



## The History and Doctrine of American Copyright Protection for Fashion Design: Managing *Mazer*

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### I. INTRODUCTION TO *MANAGING MAZER*

In order to be copyright-eligible, a component of fashion design must be not only “fixed” and “original” (as discussed in the previous installment of this five-article series, *On ‘Originality’*), but also constitute a work whose aesthetic characteristics are *separable* from the “utilitarian” material to which it is affixed.<sup>1</sup> In this installment of *The History and Principles of American Copyright Protection for Fashion Design*, I trace the trajectory of the courts’ rulings on the copyrightability of certain aspects of fashion design in the wake of the Supreme Court’s pivotal 1954 decision in *Mazer v. Stein*.<sup>2</sup>

I will begin with a discussion of the background and substance of the Supreme Court’s *Mazer* decision. I will then provide a series of more or less detailed chronologies of lower-court rulings on the copyrightability of fashion design between the mid-1950s and mid-1970s, resulting in the crystallization of certain categories of presumptively copyright-eligible fashion works—namely, fabric patterns and lace; focal images placed on wearable objects; jewelry design; and some costume works. Along the way, I will

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<sup>1</sup> For works subject to the Copyright Act of 1976, the “separability” determination is intertwined with the “useful articles” inquiry laid out at 17 U.S.C. § 101 (2016). This article focuses primarily on the “separability” case law that developed before and/or independently of § 101; the next article in this five-part series examines the judicial decisions purportedly reaching conclusions on separability through an application of the 1976 Act’s operative provisions.

<sup>2</sup> 347 U.S. 201 (1954). The numerous non-“doctrinal” influences on this jurisprudence will be explored in the fifth and final installment of this series, *The Politics of ‘Piracy.’*

highlight techniques employed by courts sometimes limiting the practical impact of the *Mazer* decision.

In the next article in this series, *On 'Useful Articles,'* I will turn my attention to the very different jurisprudence that has emerged from copyright-for-fashion litigation over other types of works from the late 1970s to present. As I will discuss, the categories mentioned above were “grandfathered in” in key respects, while judges’ treatment of fashion design not falling comfortably into those categories led to the proliferation of varied “useful article”/“separability” frameworks purportedly crafted to guide determinations of the copyrightability of these new items.<sup>3</sup> As of this writing, the Supreme Court has granted *certiorari* in a case concerning these frameworks; the Court’s decision in that case will be examined in the next installment of this series.<sup>4</sup>

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<sup>3</sup> In practice, I will argue, most of these frameworks have not only been structured and/or finessed as to keep not-yet-adjudicated aspects of fashion design from being welcomed into the fold of copyrightability, but also to provide a means for courts to engage in a “discourse of intractability.” Many of the long-existing stigmas on design—especially fashion design—continue to carry force today. *Cf.* Charles E. Colman, *Design and Deviance: Patent as Symbol, Rhetoric as Metric—Part 1*, 55 JURIMETRICS J. 419 (2015) (discussing influence and legacy of anti-design attitudes on U.S. intellectual property law).

<sup>4</sup> See *Star Athletica, LLC v. Varsity Brands, Inc.*, 15-866 (U.S. May 2, 2016). Some might see in the Supreme Court’s willingness to hear the *Star Athletica* appeal a newfound appreciation of design-law issues, particularly on the heels of the Court’s recent grant of *certiorari* in another case hinging on a question of substantive design-patent doctrine (the first time the Court has agreed to hear such a case in over a century.) See *Samsung Electronics Co. v. Apple*, 15-777 (U.S. Apr. 5, 2016); Charles E. Colman, *Design and Deviance: Patent as Symbol, Rhetoric as Metric—Part 2*, 56 JURIMETRICS J. 1, 18-21, 42-44 (2015) (examining context and effects of the Court’s late nineteenth-century withdrawal from design-patent realm). While the Court’s actions could conceivably represent a rapprochement with design, it seems more likely that the Justices consider such cases sufficiently low-stakes for adjudication by an eight-Justice Court. See Robert Barnes, *Scalia’s death affecting next term, too? Pace of accepted cases at Supreme Court slows*, WASHINGTON POST, May 1, 2016, available at [https://www.washingtonpost.com/politics/courts\\_law/scalias-death-affecting-next-term-too-pace-of-accepted-cases-at-supreme-court-slows/2016/05/01/1d304d1c-0ecb-11e6-bfa1-4efa856caf2a\\_story.html](https://www.washingtonpost.com/politics/courts_law/scalias-death-affecting-next-term-too-pace-of-accepted-cases-at-supreme-court-slows/2016/05/01/1d304d1c-0ecb-11e6-bfa1-4efa856caf2a_story.html) (“The court has accepted only six cases since [Justice Antonin] Scalia died Feb. 13. The number is low compared with the average, Scotusblog.com editor Amy Howe said at an event last week reviewing the Supreme Court’s work. And none of the cases that the court has accepted for the term that begins in October approach the level of controversy that have marked the dramatic rulings of recent years.”).

## II. THE SUPREME COURT'S 1954 DECISION IN *MAZER V. STEIN*

As discussed in the first installment of this series, *A Strange Centennial*, copyright protection for works of “fashion design”<sup>5</sup> was almost completely unavailable (and, in any event, essentially unenforceable) under U.S. copyright law until the mid-1950s. Consistently adverse judicial treatment of fashion design in copyright litigation notwithstanding, the Copyright Office had for some time been accepting deposits and issuing registrations for certain artistic features of consumer goods. That practice would both foreshadow and facilitate the courts’ mid-century shift in their attitude toward the copyrightability of works of applied art and industrial design.

Indeed, in the early 1950s, various cultural, economic, political, and jurisprudential forces contributed to newly favorable—if sporadic—judicial applications of intellectual-property law doctrines to works of design.<sup>6</sup> In

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<sup>5</sup> For the definition of “fashion” used here, see my discussion in the first installment of this series, *A Strange Centennial*, 6 HARV. J. SPORTS & ENT. L. 225, 228 (2015) (“The term ‘fashion’ is generally used throughout this series to refer to the design (i.e., shape, color, material, and overall appearance) of items, not exclusively utilitarian in nature, that are created primarily to be worn or carried on the human body.”) (Emphasis removed.) I use this definition mindful of the fact that much broader (and more sociologically and/or theoretically meaningful) definitions of fashion are available. See, e.g., Herbert Blumer, *Fashion*, in THE INTERNATIONAL ENCYCLOPEDIA OF SOCIAL SCIENCES V, 341, 341-42 (David L. Sills ed., 1968) (suggesting the terms “in fashion” and “outmoded” “signify a pattern of change in which certain social forms enjoy temporary acceptance and respectability only to be replaced by others”); Joanne E. Eicher, *Editing Fashion Studies*, in FASHION STUDIES: RESEARCH METHODS, SITES AND PRACTICES 199, 204-05 (Heike Jenks, ed., 2016) (“What is seen or understood as fashion depends on space and time . . .”). I am also cognizant that similar assumptions about “utilitarian” items characterize my working definition and many of the judicial analyses deconstructed in the next installment of this series; these assumptions will be unpacked in due course.

<sup>6</sup> Among the many factors paving the way for the courts’ change of direction in this area, as I will discuss in *The Politics of ‘Piracy,’* were (1) the cultural repositioning of mass-produced works of industrial design and applied arts as a form of artistic imagination and marketing tool newly aligned with corporate objectives; (2) a mid-century governmental implementation of policies in multiple areas, including intellectual property law, that appeared to strike a desirable balance among the virtues and imperatives of anti-elitism, egalitarianism among art forms, and gendered morality; (3) a newfound judicial sensitivity to a growing popular awareness of the contingent and personal nature of adjudication, and corollary critiques of bias, in the form of incipient accusations of “judicial activism” that surfaced in the wake of New Deal-era inter-branch conflicts; and (4) apparent macroeconomic and geopolitical mandates under which the federal judiciary was partially tasked with helping to present the United States as the archetypal free “Affluent Society”—in contradistinction to the Soviet Union, during a tense phase of the Cold War—in which the

1951, for example, the Fourth Circuit in *Glen Raven Knitting Mills v. Sanson Hosiery Mills* affirmed the validity of a design patent in a new type of hosiery, to the surprise of practitioners accustomed to the appellate courts' longtime hostility toward design patents.<sup>7</sup> Later that year, District Court Judge Welsh of the Eastern District of Pennsylvania—notably the erstwhile Chairman of the long-dissolved Committee on Industrial Art and Expositions in the U.S. House of Representatives—took note of the *Glen Raven* decision in ruling that the party prevailing before the Fourth Circuit could tell the world of its rivals' design-patent infringement without significant risk of liability.<sup>8</sup> Even more surprisingly, Judge Welsh's opinion diverged from decades of anti-design rhetoric in the courts by making a point of praising the fashion design in question.<sup>9</sup>

Soon thereafter, a few bold plaintiffs decided to try their luck in the arena of *copyright* protection for works of industrial design.<sup>10</sup> The conflicting judicial decisions arising from such litigation paved a path to the Supreme Court; in its 1954 decision in *Mazer v. Stein*, the Court held that a sculptural work in the shape of a dancer, designed to be used as a mass-produced lamp base, was copyrightable despite the “utilitarian” function to which it was dedicated.<sup>11</sup>

The *Mazer* Court invoked a somewhat amorphous combination of “economic” considerations,<sup>12</sup> a self-consciously egalitarian view of “art,”<sup>13</sup> and

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symbols of American virtue and luxury consistently took the form of artistic and/or consumer goods.

<sup>7</sup> 189 F.2d 845 (4th Cir. 1951).

<sup>8</sup> *Sharnay Hosiery Mills, Inc. v. Sanson Hosiery Mills, Inc.*, 109 F.Supp. 956, 958 (E.D. Pa. 1951).

<sup>9</sup> *Id.* at 957 (“Prior to the appearance of the stockings of the Bley Patent on the market, nearly all stockings worn by women embodied a conventional type of heel and foot-sole reinforcement having at the back thereof either a plain rectangular or triangular configuration or a patch tapering upwardly to a narrow top. The Bley invention revitalized the old conventional reinforcement, bringing out its latent possibilities and converting it into an attractive design. What had heretofore constituted a mere wear-resistant reinforcement, largely functional and often relatively unsightly in appearance, was transformed into an ornamental feature of such appeal to the purchasing public that it was an immediate success.”).

<sup>10</sup> 347 U.S. 201 (1954).

<sup>11</sup> *Id.* at 204-05 (asking whether “statuettes [can] be protected in the United States by copyright when the copyright applicant intended primarily to use the statuettes in the form of lamp bases to be made and sold in quantity and carried the intentions into effect,” and answering in the affirmative).

<sup>12</sup> *See id.* at 219 (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the

gestures of inter-branch deference<sup>14</sup> in order to reach its ruling. The justifications that sounded in judicial restraint received disproportionate space and attention in the *Mazer* decision. Citing materials submitted by the Register of Copyrights, in conjunction with the Department of Justice, the Court proceeded from the observation that the Copyright Office had indeed issued registrations to the creators of some works of industrial design to the more sweeping conclusion that “[t]he practice of the Copyright Office [has been] to allow registration ‘as works of the fine arts’ of articles of the same charac-

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talents of authors and inventors in ‘Science and useful Arts.’ Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”).

<sup>13</sup> See *id.* at 213, 214 (“This Court once essayed to fix the limits of the fine arts . . . Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.”) The Court cited several cases in support of this proposition, including the still-influential *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903) (Holmes, J.) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change. That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs’ rights . . . We are of opinion that there was evidence that the plaintiffs have rights entitled to the protection of the law.”).

<sup>14</sup> See *Mazer*, 347 U.S. at 213-214 (“The successive acts, the legislative history of the 1909 Act and the practice of the Copyright Office unite to show that ‘works of art’ and ‘reproductions of works of art’ are terms that were intended by Congress to include the authority to copyright these statuettes. Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. As a standard we can hardly do better than the words of the present Regulation [of the Copyright Office] naming the things that appertain to the arts. They must be original, that is, the author’s tangible expression of his ideas. Such expression, whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color, is copyrightable. What cases there are confirm this coverage of the statute. The conclusion that the statues here in issue may be copyrighted goes far to solve the question whether their intended reproduction as lamp stands bars or invalidates their registration. This depends solely on statutory interpretation. Congress may after publication protect by copyright any writing of an author.”) (Internal citations omitted.).

ter as those of respondents now under challenge.”<sup>15</sup> The Court treated this practice as the Office’s expert reading of a recently revised regulation:

The current pertinent regulation, published in 37 C.F.R. § 202.8 (1940), reads thus: Works of art (Class G) — (a) In General. This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. . . .

So we have a contemporaneous and long-continued construction of the statutes by the agency charged to administer them that would allow the registration of such a statuette as is in question here.<sup>16</sup>

The Court’s identification of a purported “contemporaneous and long-continued construction” of the copyright statutes by the Copyright Office was an oversimplification, at best; an exercise in revisionist history, at worst. In any event, the Court’s reiteration of Justice Holmes’ articulation of “art” in *Bleistein*, now imported into the design context, was unequivocal: “Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.”<sup>17</sup> The accompanying holding, if somewhat less transparent, was equally designer-friendly: “We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law.”<sup>18</sup>

### III. MAZER-INSPIRED DEVELOPMENTS CONCERNING THE COPYRIGHTABILITY OF CERTAIN COMPONENTS OF FASHION DESIGN

Designers in diverse industries quickly recognized the potential significance of *Mazer* for their creative and commercial goals; the Register of Copyright’s November 1956 Report to Congress noted, for example, that “[a]s a

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<sup>15</sup> *Mazer*, 347 U.S. at 211-12 (internal citations omitted).

<sup>16</sup> *Id.* at 212-13 (internal citations omitted).

<sup>17</sup> *Id.* at 214.

<sup>18</sup> *Id.* at 218. As I will explain in the fifth and final installment of this series, *The Politics of ‘Piracy,’* there were compelling non-“legal” considerations that perhaps motivated the Court’s ruling. The Court arguably gestured to its encouragement of using the different branches of IP law to build up the American design industries—not only copyright, but “unfair competition,” which the Court seemed to suggest in *Mazer* as another potential basis on which the plaintiffs might have brought their claim, and design patents, whose potential availability, the Court noted, did not preclude the lamp bases’ copyrightability. *See id.*

result of the decision of the Supreme Court in *Mazer v. Stein* (347 U. S. 201), several suits have been filed to test the extent of copyright protection for designs in jewelry . . . .<sup>19</sup> Indeed, the first wave of post-*Mazer* fashion-related litigation concerned works of costume jewelry, resulting in decisions like *Trifari, Krussman & Fishel, Inc. v. Charel Co.*<sup>20</sup> There, a judge in the Southern District of New York in September of 1955 invoked *Mazer* in rejecting a defendant's contention that a plaintiff's costume jewelry (which the defendant had "[c]haracterize[ed] . . . disparagingly as 'junk jewelry,'" to the court's apparent displeasure) belonged to a genre of works categorically ineligible for copyright protection.<sup>21</sup> The court reasoned:

In defining the scope of the term 'works of art' as used in Section 5(g) of the Copyright Act, 17 U.S.C.A., the Supreme Court has said: 'we can hardly do better than the words of the present Regulation, § 202.8 . . . naming the things that appertain to the arts.' [*Mazer*, 347 U.S. at 201, 202, 214] . . . .

'§ 202.8 Works of art (Class G)— (a) In general. This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as *artistic jewelry*, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture . . . .'<sup>22</sup>

The *Trifari* court proceeded to paraphrase *Mazer's* egalitarian teachings about art:

Artistic expression may take innumerable forms; '(i) individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.' [*Mazer*, 347 U.S. at 21]. Costume jewelry may express the artistic conception of its 'author' no less than a painting or a statue . . . . A necklace, like a circus poster or a book, is not to be denied the benefits of the Copyright Act because it may not attain the same recognition as is accorded the work of a renowned artist. So long as the material for which copyright is sought exhibits some degree of individuality so that the court is convinced that the author has created an original, tangible expression of

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<sup>19</sup> FIFTY-NINTH ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS FOR THE FISCAL YEAR ENDING JUNE 30, 1956, 5-6, COPYRIGHT OFFICE, THE LIBRARY OF CONGRESS (1956).

<sup>20</sup> 134 F. Supp. 551 (S.D.N.Y. 1955).

<sup>21</sup> *Id.* at 552. The court described plaintiff's work as "an article of ladies costume jewelry consisting of a series of half beads or 'cabs,' each surrounded by a narrow graduated rim of gold colored metal which folds around and over parts of the cab in such manner that the connecting links between the cabs are effectively concealed"). *Id.* at 553.

<sup>22</sup> *Id.* at 552 (emphasis added to regulation language by court).

an idea rather than a merely pleasing form dictated solely by functional considerations, copyright registration is available. It is this expression which the copyright statute is designed to protect . . . . In the case of costume jewelry, while the overall form is to some extent pre-determined by the use of 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. There is neither basis in the Copyright Act nor judicial precedent for excluding costume jewelry from works of art to which copyright protection may attach. Simply because it is a commonplace fashion accessory, not an expression of 'pure' or 'fine' art does not preclude a finding that plaintiff's copyrighted article is a 'work of art' within the meaning and intent of the Act.<sup>23</sup>

Designers followed cases like *Trifari* and responded to the outcomes in largely predictable ways. As the Copyright Office reported to Congress in the above-mentioned 1956 Annual Report: "Registrations for published works of art increased 44 percent over 1955, due largely to an influx of jewelry resulting from . . . favorable court decisions."<sup>24</sup> More registrations resulted in more litigation, which would—at least at first—be resolved similarly to *Trifari*. By 1958, a Second Circuit panel felt that the question had been sufficiently tested to justify its publication of a *per curiam* decision that began: "It is not seriously disputed that defendants manufactured and sold carbon copies of certain items of costume jewelry which had been registered in accordance with the Copyright Act as works of art."<sup>25</sup>

Initially, creators of fabric patterns were more cautious than were jewelry designers in invoking *Mazer*; as the Register of Copyrights informed Congress in his 1956 Annual Report, the Copyright Office had been surprised not to encounter a post-*Mazer* "rush" in textiles.<sup>26</sup> When viewed against the bitter history of fabric designers' failed efforts to marshal copyright law in their favor, however, such reticence was arguably to be expected. Fresh in the minds of those favoring the copyrightability of fabric patterns were three decades of unsuccessful lobbying and essentially near-unanimous adverse decisions in the federal district courts, the Second Circuit,<sup>27</sup> and even the Supreme Court.<sup>28</sup>

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<sup>23</sup> *Id.* at 553.

<sup>24</sup> *Supra* note 19, at 6.

<sup>25</sup> *Boucher v. Du Boyes, Inc.*, 253 F.2d 948, 949 (2d Cir. 1958), *cert. denied*, *Du Boyes, Inc. v. Boucher*, 347 U.S. 936 (Jun. 30, 1958).

<sup>26</sup> *Supra* note 19, at 6.

<sup>27</sup> As discussed in *A Strange Centennial*, *supra* note 5, the decision in *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (1929), *cert. denied*, 281 U.S. 728 (Mar. 12, 1930), though resting on somewhat different grounds, was (and still is) often remembered



Further, while the Copyright Office's 1956 regulation on copyrightable works (quoted in the *Trifari* excerpt appearing above) listed "tapestries" alongside works of "artistic costume jewelry," there was no administrative language concerning other types of textiles.<sup>29</sup> Indeed, it was not clear that the courts would readily welcome into the copyright fold works of industrial design and applied art not specifically listed in the relevant regulations; as late as 1958, one Second Circuit panel majority in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.* effectively denied copyright protection to the designer of an elaborate wrist watch:

In the case at bar it might be argued that the Register's decision [not to register] the plaintiff's wrist watch [as] a 'work of art' within § 5(g) of Title 17 involved such an exercise of discretion that 'mandamus' will not go to review it. It is true that 'works of art' is a loose phrase whose perimeter is hard to define; nevertheless, the decision here did not demand the exercise of a discretion that was conclusive with the Register. There were no disputed facts; and the mere fact that the meaning of the phrase, 'works of art,' admits of debate does not make it different from many statutes whose interpretation is every day regarded as reviewable by courts . . . . The judgment dismissing the copyright count will be affirmed.<sup>30</sup>

On the one hand, the Copyright Office had revised its 1949 regulations concerning copyrightable works of art in 1956 and would do so again in 1959, each time without making any mention of apparel.<sup>31</sup> On the other hand, the Supreme Court in *Mazer* seemed to urge, if not require, judicial deference to the Office where it had—unlike in *Vacheron & Constantin-Le*

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as standing for the proposition that fabric patterns were not copyrightable. Bolstering the impact of *Cheney Bros.* was the stature of Judge Learned Hand, who authored that decision and many subsequent Second Circuit decisions relying on *Cheney Bros.*-like reasoning. By 1950, Hand was among the most widely respected jurists in the United States, especially in the area of intellectual property law. See EDWARD G. WHITE, *THE AMERICAN JUDICIAL TRADITION: PROFILES OF LEADING AMERICAN JUDGES* 263-64 (rev. ed. 1988); *R. M. Palmer Co. v. Luden's, Inc.*, 236 F.2d 496, 500 (3d Cir. 1956) (invoking Hand's name twice in two paragraphs to bolster ruling on design patents).

<sup>28</sup> See *A Strange Centennial*, *supra* note 5, at 266 (discussing the context and reasoning of the *FOGA* decision).

<sup>29</sup> See *Mazer*, 347 U.S. at 214 ("As a standard we can hardly do better than the words of the present Regulation . . . naming the things that appertain to the arts.").

<sup>30</sup> 260 F.2d 637, 640 (2d Cir. 1958).

<sup>31</sup> 37 C.F.R. 202.1 (1956); 24 Fed. Reg. 4955 (Jun. 18, 1959) (announcing a new proposed version of Copyright Office regulations for public comment).

*Coultre Watches, Inc.*—granted a copyright registration, an act premised on the conclusion that a creator's material was indeed a "work of art."<sup>32</sup>

Potential litigants' ambitions to ask courts to apply *Mazer* and its progeny to fabric patterns, and judicial receptivity thereto, likely drew on newfound momentum for design in adjacent areas of U.S. intellectual property law. Objects from timepieces to flatwear had recently started to receive more favorable treatment from courts applying state unfair competition law and Section 43(a) of the Lanham Act of 1946;<sup>33</sup> even the long-marginalized design patent seemed to be gaining ground in the federal appellate courts throughout the 1950s.<sup>34</sup> In short, it seemed that those who made a living

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<sup>32</sup> See *Trifari, Krussman & Fishel, Inc. v. B. Steinberg-Kaslo Co.*, 144 F. Supp. 577, 579 (S.D.N.Y. 1956) ("All works of art may be copyrighted. 17 U.S.C. § 5(g). The regulations include costume jewelry within this category. 37 C.F.R. § 202.8. Unless these regulations are invalid therefore, plaintiff, at least initially upon registration, obtained a valid copyright. I see no reason to depart from the decisions in this District holding them valid. See *Hollywood Jewelry Mfg. Co. v. Dushkin*, D.C.S.D.N.Y., 136 F.Supp. 738; *Trifari, Krussman & Fishel, Inc., v. Charel Co.*, D.C.S.D.N.Y., 134 F.Supp. 551.").

<sup>33</sup> Compare *General Time Instruments Corp. v. U. S. Time Corp.*, 165 F.2d 853 (2d Cir. 1948), *cert. denied*, 334 U.S. 846 (Jun. 14, 1948) (rejecting viability of clock designer's unfair competition claim over dissenting judge's wish to remand for fact-finding on "secondary meaning" issue) with *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-LeCoultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir. 1955), *cert. denied*, 350 U.S. 832 (Oct. 10, 1955), *reb'g denied*, 350 U.S. 897 (Nov. 14, 1955) ("[A]s the judge found, plaintiff [and counterclaim defendant] copied the design of the Atmos clock because plaintiff intended to, and did, attract purchasers who wanted a 'luxury design' clock. This goes to show at least that some customers would buy plaintiff's cheaper clock for the purpose of acquiring the prestige gained by displaying what many visitors at the customers' homes would regard as a prestigious article."). See also *Dior v. Milton*, 155 N.Y.S.2d 443, 460 (Sup. Ct. N.Y. Cty. 1956), *aff'd*, 156 N.Y.S.2d 996 (N.Y. App. Div. 1956) ("There is no reason apparent to this court why the rights of the plaintiffs [in its 'unique and valuable dress designs' displayed in private showroom and copied by defendant] should receive less protection than those of the sponsor of sporting events and the disseminator of news. The law at least regards both of these diverse facets of human endeavor with impartial and approving judgment. Equity will not bear witness to such a travesty of justice; it will not countenance a state of moral and intellectual impotency. Equity will consider the interests of all parties coming within the arena of the dispute and admeasure the conflict in the scales of conscience and on the premise of honest commercial intercourse.").

<sup>34</sup> Compare *Neufeld-Furst & Co. v. Jay-Day Frocks*, 112 F.2d 715, 715 (2d Cir. 1940) (*per curiam*) ("In the case at bar the prior art showed numerous designs for dresses each of which had one or more of the salient features of the patent in suit. To combine them into the design of the patent produced a dress of new and pleasing appearance which caught the fancy of the purchasing public in the summer of 1938,

designing fabric patterns—only to get “knocked off”—should make another go at copyrightability in the post-*Mazer* era.<sup>35</sup> And they did, with initially remarkable success.

By the end of the decade, the issue of intellectual property protection for applied art and industrial design seemed to be on everyone’s radar. Shifting attitudes toward intellectual property protection for design are reflected not only in case law of the period—examined in much greater detail, below—but in other legal spheres. One prominent co-sponsor of a 1961 bill to amend the design patent laws, for example, declared to the Senate (in a dramatic departure from the pervasive anti-design rhetoric of just a few years before): “The importance of this proposed legislation ought not be underestimated because in recent years designs are applied to the whole area of modern industry. There is scarcely a manufactured article not affected by

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but we cannot say that it required more than the skill of a good dressmaker who had, or is chargeable with, knowledge of the prior art. We think the patent is invalid. The decree should be reversed and the complaint dismissed. So ordered.” *with International Silver Co. v. Pomerantz*, 271 F.2d 69, 71 (2d Cir. 1959) (“The defendant, we hold, failed to prove that the patent in suit did not have the requisites of patentability. Concededly, the flatware prior art contained some three thousand design patents. The defendant, from this number, selected twenty-one design patents as the most pertinent to the patent in suit, which it put in evidence. These we have carefully scrutinized and find not one which gives the effect of the asymmetrical swirling contours combined with the flutings disclosed by Doerfler’s ‘Flair.’ And the defendant in this case, unlike the defendant in *Gold Seal Importers, Inc.*, *supra*, put in evidence not a single design from the prior unpatented art. Assuming, as we must, that the prior art patents in evidence, which the defendant has culled from the vast prior art, illustrate the general level of skill in design in this field, consistent with the authorities cited above we think the judge below did not err in his conclusion that the design in suit was not only novel, original and genuine artistic merit but also so striking and so arresting in the effect produced as to attest the presence of a creative skill surpassing that of a routinier.”). *See also Pomerantz*, 271 F.2d at 72 (Swan, J., concurring) (“In recent years this court has sustained few design patents. Were I sitting alone, I should be disposed to hold that the design of the patent in suit does not differ sufficiently from the prior art— particularly Patent Des. No. 167,490 to Van Koert and Patent Des. No. 172,006 to Conroy et al.— to establish that ‘invention’ was required to create it. But what is ‘invention’ in a design is a matter upon which one can seldom reasonably hold a dogmatic opinion. My brothers are satisfied that the patent in suit is valid. While not free from doubt, I am willing to concur in their judgment.”); Colman, *supra* note 4, at 18-26 (investigating judicial motivations behind multi-decade period of design patents’ near-total irrelevance).

<sup>35</sup> The success of these multiple waves of copyright-for-design lawsuits, along with the array of cultural and political factors to be discussed in *The Politics of Piracy*, dovetailed in important ways with 1950s developments in international harmonization of intellectual property laws.

design.”<sup>36</sup> While legislative efforts concerning design always seemed to run into one obstacle or another,<sup>37</sup> the courts pressed onward—not only in copyright doctrine, but also in the areas of “trade dress” rights and, if somewhat more haltingly, design patent law. Eventually, concerns about overlapping rights would find their way into the text of judicial decisions, as discussed below. As with this series more generally, the sections that follow are mostly limited to an examination of the federal courts’ rulings on the *copyright-eligibility* of various types of fashion-related items in the wake of the 1954 *Mazer* decision. At the same time, this subject matter-eligibility question repeatedly bleeds into issues of “originality,” the “idea-expression” distinction, and the application of the “substantial similarity” test for infringement—as courts have narrowed the scope of copyright for works that many judges seem to wish had never been brought under the umbrella of copyright law in the first place.

While the decisions reviewed below extend from the years immediately following *Mazer* to more recent decades, this installment of *The History and Principles of American Copyright Protection for Fashion Design* generally defers questions about the effect of design-oriented provisions of the Copyright Act of 1976. Seizing on statutory language about “useful articles” and “separability,” many courts since the late 1970s have issued decisions—alternately reflective and cursory—that have collectively turned the tide against the possibility of copyrightability for new aspects of fashion design.

With that said, the categories of fashion-related works recognized as copyrightable before 1978 have—at least formally<sup>38</sup>—been “grandfathered” into copyright protection, language of the 1976 Copyright Act notwithstanding. Thus, most cases involving jewelry design and fabric patterns continue to be adjudicated under slight variations on pre-1978 doctrinal frameworks.<sup>39</sup> While this installment addresses the first wave of fashion-related works deemed presumptively copyrightable under *Mazer v. Stein*, the

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<sup>36</sup> Hearing on S. 1884, U.S. Senate Subcommittee on Patents, Trademarks, and Copyrights (Aug. 15, 1961).

<sup>37</sup> See generally David Goldenberg, *The Long and Winding Road: A History of the Fight Over Industrial Design Protection in the United States*, 45 J. COPYRIGHT SOC'Y U.S.A. 21 (1997).

<sup>38</sup> I hedge on this point because, as discussed at length in the previous installment of this series, *On 'Originality,'* 6 HARV. J. SPORTS & ENT. L. 299 (2015) (and in the next installment, *On 'Useful Articles'*), the federal courts have at certain points employed other doctrines, reasoning, and rhetorical techniques resulting in the *unenforceability* of various plaintiffs’ ostensible rights in copyrightable and copyrighted fashion-related creations.

<sup>39</sup> There have been rare instances in which the phrase “useful articles” has had direct statutory (*i.e.*, non-precedent-based) relevance to the enforceability of copy-

next installment of this series will proceed to examine frameworks developed under the Copyright Act of 1976 to determine the copyrightability of other types of fashion-related works (including the famed “belt buckle” case, *Kieselstein-Cord v. Accessories by Pearl*, adjudicated by the Second Circuit in 1980<sup>40</sup>).

#### A. *The copyrightability of fabric patterns*

The Second Circuit in 1991 described the general doctrinal landscape of copyright protection for fabric patterns:<sup>41</sup>

We begin with general principles bearing on the copyrightability of fabric designs. The right of an author under the common law to have the sole right of first printing and publishing his work was settled early in England by Lord Mansfield writing for the majority in *Millar v. Taylor*, 4 Burrows 2303 (1769). This common law concept was adopted in our Constitution which authorized Congress “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. The word “writings” is broadly construed; it includes all its forms that may be used to the end that the author’s ideas are tangibly expressed. Thus, a drawing which may be “multiplied by the arts of printing in any of its branches” is copyrightable by its author, who is defined as the “originator” or “maker.” *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56-58, 28 L. Ed. 349, 4 S. Ct. 279 (1884).

Among those forms of “writings” now recognized as entitled to copyright protection are fabric designs, which are the subject matter of this appeal. See, e.g., *Millworth Converting Corp. v. Slifka*, 276 F.2d 443 (2d Cir. 1960) (Friendly, J.); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960) (L. Hand, J.). Fabric designs are distinguished from “dress designs,” which as useful articles under 17 U.S.C. § 101, are not typically

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rights in fabric patterns. See, e.g., *Langman Fabrics v. Graff Californiawear, Inc.*, 160 F.3d 106, 110, 114-15 (2d Cir. 1998).

<sup>40</sup> 632 F.2d 989 (2d Cir. 1980).

<sup>41</sup> *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (2d Cir. 1991). I refer to fabric “patterns” in order to draw a distinction with “images placed on wearable objects,” discussed below. The salient distinction, for present purposes, is whether the images appearing on textiles and other fashion-related materials appear to constitute a central “focal point” or a diffuse field of visual stimuli for a hypothetical viewer. I use this as an organizational tool, despite its partial asymmetry with fashion-industry practices and understandings, because copyright disputes tend to yield judicial decisions more explicitly concerned with visual effects than with the specific weaving and/or printing techniques used to achieve those effects.

copyrightable. See *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989); 1 *Nimmer on Copyright*, § 2.08(H) (1990).<sup>42</sup>

It would not be feasible—or even necessarily helpful—to provide a complete inventory or taxonomy of decisions on the copyrightability of fabric patterns here. Thus, I will present a selective chronology of cases and illuminating excerpts to highlight general trends in this area of law, beginning in the late 1950s:

- *Peter Pan Fabrics Inc. v. Brenda Fabrics Inc.*, 169 F. Supp. 142, 143 (S.D.N.Y. 1959)

The problem to be decided is whether a design printed upon dress fabric is a proper subject of copyright. Much help can be obtained from section 5 of Title 17 U.S. Code, which requires that the application for registration for copyright shall specify that the work in which copyright is claimed belongs to one of thirteen enumerated classes lettered (a) to (m). Class (g) is described as 'Works of art; models or designs for works of art.' Class (k) is described as 'Prints and pictorial illustrations including prints or labels used for articles of merchandise.' . . .

[Based on this statutory language—without specific regard to the language of Copyright Office regulations—the rationale of *Mazer*, and the policy considerations in *Bleistein v. Donaldson Lithographing Co.* on which the *Mazer* Court relied], I therefore find that plaintiffs' design is a proper subject of copyright both as a work of art and as a print. It was described in the application for copyright as a work of art but that does not preclude sustaining its copyrightability on the ground that it is a print. It is provided in section 5 of title 17 referred to above that no error in classification shall invalidate or impair the copyright protection secured under that title.

- *Peter Pan Fabrics, Inc. v. Acadia Co.*, 173 F. Supp. 292, 296 (S.D.N.Y. 1959), *aff'd*, *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960) (Hand, J.)

[T]he court has concluded that the plaintiffs *prima facie* have validly copyrighted the designs in issue; that both defendants have infringed the copyrights by copying; that all of the defendants' contentions are lacking in merit; and, consequently, plaintiffs' motions for a preliminary injunction should be and hereby are, granted as to both defendants . . . .

In order to satisfy the demand by better women's apparel manufacturers for highly styled and novel materials, plaintiffs maintain a design department and send their representatives throughout the style centers of the world for the purpose of producing new and fashionable textiles. This em-

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<sup>42</sup> *Id.* at 762-63.

phasis on creating original, highly-styled designs requires the plaintiffs to produce a full line of new designs in all colors, although only a few of such designs become popular in any one selling season. To recoup the costs that are an inherent part of this mode of operation, the plaintiffs must necessarily charge a price that is substantially higher than that of a converter of finished printed textiles [like defendant] who ‘adopts’ a successful design.

- *Scarves by Vera, Inc. v. United Merchants & Mfgs., Inc.*, 173 F. Supp. 625, 627 (S.D.N.Y. 1959)

Plaintiff has obtained certificates of copyright Nos. Pg 16899, Gp 16624 and Gp 15744, under class (g) of 17 U.S.C. § 5: ‘Works of art; models or designs for works of art.’ Each is a silk screen painting which plaintiff applies in the manufacture of ladies blouses. The first is titled ‘Big Fish’, the second, ‘Sailor’, and the third, ‘Ice Cream Parlor’. The defendants do not argue that a design printed upon blouse fabric is not a proper subject of copyright, or that the designs in issue were not validly copyrighted. Clearly the design is a proper subject of copyright, [*Peter Pan Fabrics, Inc. v. Brenda Fabrics*, 169 F. Supp. 142 (S.D.N.Y. 1959)] (Dimock, J.); *Cf. Mazer v. Stein*, 347 U.S. 201 [(1954)]; *see* 37 C.F.R. § 202.10(b), as of Jan. 1, 1959. And there is sufficient originality in the designs to warrant copyright. Obviously, fish, sailor suits and ice cream parlor trappings are in the public domain, but the plaintiff has contributed enough to qualify the designs as distinguishable variations. *See Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, [191 F.2d 99, 102-103 (2d Cir. 1951)]. ‘Copyright protection extends to any production of some originality and novelty, regardless of its commercial exploitation or lack of artistic merit.’ *Rushton v. Vitale*, [218 F.2d 434, 435 (2d Cir. 1955)]; *Mazer v. Stein, supra*.

- *H. M. Kolbe Co. v. Armigus Textile Co.*, 279 F.2d 555, 555 (2d Cir. 1960) (*per curiam*)

For the reasons stated by Judge Murphy in his opinion below, [184 F. Supp. 423 (S.D.N.Y. 1960),] we conclude that plaintiff has made a *prima facie* showing both of the validity of its copyright and of infringement by the defendants, and hence is entitled to the injunction pending suit granted below. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, [274 F.2d 487 (2d Cir. 1960)].

- *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F.Supp. 334, 336 (S.D.N.Y. 1960)

Recently, there have been numerous cases upholding copyrights in this field which sustain the granting of a preliminary injunction as the proper remedy for the copyright proprietor. [*See, e.g., Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*; *H. M. Kolbe Co., Inc. v. Armigus Textile Co., Inc.*] It has also been held that a dress manufacturer may be enjoined. *Peter Pan Fabrics, Inc.*

*v. Kay Windsor Frocks*, [187 F. Supp. 763 (S.D.N.Y. 1959)]. Plaintiffs are entitled to a preliminary injunction against defendant.

As illustrated by these excerpts, the Second Circuit—followed by other circuits—had unequivocally established by 1960 that fabric patterns—at least, as a general proposition—were copyrightable. Defendants in copyright litigation over fabric patterns thus shifted their focus from the question of categorical copyright-eligibility to issues of originality, substantial similarity, the purported distinction between *ideas* and *expression*, and (non-)compliance with various formalities.<sup>43</sup> Some of these arguments, especially those emphasizing potentially anticompetitive effects of judicial enforcement of fabric-pattern copyrights, would be reflected in case outcomes—which increasingly turned on courts’ discussions of infringement rather than copyright-eligibility, *per se*:

- *Millworth Converting Corp. v. Slifka*, 276 F.2d 443, 445 (2d Cir. 1960) (Friendly, J.)

Defendants do not dispute that the ‘Schiffli’ embroidered design was a ‘work of art,’ 17 U.S.C. 5(h), *Mazer v. Stein*, 1954, 347 U.S. 201, 74 S.Ct. 460, 98 L.Ed. 630. Their principal argument both in the District Court and here was that, despite this, plaintiff’s copyright was invalid since, in contrast with Peter Pan, the embroidered design was in the public domain and, as defendants alleged, plaintiff’s reproduction contained no element of originality. We think [the District Court] correctly held defendants’ attack on the validity of the copyrights to be foreclosed by the principle enunciated in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, [191 F.2d 99 (2d Cir. 1951)<sup>44</sup>], which upheld copyrights on mezzotint reproductions of paintings that were in the public domain . . .

<sup>43</sup> Some of these formalities presented practical challenges in the fabric-pattern context, though the courts gradually relaxed these requirements, both in the fashion-design context and in U.S. copyright law, more generally. See *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970) (noting exceptions recognized to notice requirements, and applying one in favor of lace-designer plaintiff).

<sup>44</sup> In *Alfred Bell*, the Second Circuit set the bar for “originality” very low, in a manner that would impact the treatment of fashion design (favorably) over the next two decades. See *id.* at 105 (“We consider untenable defendants’ suggestion that plaintiff’s mezzotints could not validly be copyrighted because they are reproductions of works in the public domain. Not only does the Act include ‘Reproductions of a work or art’, but—while prohibiting a copyright of ‘the original text of any work . . . in the public domain’—it explicitly provides for the copyrighting of ‘translations, or other versions of works in the public domain.’ The mezzotints were such ‘versions.’ They ‘originated’ with those who make them, and—on the trial judge’s findings well supported by the evidence—amply met the standards imposed



Here plaintiff offered substantial evidence that its creation of a three-dimensional effect, giving something of the impression of embroidery on a flat fabric, required effort and skill . . . .

Plaintiff's case fails not on validity but on infringement . . . . [A]s Judge Learned Hand [has] explained, the 'public demesne' remain[s] important on the issue of infringement since defendants are 'entitled to use, not only all that had gone before, but even the plaintiffs' contribution itself, if they drew from it only the more general patterns; that is, if they kept clear of its 'expression. We think that is what defendants' fabric did. The claimed originality and the distinctive feature of plaintiff's reproduction is the three-dimensional look; this is what defendants' fabric lacks.

- *Clarion Textile Corp. v. Slifka*, 223 F. Supp. 950, 950-51 (S.D.N.Y. 1961)

The color schemes in which plaintiff's design is used are not, so far as appears from this record, copyrighted and plaintiff does not rely on unfair competition as a basis for a preliminary injunction. The basic question then is whether defendants copied plaintiff's design as well as plaintiff's colors.

As I have said, plaintiff's design was undoubtedly the inspiration of defendants'. The only question is whether defendants have gone past the permissible appropriation of an idea and reached the point of the forbidden appropriation of its expression.

I must hold that defendants have not passed the bounds of idea appropriation. The designs are enough alike so that a woman wearing plaintiff's Capri #751 in brown and green would exclaim "There goes my dress" if

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by the Constitution and the statute.") (Internal citations omitted). As discussed in *On 'Originality,' supra* note 38, the period between this decision—rendered operative in the design context by *Mazer v. Stein*—and the mid-1970s represents a period of broad copyrightability. After 1976, however, many courts took their cue on originality not from *Alfred Bell*, but rather from *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 492 (2d Cir. 1976) ("Absent a genuine difference between the underlying work of art and the copy of it for which protection is sought, the public interest in promoting progress in the arts indeed, the constitutional demand . . . could hardly be served. To extend copyrightability to minuscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work. Even in *Mazer v. Stein, supra*, which held that the statutory terms 'works of art' and 'reproduction of works of art' (terms which are clearly broader than the earlier term 'works of the fine arts') permit copyright of quite ordinary mass-produced items, the Court expressly held that the objects to be copyrightable, 'must be original, that is, the author's tangible expression of his ideas.' 347 U.S. at 214 [(1954)]. No such originality, no such expression, no such ideas here appear.").

she saw a woman wearing Slifka Fabrics No. 9074 in the same color scheme. My belief is, however, that there would be no such exclamation if the Slifka Fabrics No. 9074 were in light green and cerise.

As far as the designs are concerned all that can be said about their similarity is that each consists of flowers enclosed in staggered rectangles formed by fine lines.

- *Condotti, Inc. v. Slifka*, 223 F. Supp. 412, 415 (S.D.N.Y. 1963)

Defendants sedulously borrowed each of plaintiff's "ideas". Defendants then proceeded to make substantial deviations from plaintiff's "expression" of those ideas by cross-breeding plaintiff's expressions with those found in the design form-book (Exhibit "A"). As a result, defendants' designs are aesthetic mutations, reflecting major changes and significant alterations that keep clear of plaintiff's "expression".

In view of the preceding finding, the present case is governed by the principle that there is no copyright infringement when *only* the ideas are copied . . . . This is not a case where the copyists infringed the plaintiff's "expression" of its ideas, as in *Peter Pan Fabrics, Inc. v. Acadia Company, supra*; *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F. Supp. 334, 336 (S.D.N.Y. 1960).

- *Manes Fabrics v. Miss Celebrity, Inc.*, 246 F. Supp. 975, 976 (S.D.N.Y. 1965)

The plaintiffs have satisfied all the statutory requirements for copyright registration and consequently their copyright has *prima facie* validity. *H. M. Kolbe Co. v. Armigus Textile Co.*, 184 F. Supp. 423 (S.D.N.Y.), *aff'd* 279 F.2d 555 (2 Cir. 1960); *Peter Pan Fabrics, Inc. v. Acadia Co.*, 173 F. Supp. 292, 299 (S.D.N.Y. 1959), *aff'd* 274 F.2d 487 (2 Cir. 1960). The defendant has attempted to rebut the resulting presumption of the copyrighted design's originality by exhibiting to the court other fabrics featuring floral arrangements set against vertical stripes. However, in view of this court's finding that the defendant's fabric is not a [substantially similar] 'copy' of the plaintiffs', the question of whether the registered design is sufficiently original to warrant copyright protection becomes moot.

The 1960s thus witnessed a newfound judicial tendency to invoke the limiting doctrines mentioned above to bypass the question of copyright eligibility and resolve cases in favor of defendants on the dispositive question of actionable similarity. At the same time, courts' inclinations and ability to turn to such tools varied depending on the perceived character of defendants and/or preexisting relationships between the parties:

- *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969)

[The District Court] denied Concord's motion for a preliminary injunction and vacated the restraining order, finding that the allegedly infringing pattern was not so similar to the copyrighted pattern as to merit an injunction pending completion of the trial. 296 F. Supp. 736. We disagree. The design on both plaintiff's and defendant's fabric consists of a circle within a square within a square, with the dimensions of the circles and squares being identical. The colors are essentially the same, although the defendant's are somewhat brighter and more garish. The designs within the circles, between the squares, and around the outer square, while having some differences, give the same general impression on both samples. While the trial court placed great emphasis on the minor differences between the two patterns, we feel that the very nature of these differences only tends to emphasize the extent to which the defendant has deliberately copied from the plaintiff. For example, the frames around the border on the defendant's sample are similar but run in opposite directions from the plaintiff's figures. The same is true of the figures around the outer part of the circle. In sum, a comparison of the samples strongly suggests that defendant copied plaintiff's basic design, making only minor changes in an effort to avoid the appearance of infringement.

- *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 410, 411 (2d Cir. 1970)

In 1964, plaintiff obtained a copyright on a pansy lace design first embodied in an elastic 'spandex' fiber. The next year, plaintiff secured a second copyright on an adaptation of this design in a rigid nylon fiber. This nylon pattern was purchased in substantial quantities by a single customer, The Warner Brothers Company. Not long after plaintiff began selling lace of this design to Warner, the latter's Purchasing Director suggested to defendant's vice president that it produce a lace 'which would have the look' of plaintiff's design, and gave defendant a sample of plaintiff's lace from which to work . . . .

The case, therefore, is an unusual one. There is no question of access; the fact of copying is now clear . . . .

[However,] Defendant claims that either or both of plaintiff's copyrights are invalid for a number of reasons, principally lack of creativity . . . .

[T]he required creativity for copyright is modest at best. It has been variously described as 'little more than a prohibition of actual copying' or something more than a 'merely trivial' variation, or 'enough' if it be the author's own, 'no matter how poor artistically.' *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951). Plaintiff's pansy [lace] design was created by its own staff. The configuration of the design, including

such details as petals and leaves, required an appreciable amount of creative skill and judgment. Copyright protection for floral design is not unknown. See *H. M. Kolbe Co. v. Armigus Textile Co.*, 279 F.2d 555 (2d Cir. 1960), 315 F.2d 70 (2d Cir. 1963); *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F. Supp. 334 (S.D.N.Y.1960); cf. *Prestige Floral, S.A. v. California Flower Co.*, 201 F. Supp. 287, 291 (S.D.N.Y.1962). While plaintiff's lace design is not what the phrase 'work of art' ordinarily calls to mind, it possesses more than the 'faint trace' of originality required. See *Dan Kasoff, Inc. v. Novelty Jewelry Co.*, 309 F.2d 745, 746 (2d Cir. 1962).

Other decisions appeared to represent idiosyncratic confluences of procedural standards, skepticism toward plaintiffs asserting rights over designs in already established styles, and judicial intuitions about often under-specified "hypothetical" observers:

- *Concord Fabrics, Inc. v. Generation Mills, Inc.*, 328 F. Supp. 1030, 1033 (S.D.N.Y. 1971)

[B]ecause the concept of alternating squares of solids and plaids is shown not to be novel, the court has necessarily mixed into the emulsion of pertinent ideas the burden upon plaintiff in such a case of proving extremely close copying.

Accordingly, in positing our hypothetical lay observer and his role [for purposes of adjudicating the plaintiff's motion for a preliminary injunction], we must assume that he is confronted with the various samples in our present record of Madras plaids alternated with solid squares, this being the general description of plaintiff's, defendant's and other designs in the public domain. With such materials before him, the lay observer would more probably than not reject plaintiff's claim of copying. While the differences between defendant's and plaintiff's designs are small, that is equally true of the differences between plaintiff's and prior designs. Having said that, we conclude that the differences are meaningful ones, and that to the extent that plaintiff's "expression" is separate from the basic "idea" of both designs, the defendant has stayed clear of the copyright.

In defendant's fabric the solid squares of plaintiff's fabric have been divided into two rectangular parts, each differently colored and, to simulate a handsewn patchwork effect, each containing hand-drawn stitches somewhat different in type from plaintiff's. Some squares are divided horizontally, some vertically, so that as one's eye moves from solid area to solid area, the axis of symmetry continually rotates ninety degrees. In addition, the Madras-type squares are different in the two fabrics; defendant's fabric is distinguished by a much greater variation in shades of the same color in individual squares, and by a blotter effect in which sections of color within each square spread out beyond straight-line boundaries. The end result of these differences, particularly in the solid areas of the design, is that defendant's fabric is considerably more lively in appearance.

By the early 1970s, the accumulated case law concerning the availability and enforceability of copyright protection for fabric patterns was far too variable to support a credible claim that this area of law was characterized by any formal, conventional “rules” or “standards.” Some judges acknowledged this to some degree, but sought to bolster the persuasive force of their rulings through other (arguably more problematic) means—for example, by stressing “good eyes and common sense.”<sup>45</sup> The court in *Lauratex Textile Corp. v. Citation Fabrics Corp.*, for example, gave essentially dispositive weight to the judge’s “common sense” on both aesthetics and fairness in finding that the defendant had not infringed plaintiff’s copyright in a work the court described as “well-traveled terrain in design concept.”<sup>46</sup> The court opined that it was only fair that “the same reasoning which supports the validity of plaintiff’s copyright [apply] to defeat the charge of copyright

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<sup>45</sup> See *Couleur Int’l Ltd. v. Opulent Fabrics, Inc.*, 330 F. Supp. 152, 153 (S.D.N.Y. 1971) (“Good eyes and common sense may be as useful [in this area of law] as deep study of reported and unreported cases, which themselves are tied to highly particularized facts.”). Cf. Colman, *supra* note 4, at 31 (on self-professed judicial “hunches” in design-patent case law during same period). See SOPHIA ROSENFELD, *COMMON SENSE: A POLITICAL HISTORY* 244 (2011) (“In the second half of the twentieth century, common sense became, more than ever, a way to sell products and policies . . . . [T]he appeal to common sense . . . constitutes a seemingly unthreatening, nonpartisan, and modern way to push one very particular point of view of commodity at the expense of another. Common sense has, by now, long existed as a fake normative criterion for making choices, whether the subject is soaps or candidates for office.”). For a relatively recent, refreshing judicial expression of skepticism of the analytical value of certain aspects of copyright doctrine in the visual arts context, see *Mannion v. Coors Brewing Co.*, 377 F.Supp.2d 444 (S.D.N.Y. 2005):

[T]here is a difference between the sort of [indeterminacy] difficulty Judge Hand identified in . . . *Peter Pan Fabrics* and . . . the defendants’ argument about ideas in this case. The former difficulty is essentially one of line-drawing, and, as Judge Hand taught, is common to most cases in most areas of the law. The latter difficulty, however, is not simply that it is not always clear where to draw the line; it is that the line itself is meaningless because the conceptual categories it purports to delineate are ill-suited to the subject matter . . . . In the visual arts, the distinction breaks down. For one thing, it is impossible in most cases to speak of the particular ‘idea’ captured, embodied, or conveyed by a work of art because every observer will have a different interpretation. Furthermore, it is not clear that there is any real distinction between the idea in a work of art and its expression. An artist’s idea, among other things, is to depict a particular subject in a particular way . . . . [T]hose elements of a photograph, or indeed, any work of visual art protected by copyright, could just as easily be labeled ‘idea’ as ‘expression.’ *Id.* at 457-59 (internal citations omitted).

<sup>46</sup> 328 F. Supp. 554, 555 (S.D.N.Y. 1971).

infringement,” asserting that “if plaintiff can get a valid copyright by making a few minor variations [from existing material in its genre], then defendant too can [avoid infringement] by making a few more variations on the pattern.”<sup>47</sup> The judge felt that he was ultimately “left with a situation where, as noted by Judge Frankel in [1971,] ‘Good eyes and common sense may be as useful as deep study of reported and unreported cases, which themselves are tied to highly particularized facts.’”<sup>48</sup> So “authorized,” the court disposed of the case.

The presiding judge in *Primcot Fabrics, Dep’t of Prismatic Fabrics, Inc. v. Kleinfab Corp.*,<sup>49</sup> by contrast, found that the “*ad hoc*” nature of fabric-pattern litigation provided enough breathing room for the court to apply its own “common sense” about whether the similarity between the works at issue could plausibly have been a “coincidence”:

No expert has been tendered to apply the mathematical laws of permutations and combinations, but it is sufficiently evident that the similarity of the colors applied to the respective designs, design for design, is more than likely to be no coincidence . . . . The [defendant’s] almost identic imposition of colors, plus the additional common design, [purportedly inspired by] an unidentified ‘salesman’s necktie’ leads to the finding that the copying was of plaintiff’s pattern rather than of the French fabrics.<sup>50</sup>

Here, as in the Second Circuit’s decision in *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, above, the judge’s declared view the defendant was a “bad actor” apparently meant that precedent on “slight variations” did not undermine infringement.<sup>51</sup>

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<sup>47</sup> *Id.* at 555-56.

<sup>48</sup> *Id.* at 556.

<sup>49</sup> 368 F. Supp. 482 (S.D.N.Y. 1974).

<sup>50</sup> *Id.* at 484-85.

<sup>51</sup> *Id.* (“The defendant contends that the plaintiff’s copyright design is a common pattern in the textile trade; that it falls in the category of ‘patchwork merchandise,’ and has been in the public domain from time immemorial. There is no doubt that each of the designs in each square is in the public domain or that the colors used are primary or calico colors which never could be appropriated to exclusive use. Yet the arrangement of the known designs in a pleasing pattern with a particular juxtaposition of colors may be deemed ‘the [reproductions] of a work of art.’ Section 5(h) of the Copyright Act, 17 U.S.C. § 5. In *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2 Cir. 1960), the Court of Appeals held that ornamental designs on cloth were the proper subject of copyright under that section. A design printed on dress fabric is also copyrightable as a ‘print’ under Section 5(k). *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142 (S.D.N.Y. 1959). The copyright protects originality rather than novelty or invention. *Mazer v. Stein*, 347 U.S. 201, 218, 74 S. Ct. 460, 98 L. Ed. 630 (1954). ‘No large measure of novelty is necessary.’

When such “*ad hoc*” district-court decisions went up to the Second Circuit for review, some judges on that court in the mid-1970s tried to bring more systematicity to the doctrine in this area—even as they acknowledged the subjective aspects of fabric-pattern cases. In *Soptra Fabrics Corp. v. Stafford Knitting Mills*,<sup>52</sup> for instance, an unusually elaborate *per curiam* opinion addressed the doctrinal relevance of color variation—even as the court put its own bizarre spin on the “common sense” trope identified above:

This textile design copyright case presents, in addition to a question of validity which goes right to the heart of design copyright in the fabric field, the issue whether the accused design was merely ‘inspired’—to use appellee Stafford’s design studio salesman’s word—by, or was flatly pirated from, appellant Soptra’s attractive, geometric design for use in dresses. District Judge Duffy, relying primarily upon a comparison of black and white photographic reproductions of the designs, found no infringement and did not reach the question of validity . . . .

By looking only to the black and white reproductions, the district judge, we fear, missed the point here also. Certainly the color schemes were not to be entirely overlooked . . . .

But perhaps the error was really the result of a young district judge’s failure to appreciate with the wisdom and experienced eye that only middle age can bring to the subject of feminine wear the substantial similarity we appellate judges discern in appellant’s and appellee’s designs . . . .

On the question of validity Stafford argues that the Soptra copyright is invalid because it represents an exact copy of the uncopyrighted Rampelberg design and thus lacks the requisite originality. Stafford rightly refers us to, *e.g.*, *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951) (mezzotints of old masters’ paintings entitled to copyright), for the proposition that skill and judgment must be employed in the reproduction to entitle it to copyright. But *Peter Pan Fabrics v. Dan River Mills*, 295 F. Supp. 1366 (S.D.N.Y.), *aff’d*, 415 F.2d 1007 ([2d Cir.] 1969) (*per curiam*), states what we consider to be the law of this circuit in terms of textile designs. The embellishment or expansion of the original design ‘in repeat,’ so as to broaden the design and thereby cover a bolt of cloth, together with beginning the pattern in a particular way so as to avoid showing an unsightly joint when the pattern is printed on textiles on a continual basis, constitutes modest but sufficient originality so as to support the copyright. 295 F. Supp. at 1368. The minimal quantum of

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*Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-103 ([2d] Cir. 1951); *Peter Pan Fabrics, Inc. v. Dixon Textile Corporation*, 280 F.2d 800, 802 ([2d] Cir. 1960). I find the creation of the pattern in suit to be sufficiently original to merit copyright either as a reproduction of a work of art or as a print.”)

<sup>52</sup> 490 F.2d 1092 (2d Cir. 1974) (*per curiam*).

originality in the textile pattern field, where the design printed is itself unmistakably original, as here, is not very high. Nevertheless, even if there were no originality, the Rampelberg painting-design could have been filed as a 'work of art' under § 5(g) of the Act, 17 U.S.C. § 5(g). The filing here under § 5(h) as a reproduction of a work of art is at most an 'error in classification' which under § 5 does not 'invalidate or impair the copyright protection secured under this title.' 295 F. Supp. at 1368.<sup>53</sup>

More nuanced still was the thoughtful discussion of the precise role of color in fabric-pattern cases in Judge Mansfield's 1977 concurring and dissenting opinion in *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*:

The majority express doubt as to whether color or color schemes should constitute part of a copyrighted design and remand the case to the district court for further consideration of that issue after briefing by the parties. I believe this is unnecessary. If color did not constitute an integral element of copyrighted design, we have already gotten off on the wrong foot. As already noted, the similarity of colors between the copyrighted Novelty design and the two Joan designs found to infringe was an influential factor. If the copyright extended only to the 253 design in black and white, we should have limited ourselves to a comparison of the alleged infringing designs with Novelty's 253 in black and white, which in my view would lead us, upon duplicating in black and white the courtroom comparison made by us, to hold that the designs were not substantially similar.

Our courtroom comparison, therefore, implicitly recognizes that where (as here) a design is registered in a particular colorway rather than in black and white, that colorway is part of the copyrighted design . . . . Although we have never ruled as a matter of law on the issue, it seems to me that if color is to be taken into consideration for infringement purposes, it must inevitably be considered as an element of the copyrighted subject matter.

In short, what Novelty copyrighted was its plaid design in a brown, beige and white color combination. In this well-plowed field of Argyle and bias plaids, it obviously did not gain protection against the manufacture of all similar textile plaids, even though some might be produced by persons who had access to its copyrighted design. In my view it gained copyright protection for the overall effect or impression created by the particular combination of lines, space, juxtaposition, shading and color scheme. Whether another manufacturer could avoid infringement by changing the color scheme would depend in a particular case on how important the color scheme was in the overall effect or impression of the design. Obviously if the design consisted merely of a simple red square or circle with dots, a change by the copier from red to green would be of great importance. On the other hand, if the design were an intricate or unusual one, as the court noted in [*Soptra Fabrics Corp. v. Stafford Knitting Mills*, 490 F.2d 1092,

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<sup>53</sup> *Id.* at 1092-93, 1094.



1094 (2d Cir. 1974)], a mere change in color would be insufficient to avoid infringement.<sup>54</sup>

To some degree, this judicial thoughtfulness about fabric-pattern litigation mirrors the initially reflective character of the 1976 Copyright Act-based rulings on the “separability” (discussed in a forthcoming installment, *On ‘Useful Articles’*) of components of fashion design whose copyrightability had not yet been adjudicated. In both areas, however, most courts would gradually move from the relatively nuanced, contemplative approach illustrated by the decisions excerpted above to a more mechanical and ultimately design-hostile method of resolving such disputes.

Well into the 1990s, many judicial decisions continued to offer productive aesthetic analysis similar to those characterizing earlier opinions on fabric patterns:

- *Dolori Fabrics, Inc. v. Limited, Inc.*, 662 F. Supp. 1347, 1353 (S.D.N.Y. 1987)

The court finds Dolori’s design to be sufficiently original to support a copyright. We agree with Fixelle’s description of the [‘inspiration’] photograph’s design as ‘very muddled and tonal and dimensional’, while his pattern is ‘flat and clean’ and has an equal positive/negative distribution.

- *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2d Cir. 1991)

Applying [established] principles to the case at hand, access to Pattern # 1365 has been admitted by defendants. Thus, the issues before us are narrowed in the first step of our analysis to considering whether there is substantial similarity between the works, and whether there was independent origination for the work. We have viewed the fabrics bearing each of the designs at issue in this case and, applying the more discerning “ordinary observer” test, conclude there was no copying. Although the roses in both designs are placed against the background in a similar straight line pattern, the roses themselves are not substantially similar. As the district court correctly pointed out, each of the roses in Pattern # 1365 is identical, while the roses in the Baroque Rose pattern differ from each other in their details and nuances. The Baroque Roses appear to be in soft focus and the Folio Rose has a sharper, clearer image. Moreover, though playwrights and poets from William Shakespeare to Gertrude Stein have extolled the beauty of this five-petaled flower, by the rose’s very nature one artist’s rendering of it will closely resemble another artist’s work. For these reasons, we believe that “an average lay observer would [not] recognize the

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<sup>54</sup> 558 F.2d 1090, 1095-96 (2d. Cir. 1977) (Mansfield, J., concurring and dissenting).

alleged copy as having been appropriated from the copyrighted work.” *Novelty Textile Mills v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 (2d Cir. 1977) (quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)).

- ***North Coast Industries v. Jason Maxwell, Inc.***, 972 F.2d 1031, 1034-35 (9th Cir. 1992)

In this case, we are presented with a [fabric] design of rectangular shapes that is similar to but not identical to the St. Laurent design inspired by Mondrian. The district court concluded that the only variations that distinguished design 7114 from the St. Laurent design, were the location of the vertical band and the proportion of the rectangular shapes. In the court’s mind, these variations were “trivial in their impact upon the idea represented by this design,” and thus were not entitled to copyright protection. The district court did not focus on the critical distinction between the idea and expression of the idea that is so fundamental to our copyright law. While the “idea” of using bounded geometric figures in a pattern is clearly one which the plaintiff borrowed, it is by no means clear that the “expressions” of that idea, in the configurations of geometric figures in the St. Laurent’s design and design 7114 (figures A & B), are substantially similar and the differences merely trivial. Mondrian’s own claim to fame comes from his use of such geometric shapes in a uniquely characteristic style. Mondrian “developed a distinctive style of nonobjective painting based on the reduction of pictorial elements to vertical and horizontal lines, using the three primary colours and non-colours. His work has exerted a powerful influence on 20th-century art, including architecture, advertising art, and topography.” 12 *Encyclopaedia Britannica* 343 (15th ed.) (1982).<sup>1</sup> If we were to accept the view that, as a matter of law the differences in the placement of geometric shapes should be regarded as trivial, we would be forced to conclude that Mondrian’s creativity with geometric shapes ended with his first painting, and that he went on to paint the same painting a thousand times. This is not the judgment of art history, and it cannot be the correct judgment of a court as a matter of law. The plaintiff was entitled to have the validity of its copyright determined by a trier-of-fact.

- ***Banff Ltd. v. Limited, Inc.***, 869 F. Supp. 1103, 1104 (S.D.N.Y. 1994)

While both of the sweaters at issue here are of recent creation, the style from which they derived has a storied history. The Aran style of knitting is believed to date back as far as the Middle Ages, when Irish seamen and their families would create clothing that was not only practical, but which also served to identify their background and relationship to their environment. The typical Aran design “consists of a centre panel with two side panels bordered with cable, signifying the ropes or lifelines on which a fisherman’s life might depend.” Hollingworth, *The Complete Book of Traditional Aran Knitting*, at 6. The body of the sweater is made up of a variety

of standard stitches, such as the Basket Stitch (meant to symbolize the fisherman's basket and an abundant catch) and the Cable Stitch (meant to symbolize the fisherman's rope and its attendant virtues of safety and good luck). It is apparent that there are innumerable ways in which these standard stitches may be and have been combined to create a design that is unique while conforming to the traditional Aran style. *Aran Stitches*.

The Banff sweater was designed by one of its employees, Jeffrey Gray. It incorporates a combination of cabled patterns, traditional stitches and crocheted flowers. The defendants make much of the fact that Gray consulted books on Aran stitching and crocheting in arriving at the sweater design, in the hopes of suggesting a lack of originality in Gray's efforts. Banff does not dispute that the elements of its sweater are standard and well-known, but contends that Gray combined them in a unique design. Banff's sweater was sold by a variety of retailers, including Bergdorf Goodman and Bloomingdale's. Defendants sold their sweater at a chain of outlets operated and managed by Express.

- *Prince Group v. MTS Prods.*, 967 F. Supp. 121, 125 (S.D.N.Y. 1997)

The polka dots in this case are more than average circles. First, they are irregularly shaped, and not the perfect circles of a standard polka dot. They are "shaded," that is, there is a crescent of white around half of the perimeter of each of the dots which is different from the standard uniformly colored polka dot, and they consist of several different colors. Thus, the shape and the shading of the dots are sufficiently original to meet the threshold of creativity.

Even if the polka dots on their own are not sufficiently creative to meet the threshold of creativity, "a work may be copyrightable even though it is entirely a compilation of unprotectable elements." *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003-04 (2d Cir. 1996) (citing *Feist*, 499 U.S. 340) (the court ruled that even telephone directory listings can be copyrightable if they are selected, coordinated or arranged in an original fashion). Creativity of arrangement is also low. *Folio Impressions, Inc. v. Byer Ca.*, 937 F.2d 759 (2d Cir. 1991) (the court ruled that decision to place roses in straight lines was sufficiently creative to meet the test); see also *Cranston Print Works Co. v. California Dimensions, Inc.*, 1990 U.S. Dist. LEXIS 3062, 1990 WL 33580 (S.D.N.Y. 1990) (citing *Primcot Fabrics, Dep't of Prismatic Fabrics, Inc. v. Kleinfab Co.*, 368 F. Supp. 482, 484 (S.D.N.Y. 1974)). Here, the decision to place the polka dots in imperfect and conflicting diagonal lines at varying distances from each other giving the appearance of randomness, distinguishes this arrangement from the regularity of the generic creativity for copyright validity. Having met the tests of independent creation and creativity, the Court finds that the Plaintiff's Mega Dot design is valid.

Further, the 1990s saw the courts' formalization of the notion that lace and woven apparel, like sweaters, were presumptively copyrightable alongside fabric patterns:

- *Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484, 489 (S.D.N.Y. 1997)<sup>55</sup>

It is firmly established in the Second Circuit that clothes are not copyrightable . . . . However, fabric designs “are considered ‘writings’ for purposes of copyright law and are accordingly protectible” . . . . Because lace designs are a form of fabric designs, I find that plaintiffs’ lace designs are copyrightable. Pursuant to 17 U.S.C. § 410(c), I further find that plaintiffs’s [*sic*] Certificates of Copyright Registration constitute prima facie evidence demonstrating their valid ownership of the copyrighted lace designs.

- *Imperial Laces v. Westchester Lace*, 95 Civ. 5353, 1998 WL 830630, at \*3 n.5, \*3 (S.D.N.Y. Nov. 30, 1998)

It is undisputed that fabric designs, including lace designs, are copyrightable. *See, e.g., Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484, 489 (S.D.N.Y.1997) . . . .

Based on the facts as stipulated to by the parties, the Court finds that Imperial’s lace design No. 8191 is sufficiently original to warrant copyright protection. The test of originality is “one with a low threshold in that all that is needed . . . is that the ‘author’ contributed something more than a ‘merely trivial’ variation, something recognizably ‘his own.’” *Batlin*, 536 F.2d at 490 (internal quotation marks and citation omitted). In fact, the “vast majority of works [satisfy the originality requirement] quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be.” *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (internal quotation marks and citation omitted).

As lace design No. 8191 is based on lace design No. 5725, similarities between the two designs naturally exist. The use of the heavy liner in lace design No. 8191, however, gives the design a readily discernible reticulated or squiggly appearance that distinguishes it from design No. 5725 in

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<sup>55</sup> For a curious epilogue to this decision, *see* Gary Brown & Assocs. v. Ashdon, Inc., 268 Fed. Appx. 837, 839, 2008 WL 612672, at \*1 (11th Cir. Mar. 7, 2008) (“In 1997, Eve of Milady, an unrelated competitor, brought a copyright infringement suit alleging that Impression had been copying its designs. According to GBA, the Special Magistrate informed Impression that it could continue manufacturing the subject bridal wear if a small modification was made to the patterns of lace. Eve of Milady and Impression ultimately settled the lawsuit.”).

a more than trivial way. Accordingly, the Court holds that Imperial's copyright on lace design No. 8191 is valid.

By contrast, the case law in this area post-dating (roughly) 2000 is largely characterized by hastily reasoned decisions (often disposing of cases brought by so-called "copyright trolls," who found their way into the fashion industry after their predecessors encountered success in bringing "strike suits" in other fields). While a judicial desire to thwart the vexatious litigation of such trolls is potentially beneficial to all legitimate stakeholders, the specific techniques sometimes employed by courts in their decisions disposing of such cases are less commendable. Specifically, the past fifteen years have witnessed a marked rise in opinions on copyright and fabric designs utilizing mechanical, painfully narrow reasoning in essentially one-off dispositions containing little to no substantive analysis of the works in dispute:

- *Segrets, Inc. v. Gillman Knitwear Co.*, 207 F.3d 56, 62 (1st Cir. 2000)

Gillman cannot copy the intricate patterns and juxtapositions of the Blanket Stitch design virtually line-for-line and then escape liability for infringement merely by changing the color and saying this necessarily destroys any substantial similarity. See *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1094 n.6 (2d Cir. 1977), cited in *Concrete Machinery*, 843 F.2d at 610. Color may be a factor, among others, in determining substantial similarity in clothing designs. But that does not assist Gillman's case. Even considering the color variation, there was substantial similarity.

- *Express, LLC v. Forever 21, Inc.*, No. CV 09-4514 ODW-VBKx, 2010 WL 3489308, at \*6-\*7 (C.D. Cal. Sep. 2, 2010)

Express argues that the burden falls on Defendants to prove that the Plaid copyrights are invalid by, for example, producing "identical public domain plaids" because Express registered the Plaids with the Copyright Office and registered copyrights are presumed valid. 17 U.S.C. § 410(c) ("In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate."). However, as Defendants point out, Express failed to disclose in its copyright applications that the Plaids were based on pre-existing designs and, further, has failed to amend its registrations during the course of this litigation. The Court fails to see why it should give presumptive effect to a copyright registration that contradicts the sworn testimony of the purported creator of the copyrighted work. Cf. *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 668 n. 5 (3d Cir. 1990) ("It may be that the correct approach in situations where there has

been a material, but inadvertent omission, is to deprive the plaintiff of the benefits of § 410(c) and to require him to establish the copyrightability of the articles he claims are being infringed.”).

In any event, the Court concludes that, even if Express’s copyright registration [is] entitled to presumptive effect, Defendants have rebutted that presumption . . . .

- *Royal Printex, Inc. v. Unicolors, Inc.*, 91 U.S.P.Q.2D 1439, No. CV 07-05395-VBK, 2009 WL 2712055, at \*3 (C.D. Cal. Jul. 8, 2009)

The daisy design in this case does not possess at least the requisite minimum degree of creativity to qualify as an original design which is copyrightable. In the daisy design, the actual flowers, and their repetition throughout the design, constitute the predominant design elements. Neither the flowers, nor their repetitive placement, were independently created by Unicolors. [Further, the] deletion of the ticking stripe background from the forties flower design, and the insertion of generic polka-dots, does not constitute the requisite originality required for a design to be copyrightable.

At the same time, however, some thoughtful and dedicated judges have continued to wrestle seriously with the difficult questions presented by disputes over the availability and enforceability of copyright protection for fabric patterns and allied works:

- *Express, LLC v. Fetish Group Inc.*, 424 F. Supp. 2d 1211, 1224-25 (C.D. Cal. 2006)

[T]he utilitarian functions of the GH268 Tunic cannot be protected by copyright. However, because the lace and embroidery accents are totally irrelevant to the utilitarian functions of the tunic, those aspects of the GH268 Tunic are copyrightable. Express argues that because the “placement,” “arrangement” and “scalloping” of the lace trim cannot exist separately from the camisole itself, these aspects of the GH268 Tunic cannot be accorded copyright protection. Defendant’s understanding of which elements of clothing can be copyrighted is too narrow. The point is that the placement and arrangement of the lace do not relate to the functionality of the GH268 Tunic. This view is confirmed by the district court in *Eve of Milady v. Impression Bridal, Inc.* (“*Eve of Milady II*”), 986 F. Supp. 158 (S.D.N.Y. 1997), which held that the plaintiff in that case could not only claim a copyright in the actual design of the lace, but could also claim a copyright in “the way that lace is placed and arranged on the dresses.” *Id.* at 161. Thus, the placement, arrangement, and look of the lace trim on the GH268 Tunic are copyrightable. Whether the actual scalloping of the lace trim is copyrightable (Express argues it is not because it is the least wasteful way of cutting the lace trim) is irrelevant—the point is that as a whole

the look of the GH268 Tunic, as separated from its utilitarian elements, is copyrightable.

- *Brighton Collectibles, Inc. v. RK Texas Leather Mfg.*, 10-CV-419-GPC (WVG), 2012 WL 6553403, at \*8 (S.D. Cal. Dec. 13, 2012)

[A] designer who contributes original touches [to public-domain material] is entitled to protect those elements. For example, a jelly fish designer may copyright his work to the extent he adds a distinctive curl to particular tendrils or arranges certain hues in his original design. [*Satava v. Lowry*, 323 F.3d 805, 810-11 (9th Cir. 2003)]. Moreover, the Copyright Act will protect a designer who creatively selects and arranges a sufficient number of unprotectable elements into a new and original combination. *Id.* Recently, the Ninth Circuit applied that exception to a floral fabric design and concluded that the plaintiff's original selection, arrangement, and composition of leaves, stems, flowers, and buds was copyrightable . . . .

Defendants argue that none of Brighton's heart designs are original because they all use hearts, scrolls, roping, and flowers that are common elements in women's fashion accessories. . . . Zapata reports that other elements such as the fleur-de-lis lily, rope twists, dots, angels, scrolls, and flowers have been ubiquitous motifs in jewelry for centuries.

"[T]here are gazillions of ways to combine" flowers, ropes, and scrolls in heart designs [quotation omitted] . . . . As Brighton points out, the heart shape itself is simply a frame, like a rectangle, that a particular artist can fill with his or her own unique, original contributions. A visual inspection of Brighton's copyrighted designs reveals unique combinations, arrangements, and compositions of elements, thus, even though hearts, flowers, ropes, and scrolls are familiar shapes . . . , the Court rejects Defendants' argument that Brighton's heart designs are entitled to only "thin" copyright protection.

In sum, the subject matter of fabric patterns and items treated similarly by courts (including lace designs and some knitwear) has given rise to the single largest number of decisions on the subject of American copyright protection for fashion design. However, the diverse trends noted above, along with other factors contributing to the idiosyncratic outcomes of lawsuits in this area, make broad generalizations difficult—or even dangerous, from the perspective of risk assessment. It remains to be seen whether the Supreme Court will take advantage of the design-related cases on its docket for the upcoming term to bring some semblance of order to this area of law, if only through dicta. If equipped with (long-overdue) meaningful guidance, more judges might successfully navigate between the Scylla of "common sense" and the Charybdis of formalistic avoidance of thorny questions about the availability and enforcement of copyrights for fabric patterns.

*B. Focal images appearing on wearable objects*

Just a few years before the Supreme Court's 1954 ruling in *Mazer v. Stein*, one judge in the Southern District of New York ruled that a plaintiff's copyright in a painting could be infringed via reproduction on a scarf.<sup>56</sup> Yet that decision said nothing about the copyrightability of images first appearing on fabric. In some instances, of course, the application of such an image might simply be a "fabric pattern" in the sense used in the immediately preceding section. To the extent such images are made the visual focal point of apparel through conspicuous placement and/or non-repetition, however, they appear to be perceived and treated as something else by many courts. As new technologies—and the influence of aesthetic trends like Pop Art—have made the use of such images increasingly popular, various courts have been confronted with questions about the availability and enforcement of copyrights in this area.

Where the objects to which such images are affixed were pants, shirts, dresses, and the like, the courts treated them quite favorably in the years immediately following *Mazer*. Indeed, the Supreme Court's rationale in its 1954 decision left little doubt that such images should not be excluded from copyright's embrace merely by virtue of their having been placed on a "utilitarian" object.<sup>57</sup> Difficulties started to arise, however, when designers increasingly seized on this rationale to assert broader rights over simpler figures placed on "utilitarian" objects, especially outside of the garment realm.

The number of cases in this area is far smaller than that in the fabric-pattern context reviewed above, which makes attempts at synthesis both more tempting and potentially less reliable, due to sample-size issues. With that said, three factors in particular seem to have wielded substantial influence on the outcomes of cases over images on apparel: (1) the timing of "image" cases, relative to the vacillations of the phenomenon identified in *On 'Originality'* as the "Originality Pendulum"; (2) the breadth of a given plaintiff's claim—*i.e.*, over a broad "style" or "idea" versus a specific (and

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<sup>56</sup> *Home Art v. Glensder Textile Corp.*, 81 F. Supp. 551, 553 (S.D.N.Y. 1948) ("The validity of the copyright on the reproduction, on which plaintiff relies, is established prima facie by the Certificate of Copyright issued to plaintiff, and the allegation of the moving affidavit that the picture on the scarf is a copy of the copyrighted reproduction stands undenied . . . . [Plaintiff's motion] for summary judgment is granted and damages to the plaintiff, if any, are to be fixed and determined.").

<sup>57</sup> *Mazer*, 347 U.S. at 212–13.



unique or “commonplace”) image; and (3) the perceived complexity and overlap of the image(s) at issue in a specific case.

There is no doubt that in many instances, courts have found (or simply assumed) images superimposed on fashion-related items to be copyrightable—and gone on to enforce the relevant copyrights. In *Cofre, Inc. v. Lollytogs, Ltd.*, for example, a district court judge in 1992 held that despite seemingly commonplace nature of car-racing imagery on children’s wear, there could be no doubt about the outcome as to either copyrightability or infringement thereof:

[E]ven the common use of a racing car motif can have an infinite variety of renderings. Defendant has chosen to use the same three symbols of racing as plaintiff used . . . . There must be innumerable positions in which one can depict a racing car, flag and light on the front of a garment. That defendant has placed the items just as plaintiff had placed them contradicts defendant’s contention that its garment is of a different artistic expression and makes the two the same in total concept and feel. It is, indeed, the very expression of these racing symbols that defendant appears to have copied from plaintiff.<sup>58</sup>

Indeed, courts have sometimes applied the general rule that images superimposed on fashion items are presumptively copyrightable even in areas at some remove from the traditional fabric-pattern case. In *Swatch v. Siu Wong Wholesale*, for example, a district court granted partial provisional relief to Swatch based on its two-dimensional “artwork applied to [a] wrist-watch.”<sup>59</sup> Courts have sometimes granted similar relief to creators of two-dimensional images on footwear.<sup>60</sup> And at least one court has also recognized as copyrightable the opposite—*i.e.*, placement of three-dimensional embellishments on a “flat” object.<sup>61</sup>

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<sup>58</sup> No. 88 Civ. 9130(SWK), 1991 WL 40366, \*3 (S.D.N.Y. Mar. 15, 1992).

<sup>59</sup> 92 Civ. 3653(PKL), 1992 WL 142745, at \*9 (S.D.N.Y. Jun. 8, 1992).

<sup>60</sup> See, e.g., *GMA Associates, Inc. v. Olivia Miller, Inc.*, No. 03 Civ.4906(MBM), 2004 WL 1277997, at \*1 (S.D.N.Y. Jun. 8, 2004), *aff’d sub nom.* *GMA Accessories, Inc. v. Olivia Miller, Inc.*, 139 F. App’x 301 (2d Cir. 2005) (“This case concerns defendant’s infringement of plaintiff’s copyrighted pattern, ‘Hawaiian Punch,’ imprinted on light-weight slippers worn in these climes principally during the summer, called ‘flip-flops.’ Plaintiff GMA Accessories, Inc., which sells these items, sued defendant, Olivia Miller, Inc., which distributes clothing and accessories and contracted for the manufacture of the offending flip-flops in China for resale to one of its customers. Infringement was conceded, and the one remaining issue in the case concerns the award of costs and attorney fees after a trial on damages.”).

<sup>61</sup> See *Magical Mile, Inc. v. Benowitz*, 510 F.Supp.2d 1085, 1088-89 (S.D. Fla. 2007).

Yet, as with fabric patterns, courts have scrutinized claims of “image” copyrights with greater vigilance over time, especially where the imagery in question has been on the simpler end of the design spectrum and/or where a plaintiff has appeared to be seeking exclusive rights over a “theme” or “idea” rather than a specific image. Such judicial skepticism has sometimes taken the form of cautionary notes in appellate-court decisions concerning works displaying “commonplace” and/or “nature-inspired” imagery:<sup>62</sup>

- *Samara Bros. v. Wal-Mart Stores*, 165 F.3d 120, 132 (2d. Cir. 1998), *abrogated on other grounds*, 529 U.S. 205 (2000)

Each of the challenged copyrights is registered with the U.S. Register of Copyrights. A certificate of registration “constitutes *prima facie* evidence of the validity of a copyright, 17 U.S.C. § 410(c), though that presumption may be rebutted.” *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 763 (2d Cir.1991). We review “the trial court’s determination of originality under a clearly erroneous standard.” *Id.*

In *Folio Impressions* this Court awarded protection to a design of a series of roses, a common shape, placed in straight lines on an ornate background and turned so that the roses faced in various directions. We first recognized protection for the rose design itself separate from its arrangement on the background. Although the rose is a common shape, we noted that because there was a valid registration, the rose had a “presumption of validity” and the defendants “offered no proof at trial to overcome this presumption.” *Id.* We must find the Samara designs similarly original. Their registrations provide a presumption of validity which Wal-Mart has failed to overcome. Wal-Mart provided no evidence at trial challenging the validity of the copyright registrations. Specifically, it failed to adduce evidence to show that the works were not “independently created by its author, and not copied from someone else’s work.” *Id.* at 764.

We do note that copyrights depicting familiar objects, such as the hearts, daisies and strawberries in Samara’s copyrights, are entitled to very narrow protection. See *Folio Impressions*, 937 F.2d at 765. It is only the virtually identical copying, such as the copying in this case, which will result in a successful claim of infringement of familiar objects.

In other disputes over the availability and/or enforceability of copyright in images placed on wearable objects, courts have effectively narrowed

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<sup>62</sup> See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1008-09 (2d Cir. 1995) (upholding copyright protection for puffy leaf appliqués on sweaters and reversing district court’s finding of trade dress protection in same; defendant had infringed the plaintiff’s copyrighted designs through placement of images of leaves and squirrels on its own line of sweaters).

or denied copyright protection—in a manner reminiscent of the so-called “thin copyright” doctrine, discussed in *On ‘Originality’*—by invoking the idea/expression distinction in conjunction with “similarity” analyses:<sup>63</sup>

- *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 553-54 (S.D.N.Y. 2003)

[Under U.S. copyright doctrine,] only the particularized expression of the dragon is protectable, not the idea of the dragon itself or even the idea of putting a dragon on pants.

No reasonable factfinder could conclude that the dragons at issue are substantially similar in the relevant respect because virtually all of the similarity is attributable to the fact that the images are all dragons. *See Mattel, Inc. v. Azrak-Hamway Int'l. Inc.*, 724 F.2d 357, 360 (2d. Cir 1983) (“Though the dolls’ bodies are very similar, nearly all of the similarity can be attributed to the fact that both are artist’s renderings of the same unprotectable idea — a superhuman muscleman crouching in what since Neanderthal times has been a traditional fighting pose.”). Most notably, Maharishi’s dragon is camouflage, and Abercrombie’s is yellow and scaly. The body of Maharishi’s dragon is oriented down the pant leg, with the head below, while Abercrombie’s dragon is oriented up the pant leg, with the head above. The Maharishi dragon has four legs; the Abercrombie dragon has only two. The “dragon” image on the Shi Dings hang tag looks more like some type of cat-human-lizard hybrid and is so obviously different from Maharishi’s dragon as to not warrant more discussion.

Maharishi directs the Court’s attention to *Knitwaves*, in which the Second Circuit, after noting a list of differences between the sweater patterns at issue, stated: “These differences in detail, while requiring considerable ink to describe, do little to lessen a viewer’s overwhelming impression that the two Lollytogs sweaters are appropriations of the *Knitwaves* sweaters.” 71 F.3d at 1004. Maharishi emphasizes that merely being able to list differences in the image should not suffice, especially on a motion for summary judgment . . . .

Here, the overwhelming impression is of dissimilarity, and the Court cannot imagine that the dragon images (as distinguished from the mere idea of putting a dragon on pants) came from the same creative source. The

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<sup>63</sup> For a discussion of “thin copyright” in the fashion-design context, see *On ‘Originality,’* supra note 38, at 334-337 (observing that courts have sometimes narrowed scope of protection for ostensibly protected works in ruling that only “thin copyright” protection is warranted). For an inchoate version of the more sophisticated judicial analysis in the *Maharishi* case, see *Fashion Victim, Ltd. v. Sunrise Turquoise, Inc.*, 785 F. Supp. 1302, 1307 (N.D. Ill. 1992) (acknowledging copyrightability of images on t-shirts depicting skeletons engaged in sexual acts, but rejecting possibility of infringement on basis of idea-expression distinction).

Court's noted differences are merely illustrative of a factual finding which is difficult to explain beyond saying that the dragons are obviously and substantially dissimilar.

On rare occasions, courts have disposed of copyright claims over imagery on fashion-related items by declaring, in essence, that copyright is the wrong vehicle for the assertion of a plaintiff's rights:

- *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 257, 269-70 (4th Cir. 2007)

In 2002, LVM adopted a brightly-colored version of the Monogram Canvas mark in which the LV mark and the designs were of various colors and the background was white (the "Multicolor design"), created in collaboration with Japanese artist Takashi Murakami. For the Multicolor design, LVM obtained a copyright in 2004. In 2005, LVM adopted another design consisting of a canvas with repetitions of the LV mark and smiling cherries on a brown background (the "Cherry design") . . . .

Finally, LVM argues that the district court erred in finding that Haute Diggity Dog's use of the "CV" and the back-ground design was a fair use of LVM's copyrighted Multicolor design. Because LVM attempts to use a copyright claim to pursue what is at its core a trademark and trade dress infringement claim, application of the fair-use factors under the Copyright Act to these facts is awkward. *See* 17 U.S.C. § 107; *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994). Nonetheless, after examining the record, we agree with the district court that Haute Diggity Dog's use as a parody of certain altered elements of LVM's Multicolor design does not support a claim for copyright infringement.<sup>64</sup>

Subject to these important caveats, the copyrightability of images placed on the surfaces of fashion apparel and accessories is a settled question—at least "on paper." As with fabric patterns, the outcomes of real-life cases can be difficult to predict, even in conventional contexts like textile-based imagery. Idiosyncrasies in judicial applications of copyright law to fashion-related works are (as should be increasingly evident from this series of articles) largely unavoidable and rarely systematic.<sup>65</sup>

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<sup>64</sup> *See also* *Omega S.A. v. Costco Wholesale Corp.*, 776 F.3d 692, 700 (9th Cir. 2015) (Wardlaw, J., concurring in the judgment) ("The district court correctly held that Omega misused its copyright 'by leveraging its limited monopoly in being able to control the importation of [an image carved on the back of watch faces] to control the importation of its Seamaster watches.'").

<sup>65</sup> This observation applies with even greater force to media raising arguably unique public-policy concerns and/or complex issues of ownership. *See, e.g.*, Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 22 J. INTELL. PROP. L. 29,

### C. Works of jewelry design

As discussed above, jewelry designers were among the first to test the applicability of *Mazer v. Stein* to their works, in cases like *Trifari, Krussman & Fisbel Inc. v. Charel Co.*<sup>66</sup> The plaintiff's victory in that 1955 case, bolstered by the Second Circuit's plaintiff-friendly decision in *Boucher v. Du Boyes* three years later,<sup>67</sup> established the presumptive copyrightability of works of jewelry.<sup>68</sup> Despite occasional disputes over the adequacy of copyright notices that designers had placed on their works—resolved in keeping with a general judicial trend of relaxed formalities—the legal landscape was generally sunny for those wishing to register and enforce copyrights in jewelry designs through the late 1950s and 1960s.<sup>69</sup>

That picture changed somewhat in the early 1970s. A new trend in judicial application of copyright protection to works of jewelry design is reflected in the contrast between a 1970 decision, *Herbert Rosenthal Jewelry*

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70 (2014) (“A tattoo is often developed in collaboration between the tattoo artist and the person seeking to purchase a tattoo. In many cases, the tattoo copyright will be owned by the tattoo artist. However, the fluidity and informality of the tattoo creation process generates ambiguities regarding ownership in some circumstances . . . [Further, e]nforcement of tattoo copyrights will be difficult. The artists’ choice of medium will result in diminution of the exclusive rights of the copyright owners. Tattoo artists should understand the need to relinquish some control over their inked creations, and they already seem generally accepting of uses of their works by tattoo bearers.”).

<sup>66</sup> 134 F. Supp. 551, 553 (S.D.N.Y. 1955).

<sup>67</sup> 253 F.2d 948 (2d Cir. 1958) (*per curiam*) (holding copyright valid even though the notice appeared on only one of two earrings which might have been worn separately as a dress ornament or clip), *cert. denied*, 357 U.S. 936 (1958).

<sup>68</sup> *Trifari*, 134 F. Supp. at 553 (“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. There is neither basis in the Copyright Act nor judicial precedent for excluding . . . jewelry from works of art to which copyright protection may attach. Simply because it is a commonplace fashion accessory, not an expression of ‘pure’ or ‘fine’ art does not preclude a finding that plaintiff’s copyrighted article is a ‘work of art’ within the meaning and intent of the Act.”).

<sup>69</sup> *Cf.*, e.g., *Dan Kasoff, Inc. v. Novelty Jewelry Co.*, 309 F.2d 745, 746 (2d Cir. 1962) (*per curiam*) (“Although it might be thought that the invocation of the power of government to protect designs against infringement implied some merit other than a faint trace of ‘originality’, it is now settled beyond question that practically anything novel can be copyrighted. *Mazer v. Stein*, 347 U.S. 201 (1954); *Rushton v. Vitale*, 218 F.2d 434 (2d Cir. 1955). ‘No matter how poor artistically the ‘author’s’ addition, it is enough if it be his own’. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951).”). As illustrated in Colman, *supra* note 4, hostile rhetoric can be a precursor to adverse doctrine.

*Corp. v. Grossbardt*, in which the Second Circuit upheld an injunction against a defendant who had produced a substantially similar version of Plaintiff's bejeweled turtle pin<sup>70</sup> and the court's 1974 decision in *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., Inc.*, which essentially questioned whether the nature of the pin made copyright enforcement inappropriate:

The threshold question is what characteristics of appellant's design have gained copyright protection. Since all turtles are created more or less along the same lines, appellant cannot, by obtaining a copyright upon one design of a turtle pin, exclude all others from manufacturing gold turtle pins on the ground that they are substantially similar in appearance. Clearly, a copyright does not offer protection of such breadth.<sup>71</sup>

What had changed in the interim? Doctrinally speaking,<sup>72</sup> the Ninth Circuit had recently disposed of a case, *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, brought by the same jewelry-designer plaintiff, reasoning that the preservation of robust competition in the marketplace, related public policies embodied in the "idea-expression" distinction, and prudent application of the "substantial similarity" test for infringement precluded a ruling for the jewelry-designer plaintiff.<sup>73</sup> The Ninth Circuit had reasoned:

What is basically at stake is the extent of the copyright owner's monopoly—from how large an area of activity did Congress intend to allow the copyright owner to exclude others? We think the production of jeweled bee pins is a larger private preserve than Congress intended to be set aside in the public market without a patent. A jeweled bee pin is therefore an 'idea' that defendants were free to copy."<sup>74</sup>

While mid-1970s decisions considering the application of the idea-expression distinction to jewelry designs were not unanimous,<sup>75</sup> it was clear

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<sup>70</sup> 428 F.2d 551 (2d Cir. 1970).

<sup>71</sup> 509 F.2d 64, 65 (2d Cir. 1974) (*per curiam*).

<sup>72</sup> As noted previously, I have postponed a detailed examination of the broader cultural landscape to the final article of this series, *The Politics of 'Piracy.'* As I will discuss in that installment, the 1970s witnessed, alongside important economic, political, and cultural developments, a growing discussion of the appropriate uses of different types of intellectual property rights—often in connection with the decade-long process culminating in the Copyright Act of 1976.

<sup>73</sup> See 446 F.2d 738, 742 (9th Cir. 1971).

<sup>74</sup> *Id.*

<sup>75</sup> See, e.g., *Cynthia Designs, Inc. v. Robert Zentall, Inc.*, 416 F. Supp. 510, 512 (S.D.N.Y. 1976) (holding that the designer's products were copyrightable, idea-expression distinction notwithstanding, because the renditions of a T-shirt as articles of jewelry required the exercise of artistic craftsmanship, and the T-shirts contained distinguishable variations from ordinary T-shirts in the public domain).

by the end of the decade that the doctrine would sometimes represent a serious obstacle to the recognition and/or enforcement of jewelry-related copyrights. One judge in the Eastern District of Pennsylvania explained the coalescing picture in 1977, noting that courts had found that “the idea and its expression” in certain jewelry works were “virtually indistinguishable” and thus “held that the copyright did not confer a monopoly of the ‘idea’ and did not grant protection from the manufacture and sale by others of such jewelry.”<sup>76</sup>

With the new teeth that many judges gave to such limiting principles, courts in the decades to come would apply a variety of (sometimes) surprising tests to determine the copyrightability and/or infringement of jewelry designs. In one especially notable 2005 district court decision, *Todd v. Mont. Silversmiths Inc.*, the presiding judge denied copyright protection altogether to the creator of bracelets and earrings made in the style of barbed-wire.<sup>77</sup> The presiding judge reasoned that despite the presumptive copyrightability of works of jewelry designs, the plaintiff’s “arrangement [of these works was] visually but not conceptually distinguishable from barbed-wire.”<sup>78</sup> Further, because barbed-wire had long been in what the court described as “the public domain,” the court ruled that the works were “not truly ‘original’ in the ordinary meaning of the word.”<sup>79</sup>

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<sup>76</sup> *Russell v. Trimfit, Inc.*, 428 F. Supp. 91, 94 (E.D. Pa. 1977) (citing *Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971); *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., Inc.*, 509 F.2d 64 (2d Cir. 1974); and *PPS, Inc. v. Jewelry Sales Representatives, Inc.*, 392 F. Supp. 375 (S.D.N.Y. 1975)).

<sup>77</sup> 379 F. Supp. 2d 1110, 1111 (D. Colo. 2005).

<sup>78</sup> *Id.* at 1114.

<sup>79</sup> *Id.* It warrants mention that, as discussed at length in *On ‘Originality,’ supra* note 38, courts have rarely interpreted the term “original” in the copyright context by looking at the *Todd* court’s so-called “ordinary meaning of the word.” *Cf. Medallie Art Co. Ltd. v. Washington Mint, LLC*, No. 99-9064, 2000 WL 298253, at \*2 (2d Cir. Mar. 21, 2000) (“Based on our independent comparison of the products at issue and the U.S. Treasury notes and coins on which they are based, we cannot say that the District Court’s finding of sufficient originality with respect to the thirteen U.S. Treasury note replicas was clearly erroneous. Although Medallie conceded to replicate the U.S. Treasury notes as accurately as possible, the task of translating the two-dimensional paper notes into three-dimensional silver forms involved ‘at least that minimal level of creativity necessary to entitle them to copyright protection as derivative works’ . . . . For example, in making each note replica, Medallie made choices about how to translate color contrasts into a silver medium, how to represent the intricate background detail of U.S. Treasury notes, whether certain features should be dull silver or highly polished silver, and whether certain features should be engraved or set off in bas relief. These differences are ‘not merely . . . trivial variation[s] such as might occur in the translation to a different medium.’ *Batlin*, 536 F.2d at 491.”).

The *Todd* case is an extreme example of the types of risks jewelry designers sometimes face when seeking to enforce their copyrights; as always, counterexamples are readily available. Judges have affirmed the validity and enforceability of copyrights in varied jewelry (and even in decorative eyewear<sup>80</sup>), particularly where the party advocating for protection and enforcement had successfully registered the work with the Copyright Office. Not unrelatedly, designers have been more successful when associated with a well-funded company that has bought itself a reputation for high-end jewelry with accompanying “artistic” allure:

- *Yurman Design, Inc. v. Golden Treasure Imps., Inc.*, 275 F. Supp. 2d 506, 509, 519 (S.D.N.Y. 2003)

The plaintiffs have several signature jewelry collections, many of which incorporate the cable design, along with other elements. (Fourth Am. Compl. PP 9-10; see, e.g., Fourth Am. Compl. P 15 (noting that the ‘Channel Collection’ ‘has as a common theme yellow gold collars with colorful semi-precious stones placed on twisted sterling silver cable. The collars are composed of single bands of yellow gold on either side of square cut semi-precious colorful stones. The collars complete a circle around the sterling silver twisted cable that are then shaped into bracelets, necklaces, rings, and earrings.’ . . . The plaintiffs’ motion for partial summary judgment on the validity of certain copyrighted designs is granted.

- *Yurman Studio v. Castaneda*, 591 F. Supp. 2d 471, 495 (S.D.N.Y. 2008) (modified on a motion for reconsideration, examined in footnote 84, *infra*)

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<sup>80</sup> The Second Circuit in 2001 assumed copyrightability in determining the proper measure of damages for infringement of a copyright in a plaintiff’s “eye jewelry,” consisting of “sculptured metallic ornamental wearable art” containing “perforated metallic discs or plates in the place that would be occupied by the lenses of a pair of eyeglasses.” *Davis v. Gap Inc.*, 246 F.3d 152, 156 (2d Cir. 2001) (Leval, J.). For a Customs-related “Section 337” proceeding in which only trade-dress rights in arguably similar materials were adjudicated, see *In re Certain Novelty Glasses*, 208 U.S.P.Q. 830, No. 337-TA-55, 1979 WL 61009, at \*5 (ITC Jul. 1979) (“The physical exhibits of complainants’ and respondents’ glasses reveal the striking similarities between the nonfunctional design features of the glasses themselves and their packaging. The glasses from both sources are nearly identical in their nonfunctional design aspects, e.g., style of lettering, size, similar colors, and novelty features such as the games and the rocks. Additionally, the packaging of products from both sources utilizes black backgrounds with photographic reproductions of the enclosed glasses. The effect of viewing the two products, even when side by side, is to create a general impression that the products are identical. We find it likely that a reasonable consumer under ordinary circumstances would be confused as to the source of the two products.”).



Scholars disagree, and the Second Circuit has not decided, as to whether a defendant challenging the originality of a plaintiff's copyrighted work must provide evidence of actual copying [from material in the public domain], of [sic] if copying may be inferred through plaintiff's access to designs in the public domain and the substantial similarity of the works to those designs. At the summary judgment stage, drawing all inferences in favor of the non-moving party, Yurman's access to these historical jewelry designs in the public domain must be inferred.

Because defendants' submissions raise fact issues regarding the originality of the two designs, summary judgment is denied on defendants' counterclaim as to the Albion collection bracelet and the Linked Renaissance single chain jewelry. However, with respect to all other Yurman copyrighted designs, after careful review of the images of preexisting jewelry produced by defendants, I conclude that Yurman's designs are sufficiently original as a matter of law and Yurman is entitled to summary judgment on the claims for cancellation of those designs.

- *Van Cleef & Arpels Logistics, S.A. v. Landau Jewelry*, 547 F. Supp. 2d 356, 364 (S.D.N.Y. 2009)

[T]here is nothing in the record to support defendants' contention that the copyright is not valid because the Design was copied from the public domain. Defendants have provided photographs of, *inter alia*, the 88th Division's clover insignia in varied incarnations, edifices utilizing the clover shape in their architectural design, and possibly infringing jewelry pieces from other companies. However, the clover shapes pictured in defendants' photographs are readily distinguishable from the Design, and they do not feature the combination of elements over which plaintiffs claim copyright protection. Moreover, the fact that distinguishable clover shapes exist does not constitute evidence that plaintiffs' Design was copied from the public domain. In the absence of any evidence linking the creation of plaintiffs' Design to the public domain, defendants' argument is untenable . . . . Because defendants have not offered evidence to raise a disputed issue as to a material fact and because the undisputed evidence supports plaintiffs' version of the facts, I hold that plaintiffs own a valid copyright in the Design as a matter of law.

Somewhat perversely, courts appear to be consistently more "vigilant" of adverse effects on industry competition where jewelry-designer plaintiffs are smaller and/or less well-known entities. One might even argue that the weight many courts accord the "presumption of validity" supposedly accompanying registered copyrights (where registered within five years of publication) varies proportionally with the profile and/or prestige of the enforcing party. Discussions in the following vein appear far less common in judicial decisions favoring the "major players" of jewelry design:

Significantly, the Plaintiff claims it is not seeking a monopoly over the idea of bird's nest jewelry. There are other variations of bird's nest jewelry sold by others, but the Plaintiff is only claiming infringement on the Defendant's allegedly identical pendant . . . . To be sure, the Plaintiff's creation strikes one as a generic bird's nest. But in nature, birds' nests can be deeper, wider, or narrower . . . . The nature of the work distinguishes it from the cases relied upon by the Defendant. In *Todd*, the barbed-wire jewelry was not original because it was not recast or arranged in an original way but instead stuck with the 'elemental arrangement' of barbed wire . . . . Here, the Plaintiff arranged the nest in the slightly atypical way described above. Further, in *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., Inc.*, 509 F.2d 64, 65-66 (2d Cir. 1974), the Second Circuit found no originality in a bejeweled-backed turtle in part because there are only a certain number of vertebrae segments on a turtle. *Id.* There are no such natural limitations here—a natural nest could have any number of eggs depending on the species . . . . Thus, the Plaintiff's original expression of a bird's nest is copyrightable.<sup>81</sup>

While such judicial efforts to preserve marketplace competition through their rulings in copyright litigation are not entirely misguided,<sup>82</sup> they do have a decidedly hollow (and even suspect) ring given (1) the courts' disproportionate invocation of pro-competition considerations against smaller and/or lower-end designers in copyright litigation (as reflected in, *inter alia*, various decisions excerpted above); (2) the fractured *manner* in which these considerations find their way into the courts' adjudication of copyright disputes over works of fashion design;<sup>83</sup> and (3) the same courts'

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<sup>81</sup> *Metal Morphosis, Inc. v. Acorn Media Publ., Inc.*, 639 F. Supp. 2d 1367, 1374-75 (N.D. Ga. 2009).

<sup>82</sup> For a critical discussion of certain high-profile fashion companies' use, facilitated by strategic manipulation of IP regimes by sophisticated attorneys, of anticompetitive trade-dress registrations over basic (presumably copyright-ineligible) components of design, see Charles E. Colman, *The TTAB's Dangerous Dismissal of 'Doubt,'* HARV. J. L. & TECH. DIG., Nov. 12, 2013.

<sup>83</sup> Judge Victor Marrero of the Southern District of New York noted in a 2009 decision: "While courts are not in agreement as to which test is appropriate for jewelry designs . . . , the Court is persuaded that the 'ordinary observer' test is the proper vehicle for determining whether the Gate B9 pieces are substantially similar to the Stella Pieces." *R.F.M.A.S., Inc. v. Mimi So*, 619 F. Supp. 2d 39, 64-65 (S.D.N.Y. 2009). Judge Marrero's acknowledgment of a lack of uniformity and certainty on issues of IP of direct relevant to fashion design is warranted and deeply admirable, as is his consistently thoughtful and even-handed treatment of competition-related considerations in fashion-related intellectual-property litigation. See, e.g., *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F.Supp.2d 535, 543 n.4 (S.D.N.Y. 2003) ("As explained more fully [below], the definition of functionality [in trade-dress law] is not as clear as the Supreme Court's statement might indicate."); *Christian Louboutin S.A. v. Yves Saint Laurent America Hold-*

resolution of dispositive questions in trade-dress and design-patent litigation in a manner disproportionately favorable to “high-end” jewelry designers<sup>84</sup> and unfavorable—if not fatal—to countless smaller, typically less

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ings, Inc., 778 F.Supp.2d 445 (S.D.N.Y. 2011) (Marrero, J.) (applying trademark law’s “aesthetic functionality” doctrine to preclude enforcement of essentially exclusive rights in bright-red soles on high heels—a design feature ineligible for copyright or design-patent protection by time plaintiff obtained its trade-dress registration in 2008). The decision overruling Judge Marrero’s ruling in *Louboutin* is another disturbing example of the outcome-driven, *sub rosa* fact finding of the Second Circuit that has characterized its “jurisprudence” on IP protection for fashion design in recent years. Notwithstanding Judge Marrero’s many positive attributes, it warrants mention that his statement in *R.F.M.A.S.* substantially understates the level of variability in the case law. Judges purporting to apply the default “substantial similarity” test have differed dramatically not only in their *selection* of the “appropriate” test for jewelry designs, but also in their application of those tests and their implementation of the considerations prompting the adoption of “alternative” tests into another of the many other determinations made in the course of copyright litigation. As discussed in the previous installment of this series, the “originality” determination has often been one such “alternative implementation” site. See generally *On ‘Originality,’ supra* note 38.

<sup>84</sup> Consider, for example, the near-clean sweep Judge Shira Scheindlin handed to high-end jewelers David Yurman, Gucci, and Cartier in *Yurman Studio, Inc. v. Castaneda*, 591 F.Supp.2d 471, 497 (S.D.N.Y. 2008) (granting summary judgment in favor of luxury jewelry designers on copyright, trade dress, and design patent claims). Judge Scheindlin’s decision illustrates that court rulings adversely affecting the availability and/or enforceability of copyright protection for jewelry design will likely have little meaningful impact on well-funded entities with a variety of other “rights enforcement” tools at their disposal—the redundancy of which only compounds the benefits these large (but often less innovative) design companies derive from elite counsel and the “instant credibility” of both the entities and their attorneys enjoy in the eyes of many judges. This point is underscored in the astonishing follow-up decision to *Castaneda*, in which even the few points on Yurman’s copyright claims initially resolved in favor of Yurman’s adversary were reversed by Judge Scheindlin on a request for reconsideration. See Nos. 07 Civ. 1241(SAS), 07 Civ. 7862(SAS), 2008 WL 4298582 (S.D.N.Y. Sep. 19, 2008). But perhaps worse than any of these reverse-Robin Hood maneuvers by the court is Judge Scheindlin’s disparaging, “defendant has missed the point”-type rhetoric directed at Yurman’s adversary in her initial decision (an opinion ironically pre-dating her own “correction” in her rare partial grant of Yurman’s motion for reconsideration, submitted by the same elite law firm that persuaded another decision maker to back down from a conflict with another well-funded, high-profile fashion house, discussed in Colman, *supra* note 82). Such judicial accusations of a party and/or its attorney having “missed the point” seem to be aimed primarily at bolstering the court’s credibility at the expense of a party/attorney who, in the realm of copyright protection for fashion design, in particular, has only “missed the point” in extracting a different principle from the unusually incoherent and unprincipled body of case law that is the focus of this series of articles. Cf. STANLEY FISH, THERE’S NO SUCH THING AS

financially robust designers (for whom copyright litigation is often the sole cost-effective means of formalizing and asserting rights).

D. *Certain components of costume designs*

While one might argue that all apparel is, in essence, *costume*, the courts have generally not taken this expansive view. A narrower definition of “costumes,” either tacit or explicit, has both facilitated and constrained the application of *Mazer v. Stein* to a number of wearable objects beyond the fabric patterns, focal images, and jewelry works discussed above. As with that subject matter, the copyrightability of certain costume-related material has been adjudicated through the lens of *Mazer v. Stein* and its progeny—even as courts presiding over more recent costume disputes have largely pivoted to the 17 U.S.C. § 101 “useful articles”/“conceptual separability” framework(s) examined in the next installment of this series.

Costume knockoff litigation is surprisingly common,<sup>85</sup> resulting in a fairly ample body of case law purporting to interpret fashion-related precedent.<sup>86</sup> Indeed, almost immediately after the presumptive copyrightability of jewelry designs and fabric patterns was recognized in the 1950s, that case law was in turn invoked in “novelty item” cases,<sup>87</sup> which would soon blur with “human figure” and “wearable costume” cases—often linked through

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FREE SPEECH 145 (1994) (“The act of construction for which [a judge] says there is no room [for legal minds to reasonably reach different conclusions] is one he is continually performing. Moreover, he performs it in a way no different from the [attorney’s] performance he castigates.”).

<sup>85</sup> See *Funrise Canada (HK) Ltd. v. Zauder Bros., Inc.*, 99-CV-1519(ARR), 1999 WL 1021810, at \*4 (E.D.N.Y. Jul. 8, 1999) (“According to [the declaration of named defendant Brian] Blatherwick, Funrise, like other companies in the Halloween product business, routinely engages in ‘parallel development,’ copying other companies’ successful products and modifying them to lower production expenses. . . . Blatherwick contends that modifications made to competitors’ products are ‘rarely large.’”).

<sup>86</sup> See, e.g., *Beaudin v. Ben and Jerry’s Homemade, Inc.*, 95 F.3d 1, 2 (2d Cir. 1996).

<sup>87</sup> See, e.g., *Royalty Designs, Inc. v. Thrifticheck Service Corp.*, 204 F.Supp. 702, 704 (S.D.N.Y. 1962) (“[I]f the notice of copyright on the metal disc at the bottom of [plaintiff Royalty’s ‘Boxer and Cocker Spaniel dog toy banks’] is properly affixed Royalty is entitled to a preliminary injunction . . . . The method of affixing the notice amply satisfies the requirements of 17 U.S.C. §§ 10 and 19.”) (citing, *inter alia*, *Peter Pan Fabrics v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960); *Boucher v. Du Boyes*, 253 F.2d 948 (2d Cir. 1958); *Scarves by Vera v. United Merchants and Manufacturers*, 173 F.Supp. 625 (S.D.N.Y. 1959); *Trifari, Krussman & Fishel v. Charel Co.*, 134 F. Supp. 551 (S.D.N.Y. 1955)).

courts' approaches to questions of subject matter-eligibility, the "originality" requirement, and/or the idea/expression distinction. The last of these has featured especially prominently in decisions over the availability and enforceability of copyright protection for costume designs, probably because of their frequently representational nature.

But whereas fabric-pattern, focal-image, and jewelry-design cases have generally been adjudicated under doctrinal frameworks developed in relative isolation from statutory language, costume-related decisions have just as often invoked the language of the 1976 Copyright Act as pre-1976 *Mazer*-inspired case law. Costume-specific judicial decisions are arguably unique in reflecting hybrid approaches, in which earlier "novelty item" precedent interacts heavily with, informs, and/or is deemed superseded by the 1976 Copyright Act and administrative guidance provided thereunder.<sup>88</sup>

The shifting treatment of these issues over time, much more so than in the fabric-pattern and jewelry-design contexts, reflects the rise in judicial rhetoric about the risks of overlapping intellectual property protection—an arguably unsurprising development at a time when the post-*Mazer* expansion of copyright-eligibility principles coincided with the expansion of

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<sup>88</sup> The "hybridity" of such cases is compounded by the dynamic noted throughout this series, in which certain tropes of reasoning and rhetoric have the practical effect of limiting the eligibility and/or enforcement of copyright for even presumptively protectable fashion-related works—often without any explicit acknowledgment by the court applying the particular rearrangement of principles that suit it. This phenomenon, discussed in *On 'Originality,'* will be further explored in *On 'Useful Articles.'* For a handful of costume and novelty-item cases displaying such variation, see *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1221 (9th Cir. 1997), *cert. denied*, 523 U.S. 1021 (1998) (denying copyright protection to "derivative walkaround costume figures" based on finding insufficient originality); *Winfield Collection, Ltd. v. Gemmy Indus., Corp.*, 147 Fed. App'x 547, 550-51 (6th Cir. 2005) ("In limiting protection to the design, the district court cited several cases involving clothing, in which courts refused to accord copyright protection to the actual articles of clothing . . . . [The lower court erred in doing so because] Winfield's witch is . . . a purely 'ornamental design.' It is art, plain and simple; like a painting or a sculpture, its only function lies in being pleasing to the eye. Therefore, the reasoning behind the clothing and architecture cases clearly does not apply. The parties do not direct us to any cases where patterns or drawings instruct the creation of purely ornamental objects."); *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 853 F. Supp. 319, 322 (N.D. Cal. 1994) ("[T]his court finds that any aspect of a 'sculptural work' which is driven primarily by a functional, utilitarian or mechanical consideration will not merit copyright protection. Any differences in appearance between a derivative work and the preexisting work which are driven primarily by a functional, utilitarian or mechanical purpose cannot be considered when seeking artistic differences for the purpose of originality.").

trade-dress protection and the resurrection of design-patent protection.<sup>89</sup> The explicit linking of the idea-expression distinction and competition-related considerations stemming from IP overlap can be observed in the reasoning of a New York district court in its 1999 decision in *Funrise Canada v. Zauder Bros., Inc.*:

Unlike patent law, copyright law does not authorize a plaintiff to claim ownership over ideas. According to the U.S. Supreme Court, copyright “protection is given only to the expression of the idea—not the idea itself.” *Mazer v. Stein*, 347 U.S. 201, 217 (1953). Consequently, to prevail upon a copyright claim, “the plaintiff must show that the defendant appropriated the plaintiff’s particular means of expressing an idea, not merely that he expressed the same idea.” *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 123 (2d Cir.1994). Clear precedent thus prevents this court from finding that the plaintiff holds copyright ownership over the idea of a costume mimicking the uniform of an emergency worker.<sup>90</sup>

Similar rationales, not explicitly framed in patent-law terms but nevertheless drawing on patent law-like intuitions about the (in)adequacy of distance between a costume-like work and the relevant “prior art” (as idiosyncratically determined by the presiding judge(s))—can be noted in many judicial opinions concerning wearable novelty items. In the 1985 case of *Past Pluto Prods. v. Dana*, for example, a judge in the Southern District of New York invoked the idea/expression distinction in declining to recognize copyright protection for plaintiff’s Statue of Liberty-inspired foam hats; the hats differed from the actual Statue of Liberty in certain respects deemed too minor to warrant the recognition of rights in the creation.<sup>91</sup> Similarly, in *Beaudin v. Ben & Jerry’s Homemade*, the Second Circuit found that the idea/expression distinction precluded the possibility of enforcing a registered copyright in the design of a white hats with black spots, intended to evoke the appearance of Holstein cows:

<sup>89</sup> See Colman, *supra* note 4, at 42-44.

<sup>90</sup> 99-CV-1519(ARR), 1999 WL 1021810, at \*9 (E.D.N.Y. Jul. 8, 1999). It is potentially illuminating to compare *Funrise* with a 1962 decision in which concerns about the public domain had yielded to concerns about unfair business practices. See *Sunset House Distributing v. Doran*, 304 F.2d 251, 252 (9th Cir. 1962) (“No court can properly enjoin parties from the whole field of manufacturing [life-size figures of] Santa Claus. But defendants’ trouble is that their Santa Claus was just a lazy copy of the Doran Santa Claus. There was some slight variation in design which was made by the defendants, but not much.”). *But see* *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1219-29 (9th Cir. 1997) (casting doubt on scope and continuing force of *Doran*).

<sup>91</sup> 627 F. Supp. 1435 (S.D.N.Y. 1985).

The District Court correctly applied basic copyright principles in concluding that no triable issue was raised by Beaudin's claim that his "artwork on hats" copyright was infringed by Ben & Jerry's cow hats. The idea of placing Holstein-like black splotches on a white background is not the subject of the copyright, which protects only Beaudin's expression of this idea. See *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 765 (2d Cir. 1991); *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co.*, 509 F.2d 64, 65 (2d Cir. 1974). Indeed, it is doubtful whether taking a pattern that appears in nature and rendering it in a variety of minute variations that inevitably result from hand-painting satisfies even the minimal originality requirement of copyright. Protecting Beaudin's particular renderings of black splotches on a white background against identical copying would run the risk of infringement liability for anyone else who happened to see one of his hand-painted articles and, despite having no intent to replicate, in fact created a fabric design that was indistinguishable from the Beaudin "original."<sup>92</sup>

An instructive point of comparison to *Beaudin* is the earlier case of *Animal Fair, Inc. v. AMFESCO Industries, Inc.*, where a judge in the District of Minnesota found that a bear-shaped slipper intended to be worn at home was copyrightable, as it was not a "realistic representations of a bear's paw."<sup>93</sup> There, in contrast to Beaudin, the court opined that the "plaintiff [sought] only to protect what may be properly copyrighted under the law: the particular artistic expression embodied in its novelty slipper."<sup>94</sup>

It seems likely that the (non-)existence of a fashion *convention* of placing animal prints on articles of clothing, as opposed to making slippers in the shape of animal paws—influenced each court's impressions of the (non-)monopolistic character of the respective plaintiffs' assertions of rights. Another influential consideration for the presiding judges might have been an unstated—and perhaps not consciously recognized—assumption about the existence and legal significance of a distinction between "content" and "context"; such ideas have been interrogated by cultural and art theorists in postmodernist discourse, but received little or no substantive discussion in judicial decisions typically built on modernist foundations. In some cases, the perceived (non-) "functionality" of the costumes in question played a prominent role in judges' proffered reasoning.<sup>95</sup> In the 1988 case of *National*

<sup>92</sup> 95 F.3d 1, 2 (2d Cir. 1996).

<sup>93</sup> 620 F. Supp. 175, 187 (D. Minn. 1985), *aff'd*, 794 F.2d 678 (8th Cir. 1986).

<sup>94</sup> *Id.*

<sup>95</sup> See, e.g., *Wildlife Exp. Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 507 n.3 (1994) ("The parties in this case distinguish between the duffle bag itself, which is a 'useful article,' and the animal head and tail attached to the ends of the bag, which are artistic designs entitled to copyright protection. See 17 U.S.C. § 102(a)(5). Under the Act, an artistic work such as a drawing which is 'multiplied by the arts

*Theme Productions. v. Jerry B. Beck, Inc.*, a California district court judge ruled that the law presented no obstacle to copyrightability for a plaintiff's tiger costume that had been "devised [and] marketed by NTP as a novelty item intended as a wearable toy to be placed over a leotard or other adequate body covering solely for masquerade purposes."<sup>96</sup> Of particular importance to the *National Theme* court was the fact that the costume could not "be worn without a separate body covering underneath as it is too narrow to cover a woman's chest and contains no sides or bottom."<sup>97</sup> The item's artistic features thus did not "advance their utilitarian purpose as clothing or accessories," such that "they should be afforded protection as applied art under the copyright law."<sup>98</sup>

The potential analytical thorniness of looking to "functionality" as a dispositive criterion for the copyrightability for costumes was highlighted the following year in *Whimsicality, Inc. v. Rubie's Costumes Co.*,<sup>99</sup> when a New York district court judge rejected the *National Theme* rationale based on its finding that a costume's facilitation of "masquerading" was itself a "utilitarian" purpose that precluded the recognition or enforcement of copyright:

[T]his Court must reject the analysis in *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348 (S.D. Cal. 1988). Beginning with the same general principles discussed in this opinion, the *National Theme* court reasoned that the utilitarian purpose of the Halloween costumes at issue was simply to clothe; accordingly, it quite easily concluded that the costumes were copyrightable because the artistic elements in the costumes 'simply do not advance their utilitarian purpose as clothing or accessories,' 696 F. Supp. at 1354, and that 'the costumes were not . . . designed to optimize their function as clothing.' *Id.* at 1353. In this Court's view, the *National Theme* court's conceptual separability analysis is flawed because

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of printing in any of its branches' is copyrightable by its 'originator' or 'maker.' . . . However, the Act requires that a distinction be drawn between artistic expressions such as fabric designs, which are worthy of copyright expression, *see, e.g., Millworth Converting Corp. v. Slifka*, 276 F.2d 443, 444-45 (2d Cir. 1960) (Friendly, J.); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (Hand, J.), and 'useful articles' such as dress designs, which are not usually the subject of copyrights. *See Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989); *see also Folio Impressions*, 937 F.2d at 763 (stating this distinction.)" (internal citations omitted).

<sup>96</sup> 696 F. Supp. 1348, 1350 (S.D. Cal. 1988).

<sup>97</sup> *Id.*

<sup>98</sup> *Id.* at 1354 (citing as analogous plaintiff's bear-shaped slippers in *Animal Fair*, 620 F. Supp. 175, and animal-shaped children's backpacks at issue in *Act Young Imports, Inc. v. B and E Sales Co.*, 673 F. Supp. 672 (S.D.N.Y. 1987), both found to be copyrightable).

<sup>99</sup> 721 F. Supp. 1566 (E.D.N.Y. 1989).



the court failed to assess the artistic elements in light of the costumes' purpose as masquerade clothing. Indeed, logically applied, *National Theme* would extend copyright protection and monopoly status to the high fashion designs of the garment industry, contrary to well established case law, Copyright Office and historical precedent.<sup>100</sup>

The District Court's reasoning on this point was not addressed on the plaintiff's appeal to the Second Circuit—whose manner of reaching a ruling for the defendant was characterized by an apparent lack of good-faith efforts to apply then-existing precedent.<sup>101</sup>

The following year, the Third Circuit in turn rejected the New York court's reasoning in its decision in *Masquerade Novelty v. Unique Industries*.<sup>102</sup>

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<sup>100</sup> *Id.* at 1575.

<sup>101</sup> The Second Circuit in *Whimsicality* did not reach the question of copyrightability that had proved dispositive for the District Court. *See generally* 891 F.2d 452 (2d Cir. 1989). Instead, the panel ruled—in an almost shocking episode of judicial overreach—that (1) the designer plaintiff could not take advantage of copyright protection where it had obtained its registrations through “deception” of the Copyright Office (relying on the most tenuous “evidence” in support of this finding); and (2) in light of this “deception,” the defendant was entitled to an award of attorneys' fees. *Id.* at 454-57. *But see* *JB Fabric, Inc. v. Brylane, Inc.*, 714 F. Supp. 107, 109 (S.D.N.Y. 1989) (“The fact that the design was not registered as a derivative work does not automatically invalidate plaintiff's registration. *See L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 n.2 (2d Cir.1976) (*en banc*) (mere error in classification insufficient to invalidate registration). If, of course, plaintiff deliberately falsified its registration that registration would indeed be invalid . . . . However, whether plaintiff had the requisite scienter for a finding of fraud is a factual issue which cannot be resolved on this motion for summary judgment.”). Given the divergence between the actual doctrinal landscape at the time of the *Whimsicality* appeal and the Second Circuit's near-complete disregard thereof, one is led to wonder if the appellate court's ruling represents another instance of what is termed “ruling by reputation,” where courts determine the “appropriate” orientation of the reputation proxy primarily through an assessment of prestige, profits, and market share. *See Whimsicality*, 891 F.2d at 454 (observing, for reasons not elaborated upon, that defendant's annual sales volume was more than twenty times that of plaintiff's); *cf. supra* note 84 (examining decision giving “near-clean sweep” to major high-end jewelry companies and positing outcome to be result of judicial perceptions of prestige). The *Whimsicality* saga continued as the copyright-for-costume landscape evolved. *See generally* 836 F. Supp. 112 (E.D.N.Y. 1993) (finding after remand from Second Circuit that plaintiff filed motion to vacate judgment, in response to which district court held that an affidavit from a Copyright Office administrator constituted newly discovered evidence showing that, contrary to the 1989 dictates of the Second Circuit, plaintiff's registrations were enforceable, and defendant was not entitled to an award of attorney's fees).

<sup>102</sup> 912 F.2d 663 (3d Cir. 1990).

We believe the district court erred in considering nose masks as “useful articles” for purposes of § 101 [of the Copyright Act of 1976], and in therefore proceeding to conclude that they were not entitled to copyright protection because their utility could not be separated from their sculptural elements. This error, and the error of Unique’s position, flows from regarding as a utilitarian function the effect, humor, produced by the only utility the nose masks have, which is in their portrayal of animal noses. *Unlike a design incorporated in a belt . . . , which holds up the wearer’s pants, or even a costume, which may serve, aside from its appearance, to clothe the wearer, nose masks have no utility that does not derive from their appearance.*

That nose masks are meant to be worn by humans to evoke laughter does not distinguish them from clearly copyrightable works of art like paintings. When worn by a human being, a nose mask may evoke chuckles and guffaws from onlookers. When hung on a wall, a painting may evoke a myriad of human emotions, but we would not say that the painting is not copyrightable because its artistic elements could not be separated from the emotional effect its creator hoped it would have on persons viewing it. The utilitarian nature of an animal nose mask or a painting of the crucifixion of Jesus Christ inheres solely in its appearance, regardless of the fact that the nose mask’s appearance is intended to evoke mirth and the painting’s appearance a feeling of religious reverence. Thus, Masquerade’s nose masks are not “useful articles” for purposes of 17 U.S.C. § 101, and are copyrightable as sculptural works. 17 U.S.C. § 102(a)(5).

Our conclusion in this regard is supported by the case of *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970 (6th Cir.1983), in which the copyrightability of a toy airplane was disputed. The district court had concluded that the airplane was not copyrightable because toys are useful articles since they permit a child to dream and to let his or her imagination soar.<sup>103</sup>

The decisions in *Beaudin* and *Animal Fair*, mentioned above, arguably illustrate tacit methods of evaluating cognizable creativity in wearable designs; in a similar vein, the *National Theme-Whimsicality-Masquerade Novelty* trio places into high relief the dramatically undertheorized meaning of “utilitarian” in the area of copyright-for-fashion. The latter issue has been sporadically addressed—and will likely receive attention from the Supreme Court in its 2016-2017 term—in decisions outside the costume context, in a line of cases examined in my forthcoming installment *On ‘Useful Articles.’*

Uniformity on the question of the copyrightability of costumes, specifically, was the aim of a 1991 Copyright Office Policy Decision, *Registrability*

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<sup>103</sup> *Id.* at 670-71 (emphasis added). The importance of themes addressed in this excerpt to a nuanced analysis of “separability” outside the realm of costumes and related objects is discussed in the next installment, *On ‘Useful Articles.’*

of *Costume Designs*.<sup>104</sup> The Decision reviewed the fractured case law that had resulted from the Office's registration of what it called "a few narrowly drawn claims in certain three-dimensional fanciful or animal-shaped items that can be worn," and attempted to outline a framework intended to ameliorate the widespread "uncertainty regarding the registrability of masks and costume designs."<sup>105</sup>

The Policy Decision made clear that the Copyright Office interpreted the legislative history of the 1976 Act as endorsing the principle that "clothing cannot be protected by copyright merely on the ground that the appearance of the useful article is determined by aesthetic considerations."<sup>106</sup> The document then outlined the approach the Office would take in the future, which was essentially an attempted synthesis of the court decisions excerpted above. While perhaps the most pragmatic approach for an agency whose conventional policymaking authority is quite minimal, it is worth considering whether it is productive for the Copyright Office to interpret statutory language in this quasi-accommodationist manner—particularly when some courts will in turn premise their rulings on the Office's purported "views." This counterproductive dynamic is arguably emblematic of a more general lack of coherency and/or clarity concerning the relationship between the Copyright Office and the courts.

According to the Copyright Office, even "fanciful" costumes should be treated no differently from other "useful articles":

For purposes of copyright registration, fanciful costumes will be treated as [copyright-ineligible] useful articles. Costumes serve a dual purpose of clothing the body and portraying their appearance. Since clothing the body serves as a useful function, costumes fall within the literal definition of useful article. In addition, the case law consistently treats costumes as useful articles, and a Copyright Office decision to differ substantially from these court decisions would appear difficult to justify.

In accordance with the copyright principles applying to useful articles, fanciful costumes will be registered if they contain separable pictorial or sculptural authorship. The separable authorship may be physically separable, meaning that the work of art can be physically removed from the costume, or conceptually separable, meaning that the pictorial or sculp-

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<sup>104</sup> United States Copyright Office, 56 Fed. Reg. 56530 (1991).

<sup>105</sup> *Id.*

<sup>106</sup> *Id.* This acknowledgment would appear to echo and/or assuage concerns about what some have called "copyright bleed," of the sort voiced by the district court judge in the above-excerpted 1989 *Whimsicality* decision.

tural work is independently recognizable and capable of existence apart from the overall utilitarian shape of the useful article.<sup>107</sup>

The Copyright Office concluded its discussion by noting that “apparel” would receive no copyright protection beyond that already recognized in the case law: “[G]arment designs (excluding separately identifiable pictorial representations of designs impose upon the garment) will not be registered even if they contain ornamental features, or are intended to be used as historical or period dress.”<sup>108</sup>

Some judicial decisions on costumes and similar material in the years following the 1991 Policy Decision contained attempts at formalizing a sort of spectrum of protectability for “fanciful” objects worn on the body.<sup>109</sup> On balance, however, the 1991 Policy Decision seems not to have resulted in any real consensus, or even shared understanding of the relevant legal issues, among courts adjudicating costume-related cases—as acknowledged by an Indiana district court judge’s 2002 decision in *Celebration International, Inc. v. Chosun International, Inc.*:<sup>110</sup>

There is some dispute about whether costumes are protected by copyright at all. The Copyright Act (the “Act”) protects pictorial, graphic, and sculptural works. 17 U.S.C. § 102(a)(5). This is why Celebration referred to its tiger costume as “sculpture” in its application to the Copyright Office. The Act defines useful articles as “an article having intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information,” 17 U.S.C. § 101, and “[c]opyright in the design of a useful article may be claimed ‘only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’” MELVILLE B. NIMMER AND DAVID NIMMER, 1 NIMMER ON COPYRIGHT, § 2.08[H][3] (quoting 17 U.S.C.

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<sup>107</sup> *Id.*

<sup>108</sup> *Id.*

<sup>109</sup> In *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 507 n.3 (7th Cir. 1994), for example, the Seventh Circuit recognized the availability of copyright protection for a duffel bag designer’s embellishment of stuffed “animal heads and tails themselves, and for the way they are placed on the duffel bags,” noting that as expressions become more particularized, the area of protection becomes greater. The general concept embodied in this notion arguably reflects—albeit at a high level of abstraction—impulses that have informed trademark law’s use of a graded spectrum used to determine the level of trademarks’ “inherent distinctiveness.” Trademark law’s framework also places “fanciful” marks on the favored end of the scale. Readers should not infer from the similar terminology, however, that case law in one area has been used by courts to inform doctrinal analysis the other, despite the conceptual kinship between them.

<sup>110</sup> 234 F. Supp. 2d 905 (S.D. Ind. 2002).

§ 101) (the “separability rule”). Costumes, like clothing garments, clearly have a utilitarian aspect because they cover the wearer’s body and protect the wearer from the elements. Thus, because the language of 17 U.S.C. 101 only requires a work to have an intrinsic utilitarian function, this clothing function suffices to qualify the costumes as useful articles for purposes of the Act. See PAUL GOLDSTEIN, 1 COPYRIGHT, § 2.5.3 at 2:62 (2002).<sup>111</sup>

That the courts by the 1990s no longer gave Copyright Office decisions to register the persuasive force they once claimed to<sup>112</sup> might help to explain why the Office’s expertise and intervention have only sporadically and marginally driven judicial analyses in this area.

In part because of the courts’ selective and variable treatment of Copyright Office guidance, the legal landscape for costumes and similar items over the past fifteen years has been little more than a hodgepodge of doctrinal cherry-picking alongside occasionally bewildering treatment of costume-related copyrightability as an issue of pseudo-first impression:

- *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1221 (9th Cir. 1997)

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<sup>111</sup> *Id.* at 912 (citations omitted). For an in-depth discussion of the “separability” test, see *On ‘Useful Articles,’* the next installment in this five-article series.

<sup>112</sup> See, e.g., *Masquerade Novelty*, 912 F.2d at 669 n.7 (“In cases like this where the only issue is the copyrightability of a particular article that it is incontestably original, the § 410(c) presumption is of little real force. This is so in this case. Absent an indication from the Copyright Office as to why it registered the nose masks, or the existence of a controlling administrative regulation or interpretation of 17 U.S.C. § 101, the only deference we can give to the Copyright Office’s expertise in questions of copyright law, *Norris Industries v. Internat’l Telephone & Telegraph Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (the Copyright Office’s expertise in interpreting the copyright laws and applying them to the facts of copyright applications should be given deference), and the only meaning we can give to § 410(c) is to place the burden on Unique to show that the articles are not copyrightable. See *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985) (where the only question is whether certain articles are copyrightable, the court is in as good a position as the Copyright Office to consider this question).”). This 1990 passage, viewed against costume-related case law post-dating the Office’s 1991 Policy Decision, suggests that courts have sometimes cited a lack of Copyright Office guidance only to disregard or manipulate the guidance provided. It would seem such judicial lamentations about a lack of “guidance” or “clarity” (in which the blame is implicitly attributed to third parties or even certain types of works) might—as will be discussed in detail in *On ‘Useful Articles’*—be best understood as a means of misdirection than as the genuine expression of a request for assistance or “certainty.”

Although the category of costumes has rarely been dealt with in the copyright context, it seems clear that for copyright purposes, costumes would fall under the category of “pictorial, graphic and sculptural works” and would be treated as sculptural works. See 17 U.S.C. §§ 101, 103. This fact is critical to our determination, as Section 101 of the Copyright Act states that sculptural works of artistic craftsmanship receive copyright protection only

insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article [ordinarily not copyrightable] . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. § 101.

Accordingly, any aspects of ERG’s costumes that are purely functional, utilitarian or mechanical, will not be given any copyright protection. *Id.*; see also *Fabrica Inc. v. El Dorado Corp.*, 697 F.2d 890, 893 (9th Cir.1983). Moreover, any artistic aspects of ERG’s costumes will also not receive copyright protection unless they can be identified separately from, and are capable of existing independently of, the utilitarian purpose of the costumes. 17 U.S.C. § 101; see also *Fabrica*, 697 F.2d at 893.

- ***Whimsicality, Inc. v. Battat***, 27 F.Supp.2d 456, 463 (S.D.N.Y. 1998)

The costumes at issue (including the costumes that Whimsicality wants to add) are “useful articles” as that term is defined by 17 U.S.C. § 101, and as that term is understood for copyright purposes. *Rubie’s I*, 721 F.Supp. at 1571–73. Indeed, the purpose of Whimsicality’s entire line of costumes is to enable the wearer of them to masquerade—to pretend to be a frog, turtle, lion, shark, or butterfly. A “useful article” may be copyrightable, but only to the extent that the article “incorporates pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U.S.C. § 101; see also 17 U.S.C. § 102(a)(5); *Rubie’s I*, 721 F.Supp. at 1571–73. On the record before me, Whimsicality’s costumes do not meet this standard, and no reasonable juror could conclude otherwise.

Because the purpose of Whimsicality’s line of costumes is to enable the wearer to masquerade, the “artistic” elements of the costumes—including elaborate headpieces, masks, facial details, attractive color combinations, special fabrics and prints—are not separable on these facts from the costumes’ utilitarian aspects. *Rubie’s I*, 721 F.Supp. at 1574, 1574 n. 8. Thus, as Judge Dearie held in *Rubie’s I*, Whimsicality’s costumes are not copyrightable despite the fact that Whimsicality has obtained copyright registrations for them from the Copyright Office. *Id.* at 1573–76; *Fonar*, 105 F.3d at 104 (presumption of validity of copyright registrations “can be

overcome by evidence that the work was a non-copyrightable utilitarian article”) (citation omitted).

Thus, some courts have simply parroted earlier pronouncements about the “utilitarian” aspects of “masquerade.” They have emphatically failed to take seriously the relevant administrative and statutory language—and, just as importantly, the ways in which worn objects actually *work* on artistic and semiotic levels<sup>113</sup>—to make cogent rulings on arguably separable, and thus potentially copyrightable, components of costumes and apparel not “grandfathered in” by court rulings pre-dating the last gasps of candid and principled jurisprudence in this area.

#### IV. CONCLUSION TO *MANAGING MAZER*

This installment of *The History and Principles of American Copyright Protection for Fashion Design* has provided a general overview of themes, trajectories, and contradictions in the “doctrine” concerning the (formally recognized and practically limited) copyrightability of fabric patterns, focal images placed on otherwise non-copyrightable items, works of jewelry design, and costume elements, as this doctrinal landscape developed after the Supreme Court’s 1954 decision in *Mazer v. Stein*. The copyrightability of fashion-related subject matter not falling into or readily analogized to the material in these categories has typically been adjudicated, since 1978, through the lens of 17 U.S.C. § 101’s “useful article” language, examined in the next installment of this series. To convey the substantial, if incomplete, bifurcation of these two areas of law, I have separated the above discussion of what I have called “*Mazer* separability” from what I will later call “§ 101 separability.”

As noted in this installment, some courts’ rulings on *Mazer* separability and the practical consequences thereof seem to hinge more on judges’ apparent sense of whether a plaintiff’s motivation in filing suit, or the nature of the market effects deemed likely to follow from granting relief to that plain-

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<sup>113</sup> See generally Efrat Tseelon, *From Fashion to Masquerade: Towards an Ungendered Paradigm*, in *BODY DRESSING* 103 (Joanne Entwistle & Elizabeth Wilson, eds., 2001). However, decisions in which courts have found “masquerade” to be a “function” of costumes precluding their copyrightability have neither explored this idea in a thoughtful way nor persuaded the majority of courts. See, e.g., *Whimsicality* 27 F. Supp. 2d at 463 (S.D.N.Y. 1988) (“Because the purpose of Whimsicality’s line of costumes is to enable the wearer to masquerade, the ‘artistic’ elements of the costumes—including elaborate headpieces, masks, facial details, attractive color combinations, special fabrics and prints—are not separable on these facts from the costumes’ utilitarian aspects.”).

tiff, might be anticompetitive. But arguably less “principled” considerations that recur in the copyright case law discussed above include courts’ (sometimes tacit and often un(der)informed) perceptions of the complexity of the works at issue; the reputation, prestige, history, and litigation tactics of the parties; and factors stemming from broader cultural and political circumstances to be discussed in detail later in this series. For now, it is sufficient to note the important dynamic of judicial dissatisfaction with the doctrinal repercussions of *Mazer v. Stein*, which can be observed starting as early as the mid-1960s, in some of the fabric-pattern cases excerpted above. By the 1970s (when the Second and Ninth Circuit invoked the idea-expression distinction to effectively deny copyright to animal-shaped jewelry pins), judicial and scholarly commentary decrying the extension of copyright to “trivial” objects had grown louder.<sup>114</sup>

After the 1976 Copyright Act went into effect on January 1, 1978, courts confronted with questions about the copyrightability of components of wearable material not “grandfathered in” under earlier case law would interpret newly operative statutory language on “useful articles” and “separability” in very different ways.<sup>115</sup> Some courts crafted tests that appeared to contemplate the possibility of meaningful extensions of copyright protection to new artistic features of fashion design in the future. Even the courts

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<sup>114</sup> See, e.g., *Monogram Models, Inc. v. Industro Motive Corp.*, 448 F.2d 284, 277-78 (6th Cir. 1971) (“It is a legitimate question as to how certain of the classifications, such as photographs, motion pictures and ‘Works of art; models or designs for works of art’ can be reconciled as ‘writings of an author.’ However, courts have held, either by assuming *sub silentio* or through the use of a legal fiction, that the phrase ‘writings of an author’ is not to be literally construed so as to restrict the scope of copyrightable subject matter. Thus, there has been upheld copyright protection on ‘writings of an author’ [very] far removed from a literal definition of ‘writings’ and ‘author’ . . .”). The court asserted that the “list goes on and on,” and that this showed that—at least as of 1971 (though the statement was false in both formalistic and substantive respects even then)—“‘practically anything novel can be copyrighted’ . . . so long as it is ‘original’” (citing *Dan Kasoff, Inc. v. Novelty Jewelry Company*, 309 F.2d 745, 746 (2nd Cir. 1962) and *Mazer v. Stein*, 347 U.S. 201, 214 (1953), respectively).

<sup>115</sup> See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468 (6th Cir. 2015) (reviewing courts’ and commentators’ approaches to the question of “conceptual separability”). As with the *Mazer v. Stein* opinion that served as a doctrinal catalyst for expanded judicial recognition of the copyrightability of fashion-related items, the judicial decisions under the 1976 Copyright Act—which increasingly closed the door to fashion-related works not already deemed copyrightable—can only be meaningfully understood against a complex backdrop of cultural, economic, geopolitical, and institutional circumstances, to be explored in Part 5 of this series, *The Politics of ‘Piracy.’*



responsible for articulating those tests, however, would rarely remain faithful to them over the years. Increasingly strained readings of the language of the 1976 Copyright Act and occasional judicial legerdemain had, by 2015, largely foreclosed the possibility of copyright protection for types of fashion-related works ineligible for protection under a “*Mazer* separability” theory.<sup>116</sup> It came as a pleasant surprise when, in April 2016, the Supreme Court agreed—perhaps as part of a broader effort to avoid higher-profile political controversies until the late Justice Scalia’s seat was filled—to weigh in on the issue of separability for aesthetic components of wearable articles in *Star Athletica v. Varsity Brands*.<sup>117</sup> The next installment of this series, *On ‘Useful Articles,’* will examine the federal courts’ divergent, often tautological applications of the relevant provisions from the 1976 Copyright Act to fashion-related works, and will conclude by parsing the Supreme Court’s anticipated ruling in *Star Athletica*. This author, for one, fervently hopes that the Court displays in *Star Athletica* a less flippant and more reflective approach to the issues arising in this complex corner of the law than one finds in so many judicial decisions issued to date—even as the Court keeps in mind the very real anticompetitive effects that broad copyrightability of fashion designs can yield.

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<sup>116</sup> *See id.* (reviewing myriad approaches to “conceptual separability” employed by other courts and purporting to craft a unique approach for the Sixth Circuit, but ultimately resolving appeal concerning cheerleader uniform “zigzag” designs through decidedly facile analogy to fabric patterns).

<sup>117</sup> 15-866 (U.S. May 2, 2016).

