Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act

Laura C. Marshall
University of Georgia School of Law

Follow this and additional works at: https://digitalcommons.law.uga.edu/jipl

Part of the Entertainment, Arts, and Sports Law Commons, and the Intellectual Property Law Commons

Recommended Citation
Available at: https://digitalcommons.law.uga.edu/jipl/vol14/iss2/4

This Notes is brought to you for free and open access by Digital Commons @ Georgia Law. It has been accepted for inclusion in Journal of Intellectual Property Law by an authorized editor of Digital Commons @ Georgia Law. Please share how you have benefited from this access. For more information, please contact tstriepe@uga.edu.
CATWALK COPYCATS: WHY CONGRESS SHOULD ADOPT A MODIFIED VERSION OF THE DESIGN PIRACY PROHIBITION ACT

TABLE OF CONTENTS

I. INTRODUCTION ........................................... 307

II. BACKGROUND ............................................ 308
A. THE DESIGN PIRACY PROHIBITION ACT AND THE U.S. 
   FASHION INDUSTRY ..................................... 309
   1. Proposed Federal Legislation to Extend Intellectual 
      Property Protection to Fashion Works .................. 309
   2. The Fashion Industry and the Prevalence of 
      Knockoffs ........................................... 310
B. HISTORY OF INTELLECTUAL PROPERTY PROTECTION FOR 
   FASHION WORKS AND CURRENT STATE OF THE LAW .......... 311
   1. Design Patent ........................................ 311
   2. Trademark and Trade Dress ............................ 313
   3. Copyright .......................................... 314
C. INTELLECTUAL PROPERTY PROTECTION FOR FASHION 
   DESIGNS IN EUROPE ..................................... 317
   1. Protection of Design Rights in the European 
      Community ........................................... 317
   2. Protection of Designs Under United Kingdom 
      Law ................................................ 318
   3. Copyrights and Design Rights Under French 
      Law ................................................ 319
D. THE TRIPS AGREEMENT .................................. 319
E. THE ARGUMENT AGAINST IP RIGHTS FOR FASHION 
   DESIGNS: THE “PIRACY PARADOX,” OR WHY 
   COPYING IS GOOD FOR THE FASHION INDUSTRY .......... 320

III. ANALYSIS ................................................. 322
A. WHY FASHION DESIGNS SHOULD RECEIVE INTELLECTUAL 
   PROPERTY PROTECTION .................................. 323
   1. Fashion As Art ....................................... 323
   2. Safeguarding Entrepreneurs Through Intellectual 
      Property Rights .................................... 324

305
3. **Filling the Gap in Existing Law and Relieving Courts of the Unworkable Conceptual Separability Standard** ............................................ 325

B. **CONGRESS SHOULD ADOPT A MODIFIED VERSION OF THE DESIGN PIRACY PROHIBITION ACT** ........................................ 327
   1. **Change the Period of Protection to One Year** .................... 327
   2. **Establish More Specific Guidelines for What Constitutes a “Fashion Design”** .................................................. 328
   3. **Widen the Scope of Available Remedies** ............................ 329

IV. **CONCLUSION** .............................................................. 330
I. INTRODUCTION

What you don’t know is that that sweater is not just blue, it’s not turquoise, it’s not lapis, it’s actually cerulean. You’re also blindly unaware of the fact that in 2002, Oscar De La Renta did a collection of cerulean gowns. And then I think it was Yves St Laurent, wasn’t it, who showed cerulean military jackets? And then cerulean quickly showed up in the collections of eight different designers. Then it filtered down through the department stores and then trickled on down into some tragic Casual Corner where you, no doubt, fished it out of some clearance bin. However, that blue represents millions of dollars and countless jobs and so it’s sort of comical how you think that you’ve made a choice that exempts you from the fashion industry when, in fact, you’re wearing the sweater that was selected for you by the people in this room.

—Miranda Priestly, *The Devil Wears Prada*

Fashion plays a huge role in American culture, from designer Isaac Mizrahi’s line of clothing, accessories, and housewares available at Target (which features well-known designers in its “Design for All” lines) to the $400-per-pair Manolo Blahnik shoes lauded on HBO’s *Sex and the City.* Cable channel Bravo broadcast the third season of the hit fashion reality television show *Project Runway* in the fall of 2006. The October 18th season finale of *Project Runway* garnered a record 5.36 million viewers. The movie *The Devil Wears Prada*, based on the best-selling novel about a naive college graduate looking to break into journalism who takes a job working for a top fashion magazine editor, grossed more than $27 million in its opening weekend. In 2006, *Glamour* magazine’s readership was more than 12 million and *Vogue* magazine’s readership was more than 10 million.

---

1 *The Devil Wears Prada* (Twentieth Century Fox 2006).
3 See http://www.hbo.com/city/episode/season4/episode64.shtml (last visited Mar. 21, 2007) (“On a shoe shopping excursion with Miranda, Carrie realizes she’s spent $40,000 on shoes.”).
These numbers, however, attest only to the popularity of fashion and its role within the larger television, film, retail, and publication industries. By contrast, most fashion designers are self-employed, earn moderate salaries, and face competition from much larger companies able to replicate their ideas within a matter of days. Moreover, while film studios and publishing conglomerates receive strong protection for their fashion-related products through trademark and copyright law, designers are unable to obtain intellectual property rights for fashion works other than peripheral protections, such as logo trademarks and fabric print copyrights. However, the fashion industry is trying to fight back against piracy. The Council of Fashion Designers of America successfully lobbied Congress to consider the Design Piracy Prohibition Act (DPPA), a bill aimed at providing intellectual property protection for fashion designs. If passed, the DPPA would establish a copyright regime for garment and accessory designs.

This Note considers the proposed legislation in the context of the complex history of intellectual property rights for fashion designs and the current state of the law in the United States and Europe. Part II examines the provisions of the bill, the contours of the U.S. fashion industry, the history of the fashion industry's intellectual property protections, and the current state of U.S. and international law. This part concludes by summarizing some of the points made in a recent law review article arguing against intellectual property rights for fashion designs. Part III demonstrates that public policy considerations come out in favor of intellectual property rights for fashion designs and concludes that a short-term, non-renewable copyright regime best balances the competing interests of consumers and fashion designers. More specifically, this Part argues that Congress should adopt a modified version of the DPPA by shortening the term of protection to one year, providing courts with more guidance on how to determine when someone has infringed a protected fashion design, and widening the scope of remedies available for infringement.

II. BACKGROUND

In 2006, a bill was proposed in the House of Representatives which would allow fashion designers to obtain short-term copyrights for clothing and accessory designs. This bill represents a Congressional response to the prevalence of design piracy within the fashion industry. In recent years, designers at all levels of renown have seen their designs replicated by large companies before the originals

8 See infra Part II.A.2 and accompanying notes.
9 See infra Parts II.B.2-3 and accompanying notes.
10 Olvera Medenica, Bill Would Protect Fashion Designs, NAT'L L.J., Aug. 28, 2006, at S1; see also infra Part II.A.1 and accompanying notes.
even make it onto the retail market. This kind of piracy is not new to the fashion industry; however, the pace of copying has increased significantly in the digital age. For decades, designers have sought shelter for their work in nearly all areas of intellectual property law, including design patent, trademark, trade dress, and copyright. However, none of these fields of law has provided complete protection for fashion designs.

In contrast, many European countries give designers stronger intellectual property protection in the form of short-term copyrights and “design rights.” The contrast between European and American law manifests itself in the TRIPs Agreement, an international agreement to which the United States is a signatory. The TRIPs Agreement represents a multinational attempt to level the playing field of intellectual property protection among the signatory governments. However, some scholars hope the United States will resist the international pressure, arguing that the framework of free copying in this country actually benefits the fashion industry as a whole more than the stricter laws in Europe. All in all, the international legal landscape is not an easy one for designers to navigate.

A. THE DESIGN PIRACY PROHIBITION ACT AND THE U.S. FASHION INDUSTRY

1. Proposed Federal Legislation to Extend Intellectual Property Protection to Fashion Works. On March 30, 2006, Representative Bob Goodlatte (R-Va.) introduced a bill in the House of Representatives that would extend copyright protection to fashion works.11 The proposed bill, the Design Piracy Prohibition Act (DPPA), would amend the Copyright Act to give three years of protection to clothing designs and accessories.12 The bill defines “fashion design” as “the appearance as a whole of an article of apparel, including its ornamentation.”13 “Apparel” encompasses “an article of men’s, women’s, or children’s clothing, including undergarments, outerwear, gloves, footwear, and headgear; handbags, purses, and tote bags; belts; and eyeglass frames.”14 A fashion designer seeking protection would be required to apply for copyright registration by submitting photographs or sketches of her design to the Copyright Office within three months of the article’s first “public appearance” (such as on a runway or in a magazine).15 In return, the designer would receive a three-year copyright, under which she could

---

12 Id.
13 Id.
14 Id.
15 Id.; see also Elizabeth Woyke, Fashion’s Bid To Knock Out Knockoffs, BUS. WK., Apr. 10, 2006, at 16 (describing a proposed process for obtaining fashion copyrights).
seek recovery in the form of statutory damages of $250,000 or $5 per copy from infringers.16

The Council of Fashion Designers of America has provided much of the impetus for the bill, sending designers such as Jeffrey Banks and Zac Posen to meet with members of Congress or testify before the House Subcommittee on Courts, the Internet, and Intellectual Property.17 The Subcommittee has completed its hearings but has not yet voted on the bill.18

2. The Fashion Industry and the Prevalence of Knockoffs. Fashion contributes significantly to the U.S. economy. In 2005, the U.S. clothing industry generated $181 billion in sales.19 However, big-name designers, such as Ralph Lauren and Marc Jacobs, make up only a small portion of the industry. In May 2004, the median annual salary for fashion designers was $55,840, and only ten percent of designers earned more than $112,000.20 In addition, one in four fashion designers was self-employed in 2004.21

The requirements of the job are a far cry from red-carpet glamour; most designers put in long hours to earn their salaries. A designer typically requires eighteen to twenty-four months to take a design from beginning sketches to final manufacture.22 Designers who are not well-established usually have a hand in most of the steps of the process, including pattern-making and construction of the garment.23

After putting in nearly two years of work, a designer can have the fruits of her labor stolen in a flash. Companies that specialize in fashion knockoffs often send representatives to runway shows or red-carpet events to take digital photographs of the designs.24 These photographs are then sent to factories in China that mass-produce less expensive copies of the designs quickly enough to put the knockoffs on the market months before the original design appears, thus leaving designers little chance to recoup the costs of production.25 For example, the clothing

16. H.R. 5055.
21. Id.
22. Id.
23. Id.
24. Hearing, supra note 17, at 77–84 (statement of Susan Scafidi, Visiting Professor, Fordham Law School).
25. Id.
company Faviana manufactured copies of designer dresses worn by celebrities at the 2006 Emmy Awards only three days after the event. 26

B. HISTORY OF INTELLECTUAL PROPERTY PROTECTION FOR FASHION WORKS AND CURRENT STATE OF THE LAW 27

Fashion designers have sought protection under nearly every branch of intellectual property law, with varying degrees of success. A small subset of fashion works, such as shoe designs, qualify for design patents. Designers with well-known logos have found strong safeguards for those logos in trademark law. While copyright law provides protection to "pictorial, graphic, and sculptural works" with non-utilitarian functions, 28 architectural designs, 29 and even boat hulls, 30 the law does not recognize fashion designs. Designers looking to protect the overall appearance of a garment have run up against obstacles in every area of intellectual property law.

1. Design Patent. Fashion works have received limited intellectual property protection under the design patent system. To obtain a design patent, the applicant must show that her design is "novel," "nonobvious," "ornamental," and "nonfunctional." 31 The requirements of nonobviousness and nonfunctionality present significant obstacles for fashion designers seeking patents for their works. Under the functionality requirement, if the design of the article is "essential" to its use, it will not qualify for a design patent. 32 Only a few fashion items, such as footwear, have met the nonfunctionality test for design patents. 33

---

32 See, e.g., L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) ("If the particular design is essential to the use of the article, it can not [sic] be the subject of a design patent."); Rockport Co. v. Deer Stags, Inc., 65 F. Supp. 2d 189, 194 n.3 (S.D.N.Y. 1999) (finding stitching and heel counter aspects of shoe design to be "primarily ornamental and non-functional").
However, even if a fashion design meets the nonfunctionality element, the non-obviousness element often presents a greater hurdle. This element is analyzed from the perspective of "a designer of ordinary skill or capability" in the same profession. In terms of apparel design, "the nonobviousness standard is so demanding that even new clothing designs that do not incorporate any known design elements can still fail to qualify for design patent protection." Accessory designers have fared somewhat better; courts have found some shoe designs sufficiently nonobvious.

In addition to these stringent requirements, design patents are ill-suited for fashion designs for a number of practical reasons. The process of obtaining a patent is costly and lengthy. In 2005, the pendency time of an average, non-design patent was approximately twenty-nine months. Although this figure does not include design patents, one commentator has noted that while design patents likely require less time to process, a "cautious estimate" of their pendency timespan is twenty-six months. As one court noted decades ago, "designs and patterns usually are short-lived and with the conditions and time incidental to obtaining the patent, this protection comes too late, if at all." A design patent application currently costs $310 to file with another $430 due upon issuance of the patent.

In addition to these costs, many patent applicants require the

34 L.A. Gear, 988 F.2d at 1124 (citing In re Nalbandian, 661 F.2d 1214, 1216 (C.C.P.A. 1981)).
35 Briggs, supra note 27, at 177 (referencing White v. Lombardy Dresses, Inc., 40 F. Supp. 216 (S.D.N.Y. 1941)). In White, the court noted that "While the granting of the patent carries the weight which is attached to such act of the government, the facts on the trial and the state of the art duly proved, makes one wonder how any patent on such dresses can be obtained provided true invention is required. A dress may be new, original and attractive and yet not be patentable unless this faculty of invention is likewise present."
36 See, e.g., L.A. Gear, 988 F.2d at 1124 ("The district court found that all of the elements of the design of the '081 patent were known, but that these particular elements had not previously been combined in a single shoe design. A reconstruction of known elements does not invalidate a design patent, absent some basis whereby a designer of ordinary skill would be led to create this particular design."); Rockport Co., 65 F. Supp. 2d at 196 (finding that shoe designs which contained elements found in an earlier shoe patent were nonetheless patentable because of "different overall visual appearance").
38 Tsai, supra note 27, at 457 n.105.
assistance of an attorney in preparing and filing the patent application. The median attorney’s fee per design patent application in 2003 was $1,100.41

Further, design patents last too long to fit comfortably into the fast-paced fashion market. If design patents, which expire fourteen years after the date on which they are granted, 42 were regularly given to fashion works, the fashion cycle might grind to a halt because of designers’ fear of infringing another designer’s long-lasting patent. Long-term protection is particularly out-of-sync with the transitory nature of fashion designs in the Internet era, in which websites like Style.com provide daily updates on fashion news.43

2. Trademark and Trade Dress. Trademark law provides strong protection for company logos and other distinctive marks which identify the source of the fashion design.44 The Second Circuit recently found that the color-design combination constituting a Louis Vuitton mark on its handbag collection qualified for trademark protection because it was both “inherently distinctive” and had “acquired secondary meaning.”45 Ralph Lauren’s Polo Fashions company has sued successfully several times for infringement of its “Polo” trademark.46 However, fashion designers have not met with nearly as much success in seeking to protect the overall design of an article of clothing under the rubric of trade dress.

The concept of trade dress, which used to be limited to the packaging of a product,47 now encompasses “the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.”48 To recover for trade dress infringement, the plaintiff must show that her design is nonfunctional and distinctive and that the infringer’s design is likely to cause consumer confusion as to the source of the design.49

Each of these elements poses difficulties for a fashion designer seeking to sue a knockoff artist for trade dress infringement.50 First, the functionality doctrine,

41 Tsai, supra note 27, at 457.
44 Tsai, supra note 27, at 453.
45 Louis Vuitton Malletier v. Dooney & Bourke, Inc., 454 F.3d 108, 116 (2d Cir. 2006). The appellate court remanded the case in part for a determination of whether the defendant’s mark was likely to be confused with the plaintiff’s mark. Id. at 119–20.
46 Briggs, supra note 27, at 195.
47 See JEROME GILSON & ANNE GILSON LALONDE, 1 GILSON ON TRADEMARK PROTECTION AND PRACTICE § 2A.01[1] (2006 ed.).
49 GILSON & LALONDE, supra note 47, § 2A.01[3].
50 See Briggs, supra note 27, at 195 (“Clothing designs have faced hurdles under all three of these requirements.”).
as explained recently by the Supreme Court, covers both utilitarian and aesthetic functionality. The utility prong asks whether the allegedly infringed feature of the design is “essential to the use or purpose of the device” or “affects the cost or quality of the device.” The aesthetic prong examines whether the feature “is so important to the value of the product to consumers that continued trademark protection would deprive them of competitive alternatives.” Courts, wary of establishing market monopolies, have tended to find that fashion designs do not meet the nonfunctionality element of trade dress protection.

Second, fashion designers have struggled to show the distinctiveness and likelihood of confusion elements. While some famous designers have succeeded in showing consumer confusion between knockoffs and originals, the confusion element is harder for less well-known designers to prove. Furthermore, smaller designers have trouble establishing the distinctiveness element. The Supreme Court has suggested that the design of a product (including a fashion work) is not inherently distinctive, and thus designers must show “secondary meaning”—that “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” In general, the fast pace of the fashion cycle prevents all but the most well-known designers from establishing secondary meanings for their products. Thus, while trademark law provides sufficient protection for fashion designers’ marks and logos, trademark and trade dress law do not provide strong protection against knockoffs of overall clothing or accessory design.

3. Copyright. Although Congress has considered more than seventy bills since 1914 to give copyright or copyright-like protection to clothing designs, federal

52 Id. at 32 (citations omitted).
53 W.T. Rogers Co. v. Keene, 778 F.2d 334, 347 (7th Cir. 1985).
54 Briggs, supra note 27, at 197 (citing Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000); Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996 (2d Cir. 1995); and Coach Leatherware Co. v. AnnTaylor, Inc., 933 F.2d 162 (2d Cir. 1991)).
56 See Briggs, supra note 27, at 198 (“Thus, while the confusion analysis is somewhat unpredictable, it appears to be difficult to demonstrate if the trade dress is not already well known to consumers . . .”).
58 See Briggs, supra note 27, at 199 (“Consumers are very unlikely to be able to attribute a particular clothing design to a particular designer, without the aid of trademarks, labels or a substantial advertising campaign.”).
copyright law does not currently protect fashion works. Congress has been unwilling thus far to make a fashion-design exception to the "useful articles" doctrine of the Copyright Act. The statute defines a "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." The useful articles doctrine reflects Congress's attempt to prevent manufacturers from acquiring monopolies on designs based only on the product's function.

In 1954, the Supreme Court first acknowledged that, if an object's artistic features could be separated from its useful functions, the artistic features could be protected by copyright law. In portions of the Copyright Act of 1976, Congress attempted to clarify the Court's holding by enacting a "separability" test for distinguishing the artistic elements of an object from its utilitarian function. However, the legislation caused consternation among courts attempting to apply the statute in the context of design litigation, and the separability test has not grown clearer or easier to apply over time.

Under the conceptual separability doctrine, "pictorial, graphic, or sculptural" features of a design may be copyrightable if those features are physically or conceptually separable from the useful features of the product. Some aspects of clothing design, such as a particular fabric pattern or the lace and embroidery accents on a shirt, have easily passed the separability test. Conceptual separability has proved much more difficult to apply in "closer" cases, however, and courts have interpreted and applied the doctrine in a

---

61 Id.
62 Briggs, supra note 27, at 181.
63 See Mazer v. Stein, 347 U.S. 201, 218 (1954) (holding that statuette that formed base of lamp could be copyrighted).
64 See H.R. REP. No. 94-1476, at 55 (1976) ("Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill."), reprinted in 1976 U.S.C.C.A.N. 5109, 5668, and cited in Briggs, supra note 27, at 182 n.81.
65 Briggs, supra note 27, at 183.
66 See Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980).
67 See, e.g., Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1002 (2d Cir. 1995) ("[F]abric designs ... are considered 'writings' for purposes of copyright law and are accordingly protectible."); Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc., 169 F. Supp. 142, 143 (S.D.N.Y. 1959) (finding that "plaintiffs' design is a proper subject of copyright both as a work of art and as a print"); Express, LLC v. Fetish Group, Inc., 424 F. Supp. 2d 1211, 1215 (C.D. Cal. 2006).
68 See, e.g., Masquerade Novelty, Inc. v. Unique Indus., Inc., 912 F.2d 663, 670 (3d Cir. 1990) ("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.").
multitude of ways with often inequitable results. The D.C. Circuit reasoned that an object is not copyrightable if an intrinsic function of the object is utilitarian. The doctrine has generated seemingly contradictory judicial opinions within the Second Circuit. In the 1980 Kieselstein-Cord case, the court held that a designer could obtain a copyright for his belt-buckle design because the "primary ornamental aspect" of the buckles was "conceptually separable from their subsidiary utilitarian function."

Five years later, the dissenting judge in Carol Barnhart, Inc. v. Economy Cover Corp., a case involving the copyrightability of dress forms for displaying clothing, proposed a different separability test: "For the design features to be 'conceptually separate' from the utilitarian aspects of the useful article that embodies the design, the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function." The Second Circuit has never adopted this test, but some designers seeking copyright protection have reflected its underlying concepts in their argument that fashion is art.

Two years after the Carol Barnhart decision, the Second Circuit yet again reworked the test, adopting a model suggested in a scholarly article on conceptual separability. According to the court, "If design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists." Building upon this history of fuzzy standards, the Seventh Circuit recently found that an object that is "the product of a creative process unfettered by functional concerns" passes the conceptual separability test.

Conceptual separability as applied to fashion designs caused such confusion among the circuits that the Copyright Office issued a policy decision on the registrability of costume designs. The Office determined that clothing design,
including the design of costumes, is not copyrightable under the useful articles doctrine, but masks are copyrightable because they are non-utilitarian objects.\(^{78}\)

Finally, designers have tried with limited success to receive copyright protection by classifying their designs as "soft sculpture." The copyright statute protects "pictorial, graphic, and sculptural works," which include "two-dimensional and three-dimensional works of fine, graphic, and applied art."\(^{79}\) In *Whimsicality, Inc. v. Rubie's Costume Co.*, the Second Circuit held that a costume company had obtained an invalid copyright because the company had misrepresented its costume designs as "soft sculpture" in its copyright application.\(^{80}\) The court found that "the only practical use" for the plaintiff's outfits, which included pumpkin, bee, and spider designs, was "as costumes," and that there was "no evidence of any actual use as sculpture."\(^{81}\) Similarly, in *Lim v. Green*, the Ninth Circuit found that the plaintiff's scarf cap, which the plaintiff intended to market to Harley Davidson, did not qualify as a soft sculpture.\(^{82}\)

By contrast, eleven years later the Ninth Circuit held in *Poe v. Missing Persons* that the plaintiff presented enough evidence to get past summary judgment on the issue of whether his rock-filled, plastic "swimsuit/piece of conceptual artwork," which appeared in a Los Angeles art show, was copyrightable as soft sculpture.\(^{83}\) The Court noted that "[t]he evidence . . . shows that Poe was attempting to create a work of art which portrayed an article of clothing."\(^{84}\) However, the circumstances in *Poe*, in which the plaintiff displayed his design, an essentially unwearable "swimsuit," in an art show, make the case a rare exception to the rule.

C. INTELLECTUAL PROPERTY PROTECTION FOR FASHION DESIGNS IN EUROPE

In Europe, fashion designers may obtain intellectual property protection through a European Community design regulation, United Kingdom industrial design rights, or French copyright or design right law.

1. Protection of Design Rights in the European Community. In 2001, the European Community adopted a design regulation that set up a two-part system of intellectual property design rights.\(^{85}\) The regulation recognizes both registered and unregistered community designs and provides uniform protection throughout

---

\(^{78}\) *Id.* at 56,531.


\(^{80}\) 891 F.2d 452, 456 (2d Cir. 1989).

\(^{81}\) *Id.* at 454.

\(^{82}\) No. 99-16538, 2000 U.S. App. LEXIS 29291, at *3 (9th Cir. Nov. 13, 2000).

\(^{83}\) 745 F.2d 1238, 1240–42 (9th Cir. 1984).

\(^{84}\) *Id.* at 1242.

the Member States.\textsuperscript{86} To qualify for protection, a design must be both “new”\textsuperscript{87} and of an “individual character.”\textsuperscript{88} The regulation defines a “design” as “the appearance of the whole or a part of a product resulting from . . . features” such as “the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.”\textsuperscript{89}

Designs that are registered with the Office for Harmonization in the Internal Market (OHIM) in Spain receive a five-year term of protection, renewable at five-year intervals for up to twenty-five years.\textsuperscript{90} Unregistered designs are protected for three years beginning on the date they are first made available to the public.\textsuperscript{91} The Regulation provides detailed information about jurisdiction, judicial proceedings, the types of intellectual property rights available to registered and unregistered designs, what constitutes infringement, and what remedies are available.\textsuperscript{92}

2. Protection of Designs Under United Kingdom Law. Legislation in the United Kingdom protects both registered and unregistered industrial designs, i.e., the overall appearance of a mass-produced item.\textsuperscript{93} A design right does not exist unless the design is recorded in document form (e.g., a photograph or drawing) or an article has been constructed from the design.\textsuperscript{94} The modes of protection for unregistered and registered designs include the 1988 Copyright, Designs and Patents Act (CDPA),\textsuperscript{95} the 2002 Community Design Regulation,\textsuperscript{96} and, for designs in existence prior to enactment of the CDPA, general copyright protection.\textsuperscript{97} Registered designs receive stronger legislative protection in both the United Kingdom and in the European Community.\textsuperscript{98} Design rights last from ten to fifteen years.\textsuperscript{99}

\textsuperscript{86} Id.
\textsuperscript{87} Council Regulation 6/2002, art. 5, 2002 O.J. (L 3) 4 (designating a design as “new” if “no identical design has been made available to the public”).
\textsuperscript{88} Id. art. 6, at 4 (classifying a design as having “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{89} Id. art. 3(a), at 4.
\textsuperscript{90} Smulders, supra note 85, § 4.
\textsuperscript{91} Id.
\textsuperscript{92} Id.
\textsuperscript{93} COPINGER AND SKONE JAMES ON COPYRIGHT § 13-01 to -03 (Kevin Garnett & Gillian Davies eds., 15th ed. 2004).
\textsuperscript{94} Id. § 13-78 to -80.
\textsuperscript{95} Id. § 13-08.
\textsuperscript{96} Id.; see also supra Part II.C.1 and accompanying notes.
\textsuperscript{97} COPINGER AND SKONE JAMES ON COPYRIGHT, supra note 93, § 13-08.
\textsuperscript{98} Id. § 13-09.
\textsuperscript{99} Id. § 13-101.
3. *Copyrights and Design Rights Under French Law.* France has adopted the design regulations of the European Community. In addition, French copyright law extends protection to original fashion designs. French copyright-holders receive both patrimonial and moral rights at the moment they create an original work rather than at the point of public disclosure. Patrimonial rights include "the exclusive rights to represent, reproduce, sell or otherwise exploit the copyrighted work of art and to derive a financial compensation therefrom." A moral right, which is granted exclusively to an author or artist and, at his death, to his heirs, and which does not expire, is "essentially the right for the author to see both his name and his work of art respected." Copyright infringers are subject to both civil suits for damages and criminal penalties, including up to three years in jail and a fine of 300,000 euros.

D. THE TRIPS AGREEMENT

In 1994, members of the World Trade Organization (WTO), including the United States, signed the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement). The TRIPs Agreement seeks to harmonize international intellectual property rights by setting a minimum level of protection each signatory government must provide and by creating a structure of common international rules. The Agreement's provision on design rights, Article 25(2), states:

> Each Member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.

---

100 See supra Part II.C.7 and accompanying notes.
101 LOVELLS & PAUL, HASTINGS, JANOPFSK & WALKER (EUROPE) LLP, 2 DOING BUSINESS IN FRANCE § 17.06 (Release May 31, 2006).
102 Id.
103 Id.
104 Id.
105 Id.
108 TRIPS Agreement, supra note 106, at Part II, § 4, art. 25(2).
This provision may be construed narrowly or broadly in terms of the standards it sets for protection of design rights. A narrow reading would likely find that the United States is in compliance with this provision because the Agreement provides a minimum level of intellectual property protection to some textile design through design patents, trademarks, and copyrights. However, a broader, policy-based reading might construe the provision as suggesting that textile designs deserve intellectual property rights equivalent to those given to other artists, in which case the United States would be in breach of its duties under the Agreement.

E. THE ARGUMENT AGAINST IP RIGHTS FOR FASHION DESIGNS: THE “PIRACY PARADOX,” OR WHY COPYING IS GOOD FOR THE FASHION INDUSTRY

In their recent article exploring what they term the “piracy paradox,” Professors Kal Raustiala and Christopher Sprigman argue that copying in the fashion industry does not hinder creativity and may in fact produce greater innovation among designers. They observe that the fashion industry remains stable in a “low-IP equilibrium” and suggest that this stability results from two connected features of the industry: “induced obsolescence” and “anchoring.” Induced obsolescence is the phenomenon by which trends become distasteful to their initial, wealthy customers as knockoffs of these trends “diffuse to a broader clientele” at cheaper prices. Widespread copying drives the elite fashion houses to create more new designs as the trend-of-the-moment becomes defunct. Therefore, the authors argue, design piracy actually works in designers’ favor “by inducing more rapid turnover and additional sales.”

In a similar vein, the authors posit that, in addition to induced obsolescence, the anchoring of seasonal trends benefits the entire industry as a whole:

While the industry produces a wide variety of designs at any one time, readily discernible trends nonetheless emerge and come to define a particular season’s style. These trends evolve through an undirected process of copying, referencing, receiving input from

---

109 Briggs, supra note 27, at 209.
110 Id.
111 Id.
113 Id.
114 Id. at 1719.
115 Id. at 1721.
116 Id. at 1722.
consultants, testing design themes via observation of rivals’ designs at runway shows, communication with buyers for key retailers, and coverage and commentary in the press . . . . Like a school of fish moving first this way and then that, fashion designers follow the lead of other designers in a process that, while bewildering at times, results in the emergence of particular themes.117

Raustiala and Sprigman argue that this phenomenon of trend anchoring, brought about by “free appropriation” among designers, is a key element of the fashion economy.118 Design houses tolerate copying, knowing that they may be the ones borrowing the idea the following season.119 Anchoring allows consumers to identify discernible trends each season; a firmly established trend then becomes the “must have” item of the season, and fashion designers throughout the industry benefit from this trend-driven consumerism.120

Raustiala and Sprigman contend that because induced obsolescence and anchoring bring more benefit than harm to the fashion industry as a whole, the industry for almost all of its existence has been willing to tolerate blatant copying.121 Other commentators have suggested that some fashion houses condone copyists because the replicas draw attention to the original design and confirm the status of the fashion house as one deserving of imitation.122 As Raustiala and Sprigman point out, clothing and accessories usually derive their value not from their intrinsic worth (with the exception of items such as diamond necklaces) but rather from their status in the eyes of other consumers.123 When

---

117 Id. at 1728.
118 Id. at 1729.
119 See id. at 1727 (“The house that sets the trend one season may be following it the next, and whether a particular firm will lead or follow in any given season is likely difficult to predict.”).
120 Id. at 1729.
121 See id. at 1692 (“These twin features help to explain why design copying can be counter-intuitively beneficial for designers, and hence help account for the remarkable persistence of the permissive legal regime governing fashion design.”).
122 See Brian Hilton, Chong Ju Choi, & Stephen Chen, The Ethics of Counterfeiting in the Fashion Industry: Quality, Credence and Profit Issues, 55 J. BUS. ETHICS 345, 351 (2004) (“This copying is accepted not only because the fashion houses benefit from the publicity, but also because the copying legitimizes their designs as ones that are desirable and worth copying.”).
123 Raustiala & Sprigman, supra note 112, at 1718–19; see also Jonathan M. Barnett, Shopping for Gucci on Canal Street: Reflections on Status Consumption, Intellectual Property, and the Incentive Thesis, 91 VA. L. REV. 1381, 1383 (2005) (“In markets for such status goods, each consumer’s preferences are determined in part by the visible purchasing behavior of certain other consumers—what each consumer deems to be fashionable is determined in significant measure by the observed purchasing behavior of certain other consumers.”).
the market becomes drenched with copies, the elite fashion designers have already moved on to the next concept.  

III. ANALYSIS

Although some commentators, such as Raustiala and Sprigman, have proposed tenable reasons to continue to allow copying of fashion designs, policy considerations, including logical and legal consistency, fairness, and practicality, weigh in favor of extending intellectual property protection to fashion works. Both fashion designers and the public at large consider clothing and accessories to be not only useful articles but also works of creative expression. Thus, U.S. intellectual property law should provide fashion designers with protections similar to those given to their peers in the music, film, literary, and visual arts industries. Further, because the fashion industry is decentralized and largely composed of entrepreneurs working on moderate salaries, U.S. law should allow designers to recoup the investments they must make to create and market original designs. Finally, Congress should fill the gap in intellectual property law as it applies to fashion designs in order to relieve the courts from the frustrating process of sorting out elements of design that are “conceptually separable” from a garment’s utilitarian function. By extending intellectual property protection to the overall design of a fashion work, Congress will provide a more just framework for designers and save the courts the trouble of applying a vague and often inconsistent standard.

More specifically, Congress should modify the DPPA in order to extend intellectual property protection to fashion designs while guarding the interests of consumers and the free market. Although the bill is a good first step in protecting designers, the current drafting of the bill allots too extensive a period of protection to designs, does not provide courts with adequate guidance in evaluating design copyright infringement, and does not set up an adequate remedial framework. Accordingly, the bill drafters should shorten the period of copyright protection to one year to balance adequately the interests of both designers and consumers in a swiftly changing fashion market. The drafters should also give courts more guidance on how to evaluate when one designer has infringed another designer’s copyright to an extent for which the law provides redress. In specifying what constitutes copying, the drafters should look to

124 Raustiala & Sprigman, supra note 112, at 1722.
125 See supra Part II.E and accompanying notes.
126 See infra Part III.A.1 and accompanying notes.
127 See supra Part II.A.2 and accompanying notes.
128 See supra Part II.B.3 and accompanying notes.
European Community design law for guidance but should also adopt a stricter copying standard than the “overall impression” standard present in European Community law so that fashion houses are not punished simply for following a season’s trends. Finally, the drafters should look to other provisions of the Copyright Act to create a wider scope of available remedies for infringement.

A. WHY FASHION DESIGNS SHOULD RECEIVE INTELLECTUAL PROPERTY PROTECTION

While the arguments against intellectual property protection for fashion designs seem persuasive at first glance, many policy considerations that favor short-term copyrights for fashion designs counterbalance concerns about stagnation of the fashion market. The arguments in favor of free appropriation in the fashion industry assume a market in which either the trend trickles down to less expensive retailers over time 129 or in which technically illegal counterfeit operations sell knockoffs of high-end luxury goods that are distinguishable from the originals. 130 However, these assumptions about the fashion industry only describe part of the market reality; start-up designers without extensive financial assets often find their designs copied by large retailers able to mass-produce the items at a much lower cost. 131 Furthermore, the perception of fashion as art suggests that designers should receive intellectual property rights comparable to those of their peers in other creative industries. Finally, it is time that Congress filled the gap in intellectual property law as applied to fashion designs and spared the courts from having to continue to struggle with the problematic conceptual separability test.

1. Fashion As Art. Fashion designers frequently describe themselves and their work in artistic terms; they speak of their vision, their inspiration, the craftsmanship of their clothing, and the theme or message of a particular collection. 132 Many art museums throughout the country, such as New York

---

130 See Barnett, supra note 123, at 1384 (“This market is shadowed by a large counterfeiting industry, which generally produces items of various grades inferior to the original . . .”).
131 See, e.g., infra notes 141–43 and accompanying text.
132 See, e.g., Kate Bolick, Q&A with Diane Von Furstenberg, BOSTON GLOBE, Aug. 6, 2006, at C3 (“I create clothes that empower women. A woman who can somehow do it all but loves being a woman is very much the personality and DNA of the brand.”); BravoTV.com, Q&A with Season 3 Winner Jeffrey Sebelia (Feb. 26, 2007), http://www.bravotv.com/blog/fashionforwardqa/2006/10/jeffrey_sebelia.php (“I don’t necessarily expect people to get what I do. But I worked really hard, I know what I’m doing, I have my vision and I know how to execute it.”).
City’s Metropolitan Museum of Art and Guggenheim Museum, maintain temporary or permanent fashion exhibits alongside their fine art collections. Some designers have also joined forces with visual artists to create collections for some of the larger and more elite fashion houses. For instance, the British artist Simon Periton collaborated with milliner Philip Treacy in 1999 to produce a line of hats for Treacy’s Fall/Winter collection. Periton has also worked with Raf Simons, a Belgian designer, and Junya Watanabe, a designer who created a line for the fashion house Comme des Garçons. Other artist-designer pairings have included Damien Hirst and Miuccia Prada, Jenny Holzer and Helmut Lang, and Roy Lichtenstein and Gianni Versace. The teaming up of Marc Jacobs and Japanese artist Takashi Murakami to create a handbag line for Louis Vuitton in 2002 generated more than $300 million in sales for the French design house.

Yet, while U.S. copyright law provides protection to visual artwork with non-utilitarian functions, architectural designs, and even boat hulls, the law does not protect clothing designs. The United States should join Europe in recognizing fashion as art by enacting legislation that provides designers with intellectual property rights similar to those granted to other artists.

2. Safeguarding Entrepreneurs Through Intellectual Property Rights. Most fashion designers, like most artists, work on a fairly limited budget unless they are lucky enough to be picked up by a large fashion house or to win public recognition. Fashion designers typically invest thousands of dollars in producing a collection before receiving any guarantee of profit. Large retail companies are able to produce replicas of an independent designer’s idea on a larger scale, at a quicker pace, and at a much lower cost without having to compensate the designer for the


135 Id.


137 Kate Betts, The School of Cool: With His Thrift-Store Style and Sexy Silhouettes, Marc Jacobs Has Become American Fashion’s Go-To Guy, TIME, Feb. 23, 2004, at 58.

138 See supra notes 28–30 and accompanying text.

139 See supra notes 20–23 and accompanying text.

140 See Hearing, supra note 17, at 10–12 (statement of Jeffrey Banks) (“Whether you are an accessory designer or a star designer creating men’s, women’s, children’s lines, you spend many thousands of dollars before you see your first order.”).
concept. In her testimony before the House Subcommittee on Courts, the
Internet, and Intellectual Property, law professor Susan Scafidi gave a concrete
example of this phenomenon at work. She described how handbag designer
Jennifer Baum Lagdameo created her own label, Ananas, which she operated
from her home.141 While Lagdameo enjoyed initial success selling her brand on
her own, one of her buyers recently cancelled an order after finding cheaper,
virtually identical copies of the handbags from another supplier.142 Scafidi also
noted on her weblog that Target began selling an almost indistinguishable copy
of an Ananas bag (down to the plum color scheme) for its Xhilaration label in
August of 2006.143

Because intellectual property law does not provide protection for the design
of a handbag or a garment, entrepreneurs such as Lagdameo are likely to be put
out of business by corporate giants such as Target. Thus, under current law,
while huge film studios such as Warner Brothers could, at least in theory, sue
college students who post three minute clips of their films on websites such as
YouTube.com, small, self-employed designers cannot recover from publicly-
owned retailers who openly pirate the designers’ ideas. If one of the major
policies of copyright law is to promote investment in creativity by protecting
artists from copyists, then Congress should provide designers recourse when
competitors flagrantly copy the designers’ craft.

3. Filling the Gap in Existing Law and Relieving Courts of the Unworkable Conceptual
Separability Standard. Courts have struggled for decades (often unsuccessfully) to
apply the conceptual separability standard to fashion works in order to separate
the design elements from the useful functions of a garment.144 Meanwhile,
despite how entrenched the useful articles doctrine appears to be in copyright law,
Congress has demonstrated its willingness to deviate from this doctrine by
amending the Copyright Act to provide protection for architectural works, boat
hulls, and semiconductor chips, all of which are ostensibly useful objects.
Extending copyright protection to fashion works therefore would not fly in the
face of current copyright law but rather would follow the course of legislation
established to protect “useful” objects that fall outside the realm of patent law.

Providing copyrights for fashion designs would bring to an end the judicial
confusion resulting from the conceptual separability doctrine. For decades,
judges have bemoaned the lack of redress for design piracy but have repeatedly
stressed that the proper remedy is through legislation rather than judicial

141 Id. at 77–85 (statement of Susan Scafidi).
142 Id.
20:15 EST).
144 See supra Part II.B.3 and accompanying notes.
interpretation. As the Fifth Circuit noted in 2005, "[h]ow to conduct the conceptual separation is . . . what continues to flummox federal courts."

In applying the confusing and varying standards of conceptual separability, courts have held that Halloween costumes are not copyrightable but masks and bear paw slippers are; belt buckles and bracelets are protected but casino workers' uniforms are not, and lace patterns on bridal dresses may be copyrighted but the dress designs themselves may not.

These results, when laid out all at once, seem not only absurd but also unfair. A pumpkin costume is no less a product of artistic creativity than a cat mask, and yet the latter is copyrightable while the former is not.

The courts would benefit from a clearer and more just standard, but they are incapable of providing an adequate solution for designers. Congress, not the courts, must fill the gap in intellectual property law resulting from the non-copyrightability of fashion designs. By enacting legislation giving short-term copyrights to fashion works, Congress would ameliorate this problem and relieve judges from wrestling with the inadequacies of the conceptual separability test.

See Cheney Bros. v. Doris Silk Corp., 35 F.2d 279, 279 (2d Cir. 1929) (Hand, J.) ("[T]he plaintiff, which is put to much ingenuity and expense in fabricating [silk designs], finds itself without protection of any sort for its pains."). Later in the opinion, Judge Learned Hand noted, "Judges have only a limited power to amend the law; when the subject has been confided to a Legislature, they must stand aside, even though there be an [sic] hiatus in completed justice." Id. at 281. Today, Cheney Brothers would have a remedy against Doris Silk because the courts have determined that fabric designs are conceptually separable from the garments themselves and are thus protected by copyright law. See supra note 67 and accompanying text. Eleven years after Cheney Brothers, the Second Circuit again lamented the lack of intellectual property protection for fashion works, specifically hat designs. See Millinery Creators' Guild v. FTC, 109 F.2d 175, 177 (2d Cir. 1940) ("[T]he designer 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 investment. Yet the imitator may copy with impunity, and the law grants no remedy to the creator.").

Galiano v. Harrah's Operating Co., 416 F.3d 411, 419 (5th Cir. 2005).


Masquerade Novelty, Inc. v. Unique Indus., 912 F.2d 663, 671 (3d Cir. 1990).

Animal Fair, Inc. v. AMFESCO Indus., 620 F. Supp. 175, 188 (D. Minn. 1985).

Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980).


B. CONGRESS SHOULD ADOPT A MODIFIED VERSION OF THE DESIGN PIRACY PROHIBITION ACT

Congress can balance the interests of consumers and fashion designers by passing a modified version of the proposed legislation, one which shortens the period of copyright, provides more guidance to courts in determining infringement, and broadens the scope of available remedies.

1. Change the Period of Protection to One Year. Congress should provide copyrights for fashion designs, but the term of the copyright should not exceed one year. This period of time would provide the best balance between the interests of the designer in preventing the proliferation of knock-offs and the interests of the consumer in obtaining affordable fashion. The “fashion cycle” traditionally worked as a cycle: runway concepts spurred retail knock-offs which spurred budget designs, and the cycle began again in a new season. Economists sometimes describe the cycle in terms of consumer behavior: elite (or “snob”) consumers set a trend; “aspirational” consumers (those who desire the expensive trends but lack the substantial budget to make many such purchases) copy the trend and “distribute” it to a broader audience; “bandwagon consumers” then begin buying into the trend as a way of being “in style.” Today, however, with Chinese factories spinning off copies of high fashion before the originals hit the market, the designers who come up with the ideas are unable to secure the first spot on the market.

A one-year term of copyright for fashion designs would help put the traditional fashion cycle back on course. Fashion houses, such as Prada and

---

154 See Hearing, supra note 17 (statement of Susan Scafidi) (“Once upon a time it may have been that the adoption of a new luxury item by affluent trendsetters was imitated first by wealthy consumers, then by the middle class, and then in the form of knockoffs by everyone else, at which point the fashion-forward would abandon the item and demand the next new thing—which producers were happy to provide. Today, however, this ‘fashion cycle’ scenario is rendered obsolete by the fact that poor quality knockoffs can be manufactured and distributed even more quickly than the originals. . . .”).

155 See Barnett, supra note 123, at 1390–91. Barnett also notes that “these three demand patterns—the snob, aspirational, and bandwagon effects—operate partly in sequence and partly simultaneously.” Id. at 1391.

156 See supra notes 24–26 and accompanying text; see also Raustiala & Sprigman, supra note 112, at 1714–15 (“Given the evanescence of many trends, fashion copying causes the greatest protests when copies are produced and distributed quickly. Increasingly, they are. Digital photography, digital design platforms, the Internet, global outsourcing of manufacture, more flexible manufacturing technologies, and lower textile tariffs have significantly accelerated the pace of copying. Copies are now produced and in stores as soon as it becomes clear a design has become hot, if not before.”).

157 See Schmidt, supra note 59, at 877 (suggesting that a one-year period of protection would balance the interests of designers and the public); see also Nurbhai, supra note 27, at 518 (arguing in
Marc Jacobs, display their seasonal collections on runways in New York City, London, Milan, and Paris, approximately six months before the designs will appear on the market (i.e., designs for the upcoming fall are shown in February and March). Thus, a one-year period of protection would allow designers to reap the rewards of their work and recoup costs by preventing piracy of their ideas on the runway and by enjoying about six months of exclusive sales on the retail market. The short length of exclusivity would also further the interest of the consumer in obtaining lower-cost fashion that is still “in style” and would prevent designers from stymieing the market with monopolies.

2. Establish More Specific Guidelines for What Constitutes a “Fashion Design.” The drafters of the DPPA should also provide more guidance about what types of designs are protected and what constitutes infringement. As currently worded, the bill grants copyrights to “the appearance as a whole of an article of apparel, including its ornamentation.” However, the phrase “the appearance as a whole” raises more questions than it answers. For instance, if a designer sought a copyright for a dress, it is not clear if the copyright would protect the cut and seaming of the dress, the color, or the beading.

The bill’s drafters clearly looked to the European Community’s design legislation when drafting their bill, as some of the provisions of the DPPA mirror provisions of the European Community regulation. However, the DPPA drafters would do well to look more closely at the detail provided in the European Community legislation. For instance, the regulation notes that the “appearance as a whole” of a garment or accessory results from its shape, color, texture, lines, ornamentation, and the material of which it is composed. This kind of detail forewarns would-be copyists about how closely they can mimic a design without being haled into court and gives designers a clearer understanding of the scope of protection they would receive.

While the detail of the European Community regulation is worthy of Congressional imitation, the bill drafters should adopt a stricter standard than that of the regulation. The regulation finds violation of a design right when the alleged infringer’s design “does not produce on the informed user a different overall impression.” Thus, the European Community regulation essentially forbids

favor of a one-year term of protection).

158 See Raustiola & Sprigman, supra note 112, at 1693.
159 See supra note 13.
160 For instance, the DPPA adopts the Regulation’s “appearance as a whole” language, and the proposed three-year copyright term in the U.S. bill reflects the term of protection for unregistered European Community designs. See supra Part II.A.1 and accompanying notes; supra Part II.C.1 and accompanying notes.
161 See supra note 89 and accompanying text.
162 See supra note 88 and accompanying text.
designers from producing garments in line with a particular season’s trend. For instance, Gucci might design a black, sleeveless, silk slip dress for the fall season, and H&M, a low-cost design retailer known for mimicking high fashion trends, might market a similar sleeveless rayon slip dress with a slightly different cut and beading along the neckline. Under the European Community regulation, H&M’s dress, while visually distinguishable from the Gucci version, might create the same “overall impression” and thus violate Gucci’s design right.

The fashion industry thrives on trends, with multiple design houses creating similar “looks” each season. Imitation, to a certain extent, fuels the industry. Copyright law must account for this phenomenon by prohibiting copyists from producing designs that are practically indistinguishable from the originals. Therefore, fashion retailers such as A.B.S. by Allen Schwartz, which openly market themselves as producing nearly exact replicas of runway dresses, would be held accountable for piracy, but other designers would not be dragged into the courthouse for creating their own version of the season’s cigarette pants.

The European Community regulation adequately limits the availability of intellectual property protection to certain designs. Only designs that have an “individual character” and are “new” qualify for protection. The DPPA does not offer similar clarity about the level of originality necessary to obtain a copyright for a fashion work. Congress should clarify the requirements for design copyright protection before enacting such a bill.

3. *Widen the Scope of Available Remedies.* The DPPA also does not provide comprehensive information about remedies. The bill suggests only that copyright-holders may seek $250,000 or $5 per copy in damages from infringers. However, these damages do not account for the wide variety of factors that influence how much a designer is “injured” by a copyist: the speed with which the copy appeared on the market, the costs the designer put forth in manufacturing and marketing the design, the popularity of the knock-off, the

---

163 See Raustiala & Sprigman, *supra* note 112, at 1728–32 (discussing anchoring phenomenon whereby the industry as a whole recognizes the trends of a particular season).

164 See, e.g., *What’s Hot Now: The Big Bangle Theory*, INSTYLE, Feb. 2007, at 182 (“As far as Hollywood’s major trendsetters are concerned, these days, bigger is indeed better when it comes to wrist accessories.”).


166 See *supra* note 88 and accompanying text.

167 See *supra* note 87 and accompanying text.

168 See *supra* note 16 and accompanying text.
extent of the copy’s effect on the original designer’s profits, and the designer’s financial situation. The bill drafters should take guidance from other sections of the Copyright Act, which entitle a plaintiff whose copyright has been infringed to recoup not only actual damages but also “any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages.” The Act also provides that the plaintiff may choose to recover statutory damages in lieu of actual damages and profits. The DPPA drafters should include this kind of remedial flexibility in their bill.

IV. CONCLUSION

Today’s fashion industry reaches into many other creative trades: fashion is often prominently displayed in films and on television shows (some of which, such as What Not To Wear and Project Runway, are devoted exclusively to fashion and style); the Oscars are as much a style contest as an acting or directing competition; fashion magazines sell millions of copies each year; musicians (such as Sean Combs) and actors (such as Jessica Simpson) have launched their own name-brand fashion lines. However, while the publishing, film, music, and television industries receive extensive intellectual property protection, fashion designers, all but a few of whom make only moderate salaries, are left in the cold. Courts have struggled for decades to determine which elements of a design are legally protected and which are “useful articles,” often bemoaning the void in intellectual property law but lacking means to provide redress. Professional copyists with factories in Asia are now able to use digital technology to reproduce catwalk designs almost instantaneously and place copies on the market even before the originals retail.

Given this state of affairs, Congress should step in and fill the void with short-term, narrowly tailored copyright protection for clothing and accessory designs. A one-year copyright would put the fashion cycle back on course, allowing original designers some time to recoup their investments in creativity while protecting consumers from long-lasting market monopolies. A narrowly tailored copyright would provide protection only for blatant and purposeful design piracy rather than casting a large net over an industry that thrives on trends and referencing. In order for upstart designers and entrepreneurs to be able to make a name for themselves and to reap rewards from their investment of time and resources, Congress should close the gap in intellectual property law with legislation providing a one-year, non-renewable copyright for fashion designs.

169 17 U.S.C. § 504(b) (2000); see also 1 Nimmer & Nimmer, supra note 70, § 14.01[A] (discussing plaintiff’s right to both actual damages and defendant’s profits).
170 17 U.S.C. § 504(c).
be most effective, this legislation should provide more guidance to courts about what acts constitute infringement and should offer plaintiffs a broader scope of remedies modeled on other provisions of the Copyright Act.

Laura C. Marshall