

FASHIONING PROTECTION: A NOTE ON THE PROTECTION OF  
FASHION DESIGNS IN THE UNITED STATES

by  
Julie P. Tsai\*

*Current United States law does not offer fashion designs protection against design piracy. This Note reviews the current state of intellectual property protection for fashion designs, contends that fashion designs should be protected, and proposes a viable option for fashion design protection in the United States.*

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I. INTRODUCTION

Today, clothing transcends necessity. Our clothing has become a statement of who we are. Fashion designers across the United States work vigorously to provide the consumer with original fashion designs. In 2001, the U.S. apparel industry raked in \$166 billion.<sup>1</sup> Yet, in a world where the creative works of musicians, artists, and filmmakers are so highly protected that even a child can

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\* Student, Lewis & Clark Law School, J.D. expected May 2005; The Johns Hopkins University, B.A. 1999 (Biophysics). The author would like to thank Professor Lydia Loren for her assistance with this paper.

<sup>1</sup> Press Release, NPDFashionworld, NPDFashionworld Reports 2001 U.S. Apparel Industry Down for First Time in Three Years, Apr. 29, 2002, [http://www.npd.com/press/releases/press\\_020429.htm](http://www.npd.com/press/releases/press_020429.htm).

be sued for sharing music over the Internet,<sup>2</sup> the United States does not see a need to protect the designs that a fashion designer creates.

Design piracy harms fashion designers. Three out of ten designers in the United States are self-employed.<sup>3</sup> This is almost five times the proportion for all professional and related occupations.<sup>4</sup> The median annual earnings for a fashion designer in the United States in 2000 was \$48,530 with the lowest ten percent earning less than \$24,710 and the highest ten percent earning more than \$103,970.<sup>5</sup> As small business owners, new designers are the most vulnerable to piracy of their designs. Piracy is also likely to be most detrimental to new designers. Given the uncertain outcome under existing law that does not expressly protect fashion designs, small businesses lack the financial ability to bring suits against design pirates.<sup>6</sup> Larger businesses realize the advantage they have over smaller businesses with respect to design piracy.<sup>7</sup> Therefore, these larger design firms are often able to copy the designs of smaller firms without repercussion.<sup>8</sup> A new designer then faces the threat of losing credibility with customers, the likely decline in value of the original design, and, in the worst case scenario, a designer may even be forced out of business.

If fashion designs were protected under United States law, smaller, newer designers would be more likely to bring suits against design pirates because their rights in their designs would be clearly established, thus reducing the litigation costs relative to the likelihood of obtaining effective relief. If a fashion design was truly pirated, the designer would have a higher likelihood of success, and would therefore be more inclined to defend her rights, despite the fact that she lacked the financial advantage of the larger designers. As it stands today, no clearly defined rights exist in overall fashion designs in the United States.<sup>9</sup>

Fashion designers, especially as small business owners, need protection for their designs. In a nation that thrives on entrepreneurship and rewarding people for their new and creative ideas, fashion design is one area that is in need of reform. To stay afloat, fashion designers must always be one step beyond the

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<sup>2</sup> *12-Year-Old Settles Music Swap Lawsuit*, CNN.COM, Feb. 18, 2004, at <http://www.cnn.com/2003/TECH/internet/09/09/music.swap.settlement>; Patrick Danner, *Music Piracy Suits Hitting Home*, HERALD.COM, Nov. 9, 2004, at <http://www.miami.com/mld/miamiherald/10133324.htm?1c> (father sued because his son downloaded songs when he was ten years old).

<sup>3</sup> BUREAU OF LABOR STATISTICS, U.S. DEP'T OF LABOR, OCCUPATIONAL OUTLOOK HANDBOOK: DESIGNERS 120 (2002-03 ed.), <http://www.bls.gov/oco/ocos090.htm>.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* at 123.

<sup>6</sup> Although there is currently no specific protection for fashion designs, certain elements of the designs may be protectable. 35 U.S.C. § 171 (2000); 17 U.S.C. § 102 (2000). The problems with these protections are discussed *infra* Part III. It is likely that the costs of litigation for these suits may deter some copying by other designers.

<sup>7</sup> E-mail from Mary Ping, fashion designer, to Julie Tsai (Oct. 13, 2003, 23:42:20 EST) (on file with author).

<sup>8</sup> *Id.*

<sup>9</sup> Although fashion designs are not generally protected, ornamental aspects of the clothing may be protected with design patents or copyright. 35 U.S.C. § 171; 17 U.S.C. § 102.

current trends. This requires both hard work and innovation. Therefore, if others are rewarded for their hard work and innovation, fashion designers should be as well. This Note will review the current state of intellectual property protection for fashion designs: Part II discusses design piracy in the United States; Part III provides an overview of current United States intellectual property protection and the problems with using it to protect fashion designs; Part IV discusses why fashion designs should be protected in the United States; and Part V proposes a plan for protection of fashion designs in the United States.

## II. DESIGN PIRACY

Fashion design piracy is a problem in the United States. Fashion designers invest time and money to develop designs only to have their original designs legally copied by other designers or manufacturers. While notions of justice and fairness suggest that these designers should be compensated and protected by law, design piracy is entirely legal under present U.S. law.<sup>10</sup>

Design piracy costs original designers hundreds of millions of dollars per year.<sup>11</sup> The piracy of sound recordings also reaches these highs and the law allows the recording industry to claim copyright protection and police its rights in a “draconian” fashion.<sup>12</sup> In other areas of artistic creation, pirates of visual arts, sound recordings, and motion pictures can be charged with both criminal and civil penalties.<sup>13</sup> In 1971, sales of record and tape piracy were estimated to be over \$100 million<sup>14</sup> and in 1984 sales of pirated computer chips exceeded \$100 million.<sup>15</sup> Prior to reaching those highs, music and computer chips were not protected against piracy.<sup>16</sup> However, once those record highs were reached, Congress recognized a need to pass legislation granting protection to those previously unprotected areas and added protection for sound recordings in 1972<sup>17</sup> and computer chips in 1984.<sup>18</sup> In the early 1980s, one fashion designer who openly copied designs from other designers earned as much as \$200 million in one year.<sup>19</sup> Congress has yet to redress the piracy of fashion designs.

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<sup>10</sup> S. Priya Bharathi, *There Is More than One Way to Skin a Copycat: The Emergence of Trade Dress to Combat Design Piracy of Fashion Works*, 27 TEX. TECH. L. REV. 1667, 1667 (1996).

<sup>11</sup> Samantha L. Hetherington, *Fashion Runways Are No Longer the Public Domain: Applying the Common Law Right of Publicity to Haute Couture Fashion Design*, 24 HASTINGS COMM. & ENT. L.J. 43, 44 (2001).

<sup>12</sup> RECORDING INDUS. ASS'N OF AM., ANTI-PIRACY, at <http://www.riaa.com/issues/piracy/default.asp> (last visited Feb. 25, 2005); Hetherington, *supra* note 11, at 44.

<sup>13</sup> Hetherington, *supra* note 11, at 45; 17 U.S.C. § 102; 17 U.S.C. §§ 501–506 (2000).

<sup>14</sup> H.R. REP. NO. 92-487, at 2 (1971), reprinted in 1971 U.S.C.C.A.N. 1566, 1567.

<sup>15</sup> Leslie J. Hagin, *A Comparative Analysis of Copyright Laws Applied to Fashion Works: Renewing the Proposal for Folding Fashion Works into the United States Copyright Regime*, 26 TEX. INT'L L.J. 341, 346–47 (1991).

<sup>16</sup> *Id.*

<sup>17</sup> 17 U.S.C. § 1101 (2000).

<sup>18</sup> Semiconductor Chip Protection Act of 1984, 17 U.S.C. §§ 901–914 (2000).

<sup>19</sup> Hagin, *supra* note 15, at 347. “‘Copycat King’ Victor Costa expected to gross over \$50 million in 1988 alone [while] Jack Mulqueen grossed over \$200 million in 1981, nearly

Copying of designs can, and often does, occur very blatantly. Design pirates will send designers to fashion shows to sketch designs as they are coming down the runways and will have designs ready to be sold before the original even reaches the stores.<sup>20</sup> The defendant in *Johnny Carson Apparel, Inc. v. Zeeman Manufacturing Co.*<sup>21</sup> purchased a suit designed by the plaintiff, took it apart to copy it, put it back together, then had the audacity to try to return it to the store where it was purchased.<sup>22</sup> Other clothing companies will copy designs by sending their manufacturer the article of clothing they would like to reproduce and telling them to use it as a model to create a knockoff.<sup>23</sup> Still others, once they have obtained the article of clothing, will bypass the original designer and ask the manufacturer of the original design to reproduce the designs for them directly.<sup>24</sup>

One fashion design firm, A.B.S. Clothing Collection, Inc. (ABS), has built its entire business around copying the creations of other designers.<sup>25</sup> Allen B. Schwartz, the President of ABS, has admitted to watching the Academy Awards telecast, sketching the dresses of the stars on the red carpet and then deciding which gowns he is going to “interpret.”<sup>26</sup> ABS even goes so far as to name its designs after the celebrity wearing it.<sup>27</sup>

Most small designers will let design piracy slide, with the knowledge that going to court will be expensive and unlikely to provide any redress. Other, larger design houses have taken severe precautions to protect their designs. International design house, Hermès, represented by a large, private law firm in New York, has its lawyers looking for knockoffs of the company’s scarves, handbags, and accessories on eBay as well as roaming shops to keep knockoffs off the street.<sup>28</sup> If knockoffs are found and the shape or style of the knockoff leads a likely Hermès consumer into thinking that it is genuine, then a court

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all from copying the original creations of other designers.” *Id.* Barneys New York puts out private label merchandise, some of which closely resembles the best of the pricier designer wear. See Teri Agins, *Copy Shops: Fashion Knockoffs Hit Stores Before Originals as Designers Seethe*, WALL ST. J., Aug. 8, 1994, at A1. Barneys’ private label merchandise accounted for more than 30 percent of its sales in 1994 and has likely gone up since then. *Id.*

<sup>20</sup> See Agins, *supra* note 19, at A1.

<sup>21</sup> *Johnny Carson Apparel, Inc. v. Zeeman Mfg. Co.*, No. C75-544A, 1978 WL 21356 (N.D. Ga. Nov. 4, 1978).

<sup>22</sup> *Id.* at \*4.

<sup>23</sup> *Segrets, Inc. v. Gillman Knitwear Co.*, 207 F.3d 56, 59 (1st Cir. 2000).

<sup>24</sup> *U-Neek, Inc. v. Wal-Mart Stores, Inc.*, 147 F. Supp. 2d 158, 166 (S.D.N.Y. 2001).

<sup>25</sup> Hetherington, *supra* note 11, at 45.

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

<sup>27</sup> *Id.* at 56 n.90 (ABS named a knock-off of the pink Ralph Lauren dress that Gwyneth Paltrow wore to the 71st Annual Academy Awards in 1999 “Gwyneth”).

<sup>28</sup> See Jen Chung, *Purse Gestalt: The Hermes Problem*, GOTHAMIST, Aug. 12, 2003, at [http://www.gothamist.com/archives/2003/08/12/purse\\_gestalt\\_the\\_hermes\\_problem.php](http://www.gothamist.com/archives/2003/08/12/purse_gestalt_the_hermes_problem.php); *Fashion Industry Copes with Designer Knockoffs: With Copyright Protection Elusive, Copies are Common*, NPR, Sept. 18, 2003 at [http://www.npr.org/display\\_pages/features/feature\\_1434815.html](http://www.npr.org/display_pages/features/feature_1434815.html) [hereinafter *Fashion Industry Copes*].

will likely be convinced that the fake violates Hermès' trademarks or trade dress rights.<sup>29</sup>

On the other hand, not everyone believes that the creative works of fashion designers should be protected. Some believe that the fashion world has purposefully chosen to allow its works to remain in the public domain.<sup>30</sup> Laurie Racine and David Bollier assert that the lack of protection is what allows the fashion industry to thrive.<sup>31</sup> Styles and designs are reused and recycled to the benefit of the public.<sup>32</sup> Bollier and Racine use Disney as an example of the harmful effects of one-way privatization.<sup>33</sup> Disney has taken classic folk stories and turned them into works that no one else can access, all the while, Disney has contributed nothing to the public domain.<sup>34</sup> Fashion, on the other hand, is perhaps copied or taken from the public domain, but something is always returned to the public.<sup>35</sup>

Although there is controversy over whether fashion designs should be protected, even within the fashion design industry, fashion designs should be granted protection. There may not currently be a dearth of new fashion designs, however, it is likely that with protection, there would be even more designs. Further, creative talents in other areas, including art and music, are protected; therefore, creative fashion designs should be protected as well.

### III. PROTECTION FOR FASHION DESIGNS IN THE UNITED STATES

Protection of fashion designs in the United States was not a major problem for designers until changes in the clothing industry during the 1920s contributed to the problem of design piracy,<sup>36</sup> and by the 1950s, the piracy business was flourishing.<sup>37</sup> First, the jobbing organization grew astonishingly during this time.<sup>38</sup> A "jobber" would purchase the fabrics and turn them over to manufacturers that could cut, trim and finish the garments on a contractual basis.<sup>39</sup> The manufacturers would then return the garments to the jobber to sell.<sup>40</sup> Jobbers had very low overhead and were unaffected by the labor troubles

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<sup>29</sup> *Fashion Industry Copes*, *supra* note 28; *see infra* Part III(A) for a discussion of trademark law.

<sup>30</sup> David Bollier & Laurie Racine, *Control of Creativity? Fashion's Secret*, CHRISTIAN SCI. MONITOR, Sept. 9, 2003, para. 2, at <http://www.csmonitor.com/2003/0909/p09s01-coop.html>. David Bollier and Laurie Racine are senior fellows at the Norman Lear Center of USC Annenberg. *See* THE NORMAN LEAR CENTER, USC ANNEBURG, ABOUT FELLOWS, at <http://www.learcenter.org/html/about/?cm=fellows> (last visited Feb. 25, 2005).

<sup>31</sup> Bollier & Racine, *supra* note 30, para. 4.

<sup>32</sup> *Id.*, para. 8.

<sup>33</sup> *Id.*, para. 12.

<sup>34</sup> *Id.*

<sup>35</sup> *Id.*, para. 11.

<sup>36</sup> Maurice A. Weikart, *Design Piracy*, 19 IND. L.J. 235, 239 (1944).

<sup>37</sup> Hagin, *supra* note 15, at 345.

<sup>38</sup> Weikart, *supra* note 36, at 238.

<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

that a manufacturer faced, thus making the jobbing organization appealing.<sup>41</sup> This system encouraged copying because jobbers purchased designs from freelance designers and were indifferent as to whether the same design had been sold to someone else or not.<sup>42</sup> Further, giving the design to several manufacturers who worked on different parts of the finished garment increased the chances of copying.<sup>43</sup>

Second, “hand-to-mouth” buying increased after 1921.<sup>44</sup> “Hand-to-mouth” buying is the placing of orders for such quantities that can be sold immediately.<sup>45</sup> This increased the strain on jobbers and manufacturers who had to produce garments without any advance orders, essentially requiring them to guess which designs would be in demand.<sup>46</sup> This encouraged piracy because the copiers could wait to see which designs were popular and then copy them.<sup>47</sup> Finally, the natural growth of the industry contributed to the rise in design piracy.<sup>48</sup>

In the late 1930s, the Fashion Originators’ Guild of America (FOGA) decided to take matters into its own hands when the designs of its members were being copied and sold to the same stores at lower prices.<sup>49</sup> In order to destroy competition resulting from design pirates, FOGA boycotted and declined to sell its products to retailers who sold clothing copied by other manufacturers from designs by FOGA members.<sup>50</sup> Violators of FOGA requirements, who sold to boycotted stores or sold copied designs, were subject to heavy fines.<sup>51</sup> As to be expected, the Federal Trade Commission swiftly ended this practice because it created unfair competition, resulting in a monopoly.<sup>52</sup> The practice also ran counter to federal antitrust and trade acts.<sup>53</sup> Since then, designers have been looking for a viable way to protect their designs within the law.

In the United States, there are three main areas of intellectual property law: trademark, patent, and copyright. Each of these three areas of law are currently problematic when applied to protection of fashion designs.

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<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* at 239.

<sup>45</sup> *Id.*

<sup>46</sup> *Id.*

<sup>47</sup> *Id.*

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

<sup>49</sup> *Fashion Originators’ Guild of Am., Inc. v. FTC*, 312 U.S. 457, 461 (1941). FOGA members design, manufacture, sell, and distribute women’s clothing. *Id.*

<sup>50</sup> *Id.*

<sup>51</sup> *Id.* at 463.

<sup>52</sup> *Id.* at 464–65.

<sup>53</sup> *Id.*

A. *Trademark and Trade Dress*

Trademarks serve as an indicator of source.<sup>54</sup> Trademark law protects design logos such as the Ralph Lauren polo player, the “LV” mark on Louis Vuitton products, and any other mark a company may choose to put on its product.<sup>55</sup> Trade dress, which is protected by the Lanham Act under the guise of trademark, refers to a product or service’s overall appearance with elements that serve to identify the product’s source to the customer.<sup>56</sup> Trade dress has been granted to rather diverse items including a restaurant’s ambience and the style of a musical performance.<sup>57</sup> There are problems, however, in applying trade dress to protect fashion designs.

For a product design to be protectable under trade dress, the product design must be distinctive.<sup>58</sup> Distinctiveness of a trade dress can usually be proven if a product is either inherently distinctive or if the product has acquired secondary meaning.<sup>59</sup> Because a product design is rarely inherently distinctive, the product design becomes distinctive only upon a showing of secondary meaning.<sup>60</sup> A product has acquired secondary meaning if “the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.”<sup>61</sup> The producer of the product must be able to “show that the consuming public identifies the trade dress with the specific producer,” rather than the product.<sup>62</sup> Fashion designs have a short life span; therefore, “consumers are very unlikely to be able to attribute a particular clothing design to a particular designer, without the aid of trademarks, labels or a substantial advertising campaign.”<sup>63</sup> The evidentiary requirement to prove secondary meaning tends to be rigorous and expensive to establish.<sup>64</sup> Therefore, it is difficult for individual designers, who have not yet made names for themselves, to carry this burden.

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<sup>54</sup> See 15 U.S.C. § 1127 (2000); Daniel J. Gifford, *The Interplay of Product Definition, Design and Trade Dress*, 75 MINN. L. REV. 769, 769 (1991).

<sup>55</sup> *Polo Fashions, Inc. v. Craftex, Inc.*, 816 F.2d 145, 145 (4th Cir. 1987); T. Anthony, Ltd. v. Malletier, No. 93 Civ. 6900 (KC), 1993 WL 659682, at \* 1 (S.D.N.Y. Nov. 24, 1993).

<sup>56</sup> *U-Neek, Inc. v. Wal-Mart Stores, Inc.*, 147 F. Supp. 2d 158, 171 (S.D.N.Y. 2001).

<sup>57</sup> See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 (1992); Cesare v. Work, 520 N.E.2d 586, 593 (Ohio Ct. App. 1987).

<sup>58</sup> *Two Pesos Inc.*, 505 U.S. at 775 (“Only . . . distinctive trade dress is protected under § 43(a) [of the Lanham Act].”).

<sup>59</sup> *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000).

<sup>60</sup> *Id.* at 216.

<sup>61</sup> *Two Pesos, Inc.*, 505 U.S. at 766.

<sup>62</sup> Karina K. Terakura, *Insufficiency of Trade Dress Protection: Lack of Guidance for Trade Dress Infringement Litigation in the Fashion Industry*, 22 U. HAW. L. REV. 569, 588 (2000).

<sup>63</sup> Anne Theodore Briggs, *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, 24 HASTINGS COMM. & ENT. L.J. 169, 199 (2002).

<sup>64</sup> See *U-Neek, Inc. v. Wal-Mart Stores, Inc.*, 147 F. Supp. 2d 158, 172 (S.D.N.Y. 2001); Terakura, *supra* note 62, at 588.

Trademark law is also limited by the functionality doctrine.<sup>65</sup> “The functionality doctrine prevents trademark law, which seeks to promote competition by protecting” a signal of the source of a product, “from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”<sup>66</sup> Functionality is based on whether a product feature “is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>67</sup> A trade dress that serves either a utilitarian or aesthetic function falls outside the scope of the Lanham Act and is unprotectable.<sup>68</sup> Elements of a trade dress that are utilitarian contribute to a product’s use, purpose, or performance.<sup>69</sup>

“Aesthetic functionality focuses on ornamental features of a product that are ‘neither essential nor helpful’ to the utilitarian function of the product.”<sup>70</sup> “[I]f the success of a product is due to the attractiveness of a design feature, then that product possesses aesthetic functionality, and is therefore unprotectable under trade dress law.”<sup>71</sup> An ornamental feature that would severely “hinder competition by limiting the range of adequate alternative designs” will also be unprotected under trademark law because it is aesthetically functional.<sup>72</sup> Although every element of the trade dress does not have to be nonfunctional, the end result must be nonfunctional when considered as a whole.<sup>73</sup>

Thus, solely aesthetic designs may pose a problem. In *Knitwaves, Inc. v. Lollytogs Ltd.*,<sup>74</sup> Knitwaves brought suit against Lollytogs for trade dress infringement.<sup>75</sup> Knitwaves designed a collection of girls’ clothing using fall motifs, which included sweaters with leaf and squirrel appliqués.<sup>76</sup> Shortly after the success of Knitwaves’ collection, a design executive at Lollytogs informed its design department that he wanted to produce garments with a fall design and presented Knitwaves’ leaf and squirrel sweaters as examples.<sup>77</sup> A designer at Lollytogs copied what she believed to be the nonoriginal parts and altered the original parts of the sweater.<sup>78</sup> The Second Circuit was persuaded by Lollytogs’ contention that Knitwaves’ objective in the designs was primarily aesthetic

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<sup>65</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

<sup>66</sup> *Id.*

<sup>67</sup> *Id.* at 165 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 (1982)).

<sup>68</sup> *New Colt Holding Corp. v. RJG Holdings of Fla., Inc.*, 312 F. Supp. 2d 195, 211–12 (D. Conn. 2004).

<sup>69</sup> Terakura, *supra* note 62, at 584.

<sup>70</sup> *Id.*

<sup>71</sup> *Id.* at 585.

<sup>72</sup> *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1006 (2d Cir. 1995).

<sup>73</sup> Terakura, *supra* note 62, at 583.

<sup>74</sup> 71 F.3d at 996.

<sup>75</sup> *Id.* at 1000.

<sup>76</sup> *Id.*

<sup>77</sup> *Id.*

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

rather than source identifying.<sup>79</sup> Therefore, the designs failed to qualify for trade dress protection.<sup>80</sup>

Similarly, in *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*,<sup>81</sup> Abercrombie brought an action against American Eagle alleging trade dress infringement of its clothing designs.<sup>82</sup> Abercrombie sought to protect certain design elements of its clothing including the use of the words *performance, authentic, genuine brand, trademark, and since 1892* in combination with Abercrombie's trademarks on clothing bearing "primary color combinations . . . in connection with solid, plaid and stripe designs and made from all natural cotton, wool and twill fabrics" to create reliable rugged and casual clothing.<sup>83</sup> The court found that Abercrombie's competitors would be at a significant non-reputational competitive disadvantage due to the paucity in comparable alternative features if protection were granted.<sup>84</sup> Therefore, the court held that the designs were functional and rejected Abercrombie's claim for trade dress infringement.<sup>85</sup>

Although it has been argued otherwise,<sup>86</sup> trade dress protection is ill-suited to protect fashion designs. Unless the public suddenly becomes competent in distinguishing between the styles of particular designers, trade dress will not adequately protect fashion designs.

#### B. Design Patent

Patent protection can be obtained for useful inventions<sup>87</sup> and original designs for articles of manufacture.<sup>88</sup> Utility patents protect the way an article is used, while design patents protect the way an article looks. To obtain a design patent, a showing of novelty, nonobviousness, ornamentality, and nonfunctionality is required.<sup>89</sup> The main difficulties in using design patents to protect fashion designs are demonstrating nonobviousness and nonfunctionality. The nonfunctionality requirement of the design patent may pose a problem because to be protected, a design must not be dictated by functional considerations.<sup>90</sup> To determine whether a design is primarily functional or primarily ornamental, the design is viewed in its entirety to determine whether the claimed design is dictated by the utilitarian purpose of

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<sup>79</sup> *Id.* at 1006, 1009.

<sup>80</sup> *Id.* at 1009.

<sup>81</sup> 280 F.3d 619 (6th Cir. 2002).

<sup>82</sup> *Id.* at 624.

<sup>83</sup> *Id.* at 642–43.

<sup>84</sup> *Id.* at 643.

<sup>85</sup> *Id.* at 643–44.

<sup>86</sup> See generally Bharathi, *supra* note 10.

<sup>87</sup> 35 U.S.C. § 101 (2000) ("Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.").

<sup>88</sup> 35 U.S.C. § 171 (2000) ("Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent.").

<sup>89</sup> 1 DONALD S. CHISUM, CHISUM ON PATENTS § 1.04[2], at 1-301 (2004).

<sup>90</sup> *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

the article.<sup>91</sup> Clothing is inherently functional, hence only certain aspects of the fashion design are eligible for design patent protection.<sup>92</sup> Consequently, the overall fashion design is unlikely to be protected by a design patent.

Nonobviousness, however, is the primary difficulty for fashion designs to overcome. Nonobviousness is required from the point of view of a skilled designer in the field.<sup>93</sup> This standard is used to set a high bar; design patents require more than just commercial viability; there must be an actual invention.<sup>94</sup> Design patents require some skill beyond that of an ordinary designer.<sup>95</sup> This is such a high standard that even new fashion designs that do not incorporate any known design element can fail to acquire patent protection.<sup>96</sup> Further, some courts have even expressed doubt that clothing can ever qualify for design protection.<sup>97</sup>

In *H.W. Gossard Co. v. Neatform Co.*,<sup>98</sup> Gossard brought suit against five defendants for infringement of its design patent.<sup>99</sup> The subject matter of the design patent was an ornamental design for a panty girdle.<sup>100</sup> The plaintiff contended that the new element of the design was that the elastic edging on the perimeter of the leg openings did not end on the perimeter; instead, it extended in a continuing line until it reached the center front panel of the girdle.<sup>101</sup> The plaintiff alleged that this made a more pleasing design than those which had previously been used.<sup>102</sup> Although the court found that the design was new, original, and ornamental, it also established that merely changing the angle of the border “would not have required inventive genius.”<sup>103</sup> Therefore, the design of the girdle did not meet the nonobvious standard, as the design would have been obvious to a person with ordinary skill in the art.<sup>104</sup>

In addition to the difficulties in satisfying the requirements for a patent, there are several other considerations that make patents less than ideal for protection of fashion designs. First, the patent process is a difficult and lengthy

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<sup>91</sup> *Id.* (“The elements of the design may indeed serve a utilitarian purpose, but it is the ornamental aspect that is the basis of the design patent.”).

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

<sup>93</sup> Briggs, *supra* note 63, at 176–77.

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

<sup>95</sup> *Id.* at 177.

<sup>96</sup> *White v. Lombardy Dresses, Inc.*, 40 F. Supp. 216, 218 (S.D.N.Y. 1941) (holding that dresses copied by the defendant did not meet the novelty and nonobviousness standards, even though the dresses did not contain known dress design elements nor were they combinations of prior known dress designs).

<sup>97</sup> See *H.W. Gossard Co. v. Neatform Co.*, 143 F. Supp. 139, 143 (S.D.N.Y. 1956); *White*, 40 F. Supp. at 218 (“[U]ntil and unless a higher court decides that a design patent does not require the exercise of the inventive faculty to the extent that patent law now requires in advancing the particular art, the obtaining of a patent on simply a new and attractive dress is a waste of time.”).

<sup>98</sup> 143 F. Supp. 139 (S.D.N.Y. 1956).

<sup>99</sup> *Id.* at 140.

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

<sup>101</sup> *Id.* at 141.

<sup>102</sup> *Id.*

<sup>103</sup> *Id.* at 143.

<sup>104</sup> *Id.* at 143–44.

one. The Patent and Trademark Office (PTO) takes an average of 26 months to review each patent application.<sup>105</sup> The PTO rejects about 25 percent of the applications.<sup>106</sup> Even if the application is approved, courts will often find patents invalid, or if valid, they will only find infringement in about half of the cases.<sup>107</sup>

Second, the long lasting protection that design patents grant is unnecessary for fashion designs. Design patents last for fourteen years from the date of the grant.<sup>108</sup> Fashion designs have a short life span and would not likely need protection beyond this time.<sup>109</sup> Thus, it would be a waste of resources to spend 26 months reviewing a patent for a fashion design with a life span of less than 12 months.<sup>110</sup>

Finally, the high costs of obtaining design patents would make it difficult for an individual designer or small business to acquire protection for its entire collection. The designer would necessarily require the assistance of a patent lawyer during the long process of searching the prior art in addition to the fees required by the United States Patent and Trademark Office (USPTO).<sup>111</sup> The filing fee for a design patent application is currently \$310 and if the patent is issued there is an additional fee of \$430 for each design patent issued.<sup>112</sup> Further, in 2003, attorneys charged a median fee of \$1,100 per design patent application for preparing and filing the patent.<sup>113</sup> Therefore, it would cost a designer with a mere 10 articles of clothing in her collection nearly \$20,000 to apply for and obtain protection for her collection, including attorney fees.

The difficulties in obtaining design patents, as well as the cost and time requirements, make design patents an unappealing choice for fashion design protection. Even if fashion designs were granted design patents, designers,

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<sup>105</sup> U.S. PATENT AND TRADEMARK OFFICE, SUMMARY OF PATENT EXAMINING ACTIVITIES, at [http://www.uspto.gov/web/offices/com/annual/2003/060401\\_table1.html](http://www.uspto.gov/web/offices/com/annual/2003/060401_table1.html). Design patents are not included in this average time. *Id.* Although design patents are not included in this pendency time, the author spoke with a representative at the Investor's Assistance Center of the United States Patent and Trademark Office who stated that design patents are not included in the average because they probably require less time. However, the representative stated that 26 months is a cautious estimate of pendency time for design patents as well.

<sup>106</sup> U.S. PATENT AND TRADEMARK OFFICE, U.S. PATENT STATISTICS, CALENDAR YEARS 1963–2003, at [http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us\\_stat.pdf](http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.pdf). In 2003, 22,602 design patents were applied for and 16,574 design patents were issued. *Id.*

<sup>107</sup> CHRISTINE MAGDO, PROTECTING WORKS OF FASHION FROM DESIGN PIRACY, <http://leda.law.harvard.edu/leda/data/36/MAGDO.html>. (last visited Mar. 8, 2005).

<sup>108</sup> 35 U.S.C. § 173 (2000).

<sup>109</sup> Safia A. Nurbhai, *Style Piracy Revisited*, 10 J.L. & POL'Y 489, 502 (2002).

<sup>110</sup> See also *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 190 (S.D.N.Y. 1934) (noting the practical inadequacy of patent protection for dress designs due to the short life span of the designs and the rigorous requirements and time involved in obtaining a patent).

<sup>111</sup> Hagin, *supra* note 15, at 356 n.111; 35 U.S.C. § 41(a)(3) (2000).

<sup>112</sup> 35 U.S.C. § 41(a)(3).

<sup>113</sup> AM. INTELLECTUAL PROP. LAW ASSOC., REPORT OF THE ECONOMIC SURVEY 2003, at 92, tbl. 21 (Typical Charge by Location of Primary Place of Work) (2003). The costs per application vary depending on the location of the attorney. *Id.*

especially small businesses, would be unable to overcome the monetary and time constraints.

### C. Copyright

At first glance, copyright may seem like the ideal method of protecting fashion designs. Copyright registration is not required for protection, even though it is a relatively easy process.<sup>114</sup> Copyright law protects “original works of authorship fixed in any tangible medium of expression.”<sup>115</sup> The only possible category that fashion designs would fit under is the “pictorial, graphic, and sculptural works” category.<sup>116</sup>

The main obstacle with using the Copyright Act to protect fashion designs is the “useful article” doctrine, which limits copyright protection for items with a functional as well as aesthetic purpose. Under the useful article doctrine, if an item has an intrinsic utilitarian function, it must pass either a test of physical or conceptual separability.<sup>117</sup> In other words, the pictorial, graphic or sculptural aspect of the work must be physically or conceptually separable from the utilitarian, functional parts, and even then, only the separable aspect is given protection.<sup>118</sup>

In *Galiano v. Harrah’s Operating Co.*, the court found that the artistic design feature of uniforms designed by Galiano could not be conceptually separated from their utilitarian function.<sup>119</sup> Galiano contracted with Harrah’s casinos to provide design services for its employee uniforms.<sup>120</sup> Several years after the agreement expired, Galiano received a Certificate of Registration from the U.S. Copyright Office for a collection of sketches of the uniforms.<sup>121</sup> A few months later, Galiano filed a complaint against Harrah’s for copyright infringement.<sup>122</sup> The court found the clothing designs depicted in the collection to be uncopyrightable before considering whether any design elements were conceptually separable from their utilitarian aspects.<sup>123</sup> Galiano’s expert identified several artistic design elements,<sup>124</sup> but the court, while

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<sup>114</sup> 17 U.S.C. §§ 408–409 (2000).

<sup>115</sup> 17 U.S.C. § 102(a) (2000). The Copyright Act includes works of authorship in the following categories: “(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.” *Id.*

<sup>116</sup> 17 U.S.C. § 102(a)(5).

<sup>117</sup> *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2nd Cir. 1980).

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

<sup>119</sup> *Galiano v. Harrah’s Operating Co.*, No. Civ.A. 00-0071, 2004 WL 1057552, at \*9 (E.D. La. May 10, 2004).

<sup>120</sup> *Id.* at \*1.

<sup>121</sup> *Id.*

<sup>122</sup> *Id.* at \*2.

<sup>123</sup> *Id.* at \*9–10.

<sup>124</sup> The design elements identified include:

logo cuff, a piped mandarin collar with a notch at center front, the inverted center back pleat with a star at the top, jacquard fabric trim on a concealed button or snap placket, jacquard fabric stripes down either

acknowledging the aesthetic value of the features, found that the artistic design features of the uniforms depicted in the illustrations could not be conceptually separated from their utilitarian function.<sup>125</sup> However, the court did find that the silkscreen artwork on the uniforms could be copyright protected because of its capability of existing independently of the clothing.<sup>126</sup>

In contrast to *Galiano*, conceptual separability was shown in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, where the ornamental aspect of a carefully crafted belt buckle was conceptually separable from the buckle itself.<sup>127</sup> Barry Kieselstein-Cord designed the two belt buckles at issue from original renderings that he had conceived and sketched.<sup>128</sup> He then hand carved a wax prototype of each from which molds were made for casting.<sup>129</sup> The buckles were sold in silver or gold with retail prices ranging from \$150 to \$6,000 per buckle.<sup>130</sup> Both of the buckles were also donated to and accepted by the Metropolitan Museum of Art for its permanent collection.<sup>131</sup> The court in *Kieselstein-Cord* found that the primarily ornamental aspects of the buckles were conceptually separable from their subsidiary utilitarian function and that the buckles rose to the level of creative art.<sup>132</sup> Therefore, the buckles were entitled to copyright protection.<sup>133</sup>

In other cases, the court does not even consider whether there are copyrightable aspects separable from the utilitarian function of an article once it finds the article to be utilitarian. This was the case in *Lim v. Green*.<sup>134</sup> In *Lim*, the plaintiff designed a scarf cap that he wanted to copyright as a soft sculpture.<sup>135</sup> The plaintiff, however, admitted that his design was influenced by a belief that Harley Davidson may be interested in it as a line of accessories, indicating his intent to use the scarf cap as a functional, commercial article.<sup>136</sup> Therefore, the court found the scarf cap to be uncopyrightable because of its utilitarian function.<sup>137</sup> However, the court failed to even consider whether there were any protectable aspects of the scarf cap that were separable from the

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side, piped cuff trim, princess lines in front and back, star buttons, a flange at the shoulder, concentric flanges on the jacket front, asymmetric closures, button designs, bib front, placement of buckle closures, color blocking, and combinations of fabrics, style lines, trim and silhouette.

*Id.* at \*9.

<sup>125</sup> *Id.* at \*10.

<sup>126</sup> *Id.*

<sup>127</sup> *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2nd Cir. 1980).

<sup>128</sup> *Id.* at 990.

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

<sup>130</sup> *Id.* at 991.

<sup>131</sup> *Id.*

<sup>132</sup> *Id.* at 993.

<sup>133</sup> *Id.*

<sup>134</sup> No. 99-16538, 2000 U.S. App. LEXIS 29291 (9th Cir. Nov. 13, 2000).

<sup>135</sup> *Id.* at \*3.

<sup>136</sup> *Id.*

<sup>137</sup> *Id.*

utilitarian aspects of the article, merely stating that “it has long been established that clothing designs are not subject to copyright protection.”<sup>138</sup>

Unlike *Lim*, the court accepted the plaintiff’s argument that an article of clothing was actually a soft sculpture in *Poe v. Missing Persons*.<sup>139</sup> In *Poe*, there was a genuine question as to whether a swimsuit was a soft sculpture or whether it was a useful article.<sup>140</sup> Poe created the piece, entitled “Aquatint No. 5,” which he described as a “three dimensional work of art in primarily flexible clear-vinyl and covered rock media.”<sup>141</sup> The piece was shown in an art show and the only evidence presented of utilitarian function was that the piece was worn once so that it could be photographed for a band’s album cover.<sup>142</sup> The court thus reversed the grant of summary judgment for Missing Persons, who claimed that Aquatint No. 5 was a useful article.<sup>143</sup> Summary judgment was inappropriate because there was a genuine issue of fact as to whether Aquatint No. 5 was a useful item of clothing or a work of art.<sup>144</sup>

As with trade dress and design patent protection, copyright presents problems for the protection of fashion designs. The requirement of separability creates a significant hurdle for fashion design protection. Clothing is inherently useful and only in the very rare case, where the clothing can be viewed as “soft sculpture” rather than solely utilitarian, is the design likely to receive copyright protection.<sup>145</sup> Further, the primary skill in designing clothing is determining the correct shape and fit, which cannot be physically separated from the clothing itself and is difficult, if not impossible, to conceptually separate.<sup>146</sup> Unless Congress decides to amend the Copyright Act to specifically protect the design of clothing, fashion designs will continue to be unprotected by copyright law.<sup>147</sup>

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<sup>138</sup> *Id.* at \*2.

<sup>139</sup> 745 F.2d 1238 (9th Cir. 1984).

<sup>140</sup> *Id.* at 1239.

<sup>141</sup> *Id.* at 1240.

<sup>142</sup> *Id.* at 1241.

<sup>143</sup> *Id.* at 1243.

<sup>144</sup> *Id.*

<sup>145</sup> See *infra* Part III.C; *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980); *Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F. Supp. 175 (D. Minn. 1985). In *Animal Fair*, with respect to bear paw shaped slippers, the court found that “[t]he impractical width and shape of the [slipper] sole, the artwork on the sole, the particular combination of colors, the profile of the slipper, the stuffed aspect of the slipper, and the toes are all sculptural features which comprise the artistic design and which are wholly unrelated to function.” *Id.* at 187–88. The slipper was therefore found to be protectable under the Copyright Act. *Id.*

<sup>146</sup> Briggs, *supra* note 63, at 183–84.

<sup>147</sup> In 1990, Congress amended the Copyright Act to include protection for architectural works. Architectural Works Copyright Protection Act, Pub. L. No. 101-650, 1990 U.S.C.A.N. (104 Stat.) 5133; 17 U.S.C. § 101 (2000). Prior to the enactment of the Architectural Works Act, architecture was unprotected under copyright law primarily due to the “usefulness” of the works. *Demetriades v. Kaufmann*, 680 F. Supp. 658, 663 (S.D.N.Y. 1988). After the enactment, because there was a specific provision in the Copyright Act for architectural works, the “separability” element was avoided. H.R. REP. No. 101-735, at 19 (1990), reprinted in 1990 U.S.C.A.N. 6935, 6951.

## IV. FASHION DESIGNS SHOULD BE PROTECTED

Fashion designs should be protected in the United States. Fashion designs are a form of art, and thus should be entitled to protection, as are other works of art. Further, by protecting fashion designs, the United States will be able to preserve competitive markets by encouraging creativity within its borders. Offering protection for fashion designs will also put the United States in a better position to compete with an international market that already offers protection for fashion designs.

A. *Fashion Designs as Art*

Fashion designers are artists and the medium that they work with is clothing. Unfortunately for the designers, clothing, unlike art, has a utilitarian purpose, and thus is not given the same protection that artwork is given. Fashion design, however, is increasingly merging with artwork. Therefore, fashion designs, like art, should be granted protection from piracy.

Exhibits in world renowned museums have displayed works of art by fashion designers. The Guggenheim Museum in New York had an exhibit displaying designs by Giorgio Armani.<sup>148</sup> The exhibition offered a look into the designer's evolution and contribution to fashion over the last 25 years and featured daywear, evening wear, and costumes.<sup>149</sup> In 2001, with an unprecedented special exhibition, the Metropolitan Museum of Art (Met) in New York displayed the "iconic fashion" of Jacqueline Kennedy.<sup>150</sup> Over 80 items of clothing and accessories were on view.<sup>151</sup> The Met even has a permanent collection in its Costume Institute, which is in possession of over 75,000 costumes and accessories from seven centuries and five continents.<sup>152</sup> The Costume Institute includes articles of haute couture,<sup>153</sup> postwar American sportswear, and contemporary fashions.<sup>154</sup>

Not only have museums begun to feature exhibits containing fashion works, but museums dedicated to fashion have also begun to emerge in fashion capitals around the world. London's first museum dedicated to the global

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<sup>148</sup> GUGGENHEIM MUSEUM, GIORGIO ARMANI, at [http://guggenheim.org/exhibitions/past\\_exhibitions/armani/](http://guggenheim.org/exhibitions/past_exhibitions/armani/) (last visited Nov. 8, 2003). The Guggenheim Museum celebrated Giorgio Armani as one of the most influential fashion designers of the twentieth century. *Id.*

<sup>149</sup> *Id.*

<sup>150</sup> THE METRO. MUSEUM OF ART, JACQUELINE KENNEDY: THE WHITE HOUSE YEARS—SELECTIONS FROM THE JOHN F. KENNEDY LIBRARY AND MUSEUM, at [http://www.metmuseum.org/special/se\\_event.asp?OccurrenceId={ACBF8E12-B196-11D4-93B6-00902786BF44}](http://www.metmuseum.org/special/se_event.asp?OccurrenceId={ACBF8E12-B196-11D4-93B6-00902786BF44}) (last visited Nov. 7, 2003).

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

<sup>152</sup> THE METRO. MUSEUM OF ART, THE COSTUME INSTITUTE, at <http://www.metmuseum.org/collections/department.asp?dep=8> (last visited Nov. 8, 2003).

<sup>153</sup> Haute couture literally means "high tailoring" in French and refers to handmade clothing tailored to the client and styled to her taste. Hetherington, *supra* note 11, at 46 n.11. The resulting design is considered fashion at its most elevated art form. *Id.*

<sup>154</sup> THE METRO. MUSEUM OF ART, *supra* note 152.

fashion industry's achievements opened in 2003.<sup>155</sup> Likewise, Japan's Kobe Fashion museum is the first museum in Japan to specialize in fashion.<sup>156</sup> Although the exhibition of fashion designs in museums does not necessarily make the designs art, it emphasizes the idea that fashion designs are something more than mere useful articles.

In addition to museums displaying clothing, high-end fashion design houses have begun to sell their clothing in museum-like stores. The Prada store in New York City is more like a museum than a store. Clothes are displayed in a series of aluminum mesh cages hanging from the ceiling and there is a curving floor running from street level to the basement which serves as a shoe display and a performance area.<sup>157</sup> The Prada store even offers a coat check.

Collaborations between artists and design houses have become a very stylish thing to do as well. In 2002, artist Takashi Murakami and designer Marc Jacobs collaborated on a series of hand bags for the luxury fashion firm, Louis Vuitton.<sup>158</sup> The response to these specially designed bags has been phenomenal, as evidenced by sales which generated over \$40 million in less than seventeen months.<sup>159</sup> Other fashion designers, including Jean Patou, Gabrielle Chanel, and Elsa Schiaparelli, undertook collaborations with contemporary artists at some time during their careers.<sup>160</sup> In addition, many artists do not see their designs as fashions. Manolo Blahnik has stated that his "shoes are not fashion. They are gestures; objects that happen to be fashion."<sup>161</sup>

It is unfair for the law to selectively protect works of art. Artwork is protected under copyright law as "pictorial, graphic, and sculptural works."<sup>162</sup> Further, courts do not judge the artistic merits of a work. So long as the work meets a de minimis level of creativity, it may be protected.<sup>163</sup> The vast majority

<sup>155</sup> *Fashion Museum Breaks New Ground*, CNN.COM, May 12, 2003 at <http://www.cnn.com/2003/WORLD/europe/05/12/design360.fashion.museum>.

<sup>156</sup> KOBE FASHION MUSEUM, at <http://www.city.kobe.jp/cityoffice/17/010/english/spot/fashion.html> (last visited Nov. 8, 2003).

<sup>157</sup> Hillary Lobo et al., *Prada Epicenter, New York*, ARUP J., Jan. 2003, at 21, <http://www.arup.com/journal.cfm>.

<sup>158</sup> Kate Betts, *The School of Cool: With His Thrift-Store Style and Sexy Silhouettes, Marc Jacobs Has Become American Fashion's Go-To Guy*, TIME, Feb. 23, 2004, at 58; *Malletier v. Dooney & Bourke, Inc.*, 340 F.Supp. 2d 415, 424-25 (S.D.N.Y. 2004).

<sup>159</sup> *Malletier*, 340 F. Supp. 2d at 426.

<sup>160</sup> A & L TIROCCHI DRESSMAKERS PROJECT, THE RISD MUSEUM, FROM PARIS TO PROVIDENCE: THE TIROCCHI SHOP AND THE ART WORLD, at [http://tirocchi.stg.brown.edu/exhibition/intro/fash\\_txt.html](http://tirocchi.stg.brown.edu/exhibition/intro/fash_txt.html) (last visited Jan. 31, 2004).

<sup>161</sup> Jae-Ha Kim, *Well-Heeled Stars Love Their Manolos*, CHI. SUN TIMES, Aug. 30, 2000, at 2000 WLNR 4272374; see also MANOLO BLAHNIK, MANOLO BLAHNIK: DRAWINGS 130 (2003). Manolo Blahnik has been a shoe designer for over 30 years. His shoes have been praised as "better than sex" by Madonna, and Sarah Jessica Parker was wearing his shoes up until the day before she gave birth. *High on Heels*, OBSERVER MAG., Jan. 12, 2003, at <http://observer.guardian.co.uk/magazine/story/0,11913,873004,00.html>.

<sup>162</sup> 17 U.S.C. § 102 (2000). "'Pictorial, graphic, and sculptural works' include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans." 17 U.S.C. § 101 (2000).

<sup>163</sup> *Mattel, Inc. v. Goldberger Doll Mfg. Co.*, 365 F.3d 133, 135 (2d Cir. 2004).

of works easily meet this de minimis creativity threshold of copyright law,<sup>164</sup> therefore most works of applied art will be protected under copyright law. Fashion designing is a form of art that requires more than the minimal level of creativity needed for copyright protection. Consequently, fashion designs should be granted the same protection as other forms of art. As fashion designers and artists continue to collaborate on fashion designs, there is hope that fashion designs will increasingly be viewed as more than just useful articles and therefore worthy of protection.

#### B. Competitive Markets

Designers that design and introduce new products into the market have higher costs of production than their competitors. Since a company that pirates others' designs does not have the higher designing costs, that company can afford to sell its products at a lower cost. This can cause problems for the company that creates designs because it will be forced to lower its prices due to the competition, thus making its venture less profitable and lessening the incentive to create its own designs.

This exact dynamic played out in *Knitwaves, Inc. v. Lollytogs Ltd.*<sup>165</sup> Knitwaves, a small business, designs its own new products, spending over \$1 million a year designing those products.<sup>166</sup> As a result of its decision to introduce new products into the market, rather than pirating others' designs, Knitwaves's costs are higher than those of its competitors.<sup>167</sup> Its commercial viability is dependent on its reputation for innovative designs and high quality manufacturing.<sup>168</sup> Although this would seem to encourage Knitwaves to produce new designs to get a competitive edge, in this case, the direct competition from Lollytogs, which pirated Knitwaves's designs, caused Knitwaves to reduce its prices, resulting in lost profits.<sup>169</sup>

If new designers continually have their designs knocked off and suffer commercial or economic stress, eventually there may be no incentive to create new designs. Francesca Sterlacci, the chairperson of the Fashion Design School at New York's Fashion Institute of Technology, has stated that it is cheaper and easier to simply knock off new designs, while it is expensive and risky to actually create them.<sup>170</sup> Sterlacci believes that designers usually overlook the

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

<sup>165</sup> 71 F.3d 996 (2d Cir. 1995).

<sup>166</sup> *Id.* at 999. Knitwaves is a clothing manufacturer that sued another corporation for trade dress infringement and copyright infringement. *Id.* The items in question for infringement in this case were two sweaters, one with a leaf motif and one with a squirrel motif. *Id.*

<sup>167</sup> *Id.* at 1000.

<sup>168</sup> *Id.*

<sup>169</sup> *Id.*

<sup>170</sup> *Fashion Industry Copes with Designer Knockoffs: With Copyright Protection Elusive, Copies are Common*, NPR, Sept. 18, 2003, at [http://www.npr.org/display\\_pages/features/feature\\_1434815.html](http://www.npr.org/display_pages/features/feature_1434815.html).

copying because new designs come out every few months and “you’re never really sure whether or not you’re going to win” a lawsuit.<sup>171</sup>

C. *The Berne Convention and the European Union*

The Berne Convention for the Protection of Literary and Artistic Works (Berne Convention) requires its member states to provide copyright protection to authors of other member states.<sup>172</sup> The Berne Convention also imposes certain minimal requirements of copyright laws for its member states.<sup>173</sup> Although the Berne Convention does not explicitly require protection for fashion designs, other member countries do provide for protection. Therefore, the United States should use this fact as incentive to establish protection for its own citizens.

The United States became a party to the Berne Convention in 1989.<sup>174</sup> However, the United States does not provide the same standards of protection as do other signatories of the Berne Convention. Both the United Kingdom and France have copyright laws that specifically provide protection for fashion designs.<sup>175</sup> Therefore, because the United States does not provide this protection to its own citizens, U.S. based fashion designers are granted more protection for their designs abroad than they are at home and international designers who are granted protection abroad are not granted protection in the United States.<sup>176</sup>

The United States should provide protection for its fashion designs to put its designers on an equal playing field with those in the other member states of the Berne Convention, particularly the members of the European Union. By denying this protection, the United States is only harming the fashion industry in its own country. American designers are finally getting the recognition they deserve, but mostly abroad where established European fashion houses are recognizing the role their talent can play in the international market.<sup>177</sup> Thus, it makes sense that American designers are going abroad to have their skills recognized.<sup>178</sup>

France, the home of many of the international fashion powerhouses, offers fashion design protection for its citizens.<sup>179</sup> In 1994, Yves Saint Laurent (YSL),

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<sup>171</sup> *Id.*

<sup>172</sup> Berne Convention for the Protection of Literary and Artistic Works, revised July 24, 1971, amended 1979, S. TREATY DOC. No. 99-27, art. 5, para. 3 (1986). Therefore, “when the author is not a national of the country of origin of the work for which he is protected under this Convention, he shall enjoy in that country the same rights as national authors.” *Id.*

<sup>173</sup> Bharathi, *supra* note 10, at 1675.

<sup>174</sup> Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 1988 U.S.C.A.N. (102 Stat.) 2853; ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 369 (3d. ed. 2003).

<sup>175</sup> Bharathi, *supra* note 10, at 1676.

<sup>176</sup> *Id.*

<sup>177</sup> Virginia Brown Keyder, *Design Law in Europe and the US*, ITAA PROC., at <http://www.itaaonline.org/ITAAnew/Proceedings/012.html> (last visited Sept. 23, 2003).

<sup>178</sup> *Id.*

<sup>179</sup> Bharathi, *supra* note 10, at 1676.

a top Paris fashion house, sued American designer Ralph Lauren for copying its popular tuxedo dress.<sup>180</sup> A French court found that Lauren's \$1,000 interpretation of YSL's \$15,000 dress was a copy. Although there was no redress for YSL in the United States, Lauren, a New York-based designer, was fined \$383,000 in France.<sup>181</sup>

By providing U.S. based fashion designers the same protection as designers obtain abroad, the United States will encourage the growth of small businesses in a multi-billion dollar industry. Moreover, U.S. designers will be less likely to take their designs and creations abroad to get the protection that they deserve here.

## V. RECOMMENDED SOLUTION

The European Union (EU) has recently begun to offer design protection in the form of registered and unregistered Community Designs.<sup>182</sup> The Community Designs are set up to serve industries that need immediate, relatively simple to enforce, low cost protection against copying and the option of longer term, exclusive right protection.<sup>183</sup> The practical design system also includes suggestions for other countries to consider in improving their own design protection.<sup>184</sup> Further, EU design law is increasingly being used as the model of legal reform throughout the world.<sup>185</sup> Since the United States has failed to implement its own design protection right, the United States should follow in the footsteps of the EU to provide this right, which serves as an effective means to protect fashion designs.

### A. Overview of Design Protection in the European Union

On January 1, 2003, acceptance of applications of the new registered Community Designs began and those applications appeared on the register in April of that year.<sup>186</sup> For the first time, there was a form of uniform and unitary design protection in the EU.<sup>187</sup> The registration process is simple and quick, with only application formalities and general compliance with the law

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<sup>180</sup> Agins, *supra* note 19, at A1.

<sup>181</sup> *Id.* YSL is an example of the circular nature of design piracy. Several years before its suit against Lauren, in 1985, YSL was itself fined \$11,000 in a French court for copying a toreador jacket by designer Jacques Esterel. *Id.*

<sup>182</sup> OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET, TRADE MARKS AND DESIGNS, COMMUNITY DESIGN, at <http://oami.eu.int/en/design/default.htm> (last visited Feb. 25, 2005).

<sup>183</sup> William T. Fryer, III, *European Union (EU) Revolutionizes General Industrial Design Protection*, 84 J. PAT. & TRADEMARK OFF. SOC'Y 899, 899 (2002).

<sup>184</sup> *Id.*

<sup>185</sup> Keyder, *supra* note 177.

<sup>186</sup> *First Registered Community Designs Proceed to Registration*, IP/IT NEWS (Davenport Lyons), Summer 2003, at 3, available at [http://www.davenportlyons.com/www/publications/dldotcom/it\\_newsletter\\_summer2003.pdf](http://www.davenportlyons.com/www/publications/dldotcom/it_newsletter_summer2003.pdf).

<sup>187</sup> *Id.*

reviewed.<sup>188</sup> Initial registration lasts for five years, with four five-year renewal terms available.<sup>189</sup> The date of registration is the date of filing, and upon registration there is automatic protection in every state.<sup>190</sup> There are no restrictions on who can apply and individuals can file any number of designs in one multiple application; the multiple designs do not have to be used together or look similar.<sup>191</sup> Registered designs are published bi-monthly in the 11 official languages of the EU in the *Community Design* bulletin.<sup>192</sup> The bulletin will eventually lead to a searchable database.<sup>193</sup>

“Design” is defined broadly as “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture, and/or materials of the product itself and/or its ornamentation.”<sup>194</sup> Registered designs must be new and give a different overall impression from known designs.<sup>195</sup> It is unnecessary for the design to have aesthetic quality, but it must be visible in normal use.<sup>196</sup> Registered designs are given an “exclusive right to use and prevent making, offering, putting on the market, importing, exporting, using or stocking for such purposes, products incorporating the design, which do not produce a different overall impression.”<sup>197</sup> Therefore, registered designs may be infringed regardless of independent creation.<sup>198</sup>

Unregistered Community Designs protect the same features as registered designs, but last for a shorter period.<sup>199</sup> Unregistered designs are provided automatic short-term protection for designs that would qualify for registration.<sup>200</sup> There is an automatic design right when a new design is made public in the EU.<sup>201</sup> This right lasts for three years from the date that the design

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<sup>188</sup> Fryer, *supra* note 183, at 900. Registration can be obtained in as little as a month. SERJEANTS, DESIGNS & COPYRIGHT, at <http://www.serjeants.co.uk/pages/copy.htm> (last revised July 2003).

<sup>189</sup> Mauro Paiano & Ann Critchell-Ward, *The Harmonization of Intellectual Property Rights Throughout the European Union*, N.J. LAW., Oct. 2003, at 36, 39.

<sup>190</sup> *First Registered Community Designs Proceed to Registration*, *supra* note 186; Paiano & Critchell-Ward, *supra* note 189, at 39.

<sup>191</sup> Paiano & Critchell-Ward, *supra* note 189, at 39.

<sup>192</sup> *Id.* However, publication may be delayed for up to 30 months for those who wish to keep their designs confidential until they are ready to disclose them. OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET, TRADE MARKS AND DESIGNS, THE REGISTERED COMMUNITY DESIGN, at <http://oami.eu.int/en/design/pdf/leaflet1.pdf> (last visited Feb. 25, 2005).

<sup>193</sup> Paiano & Critchell-Ward, *supra* note 189, at 39.

<sup>194</sup> EUROPEAN UNION LAW GUIDE: INTELLECTUAL PROPERTY LAW Tit. II, § 1, art. 3(a), at 6 (Phillip Raworth ed.) (2003).

<sup>195</sup> SERJEANTS, *supra* note 188.

<sup>196</sup> *Id.*

<sup>197</sup> OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET, TRADE MARKS AND DESIGNS, FREQUENTLY ASKED QUESTIONS ON THE COMMUNITY DESIGN, at <http://oami.eu.int/en/design/faq.htm#20> (last visited Feb. 25, 2005).

<sup>198</sup> SERJEANTS, *supra* note 188.

<sup>199</sup> Paiano & Critchell-Ward, *supra* note 189, at 39.

<sup>200</sup> SERJEANTS, *supra* note 188.

<sup>201</sup> Paiano & Critchell-Ward, *supra* note 189, at 39.

was first made available to the public.<sup>202</sup> Unregistered designs may only be infringed by copying; there is no recourse for independent creation.<sup>203</sup>

*B. Design Protection as a Model for the United States*

The United States should use the European Union's registered and unregistered Community Designs as a model for its own design legislation. The EU community design regulation is a major achievement for improved industrial design protection and the United States should follow the trend.<sup>204</sup>

Although the United States does not have specific design protection legislation, at various times Congress has considered proposals to protect designs with copyright.<sup>205</sup> For example, as part of the Digital Millennium Copyright Act of 1998, Congress passed the Vessel Hull Design Protection Act, which provided *sui generis* protection for original designs of watercraft hulls and decks.<sup>206</sup> The designs of semiconductors were also granted *sui generis* protection in 1984 and the Copyright Act was even amended in 1990 to specifically include designs of architectural works.<sup>207</sup> Therefore, Congress is not completely opposed to design protection legislation; the United States just needs a little guidance in the right direction. The guidance is available, as exemplified by the EU's design protection legislation as discussed above. The United States should use this example to bring its own intellectual property laws forward into a new millennium.

By doing this, the United States will also continue to break down trade barriers created by its own intellectual property laws. More foreign based designers may be inclined to bring their talents to the United States if they were granted protection, resulting in an increase in commerce, as well as employment opportunities in the United States. Under current U.S. law, if a foreign designer decides to market his designs in the United States, he stands to have his designs freely and openly copied, with very little legal recourse. Thus, there is no incentive for foreign designers to bring their talents to the United States. Further, American designers are taking advantage of the design protection laws abroad<sup>208</sup> and increasingly going abroad to have their designs and talents protected.<sup>209</sup> The United States should provide its designers some

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<sup>202</sup> *Id.* A design is made available to the public when it is disclosed in any way, except when the disclosure could not have become known to the people working in the relevant field in the EU. *Id.*

<sup>203</sup> *Id.*

<sup>204</sup> Fryer, *supra* note 183, at 903.

<sup>205</sup> MERGES ET AL., *supra* note 174, at 363 n.6.

<sup>206</sup> Vessel Hull Design Protection Act, Pub. L. 105-304 as codified in 17 U.S.C. §§ 1301–1332 (2000).

<sup>207</sup> *See supra* Part II; Semiconductor Chip Protection Act of 1984, 17 U.S.C. §§ 901–914 (2000); 17 U.S.C. § 1101 (2000).

<sup>208</sup> Paiano & Critchell-Ward, *supra* note 189, at 39. Currently about seven percent of new filings are from the U.S. and this number is increasing as benefits of community design protection become more apparent and understanding grows as to how the new system works. *Id.*

<sup>209</sup> Keyder, *supra* note 177.

protection at home to discourage them from leaving the United States and taking their talents abroad.

The EU scheme of registered and unregistered Community Designs is a good model for the United States to use. For registered designs, the quick and simple registration process would be beneficial to fashion designers because fashion trends come and go quickly. The only potential problem with using registered designs to protect fashion designs, however, is that the five-year duration of protection would be unnecessarily lengthy, given the short life span of fashion designs. On the other hand, an unregistered design right would be ideal for protection of fashion designs. The unregistered designs, which protect the same features as registered designs, provide automatic short term protection for three years from the date it was made available to the public. The automatic protection would alleviate any concerns regarding the short life span of fashion designs, as the fashion designer would not have to go through any registration process. Also, the shorter period of protection would be more appropriate, as fashions vary from season to season. The United States should therefore adopt the EU's model of registered and unregistered Community Designs to provide design protection to its fashion designers.

## VI. CONCLUSION

Fashion and clothing design is very much a part of the American culture. When something permeates every aspect of popular culture the way that fashion does, there should be legislation to protect and encourage it.<sup>210</sup>

Fashion designs should have their niche in intellectual property protection. Shoes and handbags have found their place in design patents and trademark/trade dress, respectively; clothing designs should logically follow. Although the current intellectual property regime in the United States does not comport with offering protection to clothing designs, it is possible. By using the EU scheme as the model of design protection in the United States, the United States will be one step closer to promoting the interests of fashion designers.

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<sup>210</sup> Fashion shows are like concerts, where a front row seat is always coveted. There is always coverage of fashion shows; some are even telecast (Victoria's Secret). Television shows such as *Fashion Emergency* and *Style Court* are a further indication of fashion's influence in popular culture. Some people, including Joan and Melissa Rivers, have gone so far as to make careers out of broadcasting what other people are wearing. There is even a television channel, Fashion TV, that dedicates itself to fashion coverage 24 hours a day, 7 days a week, including interviews with designers and broadcasting fashion shows.