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Protecting Fashion: A Comparative Analysis of Fashion Design Protection in the U.S. and Europe

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In the year 2012 alone, the U.S. fashion industry generated over $330 billion in revenue.((US apparel industry reached a value of $338 billion in 2012, Companiesandmarkets.com, last visited Apr. 17, 2014, http://www.companiesandmarkets.com/News/Textiles-and-Clothing/US-apparel-industry-reached-a-value-of-338-billion-in-2012/NI8084.)) Not only does fashion contribute significantly to the economy, but fashion design is also a respected form of art in the United States.((Prominent museums have devoted their halls to fashion exhibits, thus illustrating the artistic significance behind fashion, including the Metropolitan Museum of Art's (the "Met") Alexander McQueen exhibit, "Savage Beauty," and the Met's Punk: Chaos to Couture exhibit. See http://blog.metmuseum.org/alexandermcqueen/; see also http://www.metmuseum.org/en/exhibitions/listings/2013/punk.)) Despite fashion's economic and artistic significance, the fashion articles themselves (i.e., the tailoring and structural aspects of a fashion article) are not currently protected under U.S. copyright law. An original pattern on a skirt or a screen print of an artist's painting on a t-shirt may be copyrightable. But a dress that a designer sketched in detail, for which he or she meticulously selected the colors, and artistically tailored, is not afforded copyright protection in the United States. In contrast, Europe has broader protections for fashion designs under European Community and national laws. This paper will compare the intellectual property fashion design protections in the United States, including the recent congressional attempt to protect fashion designs under copyright law, with the fashion intellectual property protections offered in the European Union, France, Italy and the U.K.

I. FASHION PROTECTION IN THE UNITED STATES

A. Limited Fashion Design Protection under Trademark and Patent Law

In the United States, several forms of intellectual property are available for designers. Under trademark law, a designer may protect his fashionable goods by investing in a distinctive logo or trade name that the consuming public recognizes as an indicator of the fashion article's source.((Michael P. Ryan, PhD, Introduction: Intellectual Property And The Creative And Innovative Economy, http://www.uspto.gov/ip/events/uspto_mena_booket_introduction.pdf.)) A designer can also seek trade dress protection in the "overall look and feel of a product or its packaging that signif[ies] the source of the product to consumers;" trade dress includes the shape of a fashionable good.((Michelle Mancino Marsh & Natasha Sardesai-Grant, Safe

Protection/Safe Inspiration:An Introduction to Intellectual Property Law for Fashion Designs, available at http://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=3&ved=0CDwQFjAC&url=http%3A%2F%2Fwww.kenyon.com%2F~%2Fmedia%2FFiles%2FPublication%2520PDFs%2F2012%2FFashion_and_IP_article.ashx&ei=N3JJU_nuJ-zQsQT2k4HQDg&usg=AFQjCNEeV1YKhMnfzfc1ybDLPbMNiNqwCA&sig2=zD9RbFaxGPI5-FDjemQ06A&bvm=bv.64542518,d.cWc.)) Some designers use trademarks to distinguish their designs by incorporating their logos or marks into the fashionable item.((Id. ("The Burberry plaid provides an example-the plaid is a registered trademark, which the company incorporates into many of its products.").)) But even then, the designer must show that the design identifies the source of the fashion article.((Id.)) One issue with this approach is that once the design becomes popular, many other companies will begin to use the same design on their goods since the design itself is not actually protected.((Id.)) Once others use the design, it no longer points to the original fashion designer as the source.((Id. Companies like Forever 21 frequently copy the designs and popular fashion trends from other designers. See Justin Fenner, How F21 Manages To Copy Designer Fashion And Get Away With It, (July 21, 2011 4:31 P.M.) http://www.styleite.com/news/forever21-copy-designer-clothing/.)) Trademark law offers minimal protection for fashion articles, as it only protects the logos and marks that distinguish the source of the goods, rather than the designs themselves. ((See Lisa J. Hedrick, Tearing Fashion Design Protection Apart at the Seams, 65 Wash. & Lee L. Rev. 215, 226 (2008).))

A designer can also apply for a design patent,((Some iconic fashion design patents are Bottega Veneta's "Veneta" Handbag, U.S. Patent No. D657,952 and Jimmy Choo's "With a Twist" U.S. Patent No. D529,264. Marsh & Sardesai-Grant, supra note 4.)) which protects any "new, original and ornamental design for an article of manufacture."((35 U.S.C.A. § 171 (West). This section lists various types of works that would be considered "works of authorship" for the purpose of this section, and apparel is not listed: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. Id.)) However, design patent are difficult to obtain for fashion designs "'[b]ecause so many apparel designs are re-workings 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."((Hedrick, supra note 9 at 223 (citing Kal Raustiala & Christopher Sprigman, The Piracy Paradox: Innovation and Intellectual Property in Fashion Design, 92 Va. L. Rev. 1687, 1704 (2006).))

B. Current Copyright Protection

A third form of intellectual property—copyright—protects "original works of authorship fixed in any tangible medium of expression."((17 U.S.C.A. § 102 (West))) For a work to be

considered original, it need only be "independently created by the author (as opposed to copied from other works), and possess at least some minimal degree of creativity."((Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 345, (1991), citing 1 M. Nimmer & D. Nimmer, Copyright §§ 2.01[A], [B] (1990).)) Since the originality requirement for copyright is a lesser hurdle than the "novelty" threshold required for a design patent, copyright appears to be the most practical intellectual property regime to protect fashion designers.((Hedrick, supra note 9 at 228.))

However, fashion designs, i.e., the particular manner a garment is assembled and tailored, are not protectable under current U.S. copyright law.((Nimmer on Copyright, § 2.08 [H])) Professor David Nimmer differentiates between two separate concepts that fall under the term "fashion designs": (1) "fabric designs" and (2) "dress designs." ((Id.)) Fabric designs are the patterns used on the article of clothing, such as the floral design repeated on a blouse, and are copyrightable. ((Id. citing Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc., 169 F. Supp. 142 (S.D.N.Y. 1959); Peter Pan Fabrics, Inc. v. Acadia Co., 173 F. Supp. 292 (S.D.N.Y. 1959), aff'd, 274 F.2d 487 (2d Cir. 1960); Peter Pan Fabrics, Inc. v. Candy Frocks, Inc., 187 F. Supp. 334 (S.D.N.Y. 1960); Spectravest, Inc. v. Mervyn's, Inc., 673 F. Supp. 1486 (N.D. Cal. 1987).)) However, the latter type—dress designs—which "graphically sets forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment," are not protectable by copyright. ((Nimmer on Copyright, § 2.08 [H]))

Clothing has been considered a "useful article" as defined in section 101 of the Copyright Act because it has "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."((Id.; 17 U.S.C. § 101. However, Professor Nimmer believes that not all clothing has an intrinsic utilitarian function, but rather some clothing items may be "intended to portray the appearance of the article" and offers men's ties as a possible example. (Id. citing Nimmer on Freedom of Speech, § 3.06[E][3]).)) The only way for the design of a garment to acquire copyright protection is if the design "can be identified separately from, and [is] capable of existing independently of, the utilitarian aspects of the article," as set out in section 101 of the Copyright Act. ((See 17 U.S.C. § 101)) Courts have construed this separability requirement to mean both "physical" or "conceptual" separability. ((Jovani Fashions v. Fiesta Fashions, Docket No. 12-598-cv, 2012 WL 4856412 (citing Chosun Int'l, Inc. v. Chrisha Creations, Ltd. 413 F.3d 324 (2d Cir. 2005) ("We have construed 17 U.S.C. § 101 to afford protection to design elements of clothing only when those elements, individually or together, are separable—'physically or conceptually'—from the garment itself.").)) Physical separability is demonstrated when the decorative elements "can actually be removed from the original item and separately sold, without adversely impacting the article's functionality." ((Chosun, 413 F.3d at 329.)) Conceptual separability is when the garment "invoke[s] in the viewer a concept separate from that of the [garment's] 'clothing' function," and if its "addition to the [garment] was not motivated by a desire to enhance the [garment's] functionality qua clothing." For example, a fabric design—the repeated floral print—is capable

of existing separately from the actual skirt, but the dress design—the tailoring and the shape the skirt—cannot exist separately from the skirt. ((See Nimmer on Copyright, § 2.08 [H].))

For certain articles of clothing that may appear to serve an added function other than usefulness—e.g., costumes, prom dresses, or worker's uniforms—the actual dress designs may or may not be copyrightable. In 2005, the Second Circuit in Chosun Int'l, Inc. v. Chrisha Creations, Ltd. held that Halloween costumes may be protected by copyright if the costume's design elements can be separated from the overall function of the costume as clothing. ((413 F.3d 324 (2d Cir. 2005).)) In a 2012 unpublished decision, Jovani Fashions v. Fiesta Fashions, the Second Circuit denied copyright protection to the designs of a prom dress, specifically "the arrangement of decorative sequins and crystals on the dress bodice; horizontal satin ruching at the dress waist; and layers of tulle on the skirt." ((Docket No. 12-598-cv, 2012 WL 4856412)) Citing Chosun as precedent, the court held that Jovani failed to meet the separability requirements: for physical separability, "Jovani has not alleged, nor could it possibly allege, that the design elements for which it seeks protection could be [physically] removed from the dress in question and separately sold." ((Id.)) Towards conceptual separability, the Court added "that clothing, in addition to covering the body, serves a 'decorative function,' so that decorative elements of clothing are generally 'intrinsic' to the overall function, rather than separable from it." ((Jovani Fashion, Ltd. v. Fiesta Fashions: Second Circuit Finds Dress Designer's Copyright Claim Weak at the Seams, Sheppard Mullin Richter Hampton LLP, Dec. 3, 2012, http://www.martindale.com/intellectual-property-law/article_Sheppard-Mullin-Richter-Hampton-LLP_1635964.htm Citing Jovani.))

The Fifth Circuit in Galiano v. Harrah's Operating Co. denied copyright protection for uniforms of casino workers, because the clothing designer could now show that "its designs [were] marketable independently of their utilitarian function as casino uniforms." ((416 F.3d 411, 420 (5th Cir. 2005))) The Fifth Circuit admitted that "[t]he caselaw on costume design is, to say the least, uneven." But regardless of which standard test a court may use to find valid "separability," copyright protection would still be limited to the portions of the fashion, and not the fashion article as a whole. ((See Hedrick supra note 9 (citations omitted).))

C. Legislative Initiative to Extending Copyright Protection to Fashion Designs—the IDPA

In an effort to expand copyright protection to entire fashion articles, a recent congressional proposal has been made to amend the Copyright Act's definition of "useful article" to include apparel. ((Jovani Fashion, at 3.)) The most recent proposal is the Innovative Design Protection Act of 2012 (the "IDPA"). ((S.3523-112th Congress (2011-2012). The IDPA was reintroduced from its predecessor bill, the Innovative Design Protection and Piracy Prevention Act (the "IDPPPA"), H.R.2511.)) The IDPA would grant protection to fashion designs for three years and would prohibit a claim that a fashion design was copied from a protected design if it "(1) is not substantially identical in overall visual appearance to and as to the original elements of a protected design, or (2) is the result of independent creation." ((

http://beta.congress.gov/bill/112th-congress/senate-bill/3523/text.)) It also revises the state infringement remedy by declaring the design owner can sue for design infringement after the design is made public and after a twenty-one day notice period. ((http://beta.congress.gov/bill/112th-congress/senate-bill/3523.))

The debate continues in the United States whether extending copyright protection to fashion designs will help or hurt the U.S. fashion industry. The IDPA "has been heralded by [some of] the heads of the fashion industry as a tool that may finally level the playing field in the counterfeit goods and design infringement cases that have been exploding in recent years due to the ease at which individuals are able to steal designs." ((Kelly Grochala, "Intellectual Property Law: Failing the Fashion Industry and Why the 'Innovative Design Protection Act' Should be Passed" (2014), Student Scholarship, Paper 133 available at http://erepository.law.shu.edu/student_scholarship/133 (citing Guillermo C. Jimenz, Let's Pass the New Design Piracy Bill, Fashion Law Center, Sept. 13, 2010 available at http://fashionlawcenter.com/?tag=design-piracy).)) In contrast to the idea that unauthorized copying reduces innovation, some scholars believe that copying actually benefits the U.S. fashion industry. ((See Kal Raustiala & Christopher Sprigman, The Piracy Paradox: Innovation and Intellectual Property in Fashion Design, 92 Va. L. Rev. 1687 (2006).)) According to Kal Raustiala and Chris Sprigman, "piracy paradoxically benefits designers." ((Id.)) This "piracy paradox"—the notion that copying actually "promote[s] innovation and benefit[s] originators" in the U.S. fashion industry ((Eveline van Keymeulen & Louise Nash, Fashionably late, Intellectual Property Magazine, at 53 http://www.cov.com/files/Publication/8fc11e54-27e2-4da3-9323-0663dd0a5746/Presentation/PublicationAttachment/45a27275-df92-475b-9e11-11154b0c1061/Fashionably%20Late.pdf.))— why the debate continues on in the United States and why no action has been taken is a reason to push forward with the IDPA since it was introduce in 2012. ((http://beta.congress.gov/bill/112th-congress/senate-bill/3523.))

II. FASHION DESIGN PROTECTION IN EUROPE: COPYRIGHT AND DESIGN RIGHTS

Intellectual property protection is at the heart of most European fashion business models; the industry is "driven by fast paced innovation embodied in the creation of seasonal collections of new fashion designs." ((Keymeulen & Nash, supra note 38.)) In contrast to the United States copyright system, Europe's copyright regime protects dress designs. Europe remains the center of the haute couture, ((Haute couture can be defined as "(the business of making) expensive clothes of original design and high quality." http://dictionary.cambridge.org/us/dictionary/british/haute-couture.)) and the protection of fashion designs is a core feature of its cultural identity and legal regimes. In the European Union (the "EU"), fashion products—including traditional apparel categories, accessories, and footwear—can be protected under national and Community design laws and national copyright laws. ((Id.))

A. Community Design Protection

The European Union implemented a uniform, EU-wide protection for design rights by first adopting the EU Designs Protection Directive (98/71/EC), which required all Member States (the individual European countries that comprise the European Union) to protect "designs" by registration ((See Council Directive 1998/71, art. 3, 1998 O.J. (L 289) 28, 30 (EC) [hereinafter EU Directive].)) and defined design as "the appearance of the whole or a part of a product resulting from the features of . . . the lines, contours, colours, shape, texture . . . or its ornamentation." ((Id., art. 1, at 30.)) The design right protects designs that are "novel" and possess an "individual character"; ((Id., art. 3, at 30.)) novelty is determined by whether or not there are identical designs available to the public, and individual character is determined by whether "the overall impression, from an informed user's point of view, is different from other designs available to the public." ((Emma Yao Xiao, The New Trend: Protecting American Fashion Designs Through National Copyright Measures, Note, 23 Cardozo Arts & Ent. L.J., 405, 412, available at https://www.cardozoaelj.com/wp-content/uploads/Journal%20Issues/Volume%2028/Issue%202/Xiao.pdf ("This is a heightened standard of infringement because even if a design has not been copied exactly, infringement can occur if it has the same overall impression on an informed user.").))
After its design right directive, the EU enacted EU Regulation 6/2002, (the "EU Regulation"), extending protection of the Community design right to include both registered and unregistered rights. ((JF Bretonniere & Frédérique Fontaine, Europe: Using Community design rights to protect creativity, Building and enforcing intellectual property value 2010, at 32, available at http://www.iam-magazine.com/issues/Article.ashx?g=2309c3b6-a4fe-4f8b-bb07-48775ecfee22.)) While registered design rights were already provided for, the EU Regulation 6/2002 implemented a new sui generis design right for the unregistered Community design. ((Id.)) Registered and unregistered Community design rights provide different rights; for example, registered rights are protected for the first term five years from the application filing date with a renewal possibility for up to 25 years, whereas unregistered designs are only protected for three years from the date which the design was first published in the Community. However, unregistered design rights are good for protecting "short-life products (e.g., products within the fashion industry)," because the registration process may be long and costly. ((Id.))

B. National Copyright Protection: France, the United Kingdom, and Italy

Community design rights can also be protected under national copyright laws, but the conditions to obtaining copyright protection, including the level of originality required, are determined by each Member State. ((Id.)) As the home to some of the most prominent haute couture fashion houses, France's copyright system has historically protected fashion designs. ((See Xiao, supra note 46 at 413; see also Keymeulen & Nash, supra note 38 at 54.)) The French Intellectual Property Code (the "French IP Code") protects original works of the mind, including those that "reflect the personality of their author" and expressly lists "the creations of the seasonal industries of dress and articles of" as a protected work of the mind in Article L. 112-2. ((Holger Gauss, Boriana Guimberteau, Simon Bennett, Lorenzo Litt, Red Soles Aren't

Made for Walking: A Comparative Study of European Fashion Laws, 5 Landslide 6, available at http://www.americanbar.org/publications/landslide/2012_13/july_august/red_soles_arent_made_walking_comparative_study_european_fashion_laws.html.)) The challenge faced by design owners is showing the original character of their designs, because fashion designs usually follow the current trends and therefore may lack originality. ((Id.)) The design is granted protection on the date of creation, regardless of registration. ((Xiao, supra note 46(The grant of protection regardless of registration is "unlike different protection schemes given to registered and unregistered designs under the European Union regulations.").)) The French courts tend to adhere more strictly to the originality requirement for designs and typically will deny copyright protection over a design that could be considered commonplace. ((Gauss, Guimberteau, et al, supra note 52.))

In contrast to U.S. law, French law offers the designer both moral and patrimonial rights over his or her design at the moment the original work is created. ((Laura C. Marshall, Catwalk Copycats: Why Congress Should Adopt A Modified Version Of The Design Piracy Prohibition Act, 14 J. Intell. Prop. L. 305, 319.)) Patrimonial rights offer the author "'the exclusive rights to represent, reproduce, sell or otherwise exploit the copyrighted work of art and to derive a financial compensation therefrom.'" ((Id. (citation omitted).)) Under section L121-9 of the French IP Code the designer has four main branches of moral rights: (1) the droit de paternité – the right of attribution of a work, which is designer's right to be identified as the author; (2) the droit au respect de l'intégrité de l'œuvre, the right of integrity, which is the designer's right to prohibit the modification or destruction of his or her work; (3) the droit de divulgation – the right of disclosure, which is the designer's right to chose when and how to publicize his work; and (4) the droit de repentir ou de retrait – the right of withdrawal, which allows the designer to take back works that have been already publically disclosed. ((Jean-François Bretonnière & Thomas Defaux, France: French copyright law: a complex coexistence of moral and patrimonial prerogatives, available at http://www.iam-magazine.com/issues/Article.ashx?g=17e4662b-dbdd-4a41-9dcf-b58838853682.)) New fashion designs can be protected not only under copyright, but also under the sui generis design rights as discussed above.

Like France, Italy protects fashion designs under its national copyright system. The Italian Copyright Law (the "LDA") protects "works of the mind having a creative character and belonging to literature, music, figurative arts, architecture, theater or cinematography, whatever their mode or form of expression, shall be protected in accordance with this Law," and "[i]n particular, protection shall extend to . . . industrial design works that have creative character or inherent artistic character." ((Gauss, Guimberteau, et al, supra note 52, citing Legge d'autore [LDA] 22 aprile 1941, n. 633, pt. I, ch. I (It.).)) Copyright protection does not depend on registration; under the LDA, fashion designers can seek an ex parte interim injunction to seize any copy of their designs that have creative and artistic value from the Italian courts and then ask for a permanent injunction and damages for unregistered works. ((Id.)) A designer's copyright lasts the life of the designer plus seventy years after the

designer's death. ((Xiao, supra note 46 at 414 (citing Law No. 633 of April 22, 1941, § 25, Protection of Copyright and Rights Related to its Exercise (It.), available at http://www.wipo.int/clea/en/text_html.jsp?lang=en&id=2582).)) A designer in Italy can protect his or her fashion designs under both copyright and design protection. The Italian Industrial Property Code (the "CPI") protects designs that are registered with the Italian Patent and Trademark Office ("IPTO") and any applicable international design registrations. ((Id. at 415.))

In the United Kingdom, fashion designs that are original "artistic works" obtain automatic copyright protection. ((Id.)) "'Artistic' works include graphic works, photographs, sculpture, or collage, irrespective of artistic quality and works of artistic craftsmanship." ((Id.)) To obtain automatic copyright protection, the creative idea must be fixed in tangible form, they must be original, and the designer must be a U.K. citizen or domiciled in the United Kingdom or a country that belongs to the Berne and Universal Copyright Conventions or to the WIPO Copyright Treaty. ((Id.)) Separate from copyright protection, a designer can also seek design protection under the Copyright, Designs, and Patents Act of 1988 ("CDPA"). Under the CDPA, a design must be original and "recorded in a design document or an article has been made to the design." ((Copyright, Designs and Patents Act, 1998, c.48 (Eng.), at § 213, available at http://www.opsi.gov.uk/acts/acts1988/UKpga_19880048_en_1.htm.)) If a design is considered "commonplace in the design field in question at the time of its creation" it is not "original" for the purpose of the design right. ((Id. at § 213(4).))

The copyright protections granted under France, Italy, and U.K. national laws are separate and distinct from the sui generis design rights designated under the EU Regulation 6/2002 and EU Designs Protection Directive (98/71/EC). Therefore, dual protection (copyright and design protection) over a fashion design may sometimes confuse courts and cause them to conflate the novelty requirement for design protection with the originality requirement for copyrights. For example, the Paris Court of Appeals held that a shoe model was original (in favor of the copyright protections) but also novel and possessing individual character (relating to the design protection requirements) because no identical model was disclosed to the public and the overall impression it imposed upon the consumer was different from the other models disclosed to the public. ((Id. citing CA Paris, June 3, 2011, SAS Chaussea v. SARL Menport (Fr.).)) There is an effort to distinguish copyright and design rights. Thus it may be possible for a fashion creation to be denied copyright protection but granted design protection in France, as illustrated by a recent French Supreme Court decision, which rejected the protection of a shoe because it had the same characteristics as a preexisting model, but upheld the design rights because the models were not identical. ((Id. citing Cass., 1e civ., Apr. 5, 2012, J-M Weston v. Manbow (Fr.).))

CONCLUSION

A fashion designer seeking to protect his or her designs must be cognizant of the differences in the intellectual property protections that cover fashion designs in the United States versus

those in the European Union. In the United States, fashion designs are afforded minimal protection under trademark and patent law, and currently dress designs are not protected under copyright. Despite the recent congressional proposals to amend the Copyright Act to include fashion articles as a copyrightable work, ((S.3523-112th Congress (2011-2012) (IDPA).)) the U.S. fashion industry is a unique business that many U.S. scholars believe actually benefits from rapid widespread copying, and therefore extending copyright protection to fashion articles may be unlikely to occur anytime soon.

In contrast, the European Union offers substantially more intellectual property protections for fashion designers, which reflects upon the EU's reputation as the fashion hub and noted region for haute couture fashion houses. ((See Keymeulen & Nash, supra note 38 at 53.)) Designers in Europe have two main sources of intellectual property protection for fashion designs: copyright protection and sui generis design right protections. ((Gauss, Guimberteau, et al, supra note 52.)) While a designer may chose to protect his or her designs under only one regime, the cumulative protection is possible. However, both designers and even the courts of the EU Member States must be careful to recognize the difference between copyright and design protections and not conflate copyright's "originality" requirements with the design rights' "novelty" and "individual character" requirements.