Tearing Fashion Design Protection Apart at the Seams

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Tearing Fashion Design Protection Apart at the Seams†

Lisa J. Hedrick*

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I see. You think that [fashion] has nothing to do with you. You go to your closet and you select...that lumpy blue sweater.... But what you don’t know is that that sweater is not just blue. It’s not turquoise. It’s not lapis. It’s actually cerulean. And you’re also blithely unaware of the fact that in 2002, Oscar de la Renta did a collection of cerulean gowns. And then I think it was Yves Saint Laurent, wasn’t it, who showed cerulean military jackets?... And then cerulean quickly showed up in the collections of eight different designers. And then it, uh, filtered down through the department stores and then trickled on down into some tragic Casual Corner where you, no doubt, fished it out of some clearance bin. However, that blue represents millions of dollars and countless jobs and it’s sort of comical how you think that you’ve made a choice that exempts you from the fashion industry when, in fact, you’re wearing a sweater that was selected for you by the people in this room...

—Miranda Priestly, The Devil Wears Prada

I. Introduction

While Miranda Priestly’s self-important observation in the recent 20th Century Fox film, The Devil Wears Prada, certainly elicits the desired laughter from the viewing audience, it also highlights the influential impact that haute couture fashion designers have on clothing trends. In a country that has a well developed system of copyright, trademark, and patent protection and actively punishes violations of those protections, one would expect protection for fashion creations. Thus, the ease with which designers can pass fashion trends to mass consumers may come as a surprise. Fashion designs fall into

1. THE DEVIL WEARS PRADA (20th Century Fox 2006).
2. See Kal Raustiala & Christopher Sprigman, The Piracy Paradox: Innovation and Intellectual Property in Fashion Design, 92 VA. L. REV. 1687, 1691 (2006) ("Design copying is occasionally complained about, but it is as often celebrated as ‘homage’ as it is attacked as ‘piracy.'").
3. See 17 U.S.C. § 106 (2000) (giving the copyright owner exclusive right to reproduce, distribute, and display the copyrighted work and the right to authorize others to reproduce, distribute, and display). Thus, in order to copy something that is copyrighted, one must obtain permission from the copyright owner unless one of the exceptions to copyright applies. See id. § 501 (defining a copyright infringer as someone who violates the rights of the copyright
intellectual property's "negative space" and derive virtually zero benefit from current legal protections. This lack of protection allows a "design pirate" to look at a photograph or display of a $600 Oscar de la Renta pump, make an exact replica, and sell the shoe on the mass market without violating any law, with very few exceptions.

Without protection, designers can do very little to "prevent the rampant piracy of their fashion designs." Such piracy allegedly harms the designer "because these knockoffs are usually of such poor quality[;] these reproductions not only steal the designer's profits, but also damage his or her reputation." Further, evidence

owner); see also id. §§ 107–112 (listing exceptions to the exclusive rights of a copyright owner).

4. See Raustiala & Sprigman, supra note 2, at 1764 ("The fashion industry is interesting because it is part of IP's 'negative space.' It is a substantial area of creativity into which copyright and patent do not penetrate and for which trademark provides only very limited propertization."). Fashion designers are able to obtain minimal copyright protections through the idea of conceptual separability; however, such protection is difficult to obtain and only applies to portions of fashion designs, as opposed to the entire design. See infra Part II.B (discussing the difficulties in obtaining copyright protection for articles of apparel); see also 17 U.S.C. § 101 (excluding articles that are useful from copyright-eligible "pictorial, graphic, and sculptural works"); infra notes 74–75 and accompanying text (discussing the categorical treatment of clothing as "useful"). This Note adopts the definition of "fashion design" as proposed by House Bills 2033 and 5055 and Senate Bill 1957. See infra notes 21–23 and accompanying text (setting forth relevant definitions).

5. There are possibly some infringements that could arise given a particular set of circumstances. For example, if Oscar de la Renta consistently uses a particular design aspect so that the design rises to level of a trademark, copying such an element could be deemed a trademark infringement. See infra Part II.A.2 (discussing trademark law and its application to the fashion industry). Additionally, if a shoe or fashion item makes use of, or is created through, a "new and useful process," the item or process may qualify for patent protection, creating legal consequences for infringement. 35 U.S.C. § 101; see also infra Part II.A.1 (discussing the application of patent law protection to the fashion industry).


7. A Bill to Provide Protection for Fashion Design, supra note 6, at 4 (opening statement
suggests that design piracy results in an estimated $12 billion worth of loss to the fashion industry. These arguments convinced Congress in 2006 to consider the creation of three years of copyright-like protection for original fashion designs. Though this bill, House Bill 5055, died at the end of the 109th Congress in December 2006, Representative Delahunt reintroduced an identical bill in April 2007, House Bill 2033, and Senator Schumer introduced a similar bill in August 2007, Senate Bill 1957 (collectively, the Design Piracy Bills). This Note does not intend to suggest that fashion design protection is necessarily desirable. Protection may not even be essential to ensure ongoing innovation and development given that annual sales in the U.S. fashion industry increased from approximately $130 billion to over $200 billion over the past decade. Further, fashion design protection would likely create more

of Rep. Bob Goodlatte, Member, Subcomm. on Courts, the Internet, and Intellectual Property).

8. Id. at 2 (opening statement of Rep. Howard L. Berman, Ranking Member, Subcomm. on Courts, the Internet, and Intellectual Property).


10. As of January 2007, the last action taken on the bill was a hearing in the House Subcommittee on Courts, the Internet, and Intellectual Property, held July 27, 2006. See 2006 Bill Tracking H.R. 5055 (LEXIS) (providing general information regarding the progress of the bill). For a discussion of other efforts for the enactment of design protection, see infra notes 105–15 and accompanying text. In a March 2007 telephone conversation, Steven Kolb, Executive Director of the Council of Fashion Designers of America, indicated that he hoped to see a bill similar to House Bill 5055 introduced during the 110th Congress. Telephone Interview with Steven Kolb, Executive Dir., Council of Fashion Designers of Am., in New York, N.Y. (Mar. 1, 2007) (stating that the Council is still working with a bipartisan group from Congress on a bill for fashion design protection). Mr. Kolb’s hopes were realized in April 2007 when the House introduced an identical bill to House Bill 5055. Infra notes 11–12 and accompanying text.

11. H.R. 2033, 110th Cong. (2007). The only difference between House Bill 2033 and House Bill 5055 is that House Bill 2033 names the proposed legislation the “Design Piracy Prohibition Act.” Id. § 1.

12. S. 1957, 110th Cong. (2007). The Senate bill is identical to the House bill with the exception of the section on infringement. See id. § 2(d)(2) (proposing several amendments to 17 U.S.C. § 1309). The Senate bill is also entitled the “Design Piracy Prohibition Act.” Id. § 1.

13. Because of their similarities, House Bills 5055 and 2033 and Senate Bill 1957 will be collectively referred to as the Design Piracy Bills. Where differences are important, each bill will be referenced separately by its number. Additionally, discussion and hearing testimony regarding House Bill 5055 is pertinent to the analysis of House Bill 2033 and Senate Bill 1957 because the substance of the bills remains primarily unchanged.

14. For a discussion of how copying of designs is beneficial to the fashion industry, see infra notes 261–62 and accompanying text.

15. See U.S. CENSUS BUREAU, 2006 ANNUAL REVISION OF MONTHLY RETAIL AND FOOD SERVICES 3 tbl.2, available at http://www.census.gov/mrts/www/data/pdf/annpub 06.pdf (reporting that clothing and accessory sales in 1995 totaled nearly $131.6 billion). In 2005, this number rose to $201.7 billion. Id. at 4 tbl.2. But see A BILL TO PROVIDE PROTECTION FOR FASHION DESIGN, supra
TEARING FASHION DESIGN PROTECTION APART AT THE SEAMS

trouble than value because "fashion design" is hard to define and equally difficult to protect. Yet, the repeat appearance of fashion design protection on the congressional radar and the increased interest in the popular press suggest that more attention will be given to the Design Piracy Bills. Congress should fully consider the consequences of enacting fashion design protection. Should Congress enact such protection, other creative industries in the negative space—such as food, furniture, and automobiles—may also seek protection, and fashion design protection will become the model for a great expansion of current intellectual property law.

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16. See infra notes 264–66 and accompanying text (discussing the lack of clarity in the definition of "fashion design"); see also infra notes 267–87 (discussing the difficulties in applying fashion design protection because of the difficulties in determining infringement).

17. The failure of House Bill 5055 can be partially attributed to Congress's failure to do much of anything. See, e.g., Deborah Barfield Berry, Congress Wraps up 109th Session with Much Unfinished Business, GANNETT NEWS SERVICE, Dec. 9, 2006 ("[U]nlike previous sessions, this one has met fewer days and has been bogged down with corruption scandals and the Iraq war.").


19. As of February 2008, neither of the two active Design Piracy Bills has progressed very far. See 2007 Bill Tracking H.R. 2033 (LEXIS) (noting the last action taken on the bill was referral to the House Committee on the Judiciary on April 25, 2007); 2007 Bill Tracking S. 1957 (LEXIS) (noting the last action taken on the bill was referral to the Senate Committee on the Judiciary on August 2, 2007). The Subcommittee on Courts, the Internet, and Intellectual Property of the House Committee on the Judiciary held a hearing on design law on February 14, 2008; however, there has been no bill markup or vote. U.S. House of Representative Comm. on the Judiciary, Hearing Information, Hearing on Design Law: Are Special Provisions Needed to Protect Unique Industries?, http://judiciary.house.gov/oversight.aspx?ID=412 (last visited Feb. 17, 2008) (on file with the Washington and Lee Law Review).

20. Such a claim is not farfetched. In June 2007, a New York City restaurant filed suit against another restaurant claiming that it copied every element in the restaurant—from the bar stools to the Caesar dressing. See Pete Wells, Chef Sues over Intellectual Property (the Menu), N.Y. TIMES, June 27, 2007, at A1 (reporting the lawsuit). Additionally, though the transcript of
The inadequacy of current intellectual property protections with regard to fashion reveals the consequences of fashion design protection. Part II of this Note surveys the current intellectual property scheme in the United States, including the failure of Congress and the courts to extend design protection to "useful articles." Because current protections are not sufficient, Part III outlines the protection proposed under the Design Piracy Bills and the protections already in place in Japan and the European Union. Finally, Part IV looks at the mechanical problems of enacting fashion design protection and suggests improvements to the Design Piracy Bills should Congress seriously consider this legislation. Ultimately, however, this Note cautions against adding copyright protection for fashion designs because such protection would potentially harm, rather than help, designers.

The specialized nature of fashion design protection requires clear definitions of "fashion design," "design," and "apparel." The Design Piracy Bills define these terms as follows:

- Fashion design—"the appearance as a whole of an article of apparel, including its ornamentation."

- Design—"includes fashion design, except to the extent expressly limited to the design of a vessel."

- Apparel—"(A) an article of men's, women's, or children's clothing, including undergarments, outerwear, gloves, footwear, and headgear; (B) handbags, purses, and tote bags; (C) belts; and (D) eyeglass frames."

As discussed below, these ambiguous definitions are one reason the Design Piracy Bills fail to offer effective protection to fashion designers.

Finally, one additional distinction is necessary: This Note focuses on fashion copying, not counterfeiting. Fashion counterfeiting is a clear violation of trademark law because it involves the attachment of an
identifying mark to an item without permission to attach such mark. For example, if a design pirate exactly replicated the $600 Oscar de la Renta shoe mentioned above, the reproduction is a counterfeit if the pirate also includes, without permission, Oscar de la Renta's signature mark. If the pirate's own mark or label is attached to the shoe, however, the shoe is not a counterfeit item nor in violation of any other protective law and can be mass manufactured and sold. The discussion that follows assumes that design pirates are not counterfeiting trademarks or running afoul of the law in any other manner.

II. The Current State of Intellectual Property Law

The current intellectual property mechanisms of patent, trademark, trade dress, and copyright are incapable of providing protection for fashion design. Under the current scheme, protection for apparel is usually accomplished through conceptual separability. This doctrine, however, has created confusing litigation and leaves the vast majority of apparel designs unprotected. Without statutory support for protection, courts have been unable and unwilling to expand protection to clothing articles, all the while suggesting that parties petition Congress for added protections. Despite several congressional attempts at amending copyright law to protect otherwise nonprotectable designs, protection for fashion and other products of design has never materialized.

24. See 18 U.S.C. § 2320 (2000) (criminalizing the use of a counterfeit mark on or in association with any good or service). Under the statute, a "counterfeit mark" is basically a fake mark that is "identical with, or substantially indistinguishable from" a registered mark or a phony mark, "which is likely to cause confusion, to cause mistake, or to deceive." Id. § 2320(e)(1)(A)(ii), (iv).

25. There is no counterfeit violation if the producer has obtained proper authorization to use the mark. See id. § 2320(e)(1)(B) (exempting from the definition of "counterfeit mark" those marks used upon the grant of permission by the holder of the trademark rights). A trademark holder also has the right to control the quality of the good produced under the holder's mark. See United States v. Farmer, 370 F.3d 435, 441 (4th Cir. 2004) ("One of the rights that a trademark confers upon its owner is "the right to control the quality of the goods manufactured and sold" under that trademark." (quoting Shell Oil Co. v. Commercial Petroleum, Inc., 928 F.2d 104, 107 (4th Cir. 1991))).

A. Failure of Intellectual Property Law to Protect Fashion Designs

Under current intellectual property law, fashion designers can rarely find effective protection for their apparel creations. Patent protection is largely unavailable because of the length of time required to obtain a patent and because of the stringent prerequisites of novelty and nonobviousness. Trademark is applicable to the fashion industry because most designers register their logos or signature marks; but trademark protection is unavailable for fashion designs. Similarly, trade dress protection, a subset of trademark protection, provides no remedy because fashion designs are functional. The functionality of fashion designs also precludes them from copyright protection, which is not applicable to "useful articles."  

1. Patent Law

There are three types of patents currently available—utility, plant, and design. Utility patents are available to anyone who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." While apparel is unable to obtain copyright protection primarily because it is "useful," apparel’s usefulness

27. See A Bill to Provide Protection for Fashion Design, supra note 6, at 2 (opening statement of Rep. Lamar Smith, Chairman, Subcomm. on Courts, the Internet, and Intellectual Property) (arguing that new designers are harmed because fashion designs are virtually excluded from all types of legal protection).

28. See id. at 3 (opening statement of Rep. Howard L. Berman, Ranking Member, Subcomm. on Courts, the Internet, and Intellectual Property) (stating that the typical lifespan of a fashion design is three to six months and the process to register a patent is much longer).

29. See id. ("[T]rademark law protects the elements of a design that indicate the source of the product, but does not provide general protection for designs.").

30. See infra notes 65–67 and accompanying text (requiring the additional showing of nonfunctionality in order to obtain trade dress protection).

31. See infra notes 74–75 and accompanying text (providing information on the indisputable recognition by the courts and the U.S. Copyright Office that clothing is useful and thus exempt from copyright protection).

32. See 1 DONALD S. CHISUM, CHISUM ON PATENTS § 1.01 (2007) [hereinafter CHISUM ON PATENTS] (summarizing available patent protections). It is unnecessary to discuss plant patent protection in this Note for the obvious reason that apparel will never meet the requirements for a plant patent. See 35 U.S.C. § 161 (2000) (allowing plant patents for any "distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings").


34. See infra notes 74–75 and accompanying text (describing the categorical exclusion of clothing from copyright protection).
argues in favor of protection under a utility patent. There are two other requirements for securing a utility patent: (1) the invention must be novel and (2) the invention must be nonobvious. To be novel, an invention cannot be known or used by others in the United States, or patented in another country, prior to filing for patent protection. The standard for determining nonobviousness is whether the invention would "have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Because so many apparel designs are reworkings and are not 'new' in the sense that the patent law requires," it is unlikely that new fashion designs will be novel or nonobvious enough to meet the statutory qualifications for utility patent protection.

Design patents offer another potential vehicle for protection. Design patents are issued for any "new, original, and ornamental design for an article of manufacture." But articles must still satisfy the novelty and nonobvious requirements in order to receive design patent protection. Even if those requirements are not the death knell for design patent protection, the article also must be ornamental and not merely functional.

35. See 1 CHISUM ON PATENTS, supra note 32, § 4.01, at 4-4 ("The utility requirement means that an invention must perform some function of positive benefit to society."). In order to meet the requisite utility necessary for a patent, there are three tests: "First, it must be operable and capable of use. It must operate to perform the functions and secure the result intended. Second, it must operate to achieve some minimum human purpose. Third, it must achieve a human purpose that is not illegal, immoral, or contrary to public policy." Id.

36. See 35 U.S.C. § 102 (setting forth the patent requirement of novelty); id. § 103 (setting forth the patent requirement of nonobviousness).

37. See id. § 102 (enumerating all of the situations when an invention is ineligible for a patent).

38. Id. § 103(a).

39. Raustiala & Sprigman, supra note 2, at 1704. There are, however, some examples of fashion items that have been registered for patent protection. See U.S. Patent No. 7,073,204 (filed July 14, 2003) (patenting a garment with a pouch for a medical apparatus); Victoria's Secret Stores Brand Mgmt., Inc., U.S. Patent No. 7,052,360 (filed Mar. 19, 2004) (patenting a molded breast cup for one of its bras); U.S. Patent No. 5,592,759 (filed Jan. 26, 1995) (patenting a vibrating shoe with the vibrating mechanism located within the sole of the shoe).


41. See id. (stating that design patents are subject to the other provisions of U.S. Code title 35); 8 CHISUM ON PATENTS, supra note 32, § 23.01, at 23-4 to -5 ("A design patent must meet the requirements of novelty and nonobviousness."). For the argument that fashion designs will not likely be sufficiently novel or nonobvious to qualify for patent protection, see supra note 39 and accompanying text.

42. See 8 CHISUM ON PATENTS, supra note 32, § 23.01, at 23-4 ("To be ornamental, a design must present a pleasing aesthetic appearance and must not be dictated solely by functional considerations.").
[A] design patent is not rendered invalid merely because the article of manufacture which is the subject of the design may, in addition to having a pleasing appearance, also perform a useful function. ... However, if the resulting configuration proceeds primarily from the necessity of functional or mechanical requirements, it is not a valid design patent.\[^\text{43}\]\n\nAgain, courts usually treat clothing as purely functional.\[^\text{44}\]\n\nIt thus appears there is nothing about a fashion design that is not the result of its primary function as clothing.\[^\text{45}\]\n\nThe patent application process is the most significant barrier to protection. The application for a patent requires a great deal of information that is too time consuming for a designer to compile for every individual fashion design.\[^\text{46}\]\n\nFurthermore, in 2006, it took an average of twenty months for a filed application to reach an examiner’s desk, and then it took another ten months before a decision was made by the examiner.\[^\text{47}\]\n\nUltimately, about one-third of all patent applicants are denied protection.\[^\text{48}\]\n\nThe time required for application review and the risk that an application will be rejected make patent protection impractical even if a fashion design could satisfy the statutory requirements of novelty and nonobviousness.

2. Trademark and Trade Dress

Unlike patents, trademarks are easier to obtain and do not require registration for legal protection.\[^\text{49}\]\n
A trademark usually is thought of as a "word"

\[^\text{44}\] \text{Infra} note 75 and accompanying text.
\[^\text{45}\] See Chosun Int’l, Inc. v. Chrisha Creations, Ltd., 413 F.3d 324, 328 (2d Cir. 2005) ("For many years, articles of clothing have been identified as ‘useful’ items and, hence, excluded from copyright eligibility.").
or "name" used in commerce by a person or business to "identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." Also included in the definition of trademark are "symbol" and "device," which are usually classified as trade dress. Nevertheless, courts treat trade dress in the same manner as trademark.

Distinctiveness is the key requirement in establishing trademark: "The general rule regarding distinctiveness is clear: An identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning." "Secondary meaning" is a form of distinctiveness acquired through use and advertising. Obtaining distinctiveness via secondary meaning is difficult—entailing enough time, use, and advertising for a court to recognize that consumers generally associate a single mark as derived from a single source. "[A]lmost anything at all," including shapes, sounds, scents, and colors, "that is capable of carrying meaning" is eligible for trademark.
protection.\footnote{56}{Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 162 (1995).} But, "considerable effort and expenditure of money" is necessary to show that the shape, sound, etc., is eligible for protection.\footnote{57}{Burke-Parsons-Bowlby Corp., 871 F.2d at 596.} The mark must "identify and distinguish the seller's goods from goods made or sold by others."

The primary tool fashion designers use to distinguish their designs is a trademarked logo or name usually placed inside an item of apparel.\footnote{58}{1 J. THOMAS McCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1, at 3:1-2 (2007).} Sometimes designers incorporate their distinctive mark into the creation of apparel. The Burberry plaid provides an example—the plaid is a registered trademark, which the company incorporates into many of its products.\footnote{59}{For example, for over 100 years, Levi Strauss and Company has used their registered mark on the back pocket of every pair of jeans it creates. See U.S. Trademark, Ser. No. 73,169,399, Reg. No. 1,139,254 (filed May 8, 1978) (providing registration information for Levi's signature mark). Levi Strauss actively pursues actions against infringers of its signature mark. See Michael Barbaro & Julie Creswell, With a Trademark in Its Pocket, Levi's Turns to Suing Its Rivals, N.Y. TIMES, Jan. 29, 2007, at A1 (reporting that Levi Strauss has initiated approximately 100 suits for trademark infringement since 2001).} However, this use of trademark does not render the design of the article protected; the protection applies only to the distinctive mark.\footnote{60}{See supra note 26 (discussing the trademark registration of Burberry's distinctive pattern). Fabric pattern is also eligible for copyright protection, infra note 177.} For this reason, in order for a fashion design to be eligible for trademark protection, the design must rise to the same level of distinction required for a mark to be recognized as a trademark.\footnote{61}{For the distinction between fashion counterfeiting and fashion copying, see supra notes 24-26 and accompanying text.} Because many designs are copied in a relatively short span of time,\footnote{62}{It seems unlikely that a fashion designer would spend the advertising dollars necessary to educate the public that a particular design came from one specific designer as opposed to another. This is especially so because much of the discussion at the hearings for House Bill 5055 centered on the idea that fashion design protection was most crucial for those designers who were just starting out in the business and were most injured by design pirates. See A Bill to Provide Protection for Fashion Design, supra note 6, at 187 (testimony of Susan Scafidi, Visiting Professor, Fordham Law School) (arguing that without protection, young fashion designers would be put out of business by design pirates). Although a large fashion house may be able to publicize a design enough to rise to the level of trademark, this would not be possible for a new designer who lacked the funds for a publicity campaign.} the general public may identify a distinctive trend in

\begin{itemize}
\item[57.] Burke-Parsons-Bowlby Corp., 871 F.2d at 596.
\item[58.] 1 J. THOMAS McCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1, at 3:1-2 (2007).
\item[59.] For example, for over 100 years, Levi Strauss and Company has used their registered mark on the back pocket of every pair of jeans it creates. See U.S. Trademark, Ser. No. 73,169,399, Reg. No. 1,139,254 (filed May 8, 1978) (providing registration information for Levi's signature mark). Levi Strauss actively pursues actions against infringers of its signature mark. See Michael Barbaro & Julie Creswell, With a Trademark in Its Pocket, Levi's Turns to Suing Its Rivals, N.Y. TIMES, Jan. 29, 2007, at A1 (reporting that Levi Strauss has initiated approximately 100 suits for trademark infringement since 2001).
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\item[63.] See id. at 183 (testimony of Jeffrey Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America) (noting that within two days after the Oscars, manufacturers are usually offering copies of the dresses worn by stars on the red carpet); see also Today: Steal the Stars' Oscar Style (NBC television broadcast Feb. 27, 2007) (featuring dresses that manufacturers had created based on dresses the stars wore at the Oscars held on February 25, 2007). In an
\end{itemize}
fashion designs but will not likely associate that trend with one particular designer.64

While trademark cracks the door to protection for fashion designs, these designs are technically trade dress and must meet a further requirement of nonfunctionality in order to obtain legal protection.65 "The functionality doctrine prevents trademark law . . . [from] allowing a producer to control a useful product feature."66 A feature is functional if it is "essential to the use or purpose of the article or if it affects the cost or quality of the article."67 Courts categorically treat clothing as functional, thereby precluding trademark.68 The possibility still exists that a portion of a design could be eligible for trademark protection; however, as discussed below, courts struggle to separate nonfunctional design elements eligible for protection from the overall functional apparel design.69

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64. The case for trademark protection is more difficult because, according to the Council of Fashion Designers of America, the purpose of House Bill 5055 is to protect individual designs, not trends. See infra note 275 and accompanying text (stating that House Bill 5055 should not protect trends). Thus, any possible trademark protection would have to be based on a distinct, individual design.

65. See 15 U.S.C. § 1125(a)(3) (2000) ("In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional."). Trade dress originally referred to the packaging of a product or how it was "dressed," but has been found to encompass product design as well. See Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 209 (2000) (explaining the expansion of "trade dress" in the lower courts). While trade dress can be inherently distinctive, the Supreme Court has held that a product's design can be distinctive only through secondary meaning. See id. at 216 ("We hold that . . . a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning.").


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

68. See infra notes 74–75 and accompanying text (stating that the Copyright Office guidance mandates that clothing is functional).

69. Courts have interpreted copyright protection to apply to elements that can be effectively separated from the functional aspect of clothing without altering the clothing's function. See infra notes 76–78 and accompanying text (describing conceptual separability); see also TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 34 (2001) (stating that portions of a product, which previously were protected by a utility patent, could be eligible for trade dress protection if separable from the functionality of the product). In fashion design, this separation is almost impossible: What part of a sleeve is not functional to a long-sleeved shirt? What part of a pant leg is not functional to a pair of slacks?
3. Copyright

Copyright protection extends to original "works of authorship" expressed through one of various mediums from which the works can be "perceived, reproduced, or otherwise communicated." Obtaining copyright protection is fairly easy. Like trademark law, no filing is required to obtain a copyright, which is "secured automatically when the work is created." Even better, unlike the hurdle of "novelty" in patent law, a copyrightable work need only be "original": "Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying." As a result, copyright presents the most practical source of protection for fashion designs.

Copyright protection, however, does not extend to "useful articles," which are defined as those "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." This shortcoming has categorically excluded clothing from copyright registration and protection: "On this point the copyright law is reasonably clear. Garments are useful articles, and the designs of such garments are generally outside of the copyright law."

The purpose of the functionality doctrine in trademark law is to leave the protection of useful articles to patent law. See Qualitex, 514 U.S. at 164 (stating that the purpose of patent law is to protect product designs). However, the irony regarding fashion is that because of their indistinctiveness, fashion designs cannot find protection under patent law, and because of their functionality, they cannot find protection under trademark law. See supra note 39 and accompanying text (discussing the reasons patent law is inapplicable to fashion designs because of the difficulty in meeting the novelty and nonobvious requirements, in other words, their ability to be distinct from already existing designs).

70. See 17 U.S.C. § 102 (2000) (listing categories of authorship to include literary, musical, dramatic, choreographic, sculptural, audiovisual, and architectural works). The statute states that protection is offered to "original works of authorship," but does not define "original." Id. As discussed more fully below, the standard for originality has not been difficult to meet. See infra notes 136–40 and accompanying text (explaining the low threshold of originality).

71. See U.S. Copyright Office, Copyright Office Basics, How to Secure a Copyright, http://www.copyright.gov/circs/circ1.html#hsc (last visited Jan. 29, 2008) (stating that even though registration is not required, there are benefits, which mostly surface in infringement situations) (on file with the Washington and Lee Law Review); see also 17 U.S.C. § 302(a) (stating that protection for works created after January 1, 1978 begins on the date of creation).

72. See supra notes 36–37 and accompanying text (defining "novelty").


On the other hand, just as in trade dress protection, where a design or pictorial work can be separated from the functionality of an item, this separable design is eligible for copyright protection. "Conceptual separability" is the term used by courts to determine which components of a design are eligible for copyright protection and which are held to be indivisible from useful components. Courts use several tests to make the complicated determinations of copyright eligibility. Though this exception to the general exclusion of clothing from copyright provides a pocket of design protection, it is truly meaningless because most designs do not satisfy the conceptual separability tests.

B. Failure of "Conceptual Separability" to Meaningfully Protect Fashion Designs

Conceptual separability is the one mechanism within current copyright protection through which portions of a fashion design may find minimal protection. When a "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," these portions may be eligible for copyright protection. For example, in Mazer v. Stein, the Supreme Court permitted a manufacturer of lamp bases to obtain copyright

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76. See 17 U.S.C. § 101 (2000) (defining "pictorial, graphic and sculptural works" to include those useful articles "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"); see, e.g., Mazer v. Stein, 347 U.S. 201, 217–18 (1954) (holding that statuettes appearing in lamp bases can be copyrighted because the artistic elements of the lamp bases were identifiable from the utilitarian aspects); Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) (finding that the design of the belt buckles at issue was separable from the function of the belt and thus the buckles were eligible for copyright protection); see also infra Part II.B and accompanying text (discussing the difficulty courts have in applying conceptual separability to allow for copyright protection).

77. See Galiano v. Harrah’s Operating Co., 416 F.3d 411, 417 (5th Cir. 2005) (stating that the "conceptual separability test" embodies the 17 U.S.C. § 101 requirement as to pictorial, graphic, and sculptural works).

78. See id. at 417 n.13 (listing six different tests for conceptual separability that are used by courts).

79. See infra notes 93–97 and accompanying text (discussing several tests for conceptual separability).

80. See 17 U.S.C. § 101 (defining "pictorial, graphic, and sculptural works").

81. See Mazer v. Stein, 347 U.S. 201, 213 (1954) (finding that copyright protection was not barred merely because a work of art was also eligible for patent protection).
protection for the statuettes that were incorporated into the lamp bases. Though useful or mechanical articles were not eligible for copyright protection, the Court reasoned that the inclusion of a work of art in a useful article did not preclude statutory protection. Regulations promulgated in response to *Mazer* explicitly set forth the copyrightability of artistic elements of useful articles:

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

Subsequent cases stated that the separation can either be physical or conceptual. "The courts, however, have had difficulty framing tests by which the fine line establishing what is and what is not copyrightable can be drawn," creating a great deal of confusion.

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82. See id. at 217 (holding that the statuettes in the lamp bases were copyrightable).

83. See id. at 218 (declining the opportunity to read such limitation into copyright law).


85. See id. at 993 ("This problem [of separability] is particularly difficult because, according to the legislative history... such separability may occur either 'physically or conceptually.'" (quoting H.R. REP. NO. 94-1476, at 55 (1976), as reprinted in 1976 U.S.C.C.A.N. 5658, 5668)). *Kieselstein-Cord* dealt with the eligibility of sculpturally designed belt buckles for copyright protection. See id. at 990 (noting that the belt buckles were created using precious metals and were akin to jewelry in that they were primarily ornamental). In upholding the copyright registration of two belt buckles, the Second Circuit determined that "the primary ornamental aspect of the... buckles is conceptually separable from their subsidiary utilitarian function." Id. at 993. The U.S. Copyright Office has defined "physically separable" as "the work of art can be physically removed from" the useful article. Registrability of Costume Designs, Policy Decision, 56 Fed. Reg. 56,530, 56,532 (Nov. 5, 1991). "Conceptually separable," on the other hand, is found when "the pictorial or sculptural work is independently recognizable and capable of existence apart from the overall utilitarian shape of the useful article." Id.; see also U.S. Copyright Office, Compendium II, Compendium of Copyright Office Practices § 505.03 (1984) ("The mere fact that certain features are nonfunctional or could have been designed differently is irrelevant under the statutory definition of pictorial, graphic, and sculptural works.").


87. Compare Whimsicality, Inc. v. Rubie's Costumes Co., 721 F. Supp. 1566, 1574 (E.D.N.Y. 1989) ("[T]he artistic, and aesthetically pleasing, aspects of [the] designs, in this court's judgment, are inseparable from the utilitarian concern with creating something that the consumer will think resembles a bee or penguin or spider for purposes of masquerading.")., vacated in part on other grounds, 891 F.2d 452 (2d Cir. 1989), with Nat'l Theme Prods., Inc. v. Beck, Inc., 696 F. Supp. 1348, 1353-54 (S.D. Cal. 1988) (finding that the Halloween costumes were not "designed to optimize their function as clothing" and because of these "minimal
In an effort to clarify conceptual separability as it applied to costume designs, the Copyright Office issued a policy decision in 1991. In the past, "[t]he Copyright Office has generally refused to register claims to copyright in three-dimensional aspects of clothing or costume design on the ground that articles of clothing and costumes are useful articles that ordinarily contain no artistic authorship separable from their overall utilitarian shape." The Office discussed copyrightability of masks, garment designs, and fanciful costumes. Garment designs were classified as useful articles: "The general policy of nonregistrability of garment designs will be applied not only to ordinary wearing apparel, but also to period and historical dress, and uniforms." Fanciful costumes, although also useful articles, would "be registered if they contain separable pictorial or sculptural authorship." Thus, the Copyright Office will register a costume "if any portion of a work can reasonably be construed as containing copyrightable authorship," but registration will not extend to uncopyrightable portions.

Though the policy decision purported to clarify the Copyright Office's approach to registering items of clothing, the Fifth Circuit recently complained of a lack of clarity regarding conceptual separability, citing at least six different tests that have been used by courts. In determining whether artistic pleats and

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89. See id. (stating that masks were eligible for protection because they "generally portray their own appearance" and, accordingly, were not useful articles).
90. Id. at 56,532. The Copyright Office also stated that clothing for theatrical productions would be treated in the same manner as garment designs. See id. (identifying theater costumes as separate from fanciful costumes).
91. Id. The policy decision did not provide specific examples of when a fanciful costume could also be eligible for copyright protection. However, case law indicates that buttons or pleats would not be sufficiently separable from the useful function of clothing to allow such items to be eligible for copyright. Galiano v. Harrah's Operating Co., 416 F.3d 411, 414 (5th Cir. 2005).
92. Registrability of Costume Designs, Policy Decision, 56 Fed. Reg. 56,530, 56,532 (Nov. 5, 1991). The policy decision went on to further clarify by stating as follows: "Costumes, by their very nature, exist at the boundary between works of imagination and works of utility. Portions of some costumes will be registerable under the separability test, and others will be unregisterable in all respects." Id.
93. See Galiano, 416 F.3d at 417 ("There are at least six distinct variations of [the conceptual separability] test and courts 'have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function.'" (quoting
buttons on uniforms rendered garments eligible for copyright protection, the Fifth Circuit adopted the likelihood-of-marketability standard. This standard of conceptual separability bases copyright eligibility on a determination of whether a useful article "would still be marketable to some significant segment of the community simply because of its aesthetic qualities." The Second Circuit adopted a different test in evaluating the copyrightability of Halloween costumes, stating that conceptual separability could be shown if artistic elements "invoke in the viewer a concept separate from that of the costume's 'clothing' function, and that their addition to the costume was not motivated by a desire to enhance the costume's functionality." The Fifth Circuit determined that the clothing at issue was ineligible for copyright protection, while the Second Circuit remanded the determination of copyright eligibility to the district court. Yet, even if the conceptual separability tests had been

Masquerade Novelty, Inc. v. Unique Indus., Inc., 912 F.2d 663, 670 (3d Cir. 1990)). For purposes of this Note, the various tests are not as important as the understanding that any protection fashion can obtain under current intellectual property law is minimal and difficult to discern.

94. See id. at 421 (stating that courts implicitly use the likelihood-of-marketability standard).

95. Id. at 417 n.13 (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[B][3] (2004)).

96. Chosun Int'l, Inc. v. Chrisa Creations, Ltd., 413 F.3d 324, 330 (2d Cir. 2005). More importantly, the court, in dicta, appears to be overruling a line of Second Circuit cases that previously held that Halloween costumes were ineligible for copyright protection because they were useful articles—useful for masquerading. See Whimsicality, Inc. v. Rubie's Costumes Co., 721 F. Supp. 1566, 1574 (E.D.N.Y. 1989) (finding Halloween costumes to be useful because they allowed the wearer to masquerade), vacated in part on other grounds, 891 F.2d 452 (2d Cir. 1989); see also Whimsicality, Inc. v. Battat, 27 F. Supp. 2d 456, 463 (S.D.N.Y. 1998) (stating that the purpose of Halloween costumes was for masquerading). Chosun criticized the argument that the use of costumes was for masquerading, stating that this conclusion would be inconsistent with Copyright Office policy, which found masks to be non-useful articles and their only purpose would be to masquerade. See Chosun, 413 F.3d at 329 n.3 (citing Registrability of Costume Designs, Policy Decision, 56 Fed. Reg. 56,530, 56,532 (Nov. 5, 1991)). According to Chosun, if design elements "could be [physically] removed from the costume without adversely impacting the wearer's ability to cover his or her body" then they were eligible for copyright protection under physically separable standards. Id. at 329.

97. See Galiano v. Harrah's Operating Co., 416 F.3d 411, 422 (5th Cir. 2005) (affirming the denial of summary judgment because there was no showing that the design of casino uniforms were independently marketable); see also Chosun, 413 F.3d at 330 (leaving open the possibility of copyright eligibility because the only issue before the court was whether dismissal of the infringement claim was warranted; the court ruled it was not).

Though conceptual separability may not provide relief, under the Second Circuit's interpretation in dicta, there may be some hope for copyright eligibility of fashion designs under physical separability. See id. at 329 (stating that items that can be removed without interfering with the purpose of clothing the body may be eligible for protection). The real question is: What is the function of a fashion design? For example, if the function of a short sleeved dress is
satisfied in these instances, protection only would apply to portions of the articles and not to "the appearance as a whole of an article of apparel." 98

C. Failure of Courts and Congress to Allow for the Protection of Fashion Designs

The application of conceptual separability by courts was not the only attempt made to protect designs. Over the years, fashion guilds and Congress have also unsuccessfully attempted to protect designers from style piracy. In the first half of the twentieth century, courts found the protection practices of two apparel guilds to be in violation of antitrust legislation.99 These guilds "registered" the designs of their members as original and contracted with retail stores to ensure that those stores would not sell dresses or hats that were copies of guild-registered designs.100 If the store violated the contract, the guild would refuse to do business with that retail outlet.101 In both cases, the courts sympathized with the plight of the designers of unprotectable hats and dresses:

What passes in the trade for an original design of a hat or a dress cannot be patented or copyrighted. An "original" creation is too slight a modification of a known idea to justify the grant by the government of a monopoly to the creator; yet such are the whims and cycles of fashion that the slight modification is of great commercial value. The creator who maintains a large staff of highly paid designers can recoup his investment only by selling the hats they design. He suffers a real loss when the design is copied as soon as it appears; the imitator in turn reaps a substantial gain by appropriating for himself the style innovations produced by the creator's
to clothe the body, decorative sleeves are part of that function. However, if the function of the dress is to make a fashion statement, are the decorative sleeves necessary to making that statement? If not, then arguably those sleeves would be eligible for copyright protection based on physical separability.

98. See supra note 21 and accompanying text (defining "fashion design").

99. See generally Fashion Originators Guild of Am., Inc. v. Fed. Trade Comm'n, 114 F.2d 80 (2d Cir. 1940) (finding the guild practices to be in violation of federal law), aff'd, 312 U.S. 457 (1941); Millinery Creators' Guild, Inc. v. Fed. Trade Comm'n, 109 F.2d 175 (2d Cir. 1940) (finding the guild practices of hat designers to be illegal).

100. See Fashion Originators Guild of Am., Inc., 114 F.2d at 82 (stating that 12,000 retailers had signed contracts with the guild not to buy pirated dresses); Millinery Creators' Guild, Inc., 109 F.2d at 176 (stating that over 1,600 retailers signed contracts with the guild not to purchase pirated hats).

101. See Fashion Originators Guild of Am., Inc., 114 F.2d at 82 (finding that the guild placed the names of violating retailers on red cards); Millinery Creators' Guild, Inc., 109 F.2d at 176 (finding that the guild also punished members who sold to retailers who purchased from design pirates by kicking the member out of the guild).
investment. Yet the imitator may copy with impunity, and the law grants no remedy to the creator. \footnote{Millinery Creators' Guild, Inc., 109 F.2d at 177 (citing Cheney Bros. v. Doris Silk Corp., 35 F.2d 279 (2d Cir. 1929)). See also Fashion Originators Guild of Am., Inc., 114 F.2d at 84 ("It may be unfortunate—it may indeed be unjust—that the law should not thereafter distinguish between 'originals' and copies; but until the copyright law is changed, or until the Copyright Office can be induced to register such designs, . . . they both fall into the public demesne without reserve." (citing Cheney Bros. v. Doris Silk Corp., 35 F.2d 279 (2d Cir. 1929))}. Nevertheless, the courts found that the guilds' practices violated antitrust laws because they established monopolies for their products where Congress had not yet spoken. \footnote{See Fashion Originators Guild of Am., Inc., 114 F.2d at 85 ("Hence to attempt to gather to oneself all possible reproductions of a given design is to attempt to create a monopoly . . . ."); Millinery Creators' Guild, Inc., 109 F.2d at 177 ("[H]ere the courts have refrained from enjoining the pirate because they will not support a monopoly in an unpatentable idea.").} Not only have courts been unwilling to extend copyright protection in the absence of congressional authority, but the Copyright Office has directed those who desire copyright protection for fashion designs to "address their concerns to the Congress, since establishment of such protection must have congressional authorization." \footnote{Registrability of Costume Designs, Policy Decision, 56 Fed. Reg. 56,530, 56,532 (Nov. 5, 1991). But see Whimsicality, Inc. v. Rubie's Costumes Co., 721 F. Supp. 1566, 1573 (E.D.N.Y. 1989) (suggesting that Congress made a policy decision by excluding protection for clothing), vacated in part on other grounds, 891 F.2d 452 (2d Cir. 1989). Whimsicality stated: "Congress decided that it is better to risk not protecting some art than to grant to all so called art, including art resulting from non-artistic (i.e., utilitarian) considerations, the precious protection and monopoly status of copyright." Id.}

Congress previously has contemplated modifying copyright law to include protection for designs. In 1930, the House of Representatives passed the Design Copyright Bill, which would have provided protection for dressmakers as well as designers of other useful articles. \footnote{See The Vestal Bill for the Copyright Registration of Designs, 31 Colum. L. Rev. 477, 477 nn.3–4 (1931) (defining "design" under the proposed legislation and indicating that private dressmakers would be exempt from punishment under the act for copying because they were not producing dresses for commercial use); see also A Bill to Provide Protection for Fashion Design, supra note 6, at 198 (prepared statement of the U.S. Copyright Office) (referring to the passage of House Bill 11852 during the 71st Congress in 1930). In fact, the call for clothing design protection came much earlier; in 1913, the Copyright Office advocated for congressional enactment of clothing design protection—an attempt for such protection failed in 1914. See Industrial Design Protection: Hearings Before the Subcomm. on Courts, Intellectual Property, and the Administration of Justice of the H. Comm. on the Judiciary, 101st Cong. 445–46 (1990) (statement of Ralph Oman, Register of Copyrights and Assistant Librarian for Copyright Services) (indicating that the original push for design protection stemmed from mass production of clothing).} However, the Senate sought to
limit application of the Design Copyright Bill to certain industries, which did not include the fashion design industry.\textsuperscript{106} Ultimately, the Design Copyright Bill was never enacted. The Senate later passed design protection bills in 1962, 1963, and 1965, each of which proposed protection for "original ornamental designs of useful articles."\textsuperscript{107} These bills failed to pass the House, but were incorporated into legislation leading up to the Copyright Law Revision of 1976.\textsuperscript{108} However, the 1976 statute did not add design protection because the House felt it was better to consider design protection separately.\textsuperscript{109} The originally proposed design protection in 1976 resurfaced in the Industrial Innovation and Technology Act of 1987, the Industrial Design Anti-Piracy Act of 1989, and the Design Protection Act of 1989.\textsuperscript{110} The significant difference between the attempts in the 1970s and 1980s at design protection and the recent attempts is that the earlier proposals explicitly excluded protection for clothing, whereas the Design Piracy Bills would protect only the design of clothing.\textsuperscript{111}

\begin{footnotes}
\item[106] See The Vestal Bill for the Copyright Registration of Designs, supra note 105, at 493 (stating that Senate committees amended the scope of the bill and excluded dress designs from protection).
\item[108] See id. at 50 (stating that Senate Bill 1774, introduced by Senator Philip A. Hart during the 81st Congress, became Title II of Senate Bill 22, the bill that proposed general revision to copyright law in 1976).
\item[109] See A Bill to Provide Protection for Fashion Design, supra note 6, at 198–99 (prepared statement of the U.S. Copyright Office) (stating that copyright revisions were enacted in October 1976 without design protection).
\item[110] See generally Industrial Design Protection, supra note 105 (including hearings for House Bills 902, 3017, and 3499).

The legislative record indicates that the fashion industry may not have wanted fashion design protection included in the design protection bills of the 1980s. See Industrial Design Protection, supra note 105, at 187 (testimony of Bruce Lehman, counsel, representing parties in support of the bills) ("I think it is... fair to say the garments are not covered because the garment industry didn't want to be covered under this legislation. And that is something that goes back many, many years, I think, to the legislation as it was crafted originally in the 1950s and 1960s."). Since the 1940s, when the dress and hat guilds organized and took action, there has been no other organized push by the fashion industry for protection until the proposal of House Bill 5055. See supra notes 99–103 and accompanying text (discussing the methods employed by fashion guilds to protect the creations of their members). House Bill 5055 was
The legislative record indicates that Congress considered design protection legislation in the 1980s to reward creativity and to align with protection offered by other countries. Concerns that such protection would increase the number of lawsuits and harm consumers contributed to the failure of these design protection bills. Similar arguments, however, did not prevent Congress from enacting the Vessel Hull Design Protection Act in 1998. The Act created ten years of protection for very specifically defined

supported by the Council of Fashion Designers of America through the testimony of Jeffrey Banks. A Bill to Provide Protection for Fashion Design, supra note 6, at 8–13 (testimony and prepared statement of Jeffrey Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America). Possibly, the failure to lobby for protection is due to the failure for the industry to organize. See Raustiala & Sprigman, supra note 2, at 1755–56 (stating the logical argument to explain the lack of protection for the fashion industry is that there are too many participants to effectively organize for change). This argument falters in light of the fact that the Council of Fashion Designers of America has been organized since 1962 to advance the interests of fashion design and its designers. See id. at 1756 (stating that in light of the Council, the failure to organize cannot be the reason that protection has not be implemented). For information on the Council, see The Council of Fashion Designers of America, http://www.cfda.com (last visited Oct. 11, 2007).

112. For an argument supporting the protection of creativity, see Industrial Design Protection, supra note 105, at 450–51 (statement of Ralph Oman, Register of Copyrights and Assistant Librarian for Copyright Services): "Legal protection for designs would produce economic benefits for designers in the form of increased demand for their work and a more adequate reward for a good design." The competing argument is that the protections already in play are sufficient for protecting innovators. See id. at 453 (arguing that even if design protection is inadequate, it does not stifle invention and creativity).

Regarding the concern that the United States is out of step with other foreign countries in terms of design protection offered, see id. at 79 (statement of Rep. Carlos J. Moorhead, Member, Subcomm. on Courts, Intellectual Property, and the Administration of Justice). See also id. at 92 (prepared statement of Rep. Richard A. Gephardt, Majority Leader) ("If our inadequate system encourages design piracy—as it does today—then the time will surely come when America is no longer the center of innovation in the world. We will become nothing more than a giant flea market for selling the latest ripped-off products of other nations' creators.").

113. As to the concern that design protection will increase the frequency of litigation, see id. at 193 (statement of Rhonda J. Parish, Corporate Counsel, Wal-Mart Stores, Inc.). For differing arguments on the harm or benefit to consumers of design protection, see id. at 451, 453–54.

114. According to the statute, "vessel" is defined as "a craft (A) that is designed and capable of independently steering a course on or through water through its own means of propulsion; and (B) that is designed and capable of carrying and transporting one or more passengers." 17 U.S.C. § 1301(b)(3) (2000). "Hull" is defined as "the frame or body of a vessel, including the deck of a vessel, exclusive of masts, sails, yards, and rigging." Id. at § 1301(b)(4).

The evidence before Congress suggested that a hull designer may invest as much as $500,000 into the design of one hull and that this investment should be rewarded for fear that designers would "no longer invest in new, innovative boat designs that boaters eagerly await." Vessel Hull Design Protection Act, H.R. REP. NO. 105-436, at 13 (1998). Opponents argued that protection would increase litigation and stifle creativity. See id. at 12 (summarizing
"useful articles."115

Congress purposefully coupled vessel hull protection with copyright under title 17 of the U.S. Code rather than with design or utility patent protections; however, vessel hull protection is sui generis and is not a form of copyright protection.116 Nevertheless, vessel hull protection and copyright protection operate similarly. Both protections require originality as a prerequisite for protection.117 "Substantial similarity" is the test courts use to determine if articles are infringements of protected articles.118 Additionally, the vessel hull protection, like copyright, allows copying for educational purposes.119

arguments expressed in opposition to the legislation). Proponents of the legislation argued that protection was necessary to ensure public safety because vessel hull copies did not necessarily include safety mechanisms that were included in original designs. See id. at 13 ("Consumers who purchase copied boats are defrauded in the sense that they are not benefitting from the many attributes of hull design, other than shape, that are structurally relevant, including those related to quality and safety.").

115. Copyright does not extend to useful articles. See supra note 74 and accompanying text (providing the statutory exclusion of useful articles). The Vessel Hull Design Protection Act created a new protection that applied specifically to vessel hulls, plugs, and molds. See 17 U.S.C. § 1301 (2000) (extending design protection to useful articles); see also id. § 1301(b)(3) (limiting the definition of useful articles to "a vessel hull, including a plug or mold"). The statute defines "plug" as "a device or model used to make a mold for the purpose of exact duplication, regardless of whether the device or model has an intrinsic utilitarian function that is not only to portray the appearance of the product or to convey information." Id. § 1301(b)(5). "Mold" is defined as "a matrix or form in which a substance for material is used, regardless of whether the matrix or form has an intrinsic utilitarian function that is not only to portray the appearance of the product or to convey information." Id. § 1301(b)(6).


117. Regarding the requirement of originality, see 17 U.S.C. § 102 (2000) for copyright and § 1302(1) for vessel hulls. For the requirement that registration is filed with the Copyright Office, see id. § 408(a) for copyright and § 1314 for vessel hulls.

118. See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A], at 13-34.1 to -34.3 (2007) [hereinafter NIMMER ON COPYRIGHT] (providing "substantial similarity" as the standard for copyright infringement); see also 17 U.S.C. § 1309(e) (using the same standard for infringement of vessel hulls).

119. For the exception allowing copying for educational purposes, see 17 U.S.C. § 107 for copyright and § 1309(g) for vessel hulls. Copyright also has other exemptions that allow copying without infringement. See id. §§ 107–112 (specifying the limitations on copyright's exclusive rights).
Contrary to the predictions of opponents, vessel hull design protection has not resulted in an increase in litigation and does not appear to have stifled industry creativity. In 2003, a report by the Copyright and Patent and Trademark Offices indicated that in the first five years of vessel hull protection, 156 designs were registered and published. As of yet, only one case has been litigated, which resulted in the cancellation of a hull design registration. The report also concluded that the design protection encouraged creativity as evidenced by comments from those in the industry: "'[T]he existence of this legislation clearly pushes our engineers and designers to create innovative and different products, which is evidenced by the designs we have registered, with far more on the drawing board. Were it not for the [vessel hull protection], the incentive for innovation would clearly be diminished.'"

There are differences between copyright and vessel hull protection. Copyright protection is intact for the life of the author plus seventy years and begins on the date of creation. Protection for vessel hulls is ten years from the earlier of the date of publication or the date of registration. The best way to determine how effective the protection has been would be to compare the number of registrations with the total number of original vessel hulls produced; however, the latter figure was unavailable. Additionally, the report suggested that the low number of registrations could be partially explained by lack of information about the registration process. The final reason the report cited for minimal registrations was that some designers were concerned that publication of registered designs on the Internet would allow foreign manufacturers to copy these designs. Despite several positive comments as to the spur of creativity resulting from the Act, the report conceded that the commentators could not cite to examples "of designs that would not have been created and introduced to the public but for the protection of the Act."
Vessel hull design protection is worth mentioning because this was the first time Congress explicitly authorized copyright-like protection for a useful article design. Even more critical, vessel hull protection serves as the basis for the proposed fashion design protection. The Design Piracy Bills’ simple modifications to the vessel hull protection are inadequate to protect apparel meaningfully. Additionally, because fashion designs and vessel hull designs are created, copied, and sold in different ways, it is unlikely that the same low-litigation/high-creativity results of vessel hull protection will be repeated in the case of fashion design protection.

III. The Creation of Fashion Design Protection

As illustrated by the previous discussion, congressional enactment of a new intellectual property protection is the only way to protect an entire piece of clothing. The Design Piracy Bills would specifically create a new type of protection only for fashion designs. Separate design protection is not an entirely new concept—Japan and the European Union already have design protection systems. An in-depth look at the protections provided by the Design Piracy Bills, Japanese law, and European Union law assists in determining whether fashion design protection is a good fit in the United States.

124. See infra note 130 and accompanying text (stating that fashion design protection under the Design Piracy Bills would be added to the same chapter of the U.S. Code that provides currently for vessel hull design protection).

125. See infra notes 153–60 and accompanying text (illustrating some weaknesses of the Bills).

126. See infra notes 151–52 and accompanying text (describing the means of copying).

127. A direct comparison of vessel hull protection and fashion design protection may be improper. Though there is some value in a comparison, there are, no doubt, fewer vessel hulls created each year than fashion designs. Additionally, the amount of creativity allowed in hull designs may be limited; ultimately the purpose of a hull design is to provide a structure for a boat. In comparison, there are several different types of fashion apparel all with varying purposes. For the claim that fashion design protection creates senseless litigation, see infra note 213 and accompanying text. For the argument that fashion protection will stifle creativity, see infra note 261 and accompanying text.

128. One exception to this statement was found in Poe v. Missing Persons, 745 F.2d 1238, 1242–43 (9th Cir. 1984), where the Ninth Circuit reasoned that a swimsuit intended to be a work of art rather than a useful article of clothing could be eligible for copyright protection. Because most clothing is designed for wearing, this example is not helpful to providing protection to everyday apparel.

129. See A Bill to Provide Protection for Fashion Design, supra note 6, at 2–3 (opening statement of Rep. Howard L. Berman, Ranking Member, Subcomm. on Courts, the Internet, and Intellectual Property) (stating that House Bill 5005 would offer an unprecedented protection to fashion designs).
A. Proposed Protection Under the Design Piracy Bills

The Design Piracy Bills propose the addition of protection for original fashion designs to chapter 13 of title 17 of the U.S. Code, the chapter currently outlining protection for vessel hulls.\(^{130}\) The Bills propose to re-define "useful article" as "a vessel hull, including a plug or mold, or an article of apparel."\(^{131}\) The Bills offer three years of protection for fashion designs, a significantly shorter period of protection than that offered to copyrighted articles.\(^{132}\) Like protection for vessel hulls, but unlike copyright, design protection would begin on the earlier of the date of registration or the date the design was first made public.\(^{133}\)

To obtain protection for a design, the design must meet a standard of originality that makes the article "attractive or distinctive in appearance to the purchasing or using public."\(^{134}\) Originality, the same standard used for copyright protection,\(^{135}\) is a low bar and requires the new article to have something just slightly more than a trivial modification to an article already protected or in the public domain.\(^{136}\)


\(^{131}\) See H.R. 2033 § 2(a)(2)(A) (amending 17 U.S.C. § 1301(b)(2) by "inserting 'or an article of apparel,' after 'plug or mold'"); S. 1957 § 2(a)(2)(A) (same); H.R. 5055 § 1(a)(2)(A) (same); see also 17 U.S.C. § 1301(b)(2) (2000) (defining "useful article" as "a vessel hull, including plug or mold"). For the definition of "vessel" and "hull," see supra note 114. For the definition of "plug" and "mold," see supra note 115. For the definition of "apparel," see supra note 23 and accompanying text.

\(^{132}\) See H.R. 2033 § 2(c) (amending 17 U.S.C. § 1305(a) to provide protection for three years for fashion designs); S. 1957 § 2(c) (same); H.R. 5055 § 1(c) (same); see also supra note 119 (discussing the length of protection for copyright and vessel hulls).

\(^{133}\) See H.R. 2033 § 2(c) (stating that protection would begin in accordance with 17 U.S.C. § 1304, which provides that protection begins on the earlier of the date of registration or date the design is made public); S. 1957 § 2(c) (same); H.R. 5055 § 1(c) (same).

\(^{134}\) See 17 U.S.C. § 1301(a)(1) (2000) (providing protection for original designs); see also H.R. 2033 (failing to amend the requirement for originality); S. 1957 (same); H.R. 5055 (same).

\(^{135}\) See supra note 73 and accompanying text (stating that originality is a requirement for copyright protection). Though copyright law does not contain a statutory definition for "original," the definition included in chapter 13 of title 17 is simply a codification of the case law interpretation of "original" as applied to copyright. See 17 U.S.C. § 1301(b)(1) ("A design is 'original' if it is the result of the designer's creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source."). Therefore, the cases used in this section all discuss originality as it applies to copyright protection, but for all intents and purposes it is the same standard that is applicable to vessel hulls and will be applicable to fashion designs if the Design Piracy Bills are codified.

\(^{136}\) See Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102–03 (2d Cir. 1951)
David Wolfe, creative director for a fashion marketing and consulting company, suggested that nothing short of spray-on clothing would be considered "new" in terms of fashion design: "It is possible to create a new textile, a new print, but [a] new design is almost impossible because all we are doing in creating a new one is putting together existing elements in a different way." Even though the elements of apparel already exist, the Design Piracy Bills would protect the end result of a mix-and-match of fashion elements so long as the end product was original. Thus, while Mr. Wolfe may not consider a design created from existing elements to be new, under the low threshold of originality such a design may legally be considered new.

Some fashion designs will be able to satisfy the statutory requirement of originality, yet the statute requires more than originality: The statute requires originality that renders the article attractive or distinct. Currently, this same standard applies to vessel hulls and does not pose any additional hurdle to obtaining registration. The legislative record for the Vessel Hull Design Protection Act does not mention a specific congressional intent for including an attractiveness or distinctiveness requirement. But the record clearly indicates that Congress did not intend a distinctiveness requirement similar to trademark

("All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'").

137. See A Bill to Provide Protection for Fashion Design, supra note 6, at 180 (testimony of David Wolfe, Creative Director, The Doneger Group) (commenting that there was nothing new that could be made out of fabric, needle, and thread in terms of fashion).

138. Id. Information on The Doneger Group can be found on its corporate website at http://www.doneger.com.

139. See supra note 134 and accompanying text (stating that the Design Piracy Bills would impose a standard of originality for protection eligibility).

140. See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991) ("Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity." (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §§ 2.01[A], [B] (1990))).

141. Compare 17 U.S.C. § 1301(a)(1) (2000) ("The designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter . . . ."), with id. § 102(a) ("Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.").

142. There is no evidence that a vessel hull registration has been denied for a design that was found to be original but was found unattractive or indistinct.

Should protection be added for fashion designs, however, the subjective requirement for attractiveness may serve as a hurdle for protection. The malleability of an "attractiveness" standard provides breeding ground for senseless litigation and potential complications.

Assuming the design satisfies the attractiveness or distinctiveness requirement, a designer must file a design registration within three months after a design is made public or protection for the design is lost. Under the Design Piracy Bills, a protected designer acquires exclusive rights to make, sell, import, and trade the fashion design as well as control who can make, sell, or import the registered design. The designer can also institute an action for infringement of a registered design. Infringement actions can be maintained against anyone who, without permission, "make[s], ha[s] made, or import[s], for sale or for use in trade" or "sell[s] or distribute[s] for sale or for use in trade" any infringing article. The statutory exclusive rights and acts of infringement are likely sufficient to protect vessel hull designers because the primary means of copying a vessel hull requires using the actual hull to make a mold.

144. See id. at 12 (arguing that vessel hull protection was needed because designs were usually not distinct in the same way as required by trademark law).

145. The Copyright Office may not deny registration to an unattractive or indistinct article. Regardless, the requirement potentially places protection in the hands of those with varying opinions as to what is appealing.

146. Interestingly, design protections in Japan and the European Union include an attractiveness requirement. See infra note 169 (discussing Japan's attractiveness requirement); see also infra note 202 (discussing the European Union's possible attractiveness requirement).

147. See H.R. 2033, 110th Cong. § 2(e)(1) (2007) (proposing the amendment of 17 U.S.C. § 1310 to state "[i]n the case of a fashion design, protection under this chapter shall be lost if application for registration of the design is not made within 3 months after the date on which the design is first made public"); S. 1957, 110th Cong. § 2(e)(1) (2007) (same); H.R. 5055, 109th Cong. § 1(e)(1) (2006) (same). For vessel hull designs, the designer has two years from the date a design is made public to file a registration. See 17 U.S.C. § 1310(a) (2000) (stating that protection is lost after two years). For copyright, registration is not necessary to obtain legal protection. Id. § 408(a). There are benefits, however, to filing within five years of publication of a copyrighted work. See id. § 410(c) (stating that in judicial proceedings for infringement, registration made within the first five years after publication will be prima facie evidence of copyright validity; the validity of registrations made after five years is subject to judicial discretion).

148. See 17 U.S.C. § 1308 (2000) (setting forth exclusive rights of the design owner for vessel hull). The Design Piracy Bills do not propose any amendments to § 1308 so it would be applicable to fashion designs if title 17 is amended.

149. See id. § 1321(a) ("The owner of a design is entitled, after issuance of a certificate of registration of the design under this chapter, to institute an action for any infringement of the design.").

150. Id. § 1309(a)(1), (a)(2).

151. The primary means of copying a vessel hull is through "hull splashing," whereby the completed plug is used to create a mold for the creation of copies of the original hull. See
Clothing, on the other hand, can be copied by pirates based on a photograph of an article. Curiously, the Design Piracy Bills propose no amendments to the exclusive rights and infringing acts and thereby leave significant loopholes, which would allow continued piracy of designs.

For example, one concern expressed by Professor Susan Scafidi was that without design protection, photographs of dresses paraded by celebrities on the red carpet could be easily transferred via the Internet to a factory in China that would recreate the dresses within days and offer them for sale online. Yet, the Design Piracy Bills were not drafted to cure this alleged ill. These knockoffs created in China would be infringing articles under the Design Piracy Bills, which define "infringing article" as "any article the design of which has been copied from a design protected under this chapter, or from an image thereof, without the consent of the owner of the protected design." An

Vessel Hull Design Protection Act, H.R. REP. NO. 105-436, at 13 (1998) (stating that hull splashing can be used to produce virtually identical looking hulls).

See supra note 63 (discussing the speed with which clothing copies are produced after they are publicized); see also infra note 154 (stating that photographs of designs can be easily transferred via the Internet to foreign countries for quick reproductions).


See A Bill to Provide Protection for Fashion Design, supra note 6, at 79 (prepared statement of Susan Scafidi, Visiting Professor, Fordham Law School) (arguing that the Internet has drastically changed design piracy by providing designers around the world with pictures and details of other designers' creations).

Photographs, paintings, and other drawings of protected designs that appear in magazines, newspapers, movies, television shows, etc., are not infringements of the protected design. See 17 U.S.C. § 1309(e) (2000) (stating that infringing articles do not include "illustration[s] or picture[s] of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium."). A design created based on a photograph of a protected design that appears in a magazine would be an infringement unless the new design was original. See H.R. 2033, 110th Cong. § 2(d)(2) (2007) (proposing an amendment to 17 U.S.C. § 1309(e), which would add to the definition of infringing articles those articles created based on images of protected fashion designs); S. 1957, 110th Cong. § 2(d)(2)(A) (2007) (same); H.R. 5055, 109th Cong. § 1(d)(2) (2006) (same). This presents a flawed situation, as discussed below, where if a magazine publishes a photograph of a protected fashion design, another designer cannot copy that design or else it will be an infringement. However, if a magazine publishes a design sketch, even if the sketch is copyrighted, another designer can create the design in the sketch without infringing on either the copyright or any design protection. See infra notes 299-92 and accompanying text (discussing one of the gaps in the currently proposed Design Piracy Bills).

This assumes that when copying the dresses from the photographs the factory did not make changes. As discussed below, even minor changes could effectively make the resulting product an original design rather than an infringing design.

See H.R. 2033, 110th Cong. § 2(d)(2) (2007) (proposing the amendment of 17 U.S.C. § 1309(e) by adding "or from an image thereof" after "copied from a design protected under this
infringement action would be difficult to maintain against this Chinese manufacturer. Nevertheless, an infringed designer possibly could bring suit against a retailer importing the infringing articles. If, for instance, Wal-Mart or Target ordered a number of the infringing dresses from the Chinese manufacturer, an infringement action can succeed so long as the importing store knew that the items were infringing articles. Remarkably, the same is not true if the importer is an individual consumer purchasing a dress for personal use over the Internet. The importation of infringing articles is an infringement if the articles are imported "for sale or use in trade" and not for personal use. Given that Americans purchase over $13.8 billion worth of clothing online each year, failure to close this loophole may undercut the effectiveness of the Design Piracy Bills.


157. Unless the United States has a means of enforcing its law against actors in other countries or another country's law prohibits copying of U.S.-protected designs, foreign manufacturers will escape liability.

158. See 17 U.S.C. § 1309(a) (2000) (stating that failure to get permission to make, import, or sell a design is an infringement of the design); supra note 153 (stating that the Design Piracy Bills fail to suggest amendments to § 1309(a)); see also 17 U.S.C. § 1309(c) (requiring knowledge by the seller or distributor that an article is an unauthorized copy in order to be punished under the statute). Though acts committed without knowledge that the design at issue is protected are not considered to be infringing acts, there is no standard that establishes knowledge that may be imputed to sellers or distributors. Would the Design Piracy Bills require a distributor to check the design registry before importing a design to ensure it is not protected? Telephone Interview with Christopher Sprigman, supra note 6.

The Supreme Court recently addressed secondary liability for infringement of copyright. See MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 913, 935 (2005) (discussing the standard of secondary liability in copyright infringement); see also H.R. 2033 § 2 (d)(3) (proposing the amendment of 17 U.S.C. § 1309 by adding a new subsection (h) that would apply the same principles of secondary infringement and secondary liability to design protection); S. 1957 § 2(d)(3) (same); H.R. 5055 § 1(d)(3) (same). Under the new standard, infringement is not found only based on actual knowledge of infringement, but can be found "where evidence goes beyond a product's characteristics or the knowledge that it may be put to infringing uses, and shows statements or actions directed to promoting infringement." Grokster, 545 U.S. at 935. If the photographer in the textual hypothetical took photographs specifically to forward to the Chinese manufacturer there could possibly be a successful infringement suit against the photographer. The case is much different if the photographer is taking photographs for general news purposes and they are found by the Chinese manufacturer in order to copy the designs.


160. See Jessica Pallay, Independents.com: Once Reserved for the Big Boxes, an Online Presence Is Becoming the Norm for Independent Men's Shops, DAILY NEWS RECORD, Aug. 28, 2006, at 68 (reporting that sales of apparel, accessories, and footwear were $13.8 billion in 2006, an 18% increase from the $11.3 billion in sales in 2005). The article states that online
Though the Design Piracy Bills did not propose to complement existing international design protections, enactment of fashion design protection would be consistent with countries such as Japan and the European Union.\footnote{See A Bill to Provide Protection for Fashion Design, supra note 6, at 9 (testimony of Jeffrey Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America) ("The U.S. is conspicuous in that unlike Europe and Japan, it does not protect fashion in its laws.").} Both countries, however, offer comprehensive design protection not limited to fashion.\footnote{See infra notes 167, 178 and accompanying text (defining the scope of the international protections).} Other differences between the proposed fashion design protection and international protections include the length of protection—the proposed three years is less than foreign design protections—and the requirement for registration.\footnote{See infra notes 172, 185 and accompanying text (stating that the protection offered for Japan is twenty years and the protection for designs in the European Union is up to twenty-five years); see also infra notes 184–89 and accompanying text (indicating that unregistered designs are protected in the European Union although under different terms than protection for registered designs).} Because the international design protection systems have been in play for several years, they assist in foretelling the effects of similar protection in the United States.

\section*{B. Current Fashion Design Protection Offered in Japan and the European Union}

During the subcommittee hearings on House Bill 5055, witnesses urged Congress to look at the design protections offered in Japan and the European Union as examples.\footnote{See A Bill to Provide Protection for Fashion Design, supra note 6, at 9 (testimony of Jeffrey Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America) (stating that Japan and Europe provide fashion designs legal protection); see also id. at 88 (statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (urging Congress to learn from the "European experience" where protection is ineffective). For a critique of Professor Sprigman’s assertion about ineffectiveness, see infra note 209.} Japan's design protection does not provide a good example to Congress because the protection is similar to existing U.S. patent protection. The Community design system in the European Union, however, provides a better comparison. Though several other countries and individual member states of the European Union offer design protection,\footnote{See, e.g., Industrial Design Protection, supra note 105, at 461–74 (statement of Ralph Oman, Register of Copyrights and Assistant Librarian for Copyright Services) (summarizing the sales in 2006 accounted for 6\% of all apparel sales. Id. Though seemingly small, $13.8 billion is more than the $12 billion estimated by Congress as lost by the fashion industry because of design pirates. Supra note 8 and accompanying text.} only Japan's...
and the European Union’s protections are analyzed here because of their importance to witnesses before Congress.\(^{166}\)

1. Japan

Japan’s Design Law protects the "form, pattern, or color of an object or a combination of these, which appeals visually to the viewer’s sense of aesthetics."\(^{167}\) From this definition, Japan’s protection appears comparable to the Design Piracy Bills: Each protects the overall form or appearance of the article and each arguably has an attractiveness requirement.\(^{168}\) But stating that Japan’s protection is something that Congress should aspire to in creating fashion design protection is something of a red herring. Japan’s design protection more closely analogizes with patent protection already in place in the United States, not a new copyright-like form of protection for fashion designs.

Japan’s requirements include visual appeal to aesthetic sense, industrial usability, novelty, ease of creation, and uniqueness.\(^{169}\) The novelty requirement under Japan’s design law—"[n]o identical or similar design" was "in existence protection offered by the United Kingdom, France, Germany, Italy, Australia, and Japan). For a summary of design protection offered in Canada, see Canadian Intellectual Property Office, Industrial Designs, http://strategis.ic.gc.ca/sc_mrksv/cipo/id/id_main-e.html (last visited Feb. 28, 2008) (on file with the Washington and Lee Law Review). Even online virtual reality games are offering virtual fashion designers intellectual property protection. See Alan Sipress, Where Real Money Meets Virtual Reality, The Jury Is Still Out, WASH. POST, Dec. 26, 2006, at A1 (reporting that Linden Labs, creator of the online fantasy world Second Life, recently granted creators of virtual designs, including fashion designs, intellectual property protection over their designs). "[C]reators have intellectual property rights to the software patterns used in making virtual objects but no rights to the objects themselves. Under this formulation, [a designer] owns her designs but not the individual dresses and pieces of underwear." Id.

\(^{166}\) See supra note 164 (noting that congressional witnesses used Japan’s and the European Union’s protections to bolster arguments in support of and against the enactment of House Bill 5055).


\(^{168}\) For the definition of "fashion design" under the Design Protection Bills, see supra note 21 and accompanying text.

\(^{169}\) See Japan External Trade Organization, Investing in Japan § 5.7.1, supra note 167 (setting forth the criteria and examination criteria). "Visual Appeal to Aesthetic Sense" is described as the limitation that "[o]bjects whose form cannot be recognized by the human eye, such as a single grain of powder, do not meet this criterion." Id.; see also supra notes 145–46 and accompanying text (suggesting possible implications of an "attractiveness" standard for fashion designs should the Design Piracy Bills be codified). "Industrial usability" refers to the ability for mass-production of the item. Japan External Trade Organization, Investing in Japan § 5.7.1, supra note 167.
before the application was made; in other words, the design must be completely new.\textsuperscript{170}—essentially mirrors the novelty standard in U.S. patent law. Further, the "ease of creation"—design must have creativity to be registered—and "uniqueness"—design cannot be similar to already existing designs, registered or not—standards resemble the "nonobviousness" requirement in patent law.\textsuperscript{171}

The Japanese Design Protection system is also similar to U.S. patent protection in terms of registration and term of protection. Japan's protection starts on the date of registration and lapses at the end of twenty years or upon the failure of the designer to pay an annual fee.\textsuperscript{172} Examination for a registration application under Japan's Design Law takes a minimum of three months and an average of six months, with another month or two required for the actual registration process.\textsuperscript{173} Though Japan's time frame is much smaller than the thirty months necessary to obtain patent protection in the United States,\textsuperscript{174} the process is too long to effectively protect fashion designs. Protection is hardly relevant eight months after creation.\textsuperscript{175}

Given the more difficult requirements, it is doubtful that Japan's law offers real protection for fashion designs. A cursory search of Japan's online Design Gazette, where registered designs are published, listed items such as a toothbrush, a plastic storage container with lid, a fish tank filter, a sink with moveable cooking stove, and a lace pattern,\textsuperscript{176} but no fashion designs. Further,
the lace pattern—the only item possibly related to articles of apparel—could be protected through current U.S. copyright law, which clearly allows for the registration of original fabric patterns and designs.177 Thus, it appears that Japan’s design protection system does not closely resemble the type of design protection the Design Piracy Bills envision for the United States. Unlike Japan’s Design Law, the Community design system in the European Union appears more in line with the intent of the Design Piracy Bills.

2. The European Union

The Community design system defines a design as "[t]he outward appearance of a product or part of it, resulting from the lines, contours, colours, shape, texture, materials, and/or its ornamentation."178 Though similar to the definition of "fashion design" under the Design Piracy Bills, this definition is far more specific and superior to the overly general definition provided under the Design Piracy Bills. Also, the requirements for protection are similar to those required under the Design Piracy Bills. The Community design system imposes the requirements of "novelty" and "individual character" for registered designs.179 However, the Community design system uses the following database, where all registered designs are published, is available at http://www4.ipdl.inpit.go.jp/isyous registrazione ipdl?N0000=3100 (last visited Dec. 3, 2007). Unfortunately, unlike the searchable database for the European Union, searches can only be conducted through registration number. Thus, the items above were the result of a random selection of design registration numbers.

177. See Registrability of Costume Designs, Policy Decision, 56 Fed. Reg. 56,530, 56,531 (Nov. 5, 1991) (stating that fabric design is usually eligible for copyright protection); see also supra note 18 (discussing Diane von Furstenberg’s recent lawsuit against Forever 21 for copyright infringement of protected fabric designs).

178. Office for Harmonization in the Internal Market, The Community Design, Frequently Asked Questions on the Community design, Question 1.1 [hereinafter FAQs on the Community Design], http://oami.europa.eu/en/design/faq.htm (last visited Jan. 29, 2008) (on file with the Washington and Lee Law Review). There are potentially three different design protections that a designer can apply for in Europe. According to an information bulletin by the Office for Harmonization in the Internal Market, most member states of the Union have their own design protection programs; there is a protection system under the Hague Agreement that includes forty-two countries, member and nonmember states; and there is the Community design program which applies to all members in the European Union. See Office for Harmonization in the Internal Market, How to Protect Your Design in the European Union, available at http://www.icsid.org/resources/case_studies/articles49.htm (last visited Feb. 28, 2008) (explaining the different forms of protection available to member states) (on file with the Washington and Lee Law Review). Unless specified otherwise, this Note only refers to the Community design system that is applicable for the European Union as a whole.

standard for novelty: No other "identical design" is available to the public at the time of registration or when the article is made public.\textsuperscript{180} This definition sounds more like the "originality" standard proposed under the Design Piracy Bills than the "novelty" standard used in patent protection.\textsuperscript{181} The Community regulation clarifies that "[d]esigns shall be deemed to be identical if their features differ only in immaterial details."\textsuperscript{182} The requirement of "individual character" is less clear: "A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public."\textsuperscript{183}

Like the protection proposed by the Design Piracy Bills, the Community design registration process is fairly simple; however, the Community design system goes one step further—registration is not required. Unregistered designs must meet the same qualifications as registered designs, but there is no registration process and no application fee.\textsuperscript{184} The term of protection is only three years for unregistered designs compared to the initial five-year term, with a maximum of twenty-five years of protection, for registered designs.\textsuperscript{185} The rights conferred to the design owner are the greatest difference between registered and unregistered Community designs. Registered Community designs give the owner exclusive use of the design and ability to prevent unauthorized parties from using the design.\textsuperscript{186} "Use" includes "making, offering, putting on the market, importing, exporting or using of a product in

\begin{itemize}
\item \textsuperscript{180} See \textit{id.} at art. 5 (defining the requirements for novelty).
\item \textsuperscript{181} See \textit{supra} note 134 and accompanying text (stating that originality would be required for a design registered under the Design Piracy Bills).
\item \textsuperscript{182} Council Regulation 6/2002, art. 5, 2001 O.J. (L 3) 4 (EC), \textit{supra} note 179.
\item \textsuperscript{183} \textit{id.} at art. 6. The regulation also states that individual character will be assessed based on "the degree of freedom of the designer in developing the design." \textit{id.} The degree of freedom is to be evaluated based on an objective view rather than a subjective view. \textit{See FAQs on the Community Design, \textit{supra} note 178, at Question 1.13 ("Thus sectors in which prior art (i.e. all pre-existing creations) is crowded or in which standardisation imposes many constraints will be considered to leave little freedom to designers.").}
\item \textsuperscript{184} \textit{See FAQs on the Community Design, \textit{supra} note 178, at Question 1.6 (discussing the differences between registered and unregistered Community designs).}
\item \textsuperscript{185} \textit{See Council Regulation 6/2002, art. 11, 2001 O.J. (L 3) 5 (EC), \textit{supra} note 179 (stating unregistered design protection lasts for three years beginning on the date the design is made public); see also \textit{id.} at art. 12 (L 3) 5 (EC) (providing that registered designs are protected for up to twenty-five years beginning on the date of filing).
\item \textsuperscript{186} \textit{See \textit{id.} at art. 19 (L 3) 7 (EC) (explaining the rights conferred by the Community design).}
\end{itemize}
which the design is incorporated or to which it is applied, or stocking such a product for those purposes. Unregistered designs, on the other hand, only confer the aforementioned rights if the protected design was copied. If the alleged infringing design was the result of independent work without knowledge of the protected design, then the original design owner cannot prohibit the distribution and use of the second design.

The Community design system easily compares with U.S. copyright protection. First, like copyright, the Community design system allows for fair use exceptions to infringement for personal, educational, and experimental purposes. Additionally, the respective courts presume the validity of the copyright or Community design upon a showing of registration. Litigants can challenge the presumption of validity under either protection system to support a finding of noninfringement of a protected article. Owners of unregistered articles have an uphill battle to prove infringement. Under copyright, an owner can rarely bring an action for an article that is not registered. Owners asserting unregistered Community design protection bear the burden of proving their article was eligible for protection.

There are important differences between the two protections. Under U.S. copyright law, registered and unregistered articles are protected for the same

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187. Id.
188. Id.
189. See id. ("The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.").
190. See id. at art. 20 (L 3) 7 (EC) (limiting the rights given to design owners). For copyright's fair use exception, see 17 U.S.C. §§ 107-112 (2000). Under the Design Piracy Bills, an education exception will exist for registered fashion designs. See id. § 1309(g) (providing an educational use exception for vessel hulls).
191. See id. at art. 20 (L 3) 20 (EC) (providing the elements of showing validity for Community designs). The same is true for copyright. See supra note 147 (discussing that registration within five years is prima facie evidence of validity).
192. See 3 NIMMER ON COPYRIGHT, supra note 118, § 12.11[A], at 12-196 (stating that courts may "examine the underlying facts" of a registration to rebut the presumption of validity); see also Council Regulation 6/2002, art. 85, 2001 O.J. (L 3) 20 (EC), supra note 179 ("Validity [of a registration] may be challenged only with a counterclaim for a declaration of invalidity.").
193. See 17 U.S.C. § 411 ("Except [for certain actions] no action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.").
194. See Council Regulation 6/2002, art. 85, 2001 O.J. (L 3) 20 (EC), supra note 179 (stating that the design owner must demonstrate that the item has individual character and prove the date that the article was made public).
length of time. Unlike with Community design, copyright protection for an article is not lost for failure to register within a certain number of years. For a registered Community design, applications must be filed within twelve months after creation. Uniquely, the Community design system appears to allow designers to obtain protection prior to the final creation of their design. A designer can file for registration but request a publication delay for up to thirty months in order to either finish the design or to strategically coordinate the release of the design. "This can be of vital importance in a sector such as fashion . . . where it is necessary to protect designs from competitors whilst arranging the production of the design into the final product."

Finally, the Community design system declines to protect designs that are against public policy or morality. There is no similar provision in the Design

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195. See 17 U.S.C. § 302 (stating the length of protection as the life of the author plus seventy years).

196. See supra note 71 (indicating the registration is completely optional).

197. See Council Regulation 6/2002, art. 7, 2001 O.J. (L 3) 5 (EC), supra note 179 (allowing registrations to be filed even though the design was made public during the twelve months prior to filing); see also FAQs on the Community Design, supra note 178, at Question 1.10 ("[T]he fact that you disclosed a new design before you filed an application does not render your registration invalid due to lack of novelty."). This delay can be helpful to a designer who wants to gauge the success of a design before expending money to protect it. See id. at Question 1.23 ("[The grace period] allows a proprietor the opportunity to determine whether seeking protection for a design is likely to be worth the money and time required."). Under the Design Piracy Bills, registration is required within three months of a fashion design being made public. Supra note 147 and accompanying text.

198. See Council Regulation 6/2002, art. 50, 2001 O.J. (L 3) 13 (EC), supra note 179 (stating that under a request for deferred publication, the Design will be registered but it will not be published until the end of thirty months or the date requested by the designer); see also FAQs on the Community Design, supra note 178, at Question 5.2 ("This period of confidentiality allows the applicant an opportunity to further develop his marketing strategy or to finalise the preparations for production without competitors being aware of his design."). Japan has a similar provision allowing for designs to remain secret upon application for registration. See Japan External Trade Organization, Investing in Japan § 5.7.3, supra note 167 ("Because designs are influenced so strongly by fads and fashions, and because some products' periods of popularity tend to end sooner than others', this [secret design] system aims to protect the rights of design-owners for a certain period of time."). Apparently the disadvantage of secret designs is that the rights of the design owner are limited. See id. (stating that this disadvantage results in infrequent use of the secret design system).

199. FAQs on the Community Design, supra note 178, at Question 5.2. This deferment does not necessarily convey protection on an idea, but would allow for registration of a design that is not one hundred percent complete.

200. For the European Union's refusal to protect designs "contrary to public policy or to accepted principles of morality," see Council Regulation 6/2002, art. 9, 2001 O.J. (L 3) 5 (EC), supra note 179. This same provision is present in Japan's design law. See Japan External Trade Organization, Investing in Japan § 5.7.1, supra note 167 (refusing to protect "designs that may breach public order and morals").
Piracy Bills, nor is there a similar provision in the body of copyright law in the United States. A public policy provision potentially adds an extra requirement for registration—the examiner has the option to make a qualitative judgment as to the appeal and worth of the design.

IV. The Practical Effects of Enacting Fashion Design Protection

On paper, design protection is an enticing progression of intellectual property law. However, application raises the concern that this appealing protection may not meaningfully protect fashion designers. If Congress cannot offer a system that actually protects fashion designers, implementing a "protection" system will burden designers. Although difficult to predict with certainty all of the consequences of fashion design protection, the experiences of the Community design system, discussed below, and the U.S. copyright system identify enough practical difficulties to discourage Congress from enacting the Design Piracy Bills.

A. The Argument Against Protecting Fashion Designs

Though the European Union's design protection applies to a broad range of articles, it is still a useful indicator of the probable effects of the Design Piracy Bills in the United States. In 2006, the European Union registered

201. "It is unclear whether the Register of copyrights has authority to deny registration of a claim to copyright in a work which . . . contains seditious, libelous, obscene or other matter which may be illegal or opposed to public policy but it is not concluded that he is without such power." Copyrights—Denial of Registration of Claims Because of Content, 41 Op. Att'y Gen. 395 (1958), available at 1958 WL 3597.

202. See Council Regulation 6/2002, art. 47, 2001 O.J. (L 3) 12 (EC), supra note 179 ("If the Office, in carrying out the examination . . . notices that the design for which protection is sought . . . is contrary to public policy or to accepted principles of morality, it shall refuse the application."). There is no affirmative evidence to support the contention that the public policy standard poses a barrier to registration and protection. However, it is interesting in light of the possibility that should the Design Piracy Bills be enacted unchanged, there is an attractiveness/distinctiveness factor, as discussed, supra note 141, that could operate similarly to the public policy standard in that it requires an examiner to make a value judgment about the object for registration. For example, if Versace wanted to register in the European Union his dress that Jennifer Lopez wore to the 2000 Grammy Awards, which received so much attention for its plunging neck line, would registration have been denied because it was against public policy or morality? Could the dress be considered attractive or distinct such that the Design Piracy Bills would permit registration?

203. This Note is concerned with the protection of fashion designs, thus, it examines the effects of the protection systems with regard to fashion designs only.
6,430 Community designs for clothing, shoes, and accessories. 204 Although Europe is a breeding ground for haute couture design houses, surprisingly fashion designs accounted for only 8.98% of all design registrations. 205 However, upon closer inspection, the numbers are readily explained. First, in the European Union, a designer can apply for protection in one of three ways: in an individual member state, with the World Intellectual Property Organization through the Hague Agreement, or with the Union-wide Community design system. 206 Therefore, the number of Community design registrations is not necessarily representative of all designs that have been registered for some form of protection. 207 More importantly, under the Community design system, registration is optional; 208 many designers may opt not to register because they are given three years of protection for free. 209


Professor Sprigman argues that this figure is polluted because not all of the designs are fashion designs and not all of them are registrable. Telephone Interview with Christopher Sprigman, supra note 6. Arguably, due to the broad definition of "design" under the Community design system, all of these items are fashion designs albeit not haute couture designs. Similarly, the broad definitions under the Design Piracy Bills of "design" and "apparel" would also potentially allow for all of these designs to be registered. It is true, however, that all of these designs may not be protected. In accepting registrations, applications are only reviewed to ensure that they meet the formal requirements of the Community design. FAQs on the Community Design, supra note 178, at Question 5.1. The review prior to registration does not include a determination of whether the application design infringes on an already registered or unregistered Community design. Id.

205. Statistics for Community Designs 2006, Breakdown by Class, supra note 204, at 11.

206. See supra note 178 (discussing the separate protection programs available).

207. Because a designer can file for protection with a member state as well as with the Community design protection, the number of Community design registrations may include designs that are also registered through another protection system. See Council Regulation 6/2002, art. 96, 2001 O.J. (L 3) 22 (EC), supra note 179 (stating that protection by Community design does not preclude protection under the laws of any member state).

208. See supra notes 184–89 and accompanying text (describing the unregistered Community design).

209. But see A Bill to Provide Protection for Fashion Design, supra note 6, at 88 (prepared statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (commenting that the failure for designers to register is indicative of an ineffective design protection system). See also Raustiala & Sprigman, supra note 2, at 1741–42 ("If design protection were an important element of success for fashion firms competing in the European Union, we would expect to see a higher rate of registration under the E.U.-wide scheme . . . ."). Contrary to Professor Sprigman's argument, low numbers of Community designs registrations do not necessarily translate to ineffective protection. Even though enforcing protection of an
Designers may also be unaware of the design protection system or unable to pay the registration fees.\textsuperscript{210} Whether registered or unregistered, all Community design owners are able to sue parties that make unauthorized copies of the protected design. In 2006, only seven cases regarding Community designs went before Community design courts.\textsuperscript{211} Possibly none of the infringement suits involved fashion designs.\textsuperscript{212} At first glance, this appears helpful to supporters of the Design Piracy Bills, who are confronted with the charge that fashion design protection will clog the courts and harm designers who are forced to defend themselves in costly litigation proceedings.\textsuperscript{213} Low numbers of infringement suits in the European

unregistered design is more difficult, \textit{supra} notes 186–89, 194, if the life of a fashion design is only three to six months, \textit{supra} note 28, designers may be willing to take the chance on a more difficult infringement battle than pay the registration fees for every design. Another possibility is that designers wait to register knowing that there is a twelve-month grace period. \textit{See supra} notes 197–99 (discussing the ability for a designer to delay registration and still obtain protection).

\textsuperscript{210} \textit{See} FAQs on the Community Design, \textit{supra} note 178, at Question 3.1 (providing the fee schedule for Community design registration). Registration of one design requires a €230 registration fee and a €120 publication fee. \textit{Id.} Fees per design decrease in the case where multiple designs are registered on one application. \textit{See id.} (stating that the registration fee for designs two through ten is €115 each and the publication fee for those designs is €60 each).

Using an exchange rate, as of February 18, 2008, of 1.4632 U.S. dollars to every 1 Euro, the registration would cost a designer €336.55 and the publication fee would cost $175.59. Yahoo! Finance, Currency Converter, \url{http://finance.yahoo.com/currency} (last visited Feb. 18, 2008).


\textsuperscript{212} Community design courts sit throughout the European Union, so not all of their decisions are published in English. \textit{See id.} (listing only one decision from 2005 in English); \textit{see also} The Office for Harmonization in the Internal Market, List of Community Design Courts, \url{http://oami.europa.eu/pdf/design/cdcourts.pdf} (last visited Feb. 28, 2008) (listing the European Union Community design courts).

\textsuperscript{213} Opponents of House Bill 5055 stated that increased litigation would result from the creation of fashion design protection. \textit{See A Bill to Provide Protection for Fashion Design, supra} note 6, at 14 (testimony of David Wolfe, Creative Director, The Doneger Group) (stating that House Bill 5055 will increase litigation and injunctions); \textit{see also id.} at 86 (testimony of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (raising the concern that House Bill 5055 will encourage frivolous infringement suits). Supporters of House Bill 5055 argue that the bill will "permit parties to engage in more straightforward, simpler litigation." \textit{Id.} at 85 (prepared statement of Susan Scafidi, Visiting Professor, Fordham Law School). Courts will no longer have to find creative ways under current intellectual property law to protect fashion designs under House Bill 5055, thus making litigation and infringement determinations simpler. \textit{See id.} (stating that House Bill 5055 will also "clarify the parameters of what constitutes protected design"). "As in other creative industries governed by intellectual property law, an equilibrium will arise and manufacturers will find it in their best interests to offer retailers innovative rather than infringing work." \textit{Id.}
Union, however, may not translate to low numbers of suits under the Design Piracy Bills in the United States. Assuming Community designs fail to deter piracy, the low number of infringement actions may indicate that fashion designers are content with the current realities of copying and borrowing innovative ideas from other designers. Additionally, differences between the court systems in the United States and the European Union arguably increase the likelihood of lawsuits in the United States: "Unlike in Europe where there is a weak civil litigation system, here in the States we have a very powerful civil litigation system and we are a society teeming with lawyers, including obviously a class of litigation entrepreneurs that accesses the Federal courts." 

Couple the increased litigiousness of Americans with highly ambiguous protective legislation, and the end result will likely be a large number of senseless lawsuits. Litigation in and of itself is not harmful if the courts are enforcing legitimate legal protection. Yet, if the U.S. cases regarding conceptual separability are indicative, lawsuits over protected fashion designs likely will hinge on the minutiae or ambiguity inherent in the Design Piracy Bills. Further, lawsuits will force designers to expend large amounts of money and time to protect clothing with a limited shelf life.

The better articulation of an argument against fashion design protection is a fear that courts will be unable to provide cost-effective, meaningful protection of registered designs given the cost of an attorney, court fees, and the time necessary to take a case to final adjudication.

214. *See id.* at 86 (testimony of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (stating that stores like H&M, Zara, and Topshop are three of the largest retail culprits of copying high end designs and selling them at affordable prices). Professor Sprigman argues that the fact that there is widespread copying and minimal litigation in Europe means that the design protection system has done nothing to affect the way the industry operates. *See id.* (stating further that the protection system is unnecessary). Minimal litigation could also be a result of pretrial settlement of infringement suits. *See Emily Dugan, Topshop Ordered to Destroy Dresses "Copied from Chloé Design," INDEPENDENT* (London), July 27, 2007, at 17 (reporting that Topshop recently settled a claim by Chloé by paying £12,000 and destroying 2,000 alleged copies of a Chloé dress).

215. *A Bill to Provide Protection for Fashion Design, supra* note 6, at 86 (testimony of Christopher Sprigman, Associate Professor, University of Virginia School of Law).

216. *See supra* Part II.B (describing the confusion of courts trying to apply conceptual separability).

217. *See supra* note 28 (estimating the life of a fashion design to be between three and six months).

218. If the Design Piracy Bills are enacted, the court will have discretion to award attorneys’ fees to the party that is harmed by an infringement suit. *See 17 U.S.C. § 1322(b) (2000) (allowing for the award of reasonable attorneys fees); see also* H.R. 2033, 110th Cong. (2007) (failing to amend 17 U.S.C. § 1322(b)); S. 1957, 110th Cong. (2007) (same); H.R. 5055, 109th Cong. (2006) (same). However, attorneys’ fees are not guaranteed, meaning that
The number of infringement actions in the European Union also is not a good indication of potential effectiveness because the number fails to take into account alternative means of resolution, including cease-and-desist letters, private settlements, and even private licensing agreements. More importantly, the number of lawsuits may be low because there are very few acts of infringement. If the Community design protection were effective, one would expect the amount of copying to decrease. Yet, significant evidence supports the contention that copying in the design industry is rampant. Thus, the best indication of ineffectiveness is a closer examination of the designs that are registered.

As previously mentioned, a protected Community design must not be identical to any other design and must have individual character. Based on a survey of designs registered for Community designs in 2006, these requirements are not strong barriers to protection. For example, in 2006, Nike registered 471 designs. One hundred of these designs are shirts that are remarkably similar in appearance with minimal variance. Differences between the shirts are as slight as fabric color, color of trim, color of accent fabric, presence of stripes, slightly longer length of the back of the shirt, slightly longer litigation could still be expensive for designers who are victims of infringement.

219. For these possibilities, I do not have information to show if they are effective ways that designers handle infringement. I only point them out as possibilities to explain how the system may still be working effectively without leaving a paper trail in the courts.

220. See A Bill to Provide Protection for Fashion Design, supra note 6, at 86 (testimony of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (identifying several "European fashion firms that copy and that reinterpret and that recontextualize and that create derivative works" of other fashion designs).

221. See supra notes 178–83 and accompanying text (discussing requirements for Community design).

222. Of course, registration does not necessarily mean that the item is protected because it is possible that a court will later find that the registration was invalid. See supra note 192 and accompanying text (stating that the presumption of validity can be challenged). Community design applications are only reviewed for formalities, to ensure a design is the subject of the application and to ensure the design is not against public policy. See FAQs on the Community design, supra note 178, at Question 5.1 (stating that applications are mainly reviewed for formalities). Yet, registration offers some protection to the design if the only way to challenge validity is through a court proceeding and thus the fact that so many drastically similar designs are registered indicates that the formal standards for design protection in application are not difficult to meet. For the searchable database of registered Community designs, see Office for Harmonization in the Internal Market, RCD-Online Design Consultation Service, http://oami.europa.eu/RCDOnline/RequestManager.

223. In searching the Community design database, I used the following criteria: Owner, Nike; Filing Date, from January 1, 2006, to December 31, 2006; Locarno Class, 02. For the database search engine, see supra note 222. For the proper Locarno Classification, see supra note 204.
sleeves, or the presence of a patch on the front of the shirt. If the registration of these near-identical designs indicates the threshold that must be met in order to have a new, protection-eligible Community design, the protection conferred is virtually meaningless. It appears that everything short of an exact replication of an existing design would be a new design and thus legal. Therefore, it is highly possible that an alleged knockoff is really not an infringing design but instead a design that is independently eligible for registration because it meets the low threshold for Community design protection. This does not mean that a more stringent standard would render the Community design protection more effective. Under a more difficult standard there is greater risk that a designer will obtain a monopoly over an entire fashion trend and stifle industry creativity.

The same situation could potentially unfold if the Design Piracy Bills pass congressional muster. The standard proposed for new, registration-eligible fashion designs under the Design Piracy Bills is originality; however, as previously discussed, originality is not difficult to meet. Because the proposed system under the Design Piracy Bills requires registration, one can

224. Merely paging through the online pictures of the Nike shirts reveals minor details from design to design. Consider, for example, design number 000465372-0010 and design number 000465372-0009. Registered Community Design, Reg. No. 000465372-0010 (filed Jan. 20, 2006); Registered Community Design, Reg. No. 000465372-0009 (filed Jan. 20, 2006). Both are for athletic shirts that are the same shade of orange, accented with two bands of blue stripes on the sides of the shirts and blue lining around the neck and arm holes. The only difference was that 000465372-0009 has a blue patch on the front left chest. Potentially, there could be other differences that I am not skilled at noticing, however, if I am unable to discern possibly more important differences, how will a jury of twelve untrained persons be able to identify when a design has been infringed upon? See infra note 250 and accompanying text (discussing the difficulties with the test for infringement).

As a side note, though the registered designs above are distinguishable by only one digit, they are two separate design registrations. The first nine digits of the number refer to the application number and the last four digits refer to the design number on the application because multiple designs can be included for individual registration on the same application. See Telephone Interview with Eva Vyoralova, Examination Coordinator, Design Dep't, Office for Harmonization in the Internal Market, in Alicante, Spain (Jan. 28, 2007) (clarifying that each unique design number is made up of a nine-digit root number and a four digit sequence number) (on file with the Washington & Lee Law Review).

225. See supra note 184 and accompanying text (stating that registered and unregistered Community designs have the same qualification requirements).

226. If a designer were to identically copy registered Community design number 000465372-0009 but shorten or remove the designs, there is a good argument that this is a completely new design that is eligible for its own protection, registered or unregistered. See supra note 224 (describing Community design number 000465327-0009).

227. See supra notes 134–47 and accompanying text (setting forth the requirements proposed by H.R. 5055); see also supra note 136 and accompanying text (stating that originality is a minimal standard).
easily imagine a situation in which a designer would file registrations for hundreds of designs that vary only slightly to ensure protection of a design and its derivatives.\textsuperscript{228} The other likely scenario is when the owner of a protected design sues for infringement but is denied relief because the differences between the two articles are just enough to constitute a new design. In those situations, the protection offered by the Design Piracy Bills is useless.

The protection proposed under the Design Piracy Bills defines "infringing article" as "any article the design of which has been copied from a design protected under this chapter, or from an image thereof, without the consent of the owner of the protected design."\textsuperscript{229} This definition implies that a design copied from a protected design, even if modified to be original, will still be an infringing article. However, the protection offered under the Design Piracy Bills is meaningless due to what is missing from the definition of "infringing article": "A design shall not be deemed to have been copied from a protected design if it is original and not substantially similar in appearance to a protected design."\textsuperscript{230}

Substantial similarity has long been used as a test to prove copyright infringement.\textsuperscript{231} "Two works are substantially similar where 'the ordinary observer, unless he set out to detect the disparities, would be disposed to

\textsuperscript{228} Fees may actually be the only deterrent. As of July 1, 2007, the Copyright Office charges $35 per registration for applications filed electronically and $45 per registration for applications filed on paper. U.S. Copyright Office, Current Fees, http://www.copyright.gov/docs/fees.html (last visited Feb. 28, 2008) (on file with the Washington and Lee Law Review). However, these fees are lower than those for registered Community designs, supra note 210, and those fees have not deterred some companies such as Nike from registering multiple designs, supra note 223 and accompanying text.


\textsuperscript{230} 17 U.S.C. § 1309(e) (2000); see also H.R. 2033, 110th Cong. § 2(d) (failing to amend this portion of 17 U.S.C. § 1309(e)); H.R. 5055, 109th Cong. § 1(d) (2006) (same). Senate Bill 1957's proposed exclusion is slightly different: "In the case of a fashion design, a design shall not be deemed to have been copied from a protected design if it is original and not closely and substantially similar in overall visual appearance to a protected design." S. 1957, 110th Cong. § 2(d)(2)(C) (2007). The Senate Bill adopts Professor Scafidi's desired test for infringement, infra note 268, however, "closely and substantially similar" does not improve upon the ambiguity of the current test of "substantially similar." For a discussion of proposed tests for infringement, see infra notes 267-79.

\textsuperscript{231} To show copyright infringement, a plaintiff must show a valid copyright and must show that original elements of the copyrighted work were copied. See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991) (providing a two-part test to show actionable infringement). Proof of the second requirement is accomplished through another two part test: (1) factual copying and (2) substantial similarity. See 4 NIMMER ON COPYRIGHT, supra note 118, § 13.01[B], at 13-8 to -9 (stating that both prongs are required to show infringement).
overlook them, and regard the aesthetic appeal of the two works as the same." Though several tests have been constructed to determine substantial similarity, this standard has been difficult for courts to clearly address. The lack of clarity stems, in part, from the fact that the degree of similarity necessary to show infringement depends on the amount of creativity contained in the protected work. The Supreme Court recognizes some copyrightable works as "thin," meaning that the amount of creativity present is just enough to satisfy the requirement of originality. In such instances, the degree of similarity needed to show substantial similarity is higher than in cases where the work is "robust" with creativity.

Fashion design protection would protect the "appearance as a whole of an article of apparel." Because the protection is concerned with the appearance as a whole, even the slightest alteration could completely change the appearance of the article. After all, the design is a byproduct of several elements pieced together, including ornamentation, to create the final article.

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233. See 4 Nimmer on Copyright, supra note 118, § 13.03 (discussing various approaches to substantial similarity).

234. See id. § 13.03[A], at 13-34.1 (stating that substantial similarity is one of the "most difficult questions in copyright law").

235. See id. § 13.03[A], at 13-34.2 (stating that the substantiality of the similarities is dependent upon circumstances of creativity).

236. See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 348 (1991) (identifying a telephone directory as thin because the creativity is found only in the selection and arrangement of information included); see also 4 Nimmer on Copyright, supra note 118, § 13.03[A], at 13-35 (differentiating between works that are "robust" and works that are "thin" based on the level of creativity put into the creation of the work).

237. See 4 Nimmer on Copyright, supra note 118, § 13.03[A], at 13-35 (suggesting that to show infringement of works with minimal creative elements, "supersubstantial' similarity should be required). In assessing whether Microsoft's graphical user interface infringed on Apple's copyrighted interface, the Ninth Circuit held that the creativity in Apple's interface was minimal. See Apple Computer v. Microsoft Corp., 35 F.3d 1435, 1439 (9th Cir. 1994) (stating that because the "creative expression" was low, "virtual identity" was the proper test for determining infringement).


239. See supra notes 136-40 and accompanying text (discussing that originality is easily accomplished through the rearrangement of already existing elements); see also supra notes 222-26 and accompanying text (observing that minor differences in color, sleeve length, etc., justify new registration-eligible designs under the European Union design protection).

240. See supra note 21 and accompanying text (including ornamentation in the definition of fashion design).
"Fashion design is about creating compilations of elements." But intellectual property law fails to independently protect these elements. In that way, a protectable fashion design is similar to a copyrightable compilation of facts, such as a telephone directory or a cookbook—the creativity is in the arrangement and selection of otherwise nonprotectable elements. Thus, the amount of creativity in a fashion design would not be very high, correlating to the use of a more strict substantial similarity test. Infringing articles of registered fashion designs, accordingly, will be extremely rare if a subsequent article of apparel does not use all of the same elements in the same manner as the original registered design.


242. Conceptual separability in copyright law does at times provide protection for elements of fashion apparel, however, such protection is difficult to achieve because functionality serves as almost an absolute bar to protection. See supra Part II.B (discussing the difficulty for courts in applying conceptual separability); see also infra notes 257–58 and accompanying text (arguing that registration of a fashion design would preclude conceptually separable elements of the article of clothing from being copyrighted).

243. The statutory definition of "compilation" is "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (2000).

244. See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 358 (1991) (stating that some collections of facts are copyrightable). "Facts are never original, so the compilation author can claim originality, if at all, only in the way that the facts are presented. To that end, the statute dictates that the principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection." Id. Ultimately, Feist Publications found that the arrangement of names and telephone numbers in a telephone directory did not rise to the level of originality necessary to enable the work to be copyrighted. See id. at 363–64 (suggesting that if the telephone directory were found to be original then everything would be original); see also Publ'ns Int'l v. Meredith Corp., 88 F.3d 473, 482 (7th Cir. 1996) (finding that a valid copyright for a cookbook as a whole did not extend protection to the individual recipes and thus they were able to be copied without infringement).

245. See Feist Publ'ns, 499 U.S. at 349 (finding that the "copyright in a factual compilation is thin" and thus another compiler can use some of the same facts in a subsequent publication "so long as the competing work does not feature the same selection and arrangement"); see also supra note 138 and accompanying text (stating that a fashion design is created only by the arrangement of "existing elements in a different way"); A Bill to Provide Protection for Fashion Design, supra note 6, at 180 (testimony of Susan Scafidi, Visiting Professor, Fordham Law School) (suggesting that "substantial similarity" may be too broad and instead proposing a standard of "closely and substantial similar"). Several other verbalizations of substantial similarity have been suggested as possible replacements in House Bill 5055. Infra notes 268–71 and accompanying text.

246. The counter argument would be that originality is not such a low standard such that changing the hem length or the sleeve length would result in a new original design. However, if originality is not a low bar, it will be very difficult for any new article of clothing to obtain protection because anything in the entire world that exists three months prior to registration is within the public domain. Infra note 284. Thus, originality must be a minimal standard or else the
Defining the "ordinary observer" causes another problem with the substantial similarity test. At the hearing for House Bill 5055, Representative Lamar Smith presented the witness panel a photograph of a Diane von Furstenberg dress and a photograph of what he considered to be an infringing knockoff design. Jeffrey Banks, a fashion designer, responded that in fact the two dresses were not the same at all, in part because the fabric was different and also because the original was a wrap dress with cap sleeves, whereas the alleged "knockoff" was a slip-dress silhouette. If Congress cannot identify readily apparent differences such as these, how can a jury of twelve lay persons be expected to make an accurate decision as to whether or not two items are substantially similar? Thus, the question of infringement is a question best left

number of protection-eligible designs will be so small the protection would not be worth the administrative fees necessary to implement the protection.

247. See supra note 232 and accompanying text (stating that substantial similarity is determined by the ordinary observer).

248. See A Bill to Provide Protection for Fashion Design, supra note 6, at 179 (statement of Rep. Lamar Smith, Chairman, Subcomm. on Courts, the Internet, and Intellectual Property) (inquiring of the panel how copyright would work in this situation where the polka dots on the dresses were slightly different in size).

249. See id. at 179 (testimony of Jeffrey Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America) (stating that the two dresses shown were not copies of each other and in his opinion, a court would not find that they were substantially similar). David Wolfe brought jean jacket props to the hearing to demonstrate his opinion that though different, there was nothing original about any of them. See id. at 14 (testimony of David Wolfe, Creative Director, The Doneger Group) (arguing that courts would be unable to effectively define originality and thus be unable to identify infringing articles). Mr. Banks dismissed Mr. Wolfe's argument because Mr. Banks indicated that the jean jackets would not be eligible for protection because they were commonplace. See id. at 179 (testimony of Jeffrey Banks, Fashion Designer, on behalf of the Council of Fashion Designers of America) ("The jean jackets that David showed us, that is something that is commonplace.").

250. Determination of copyright infringement usually has two parts: the extrinsic test and the intrinsic test. See 4 Nimmer on Copyright, supra note 118, § 13.03[E][3][b][i], at 13-108 (articulating the tests for infringement). The extrinsic test involves expert assistance in sorting out all the elements of the articles at issue that are not eligible for protection because they are not original. See id. (explaining the role of expert testimony under the extrinsic test). The protection-eligible elements are identified the question of substantial similarity is presented to the jury under the intrinsic test. See id. (stating that expert testimony has no place in the intrinsic test). The concern with fashion designs is that if the protection applies to the design as a whole the unoriginal elements cannot be separated out because they are necessary in the determination of originality. Thus, an expert cannot provide the traditional assistance in a fashion design infringement suit as is associated with a copyright infringement suit.

Of course, there may be some clear cases when two articles are so similar that one is an infringement of a registered fashion design, but there is a strong fear that litigation could be rampant as a result of this protection. Also, it is not necessarily the case that larger haute couture design houses will bring suit; it may not be beneficial financially for them to do so. But what about an individual who brings claims against a large design house arguing that the design house
Setting aside the concern that slight variations will be seen as new, original designs as opposed to infringements, there is also the concern that design pirates have the ability to mix and match portions of designs without coming close to infringement. For example, assume Prada registers a new dress for design protection. The dress incorporates a floor-length A-line skirt with a unique and intricate bodice decorated with non-useful suspenders. A design pirate then copies the bodice of the registered dress and couples it with a ballerina skirt, creating a completely different overall appearance. This new dress is eligible for registration under the Design Piracy Bills because its "appearance as a whole" differs from the original registered Prada dress. Thus, the very unique and creative bodice could be legally copied, point for point, because infringement is based on the design as a whole as opposed to portions of the design.

One way around this loophole is to enact partial design protection similar to that adopted by Japan in 1998. The European Union also offers protection to design portions so long as they are visible during normal use of the designed item and have novelty and individual character. Conceptual separability arguably could be used to protect portions of protected designs under the

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wrongfully "pirated" a design? This situation could potentially expose the larger fashion designers to expensive litigation and other record keeping expenses in order to defend lawsuits brought against them. There are also concerns about reputational harm and negative press.

251. See infra note 282 and accompanying text (proposing the creation of an infringement panel to make decisions as opposed to leaving the question to a jury).

252. This description is not inspired from an already existing dress of Prada or any other designer. In fact, the suggested design may not even be attractive, stylish, or original.

253. See supra note 21 and accompanying text (defining "fashion design"). The eligibility of this design for registration assumes that no other design already exists prior to creation.

254. Initially the statutory language appears to prevent the copying of design portions through the definition of "originality." "Originality" is found where the variation is "more than merely trivial and has not been copied from another source." 17 U.S.C. § 1301(b)(1) (2000); see also H.R. 2033, 110th Cong. (2007) (failing to propose amendment to the explanation of originality under § 1301(b)(1)); S. 1957, 110th Cong. (2007) (same); H.R. 5055, 109th Cong. (2006) (same). Thus, Prada could argue that because the design pirate copied a portion of its original dress the pirated dress could not be original because it resulted from copying. The main problem with this argument is that the item protected under the proposed fashion design protection is the design as a whole. See supra note 21 and accompanying text (defining "fashion design"). The pirated dress can still be original because the pirate did not copy the article as a whole but just a portion of the article.

255. See Japan External Trade Organization, Investing in Japan § 5.7.3, supra note 167 (stating that partial design protection allows design owners to sue pirates that copy portions of protected designs for infringement).

256. See Council Regulation 6/2002, art. 4, 2001 O.J. (L 3) 4 (EC), supra note 179 (stating that component parts incorporated into a protected design are eligible for protection).
Design Piracy Bills. Though conceptual separability would not likely protect the bodice of the Prada dress, it may protect the decorative, non-useful suspenders. Under traditional conceptual separability analysis, it would appear the suspenders are eligible for copyright so long as they meet the necessary originality requirement. However, once fashion design protection is obtained for the article, the suspenders are no longer separable. The fashion design protection proposed under the Design Piracy Bills would protect the entire design. Thus, the suspenders could not exist independently of the rest of the design without resulting in a completely different design.

Despite the significant technical and minute-detail complications posed by the creation of fashion design protection, is there really a public policy rationale for protecting a $200 billion industry? There are several other industries that, like fashion, do not have significant intellectual property protections—the furniture, food, and automobile industries. In 2005, sales in the furniture industry were over $111 billion; sales in the automobile industry, including parts and accessories, were nearly $900 billion; and sales in the food industry


258. See supra note 21 and accompanying text (defining "fashion design"); see also supra Part II.B (discussing conceptual separability as it applies to fashion designs). Currently the statute is worded so as not to preclude other intellectual property protections except for design patent. See 17 U.S.C. § 1329 (2000) (stating that if a design patent is obtained, protection offered under chapter 17 will terminate). But see id. § 1330 (allowing common law and trademark protections in conjunction with vessel hull design protection). Through the Design Piracy Bills Congress proposes to amend the statute to also allow copyright protection to exist in conjunction with design protection. See supra note 257 (providing the proposed amendment to 17 U.S.C. § 1330 by each of the Design Piracy Bills). Thus, it appears that Congress would still allow for portions of articles of apparel to be protected by copyright if they are conceptually separable while protecting the article as a whole. Arguably co-existent protections are impossible because if every element is necessary to creating a protectable fashion design, no elements are physically or conceptually separable from that fashion design. If Congress intends to allow conceptual separability to still apply to protected designs, clarification should be made as part of any possible design protection enactment.

259. See Raustiala & Sprigman, supra note 2, at 1765 (stating that food products are not eligible for copyright protection); id at 1766 (stating that recipes are not copyrightable because they describe methods and procedures); id at 1769 (stating that furniture designs are considered "useful articles" and thus are ineligible for copyright protection); see also A Bill to Provide Protection for Fashion Design, supra note 6, at 3 (opening statement of Rep. Howard L. Berman, Ranking Member, Subcomm. on Courts, the Internet, and Intellectual Property) (asking whether Congress should consider protection for furniture and auto parts in addition to fashion design protection).
were more than $915 billion. All of these industries have flourished despite the lack of meaningful protection. In fact, critics of fashion protection argue that the fashion industry has been able to flourish because of the lack of protection: "[C]opying fails to deter innovation in the fashion industry because, counter-intuitively, copying is not harmful to originators. Indeed, copying may actually promote innovation and benefit originators." If copying is beneficial, imposing copyright protections may, in effect, suppress creativity and originality in fashion designs. "[C]opyright for fashion design doesn’t make sense because it is a craft that is dependent on building from the past, ideas that came before. It’s evolutionary."

B. Suggestions to Improve Protection for Fashion Design

Several reasons are mentioned above as to why fashion design protection should not be enacted in the United States. There are additional reasons the Design Piracy Bills, as drafted, should not be enacted. Many elements of these Bills cannot be fixed and, thus, ultimately prevent the creation of effective design protection. Other elements of the Design Piracy Bills can and should be fixed by Congress in order to minimize the potential harm of fashion design protection. Modifications are important because the enactment of fashion design protection will surely spur other negative space industries to petition Congress for similar protection. If no alterations are made, then the Design Piracy Bills will serve as a model for future offerings of meaningless protection for automobiles or couches or cakes.

First, Congress must determine the scope of the fashion design protection legislation. "[T]he appearance as a whole of an article of apparel, including its

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260. U.S. CENSUS BUREAU, 2006 ANNUAL REVISION OF MONTHLY RETAIL AND FOOD SERVICES, supra note 15, at 4. The figure for the furniture industry does not include home electronics and appliances. Id. Additionally the figure for food sales includes sales in restaurants as well as sales in grocery stores. Id.

261. Raustiala & Sprigman, supra note 2, at 1691. This baffling result is what Raustiala and Sprigman call the "piracy paradox." Id. Their argument is that lack of protection is actually beneficial to designers who one season may be setting trends and another season copying trends. See id. at 1727–28 ("Some [designers] may originate more than others, but all engage in some copying at some point. . . . "). For the argument that creativity in the food industry is not stifled by the lack of protection, see id. at 1765.


263. See supra note 259 and accompanying text (identifying other industries that do not have the benefit of strong intellectual property protections).
ornamentation," does not specifically state what is actually being protected. Much of the foregoing discussion focused on the construction of articles of apparel—but what about the effect of changes in fabric type and fabric pattern? These two elements greatly affect the overall appearance of an article of apparel. For instance, imagine that a designer creates and registers an original denim dress, then another designer creates the same dress, thread-for-thread, but uses a knit fabric instead of the stiffer denim. The resulting articles of apparel have completely different overall appearances based on the way the fabric lies on the wearer’s body. Arguably, these dresses are two different registration-eligible designs. The same could be said of color or pattern because a red suit has a much different appearance than a black pinstripe suit. Unfortunately, the definition under the Design Piracy Bills is not clear as to whether fabric type and pattern should matter.

The European Union definition of "design" is perhaps worth adopting to more fully describe what is protected. The Community design system states that "design" is "[t]he outward appearance of a product or part of it resulting from the lines, contours, colours, shape, texture, materials, and/or its ornamentation." Community design law does not protect the material used to construct the design, but will protect a design that derives its uniqueness from the material used. To avoid confusion and inconsistency in application of fashion design protection, Congress must spell out whether fabric type and pattern may be considered in assessing originality. Also, Congress must determine whether fabric type and pattern differences will result in a determination that two articles are not substantially similar.

Second, once Congress has decided on a clearer definition for "fashion design," it should reconsider the use of the "substantial similarity" test for infringement. During the subcommittee hearings, those testifying proposed

264. See supra note 21 and accompanying text (defining "fashion design").

265. See supra note 22 and accompanying text (defining "design").

266. See FAQs on the Community Design, supra note 178, at Question 1.14 ("It is the appearance of the product to which the design is applied that is protected, and the fact that a product is made of wood may add something to this outward appearance.").

267. The test is not the only aspect of infringement that Congress should revisit. Under current copyright law, statutory damages cannot exceed $150,000. 17 U.S.C. § 504(c)(2) (2000). Under the Design Piracy Bills the maximum damages allowed would be the greater of $250,000 or $5 per copy. See H.R. 2033, 110th Cong. § 2(g) (2007) (proposing the amendment of 17 U.S.C. § 1323(a)); S. 1957, 110th Cong. § 2(g) (2007) (same); H.R. 5055, 109th Cong. § 1(g) (2006) (same). The Copyright Office suggested that damages allowed for infringement of copyright and infringement of design protection should be the same. See A Bill to Provide Protection for Fashion Design, supra note 6, at 215–16 (statement of the U.S. Copyright Office) (suggesting Congress also re-draft portions of the existing § 1323(a) to ensure clarity).
other tests as substitutes: "closely and substantially similar,"268 "line-for-line,"269 "virtually identical,"270 and "point-by-point."271 A new enunciation of the infringement test is necessary because substantial similarity does not indicate what a jury, judge, or panel of experts should look for in determining infringement. If the denim and knit dresses mentioned above would constitute two separate original designs, the best verbalization of an infringement test would be line-for-line. A line-for-line standard does not suggest that the test concerns itself with microscopic point-by-point exactitude.272 A slight adjustment to the hem or placement of a zipper would not cause a design to fail the test for infringement.273 Were this the case, it would be difficult for the original designer to reproduce identical copies given human error and machine error. Line-for-line is not concerned with the way articles of clothing are constructed, but rather with the appearance of each article.

Practically speaking, the substantially similar test and a general line-for-line test are identical. However, line-for-line better verbalizes the test for infringement because it clarifies what is actually being protected.274 Fashion

268. A Bill to Provide Protection for Fashion Design, supra note 6, at 180 (testimony of Susan Scafidi, Visiting Professor, Fordham Law School).

269. See id. (attributing the line-for-line test idea to Professor Sprigman).

270. Id. at 184 (statement of Rep. Lamar Smith, Chairman, Subcomm. on Courts, the Internet, and Intellectual Property).

271. Id. at 7 (testimony of Christopher Sprigman, Associate Professor, University of Virginia School of Law).

272. As mentioned above, fashion designs are "thin" on creativity. Under the definition of a fashion design, the appearance as a whole is considered. See supra note 21 and accompanying text (defining fashion design). Thus, if a zipper is moved or a skirt hem shortened, the articles are not substantially similar because the change creates a different appearance, a different appeal, and ultimately, a different design. This is not to say that varying visual appeal should necessarily warrant protection; however, if the Design Piracy Bills were drafted to prevent a buyer from purchasing a knockoff instead of purchasing the original, the purchaser has to want the original. If Prada makes a dress with a long skirt, and the purchaser likes the dress but would rather have a short skirt, then the consumer would not buy the Prada dress, but may buy a copy of the dress with a shorter skirt.

273. Professor Susan Scafidi disagreed. See A Bill to Provide Protection for Fashion Design, supra note 6, at 180 (testimony of Susan Scafidi, Visiting Professor, Fordham Law School) (arguing that under a line-for-line test, moving one button or changing the hem results in a different, noninfringing design).

274. The concern is that a test of "substantially similar" will semantically seem to indicate a more flexible test. However, as mentioned above, because fashion designs are similar to "thin" copyright works such as compilations of facts, in that there are minimal amounts of creativity used to create the end product, a stricter form of "substantial similarity" is needed to test infringement for fashion designs. See supra note 236 and accompanying text (describing the definition and treatment of "thin" creative works). "Line-for-line" thus sounds more rigorous than "substantially similar" and will help ensure a more limited finding of infringement.
design protection is not intended to protect trends, but to protect the appearance of an article of apparel. \footnote{See \textit{A Bill to Provide Protection for Fashion Design}, supra note 6, at 6 (statement of Rep. Bob Goodlatte, Member, Subcomm. on Courts, the Internet, and Intellectual Property) (stating that the Council of Fashion Designers of America specifically did not want the proposed fashion design protection to protect trends).} Particularly problematic is that every design traces back to a preexisting design or trend. Recognizing that even minute differences in apparel designs can impact the overall look of an article, a line-for-line test ensures that protection is only extended to individual designs, as opposed to trends. Considering again the Diane von Furstenberg dress and purported copy that were discussed at the hearings on House Bill 5055, Representative Smith clearly thought the dresses were substantially similar. \footnote{See supra notes 248-49 and accompanying text (discussing the comparison of the dresses during the congressional hearing).} In taking the opposite position, fashion designer Jeffrey Banks relied on the lines of the dress—the cut, the shape, and the way the dress hung on the wearer—to differentiate the dresses. \footnote{\textit{Id.}}

The main problem with a line-for-line or a substantially similar standard appears when a court asks a jury of lay persons to determine infringement. Theoretically, this should not be a difficult evaluation for a juror to make with the help of an expert and instructions from a judge:

"Fashion is a visual medium like sculpture or painting. And it has its own system of recordation of elements. We have words to describe lapels. We have a color system to describe shades of colors. An expert in the field would have no difficulty making those very specific comparisons using the notion of the industry in which we are not all literate, but we all have a sense of how it works."

When a fashion magazine . . . publishes an original and a knockoff next to one another, the public recognizes that that is a knockoff, whether or not it is a literal line-for-line copy or whether it is something that is substantially similar. \footnote{\textit{Id.}}

Additionally, jurors frequently apply substantial similarity standards in copyright infringement cases concerning works of art produced through other mediums; in that sense, how is the comparison of two fashion designs different from the comparison of two sculptures or paintings? \footnote{\textit{A Bill to Provide Protection for Fashion Design}, supra note 6, at 191 (testimony of Susan Scafidi, Visiting Professor, Fordham Law School).} In practice, however,
differences exist, which make infringement of fashion designs a better question for a panel of experts than for a jury of twelve.

One important difference between copyright protection and fashion design protection is the length of protection and the life of the creation. If a designer brings an action for infringement of a registered design, it may take several months to pull together a court and jury to decide whether something is actually an infringement. By the time a court reaches a final infringement decision, the design may be obsolete and any preliminary injunction or intermediate action taken by the court may have hurt the party who was lawfully entitled to use and license the registered design. Instead, if a panel of fashion experts were assembled to make decisions, not only would the decisions be made faster, but the panel would be better trained in fashion designs and, therefore, better able to identify infringements. This would create greater consistency and may discourage frivolous infringement suits.

Additionally, sculptures and paintings have benefited from copyright protection for many years. As the production of artwork increased through industrialization and mass production, copyright law adapted to changes within the industry. With regard to fashion design, the proposed protection would exclude more from protection than it would protect—everything already in the

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280. In 2005, the median length of time it took for a federal civil suit to come to final disposition was 9.5 months. ADMIN. OFFICE OF THE U.S. COURTS, JUDICIAL BUSINESS tbl.C-5 (2005), available at http://www.uscourts.gov/judbus2005/appendices/c5.pdf. With regard to those civil suits that actually went to trial, the median length of time from filing to final disposition was 21.8 months. Id. If a fashion design's life is only three to six months, any claim filed for infringement would jeopardize the value of the protection.

281. See supra note 28 (estimating the life of a fashion design as three to six months). The same is not true of copyright, where a work of art may be popular and desirable well past the expiration of protection.

282. A separate agency would not be necessary to handle infringement actions for fashion designs—this could simply fall under another arm of the U.S. Copyright Office which would be designated to oversee the registration process of any enacted fashion design protection. See 17 U.S.C. § 1331 (2000) (stating that the U.S. Copyright Office is responsible for administering the protection offered under chapter 13 of title 17); see also H.R. 2033, 110th Cong. (2007) (proposing to add fashion design protection to chapter 13 of title 17 of the U.S. Code); S. 1957, 110th Cong. (2007) (same); H.R. 5055, 109th Cong. (2006) (same).

283. Quicker resolutions of infringement claims means a plaintiff could not hold another designer with a legitimately registered design hostage by either obtaining an injunction or by forcing the designer to settle the lawsuit. It may be necessary to have a specialized fashion expert—who, for example, knows shoes when Oscar de la Renta brings suit for infringement of a pump or who specializes in ball gowns when Prada brings suit for infringement of one of its red carpet numbers. In the interest of speed, arbitration may be the best means for settling design infringement allegations. Each party could appoint one expert for the reviewing panel and, in turn, these experts could appoint a neutral fashion design expert from the applicable fashion field.
public domain would be ineligible for protection. It would, therefore, be more beneficial to have experts, who are well versed on previous and current fashion designs, determine if an infringement of a registered design exists and determine a registration's validity.

The final problem with jurors as "ordinary observers" stems from the notion that fashion is part of everyone's life, whether haute couture or bargain-bin fashion. As a result, it may be difficult for jurors to discard their personal and subjective notions of fashion choice and fashion appeal when making an evaluation of registrability and infringement.

Another complication arises concerning the commencement of protection. As previously mentioned, protection for fashion designs would begin on the earlier of the date of publication or the date of registration. However, the fashion designing process does not necessarily begin with cutting and sewing; many designers first sketch out designs prior to creation. Assuming the sketches of design ideas are original, these sketches are eligible for copyright protection from the date they are created. Possible unfairness could result from a situation in which Designer A creates sketches of a pantsuit but Designer B actually creates the pantsuit depicted in the sketches. Designer A has rights

284. See H.R. 2033, 110th Cong. § 2(b)(3) (2007) (proposing amendment of 17 U.S.C. § 1302 to exclude from protection all fashion designs in existence more than three months prior to the date of registration); S. 1957, 110th Cong. § 2(b)(3) (2007) (same); H.R. 5055 § 1(b)(3) (2006) (same). Accordingly, every design that exists three months prior to the effective date of fashion design legislation is definitely in the public domain. A plaintiff could register a design identical to one in the public domain if she did not know about the earlier design and did not copy it. 17 U.S.C. § 1301(b)(1) (2000). Nevertheless, the introduction of evidence by the defendant of an earlier identical design in the public domain makes a prima facie showing that the plaintiff copied the design in the public domain. Id. § 1309(f). The plaintiff then must show originality of her design and lack of copying of the prior design. Id. Additionally, the defendant can also argue that instead of copying plaintiff's design he copied the public domain design, which is not an infringing act. Id. § 1309(a).

285. See supra note 231 (stating that the first element of showing copyright infringement is showing ownership of a valid copyright). Though copyright registration is presumed to represent a valid copyright, see supra note 147, the presumption can be rebutted. See 3 NIMMER ON COPYRIGHT, supra note 118, § 12.11[A], at 12-196 (stating that validity can be challenged).

286. See supra note 232 and accompanying text (stating that infringement is determined from the viewpoint of an ordinary observer).

287. Imagine, for instance, an infringement action over a pair of bell-bottom-inspired jeans. The Generation X jury members may approach questions of registration and infringement differently than the Baby Boomer jury members, who lived through the bell bottom trend of the 1970s. Of course, the same risk is run in an infringement suit involving abstract art—there will be some jurors who will not be capable of finding the "art" in the work and others jurors who will be much more appreciative of the nuances.

288. Supra note 133.

over the sketches, such that were Designer B to copy them without permission, Designer A could sue for infringement.290 Designer A, however, cannot sue Designer B for infringement just because Designer B actually created the item depicted in Designer A’s sketches.291 Even more ironic is the fact that should Designer B file for design protection of the created pantsuit, Designer A could be penalized for creating the article depicted in the sketches because it would be an infringement of Designer B’s protected design.292

To prevent such situations and to give Designer A the reward for the original creative impulse, Congress may wish to consider some sort of bridge protection that would give Designer A a three-to-six-month window in which to create the design depicted in the copyright-protected sketches. This would allow Designer A to promote a design idea prior to investing the money for creation of the article of apparel.293

This idea is not new to Congress; the same concern surfaced for protecting architectural works. The fear in part was that a second architect could access the blueprints or plans for a structure, create the structure, and escape liability as long as the paper blueprints were not copied.294 In 1990, Congress passed the Architectural Works Copyright Protection Act expanding the definition of "architectural work" and giving architects copyright protection of the blueprints, as well as the actual construction of the structure depicted in the blueprints.295 A similar allowance for fashion

290. The success of Designer A’s infringement action against Designer B depends on no copyright exemption applying. See 17 U.S.C. §§ 107-112 (stating the limitations of the exclusive rights under copyright law).

291. See Galiano v. Harrah’s Operating Co., 416 F.3d 411, 414 (5th Cir. 2005) (stating that the district court found that copyright for clothing sketches did not extend to the production of the clothes depicted in the sketches).

292. The fact that Designer B obtains a sneak peek at Designer A’s sketches and beats Designer A to the creation of the article of apparel may raise other legal complications, such as trade secret. However, if Designer A publishes sketches in a magazine, another designer could create the item depicted and preclude Designer A from fashion design protection if Designer A does not act quickly.

293. The ability to feel out the profitability of a proposed design may be beneficial to new designers who do not necessarily have unlimited resources to create fashion designs that will ultimately flop.

294. See T-Peg, Inc. v. Vt. Timber Works, Inc., 459 F.3d 97, 109 (1st Cir. 2006) ("[T]here was a concern that a defendant with access to the plans or drawings could construct an identical building but escape liability so long as the plans or drawings were not copied." (quoting H.R. Rep. No. 101-735 (1990), as reprinted in 1990 U.S.C.C.A.N. 6935)).

295. See 1 NIMMER ON COPYRIGHT, supra note 118, § 2.20[A], at 2-214 (describing the enactment of the Architectural Works Copyright Protection Act); see also 17 U.S.C. § 101 (defining "architectural work" as "the design of a building as embodied in any tangible medium
designers would reward the originator of a fashion design idea with the ability to obtain protection of the embodiment of the idea.

Finally, fashion is a global industry, a fact virtually ignored by the Design Piracy Bills. Excluded from protection by the Design Piracy Bills are any fashion designs that have been made public more than three months prior to a registration filing either in the United States or another country. But the proposed fashion design protection does not extend to fashion designs registered under the Community design system. Additionally, registered design protection in the United States does not translate into registered design protection in the European Union. In order to obtain registered protection in the European Union, the designer would have to file a registration application. An owner of a fashion design registered in the United States can, however, obtain unregistered design protection simply by making the design public in the European Union. It is not essential that fashion design protection in the United States interface with international design protection schemes, but because fashion designs and trends impact the world, cooperation with international design protections may be important to provide meaningful and effective protection to fashion designers.

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of expression, including a building, architectural plans, or drawings" but not including "individual standard features"). See T-Peg, 459 F.3d at 109–10 (stating that an architect is given two types of protection: one under 17 U.S.C. § 102(a)(5) for the drawings and one under § 102(a)(8) for the architectural work).


297. Currently the statute allows a person who has filed for design protection in a foreign country—one that also allows U.S. citizens to file for protection in that foreign country—to apply for protection in the United States within six months of filing in the foreign country. See 17 U.S.C. § 1311 (2000) (describing the benefits of filing in a foreign country prior to filing in the United States). However, registration in the United States is still required, including the requirement to pay an additional registration fee. Id.

298. See FAQs on the Community Design, supra note 178, at Question 2.3 (stating that there is no nationality requirement for filing for and obtaining a registered Community design).

299. See id. at Question 8.7 (stating that so long as a design is disclosed in the European Union, nationality does not affect the ability of the design to receive unregistered design protection).
V. Conclusion

Some of the greatest artists of the century [are] Halston, Lagerfeld, [and] de la Renta. And what they did, what they created was greater than art because you live your life in it.

—Nigel, The Devil Wears Prada 300

There is no question—fashion design plays an integral role in the lives of Americans. And whether or not Americans identify articles of apparel as art, there is something special about fashion and about being fashionable. The numerous magazines dedicated in part or in full to reporting on fashion trends, popular movies like The Devil Wears Prada, successful television shows like Project Runway, 301 and the more than $200 billion spent each year on articles of apparel evidence the popularity of fashion and clothing in America. Yet, the creations of fashion designers from the greats—Halston, Lagerfeld, de la Renta—to the mass marketers—Wal-Mart, Sears, Target—are virtually free for all to copy, change, borrow, and rework. This freedom does not stem from failure to appreciate these artists, but rather from the fact that the usefulness of the apparel creations place them outside the scope of traditional intellectual property protections.

In an effort to change the current scheme of protection, the Council of Fashion Designers of America recently supported congressional efforts to formulate protection specific to fashion designs. At this point, Congress cannot construct meaningful protection for fashion design. Fashion designs result from the arrangement of existing components to form an article of apparel. As such, minor variations, including changes to the skirt length, sleeve length, fabric type, or fabric color, can create new and different designs. If a designer were able to legally protect an article of apparel, then design pirates could easily avoid infringement by slight variations to the original design, leaving the original designer holding virtually worthless rights for the protected design.

Any benefit that could ultimately be derived from this sliver of protection is quickly negated by complications caused by trying to enforce exclusive rights against infringers. The cost of arguing whether a second design is substantially similar to the original design is significant in terms of time and money. Additionally, by the time a court reaches a final decision, the fashion design will likely no longer be in vogue.

300. THE DEVIL Wears PRADA (20th Century Fox 2006).
301. Project Runway (Bravo television broadcast 2006).
Even if Congress should disagree with this conclusion and ultimately decide that fashion design protection is necessary and beneficial to the fashion industry, its current proposal for protection, as outlined in the Design Piracy Bills, falls far short of protecting fashion designs. Ambiguity in the definition of "fashion design" and the standard for infringement prevents courts from understanding what exactly is protected and how they should determine if there is a violation of a design owner’s exclusive rights. Further, by refusing to recognize that fashion designs are usually an embodiment of fashion sketches, Congress makes it possible for one designer to conceive the idea for a new apparel design and another designer to profit from its creation. Congress also looks at fashion design protection in a vacuum without considering how proposed protection would interface with the international community, a necessary consideration given the global nature of the fashion industry.

Even with substantial changes to the Design Piracy Bills, the result will be minimal protection that will be underutilized by fashion designers or rarely enforced. Unfortunately, industrious and creative individuals in the fashion industry cannot be rewarded in the same manner as individuals in the movie, music, and publication industries through exclusive rights over their individual creations. Nevertheless, Congress should not try to remedy this situation through protection that cannot ultimately offer the same type of benefits that patent, trademark, and copyright law offer to other industries. Because effective protection for fashion designs is impossible, no protection is better than nominal protection.