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## Style Piracy Revisited

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## STYLE PIRACY REVISITED

*Safia A. Nurbhai\**

### INTRODUCTION

The fashion industry is an international multi-billion dollar business, one in which sales of general merchandise and apparel alone were estimated at \$784.5 billion dollars in 1999.<sup>1</sup> The public today is aware of high-end designers from cable stations and entertainment shows that center on fashion, as well as from various magazines and Internet sites.<sup>2</sup> Consumer knowledge of high-end fashion spurs the demand for designer products. As a result, style piracy—the copying of a designer’s original designs, “thereby securing, without expense, the benefit of his artistic

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<sup>1</sup> Apparel Industry Website, at [http://www.activemedia-guide.com/retailing\\_industry.htm](http://www.activemedia-guide.com/retailing_industry.htm) (last visited Mar. 18, 2002).

<sup>2</sup> Television stations such as the Style Channel, Metro TV, and Entertainment Television have various shows centered on fashion design. Metro TV airs fashion shows twenty-four hours a day during Fashion Week. Television shows, such as Access Hollywood and Extra, critique the dresses worn by Hollywood stars at awards shows, such as the Oscars. Magazines such as Vogue and Cosmopolitan advertise designer fashions in each issue.

work”<sup>3</sup>—has become more popular. In fact, style piracy has become “a way of life in the garment business.”<sup>4</sup> Copying, or “knocking off,” the work of creative designers is “standard operating procedure for many [companies] both large and small.”<sup>5</sup> Not surprisingly, many designers oppose “knocking off”<sup>6</sup> and continue to seek federal legislation to protect their works.<sup>7</sup>

Design pirates sometimes use covert methods to uncover what other designers are creating.<sup>8</sup> “It is not uncommon for design pirates to sneak into a designer’s fashion show in Paris (or raid the studio’s trash for sketches) and have ‘knock-offs’ available in New York the next day.”<sup>9</sup> In *Johnny Carson Apparel, Inc. v. Zeeman Mfg. Co.*,<sup>10</sup> the plaintiff researched and developed a suit with “a distinctive design combination [on the] pocket treatment and stitching.”<sup>11</sup> The designer spent substantial time and money to create and promote this suit,<sup>12</sup> and, as a result, the item

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<sup>3</sup> *Wolfenstein v. Fashion Originator’s Guild of Am.*, 244 A.D. 656, 657 (N.Y. 1935).

<sup>4</sup> J. JARNOW, M. GUERREIRO & B. JUDELLE, *INSIDE THE FASHION BUSINESS: TEXT AND READINGS* 28 (4th ed. 1987).

<sup>5</sup> *Id.* at 150.

<sup>6</sup> PAUL R. PARADISE, *TRADEMARK COUNTERFEITING, PRODUCT PIRACY, AND THE BILLION DOLLAR THREAT TO THE U.S. ECONOMY* 77 (1999).

<sup>7</sup> Rocky Schmidt, Comment, *Designer Law: Fashioning a Remedy for Design Piracy*, 30 *UCLA L. REV.* 861, 862 (1983).

<sup>8</sup> *Id.*; Stuart Jay Young, *Freebooters in Fashions: The Need for a Copyright in Textile and Garment Designs*, 9 *COPYRIGHT L. SYMP. (ASCAP)* 76, 103 n.10 (1958).

<sup>9</sup> Jennifer Mencken, *A Design for the Copyright of Fashion*, B.C. *INTELL. PROP. & TECH. F.* 121201 n.75 (1997), available at [http://www.bc.edu/bc\\_org/avp/law/st\\_org/iptf/articles/content/1997121201.html](http://www.bc.edu/bc_org/avp/law/st_org/iptf/articles/content/1997121201.html).

<sup>10</sup> 203 U.S.P.Q. 585 (N.D. Ga. 1978).

<sup>11</sup> *Id.* at 588.

<sup>12</sup> “One estimate of the cost of producing a ‘sample line’ is \$25,000.” Leslie J. Hagin, *A Comparative Analysis of Copyright Laws Applied to Fashion Works: Renewing the Proposal for Folding Fashion Works Into the United States Copyright Regime*, 26 *TEX. INT’L L.J.* 341, 388 n.25 (1991) (citing Telephone Interview with Bob Berkowitz, Chairman of the Board, Apparel Guild (Apr. 27, 1990) (documentation on file with the Texas International Law Journal)).

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became quite popular.<sup>13</sup> The defendant purchased one of plaintiff's suits, had it copied by his designers, and returned the original suit for a refund.<sup>14</sup> Thereafter, cheaper copies appeared on the market.<sup>15</sup>

Design piracy is unfair to designers and detrimental to competition. It is unfair to allow design pirates to reap the benefits of the original designer's creativeness, labor and risk-taking.<sup>16</sup>

Copying destroys the style value of dresses which are copied. Women will not buy dresses at a good price at one store if dresses which look about the same are offered for sale at another store at half those prices. For this reason, copying substantially reduces the number and amount of reorders which the original creators get. With this uncertainty with respect to reorders, original creators cannot afford to buy materials in large quantities as they otherwise would. This tends to increase the cost of their dresses and the prices at which they must be sold.

Reputation for honesty, style, and service is an important asset of retailers. Copying often injures such a reputation. A customer who has bought a dress at one store and later sees a copy of it at another store at a lower price is quite likely to think that the retailer from whom she bought the dress lacks ability to select distinctive models and that she has been overcharged. Dresses are returned and

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<sup>13</sup> See *Johnny Carson Apparel*, 203 U.S.P.Q. at 588.

<sup>14</sup> *Id.* The court held that while there is a great similarity in the style of the plaintiff's and defendants' suits, defendants had a right to copy the style. *Id.* at 593. The decisive question was whether defendant's methods of promotion created a likelihood of confusion in the public mind as to the source of the garments. *Id.* at 594. The court found that there was "no evidence of actual confusion." *Id.* at 595. The court found that the defendants, while acting with an improper intent, carried out their promotional scheme in such an inept fashion—whether deliberately or not—that plaintiff's rights were not disturbed. *Id.*

<sup>15</sup> *Id.* at 595. "Plaintiff discontinued the model at least in part in response to complaints from its dealers about cheap imitations." *Id.* at 593.

<sup>16</sup> See Hagin, *supra* note 12, at 364.

customers are lost.<sup>17</sup>

“Recent studies suggest that industrial design . . . cannot yield long-term rewards to innovators if the short-term profits from successful innovation are consistently appropriated by free-riders who do not share the costs and risks of the creative process.”<sup>18</sup> As a result, over time, the designers whose talents and designs are being pirated will “be driven out of target markets by cut-throat competitors who never adequately fund the process of design innovations.”<sup>19</sup>

Those opposed to the idea of apparel designs receiving any type of governmental protection argue that there is both a public welfare and an economic interest in allowing garments to be copied and sold at a cheaper price.<sup>20</sup> Arguably, the copyist is satisfying a public demand by supplying consumers with copies because the consumer is either unable or unwilling to spend the money necessary for the originals.<sup>21</sup> This reflects a process known as the style cycle that has long been recognized in the fashion industry.<sup>22</sup>

According to this theory, the wealthy class sets the fashion trends because they wish to be distinctive.<sup>23</sup> A second group of consumers emulates the first group and so on down the chain.<sup>24</sup> The lower classes buy cheaper adaptations of the styles.<sup>25</sup> Presumably, by the time a style reaches the masses, the trend has become commonplace and has already become abandoned by the trendsetters.<sup>26</sup>

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<sup>17</sup> See *id.* at 364-65 (citing *Wm. Filene's Sons Co. v. Fashion Originators' Guild of Am.*, 90 F.2d 556, 558 (1st Cir. 1937)).

<sup>18</sup> J.H. Reichman, *Design Protection and the Legislative Agenda*, 55 L. & CONTEMP. PROBS. 281, 283 (1992).

<sup>19</sup> *Id.* at 284.

<sup>20</sup> Kenneth D. Hutchinson, *Design Piracy*, 18 HARV. BUS. REV. 191, 194 (1939-40).

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> *Id.* at 195.

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> *Id.*

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Although the style cycle theory still exists, modern-day technology has given the masses access to copies of original designs much sooner than in the past.<sup>27</sup> With the advent of television and the Internet, the fashions worn by the wealthy class are seen immediately and can be copied overnight.<sup>28</sup> While some imitation is desirable for fashion to proliferate,<sup>29</sup> Congress needs to set a limit. Unless designers feel secure that they will profit from their creations, their incentive to create new works will dwindle.<sup>30</sup>

The Copyright Act is the appropriate form of protection for apparel designs because “one purpose of copyright protection is to provide equity to the artist,”<sup>31</sup> which “allow[s] the creator of a work of art to enjoy the rewards of his effort”<sup>32</sup> and encourages artistic creation.<sup>33</sup> One of the most substantial things that design pirates steal is the original designer’s equity because the pirates sell imitations of the original design at cheaper prices; thus, some have called for copyright law to be amended to include protection for apparel designs.<sup>34</sup>

The issue of design protection is “one of the most significant and pressing items of unfinished business” of copyright revision.<sup>35</sup> This note explores the history of design protection in the United States and critiques the current state of the law as

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<sup>27</sup> Peter K. Schalestock, *Forms of Redress for Design Piracy: How Victims can use Existing Copyright Law*, 21 SEATTLE U. L. REV. 113, 115 (1997).

<sup>28</sup> *Id.*

<sup>29</sup> See Hutchinson, *supra* note 20, at 193.

<sup>30</sup> S. Priya Bharathi, Comment, *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, 1671 (1996).

<sup>31</sup> See *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (“Creative work is to be encouraged and rewarded . . . . The immediate effect of our copyright law is to secure a fair return for an ‘author’s creative labor.’”).

<sup>32</sup> See Schmidt, *supra* note 7, at 873.

<sup>33</sup> See *id.* at 874.

<sup>34</sup> See Bharathi, *supra* note 30, at 1670.

<sup>35</sup> Barbara Ringer, *The Unfinished Business of Copyright Revision*, 24 UCLA L. REV. 951, 976 (1977).

applied to the protection of garment designs. It also recommends that Congress add a new chapter to Title 17 of the U.S. Code specifically geared toward the protection of apparel designs. Congress should extend the boundaries of copyright protection in order to encourage the “progress of science and useful arts”<sup>36</sup> and to reward the efforts of fashion designers.

## I. HISTORY OF DESIGN PROTECTION

### A. Protection Under the Early Copyright Statutes

The Copyright Act of 1976 only protects “original works of authorship.”<sup>37</sup> The first copyright statute, passed in 1790, protected only maps, charts, and books.<sup>38</sup> Over the years, however, copyright protection was extended to “literary works, musical works, dramatic works, pantomimes and choreographic works, pictorial, graphic, and sculptural works, motion pictures, other audiovisual works, and sound recordings.”<sup>39</sup> Since its inception, copyright law has continued to evolve.<sup>40</sup> Specifically, protection has been extended as technology has advanced.<sup>41</sup>

Although three-dimensional objects were granted copyright protection in 1870, when protection was granted to “painting, drawing, chromo, statue, statuary, and . . . models or designs intended to be perfected as works of the fine arts,”<sup>42</sup> the phrase “fine arts” excluded designs of useful articles, such as apparel designs.<sup>43</sup> In 1909 the Copyright Act was revised, and the word

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<sup>36</sup> The Constitution expressly gives Congress the right “to 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.” U.S. CONST. art. I, § 8, cl. 8.

<sup>37</sup> 17 U.S.C. § 102(a) (2000).

<sup>38</sup> 1 Stat. 124 (1790).

<sup>39</sup> 17 U.S.C. § 102 (2000).

<sup>40</sup> See Hagin, *supra* note 12, at 346-47.

<sup>41</sup> See *id.*

<sup>42</sup> Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (repealed 1916).

<sup>43</sup> See Young, *supra* note 8, at 81.

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“fine” was dropped.<sup>44</sup> It thus appeared that useful articles could gain protection.<sup>45</sup> To the disappointment of fashion designers, however, although the new law did not differentiate between “fine arts” and arts that have a useful function, a 1910 Copyright Office regulation did.<sup>46</sup> Regulation 12(g) provided:

Works of art—This term includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture.)

Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.

No copyright exists in toys, games, dolls, advertising, novelties, garments, laces, woven fabrics, or any similar articles.<sup>47</sup>

At the time, the prospect of protection for fashion design seemed hopeless because garments undeniably serve a utilitarian purpose.<sup>48</sup> Thus, the fashion industry decided to take matters into its own hands.<sup>49</sup>

In 1935 the Fashion Originator’s Guild of America formed a trade association of garment manufacturers and retailers whose mission was to protect designers from style piracy.<sup>50</sup> Retailers and manufacturers signed a “declaration of cooperation” wherein they pledged to deal only in original creations.<sup>51</sup> The Guild had an extensive design registration bureau, and as part of the

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<sup>44</sup> *See id.*

<sup>45</sup> In § 5(g) of the 1909 Act, “works of art; models or designs for works of art” were listed among articles eligible for copyright protection.

<sup>46</sup> *See Young, supra* note 8, at 81-82.

<sup>47</sup> *See id.* at 82 (citing WEIL, AMERICAN COPYRIGHT LAW 625 (1917)). In *White v. Lombardy Dresses*, 40 F. Supp. 548, 551, (S.D.N.Y. 1941), the court said, “It may be that new designs ought to be entitled to a limited copyright, but that remedy is with Congress.”

<sup>48</sup> *See Young, supra* note 8, at 83.

<sup>49</sup> *See id.* at 106.

<sup>50</sup> *See id.* at 107.

<sup>51</sup> *Fashion Originators’ Guild of Am. v. FTC*, 312 U.S. 457, 461-62 (1941).



enforcement procedures, the bureau sent its most potent weapon, the little red card, to all “non-cooperating retailers.”<sup>52</sup> Guild members were forbidden from dealing with a red-card holder under penalty of large fines.<sup>53</sup>

The Guild was highly effective. In fact, in 1936, the Guild controlled 60% of the market for women’s clothes that cost at least \$10.75 and 38% of all women’s garments wholesaling at \$6.75 and up.<sup>54</sup> Although the Fashion Originator’s Guild of America was successful in combating design piracy, the Guild was shut down in 1941 by the Supreme Court because its collective practices were found to violate the Sherman Anti-Trust Act.<sup>55</sup> Thus, the garment industry was left with the Copyright Act of 1909 as its only source of protection.

In 1949 the Copyright Office expanded the scope of articles to which copyright protection was available by broadening the definition of “works of art.”<sup>56</sup> The amendment read as follows:

§ 202.8 Works of art. (Class G)-(a) in general. This class includes works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings, and sculpture.<sup>57</sup>

At the time, many hoped the Copyright Office would eventually

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<sup>52</sup> See Young, *supra* note 8, at 107.

An extensive design registration bureau containing the designs registered by Guild members was maintained. The [red] cards were sent to all members from time to time bearing on their face, the name of a “non-cooperating” retailer. Henceforth all other members of the Guild were forbidden to deal with that retailer under penalty of large fines.

*Id.*

<sup>53</sup> *Fashion Originators’ Guild of Am.*, 312 U.S. at 463.

<sup>54</sup> *Id.* at 462.

<sup>55</sup> *Id.* at 467-68. The Court’s rationale was that the Guild’s practices substantially lessened competition and tended to create a monopoly.

<sup>56</sup> Cameron K. Wehringer, *Dress Designs: Time Protection and Copyrights*, 50 J. PAT. OFF. SOC’Y 824 (1958).

<sup>57</sup> 37 C.F.R. § 202.8(a) (1952).

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broaden its definition of works of art to include apparel designs because garments contain artistic expression, but the Copyright Office did no such thing.<sup>58</sup> Instead, the Copyright Office and the courts took the position that fashion's dominant function is utilitarian.<sup>59</sup> Advocates for the protection of apparel designs, on the other hand, maintained that while clothing does cover the human body, its primary market value rests not in its function, but in its appearance.<sup>60</sup>

In 1954, the U.S. Supreme Court ratified the 1949 regulation in *Mazer v. Stein*,<sup>61</sup> the leading case on the copyrightability of useful articles. In *Mazer*, the Supreme Court upheld the copyrightability of a statuette despite the fact that it had been reproduced for mass-market distribution and sold as a lamp base.<sup>62</sup> The Court held that the statuette qualified as a "work[] of art" eligible for copyright protection even though it served a functional purpose and had been distributed as part of a utilitarian object.<sup>63</sup>

Because the preparation of a statuette requires artistic skill, the Court found that the statuette qualified as fine art without defining a "work of art."<sup>64</sup> The Court stated that "[i]ndividual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art,"<sup>65</sup> thus leading an increased number of industrial designers to seek protection under § 5(g) of the 1909 Act.<sup>66</sup> To clarify that all ornamental useful articles could

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<sup>58</sup> See Young, *supra* note 8, at 83.

<sup>59</sup> See *Wm. Filene's Sons Co. v. Fashion Originator's Guild of Am.*, 14 F. Supp. 353, 354 (D. Mass. 1936), *aff'd*, 90 F.2d 556 (1st Cir. 1937).

<sup>60</sup> *Id.*

<sup>61</sup> 347 U.S. 201 (1954).

<sup>62</sup> *Id.* at 202.

<sup>63</sup> *Id.* at 213. The Court also held that eligibility for design patent protection did not preclude copyright protection. *Id.* at 217.

<sup>64</sup> *Protection for the Artistic Aspects of Articles of Utility*, 72 HARV. L. REV. 1520, 1525 (1959).

<sup>65</sup> *Mazer*, 347 U.S. at 214.

<sup>66</sup> 61 Register of Copyrights Ann. Rep. 12 (1958). The number of "works of art" registered under § 5(g) of the 1909 Act swelled from 3,170 in 1954 to greater than 5,000 in 1958. *Id.*

not gain protection, the Copyright Office enacted Regulation § 202.10(c) to narrow the Supreme Court's open-ended extension of copyright protection:

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.<sup>67</sup>

The "sole intrinsic function" test was applied in *Ted Arnold Ltd. v. Silvercraft Co.*,<sup>68</sup> where the court recognized copyright protection for the casing of a pencil sharpener simulating the appearance of an antique telephone. The court stated, "[We] would not agree with defendant that its 'sole intrinsic function . . . is its utility.' Customers are paying fifteen dollars for it, not because it sharpens pencils uncommonly well, but because it is also a decorative conversation piece."<sup>69</sup> Unfortunately, the regulation failed to address the "linedrawing problem inherent in delineating the extent of copyright protection available for works as applied art."<sup>70</sup> In fact, the "sole intrinsic function" test continues to confuse the law.

### *B. The Copyright Act of 1976*

The 1976 amendments to the Copyright Act codified the Supreme Court's holding in *Mazer*.<sup>71</sup> The House Committee report noted that "[u]nless the shape of . . . [the] industrial product contains some element that, physically or conceptually,

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<sup>67</sup> 37 C.F.R. § 202.10(c) (1959) (revoked Jan. 1, 1978, 43 Fed. Reg. 966 (1978)), and codified in the current Act at § 101).

<sup>68</sup> 259 F. Supp. 733 (S.D.N.Y. 1966).

<sup>69</sup> *Id.* at 736.

<sup>70</sup> MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 2.08[B] at 2-89 (1981).

<sup>71</sup> See Schalestock, *supra* note 27, at 118.

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can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.”<sup>72</sup>

While physical separability, in which the functional part of an object must be physically detachable from the artistic part,<sup>73</sup> is quite simple to apply, conceptual separability is not.<sup>74</sup> It is clear, however, that the 1976 Act generally denies protection to apparel designs because they are categorized as “useful articles” under § 101. Under current copyright law, a sufficiently original design on fabric can be granted copyright protection;<sup>75</sup> however, an

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<sup>72</sup> Richard G. Frenkel, *Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-Trips Era*, 32 LOY. L.A. L. REV. 531, 541 (1999) (citing H.R. Rep. No. 94-1476, at 55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5668) (alteration in original) (internal citations omitted).

<sup>73</sup> See *id.* (citing *Parfums Givenchy, Inc. v. C & C Beauty Sales, Inc.*, 832 F. Supp. 1378, 1392 (C.D. Cal. 1993) (holding the artistic labeling of a perfume box as physically separable from the utilitarian aspects of the perfume itself, thereby avoiding a conceptual separability analysis.)).

<sup>74</sup> Conceptual separability is defined as follows:

Conceptual separability means that the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work . . . independent of the shape of the useful article, i.e., the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article.

See Hagin, *supra* note 12, at 350 (citing *Whimsicality, Inc. v. Rubie's Costumes Co.*, 721 F. Supp. 1566, 1571 (E.D.N.Y. 1984) (quoting Compendium II of Copyright Office Practices, § 505.02)) (internal citations omitted).

<sup>75</sup> See *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 132 (1998) (holding that pattern designs depicting familiar objects, such as hearts, daisies, and strawberries, are entitled to very narrow copyright protection; however, “their registrations provide a presumption of validity, which Wal-Mart has failed to overcome”), *cert. granted*, 529 U.S. 205, 216 (2000) (holding that “in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning”). See also *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142, 143 (S.D.N.Y. 1959) (holding design printed upon a dress fabric is a proper subject of copyright, both as a work of art and as a print); *Dan River, Inc. v. Sanders Sale*

original apparel design receives no such protection due to its usefulness.<sup>76</sup> Although apparel works emphasize style and appearance instead of utility, and even though competitiveness turns on originality in the fashion industry, the doctrine of conceptual separability does not provide copyright protection for apparel.<sup>77</sup> The prevailing opinion is that products, such as ladies' dresses or any other industrial products, cannot be copyrighted if they do not contain some element that physically or conceptually can be identified as separable from the utilitarian aspects of the article.<sup>78</sup>

### *C. Title II of the Copyright Act of 1976*

Over the years, numerous bills have been introduced in Congress aimed at obtaining more protection for ornamental designs of useful articles beyond just apparel.<sup>79</sup> With respect to the Copyright Act of 1976, design protection appeared as Title II of the general copyright revision bill.<sup>80</sup> Title II was meant to protect the "original ornamental design of a useful article."<sup>81</sup> Designs that were seen as "staple or commonplace [or] dictated solely by a utilitarian function of the article were excluded."<sup>82</sup>

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Enterprises, Inc., 97 F. Supp. 2d 426, 429 (S.D.N.Y. 2000) (holding that copyright protection extends to fabric designs).

<sup>76</sup> See Schalestock, *supra* note 27, at 122-23 (citing 56 Fed. Reg. 56530-02 (Nov. 5, 1991)).

<sup>77</sup> Leonard S. Elman, *The Limits of State Jurisdiction in Affording Common Law Protection to Clothing Designs*, 11 VAND. L. REV. 501, 502-503 (1958).

<sup>78</sup> "For example, the district court in *Whimsicality, Inc. v. Rubie's Costumes Co.* noted that extending copyright protection to high fashion designs would be 'contrary to well established case law, Copyright Office and historical precedent.'" Hagin, *supra* note 12, at 350-51 (citing *Whimsicality*, 721 F.Supp. at 1575).

<sup>79</sup> See Young, *supra* note 8, at 103.

<sup>80</sup> See H.R. Rep. No. 94-1476, at 54 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668.

<sup>81</sup> S. 22, tit.II, 94th Cong., 1st Sess. § 201(a), 122 Cong. Rec. 3856-59 (1975), *reprinted in* S. Rep. No. 473, 94th Cong., 1st Sess. 39-47 (1975).

<sup>82</sup> *Id.* § 202. In an effort to win congressional approval, the three-

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Title II, the Design Protection Act of 1975, was not passed by the House “because the new form of design protection provided by Title II could not truly be considered copyright protection.”<sup>83</sup>

Although the House Report noted that the bill failed to designate a specific agency to administer the system, there was a more fundamental objection. The Department of Justice was concerned, as was the court in *Fashion Originators’ Guild of America v. FTC*,<sup>84</sup> that Title II would create a new set of exclusive rights, the benefits of which did not necessarily outweigh “the disadvantage of removing such designs from free public use.”<sup>85</sup> To date Congress has passed no bills, but the history of design protection and current *sui generis* acts, such as the Digital Millennium Copyright Act,<sup>86</sup> provide hope that another chapter could be added to Title 17.<sup>87</sup>

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dimensional shape of wearing apparel was also excluded. *Id.* § 202(3).

<sup>83</sup> See H.R. Rep. No. 94-1476, at 50.

<sup>84</sup> 312 U.S. 457 (1941).

<sup>85</sup> See H.R. Rep. No. 94-1476, at 50. See also *FOGA v. FTC*, 312 U.S. 457 at 465. The court in *Fashion Originators’ Guild of America v. Federal Trade Commission* issued a cease-and-desist order to the Fashion Originators’ Guild because the organization tended to create a monopoly in violation of the Sherman and Clayton Acts. The court found that the Guild deprived the public of the advantages that flow from free competition, stating, in part, the following reasons:

[I]t narrows the outlets to which garment and textile manufacturers can sell and the sources from which retailers can buy; subjects all retailers and manufacturers who decline to comply with the Guild’s program to an organized boycott; takes away the freedom of action of members by requiring each to reveal to the Guild the intimate details of their individual affairs; and has both as its necessary tendency and as its purpose and effect the direct suppression of competition from the sale of unregistered textiles and copied designs.

*Id.* (internal citations omitted). Similar to the court in *FOGA v. FTC*, Congress rejected Title II because “it feared creating a new monopoly for industrial design.” See Frenkel, *supra* note 72, at 543.

<sup>86</sup> H.R. 2281, reprinted in 144 CONG. REC. H10, 048-64 (daily ed. Oct. 8, 1998).

<sup>87</sup> See Frenkel, *supra* note 72, at 577.

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## II. THE CURRENT STATE OF THE LAW

*A. Why Copyright Protection is the Best Alternative*

Copyright protection appears to be the best solution to design piracy because “the primary purpose of copyright law is to secure ‘the general benefits derived by the public from the labors of authors.’”<sup>88</sup> Additionally, copyright law is flexible, and it has already been expanded to afford architects protection in their works.<sup>89</sup> “Critics have observed that the VHDPA could ‘easily be expanded’ to cover industrial design, including ‘clothing designs.’”<sup>90</sup> Another benefit of copyright protection is that the application process for protection is “cheap and expeditious.”<sup>91</sup>

Apparel designs cannot effectively be patented for a number of reasons, the most practical of which is time.<sup>92</sup> Before the Patent and Trademark Office will issue a patent, a search of prior art is required, which could take several months.<sup>93</sup> Due to the short life of apparel designs,<sup>94</sup> a work may have little or no commercial value by the time a design patent is granted.<sup>95</sup> In fact, in *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, the U.S. District Court for the Southern District of New York noted the practical inadequacy of patent protection for dress designs because of the short life span of designs and the rigorous

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<sup>88</sup> See Schmidt, *supra* note 7, at 874.

<sup>89</sup> “The Digital Millennium Copyright Act (“DMCA”) contains as a part of it the Vessel Hull Design Protection Act (“VHDPA”).” See Frenkel, *supra* note 72, at 576.

<sup>90</sup> See Frenkel, *supra* note 72, at 577 (citing Letter from Peter Jaszi of the Digital Future Coalition to Pat Roberts, United States Senator 2 (Aug. 24, 1998) (on file with Loyola of Los Angeles Law Review)).

<sup>91</sup> Ralph S. Brown, *Copyright-like Protection for Designs*, 19 U. BALT. L. REV. 308, 310 (1989) [hereinafter Brown, *Copyright-like Protection*].

<sup>92</sup> *Id.*

<sup>93</sup> *Id.*

<sup>94</sup> Fashion designs usually have a shelf life of only a few months because trends quickly go out of style. *Id.*

<sup>95</sup> See Young, *supra* note 8, at 90.

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requirements and time involved in obtaining a patent.<sup>96</sup> In addition, the patent application process is expensive and complex.<sup>97</sup> Many designers, especially new designers, cannot afford to apply for such protection.<sup>98</sup> Because patent protection is not suitable for apparel protection, fashion designers should be able to look to some variation of copyright law for protection against piracy and compensation for their creations.<sup>99</sup>

*B. The Confusing Conceptual Separability Test*

A fashion designer seeking copyright protection must convince a judge that his design is not useful or that the useful part of the item is separable from the artistic part.<sup>100</sup> As a result, “[n]umerous tests have evolved in the utility and separability areas; however, none of these tests provides a clear, predictable path for protection of apparel designs.”<sup>101</sup>

*1. The Sole Intrinsic Function Test*

Under the sole intrinsic function test, “copyright is denied to an article if its “sole intrinsic function . . . is its utility.”<sup>102</sup> To

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<sup>96</sup> 112 F. Supp. 187 (S.D.N.Y. 1934). The court stated as follows:

The patent law provides for protection to those who create dresses of novel design, Title 35 U.S.C.A. §73, now 35 U.S.C.A. §171, but as a practical matter in many instances this fails to give the needed protection, for designs and patterns usually are short-lived and with the conditions and time incidental to obtaining the patent, this protection comes too late, if at all.

*Id.* at 190. The court ultimately held that a copyright on a dress-design drawing gave the copyright holder the exclusive right to make copies or reprints of the drawing only, but no exclusive rights to produce the dress itself; that is, the copyrightable work was the drawing, not the resulting dress style. *Id.*

<sup>97</sup> See Brown, *Copyright-like Protection*, *supra* note 91, at 310.

<sup>98</sup> See Hagin, *supra* note 12, at 355-56.

<sup>99</sup> See *id.* at 374-75.

<sup>100</sup> See Frenkel, *supra* note 72, at 544.

<sup>101</sup> See *id.* at 544.

<sup>102</sup> Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV.



understand the current copyright analysis for industrial designs, one must be aware of the different ways courts have interpreted Regulation § 202.10(c). *Esquire, Inc. v. Ringer*, the leading case advocating the sole intrinsic function test, was decided under the 1909 Copyright Act and is key to understanding the regulation.<sup>103</sup>

In *Esquire*, the lower court granted copyright protection to the designer of modern light fixtures when he brought a mandamus action to require registration of his design.<sup>104</sup> Copyright registration had been denied on the theory that the fixtures did not contain “elements, either alone or in combination, which are capable of independent existence as a copyrightable pictorial, graphic or sculptural work apart from the utilitarian aspect.”<sup>105</sup> The court stated that “the lamp’s intrinsic function was not solely its utility because the lights served to decorate, as well as to illuminate, especially during the day, when they were exclusively decorative.”<sup>106</sup> The court deemed the fixture copyrightable even though it recognized the Register’s fear that a grant of copyright in this instance would “open the ‘floodgates’ to copyrighting ‘myriads of industrial designs of everything from automobiles to bathtubs to dresses.’”<sup>107</sup>

While the lower court’s decision appears to give apparel designers a glimmer of hope, since the court disregarded the Copyright Office’s concerns about “opening the floodgates” to tempt creators of industrial designs, this hope was destroyed when the decision was reversed on appeal.<sup>108</sup> Swayed by legislative intent inherent in the fact that the seventy-odd design protection bills introduced in Congress since 1914 had failed to be enacted, the Register’s concern that the floodgates would open, and the Register’s expertise in such matters, the court

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1341, 1345 (1987) (citing 37 C.F.R. § 202.10(c) (1956)).

<sup>103</sup> 414 F. Supp. 939 (D.D.C. 1976), *rev’d*, 591 F.2d 753, 795 (D.C. Cir. 1978).

<sup>104</sup> *Esquire*, 414 F. Supp. at 940.

<sup>105</sup> *Esquire*, 591 F.2d at 798-99.

<sup>106</sup> Erica Lehrer, *The Design of Design Law Today*, 35 COPYRIGHT L. SYMP. (ASCAP) 145, 162 (1988).

<sup>107</sup> *Id.* (citing *Esquire*, 414 F. Supp. 941).

<sup>108</sup> *Esquire*, 591 F.2d at 796.

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decided that the registration had been properly denied.<sup>109</sup>

The appellate court justified its reversal by stating that an object is characterized as useful when it has “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>110</sup> This new language narrowed the reach of the copyright statute and ruled out the protection of articles, such as light fixtures, with dual intrinsic functions.<sup>111</sup> The court glossed over the notion of “conceptual separability” as irrelevant to the case at hand.<sup>112</sup>

## 2. The Primary-Subsidiary Test

Under the primary-subsubsidiary test, copyright protection can be granted if the design’s primary purpose is ornamental and its utilitarian purpose is subsidiary.<sup>113</sup> The Second Circuit’s first major opinion discussing conceptual separability<sup>114</sup> originated in *Kieselstein-Cord v. Accessories by Pearl, Inc.*,<sup>115</sup> a case that the Second Circuit described as being on the “razor’s edge of copyright law.”<sup>116</sup>

In *Kieselstein-Cord*, the Copyright Office and the courts granted copyright protection to the designer of ornamental belt buckles because “the primary ornamental aspects of the . . . buckles [were] conceptually separable from their subsidiary utilitarian function.”<sup>117</sup> The court went on to state that “these are not ordinary buckles; they are sculptured designs cast in precious metal—decorative in nature and used as jewelry, principally [as]

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<sup>109</sup> See Lehrer, *supra* note 106, at 163.

<sup>110</sup> 17 U.S.C. § 101 (2000) (defining “useful article”).

<sup>111</sup> See Lehrer, *supra* note 106, at 163.

<sup>112</sup> *Id.* at 162 n.87. The court concluded that when legislative history was viewed in its entirety, the “isolated reference” to conceptual separability “disappears.” *Esquire*, 591 F.2d at 804.

<sup>113</sup> Keith Aoki, *Contradiction and Context in American Copyright Law*, 9 CARDOZO ARTS & ENT. L.J. 303, 335 (1991).

<sup>114</sup> See Frenkel, *supra* note 72, at 547.

<sup>115</sup> 632 F.2d 989 (2d Cir. 1980).

<sup>116</sup> *Kieselstein-Cord*, 632 F.2d at 990.

<sup>117</sup> *Id.*

ornamentation.”<sup>118</sup> It is difficult to understand why apparel designs cannot get protection in light of this approach. Many top fashion designers create garments, especially for the runway, that are decorative in nature and principally ornamental, which illustrates that some designs can have conceptually separable elements.<sup>119</sup>

Copyright protection was granted to costume jewelry in *Trifari, Krussman & Fishel, Inc. v. Charel Co.*<sup>120</sup> when the court used a primary-subsidary test to determine if the jewelry was protectible under copyright law. The court stated the following:

In the case of costume jewelry, while the overall form is to some extent pre-determined by the use for which it is intended, the creator is free to express his idea of beauty in many ways. Unlike an automobile, a refrigerator, or a gas range, the design of a necklace or of a bracelet may take as many forms as the ingenuity of the artist may conceive.<sup>121</sup>

Jewelry is viewed as ornamental, rather than utilitarian, because it is artistic and decorative.<sup>122</sup> Advocates of apparel design protection would argue that the design of a garment, like jewelry, “may take as many forms as the ingenuity of the designer may conceive.”<sup>123</sup> Unfortunately, the courts have failed to recognize to date that many garments express beauty and are often seen as “wearable art” in today’s society.<sup>124</sup>

### 3. *The Inextricably Intertwined Test*

Another interpretation of conceptual separability has been coined the “inextricably intertwined test,”<sup>125</sup> wherein an article is

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<sup>118</sup> *Id.* at 993.

<sup>119</sup> See Hagin, *supra* note 12, at 348.

<sup>120</sup> 134 F. Supp. 551 (S.D.N.Y. 1955).

<sup>121</sup> See Hagin, *supra* note 12, at 353 (citing *Trifari*, 134 F. Supp. at 553).

<sup>122</sup> *Trifari*, 134 F. Supp. at 553.

<sup>123</sup> See Hagin, *supra* note 12, at 352-53.

<sup>124</sup> See Mencken, *supra* note 9.

<sup>125</sup> See Frenkel, *supra* note 72, at 548.

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denied copyright protection if the “aesthetic and artistic features . . . are inseparable from [its] use as [a] utilitarian article.”<sup>126</sup> This test evolved from a Second Circuit case, *Carol Barnhart, Inc. v. Economy Cover Corp.*,<sup>127</sup> in which the court denied copyright protection to copied mannequins of partial human torsos.<sup>128</sup> The court distinguished *Kieselstein-Cord* on the ground that the artistic design of the belt buckles was “wholly unnecessary to [the] performance of the utilitarian function.”<sup>129</sup> The court found that the artistic elements of the mannequin torsos were “inextricably intertwined” with the torsos’ utilitarian features, and, therefore, were not copyrightable.<sup>130</sup> This test makes conceptual separability such a high hurdle for industrial design that few works, if any, could gain copyright protection.<sup>131</sup>

#### 4. The Denicola/Brandir Artistic Judgment Test

The Second Circuit in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*<sup>132</sup> adopted what is known as the “Denicola/Brandir artistic judgment test.”<sup>133</sup> Professor Denicola stated that “the dominant feature of modern industrial design is the merger of aesthetic and utilitarian concerns” and proposed a sliding scale between art and utility.<sup>134</sup> He believed that the more

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<sup>126</sup> *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985).

<sup>127</sup> *Id.*

<sup>128</sup> *Id.* at 418.

<sup>129</sup> *Id.* at 419.

<sup>130</sup> *Id.*

<sup>131</sup> See Frenkel, *supra* note 72, at 548 (citing Aoki, *supra* note 113, at 340).

<sup>132</sup> 834 F.2d 1142 (2d Cir. 1987).

<sup>133</sup> Robert Denicola is a professor of law at the University of Nebraska. “He surveyed the different tests for conceptual separability and concluded that none of the tests truly captured the purpose of separability—to divide copyrightable art from uncopyrightable industrial design.” See Frenkel, *supra* note 72, at 550 (citing Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 739 (1983)).

<sup>134</sup> See Denicola, *supra* note 133, at 707, 739.

an artist is concerned with utilitarian considerations, the less right the work has to copyright protection.<sup>135</sup> Judge Oakes restated the Denicola test as follows:

If design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separate from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.<sup>136</sup>

The court found that no conceptual separability existed because the aesthetic aspects of a bicycle rack were the same as the functional aspect.<sup>137</sup>

Judge Oakes's restatement of the Denicola test has been criticized for two reasons. First, while Professor Denicola's approach seems to create a sliding scale between artistic influence and functionality, Judge Oakes seems to require that industrial design be a result of either "artistic judgment" or "functional influences."<sup>138</sup> Furthermore, the test is difficult to apply because it requires judicial analysis of artistic judgment.<sup>139</sup> Judges are ill suited to assess artistic judgment because they are not necessarily skilled in that area, and conflicting rulings are likely.<sup>140</sup> It should be noted, moreover, that the two interpretations of the Denicola test potentially conflict: Professor Denicola's interpretation allows protection for garment designs reflecting more aesthetic considerations than utilitarian ones, while Judge Oakes's interpretation of the test denies protection to articles in which functional considerations are manifested.<sup>141</sup>

This conflict is illustrated in *Whimsicality, Inc. v. Rubie's*

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<sup>135</sup> See Denicola, *supra* note 133, at 739.

<sup>136</sup> *Brandir*, 834 F.2d at 1145.

<sup>137</sup> *Id.* at 1146-47.

<sup>138</sup> See Frenkel, *supra* note 72, at 551.

<sup>139</sup> See *id.*

<sup>140</sup> See *id.* at 552.

<sup>141</sup> See *id.* at 551.

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*Costume Co.*<sup>142</sup> and *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*<sup>143</sup> In *Whimsicality*, the Second Circuit cited *Brandir* and found that the artistic and utilitarian functions of clothing merge.<sup>144</sup> Thus, the court concluded that Halloween costumes could not be protected.<sup>145</sup> On the other hand, in *National*, a California district court citing *Brandir* held that the function of costumes had little to do with their design and granted the costumes protection.<sup>146</sup> The court went on to state that “the Second Circuit improperly applied the Denicola test . . . which will cause decisions to turn upon largely fortuitous circumstances.”<sup>147</sup> Although the interpretation of the Denicola test in *National* could eventually protect garments, the standard is largely subjective and will continue to result in inconsistent decisions.<sup>148</sup>

In a more recent decision, *Severin Montres, Ltd. v. Yidah Watch Co.*,<sup>149</sup> a district court in California used the *Brandir* test to analyze whether a watch should be afforded copyright protection. The plaintiff, the licensee of the Gucci trademark for the purpose of creating watch designs,<sup>150</sup> created the Gucci-G watch, a watch with its rectangular frame forming a three-dimensional letter G,<sup>151</sup> while the defendants made a J-watch and an E-watch.<sup>152</sup> The defendants claimed the frame was functional and could not be copyrighted.<sup>153</sup> The district court, however, relied on *National* and held “where design elements can be identified as reflecting the designer’s artistic judgment exercised

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<sup>142</sup> 891 F.2d 452 (2d Cir. 1989).

<sup>143</sup> 696 F. Supp. 1348 (S.D. Cal. 1988).

<sup>144</sup> See *Whimsicality*, 891 F.2d at 455.

<sup>145</sup> *Id.*

<sup>146</sup> See *National*, 696 F. Supp. at 1353-54.

<sup>147</sup> *Id.* at 1353 (quoting *Brandir*, 834 F.2d at 1151(Winter, J., concurring in part and dissenting in part)).

<sup>148</sup> See Frenkel, *supra* note 72, at 551.

<sup>149</sup> 997 F. Supp. 1262 (C.D. Cal. 1997).

<sup>150</sup> *Id.* at 1264 n.1.

<sup>151</sup> *Id.* at 1265.

<sup>152</sup> *Id.* at 1263.

<sup>153</sup> *Id.* at 1265.

independently of functional influences, conceptual separability exists.”<sup>154</sup>

The court held that the watches were copyrightable because it believed that the “plaintiff’s artistic expression contained enough artistic design to be unique and protectable under the *Brandir* test.”<sup>155</sup> Under the *Severin* analysis, artistic apparel designs might be protectible if certain design elements, such as the sleeve or neckline configuration, or the cut of the garment, could be “identified as reflecting the designer’s artistic judgment exercised independently of the functional influences,” namely covering up the body.<sup>156</sup>

### 5. The “Lack of Test” Approach

“Of course, having a confusing test may be better than having no test at all. The Ninth Circuit seems to have exactly that—no test.”<sup>157</sup> In *Fabrica Inc. v. El Dorado Corp.*,<sup>158</sup> the Ninth Circuit merely cites the statute and its legislative history. In this case, Fabrica sought copyright protection for a folder of carpet samples.<sup>159</sup> The court found that “no element of the folders . . . can be separated out and exist independently of their utilitarian aspects.”<sup>160</sup> This case-by-case approach is undesirable because the court does not clearly explain its reasoning for failing to afford protection to the design in question, and thus fails to provide guidance to designers.<sup>161</sup>

### C. Fashion Today

Apparel designs are not ordinary useful articles, especially

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<sup>154</sup> *Id.* (quoting *National Theme Productions*, 696 F. Supp. at 1353 and citing *Brandir*, 834 F.2d at 1145).

<sup>155</sup> See Frenkel, *supra* note 72, at 553.

<sup>156</sup> See *id.*

<sup>157</sup> See *id.*

<sup>158</sup> 697 F.2d 890 (9th Cir. 1983).

<sup>159</sup> *Id.* at 892.

<sup>160</sup> *Id.* at 893.

<sup>161</sup> See Frenkel, *supra* note 72, at 553.

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today when apparel is meant to be admired, analyzed, and viewed.<sup>162</sup> In *Poe v. Missing Persons*,<sup>163</sup> for example, an art student created a “swimsuit” made of clear plastic filled with crushed rock.<sup>164</sup> The designer called her work a “soft sculpture” representing a swimsuit, while the defendants characterized the work as merely a swimsuit.<sup>165</sup> The court held that the work could be afforded copyright protection because it was not clear “by looking at [the suit] whether a person wearing this object could move, walk, swim, sit, stand, or lie down without unwelcome or unintended exposure.”<sup>166</sup>

Raising an important issue, the *Poe* court stated that “given the bizarre nature of what sometimes passes for high fashion, there may be a legitimate issue even as to the threshold question of utility.”<sup>167</sup> Professor William Fryer of the University of Baltimore School of Law observed, “[W]hat some persons consider a costume is another person’s ordinary wear.”<sup>168</sup> Apparel designs and costumes are often indistinguishable today, making it difficult to determine whether a garment is utilitarian clothing or a non-utilitarian costume.

The difficulty of distinguishing between costume and high-end fashion is evident from viewing fashion shows and couture collections.<sup>169</sup> Many of the designs created for “appearances” are

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<sup>162</sup> See Hagin, *supra* note 12, at 348.

<sup>163</sup> 745 F.2d 1238 (9th Cir. 1984).

<sup>164</sup> *Id.* at 1242.

<sup>165</sup> *Id.* at 1239.

<sup>166</sup> *Id.* at 1242. Various apparel designs have been displayed in museums to be viewed as art. See Hagin, *supra* note 12, at 348. Similar to the Kieselstein-Cord belt buckles that were exhibited at the New York Metropolitan Museum of Art, Poe’s creation was displayed at the Los Angeles Institute for Contemporary Art. *Id.* In 2000, Giorgio Armani’s designs were displayed at the Guggenheim Museum in New York City. Ogale Idudu, *High Fashion as Art: Couture in Limelight At London’s V&A—“Radical Fashion” Goes from Simple to Wild*, WALL ST. J. EUROPE, Oct. 19, 2001, at 28, available at 2001 WL-WSJE 28845671.

<sup>167</sup> See Schalestock, *supra* note 27, at 123.

<sup>168</sup> See *id.* (citing Comment on file at the U.S. Copyright Office, Docket No. RM 90-7).

<sup>169</sup> See Mencken, *supra* note 9.



intended to make an artistic statement.<sup>170</sup> Style, rather than durability, is the dominant competitive factor in the fashion industry today.<sup>171</sup> In addition, Halloween costumes are often designed to imitate the attire of others.<sup>172</sup> An actor could wear an original garment in a movie or to an award show, and copies of that garment could be made for some to wear as a costume and for others to wear as everyday attire.<sup>173</sup>

#### *D. Piracy in the Apparel Industry*

Design piracy in the apparel industry is a tremendous problem. For example, the “Copycat King” Victor Costa<sup>174</sup> grossed approximately \$50 million in 1988,<sup>175</sup> and Jack Mulqueen<sup>176</sup> grossed more than \$200 million in 1981, mostly from copying the creations of other designers.<sup>177</sup> Congress has not passed legislation that affords copyright protection to the

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<sup>170</sup> *See id.*

<sup>171</sup> Maurice A. Weikart, *Design Piracy*, 19 IND. L.J. 235, 256 (1944).

<sup>172</sup> Lane Hartill, *What Costume to Wear for Halloween—Uncle Sam or Shrek?*, CHRISTIAN SCI. MONITOR, Oct. 24, 2001, at 14, available at 2001 WL 3738593.

<sup>173</sup> Emily Mitchell, *Couture May Not Seem So Important Anymore, Yet It Dazzles Modern Viewers of Fashion’s Grand Past*, at <http://www.time.com/time/international/1996/960122/fashion.html> (last visited Mar. 20, 2001).

<sup>174</sup> Victor Costa was a Dallas-based designer “who interpret[ed] fanciful couture designs at lower prices. An ostrich-feather skirt with strapless sequin top from his fall collection [sold] for \$850. Add at least one zero to that amount for the approximate price of a handmade Paris couture version.” Elizabeth Sporkin, *Paris Couture—Oooh la law!; New Passion for French Fashion*, USA TODAY, Oct. 14, 1987, at 1D, available at 1987 WL 4631418.

<sup>175</sup> *See* Hagin, *supra* note 12, at 347 (1991) (citing Bonnie Johnson, *Copycat King Victor Costa Cuts the High Costa Designer Duds*, PEOPLE, Aug. 22, 1988, at 96).

<sup>176</sup> Jack Mulqueen was an apparel manufacturer that made most of its money from sales of garments that the company’s president readily admitted were copies of original creations of other designers. *See* Schmidt, *supra* note 7, at 863.

<sup>177</sup> *See id.*

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apparel industry as it has done for other industries.<sup>178</sup> In fact, Congress has explicitly excluded apparel designs from the proposed bills.<sup>179</sup> The purpose of the Design Anti-Piracy Act of 1989, introduced by Representatives Kastenmeier and Moorhead, was to protect original designs of useful articles against unauthorized copying.<sup>180</sup> Representative Moorhead stated that “[t]he bill would exclude protection for designs compose[d] of three dimensional shapes and surfaces with respect to apparel.”<sup>181</sup>

Affording copyright protection to original apparel works would inspire designers to be more creative and would contribute to the “[p]rogress of [s]cience and useful [a]rts.”<sup>182</sup> Over the years, Congress has carefully and gradually extended the reach of the Copyright Act to include an increasing number of artistic works.<sup>183</sup> Since courts have found that designs on clothing may be

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<sup>178</sup> In 1984, Congress enacted a new category of quasi-copyright law to protect semiconductor chip designs (“mask works”) when pirated computer chip designs reached more than \$100 million per year. *See* Hagin, *supra* note 12, at 347 (citing Semiconductor Chip Protection Act of 1984, 17 U.S.C. §§ 901-14 (1988)). Furthermore, when the United States signed the Berne Convention, Congress enacted the Architectural Works Copyright Protection Act of 1990, which extends full copyright protection to architectural works. The Architectural Works Copyright Protection Act, Title VII of the Judicial Improvements Act of 1990, Pub. L. No. 101-650, 104 Stat. 5089, 5132 (to be codified in various sections of 17 U.S.C.).

<sup>179</sup> *See* Hagin, *supra* note 12, at 347.

<sup>180</sup> 135 Cong. Rec. E3484 (daily ed. Oct. 19, 1989).

<sup>181</sup> *Id.* (statement of Rep. Moorhead).

<sup>182</sup> *See* Hagin, *supra* note 12, at 342, 368-69.

<sup>183</sup> *See id.* at 348 (citing H.R. Rep. No. 1476, 94th Cong., 2d Sess. 6, *reprinted in* 1976 U.S.C.A.N. 5659, 5664 (“The history of copyright law has been one of gradual expansion in the types of works accorded protection.”)). Former Register of Copyrights Barbara Ringer has noted the following:

Copyright law revision may be changing from a sexagenary event into something resembling a continuous process. In the course of the last twenty years, copyright has emerged as one of the most important areas of American property law. As this society moves deeper and deeper into that phase of economic life called “post-industrialism,” . . . the extent to which copyrightable creations are protected by exclusive property interests can become central to

sufficiently original to receive copyright protection,<sup>184</sup> it would be appropriate for Congress to take a step further and afford the design of original garments similar treatment.

### III. RECOMMENDED SOLUTION

#### A. Current Copyright Protection

The United States is a signatory to the Trade-Related Aspects of Intellectual Property Rights (“TRIPS”) Agreement, which provides its members with minimum standards of intellectual property protection.<sup>185</sup> Although former President Clinton stated that the existing intellectual property laws in the United States are sufficient to protect industrial designs, design piracy is a big problem in this country, and current law inadequately addresses it.<sup>186</sup> Because the United States has only complied with the minimum requirements of the Berne Convention,<sup>187</sup> foreign fashion designers do not receive the same protection in the United States as they do overseas.<sup>188</sup>

Under international rules, the creative works of fashion designers are protected for a limited term under copyright law.<sup>189</sup>

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national growth.

Barbara Ringer, *The Unfinished Business of Copyright Revision*, 24 UCLA L. REV. 951, 976 (1977).

<sup>184</sup> See *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d at 132 (finding that copyrights for pattern designs, which depict familiar objects, such as hearts, daisies, and strawberries, are entitled to very narrow protection).

<sup>185</sup> Laurence R. Helfer, *Adjudicating Copyright Claims Under the TRIPS Agreement: The Case for a European Human Rights Analogy*, 39 HARV. INT’L L.J. 357, 360 (1998).

<sup>186</sup> See Frenkel, *supra* note 72, at 533.

<sup>187</sup> Under the Berne Convention, each member state extends to nationals of other member states the same copyright protection that it provides its own nationals. Additionally, Berne requires each member state’s copyright laws to meet certain minimal requirements. See Hagin, *supra* note 12, at 369.

<sup>188</sup> See Bharathi, *supra* note 30, at 1676.

<sup>189</sup> In the United Kingdom, a garment design will be protected as long as it can be related back to a copyright drawing. See Schmidt, *supra* note 7, at

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But works that are protected in Europe do not receive the same protection against design piracy when they are shown in the United States.<sup>190</sup> Thus, when European designers show their works in the United States they are risking that the works may be copied and reproduced for sale.<sup>191</sup> In fact in the United States the copier is even allowed to use the original designer's name in the advertisement to increase sales.<sup>192</sup> Congress should look to countries such as France and the United Kingdom, which provide copyright protection to garment designs, as models and similarly extend copyright protection to industrial designs.<sup>193</sup>

*B. The Garment Design Protection Act*

To extend copyright protection specifically to apparel designs, Congress should amend Title 17 of the U.S. Code with a new chapter, The Garment Design Protection Act of 2002.<sup>194</sup> The procedural provisions should follow those laid out in Representative Moorhead's and Representative Kastenmeier's version of the Design Protection Act of 1989, which was intended to protect industrial designs.<sup>195</sup>

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n.94, (citing 3 EUR. INTELL. P. REV. 163 (1981)). Under French Law, garment designs are protected as applied art or non-functional designs and patterns. Designs may be protected upon a showing of public popularity, even if there is no evidence of originality. See Schmidt, *supra* note 7, at n.94 (citing Dalloz, *Jurisprudence Generale*, at Propiete Litteraire et Artistique and Dessins et Modeles (1952)).

<sup>190</sup> See Bharathi, *supra* note 30, at 1676.

<sup>191</sup> See Mencken, *supra* note 9, at n.4 (citing Societe Yves Saint Laurent Couture v. Societe Louis Dreyfus Retail Mgmt., [1994] ECC 512, 18 May 1994, (Paris) ("The French court ruled in favor of Yves Saint Laurent for 'counterfeiting and disloyal competition' against Ralph Lauren for copying a black tuxedo dress that was created in 1966. Saint Laurent was awarded \$395,000 in 1994."); PARADISE, *supra* note 6, at 77.

<sup>192</sup> See Mencken, *supra* note 9, at n.73 (stating that a copier may mark his clothing as being "inspired" or "copied" from a certain designer without fear of trademark infringement or false advertising).

<sup>193</sup> See discussion *supra* note 189.

<sup>194</sup> See *infra* Appendix.

<sup>195</sup> See H.R. Rep. No. 3499, 101st Cong., 1st Sess. (1989).

There are several basic problems with the current copyright law as applied to apparel designs. For example, as the Copyright Act is written, apparel designs are not defined in § 101.<sup>196</sup> Accordingly, garment designs should be defined in the new chapter as “the design of a garment, including the cut of the fabric and the overall appearance and not including the fabric design.”<sup>197</sup> For purposes of the Garment Design Protection Act, an article should be deemed a “useful article” if the intrinsic utilitarian function exceeds the garment’s intention to portray the appearance of the article or to convey information. To determine an article’s usefulness, considerations should include the cut of the fabric, the style, the length and the garment’s overall appearance.<sup>198</sup>

An important feature of the Garment Design Protection Act would be the establishment of a new office, the United States Garment Design Protection Office (“GDPO”).<sup>199</sup> The GDPO would handle all the administrative functions and duties required by the act, so as to not overburden the Copyright Office. The administrator of the GDPO would have the responsibility of carrying out and delegating all official duties of the GDPO. The administrator and the subordinate officers and employees of the GDPO would be appointed by the Librarian of Congress and would act under the librarian’s general direction and supervision.

Furthermore, the administrator and all the subordinate officers who would determine whether garments are entitled to protection would be required to have a sufficient knowledge of apparel design and would have to pass a vigorous examination, just as patent office employees are required to have a scientific background and pass the patent bar exam. GDPO employees would receive the registration fees required to apply for garment design protection.<sup>200</sup>

Additionally, A new standard of originality tailored to the

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<sup>196</sup> 17 U.S.C. §101 (2000).

<sup>197</sup> See *infra* Appendix § 1(a)(2).

<sup>198</sup> See *infra* Appendix § 1.

<sup>199</sup> See *infra* Appendix § 7.

<sup>200</sup> See *infra* Appendix § 8.

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fashion industry is necessary to protect apparel designs.<sup>201</sup> The standard should not be high. A low originality threshold is necessary because “the fickle nature of fashion requires that protection be keyed to what a designer succeeds in making currently stylish.”<sup>202</sup>

To demonstrate originality, a designer would be required to show that his or her apparel design is not a copy of another’s work by showing that the design is not currently registered with the GDPO. To encourage designers to register their works, a piracy claim could not be brought on behalf of an unregistered work. “Upon such a showing and in return for creating (or re-creating) public interest, and a current market for the design, copyright protection would issue.”<sup>203</sup> Unlike with patents, prior works would not have to be submitted to the GDPO. Because the decision-makers at the GDPO would have a substantial background in apparel design, they would be able to make educated decisions about whether the designs meet the originality standard. The administrator would consider the garment as a whole; only those garments exhibiting creativity would be protected, while purely functional, uncreative, “two-sleeves-and-a-body” designs would be denied protection.<sup>204</sup> The administrator’s preliminary originality and functionality determination could be contested by an accused design pirate in an infringement action.<sup>205</sup>

Once a design is approved for protection by the GDPO,

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<sup>201</sup> See Schmidt, *supra* note 7, at 876.

<sup>202</sup> See *id.* at n.112:

Almost no garment design can ever really be considered “brand new”: garment designs generally consist of elements already “discovered.” “Old” elements are incorporated either in a new combination or at a time when such elements are not generally in vogue. Often, then, the appeal of garment designs lies solely in the re-creation of public interest in a design from the past.

See *id.* at n.105.

<sup>203</sup> See *id.* at 876.

<sup>204</sup> See *id.* at 877.

<sup>205</sup> See Hagin, *supra* note 12, at 378 (citing 136 Cong. Rec. E259, E260 (daily ed. Feb. 7, 1990) (statement of Rep. Kastenmeier)).

notice would have to be given. Notice should consist of the words “Protected Design” or the letter “F” within a circle, the year of the date on which protection for the design commenced and the name of the proprietor.<sup>206</sup> The notice would be located and applied so as to give reasonable notice of design protection while the garment is passing through its normal channels of commerce. Tags affixed to the garment would fulfill this requirement.<sup>207</sup>

If a designer knowingly attempts to deceive the public by giving false notice, he or she would be fined up to \$500 for every offense. Any person could sue for the penalty, and in such event, one-half of the fees would go to the person suing and the other to the GDPO.<sup>208</sup>

Another basic problem with the current copyright law protection as applied to apparel designs is that the period of copyright protection—the author’s life plus seventy years<sup>209</sup>—is inappropriate in view of the “seasonal and capricious nature of fashion and consumer tastes.”<sup>210</sup> As Rocky Schmidt has advocated previously,<sup>211</sup> a one-year term should be implemented to provide a reasonable time period for designers to make a profit on their designs. Since most trends go out of style after three months,<sup>212</sup> this time period should suffice.<sup>213</sup>

The shortened term of protection would serve several purposes. First, it would align copyright protection with the fickle nature of the industry.<sup>214</sup> Second, a shortened term would encourage courts to find infringement without fear that such a finding would be tantamount to granting a long monopoly in the

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<sup>206</sup> See *infra* Appendix § 9(a).

<sup>207</sup> See *infra* Appendix § 9.

<sup>208</sup> See *infra* Appendix § 16.

<sup>209</sup> The life of the author plus a seventy year period applies to works created on or after January 1, 1978. 17 U.S.C. § 302(a) (2000).

<sup>210</sup> *Wm. Filene’s Sons Co. v. Fashion Originator’s Guild of Am.*, 90 F.2d 556, 558 (1st Cir. 1937).

<sup>211</sup> See Schmidt, *supra* note 7, at 877.

<sup>212</sup> See *id.*

<sup>213</sup> See *infra* Appendix § 5.

<sup>214</sup> See Schmidt, *supra* note 7, at 877.

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design.<sup>215</sup> Third, “a one-year term should provide enough time for most designers to recover substantial ‘rewards’ for their creations.”<sup>216</sup> Finally, the designer would be more likely to apply for protection if he or she believed that the courts would effectively enforce the law.<sup>217</sup>

To ensure that the GDPO does not violate the Sherman Act, as did the Fashion Originator’s Guild of America, this article proposes, as has Rocky Schmidt, that a compulsory licensing system<sup>218</sup> be designed to limit the risk of monopolies.<sup>219</sup> Upon registering a design, the designer would own the design exclusively for one month; however, upon publishing, selling, or showing the design in public, the designer would be required to license it. The license fee arrangement would be similar to that of the blanket licenses for sound recordings used by the American Society of Composers, Authors and Publishers (“ASCAP”) and Broadcast Music, Inc. (“BMI”),<sup>220</sup> which the Supreme Court has found not violative of the Sherman Act.<sup>221</sup>

The GDPO would control the collection and distribution of the licensing fees, as well as police the stores, the Internet, magazines, and all other possible clothing distribution arenas to

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<sup>215</sup> *See id.*

<sup>216</sup> *See id.*

<sup>217</sup> Peter D. Aufrichtig, *Protection for Computer Programs*, 32 COPYRIGHT L. SYMP. (ASCAP) 133, 174-75 (1986).

<sup>218</sup> Under a compulsory licensing system, “once a designer ma[kes] his designs public, the world would be free to copy them. [However,] the copyist would be required to pay a small royalty or ‘license fee’ to the original designer.” *See* Schmidt, *supra* note 7, at 878.

<sup>219</sup> *See infra* Appendix § 6.

<sup>220</sup> ASCAP and BMI issue blanket licenses to copyrighted musical compositions for a fee. “Blanket licenses give the licensees the right to perform any and all of the compositions owned by the members or affiliates as often as the licensees desire for a stated term.” *Broadcast Music, Inc. v. Columbia Broadcasting System, Inc.*, 441 U.S. 1, 1 (1979).

<sup>221</sup> *Broadcast Music, Inc.*, 441 U.S. at 19 (holding that “[a]lthough the copyright laws confer no rights on copyright owners to fix prices among themselves or otherwise violate the antitrust laws, we would not expect that any market arrangements reasonably necessary to effectuate the rights that are granted would be deemed a *per se* violation of the Sherman Act”).



ensure that no copied material is being sold or displayed without payment of the requisite licensing fees. "The compulsory royalty system could . . . be converted into a system whereby licensing fees fund a 'pool' used to bring enforcement actions and police the use of designs."<sup>222</sup> A small percentage of the licensing fees would go to the GDPO.<sup>223</sup>

If the GDPO, or another party, believes that a copier has infringed a protected apparel design, the GDPO would notify the designer. First, the designer may request a hearing in front of the GDPO's Anti-Piracy Panel ("APP"), which would hear infringement claims. The APP would consist of lawyers trained in intellectual property law.<sup>224</sup> Thereafter, either party could appeal the APP's decision by bringing a civil action in district court.

When an infringement action is brought before the APP, the alleged infringer could pay the applicable licensing fees to avoid liability. If he or she refuses, the proprietor of the design could then seek a preliminary injunction in court; however, the APP would not have the authority to grant such an order. At this point, the court could appoint a member of the APP to serve as a court-appointed master.<sup>225</sup> The master would determine preliminarily whether infringement had occurred. If the master determined that infringement had occurred, the court could enjoin the alleged infringing party from further sales of the offending apparel until final resolution of the case. If the master finds preliminarily that infringement did not occur, the copyright holder could, of course, proceed with the litigation in front of the APP, but without an injunction preventing the other party from manufacturing or selling the allegedly pirated apparel.<sup>226</sup> The

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<sup>222</sup> Hagin, *supra* note 12, at 384 (citing Schmidt, *supra* note 7, at 879 n.136).

<sup>223</sup> See *infra* Appendix § 8(d).

<sup>224</sup> See *infra* Appendix § 7(c).

<sup>225</sup> It is well within the court's power to provide for a master to make determinations of fact in areas that are outside of the court's expertise. See *Aufrichtig*, *supra* note 217, at 176-77 (citing *Wisconsin v. Illinois*, 449 U.S. 48 (1980)). See *infra* Appendix § 14(b)(2).

<sup>226</sup> See *Aufrichtig*, *supra* note 217, at 176-77.

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parties also could resolve the matter by arbitration.<sup>227</sup>

As in all copyright infringement actions, it would not be infringement to make, have made, import, sell, or distribute any article embodying a garment design created without knowledge of a protected garment design.<sup>228</sup> After proving that he or she is innocent, the accused infringer would be permitted to sell the remainder of his or her merchandise and either cease sales or pay the licensing fees.

Whenever the alleged infringer introduces an earlier design that is identical or substantially similar to the protected design, the party alleging infringement would have the burden of affirmatively establishing its originality.<sup>229</sup> After originality is established, the degree of similarity between the protected design and the alleged infringing design would be evaluated.

In evaluating whether infringement had occurred, the master would consider a number of factors. First, he or she would have to determine whether the allegedly infringing design is an exact copy of the protected design.<sup>230</sup> If it were not, the master would determine whether significant stylistic features of the original garment are found in the second. If so, the master would compare the cut, sleeve and garment length, collar or waist, fit, and other similar features of the garments. The fabric design and necessary accessories, such as zippers and buttons, should not be included in this preliminary evaluation. The final preliminary test would be a comparison of the overall look and style of the two garments. If the master believes that, based on the foregoing, there is a basis for infringement, he or she should so advise the court and specify his or her reasoning. If the master does not find enough similarity to warrant a finding of likely infringement, he or she should indicate the degree of similarity found.<sup>231</sup>

Should the case proceed to trial before the APP, after the court has either granted or denied the preliminary injunction,

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<sup>227</sup> See *infra* Appendix § 14(c).

<sup>228</sup> See *infra* Appendix § 11.

<sup>229</sup> See *infra* Appendix § 11.

<sup>230</sup> An exact copy would violate *infra* Appendix § 11(d).

<sup>231</sup> See Aufrechtig, *supra* note 217, at 180.

both parties should provide all supporting documents, including any design drawings, relating to the development of the respective garment designs.<sup>232</sup> The parties also should provide documents tending to substantiate the period of time involved in developing and manufacturing the garment. Testimony of other employees who took part in designing the garment would be admissible as well. This could provide circumstantial evidence of the defendant's independent effort.<sup>233</sup>

The master's preliminary evaluation should play a substantial role in the APP's and the court's analysis, should the case be appealed.<sup>234</sup> If the master finds that the defendant developed a substantially similar garment in a suspiciously short period of time, or soon after the plaintiff first showed the design (either publicly or at a private show), the APP should find copyright infringement.<sup>235</sup> Of course, evidence that the design was copied from a prior work by a third party would be a valid defense.<sup>236</sup>

A prevailing plaintiff could be awarded the infringer's profits resulting from the sale of the copies if it is found that the infringer's sales are reasonably related to the use of the claimant's design.<sup>237</sup> In such a case, the plaintiff would only be required to prove the infringer's sales, and the infringer would be required to prove his or her expenses against such sales. In any action, the APP may, in its discretion, allow for the recovery of full costs by or against any party other than the United States or an officer thereof.<sup>238</sup> The APP also may award reasonable attorneys' fees to the prevailing party as part of the costs.<sup>239</sup> Additionally, the APP may award punitive damages as it sees fit.<sup>240</sup> Finally, the APP may order that all infringing articles and

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<sup>232</sup> *See id.* at 181.

<sup>233</sup> *See id.* at 180.

<sup>234</sup> *See id.*

<sup>235</sup> *See id.*

<sup>236</sup> *See id.*

<sup>237</sup> *See id.*

<sup>238</sup> *See id.*

<sup>239</sup> *See id.*

<sup>240</sup> *See infra* Appendix § 15(c).

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any patterns, models, or other means specifically adapted for making the infringed garment be delivered for destruction or other disposition, as the APP may direct.<sup>241</sup>

To date, the Copyright Office, the courts and Congress have feared (not without reason) that if apparel designs receive copyright protection, other industrial designers would demand similar protection; they fear the formation of monopolies, which will cause prices to soar.<sup>242</sup> However, implementation of a licensing scheme should allay this fear.<sup>243</sup> Although Congressman Kastenmeir suggests that “the argument that a particular interest group will make more money and therefore be more creative does not satisfy this threshold standard or the constitutional requirements of the intellectual property clause,”<sup>244</sup> copyright protection for original apparel designs would benefit the economy and consumers as well as designers.<sup>245</sup> As Ralph Brown has stated, “[W]hen one places the case for limited protection for the ornamental design of useful objects in the context of other limited monopolies in intellectual property, the case is not an unreasonable one.”<sup>246</sup>

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<sup>241</sup> See *infra* Appendix § 15.

<sup>242</sup> Brown, *Copyright-like Protection*, *supra* note 91, at 323.

<sup>243</sup> A licensing scheme, such as the one discussed in this note, would greatly reduce the threat of monopolies; designers would be willing to license their designs for royalties or a fixed fee. See Hagin, *supra* note 12, at 386. This would keep the cost of licensed imitations relatively low, and consumers would still be able to get designer look-a-likes at cheaper prices.

<sup>244</sup> Brown, *Copyright-like Protection*, *supra* note 91, at 323.

<sup>245</sup> A federal law would give the courts a bright-line rule when deciding apparel design cases, thus providing more consistency for future decisions. In addition, designers who are afforded protection for their creations would be assured greater profits, and, in turn, would be likely to create more designs. Bharathi, *supra* note 30, at 1670. This would not only increase domestic revenue for the United States, but revenue abroad as well. *Id.* at 1669-70. Protection for apparel designs would also increase competition because the imitators would begin to create their own original designs.

<sup>246</sup> Brown, *Copyright-like Protection*, *supra* note 91, at 323.

## CONCLUSION

Extending copyright law to afford protection for apparel designs would benefit society, designers and consumers.<sup>247</sup> Apparel designs are no longer merely utilitarian in nature, rather designers must “creat[e] art to fit the framework of the human form [that] often involves creativity (e.g., movement, fluidity), and [demands that the designer] create within the confines of wearability.”<sup>248</sup> Copyright law needs to adapt to changes in society because “copyright protection for fashion works is crucial to competitiveness.”<sup>249</sup> The current copyright law should be adapted to protect apparel designs, and the “proposed amendment better comports with equitable and competitive norms than does current copyright doctrine applied to this area.”<sup>250</sup> The works of fashion designers should be protected because protecting original designs would rid the U.S. apparel industry of free-riders, thus creating a truly level playing field—the very essence of fair competition.<sup>251</sup>

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<sup>247</sup> *Mazer v. Stein*, 347 U.S. 201, 219. “[The] encouragement of individual effort by personal gain is the best way to advance public welfare . . . . Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.” *Id.*

<sup>248</sup> *See Hagin, supra* note 12, at 354.

<sup>249</sup> *See id.* at 387.

<sup>250</sup> *See id.*

<sup>251</sup> *See Brown, Copyright and Its Upstart Cousins: Privacy, Publicity, Unfair Competition*, 33 J. COPYRIGHT SOC’Y 301, 313-20 (1986).

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*Appendix A**United States Code: Title 17**Other Provisions***A Proposed Bill for the Protection of Apparel Designs**

To strengthen the intellectual property laws of the United States by providing protection for original apparel designs against unauthorized copying.

*Section 1. Designs Protected*

## (a) Designs protected.

(1) In general. The designer or other owner of an original design of a useful article, which makes the article attractive or distinctive in appearance to the purchasing or using public, may secure the protection provided by this Act upon complying with and subject to this Act.

(2) Apparel Designs (also referred to as Garment Designs). The design of a garment, including the cut of the fabric and the overall appearance, and not including the fabric design, is subject to protection under this Act, notwithstanding Section 2(d).

## (b) Definitions. For the purpose of this Act, the following terms have the following meanings:

(1) A design is “original” if it is the result of the designer’s creative endeavor that 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. In determining originality, considerations should include but not be limited to the cut of the fabric, the style, the length and the garment’s overall appearance.

(2) A “useful article” is a garment design that in

normal use has an intrinsic utilitarian function exceeding the intention to portray the article or to convey information or an article that is solely useful.

(3) The “design of a useful article,” hereinafter referred to as a “design,” consists of those aspects or elements of the article, including its three-dimensional features of shape, that make up the appearance of the article. The design must be fixed in a useful article to be protectable under this Act.

### *Section 2. Designs Not Subject to Protection*

Protection under this Act shall not be available for a design that is—

- (a) not original;
- (b) staple or commonplace, such as standard geometric figures, familiar symbols, emblems, or motifs; or other shapes, patterns, or configurations that have become common, prevalent, or ordinary;
- (c) different from a design excluded by Subsection (b) above, only in insignificant details or in elements which are variants commonly used in the relevant trades; or
- (d) dictated solely by a utilitarian function of the article that embodies it.

### *Section 3. Revisions, Adaptations, and Rearrangements*

Protection under this Act shall be available notwithstanding Subsections 2(b) through (d), if the design is a substantial revision, adaptation, or rearrangement of said subject matter. Such protection shall be independent of any subsisting protection in subject matter employed in the design, and shall not be construed as securing any right to subject matter excluded from protection under this Act or as extending any

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subsisting protection under this Act.

*Section 4. Commencement of Protection*

The protection provided for a design under this Act shall commence upon the date of publication of the registration pursuant to Section 13(a), or the date the design is first publicly exhibited anywhere in the world, whichever occurs first.

*Section 5. Term of Protection*

(a) In general. Subject to Subsection (b) and the provisions of this Act, the protection herein provided for a design shall continue for a term of one year from the date of the commencement of protection as provided in Section 4.

(b) Upon expiration or termination of protection in a particular design, as provided in this Act, all rights under this Act in said design shall terminate, regardless of the number of different articles in which the design may have been utilized during the term of its protection.

*Section 6. Ownership, Transfer, and Licensing*

(a) The exclusive rights in an apparel design subject to protection under this Act belong to the registrant of the apparel design.

(b) The owner shall retain exclusive rights in the design for the period of one month after registration. After said time has expired, the owner must license the design rights to any qualified requesting retailer or licensee. Such rights may be licensed by operation of law, may be bequeathed by will, and may pass as personal property by the applicable laws of intestate succession.

(c) Any document pertaining to an apparel design may be recorded in the United States Garment Design Protection



Office (“GDPO”) if the document filed for recordation bears the actual signature of the person who executed it or if it is accompanied by a sworn or official certification that it is a true copy of the original, signed document. The Administrator of the GDPO (the “Administrator”) shall, upon receipt of the document and the fee specified by the Administrator, record the document and return it with a certificate of recordation. The recordation of any license under this paragraph gives all persons constructive notice of the facts stated in the recorded document concerning the transfer or license.

- (1) The GDPO shall be responsible for making sure that copies are being sold only by those retailers who have paid the licensing fees to copy the particular apparel designs. Those retailers who are found to be selling a garment that is substantially similar to a protected design will be subject to an infringement action as specified by Section 11 of this Act.

*Section 7. The Garment Design Protection Office  
Responsibilities, and Organization*

(a) All administrative functions and duties under this Act, except as otherwise specified, are the responsibility of the Administrator. The Administrator, together with the subordinate officers and employees of the GDPO, shall be appointed by the Librarian of Congress and shall act under the Librarian’s general direction and supervision.

The Administrator and all subordinate officers who make decisions about which garments shall receive protection, must have a sufficient understanding of past and present apparel designs, and must pass a vigorous examination given by the Administrator.

(b) In addition to the functions and duties set out elsewhere in this Act, the GDPO shall perform the following functions:

- (1) Effectively decide which garments meet the

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requirements necessary to receive copyright protection pursuant to this Act and control the registration process for protectable garments;

(2) Control the collection and distribution of the licensing fees;

(3) Police stores, the internet, magazines, and all other possible clothing distribution arenas to ensure that no copied material is being sold or displayed without a valid license.

(c) The GDPO shall have a separate department, the Anti-Piracy Panel (“APP”), that shall hear and decide claims of infringement. This department shall consist of lawyers trained in the area of intellectual property. If a party wishes to appeal the APP’s decision, the case shall be brought to an appropriate court of jurisdiction.

*Section 8. Garment Design Protection Office Fees*

(a) The Administrator shall, by regulation, set reasonable fees for the filing of applications to register designs under this Act, taking into consideration the cost of providing these services.

(b) The Administrator shall, by regulation, set reasonable fees for the licensing of protected apparel designs.

(c) The employees of the Garment Design Protection Office shall be paid with the monies received through the registration process.

(d) A reasonable percentage of the licensing fees, the amount of which is to be determined by the Administrator, will be set aside for the compensation of the GDPO employees.

*Section 9. Design Notice*

(a) Whenever any design for which protection is sought under this Act is publicly exhibited, as provided in

Section 12(b), the proprietor shall, subject to the provisions of Section 12, mark the design or have the design marked legibly with a design notice consisting of the following three elements (the "Design Notice"):

- (1) the words "Protected Design" or the letter "F" within a circle;
- (2) The year of the date on which protection for the design commenced; and
- (3) The name of the proprietor, an abbreviation by which the name can be recognized, or a generally accepted alternative designation of the proprietor; any distinctive identification of the proprietor may be used if it has been approved and recorded by the Administrator before the design marked with such identification is registered.

After registration, the registration number may be used instead of the elements specified in (2) and (3) hereof.

(b) The Design Notice shall be so located and applied as to give reasonable notice of design protection while the garment is passing through its normal channels of commerce. This requirement may be fulfilled through use of tags affixed to the material.

(c) When the proprietor of a design has complied with the provisions of this Section, protection under this Act shall not be affected by the removal, destruction, or obliteration by others of the Design Notice on an article.

#### *Section 10. Effect of Omission of Design Notice*

The omission of the Design Notice prescribed in Section 9 shall not cause loss of protection, but damages or profits shall not be recoverable under the provisions of this Act in any action for infringement, with the exception of actual proof that the infringer was notified of the design protection and continued to infringe thereafter, in which event damages or profits may be recovered only for

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infringement after such notice.

*Section 11. Infringement*

(a) It shall be infringement of a design protected under this Act for any person, without the consent of the proprietor of the design, by conduct in or affecting commerce during the term of such protection, to—

(1) make, have made or import, for sale or for use in trade, any infringing article as defined in Subsection (d) hereof; or

(2) sell or distribute for sale or use in trade any such infringing article, provided that a seller or distributor of any such article who did not make or import the same shall be deemed to be an infringer if—

(i) he or she induces, or acts in collusion with a manufacturer to make, or an importer to import such article (merely purchasing or giving an order to purchase in the ordinary course of business shall not itself constitute such inducement or collusion); or

(ii) he or she refuses, or fails upon the request of the proprietor of the design, to make a prompt and full disclosure of his or her source of such article, and he or she orders or reorders such article after having received notice by registered or certified mail of the protection subsisting in the design.

(b) It shall not be infringement to make, have made, import, sell, or distribute, any article embodying an apparel design created without knowledge of a protected apparel design.

(c) A person who incorporates into his or her own product of manufacture an infringing article acquired from others in the ordinary course of business or who, without knowledge of the protected design, makes or processes an infringing article for the account of another person in the

ordinary course of business shall not be deemed an infringer except under the conditions of clauses (i) and (ii) of Subsection (a)(2) of this Section. Accepting an order or reorder from the source of the infringing article shall be deemed ordering or reordering within the meaning of Clause (ii) of Subsection (a)(2) of this Section.

(d) An “infringing article” as used herein is any article, the design of which has been copied from, and is substantially similar to, the protected design without the consent of the proprietor, provided that an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture or similar medium shall not be deemed to be an infringing article. An article is not an infringing article if it embodies, in common with the protected design, only elements described in Subsections (a) through (d) of Section 2.

(e) The party alleging rights in any action or proceeding concerning an apparel design shall have the burden of affirmatively establishing its originality whenever the opposing party introduces an earlier work, which is identical to such design, or so similar as to make a prima facie showing that such design was copied from such work.

#### *Section 12. Application for Registration*

(a) Protection under this Act shall be lost if application for registration of the design is not made within one month after the date on which the design was first made public.

(b) A design is made public, either by the designer or with his or her consent, when an existing useful article embodying the design is anywhere publicly exhibited, publicly distributed or offered for sale or sold to the public.

(c) Application for registration may be made by the designer and shall contain such information as required by

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the GDPO.

(d) The application for registration shall be accompanied by a drawing or other pictorial representation of the useful article having one or more views, adequately displaying the design in a form and style suitable for reproduction and shall be accompanied by the prescribed fee.

(e) More than one design may be included in the same application under such conditions as may be prescribed by the Administrator. For each design included in an application the fee prescribed for a single design shall be paid.

*Section 13. Certification of Registration*

Certificates of registration shall be issued in the name of the United States under the seal of the Office of the Administrator and shall be recorded in the official records of the Office. The certificate shall state the name of the useful article, the date of filing of the application, the date of registration and the date the design was made public, if earlier than the date of filing of the application, and shall contain a reproduction of the drawing or other pictorial representation of the design. If a description of the salient features of the design appears in the application, the description shall also appear in the certificate. A certificate of registration shall be admitted in any court as prima facie evidence of the facts stated in the certificate.

*Section 14. Remedy for Infringement*

(a) The proprietor of a design shall have remedy for infringement by means of a hearing in front of the APP. Parties may appeal by bringing a civil action in front of the U.S. district courts or any other court of appropriate jurisdiction.

(b) At the time an infringement action is brought, the alleged infringer may pay the applicable licensing fees to

avoid an action. If this option is refused, the designer of the protected design may attempt to get a preliminary injunction.

(1) Any court having jurisdiction under this Act may, in its discretion, grant injunctions in accordance with the principles of equity to prevent infringement, including prompt relief through temporary restraining orders and preliminary injunctions.

(2) The Courts may appoint a master from the APP to make a preliminary decision about whether the design is likely to infringe. If the master finds the design is likely to infringe, the court can enjoin the alleged infringing party from further sales of the offending design until resolution of the case. If the master finds the design is not likely to infringe, the copyright holder may proceed with the litigation but without a preliminary injunction preventing the other party from manufacturing or selling the allegedly pirated apparel.

(c) The parties to an infringement dispute under this Act, within such time as may be specified by the Administrator by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provision of title 9, United States Code, to the extent such title is not inconsistent with this Section. The parties shall give notice of any arbitration award to the Administrator, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this Subsection shall preclude the Administrator from determining whether a design is subject to registration in a cancellation proceeding pursuant to this Act.

#### *Section 15. Recovery for Infringement*

(a) The claimant may be awarded the infringer's profits resulting from the sale of the copies if it is found that the

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infringer's sales are reasonably related to the use of the claimant's design. In such a case, the claimant shall be required to prove only the infringer's sales and the infringer shall be required to prove its expenses against such sales.

(b) In any action under this Act, the APP, in its discretion, may allow the recovery of full costs by or against any party other than the United States or an officer thereof. The APP may also award reasonable attorney's fees to the prevailing party as part of the costs.

(c) The APP may award punitive damages to the prevailing party as it sees fit.

(d) The APP may order that all infringing articles, and any patterns, models or other means specifically adapted for making the same be delivered up for the destruction or other disposition as the APP may direct.

*Section 16. Penalty for False Marking*

(a) Whoever, for the purpose of deceiving the public, marks upon, or applies to, or uses in advertising in connection with any article made, used, distributed, or sold, the design of which is not protected under this Act, a Design Notice as specified in Section 9 or any other words or symbols importing that the design is protected under this Act, knowing that the design is not so protected, shall be fined not more than \$500 for every such offense.

(b) Any person may sue for the penalty, in which event, one-half shall go to the person suing and the other to the use of the GDPO.

*Section 17. Relation to Other Laws*

Nothing in this Act shall affect any right or remedy held by any person under chapters 1 through 9 of title 17, or under title 35 of the United States Code, or under any



common law, unfair competition law, trademark law or other rights or remedies, if any, available to or held by any person with respect to a design whether or not registered under this Act.

*Section 18. Liability for Action on Registration Fraudulently Obtained*

Any person who brings an action for infringement knowing that registration of the design is obtained by a false or fraudulent representation materially affecting the rights under this Act shall be liable in the sum of \$1,000.00, or such part thereof as the court may determine, as compensation to the defendant, to be charged against the plaintiff and paid to the defendant, in addition to such costs and attorney's fees of the defendant as may be assessed by the court.

*Section 19. Severability Clause*

If any provision of this Act or the application of such provision to any person or circumstance is held invalid, the remainder of the Act or the application to other persons or circumstances shall not be affected thereby.

*Section 20. Time of Taking Effect*

This Act shall take effect immediately after enactment.

*Section 21. No Retroactive Effect*

Protection under this Act shall not be available for any design that has been commercially exploited as provided in Section 11(b) prior to the effective date of this Act.

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*Section 22. Short Title*

This Act may be cited as “The Garment Design Protection Act of 2002”.