.C. §§ 901-14 (2000)).

106. Meir, *supra* note 86, at 17.

107. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (repealed 1916).

108. *See* Meir, *supra* note 86, at 17.

109. *See* Vessel Hull Design Protection Act, Pub. L. 105-304, § 1301, 112 Stat. 2860, 2906 (1998) (codified as amended at 17 U.S.C. § 1301 (2000)).

110. Raustiala and Springman argue "[f]ashion firms and designers in the United States have neither obtained expanded copyright protection applicable to apparel designs nor sui generis statutory protections," Raustiala & Springman, *supra* note 29, at 1717, but, as explained further below, this failure is clearly not due to a lack of trying.

permits exploitation through copying at a far greater degree and a much faster pace than in the past.

American fashion designers have “repeatedly attempted to change the copyright statute (approximately 74 attempts since 1910, as of 1983).”<sup>111</sup> When legislative and judicial reform was consistently refused, the fashion industry took matters into its own hands and created the Fashion Originators’ Guild of America in 1935.<sup>112</sup> The purpose of the Guild was to prevent “style piracy,” or the “unethical and immoral” make and sale of copies of original fashion designs.<sup>113</sup> The Guild was composed of designers and those apparel manufacturers and retailers who signed a “declaration of cooperation,” forbidding them to create and sell counterfeit designs.<sup>114</sup> Designers punished manufacturers and retailers who refused to sign such declaration by boycotting their businesses, and those who violated the boycott were subject to substantial Guild-imposed fines.<sup>115</sup> However, in 1941, the Supreme Court found the Guild’s practice “constituted an unfair method of competition” in violation of the Sherman and Clayton Acts.<sup>116</sup> In the ensuing time between the termination of the Guild and today, fashion designers continued to petition both Congress and the courts for protection of their original creative works but to no avail.<sup>117</sup> Thus, the historical tradition of non-protection was not uncontested and therefore should not serve to strengthen the argument for maintaining the drafters’ original intent position of no protection.

Further, fashion design and the perception of fashion design are not static but constantly evolving. While at one point in its history, clothing

---

111. Hetherington, *supra* note 11, at 44. Already by 1958, the attempt “to seek new legislation was ‘old hat’ to the fashion industry. It had been engaged in that fight for years.” Young, *supra* note 83, at 100 (listing thirty bill proposals between 1910 and 1930).

112. See Young, *supra* note 83, at 106–07.

113. Fashion Originators’ Guild, Inc. v. FTC, 312 U.S. 457, 461 (1941).

114. *Id.* at 461–62.

115. *Id.*

116. *Id.* at 464.

117. Design protection bills passed the Senate in the 87th, 88th, and 89th Congresses and “were introduced in each Congress from the 96th through the 102d.” *Hearing on H.R. 5055, supra* note 8, at 199 (statement of the U.S. Copyright Office); see, e.g., H.R. REP. NO. 94-1476, at 50 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5663 (demonstrating that Title II of the Copyright Act amendment to protect “original ornamental design of a useful article” failed because design protection did not fall within traditional copyright doctrine and unproven benefits outweighed the “disadvantage of removing such designs from free public use”); see also *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 456 (2d Cir. 1989) (holding that Whimsicality misrepresented its costumes as “soft sculptures” to obtain invalid copyright protection, thereby precluding suit against other costume companies for copyright infringement); *Aldridge v. The Gap, Inc.*, 866 F. Supp. 312, 313–14 (N.D. Tex. 1994) (finding federal copyright law preempted state misappropriation law and under federal law, clothes, as useful articles, cannot be copyrighted).

may have been identified as primarily utilitarian, its evolution has led it to intertwine with the art industry more and more over time.<sup>118</sup> The exhibits in renowned museums displaying art by fashion designers are direct evidence of this blend of fashion and art.<sup>119</sup> The Giorgio Armani exhibit at the Guggenheim in New York,<sup>120</sup> the “iconic fashion” of Jacqueline Kennedy display at the Metropolitan Museum of Art,<sup>121</sup> the “Sixties Fashion” installation at the Victoria and Albert Museum in London,<sup>122</sup> and the “Dior: The New Look” exhibition at the Chicago History Museum<sup>123</sup> are just a few examples. Further evidence of the increased intermingling of fashion design and art is the very recent creation of museums dedicated solely to fashion, such as the Design Museum in London,<sup>124</sup> the Kobe Fashion Museum in Japan,<sup>125</sup> and the Museum at the Fashion Institute of Technology (“FIT”) in New York.<sup>126</sup> Although the latter museums are arguably less evidence of the mixture between fashion design and art because of their dedication to fashion design exclusively, their existence does “emphasize[] the idea that fashion designs are something more than mere useful articles.”<sup>127</sup> Finally, the fashion industry has increasingly integrated artists into the fashion world through collaborations between designers and artists.<sup>128</sup> Examples include the Fila and NYCollective Project<sup>129</sup> and the collaboration of Philip Treacy, Raf Simons, and Junya Watanabe—all designers—and Simon Periton, a British artist best known

---

118. See Tsai, *supra* note 93, at 461–62.

119. *Id.*

120. Guggenheim Museum, Giorgio Armani, [http://www.guggenheim.org/exhibitions/past\\_exhibitions/armani/index.html](http://www.guggenheim.org/exhibitions/past_exhibitions/armani/index.html) (last visited Feb. 5, 2007).

121. The Metropolitan Museum of Art, Jacqueline Kennedy: The White House Years—Selections from the John F. Kennedy Library and Museum, <http://metmuseum.org/special/> (followed “past exhibitions”; then “2001”; then “July 2001”) (last visited Oct. 8, 2007).

122. The Victoria & Albert Museum, Sixties Fashion, <http://www.vam.ac.uk/collections/fashion/1960s/sixtiesfashion/index.html> (last visited Feb. 5, 2007).

123. Mary Campbell, *The Man Who Changed Fashion*, WALL ST. J., Mar. 14, 2007, at D10.

124. Design Museum, <http://www.designmuseum.org/info/about-us> (last visited Aug. 2, 2007). The Design Museum’s exhibits “demonstrate[] both the richness of the creativity to be found in all forms of design,” including fashion and architecture, “and its importance.” *Id.* The grouping of architecture and fashion design implies the artistic similarity among the two and, thus, is a further argument for parallel extension of copyright to fashion as has been granted to architecture.

125. Kobe Fashion Museum, [http://www.fashionmuseum.or.jp/src/e\\_museum.php](http://www.fashionmuseum.or.jp/src/e_museum.php) (last visited Feb. 5, 2007).

126. The Museum at FIT, <http://www.fitnyc.edu/aspx/Content.aspx?menu=Future>. Global:Museum (last visited Feb. 5, 2007).

127. Tsai, *supra* note 93, at 462.

128. *Id.*

129. Fila + NYCOLLECTIVE PROJECT, <http://www.nycollective.org/> (last visited Feb. 5, 2007). Emerging artists, including graphic designers and illustrators, from the NYCOLLECTIVE PROJECT combined with Fila to create limited edition t-shirts featuring the artists’ designs. *Id.*

for his doilies.<sup>130</sup> Perhaps the most famous example occurred when Marc Jacobs, a designer, and Takashi Murakami, a painter and sculptor,<sup>131</sup> joined forces “to collaborate in the ‘revitalization’ for the new millennium of the traditional Louis Vuitton monogram.”<sup>132</sup> As evidenced by the above museum and collaboration examples, the art and fashion industries are increasingly merging, resulting in the shedding of clothing’s traditional primarily utilitarian image in favor of an artistic one. Due to this evolution, the fact that fashion design existed at the time when copyright law originated and was expressly excepted from protection is unconvincing.

Not only has the perception of fashion design shifted, but technological advances have changed both the magnitude and speed of the production of copies since the origination of copyright law. While “[i]t used to take months to copy a new style, [n]ow it takes mere hours.”<sup>133</sup> For example, with today’s technology, “[a] digital photograph of a new design can be uploaded to the Internet and sent to a knockoff artist halfway around the world before the model even reaches the end of the runway.”<sup>134</sup> In other words, a “factory[] in Jaipur, India, can deliver stores a knockoff months before the designer version.”<sup>135</sup> Thus, the need for protection was not nearly as significant when copyright law originated as it has become today.<sup>136</sup> Further, copyright law itself has not remained static but rather

---

130. See Sonya Mooney, *Ephemeral Conversations: Simon Periton’s Collaborations with Raf Simons, Philip Treacy and Junya Watanabe*, FASHION PROJECTS, <http://www.fashionprojects.org/> (search “Philip Treacy”) (last visited Feb. 5, 2007). For a review of one of Simon Periton’s recent art exhibitions of his doilies or large, delicate paper cut-outs that can be categorized somewhere between painting and sculpture, see Michael Kimmelman, *Art in Review: Simon Periton—‘Premonitions,’* N.Y. TIMES, Mar. 7, 2003, at E45.

131. Takashi Murakami’s art “ranges from cartoony paintings to quasi-minimalist sculptures to giant inflatable balloons to performance events.” Biography, <http://www.takashimurakami.com/biography.php> (last visited Aug. 25, 2007).

132. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415, 424–25 (S.D.N.Y. 2004) (quoting transcript), *aff’d in part, remanded in part*, 454 F.3d 108 (2d Cir. 2006).

133. *Hearing on H.R. 5055*, *supra* note 8, at 77 (testimony of Susan Scafidi, Visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University); *see also id.* at 9 (testimony of Jeffrey Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America) (“Copying today through technology is instantaneous.”).

134. *Id.* at 77 (testimony of Susan Scafidi, Visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University); *see also* Raustiala & Springman, *supra* note 29, at 1714–15 (“Digital photography and design platforms, the Internet, global outsourcing of manufacture, more flexible manufacturing technologies, and lower textile tariffs have significantly accelerated the pace of copying.”).

135. Eric Wilson, *Before Models Can Turn Around, Knockoffs Fly*, N.Y. TIMES, Sept. 4, 2007, at A1 (quoting Seema Anand, a “tweak[er]” of design styles for “trendy stores” carrying less expensive clothes, such as Forever 21).

136. See Robert Givhan, *The End of “Gown in 60 Seconds”?*, WASH. POST., Aug 10, 2007, at C2 (“Back in the days when the world moved at a slower pace, the impact of knockoffs was more modest.”).

“protection has extended as technology has advanced.”<sup>137</sup> Not only has technology drastically increased copying, but these advances in technology have also lead to the extension of copyright protection in other areas.<sup>138</sup>

Fashion designers, like all artists, are deserving of copyright protection. Both arguments concerning the history of nonprotection—that it has not discouraged economic investment and that it has existed since the origination of copyright, a time at which the fashion design existed—are immaterial to this theory.

### III. ECONOMIC-BASED THEORY

A primary argument against extending copyright protection to fashion design has been described as the “piracy paradox,” or the belief that copying might actually economically benefit designers,<sup>139</sup> or at the very least, does not harm the industry.<sup>140</sup> This economic argument is based on several premises, each sufficient alone but all potentially occurring simultaneously. First, copying is viewed as a catalyst, even a “necessary predicate,” to the rapid seasonal fashion cycle.<sup>141</sup> Specifically, as a “status-conferring” or “positional” good,<sup>142</sup> the diffusion of fashion to the masses revokes its ability to exude this elevated status, consequently requiring designers to create new “status-conferring” fashions.<sup>143</sup> Most importantly, it is the lack of protection for fashion designs, permitting an environment of unchecked copying, that hurries the diffusion; thus, financially benefiting designers by “inducing more rapid turnover and additional sales.”<sup>144</sup> In other words, dressing in the latest fashions gives a person an elevated social

---

137. Nurbhai, *supra* note 5, at 494 (footnote omitted); *see, e.g.*, Semiconductor Chip Protection Act of 1984, Pub. L. No. 98-620, § 902, 98 Stat. 3347, 3348 (codified as amended at 17 U.S.C. §§ 901–14 (2000)) (expanding the Copyright Act to include original “mask works” fixed in a semiconductor or chip product).

138. *See, e.g.*, *supra* notes 95–97 (listing acts extending copyright protection to computer chips, buildings, and boat hulls).

139. Raustiala & Springman, *supra* note 29, at 1691; *see also* Jonathan M. Barnett, *Shopping for Gucci on Canal Street: Reflections on Status Consumption, Intellectual Property, and the Incentive Thesis*, 91 VA. L. REV. 1381, 1384 (2005) (arguing that “counterfeiting is likely to increase the revenues of legitimate producers” (footnote omitted)).

140. Raustiala & Springman, *supra* note 29, at 1689 (“Competition, innovation, and investment . . . remain vibrant” without protection); *see also* Meir, *supra* note 86, at 17 (asserting that fashion designs “have been harmlessly unprotected since time immemorial”).

141. Raustiala & Springman, *supra* note 29, at 1692.

142. A “status-conferring” or “positional” good is one that is valued not solely for its functional character, but also, and often more substantially, for its ability to confer an elevated status on its owner within the relevant social community. Barnett, *supra* note 139, at 1386. Relevant positional goods in the fashion industry include clothing, shoes, handbags, and other accessories such as eyewear and jewelry. *Id.*

143. Raustiala & Springman, *supra* note 29, at 1718–19, 1721.

144. *Id.* at 1722.



status. Once everyone starts dressing in that fashion by wearing the copies, the trendy person must buy into the next latest fashion to maintain his or her elevated status, thus starting the fashion cycle and the latest fashion-to-copy anew. Second, widespread copying, or even the often-cited “influencing,” “inspiring,” or “referencing” among designers, facilitates the identification of major trends, which in turn increases sales within the trend.<sup>145</sup> Third, not only are trends identified by copies, but once trends are established, copying serves as an expense-free means of advertisement, even “exaggerat[ing] the popularity” of designs within the trend.<sup>146</sup> Fourth, revenues of premier fashion designers are escalated due to their ability to charge a higher price or “snob premium” for authentic original designs as a result of the existence of knockoffs.<sup>147</sup>

Although a seemingly strong and cohesive argument, there are several problems with this economic analysis. First, underlying each premise, either explicitly or implicitly, is the idea that all fashion designs are “status goods,” whose brand name is commonly recognized. However, this category of easily-recognizable fashion houses is largely limited to premier or luxury designers. Secondly, the argument is based on the unproven assumption that the designers themselves could not generate the same economic benefits through intellectual property protection and their own production of “copies” through the use of lower-priced bridge lines.<sup>148</sup> Lastly, even assuming that each of these premises is true, and, therefore, that copying produces a financial benefit for designers as a result, this is not the end of the economic analysis. The economic benefits stem not from counterfeits and knockoffs generally, but, more narrowly, from counterfeits and knockoffs of clearly inferior quality. Combined, these arguments expose the flaws of the economic argument used by opponents to block proposed legislation protecting fashion designers from the theft of their creations.

---

145. *Id.* at 1728–32.

146. Barnett, *supra* note 139, at 1385; see also Seung-Hee Lee et al., *Do Fashion Counterfeits Function as a Promotion for Genuine Products?*, INT’L TEXTILE & APPAREL ASSOC. PROC. (2003), available at <http://www.itaonline.org/downloads/P2003-RES-LEESH-fashion-res081.pdf> (concluding, based on South Korean and Taiwanese study results, “manufacturers of genuine products need not worry about the rapidly growing circulation of counterfeits because revenue loss and brand equity dilution of the original do not result from counterfeits”).

147. Barnett, *supra* note 139, at 1358. For example, a “snob premium” can be justified by designers’ inclusion of authenticity certificates with their original works. *Id.* at 1401.

148. A bridge line fills the gap between luxury and ready-to-wear clothing by starting with the premier design and using cheaper materials and design variations to create a lower-priced design targeted at consumers who will not pay luxury prices, i.e., those that might buy counterfeits or copies of luxury designs. A bridge line, as used in this Comment, means a line of clothing with a distinct label as opposed to a product line under the same luxury name.

### A. Recognizable Luxury Designers Limitation

The premises outlined above in support of the argument that widespread copying financially benefits the original designers instead of stealing sales and revenues from them each rest, either implicitly or explicitly, on the idea that apparel confers a certain status on its owner. Yet, in order to confer this status, the source of the clothing must be recognizable to the viewer. Consequently, this category of “status-conferring” apparel is largely limited to luxury designers and the associated economic benefits are similarly limited. More specifically, the first premise—that widespread copying “induc[es] more rapid turnover and additional sales”—is explicitly based on the idea of fashion as a status-conferring good.<sup>149</sup> Although the primary proponents of this premise initially state that even clothing in the lowest-level category, directly above the commodity category, is a status-conferring good, their entire subsequent analysis is based on recognizable luxury designers.<sup>150</sup> As a result, the statement including non-luxury clothing in the economically beneficial argument has no support and therefore carries no weight. The second premise, that copying helps identify trends and therefore increases sales of the original, occurs initially at the highest level when luxury designers “reference” each other’s work. In other words, as demonstrated by the opening quote from *The Devil Wears Prada*,<sup>151</sup> trends are set by the luxury designers, and afterwards, trickle down to the masses through copying. Copying occurs after trends are identified, and therefore, copies cannot benefit the creator by serving as a means of trend-identification. Instead, after the luxury designers identify a trend, it can be transferred to the public generally through the designers’ lower-priced bridge lines<sup>152</sup> and through less expensive “references” as opposed to direct copies by the mass retailers. The third premise, that copying serves as an expense-free means

---

149. Raustiala & Springman, *supra* note 29, at 1722.

150. See *id.* at 1718–25. Examples used in their analysis include Gucci, Prada, Ugg, Chanel, Armani, and Dolce & Gabbana, all indisputably luxury designers with the exception of Ugg, which is arguably a luxury designer. *Id.* at 1718–28. As an interesting aside, Raustiala and Springman claim Ugg serve as “[a] recent example of the quick ascent and descent of a fashion item” in 2003 and 2004. *Id.* at 1720. However, despite widespread copying, which according to the premise facilitated this quick fashion cycle, the traditional models of Ugg were completely sold out in most stores at Christmas 2006. See Raakhee Mirchandani & Danica Lo, *Haute List: Ugg! Why Won't They Die*, N.Y. POST, Dec. 14, 2006, [http://www.nypost.com/seven/12142006/entertainment/fashion/haute\\_list\\_fashion\\_raakhee\\_mirchandani\\_and\\_danica\\_lo.htm?page=1](http://www.nypost.com/seven/12142006/entertainment/fashion/haute_list_fashion_raakhee_mirchandani_and_danica_lo.htm?page=1). Thus, copying did not serve to “induc[e] more rapid turnover and additional sales,” Raustiala & Springman, *supra* note 29, at 1722, and was not “a necessary predicate to . . . [the] swift cycle of innovation,” *id.* at 1691, but rather served only to steal sales from the original designer (at least when inventory was available), *id.* at 1722, 1691.

151. See *supra* text accompanying note 2.

152. See *infra* Part III.B. for a discussion of lower-priced bridge lines.

of advertisement, is based on the assumption that the sight of a copy will bring to mind the original designer's product. Again, this requires the recognition of the designer, which is largely limited to the category of luxury designers. The final premise, that copying allows original designers to charge a snob premium, is by definition limited to luxury designers, as only the elite consumers are willing to incur an increased cost in order to obtain the status associated with the high-end design.<sup>153</sup>

While these economic benefits of copying are achieved only by the limited recognizable luxury designers, "[the] American fashion industry is made of thousands of small businesses."<sup>154</sup> In 2004, more than one out of four of the 17,000 American fashion designers were self-employed.<sup>155</sup> It is this sizable group of emerging small designers, whose products do not necessarily confer status benefits on their owners due to the lack of recognition, who are in the greatest need of protection from piracy because these designers do not receive financial benefits through copying. As described previously,<sup>156</sup> the example used in the House Committee Hearing on Fashion Design Protection and H.R. 5055 is that of Ananas, a handbag label of a young wife and mother working from home, whose design was ripped off.<sup>157</sup> As a direct result of the availability of a lower priced identical handbag, a buyer cancelled his wholesale order and another potential customer skipped buying an Ananas bag in favor of a cheaper identical version available online.<sup>158</sup> Thus, outside of the class of luxury designers, copying functions not to award financial benefits to original designers, but rather to steal sales and revenues directly from them.

### B. *Potential for Lower-Priced Bridge Lines*

Another challenge to the argument that widespread copying has the counterintuitive effect of economically rewarding original fashion designers is its reliance on the unproven assumption that the designers themselves could not create this environment of widespread copying through the combination of copyright protection and lower-priced bridge lines. The papers of Barnett and of Raustiala and Springman, primary

---

153. Barnett, himself, expressly concedes that his analysis, which promotes both the third and fourth premises, is limited to "the luxury fashion-goods market." Barnett, *supra* note 139, at 1384.

154. *Hearing on H.R. 5055, supra* note 8, at 9 (testimony of Jeff Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America).

155. BUREAU OF LABOR STATISTICS, U.S. DEPT. OF LABOR, OCCUPATIONAL OUTLOOK HANDBOOK (2006), available at <http://www.bls.gov/oco/ocos291.htm>.

156. *See supra* text accompanying notes 15–17.

157. *Hearing on H.R. 5055, supra* note 8, at 78 (Jeffrey Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America).

158. *Id.*

proponents of the economic benefit theory, both argue that the introduction of copies or derivatives as part of lower-priced product lines tarnishes the brand image of luxury designers.<sup>159</sup> Thus, they continue, in order to avoid any reputational harm, designers do not utilize the “vertical differentiation” or “vertical integration” method.<sup>160</sup> However, as Raustiala and Springman concede, it is unclear whether if luxury designers developed distinct brands via bridge lines, instead of distinct product lines under the same label, the premier line’s image could be preserved *and* the original designers could achieve for themselves both the economic benefits of imitation and profits on sales of such imitations.<sup>161</sup> The argument against the success of this model is rather weak. It claims copyright protection would require luxury designers to create bridge lines in order to reach lower price levels, and because many designers in this category refuse to do so,<sup>162</sup> high-end fashion would exclusively reach the wealthy and the fashion cycle, and its economic benefits to designers, would be destroyed. Conversely, in recent actual practice, many luxury designers have increasingly created lower-priced bridge lines, such as Isaac Mizrahi for Target,<sup>163</sup> Donna Karen’s DKNY, Marc by Marc Jacobs, Armani’s Emporio Armani, Calvin Klein’s ck, Michael Kors’s MICHAEL, and Dolce & Gabbana’s D&G.<sup>164</sup> It

---

159. See Barnett, *supra* note 139, at 1407–08; Raustiala & Springman, *supra* note 29, at 1719–21.

160. See Barnett, *supra* note 139, at 1403–08 (“vertical differentiation”); Raustiala & Springman, *supra* note 29, at 1725 (“vertical integration”). Vertical differentiation or integration means self-appropriation through the use of cheaper materials and production methods and slight variations in design so that the designer is able to offer his original designs at a lower price. Barnett, *supra* note 139, at 1403; Raustiala & Springman, *supra* note 29, at 1725. This is often achieved through the establishment of bridge lines. See Raustiala & Springman, *supra* note 29, at 1725.

161. See Raustiala & Springman, *supra* note 29, at 1724–26 (suggesting that the risk to a premier line’s image might be subverted through the use of bridge lines, but acknowledging that many fashion firms shy away from this practice).

162. See *id.* at 1725–26 (“It is . . . clear, however, that often fashion firms do not price-discriminate via bridge lines even when they know others will do so.”).

163. See also George Epaminondas, *Bull’s-Eye Style*, TIME, Mar. 5, 2007, at 34–36 (describing other luxury designers who have teamed up with Target and competing mainstream retailers to combine high design and low prices).

164. See also Givhan, *supra* note 9 (“[D]esigners themselves are launching their own less expensive lines and licensing their names to mass merchants, their customers are no longer limited to those with vast sums of disposable income.”). *But see* Barnett, *supra* note 139, at 1406–07 (noting that vertical differentiation often “sullies the image (and consequently injures sales)” of top lines and that Pierre Cardin, Dior, and CK are examples of “brand over-extension”). These examples, when combined with the successful examples given above the line, show that, at the very least, it has not yet been conclusively established that a lower-priced bridge line model in an environment without IP protection would create reputational harm to the top line which would diminish sales. Even assuming the worst, it is unclear whether IP protection would induce more designers to create bridge lines and achieve the economic benefits associated with widespread copying, therefore diminishing the stigma generally associated with bridge lines.

follows that if luxury designers are, in fact, willing to create lower-priced bridge lines without copyright protection—which appears to be true given the increasing number of such distinct lines<sup>165</sup>—the damage to brand image must be a myth,<sup>166</sup> or at least economically beneficial in the long run.<sup>167</sup> Thus, copyright protection would only serve to exclusively award the profits from copies of fashion designs to the original designers without harming the economic benefits achieved through the existence of imitations and without denying fashion designs to lower income levels.<sup>168</sup>

### C. *Clearly Inferior Copies Limitation*

Most importantly, even assuming that unchecked copying is economically beneficial, it is not copying in general which confers these benefits, but rather only the making of clearly inferior copies. Barnett openly admits this assumption up front, conceding that “unauthorized imitation is generally imperfect.”<sup>169</sup> This general concept that “*imperfect* counterfeiting is likely to increase the revenues of legitimate producers,”<sup>170</sup> is prevalent throughout Barnett’s analysis; and thus, the imperfection of the copies becomes a condition of his economic benefit theory. The justification for this condition is fairly straightforward: the economic benefits derived from unchecked copying rely on the ability of the original design to confer status benefits to the owner.<sup>171</sup> In order to do so, the original must be clearly distinguishable from the copy. If, however, the

165. The increasing number of bridge lines reflects a change in the designers’ attitudes. For instance, after designer Marc Bauwer’s dress was ripped off by another company, he responded “we’re all for making more affordable clothes. Have us working for Target and H&M and others—but let it come from us. Do not counterfeit our designs in such a blatant manner.” Feitelberg, *supra* note 13.

166. So long as there is sufficient distinction between the premier line and any lower-priced bridge lines, the existence of the bridge lines should not diminish the status benefits conferred by ownership of the premier line, Raustiala & Springman, *supra* note 29, at 1725, particularly as more and more luxury designers introduce bridge lines.

167. In other words, any loss of customers to the premier line due to the existence of the bridge line and its consequent damage to the brand’s overall identity is economically outweighed by revenues from the bridge line itself.

168. The extension of copyright protection to fashion designs would not encourage luxury designers to eliminate bridge lines created when there was no protection. This is so because the primary focus of bridge lines is not to compete directly with, and therefore diminish the incentives of, copyists but to reach consumers who would not otherwise purchase the designs and therefore increase total sales. See, for example, the quote from designer Marc Bauwer, *supra* note 165.

169. Barnett, *supra* note 139, at 1385.

170. *Id.* at 1384 (emphasis added). In other words, Barnett constantly qualifies his economic benefit theory with language such as “provided such imitation is generally of a visibly imperfect nature.” *Id.* at 1412.

171. See *supra* Part III.A. Each of the underlying premises of the economic benefit theory depend on fashion design’s status as a positional good. *Id.*

copy were perfect, it would prevent consumers from distinguishing between it and the original. Because the imitator did not have to incur innovation and advertisement costs, it could charge a lower price, thus directly stealing sales from the original designer with no status consequence to the consumer.<sup>172</sup> Although Raustiala and Springman do not expressly concede this inferior copy condition, since their premises also rest on the provision that fashion designs are positional goods, their economic benefit argument, likewise, is conditioned on the imperfection of the copies. Critically, Barnett further concedes that many knockoffs are closer to the perfect end on the spectrum—from “perfect and identical” to “imperfect and clearly inferior” as “many of the better-made fakes are not distinguishable [from the original] except on closer inspection.”<sup>173</sup> It is not a difficult jump to predict that improved technology over time will enable copies to move even closer to perfection. Thus, economic benefits accruing to original designers from copies are limited to clearly inferior or imperfect ones and do not result from identical or perfect imitations.<sup>174</sup>

It is here in the economic-based theory where the “double-edged scissor”<sup>175</sup> emerges. Luxury designers financially benefit from the existence of widespread copies of clearly inferior quality, assuming that copies in lower-priced bridge lines created by the original designer himself could not replace this environment of widespread copies without tarnishing the image and thereby the profits of the luxury line. However, all other fashion designers, especially smaller, emerging ones, generate little economic benefit from the imitation of their original work, and neither luxury nor smaller fashion designers accrue any significant economic benefits from the existence of perfect imitations. Because economic benefits are not universal or even certain, some form of additional protection for fashion designs is needed.

#### IV. FASHION DESIGN PROTECTION: E.U. DIRECTIVE 98/71/EC AND H.R. 5055

This section will review the existing E.U. protection of fashion designs and the most recently failed U.S. bill. Both the existing E.U. protection and H.R. 5055 provide too much protection for those who do not need it and fail to provide protection for those who do need it, and hence,

---

172. See Barnett, *supra* note 139, at 1412–13 n.82.

173. *Id.* at 1393.

174. Even if the less extreme position is taken, that the existence of widespread copies does not economically harm original designers, it is still limited to imperfect copies because perfect copies cause economic harm to original designers.

175. Medenica, *supra* note 1, at S14.

instead of improving protection for fashion design, inflict the dual cuts of a “double-edged scissor.”

A. *E.U. Directive 98/71/EC*

While fashion design remains unprotected in the United States, it is afforded double protection in Europe under the national laws of the individual European countries and the European Directive on the Legal Protection of Designs<sup>176</sup> (“E.U. Directive”). At the outset, it is important to note that these two sources provide entirely distinct protections. In other words, if a fashion designer fails to register his design with the Office for Harmonisation in the International Market (“OHIM”), as is required by the E.U. Directive, he is not precluded from seeking protection under the laws of his European state.<sup>177</sup>

While all subject to the E.U. Directive, many nations within the E.U. provide a different, additional level of protection under national law. For instance, in France, “[c]reations of the fashion industries” are among the non-exhaustive list of those “works of the mind” that are protected by copyright.<sup>178</sup> France, the home of “*haute couture*,”<sup>179</sup> affords perhaps the most liberal copyright protection to fashion under the “doctrine of the unity of art,” which does not permit excluding copyright protection solely on the basis of the work’s utilitarian function.<sup>180</sup> France further expands protection by not requiring originality, instead “provid[ing] copyright protection once the design becomes popular with the general public.”<sup>181</sup> Perhaps most importantly, designers do utilize this protection, as perhaps most famously evidenced by Yves Saint Laurent’s (“YSL”) injunction and \$385,000 monetary judgment against Ralph Lauren for its “theft” of YSL’s

176. Council Directive 98/71, 1998 O.J. (L 289) 28 (EC). Implementation by the twenty-five Member States was required not later than October 28, 2001. *Id.* art. 19, § 1.

177. *Id.* art. 16–17.

178. Andres Lucas et al., *France*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 2(2) (Paul Edward Gellar ed., 2006) (quoting the French Intellectual Property Code, L 112-2).

179. In France, *haute couture* confers legal permission to use the label only on those designers designated as such by the *Chambre de commerce et d’industrie de Paris*. Currently, there are only eight official *haute couture* designers: Armani Prive, Chanel, Christian Dior, Christian Lacroix, Elie Saab, Givenchy, Jean Paul Gaultier, and Valentino. However, recently the term has been loosely used to also include specific fashions that are custom created for an individual customer with high quality fabrics, using extensive hand construction and a seemingly excessive cost. See generally DIANA DE MARLEY, THE HISTORY OF HAUTE COUTURE 1850–1950, 1980 (elaborating on the *haute couture* qualification and history).

180. Lucas, *supra* note 178, § 2(4)(c).

181. Medenica, *supra* note 1, at S14.

*haute couture* black and white evening dress inspired by a man's dinner jacket.<sup>182</sup>

The laws of the United Kingdom provide another example. In that nation, protection for fashion designs “may arise under three regimes: (i) copyright in artistic works, (ii) unregistered design rights, or (iii) registered design rights.”<sup>183</sup> Under this scheme, a fashion design is awarded copyright protection “as long as it can be related back to a copyrighted drawing.”<sup>184</sup> Finally, Italian copyright law extends protection to “[w]orks of industrial design displaying creative character and *per se* artistic value.”<sup>185</sup> Although, the Italian standard is much more stringent than the French one, as it requires registration, novelty, and individual character,<sup>186</sup> it nonetheless provides some level of protection for fashion designers.

Beyond this protection offered on an individual basis at the national level, the E.U. Directive mandates legislation creating a “design right” to be implemented by all twenty-five E.U. member states. The objective is to unify design protection laws in E.U. member states to facilitate free trade.<sup>187</sup> To qualify for protection, a design must be registered, display novelty, and have individual character.<sup>188</sup> The novelty element requires that no identical design, including one that differs only in immaterial details, has been made public before the date of registration.<sup>189</sup> The individual character element requires that the design does not produce the same overall impression on an informed user as an already public design.<sup>190</sup> The design right grants the original designer the exclusive right to use his design and any design that produces the same overall impression and the right to prevent any third party from using it without his consent.<sup>191</sup> Although the degree of freedom—meaning the level of possible interaction between the two designers during the creation stages<sup>192</sup>—is taken into

---

182. See *Societe Yves Saint Laurent Couture S.A. v. Societe Louis Dreyfus Retail Mgmt. S.A.*, Tribunal de Commerce Paris [Trib. Comm.] [Commercial Court] May 8, 1994, E.C.C. 512 (Fr.). The Commercial Court held that Ralph Lauren's adaptation of YSL's *haute couture* dress for its ready-to-wear collection with only slight modifications in length, fabric, and buttons infringed on YSL's exclusive right to use of its “creative” features of its design. *Id.* at 514.

183. Lionel Bently & William Cornish, *United Kingdom*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 2(4)(c) (Paul Edward Gellar ed., 2006).

184. Medenica, *supra* note 1, at S14.

185. Alberto Musso & Mario Fabiam, *Italy*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 2(4)(c)(i) (Paul Edward Gellar ed., 2006) (quoting Italian Copyright Act art. 2).

186. *Id.*

187. See Council Directive 98/71, 1998 O.J. (L 289) 28 (EC).

188. *Id.* art. 3, §§ 1–3.

189. *Id.* art. 4.

190. *Id.* art. 5, § 1.

191. *Id.* art. 12, § 1.

192. *Id.* art. 9, § 2. Although the “degree of freedom” is not defined, it seems to create a sliding standard based on the potential interaction between two designers. For example, if there



consideration when determining the similarity between the overall impressions created by two designs,<sup>193</sup> the design right ultimately protects against deliberate copying and independent creation of a sufficiently similar design. This exclusive right lasts for “one or more periods of five years . . . up to a total term of 25 years.”<sup>194</sup>

The combination of the E.U. Directive’s distinct “design right” and the copyright laws of the European states<sup>195</sup> have the potential to provide substantial protection for original fashion designs.<sup>196</sup>

### B. H.R. 5055

H.R. 5055, the Design Piracy Prohibition Act, was introduced in Congress on March 30, 2006, but was cleared at session’s end before ever becoming law.<sup>197</sup> The stated purpose of H.R. 5055 was to “prevent anyone from copying an original clothing design in the United States and give designers the exclusive right to make, import, distribute, and sell clothes based on their designs.”<sup>198</sup> H.R. 5055 more closely reflected the individual national laws of the European states than the E.U. Directive because it provided for an extension of existing copyright law rather than the creation of a distinct right. H.R. 5055 would have required registration and originality, the latter of which would have been satisfied if the design “provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.”<sup>199</sup> H.R. 5055 would not extend protection for fashion designs that were a staple or commonplace, dictated solely by a utilitarian

---

were no possibility that the two designers had any contact during the creation of the designs, then the designs would have to be more similar for a violation of the E.U. Directive to exist than if there was a strong possibility that the two designers interacted during creation. For example, A.B.S., *see supra* note 11 and accompanying text, and Anand, *see supra* note 135 and accompanying text, would fall into the latter category since they both openly concede that the starting point for their “designs” is other designers’ creations. The purpose of considering the degree of freedom is most likely to try to avoid punishing designers who contemporaneously and unintentionally create a design similar to another designer. However, the E.U. Directive still penalizes unintentional copying when two designs are sufficiently similar. *See* Council Directive 98/71, art. 9 § 1, 1998 O.J. (L 289) 28 (EC).

193. *See id.* art. 9, § 1.

194. *Id.* art. 10.

195. Protection is independently available under both the E.U. Directive and the individual E.U. Member State’s laws because the E.U. Directive explicitly provides that it does not prejudice the law of the Member State. *See id.* art. 16–17.

196. The E.U. Directive and the European copyright laws only have the potential to protect fashion design because they are currently underutilized by fashion designers. *See* Raustiala & Springman, *supra* note 29, at 1740–43. The implications of this underutilization will be discussed *infra* Part V.

197. *See* H.R. 5055, 109th Cong. (2006).

198. Henry Lanman, *Copycatfight*, SLATE, Mar. 13, 2006, <http://www.slate.com/id/2137954>.

199. H.R. 5055, 109th Cong. § 1(a) (2006) (amending 17 U.S.C. § 1301).

function, or different from a staple or commonplace only in insignificant details.<sup>200</sup>

As compared to the E.U. Directive, H.R. 5055 would have protected only against designs “copied from a design . . . , or from an image thereof, without the consent of the owner of the protected design,”<sup>201</sup> and not against independent designs created without knowledge or reasonable grounds to know that the design is protected;<sup>202</sup> the E.U. Directive protects against both deliberate copying and independent creation of a similar design.<sup>203</sup> H.R. 5055 would have provided protection for only three years,<sup>204</sup> whereas the E.U. Directive allows for protection for up to twenty-five years.<sup>205</sup> Even though H.R. 5055 would have provided significantly narrower protection for fashion designs than the E.U. Directive, it failed to become law,<sup>206</sup> and thus, American fashion designers are stuck with the limited protections described in Part I.

#### V. PRIVATE FASHION DESIGN RIGHT

Since H.R. 5055 failed, the existing level of protection for American fashion designers is not sufficient. However, fashion designers, as the equivalent of artists, deserve protection, and not all of them garner economic benefits through widespread copying. Even those who do receive financial benefits do so only from a narrower class of clearly inferior copies as opposed to copies generally. Some more comprehensive form of fashion design protection is needed. This Comment proposes a private fashion design right enforced in civil actions by the infringed designer as the ideal form.<sup>207</sup>

---

200. § 1(b) (amending 17 U.S.C. § 1302).

201. § 1(d)(2) (amending 17 U.S.C. § 1309(e)).

202. § 1(d)(1) (amending 17 U.S.C. § 1309(c)).

203. See *supra* notes 192–93 and accompanying text.

204. H.R. 5055 § 1(c) (amending 17 U.S.C. § 1305(a)).

205. Council Directive 98/71, art. 10, 1998 O.J. (L 289) 28 (EC).

206. As noted earlier, see *supra* note 27, Senator Charles E. Schumer has recently introduced a bill into the Senate to amend the Copyright Act to include fashion designs, see Design Piracy Prohibition Act, S. 1957, 110th Cong. (2007). S. 1957 is virtually identical to H.R. 5055 with one substantive exception. Compare *id.* with H.R. 5055. S. 1957 creates an independent infringement standard for fashion designs, see S. 1957 § 2(d)(2)(B)–(C) (no infringement if design “is original and not closely and substantially similar in overall visual appearance to a protected design”), as opposed to clumping fashion designs into the preexisting vessel hull design standard, see H.R. 5055 § 1(d).

207. In denying the application of a design patent to a handbag, the Second Circuit recognized back in 1936 that “perhaps new designs ought to be entitled to a limited copyright.” *Nat Lewis Purses, Inc., v. Carole Bags, Inc.*, 83 F.2d 475, 476 (2d Cir. 1936) (per curiam). That is precisely what this Comment proposes.

The proposed design right has three key features. First, similar to the E.U. Directive, the protection would be distinct from copyright. The primary advantage of, or even need for, the distinction is to give fashion designers and the courts the ability to avoid confrontation with the utilitarian doctrine entrenched in copyright law. While there is a fundamental category of fashion design at the subsistence level that aims to serve the utilitarian clothing function exclusively, a large majority of fashion designs—particularly *haute couture*—are created, purchased, and worn for reasons largely independent from their clothing function.<sup>208</sup> As a result, the utilitarian limitation on copyright is misguided and inappropriate in the fashion industry.

Second, similar to H.R. 5055, the design right would confer protection on designs for three years,<sup>209</sup> as opposed to the twenty-five year period available in the E.U.,<sup>210</sup> with no possibility for renewal. Three years is sufficient to provide protection for “the typical market lifespan for a fashion design,”<sup>211</sup> yet it does not preclude the “historical cycling”<sup>212</sup> that is inherent in fashion design. Cycling is commonplace in the fashion industry, and the result of cycling is the unoriginality of a “new” design, which reintroduces a design of a past fashion era. A clear example of the cycling phenomenon can be seen in the current leggings trend, which originally gained great popularity in the 1980s. A three year design right would in no way interfere with this historical cycle, while twenty-five year protection may.

Third, and most importantly, the design right would be a private cause of action, allowing for selective enforcement at the election of the designers. Because, “[p]ractically speaking, it would be difficult to formulate and implement a statute that proscribed only perfect counterfeiting,”<sup>213</sup> selective enforcement is necessary and is achieved by eliminating the possibility for government enforcement of the design right. This feature is critical because it maintains the current situation in which economic benefits accrue to luxury designers from the existence of inferior

---

208. See, e.g., *supra* note 142 (describing “status-conferring” or “positional” goods).

209. A bill that “almost became law” in 1928—it passed in the House but failed in the Senate—provided protection that would “extend for two years with an eighteen month extension,” a time period similar to the one proposed. Young, *supra* note 83, at 104–05 (citing H.R. 9358, 70th Cong. (1928)).

210. See Council Directive 98/71 art. 10, 1998 O.J. (L 289) 28 (EC).

211. James Nguyen, *Copyright In Vogue: The Proposed Design Piracy Prohibition Act*, IP LAW 360, Nov. 28, 2006, available at [http://www.foley.com/files/tbl\\_s31Publications/FileUpload137/3648/IPLaw360\\_DesignAct.pdf](http://www.foley.com/files/tbl_s31Publications/FileUpload137/3648/IPLaw360_DesignAct.pdf).

212. Posting of Christopher Springman to the Faculty Blog, [http://uchicagolaw.typepad.com/faculty/2006/11/fashions\\_piracy.html](http://uchicagolaw.typepad.com/faculty/2006/11/fashions_piracy.html) (Nov. 3, 2006, 19:44 EST) (discussing his piece *The Piracy Paradox*).

213. Barnett, *supra* note 139, at 1416.

copies by allowing these designers to choose not to enforce their exclusive design right against this particular category of copiers. At the same time, designers could enforce their design rights against those virtually indistinguishable imitations which confer no financial benefits. The registration requirement in both the E.U. Directive<sup>214</sup> and H.R. 5055<sup>215</sup> in effect allows selective enforcement but on the wrong basis. Under the registration scheme, designers choose which designs to protect, if any, rather than which copiers to pursue;<sup>216</sup> conversely under the design right, designers could elect to enforce their protective right against nearly identical copiers and ignore imperfect copiers. Thus, the design right would eliminate the registration requirement. In balance, similar to H.R. 5055<sup>217</sup> and unlike the E.U. directive,<sup>218</sup> the design right would only impose liability for deliberate copying and not for independent designs created without knowledge of the original.<sup>219</sup> This narrower potential for liability would eliminate the need for registration because any deliberate copier creating perfect knockoffs would necessarily have knowledge of the original design independent of any registered designs list. Most importantly, this narrower liability potential would still achieve the purpose of the design right because the targeted perfect copies are necessarily deliberate point-by-point copies of the original and not independent creations. The availability of selective enforcement at the election of the designers themselves is the critical feature of the design right, and its incorporation into a future bill proposal would remove those opponents whose argument against fashion design protection is primarily economic.

In addition to the economic argument, another main argument against extending protection to fashion designers in the United States is the lack of utilization of the design right by designers in the European Union.<sup>220</sup> However, these opponents employ the wrong focus. Because fashion designers are deserving of protection, the correct focus is on the availability of protection and not on how many choose to enforce it. In the software industry, “software producers often decline to take enforcement actions

---

214. Council Directive 98/71, art. 3, § 1, 1998 O.J. (L 289) 28, 30 (EC).

215. H.R. 5055, 109th Cong. § 1(e)(1) (2006).

216. *See id.* (stating that “protection . . . shall be lost if application for registration of the design is not made”).

217. *See supra* text accompanying notes 201–02.

218. *See supra* text accompanying notes 191–93.

219. This is consistent with U.S. copyright law, which protects only “original works,” 17 U.S.C. § 102 (2000) (emphasis added), a category that includes works that are exact replicas of existing works so long as they were independently created, *see* Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 338, 345–46 (1991) (“To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original, and, hence, copyrightable.”).

220. *See* Raustiala & Springman, *supra* note 29, at 1740–42.

against counterfeiters,"<sup>221</sup> yet their underutilization of protection has had no effect on the availability of that protection. H.R. 5055's support by major fashion designers—specifically Zac Posen, Narcisco Rodriguez, and Diane von Furstenberg—suggests design protection, if available, would be utilized in the United States.<sup>222</sup> Assuming support for the bill correlates with use if it became law, this support further suggests American designers may more closely mirror Australian designers, in that they may be more willing to pursue legal protection if available. For instance, an Australian designer, explaining why his company, Scanlan & Theodore, brought three recent suits for copyright infringement, proclaimed "[copying] has not only a financial effect but, more importantly, erodes customer confidence in the exclusivity and value of our work."<sup>223</sup> Similarly, an Australian jean designer for celebrities, Bettina Liano, asserted "[i]t's not fair on my customers . . . [t]hey buy Bettina Liano—they don't want to see a lot of cheap copies around on the streets."<sup>224</sup> Finally, the proposed design right would not require registration of individual designs as is required under the E.U. Directive.<sup>225</sup> This registration requirement and, more importantly, the fees associated with registration may be the primary cause of the underutilization of available protection. In other words, registration does not survive a cost-benefit analysis for most designs largely because designers are unsure beforehand which designs will become the "it-designs" and, as a result, be subject to virtually indistinguishable copies. The proposed design right, by eliminating this registration requirement and therefore the upfront cost, would allow designers to seek protection only when economically beneficial—against nearly identical imitations. Thus, the lack of utilization of available protection in Europe is not persuasive.

## CONCLUSION

Fashion designers, as artists, are deserving of protection for their original works under Article I of the U.S. Constitution, and the status quo is not sufficient. The economic argument against protection is flawed when applied to smaller, non-luxury designers such as Ananas and when applied

---

221. Barnett, *supra* note 139, at 1413 n.84.

222. Lynn J. Alstadt, *House Considers Protection for Fashion Designs*, WORLD COPYRIGHT LAW REPORT, June 22, 2006, at 1, <http://www.buchananingersoll.com/media/pnc/7/media.1257.pdf>; see Givhan, *supra* note 9 (noting the support of the above mentioned designers as well as designers Nicole Miller, Narcisco Rodriguez, and Richard Lambartsom for S. 1957); see also *Thinking of Buying a Fake? Get Real*, HARPER'S BAZAAR, Oct. 2007, at 68 (advertising for the "Fakes are Never in Fashion" promotion by Harper's Bazaar Magazine, which suggests further potential support for the proposed design right).

223. Safe, *supra* note 10.

224. *Id.*

225. Council Directive 98/71, art. 3, § 1, 1998 O.J. (L 289) 28 (EC).

to identical copies. Nonetheless, as a compromise, protection should be narrowly tailored to avoid eliminating the economic benefits accruing to luxury designers with easily recognizable products, assuming that these luxury designers could not themselves create the economically beneficial environment of widespread copying through IP protection and bridge lines. This Comment proposes that the solution that balances these competing interests is a design right—distinct from copyright to prevent confusion with the utilitarian doctrine—that includes the right for private designers to pursue infringers, allowing for selective enforcement at their election. The design right would permit the filtering down effect alluded to in the opening quotation from *The Devil Wears Prada*,<sup>226</sup> while protecting the original designs from identical counterfeits at the outset.

EMILY S. DAY

---

226. See *supra* note 2 and accompanying text.