FASHION 2.0: IT'S TIME FOR THE FASHION INDUSTRY TO GET BETTER-SUITED, CUSTOM-TAILORED LEGAL PROTECTION

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"If you want to be original, be ready to be copied." – Coco Chanel

ABSTRACT

In the United States, fashion designs are not protectible under any of the traditional forms of intellectual property—namely patents, copyrights, or trademarks. Fashion designs are creative works of art and as such are worthy of the same protection as musical recordings, films, books, software programs, or paintings. However, because Congress has consistently neglected addressing the piracy problem in the fashion industry, fast-fashion brands and retailers have been rampantly copying fashion designs almost without consequence. This unethical behavior hurts emerging designers and smaller brands the most. This is why the legal system should stop turning a blind eye and provide designers with a solution that allows for the protection of their designs without interfering with the unique pace of the fashion industry's creative process.

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INTRODUCTION

Some people like fashion, while others simply do not care about what they are wearing. Some people can afford to go to Bergdorf Goodman and buy a handbag they saw Kim Kardashian carrying to the gym—something that many people would not be able to afford in a lifetime. Most of us, on the other hand, feel lucky when we can go to a fast fashion retailer and buy something that looks remarkably similar. We do not usually stop to think how much we are hurting Chanel, Louis Vuitton, Gucci, or Saint Laurent. But what would happen if you went to Forever 21 and found a t-shirt with a design that took you months to create, or a handbag that you have been selling for years and that represents your livelihood?

Unfortunately, that is the reality for many independent designers.[1] From the design of an enamel pin[2] or patch, to a handbag,[3] t-shirt,[4] swimsuit,[5] or jacket[6], fast fashion retailers[7] like Forever 21,[8] Zara,[9] H&M,[10] and Fashion Nova,[11] and even

1. *See generally* Tiffany F. Tse, Note, *Coco Way Before Chanel: Protecting Independent Fashion Designers' Intellectual Property Against Fast-Fashion Retailers*, 24 CATH. U. J.L. & TECH. 401, 405–06 (2016) (discussing the differences between in-house designers and independent designers).

2. Michal Addady, *12 Artists Are Accusing Zara of Stealing Their Designs*, FORTUNE (July 20, 2016, 5:30 PM), http://fortune.com/2016/07/20/zara-stealing-designs/; Thea de Gallier, *Independent Artists Claim High Street Chain Zara Is Copying Their Designs*, BBC (July 26, 2016), http://www.bbc.co.uk/newsbeat/article/36884063/independent-artists-claim-high-street-chain-zara-is-copying-their-designs; Dayna Evans, *Talking with Tuesday Bassen About Her David vs. Goliath Battle Against Zara*, CUT (July 29, 2016, 8:00 AM), https://www.thecut.com/2016/07/tuesday-bassen-on-her-work-being-copied-by-zara.html.

3. Rachel Denniston, *My Bag Design Was Stolen by a Big Fast Fashion Brand–and It Devastated Me*, HELLO GIGGLES (Jan. 15, 2018, 7:36 AM), https://hellogiggles.com/fashion/my-bag-design-was-stolen-by-a-big-fast-fashion-brand-and-it-devastated-me/; Hayley FitzPatrick, *This Designer Claims Forever 21 Ripped Off Her Bag*, YAHOO STYLE (Apr. 26, 2017), https://www.finance.yahoo.com/news/designers-claims-forever-21-ripped-off-bag-205849403.html.

4. Channing Hargrove, *Forever 21 Accused of Ripping Off the Wild Feminist T-Shirt Everyone Loves*, REFINERY29 (Aug. 18, 2017, 2:00 PM), http://www.refinery29.com/2017/08/168773/forever-21-wildfang-copy-wild-feminist-shirt.

5. Dhani Mau, *How Do Indie Designers Deal with Knockoffs?*, FASHIONISTA (Aug. 4, 2016), https://fashionista.com/2016/08/indie-designers-knockoffs.

6. Alyssa Coscarelli, *Forever 21 Strikes Again–This Time, with a Cult-Favorite Leather Jacket*, REFINERY29 (Nov. 1, 2017, 5:45 PM), http://www.refinery29.com/2017/10/179107/forever-21-sandy-liang-designer-feud?utm_source=facebook.com&utm_medium=post.

7. *See* C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1170–74 (2009). *See generally* Alexandra Manfredi, Note, *Haute Copyright: Tailoring Copyright Protection to High-Profile Fashion Designs*, 21 CARDOZO J. INT'L & COMP. L. 117–22 (2012) (discussing the "fast fashion" business model).

8. *See* Jenna Sauers, *How Forever 21 Keeps Getting Away with Designer Knockoffs*, JEZEBEL (July 20, 2011, 4:20 PM), https://jezebel.com/5822762/how-forever-21-keeps-getting-away-with-designer-knockoffs.

9. Marissa G. Muller, *Is Zara Knocking Off Small Fashion Brands?*, GLAMOUR (Aug. 30, 2016, 4:31 PM), https://www.glamour.com/story/is-zara-knocking-off-small-fashion-brands.

10. Patrick Montes, *H&M Accused of Copying Sadboys Gear Designs*, HYPEBEAST (Mar. 10, 2018), https://hypebeast.com/2018/3/sadboys-hm-love-roses.

11. *Ultra-Fast Fashion Retailer Fashion Nova is Being Sued for Copying*, FASHION L. (Dec. 4, 2018), http://www.thefashionlaw.com/home/ultra-fast-fashion-retailer-fashion-nova-is-being-sued-for-copying.

renowned designers like Marc Jacobs,[12] Christian Dior,[13] and Vivienne Westwood[14] have been called out for copying designs from social media without licensing them from their owners. Although piracy is not new, the many ways in which the world has changed in the last thirty years[15] coupled with the rapid growth of social media and its impact on the way we consume fashion have shifted the attention from high-end luxury brands to emerging, independent, and lesser-known designers and brands. To promote their businesses,[16] these designers usually rely on advertising their creations on social media, such as Instagram[17] or Facebook,[18] or online retailers such as Etsy[19] or eBay.[20] For many of them, starting their own businesses might have taken months or even years, representing a huge financial investment for themselves and their families. Many of these entrepreneurs have dreamt about being fashion designers for their entire lives, and have studied and prepared themselves to start their own label. For them, fashion is not only their business; it is also their passion. It can take these designers months to design a single piece of clothing or an accessory, and

12. *Marc Jacobs' Resort 2017 Collection Was "Not Original" per New Lawsuit*, FASHION L. (Nov. 7, 2017), http://www.thefashionlaw.com/home/marc-jacobs-resort-2017-collection-was-not-original-per-new-lawsuit.

13. Maria Thomas, *An Indian Designer Is Accusing Christian Dior of Copying One of His Prints*, QUARTZ INDIA (Jan. 24, 2018), https://qz.com/india/1187631/an-indian-designer-is-accusing-christian-dior-of-copying-one-of-his-prints/.

14. Luke Leitch, *Andreas Kronthaler for Vivienne Westwood*, VOGUE (Mar. 3, 2018), https://www.vogue.com/fashion-shows/fall-2018-ready-to-wear/andreas-kronthaler-for-vivienne-westwood.

15. S*ee* Catherine Claire, *How Social Media Has Changed Fashion*, ADWEEK (Dec. 22, 2017), http://www.adweek.com/digital/catherine-claire-guest-post-how-social-media-has-changed-fashion/; Katie Hope, *How Social Media Is Transforming the Fashion Industry*, BBC NEWS (Feb. 5, 2016), http://www.bbc.com/news/business-35483480. *See generally* Daryl Wander, Note, *Trendsetting: Emerging Opportunities for the Legal Protection of Fashion Designs*, 42 RUTGERS L.J. 247, 257–64 (2010) (explaining the many ways in which the fashion world has changed in the past twenty-five years).

16. *See generally The Ultimate Guide to Selling Clothes & Other Apparel Online*, VOLUSION (May 19, 2015), https://www.volusion.com/blog/the-ultimate-guide-to-selling-clothes-other-apparel-online/ (teaching how to effectively sell clothes online).

17. INSTAGRAM, https://www.instagram.com (last visited Dec. 15, 2018).

18. FACEBOOK, https://www.facebook.com (last visited Dec. 15, 2018).

19. ETSY, https://www.etsy.com (last visited Dec. 15, 2018).

20. EBAY, https://www.ebay.com (last visited Dec. 15, 2018).

it usually takes them even more time to see that design come to life. Some of them work from home, some of them have a team, some even have a store, but what they do not have is a legal tool that allows them to adequately protect their creations.[21]

The global fashion industry is valued at three trillion dollars, with a market value of $385.7 billion in the United States alone.[22] These impressive numbers might suggest that there exists a legal framework adequately conferring protection to designs—the industry's principal creative element—but surprisingly, the fashion industry operates in what has been called a "low-IP equilibrium."[23] In other words, the intellectual property (IP) protection afforded to the industry through copyrights, trademarks, and patents provides very limited protection for the industry's designs.[24]

While the most important form of IP protection in the fashion industry is trademark law, brands have recently begun to rely more heavily on design patents to protect their creations.[25] This recent trend can be explained by the fact that neither trademark nor copyright law protection extends to articles of clothing or accessories in their entirety.[26] In the United States, fashion designs have no specific protections different and separate from the existing and traditional mechanisms that protect other forms of IP.[27] Design patents offer the most cost-effective solution to protect the design of an article of clothing, and provide "overlapping or supplemental protection" with the other traditional forms of IP protection.[28] However, because

21. *See generally What Is Really at Stake when an Indie Brand Is Copied?*, FASHION L. (June 1, 2018), http://www.thefashionlaw.com/home/what-is-really-at-stake-when-an-indie-brand-is-copied (discussing the negative impact "copying" has on independent designers).

22. *Global Fashion Industry Statistics—International Apparel*, FASHIONUNITED, https://fashionunited.com/global-fashion-industry-statistics (last visited Dec. 15, 2018).

23. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1699 (2006).

24. *Id.*

25. *See Currently Trending in Fashion: Design Patents*, FASHION L. (June 23, 2016), http://www.thefashionlaw.com/home/currently-trending-in-fashion-design-patents.

26. *Id.*

27. Elizabeth Ferrill & Tina Tanhehco, Note, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & TECH. 251, 252 (2011).

28. *Id.* at 278.

obtaining a patent is both expensive and time-consuming, this protection is typically sought by big brands with a significant accessory business, and only for their staple items.[29] This usually means that fashion designers who have just established their businesses and do not have enough income or time to ensure their designs are protected are far more likely to become victims of online copycats.[30]

The United States is long overdue in affording fashion designers comprehensive legislation to ensure that the results of their hard work, creativity, and financial investment will be protected against copycats. To do so, Congress could follow the European model and adopt a *sui generis* regime that allows creative minds to monetize their designs without fear of being plagiarized, while at the same time allowing the fashion world's unique pace to continue evolving season by season. This would require taking some elements from already available forms of IP protection and adopting them to the fashion world's distinct needs. For example, limiting the amount of time such protection is afforded or adopting new standards of protectibility would provide the legal framework that the fashion industry's creative minds need to design new and risky items without fear of seeing their designs being sold online for a fraction of the price within days of release. A different approach would be to create specialized courts within the Copyright Office, or to join efforts with fashion organizations to mandate arbitration or mediation so that fashion experts can be in charge of deciding whether a design has been copied. No matter how legislators decide to solve this issue, however, it is clear that the current state of affairs leaves those who are trying to break into the industry at an unfair disadvantage, and is far from "promoting the progress" of one our most "useful arts": fashion.[31]

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29. *Currently Trending in Fashion: Design Patents*, *supra* note 25.

30. For a discussion of how fast-fashion impacts independent designers' economy, see Tse, *supra* note 1, at 417–22. *See also* Hemphill & Suk, *supra* note 7, at 1153 ("The main threat posed by copyists is to innovation by smaller, less established, independent designers who are less protected . . . [a]ffording design protection would level the playing field with respect to protection from copyists and allow more such designers to enter, create, and be profitable.").

31. U.S. CONST. art. I, § 8, cl. 8.

Part I of this Note addresses the current IP framework available for fashion designs and evidences why each of the three traditional forms of IP protection—copyrights, trademarks, and patents—is not suitable to safeguard fashion designers against copying. Part II will examine proposed legislation and alternative means of protection that could be made available to protect fashion designs, as well as some of the arguments that have been made for and against such stronger protection. This Note will conclude by calling for the introduction of new protective measures that would allow smaller designers to protect their inventions in a cost-effective way.

I. CURRENTLY AVAILABLE IP PROTECTION FOR FASHION DESIGNS

Unlike many countries in Europe, the United States does not have a *sui generis* framework that protects the fashion industry.[32] As a consequence, the industry relies on patents, trademarks, and copyright to protect its creations, none of which are specifically tailored or appropriate to protect fashion designs as a whole.[33] The lack of adequate safeguards puts emerging designers and small fashion brands at a higher risk than well-known brands of having their fashion designs copied without consequence.[34] Although well-known fashion brands have been consistently targeted by counterfeits and knock-offs, these companies usually have the economic means to hire lawyers to protect and enforce their rights, whereas independent designers can often only resort to shaming on social media.[35] Not only are the available forms of IP protection

32. Ferrill & Tanhehco, *supra* note 27, at 270.

33. *Id.* at 271.

34. *See Susan Scafidi on Copyrighting Fashion*, FELIX SALMON (Sept. 19, 2007), http://www.felixsalmon.com/2007/09/susan-scafidi-on-copyrighting-fashion/ ("Small emerging designers, who cannot yet hide behind their trademarks, continue to suffer from the copying of their designs, as do designers whose artistic vision doesn't include giant logos or repetitive elements of trade dress.").

35. *See* Kaitlin Menza, *If You Shame Them, Will They Pay?*, N.Y. TIMES (Sept. 20, 2017), https://www.nytimes.com/2017/09/20/fashion/forever-21-knockoff-designs.html; Kari Paul, *Is Social Media the New Court of Law for Fashion Copycats?*, MARKETWATCH (June 10, 2017, 9:40 AM),

costly and time-consuming—putting designers on a budget at a disadvantage—but they are also unfit to protect fashion designs from being copied.[36]

A. *Trademarks and Trade Dress*

The Lanham Act—the federal statute governing trademark law—defines a "trademark" as "any word, name, symbol[,] or device . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."[37] This protection is based on the distinctiveness of the good, and works to prevent "a likelihood of confusion" among the purchasing public.[38]

Trademark protection is used to identify the goods or services of a person or company,[39] and therefore does not protect individual fashion designs. Rather, trademarks safeguard brands as a whole[40] by conferring protection to specific aspects

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https://www.marketwatch.com/story/is-social-media-the-new-court-of-law-for-fashion-copycats-2017-06-09; David Yi, *How Social Media Shaming Controls Fashion Copycats*, MASHABLE (Mar. 15, 2016), https://mashable.com/2016/03/15/fashion-copying-social-media/#qSOCdr9byGqr. *See generally* DIET PRADA, https://www.dietprada.com (last visited Dec. 15, 2018) (illustrating copycat clothing designs).

36. *See Innovative Design Protection and Piracy Prevention Act: Hearing on H.R. 2511 Before the H. Subcomm. on Intellectual Prop., Competition, & the Internet*, 112th Cong. (2011) (statement of Lazaro Hernandez, Designer and Cofounder, Proenza Schouler).

37. 15 U.S.C. § 1127 (2018).

38. One of the main functions of a trademark is to distinguish a product or service from other products or services by identifying the origin or source of that product, so that consumers know which producer or manufacturer they are buying goods from. The goal is to prevent consumers from confusing said sources and ensure that they know exactly which goods or services they are purchasing. *See* 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 1.03 (1987); *see also* LOIS F. HERZECA & HOWARD S. HOGAN, FASHION LAW AND BUSINESS: BRANDS & RETAILERS 66 (2013) (providing guidance on the range of legal and business issues in the fashion industry to participants).

39. *See* Nat'l Color Labs., Inc. v. Philip's Foto Co., 273 F. Supp. 1002, 1004 (S.D.N.Y. 1967) (noting that trademark actions involve the interplay of "the public's interest in protection against deceit as to the sources of its purchases, the businessman's right to enjoy business earned through investment in the good will and reputation attached to a trade name, and the interest of others in not being restrained from free use of trade names because of mere token use on the part of one").

40. *See* Allison Gifford & Kathleen Johnson, *Fashion Design IP Protection Is Now Très Chic*, LAW360 (July 11, 2008, 12:00 AM), https://www.law360.com/articles/62053.

of a design, such as logos, brand names, and signature items.[41] For example, Chanel's interlocking C's[42] and Louis Vuitton's entwined "LV"[43] are famous marks that cannot be used without licensing them first. For this reason, it is helpful to distinguish between knockoffs and counterfeited goods, since only the latter are strictly prohibited under trademark law.[44] As long as a "design pirate" does not mark its goods as coming from the original designer by, for example, including the original designer's brand or logo, using a confusingly similar identifier, or diluting the famous trademark, it will not be infringing on the designer's trademarks.[45] Consequentially, trademark protection is more useful for protecting fashion brands as a whole than for protecting a brand's individual designs against knockoffs.[46]

Section 43(a) of the Lanham Act affords protection to a product's "'trade dress'—the total image of a good as defined by its overall composition and design, including size, shape, color, texture, and graphics."[47] Trade dress protection "includes the design and appearance of the product as well as that of the container and all elements making up the total visual image by which the product is presented to customers."[48] Designers have used these trade dress provisions to protect the product configuration of their designs. For example, Hermès's Kelly and

41. *See* Kaitlyn N. Pytlak, *The Devil Wears Fraud-a: An Aristotelian-Randian Approach to Intellectual Property Law in the Fashion Industry*, 15 VA. SPORTS & ENT. L.J. 273, 282 (2016).

42. *See* CC, Registration No. 4,241,822; Chanel, Inc. v. French, No. 05-61838-CIV-COOKE/BROWN, 2006 U.S. Dist. LEXIS 93297, at *2 (S.D. Fla. Dec. 22, 2006).

43. *See* LV, Registration No. 1,794,905; LV, Registration No. 2,361,695; Louis Vuitton Malletier v. Dooney & Bourke, Inc., 454 F.3d 108, 115 (2d Cir. 2006).

44. *See* Sara R. Ellis, Note, *Copyrighting Couture: An Examination of Fashion Design Protection and Why the DPPA and IDPPA Are a Step Towards the Solution to Counterfeit Chic*, 78 TENN. L. REV. 163, 166–68 (2010); Ferrill & Tanhehco, *supra* note 27, at 254–57 (providing a detailed explanation of this distinction).

45. *See* Leslie J. Hagin, Note, *A Comparative Analysis of Copyright Laws Applied to Fashion Works: Renewing the Proposal for Folding Fashion Works into the United States Copyright Regime*, 26 TEX. INT'L L.J. 341, 356–57 (1991).

46. Raustiala & Sprigman, *supra* note 23, at 1701.

47. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 764 n.1 (1992); Coach Leatherware Co. v. AnnTaylor, Inc., 933 F.2d 162, 168 (2d Cir. 1991).

48. Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 58 F.3d 27, 31 (2d Cir. 1995).

Birkin bags,[49] Céline's luggage, and Bottega Veneta's woven pattern are all protected trade dress,[50] as well as Louis Vuitton's Toile pattern, Crocs's shape, and Adidas's three-stripe pattern.

This legal tool is not, however, particularly well-suited to protect fashion designs. Like copyright protection,[51] trade dress is limited to the protection of "non-functional design elements,"[52] that is, design elements which are not essential to the use or purpose of the article.[53] Courts have reasoned that conferring a monopoly to the designer of an ordinary product would be granting him a monopoly on the product itself,[54] and have tried to strike a balance between protecting innovative design and encouraging competition. Functionality can be examined from a utilitarian[55] or an aesthetic perspective.[56] Under the latter approach, when aesthetic features of a product are important in a consumer's decision-making process, the feature may be considered functional if it "substantially contributes" to the appeal of the product, meaning the feature provides a "significant benefit" for the designer, which cannot

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49. *See* Hermes Int'l v. Lederer de Paris Fifth Ave., Inc., 219 F.3d 104, 108 (2d Cir. 2000).

50. Tyler McCall, *Copyright, Trademark, Patent: Your Go-To Primer for Fashion Intellectual Property Law*, FASHIONISTA (Dec. 16, 2016), https://fashionista.com/2016/12/fashion-law-patent-copyright-trademark.

51. *See infra* Section I.B.1.

52. Raustiala & Sprigman, *supra* note 23, at 1703; *see* Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 164 (1995) ("The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.").

53. Inwood Labs. v. Ives Labs., 456 U.S. 844, 850 n.10 (1982).

54. *See, e.g.*, Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 380 (2d Cir. 1997).

55. *See* TrafFix Devices v. Mktg. Displays, 532 U.S. 23, 33 (2001) ("[A] feature is . . . functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device." (citations omitted)); Le Sportsac, Inc. v. K mart, Corp., 754 F.2d 71, 76 (2d Cir. 1985) (holding the following: (1) a feature is essential "if [it] is dictated by the functions to be performed" by the article; and (2) that a feature affects the cost or quality of the article where it "permits the article to be manufactured at a lower cost" or "constitutes an improvement in the operations of goods" (quoting Warner Bros, Inc. v. Gay Toys, Inc., 724 F.2d 327, 331 (2d Cir. 1982)).

56. *See* Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., 696 F.3d 206, 219–20 (2d Cir. 2012) ("[W]hen the aesthetic design of a product is *itself* the mark for which protection is sought, we may also deem the mark functional if giving the markholder the right to use it exclusively 'would put competitors at a significant non-reputation-related disadvantage.'" (quoting *Qualitex Co.*, 514 U.S. at 165)).

be duplicated by using a different, alternative design.[57] Therefore, if the purpose of a feature is to enhance a product's appearance as opposed to identifying its source, the feature is functional and cannot be protected.[58]

The doctrine of aesthetic functionality is counterintuitive[59] and renders trade dress protection unsuitable for protecting fashion designs generally. Trade dress application in the fashion industry is therefore limited to protecting "features such as size, shape, color or color combinations, textures, graphics, or even particular sales techniques."[60] This doctrine, as applied to the fashion industry, cannot be reconciled with the fact that individuals generally choose their articles of clothing not based on their functional features, such as providing warmth and protection, but on their own aesthetic preferences, which can be dictated by personal inclinations or the desire to follow a particular trend.[61]

The Supreme Court has further restricted the application of trade dress protection to the fashion industry by requiring that the seller show the design has acquired a "secondary meaning" under trademark law.[62] To do so, a designer must show 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,"[63] meaning that a fashion design must be capable of working as a unique source identifier. This is a very difficult thing to do, especially considering the short

57. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, cmt. c (AM. LAW INST. 1995).

58. The best example of what constitutes an aesthetically functional design element is given in the Restatement. Because the shape of a box is an important factor in consumers' minds, the first manufacturer to sell Valentine's heart-shaped chocolate boxes could not have been given a monopoly on the use of such a shape, because there is no other alternative that could satisfy the desires of Valentine's chocolate box purchasers. *Id.* at § 17, cmt. c, illus. 8.

59. *See Christian Louboutin S.A.*, 696 F.3d at 220 (recognizing that the doctrine of aesthetic functionality seems counterintuitive).

60. John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983).

61. *See* Hemphill & Suk, *supra* note 7, at 1155–59 (discussing different theories that explain what fashion is).

62. Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 216 (2000) ("[I]n an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning.").

63. Inwood Labs. v. Ives Labs., 456 U.S. 844, 855 n.11 (1982).

lifespan of clothes' marketability,[64] and it is almost impossible for designers new to the marketplace to develop distinctiveness and "recognition among consumers as being associated with a particular brand."[65] Further, the "secondary meaning" doctrine naturally creates a time span in which it is perfectly fine to copy a design: the time between when an item starts being retailed and whatever amount of time it might take for it to develop a secondary meaning.[66] Moreover, features in a fashion design are usually intended to make articles of clothing more appealing, and a product's label or packaging is what serves as a source identifier, so it does not make sense to require an item of clothing, per se, to serve that function. This does not negate the fact that some items are so iconic, or so unique to a particular brand, that some people can see a person walking down the street and immediately know what brand that person is wearing. For these staple items, it seems unfair to burden designers with the expense of a trial, which will require them to pay for expensive expert witnesses and consumer surveys in the hope of convincing fashion-illiterate judges that such items have acquired secondary meaning in the minds of fashionistas.

Accordingly, trademark and trade dress law are only appropriate to protect certain aspects of a fashion design, but are overall an ineffective way to protect a fashion designer's creations.

64. There are some exceptions, however, and brands that have been in the market long enough (and which have the means to afford going to court over this issue) are able to show that some of their items have acquired secondary meaning. *See, e.g.*, Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 618 (2d Cir. 2008); Coach, Inc. v. We Care Trading Co., 67 F. App'x 626, 629 (2d Cir. 2002).

65. Ferrill & Tanhehco, *supra* note 27, at 277. *See generally* Christina Binkley, *The Problem with Being a Trendsetter*, WALL ST. J. (Apr. 29, 2010, 12:01 AM), https://www.wsj.com/articles/SB10001424052748704423504575212201552288996 (arguing that copycat fashion designers move quickly and force smaller designers to bear the brunt of the potential consequences).

66. *See* Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 163 (1995).

B. *Copyright*

Copyright protects "original works of authorship fixed in any tangible medium of expression."[67] This protection gives copyright owners exclusive rights in their work for as long as they live, plus seventy years.[68] The Copyright Act lists eight categories of work of authorship which are afforded copyright protection, but it does not include fashion designs.[69] This means that fashion designs cannot be protected under the current copyright law regime. Although efforts have been made to extend the Copyright Act's scope to include fashion designs, other doctrinal inadequacies, as set forth below, would prevent the successful application of the current regime to the protection of fashion designs.

1. *Fashion designs are useful articles*

In addition to expressly failing to include fashion designs in its subject matter, the Copyright Act does not afford protection to "useful articles," that is, "article[s] having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."[70] In other words, copyright law will protect original works of art as to their form, but not their utilitarian aspects. The cut and shape of articles of clothing are usually considered to serve utilitarian functions such as protecting from weather, "ensuring modesty, or symbolizing occupation, rank or status,"[71] which is why copyright protection is very difficult to obtain for fashion designs,[72] and why unless someone designs "shirts with three

67. 17 U.S.C. § 102(a) (2018).

68. *Id.* §§ 106, 302(a).

69. *Id.* § 102(a); 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.03 (Matthew Bender, rev. ed.).

70. 17 U.S.C. § 101(3).

71. Anne Theodore Briggs, *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, 24 HASTINGS COMM. & ENT. L.J. 169, 183 (2002).

72. *See* URSULA FURI-PERRY, THE LITTLE BOOK OF FASHION LAW 16 (2013). *Compare* Fashion Originators Guild v. FTC, 114 F.2d 80, 84 (2d Cir. 1940) (holding that "ladies' dresses" are useful articles not covered by the Copyright Act), *with* Poe v. Missing Persons, 745 F.2d 1238, 1242 (9th Cir. 1984) (reversing the district court's grant of summary judgment because there was a

sleeves or two neck holes, the aesthetic appeal of a silhouette is not copyrightable."[73] The "useful articles doctrine" has been said to limit manufacturers' ability to monopolize designs solely dictated by their function, so that the first person to make the design cannot exclude everyone else from producing that kind of product.[74] In other words, "it would have been unfair to give Levi Strauss a copyright on denim"[75] or to allow the monopolization of the shape of shoes, considering that there are only so many ways and shapes by which the human body can be covered.

The only exceptions to the "useful article doctrine" are design patterns (prints or textile patterns), which can be protected as a "pictorial, graphic, and sculptural work,"[76] much like an illustration,[77] "to the extent that [] such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."[78] In the last few years, designers have increasingly resorted to this exception in order to protect the print design of their garments:[79] fabric prints, jacquard weave, or lace patterns can be copyrightable. Nevertheless, the "useful article doctrine" is still one of the

disputed issue of material fact as to whether the swimsuit at issue was an article of clothing or a work of art, and stating that "[n]othing in our legal training qualifies us to determine as a matter of law whether Aquatint No. 5 can be worn as an article of clothing for swimming or any other utilitarian purpose. We are also unable to determine merely by looking at Poe's creation whether a person wearing this object can move, walk, swim, sit, stand, or lie down without unwelcome or unintended exposure.").

73. DAVID H. FAUX, THE AMERICAN BAR ASSOCIATION'S LEGAL GUIDE TO FASHION DESIGN 24 (2013). Examples of shapes not dictated solely by form include Zac Posen's umbrella-sleeve blouse, Diane von Furstenberg's wrap dress, Hussein Chalayan's bubble dress, Franc Fernandez's meat dress, and Azzedine Alaïa's bandage dress.

74. Briggs, *supra* note 71, at 181–82.

75. Wander, *supra* note 15, at 253.

76. 17 U.S.C. § 102(a)(5) (2018).

77. FAUX, *supra* note 73, at 25.

78. 17 U.S.C. § 101.

79. *See* Victoria Elman, *From the Runway to the Courtroom: How Substantial Similarity is Unfit for Fashion*, 30 CARDOZO L. REV. 683, 695 (2008).

biggest obstacles for fashion designers attempting to obtain protection for their creations.[80]

According to the House Report of the Copyright Act, the question of whether an article can be separated from its utilitarian function could be determined on either a physical or a conceptual basis, and the circuits split over this issue for many years.[81] The Supreme Court, however, recently abolished this distinction by holding that:

> an artistic feature of the design of a useful article is eligible for copyright protection if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article.[82]

In general, basic elements of apparel such as neckline, sleeve style, skirt shape, hemline, or pocket style are considered inseparable from the utilitarian aspects of clothing and will be uncopyrightable no matter how original or aesthetically attractive. On the other hand, certain features such as belt buckles,[83] lace accenting,[84] embroidery, and artwork[85] have been

80. *See, e.g.*, Galiano v. Harrah's Operating Co., 416 F.3d 411, 422 (5th Cir. 2005) (affirming the lower court's grant of summary judgment because plaintiff made "no showing that its designs are marketable independently of their utilitarian function as casino uniforms").

81. *See* NIMMER & NIMMER, *supra* note 69, § 2A.08.

82. Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1016 (2017).

83. Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) ("We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist.").

84. Express, LLC v. Fetish Grp., Inc., 424 F. Supp. 2d 1211, 1225 (C.D. Cal. 2006) ("Thus, the placement, arrangement, and look of the lace trim on the GH268 Tunic are copyrightable.").

85. *See Star Athletica, L.L.C.*, 137 S. Ct. at 1012 ("The decorations are therefore separable from the uniforms and eligible for copyright protection."); Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1002 (2d Cir. 1995) ("[F]abric designs, such as the artwork on Knitwaves' sweaters, are considered 'writings' for purposes of copyright law and are accordingly protectible.").

deemed copyrightable, as well as accessories such as jewelry.[86] The reasoning is that these elements are merely decorative and do not serve any particular function other than making the item more aesthetically pleasing; they can be removed from the garment and be a piece of art by themselves, and therefore these elements deserve to be copyrightable.

The main issue with the utility doctrine as applied to fashion designs is that it misses the point of why people consume fashion in the first place. Designers produce creative works, as demonstrated by the "range of designs each season" and the fact that "[i]f fashion were driven by utility . . . people would simply wear clothes until they fell apart or no longer fit."[87] In addition, Congress has provided copyright or "copyright-like" protection for architecture, vessel hulls, and semiconductor chips despite the fact that all three are original designs which perform a utilitarian function, which means that the doctrine has some flexibility and could allow for protection of fashion designs through carefully drafted legislation.[88]

2. *Substantial similarity as applied to fashion designs*

Designers who successfully obtain copyright protection for a design will face another hurdle when trying to uphold their rights in court: the substantial similarity test. In order to bring a copyright infringement action, a plaintiff must demonstrate that he is the owner of a copyright and that a defendant copied it.[89] The second element requires a plaintiff to show that the defendant actually copied the original work of art, and that the copying amounted to an "improper appropriation."[90] This means that even after copying has been established or conceded, a defendant will not be liable unless his copy is

86. *See, e.g.*, Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 109 (2d Cir. 2001); R.F.M.A.S., Inc. v. So, 619 F. Supp. 2d 39, 59 (S.D.N.Y. 2009); Trifari, Krussman & Fishel, Inc. v. Charel Co., 134 F. Supp. 551, 552 (S.D.N.Y. 1955).

87. Elman, *supra* note 79, at 690 (citations omitted).

88. *Id.* at 691.

89. NIMMER & NIMMER, *supra* note 69, § 13.01.

90. *Id.* (citing Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991)).

"substantially similar" to the plaintiff's original work.[91] There is no bright-line test to define what "substantial similarity" means,[92] but legal scholars believe that "[s]omewhere between the one extreme of no similarity and the other of complete and literal similarity lies the line marking off the boundaries of 'substantial similarity.'"[93] Therefore, determining whether a particular copy is "substantially similar" to an original work of art will be an ad hoc, fact-dependent decision, requiring a court to determine "whether [the] average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work."[94] Although the formulation for this test is very arbitrary, "a narrower standard would allow a copyist to escape liability by 'immaterial variations,'"[95] because after changing small parts of any creation, a copy would not be "substantially similar" to the original anymore.

The very purpose of the test makes it unsuitable for the fashion industry, where "minor variations" are not only acceptable, but also beneficial to the design community.[96] Fashion designers rarely create a unique piece of clothing from scratch; rather, they look for inspiration in previous trends, celebrities, fashion icons, "street looks," music, art, and even nature.[97] The substantial similarity test, which might be suitable to determine copyright infringement in different areas of expression, is not fit for fashion designs because it does not allow for the natural creative process that is unique to the industry: fashion designers take, appropriate, modify, adapt,

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91. *Id.* § 13.03.

92. *See, e.g.*, Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960); Sid & Marty Krofft TV Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1164–65 (9th Cir. 1977).

93. NIMMER & NIMMER, *supra* note 69, § 13.03.

94. Elman, *supra* note 79, at 706.

95. *Id.* at 707.

96. *Id.*

97. *See* Amy Kover, *That Looks Familiar. Didn't I Design It?*, N.Y. TIMES (June 19, 2005), https://www.nytimes.com/2005/06/19/business/yourmoney/that-looks-familiar-didnt-i-design-it.html (quoting a fashion executive saying that there is no originality in fashion); *see also* Kurt Andersen, *You Say You Want a Devolution?*, VANITY FAIR (Jan. 2012), https://www.vanityfair.com/style/2012/01/prisoners-of-style-201201 (alleging that society has been in a "stylistic freeze" for at least twenty years).

and reinterpret what others before them have created. Therefore, designers do not need the law to prohibit others from being inspired by their designs; they need it only to stop those who want to replicate an entire design without giving them proper credit.[98]

3. *Other considerations*

In addition to the "useful articles" doctrine and the substantial similarity test, there are two more hurdles preventing fashion designs from obtaining copyright protection. The first hurdle is that as early as 1880, the Supreme Court recognized that ideas and knowledge cannot be subject to copyright protection because they belong to humanity and must be communicated and applied, whereas the expression of those ideas or knowledge is the author's original creation and therefore belongs to him.[99] Established in Section 102(b) of the Copyright Act,[100] the "idea-expression dichotomy" provides that copyright protection extends to the expression of an idea, but not to the idea itself. This means that if a designer creates a unique piece of clothing, he cannot protect the overall concept against infringement, only the particular embodiment.

The second hurdle is the requirement of "originality."[101] Although the Act does not provide a definition, it has been generally understood that a work of art is "original" if its author created it independently, rather than copying it from a previous work of art.[102] This concept becomes problematic[103] when

98. Elman, *supra* note 79, at 707–08.

99. Baker v. Selden, 101 U.S. 99, 107 (1880) (holding that "blank account books are not the subject of copyright"); *see also* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 348–51 (1991) ("A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.").

100. 17 U.S.C. § 102(b) (2018).

101. *See* NIMMER & NIMMER, *supra* note 69, § 2.01.

102. *Id.*

103. *See generally* Charles E. Coleman, *The History and Principles of American Copyright Protection for Fashion Design: On "Originality"*, 6 HARV. J. SPORTS & ENT. L. 299, 317–34 (2015) (discussing how courts have applied the "originality" doctrine inconsistently to fashion designs).

applied to fashion designs because, as discussed above, designers often find inspiration in existing articles of clothing, making it almost impossible to determine whether an item should be afforded protection or whether it has infringed on someone else's design, as no article of clothing originates entirely in a designer's mind.[104] To solve this issue, a new and particular test of originality should be created with the peculiarities of fashion design and the industry's cycles in mind. In this way, "stitch-by-stitch" copies that do not include anything original are prohibited, but looking at another designer's creations for inspiration is not.

Since 2006, the Council of Fashion Designers of America (CFDA) has fought for legislation that provides copyright protection for fashion designs.[105] In 2006, the Design Piracy Prohibition Act was introduced to amend Title 17 of the U.S. Code to include fashion designs as copyrightable subject matter.[106] The CFDA supported this initiative because it believed that the legislation would afford emerging designers the protection they required; however, the legislation lacked support from the American Apparel and Footwear Association (AAFA), which claimed that the bill would hamper creativity and increase frivolous lawsuits.[107]

On the other side of the spectrum, some argue that the policy concerns which justify the protection of copyright rights seem to contradict the idea of warranting protection to fashion designs, and thus copyright law would not be the appropriate tool to protect them.[108] The reasoning behind this argument is

104. Elman, *supra* note 79, at 692–93; *see also A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Prop. of the H. Comm. on the Judiciary*, 109th Cong. (2006) (statement of David Wolfe, Creative Director, Doneger Group); *Authenticity—Not Originality—the Metric of Choice for Valuing Fashion?*, FASHION L. (Jan. 23, 2018), http://www.thefashionlaw.com/home/authenticity-not-originality-the-metric-for-valuing-fashion. *See generally* Amy L. Landers, *The Anti-Economy of Fashion: An Openwork Approach to Intellectual Property Protection*, 24 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 427, 507 (2014).

105. *About CFDA*, CFDA, https://cfda.com/about-cfda (last visited Dec. 15, 2018).

106. Ferrill & Tanhehco, *supra* note 27, at 273–74.

107. *Id.* at 273.

108. Wander, *supra* note 15, at 280.

that copyright was included in the Constitution with the goal of fostering innovation. Fashion designers, however, need to be protected against copiers, and if copyright protection was extended to fashion designs, then it would have the effect of deterring innovation in that field by the copiers, thus creating the opposite effect of what the Constitution intended.[109]

C. *Design Patents*

The U.S. patent system encompasses three different types of patents: utility, design, and plants patents. While utility patents are the most common form of patent protection sought by inventors, the issuance of design patents has increased considerably since the 1960s. For fashion designers, design patents are the only IP protection afforded to the aesthetics of the design. As opposed to utility patents, which protect the function of a product and how it works, design patents protect "how apparel looks—how a dress is cut, how the pleats are arranged, how the waistbands overlap, or how the feathers are placed on a hat."[110] Thus, "[i]f you have a shoe that has an interesting molded or sculptural heel that doesn't have any particular special function, but is part of this otherwise functional item, the shoe might have design patent possibility."[111] But both the cost of obtaining a patent and the long time they take to issue make them unsuitable mechanisms for protecting fashion designs, especially for emerging fashion designers who do not have the economic means to afford fees.

1. *Definition of design*

Title 35 of the U.S. Code extends patent protection to any "new, original and ornamental design for an article of manufacture" for a term of "fifteen years from the date of grant."[112] The statute does not, however, define the term

109. *Id.*
110. FAUX, *supra* note 73, at 32.
111. McCall, *supra* note 50.
112. 35 U.S.C. §§ 171, 173 (2018).

"design." According to the U.S. Patent and Trademark Office (USPTO), "[a] design consists of the visual ornamental characteristics embodied in, or applied to, an article of manufacture."[113] Courts have usually defined the term "article of manufacture" according to its dictionary definition, that is, anything made from raw materials, whether by hand, by machinery, or by art.[114] The USPTO identifies at least three types of designs that can be protected: "the configuration or shape of an article . . ., the surface ornamentation applied to an article, or . . . the combination of configuration and surface ornamentation."[115]

2. *Patentability requirements*

In order to obtain a design patent, a design has to be *novel*, *original*, and *non-obvious.* The novelty requirement of patentability requires that the average observer is able to look at the design and take it for a different design than the one already existing in the prior art.[116] The Federal Circuit has recently changed the test for infringement to an "ordinary observer test," i.e., "whether the ordinary observer would consider the two designs to be substantially the same."[117]

The second requirement is originality. A design will be deemed original if the patentable ornamental features originated with the design patent applicant and were not copied from others.[118] The last requirement, obviousness, has to be analyzed with reference to "the scope and content of the prior art [] to be determined[,] differences between the prior art and the claims at issue . . . [,] and the level of ordinary skill in

113. *Design Patent Application Guide*, U.S. PAT. & TRADEMARK OFF., https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide#def (last visited Dec. 15, 2018).

114. *See In re* Hruby, 373 F.2d 997, 1000 (C.C.P.A. 1967).

115. *Design Patent Application Guide*, *supra* note 113.

116. *See In re* Bartlett, 300 F.2d 942, 943 (C.C.P.A. 1962); *see also* 8 DONALD S. CHISUM, CHISUM ON PATENTS § 23.03 [5][a] (2014).

117. Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008).

118. Hoop v. Hoop, 279 F.3d 1004, 1007 (Fed. Cir. 2002).

the pertinent art resolved."[119] Therefore, a design cannot be protected if it would have been obvious to a designer of ordinary skill in the art at the time of the invention, and in light of the teachings of the prior art.[120]

In addition to the requirements set forth above, a design patent protects the ornamental, or aesthetically pleasing,[121] as opposed to the protection of functionality granted by utility patents. "It is well settled that non-functionality is an element of design patentability,"[122] even though it is not expressly stated in the U.S. Code. Therefore, "if the design claimed in a design patent is dictated solely by the function of the article," because there are no alternative designs available, "the patent is invalid because the design is not ornamental."[123]

A single invention might be protected by both a utility and a design patent. When the invention has both an original function and an original design, it is appropriate to seek both forms of patent protection to safeguard the article's functional aspect in conjunction with its appearance.[124]

3. *Design patents in the fashion industry*

Even though design patents are more common in the fashion industry, utility patents are still relevant when a designer seeks to protect the functional aspects of clothing, shoes, and eyewear. Clasps, zippers, and Velcro, for example, are all patented items used in the fashion industry. Utility patents are often sought in the arena of maternity garments and bras, but even more so in the sports and athletic wear market, in which

119. Graham v. John Deere Co., 383 U.S. 1, 17 (1966); *see also* 35 U.S.C. § 103 (2018) (stating that a patent cannot be obtained "if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains").

120. *See* KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 405 (2007) ("A court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions."); *see also* FAUX, *supra* note 73, at 33.

121. FAUX, *supra* note 73, at 34.

122. GRAEME B. DINWOODIE & MARK D. JANIS, TRADE DRESS AND DESIGN LAW 319–20 (2010).

123. Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563, 1566 (Fed. Cir. 1996).

124. HERZECA & HOGAN, *supra* note 38, at 174–75.

manufacturers often obtain patents for their high-performance, insulating fabrics, athletic attires, and athletic shoes.[125] In addition to other kinds of "functional fashion," such as hazmat suits or astronaut and space suits, the recent fashion industry trends of combining technology with apparel and footwear with accessories have also increased the number of utility patents sought by companies such as Nike, Inc.[126]

As with trademark and copyright protection, there are some problems with seeking design patent protection for fashion designs. First, the ornamentality requirement usually creates a burden for fashion designers similar to the one created by copyright law, for at least two reasons.[127] On the one hand, function-based designs are difficult to protect because designs serve no utility for the article of clothing and therefore cannot be patented.[128] As a consequence, design patents are usually only available to protect the shape or surface ornamentation of an article, or both. On the other hand, the protectible subject matter of design patents is limited to an article's aesthetic features, which means the value it might have for a fashion designer "depends upon the consistency of visual design elements over time."[129] This can be problematic when we consider that the fashion industry's model basically depends on constant change and visual stimulation.[130] Second, the biggest hurdle when seeking design patent protection for a fashion design is the non-obviousness requirement.[131] Because most fashion designs are only slightly different than those that came before, it is impossible to demonstrate the design was not readily apparent to fellow designers.[132]

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125. *Id.* at 189; McCall, *supra* note 50.

126. McCall, *supra* note 50.

127. *See supra* Section I.C.2.

128. *See, e.g.*, Chosum Int'l, Inc. v. Chrisha Creations, Ltd., 413 F.3d 324, 329–30 (2d Cir. 2005).

129. *Id.*

130. HERZECA & HOGAN, *supra* note 38, at 184.

131. 35 U.S.C. §§ 102–103 (2018).

132. Christina Phillips, Note, *The Real Cinderella Story: Protecting the Inherent Artistry of the Glass Slipper Using Industrial Design*, 48 VAL. U. L. REV. 1177, 1217 (2014); *see also* Vanity Fair Mills, Inc. v. Olga Co., 510 F.2d 336, 339–40 (2d Cir. 1975).

In addition, because pendency in the issuance of design patents is around thirteen months, and trends in the fashion industry often change quickly, design patents have been typically sought to protect only enduring or "signature" aesthetic features with demonstrated longevity, such as "handbags, footwear, timepieces, eyewear, and other accessories, as well as designs for cosmetics and fragrance packaging."[133] Examples include Christian Dior, Louis Vuitton, Bulgari, Jimmy Choo, Nike, Levi Strauss & Co., Guess, and Alexander Wang.[134] Nike, for example, is ranked third among all organizations granted design patents in the United States for *all* industries, and usually relies on its design patent portfolio over its "copyright and trademark heft."[135]

As mentioned, the use of design patents by major clothing manufacturers is on the rise, especially in the areas of shapewear, sports, and active apparel. Examples include Lululemon, Columbia, Nike, Christian Dior, Under Armour, and Times Three Clothier, LLC.[136] One of the reasons for this trend is the Federal Circuit's recent decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*, which made it easier to show infringement and abolished the point of novelty test.[137] Traditionally, proving patent infringement required the patentee to satisfy the point of novelty test, that is, that the accused design copied the novel aspects of a design which helped distinguish it from existing ones.[138] Now, however, the designer only needs to show that any ordinary observer can be deceived by the infringing product, when giving the product "normal attention under the circumstances" and in light of pre-existing designs.[139] It has been said that the removal of the point of novelty test will make

133. Phillips, *supra* note 132, at 1217.

134. *Id.*

135. FAUX, *supra* note 73, at 31–32.

136. HERZECA & HOGAN, *supra* note 38, at 184–86.

137. *See* 543 F.3d 665, 677–79 (Fed. Cir. 2008) (testing the point of novelty by showing whether the accused design copied a novel aspect of a design, which helped distinguish it from an existing one).

138. *See* Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984).

139. *Egyptian Goddess, Inc.*, 543 F.3d at 670–79; *see also* FAUX, *supra* note 73, at 41–42.

inventors less likely to design close copies, because the new test makes it difficult to determine beforehand whether a design will infringe upon a patented design, giving designers a "*de facto* increase in scope of protection."[140]

The growth in design patent applications and issuances has been accompanied by a growth in the effort put forth by patent owners to enforce their design patent portfolio.[141] For example, Lululemon sued Calvin Klein for patent infringement in 2012, claiming that the waistband in Calvin Klein's tights infringed its patents, which drew attention because of Lululemon's strategy of enforcing its patents rather than its trademarks.[142] The footwear industry (e.g., Crocs, Skechers, Nike/Converse) has also vigorously enforced its design patents.[143] Compared with the other forms of IP protection available, design patents are usually

> the weapon of choice because it is usually easier to get an injunction quickly to shut down the infringer's business, stopping their revenue stream from the design in question and making it difficult for the infringer to pay [its] lawyer to continue defending the lawsuit. Judges can decide quite easily whether an ordinary observer can be deceived, and if so, overwhelmingly, judges will issue a temporary injunction to shut down the infringer's business. Trademark infringement cases could involve costly surveys of the public, expert testimony, and lengthy discovery.[144]

However, for a designer who has just established his business, or who is seeking to enter the fashion market, patents do not provide a feasible solution. Not only does obtaining a

140. HERZECA & HOGAN, *supra* note 38, at 180.

141. *Id.* at 187.

142. *Id.*

143. *Id.*

144. FAUX, *supra* note 73, at 42.

patent cost up to $10,000, but it can also take up to eighteen months for a patent to issue.[145] The costs and waiting periods associated with obtaining design patents, in addition to the doctrinal hurdles that a fashion design needs to overcome before obtaining protection, limit the use of this tool to a select few companies that have the economic means to obtain protection for a limited number of items. However, for independent designers who need to obtain immediate protection for their designs before they can enter the market to ensure they will not be copied, design patents are generally not a viable solution.

II. ALTERNATIVE MEANS TO PROTECT SMALL DESIGNERS

The current "low-IP equilibrium" that the fashion industry operates within has permitted fast-fashion retailers to perpetuate their abusive practices almost without consequence, but the internet era demands new solutions.[146] Technology has proven to be a double-edged sword for the fashion industry.[147] On the one hand, it allows designers to showcase their creations at almost no cost and commercialize their products to broader audiences than old school brick and mortar stores. On the other hand, it allows imitators to operate from behind the anonymity of the internet and in a fraction of the time, even before the original design hits the stores, the designer makes his first sale, or a model walks out on a catwalk.[148] If desperate times call for desperate measures, then it is about time Congress designs a solution which allows emerging fashion designers, or those

145. *Currently Trending in Fashion: Design Patents*, *supra* note 25. Note, however, that only $830 of that total amounts to USPTO's fees. *See* Vic Lin, *How Much Does a US Design Patent Application Cost in 2018?*, PAT. TRADEMARK BLOG, http://www.patenttrademarkblog.com/design-patent-application-cost/ (last visited Dec. 15, 2018).

146. *See* Ferrill & Tanhehco, *supra* note 27, at 264–68.

147. *See* Casey E. Callahan, *Fashion Frustrated: Why the Innovative Design Protection Act Is a Necessary Step in the Right Direction, but Not Quite Enough*, 7 BROOK. J. CORP. FIN. & COM. L. 195, 208–10 (2012).

148. *See A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the H. Comm. on the Judiciary*, 109th Cong. 8–10 (2006) (statement of Jeffrey Banks, Fashion Designer, CFDA); Ferrill & Tanhehco, *supra* note 27, at 264–67.

with limited economic means, to be able to protect the creations they worked so hard on, instead of allowing fast-fashion retailers to destroy smaller designers by shamelessly copying their work.

A. *Proposed Amendments to the Copyright Act*

Attempts to obtain legislative protection for fashion designs began as early as 1914, but none ever materialized into law.[149] Since 2006, the CFDA, led by Diane von Furstenberg, has fought for legislation that would extend copyright protection to fashion designs.[150] Other designers and scholars, including Susan Scafidi, founder of the Fashion Law Institute at Fordham Law School,[151] have joined efforts in pushing Congress to pass a bill that would extend copyright protection to fashion designs.[152]

In 2006, Representative Robert Goodlatte introduced a bill to include fashion designs as a protected category under the Vessel Hull Design Protection Act of the Digital Millennium Copyright Act.[153] The bill defined a "fashion design" as "the appearance as a whole of an article of apparel, including its ornamentation," which would be protected for a period of three years.[154] Unfortunately, the bill was not enacted, and was cleared from the books for the 2007 session.[155] The bill was re-

149. *See* Ellis, *supra* note 44, at 179–81 (discussing efforts made in 1914 and 1932 "to obtain legislative protection for fashion designs"); Susan Scafidi, *Intellectual Property and Fashion Design*, *in* 1 INTELL. PROP. & INFO. WEALTH 115, 118–21 (Peter K. Yu ed., 2006) (outlining past legal efforts to obtain copyright protection for fashion designs).

150. Elman, *supra* note 79, at 684–85, 695–96; Diane von Furstenberg, *Von Furstenberg: Fashion Deserves Copyright Protection*, L.A. TIMES (Aug. 24, 2007), http://www.latimes.com/opinion/la-oew-furstenberg24aug24-story.html.

151. *Susan Scafidi, Academic Director, Fashion Law Institute*, FORDHAM U., https://www.fordham.edu/info/23380/susan_scafidi (last visited Dec. 15, 2018).

152. *See A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the H. Comm. on the Judiciary*, 109th Cong. 77–78 (2006) (statement of Susan Scafidi, Visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University).

153. H.R. 5055, 109th Cong. (2006).

154. *Id.*

155. The last action taken on this bill was a hearing before the House Judiciary Subcommittee on Courts, the Internet, and Intellectual Property, held on July 27, 2006, in which it became clear that legal experts and representatives of the fashion industry were in

proposed in 2007 by Representative William Delahunt as the Design Piracy Prohibition Act.[156] This version was also referred to the Subcommittee on Courts, the Internet, and Intellectual Property, but was ultimately cleared from the books when Congress changed sessions.[157]

A third version of the bill was introduced by Representative Delahunt in 2009 (DPPA).[158] The bill was co-sponsored by twenty-three members of the House of Representatives, and supported by the CFDA.[159] It proposed the inclusion of "fashion design[s]" as a protected category under the Copyright Act,[160] and "article[s] of apparel" under the definition of "useful article" in 17 U.S.C. § 1301.[161] Additionally, the bill established protection for a period of only three years,[162] which ensured protection against fast-copying while still allowing the fashion cycle to keep moving. Had the DPPA passed, it would likely not have been detrimental to designers to only be afforded protection for such a short period of time, because the first three years of a creation are normally the years in which they will make the most profit from it.[163]

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fundamental disagreement as to the need to extend copyright protection to fashion designs. *See H.R. 5055 (109th): To Amend Title 17, United States Code, to Provide Protection for Fashion Design*, GOVTRACK.US, https://www.govtrack.us/congress/bills/109/hr5055 (last visited Dec. 15, 2018).

156. Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007). The Senate bill was introduced by New York Senator Charles Schumer with some additional language under subsection (d). *See* Design Piracy Prohibition Act, S. 1957, 110th Cong. (2007).

157. *H.R. 2033 (110th): Design Piracy Prohibition Act*, GOVTRACK.US, http://www.govtrack.us/congress/bill.xpd?bill=h110-2033 (last visited Dec. 15, 2018). The Senate bill was referred to the Senate Committee on the Judiciary, but no actions were taken and hearings were not held. *S. 1957 (110th): Design Piracy Prohibition Act*, GOVTRACK.US, https://www.govtrack.us/congress/bills/110/s1957 (last visited Dec. 15, 2018).

158. Design Piracy Prohibition Act, H.R. 2196, 111th Cong. (2009).

159. *H.R. 2196 (111th): Design Piracy Prohibition Act*, GOVTRACK.US, https://www.govtrack.us/congress/bills/111/hr2196 (last visited Dec. 15, 2018).

160. H.R. 2196 § 2(a)(1).

161. *Id.* § 2(a)(2)(A).

162. *Id.* § 2(d).

163. *A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the H. Comm. on the Judiciary*, 109th Cong. 8 (2006) (statement of Jeffrey Banks, Fashion Designer, CFDA) ("Because of the unique seasonality of the fashion industry, this is enough time for the designer to recoup the work that went into designing and marketing his collection.").

The bill proposed that when assessing the originality of a fashion design, the garment should be considered as a whole,[164] and protection should be contingent upon registration of the design, which should occur within six months of its publication.[165] It also proposed a searchable, publically-available electronic database, in which "a substantially complete visual representation of all fashion designs" and the status of their registration could be easily consulted by designers.[166] This would allow designers to determine which designs were already in existence. Notably, the proposed standard of infringement was higher than before ("original and not closely and substantially similar in overall visual appearance") and excluded creations that merely reflected a "trend,"[167] which the bill defined as "a newly popular concept, idea, or principle expressed in, or as part of, a wide variety of designs of articles of apparel that create an immediate amplified demand for articles of apparel embodying that concept, idea, or principle."[168] Despite the CFDA's strong support, the DPPA was opposed by the AAFA[169] and the California Fashion Association,[170] and was ultimately rejected.[171]

After the DPPA failed in Congress, Senator Charles Schumer introduced the Innovative Design Protection and Piracy Prevention Act (IDPPA) in 2010.[172] Most of the language and provisions of the IDPPA were similar to those of the DPPA, but the new bill called for a higher standard of originality by requiring that a fashion design provide a "unique,

164. H.R. 2196, 111th Cong. § 2(a)(2) (2009).

165. *Id.* § 2(f)(1).

166. *Id.* § 2(j)(1).

167. *Id.* § 2(e)(2).

168. *Id.* § 2(a)(2)(B).

169. *See Who We Are*, AM. APPAREL & FOOTWEAR ASS'N, https://www.aafaglobal.org (follow "Who We Are" hyperlink under "About") (last visited Dec. 15, 2018).

170. *About Us*, CAL. FASHION ASS'N, http://calfashion.org/about-us/ (last visited Dec. 15, 2018).

171. The bill was referred to the House Committee on the Judiciary on the same day that it was introduced, but as with the previous attempts, it never made it out. *See H.R. 2196 (111th): Design Piracy Prohibition Act*, *supra* note 159.

172. Innovative Design Prevention and Piracy Prevention Act, S. 3728, 111th Cong. (2010).

distinguishable, non-trivial[,] and non-utilitarian variation over prior designs for similar types of articles," and be the "result of a designer's own creative endeavor."[173] Unlike the DPPA, the IDPPA did not have a registration requirement,[174] but included a section requiring that facts be pleaded with particularity in infringement actions,[175] as well as a "home sewing exception" to infringement.[176] Although the Senate Committee on the Judiciary voted for the bill to proceed to the full chamber and it was reported to the Senate, the bill was not voted on prior to the conclusion of the Congressional session,[177] despite enjoying the support of both the CFDA and AAFA.[178] The IDPPA was later re-introduced by Representative Goodlatte.[179] This time, the bill was referred to the Subcommittee on Intellectual Property, Competition and the Internet, but still was not enacted.[180]

In 2012, Senator Schumer introduced the Innovative Design Protection Act (IDPA).[181] Although most of its provisions were identical to those of its predecessors, the IDPA included a written notice provision which required the owner of a fashion design to put "any person [he] ha[d] reason to believe has violated or will violate" his rights on notice of its design protection before being allowed to commence an infringement

173. *Id.* § 2(a)(2)(B).

174. *Id.* § 2(f)(2).

175. *Id.* § 2(g)(2).

176. *Id.* § 2(e)(3).

177. *S. 3728 (111th): Innovative Design Protection and Piracy Prevention Act*, GOVTRACK.US, https://www.govtrack.us/congress/bills/111/s3728 (last visited Dec. 15, 2018).

178. *See* Cathy Horyn, *Schumer Bills Seeks to Protect Fashion Design*, N.Y. TIMES: ON THE RUNWAY (Aug. 5, 2010, 10:43 PM), http://runway.blogs.nytimes.com/2010/08/05/schumer-bill-seeks-to-protect-fashion-design/; Susan Scafidi, *IDPPPA: Introducing the Innovative Design Protection and Piracy Prevention Act, a.k.a. Fashion Copyright*, COUNTERFEIT CHIC (Aug. 6, 2010), http://counterfeitchic.com/2010/08/introducing-the-innovative-design-protection-and-piracy-prevention-act.html.

179. Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011).

180. *H.R. 2511 (112th): Innovative Design Protection and Piracy Prevention Act*, GOVTRACK.US, https://www.govtrack.us/congress/bills/112/hr2511 (last visited Dec. 15, 2018).

181. Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012).

action.[182] This bill also made its way to the Senate floor, where it died.[183]

The safeguards suggested by these bills are the closest the United States has come to adopting a *sui generis* protection for fashion designs as a variation of the traditional forms of IP protection available.[184] Although other measures can be taken to protect fashion designs, modifying the already existing copyright regime might be the easiest and quickest solution for the protection of fashion designs. Nevertheless, the different texts that have been considered in Congress fail to address some of the fundamental issues discussed above that make the extension of copyright protection to fashion designs conceptually impossible,[185] which might be one of the primary reasons, besides economic interests, why all attempts have failed.

Although fashion industry players, associations, scholars, and designers are split over the best approach for solving the fashion piracy issue,[186] these bills represent a much-needed first attempt to regulate the fashion industry's IP issues. Further, they provide an example of one of the many directions in which legislation could and should move in the near future to ensure that the fashion industry continues to be one of the most important segments of the worldwide economy, as well as one of the easiest and most accessible means for individuals to communicate and express themselves.

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182. *Id.* § 2(e).

183. *S. 3523 (112th): Innovative Design Protection Act of 2012*, GOVTRACK.US, https://www.govtrack.us/congress/bills/112/s3523 (last visited Dec. 15, 2018).

184. *See* Ferrill & Tanhecho, *supra* note 27, at 273.

185. See *supra* Section I.B for a discussion of different theories of copyright law that make copyright protection unfit to protect fashion designs. For example, the bills failed to address the useful article doctrine's bar to copyrighting fashion designs, as well as the requirement of originality for copyright protection.

186. *See* Silvia Beltrametti, *Evaluation of the Design Piracy Prohibition Act: Is the Cure Worse Than the Disease? An Analogy with Counterfeiting and a Comparison with the Protection Available in the European Community*, 8 NW. J. TECH. & INTELL. PROP. 147, 157 (2010) (outlining the diverging opinions on the DPPA).

B. Sui Generis *Design Protection in Europe*

Many countries outside the United States have enacted regimes aimed at protecting designs, as a substitute (or sometimes a supplement) for the traditional IP instruments of protection. For example, France is seen as having the strongest fashion design protection in the world, because it provides for protection under its copyright law, as well as under its industrial design law.[187] The only requirement for copyright protection is that works are "original expression[s]," and "articles of fashion" are explicitly listed as copyrightable subject matter.[188] Moreover, to receive protection under industrial design laws, a fashion design has to be "new" and "have an individual character."[189]

The European Union has adopted two instruments that establish a model for a broad design protection regime based on two parallel pieces of legislation: (1) a "Design Directive" harmonizing the *registered* design laws of the member states of the Union, and (2) a "Design Regulation" creating Union-wide design rights "consisting of a three-year *unregistered* design right that runs from the date on which a design is first made available to the public within the [European Union], and a *registered* right that could endure for twenty-five years."[190] The most important aspect of the definition of "design" for purposes of both instruments is that it does *not* include a reference to the aesthetic or functional nature of the design.[191] The threshold to protection is a two-step test that assesses "(1) whether the design is different from other designs, and (2) whether the development of the design beyond prior designs involves more than minimal creativity on the part of the designer."[192]

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187. DONJA DE RUITER, STYLE PIRACY, UNITED STATES LOW IP-EQUILIBRIUM FOR FASHION DESIGNS: SUCCESS OR THREAT? 29 (2011).

188. *Id.* at 29–30.

189. *Id.* at 31.

190. DINWOODIE & JANIS, *supra* note 122, at 527–28.

191. *Id.* at 530.

192. *Id.* at 531.

At an international level, the "Agreement on Trade-Related Aspects of Intellectual Property Rights" (TRIPS) of the World Trade Organization (WTO) establishes minimum standards of protection and enforcement that each WTO member must give to IP rights held by citizens of WTO member states.[193] It includes protection of industrial designs, that is, "the ornamental or aesthetic aspect of an article rather than its technical features," for at least ten years.[194] The agreements signed by WTO member states to obtain these protections include non-discrimination requirements such as the national treatment principle and the most-favored nation principle.[195] The former requires member states to provide the same treatment to foreign products, services, and goods as they do to domestic goods, and the latter dictates that member states will not discriminate among other trading partners.[196]

Efforts have been made to introduce a *sui generis* design legislation in the United States, but for a variety of reasons, no broad-based regime has been adopted.[197] The only *sui generis* regime under U.S. law is that instituted by the Vessel Hull Design Protection Act, which protects "an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public" but is limited to "[t]he design of a vessel hull, deck, or combination of a hull and deck"[198] and is therefore inapplicable to the protection of fashion designs. It is, however, proof that a similar solution could be devised to protect fashion designs.

193. *Intellectual Property: Protection and Enforcement*, WORLD TRADE ORG., https://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm7_e.htm (last visited Dec. 15, 2018).

194. *Id.*

195. *Principles of the Trading System*, WORLD TRADE ORG., https://www.wto.org/english/thewto_e/whatis_e/tif_e/fact2_e.htm (last visited Dec. 15, 2018).

196. *Id.*

197. UMA SUTHERSANEN, DESIGN LAW: EUROPEAN UNION AND UNITED STATES OF AMERICA 211 (2010).

198. 17 U.S.C. § 1301(a) (2018).

C. *A Unique Approach for Fashion Design Infringement*

Efforts to extend copyright protection to fashion designs have been met with strong opposition and have consistently failed to convince Congress. It therefore seems almost delusional to think that Congress would welcome attempts to adopt the European model in the United States without hesitation. One thing seems clear, however: fashion designs should be afforded some form of protection sufficient to allow emerging designers to enter the market and innovate without fear of seeing their designs plagiarized, but limited enough to allow others to be inspired by those unique creations that are so original that everyone wants to know where to buy them before they sell out. It seems like the best way to find a middle ground would be to devise a new and hybrid legal framework that allows for inspiration, does not curtail innovation, and provides a unique solution for the fashion industry's piracy problem.

In *Project Runway*, a reality television show in which contestants compete to design articles of clothing according to a particular theme, a panel composed of fashion designers and other actors of the fashion industry is in charge of judging the designs and deciding who will go home that week.[199] No one in his or her right mind would dare disagree with what famous fashion designers Michael Kors and Zac Posen say constitutes a good or a bad design, although no one is exactly sure what makes one design better than the next one, as much as no one is exactly sure how much inspiration a designer should be able to get from a colleague's piece without ripping him off. This struggle is basically what divided those who opposed the DPPA from those who wanted to see it become the law of the land. But what if we all agree that this is not an area in which bright-line rules can be established to distinguish what amounts to *too much* copying? Whether a design copies another work or is merely inspired by that work could be determined

199. *See Project Runway*, LIFETIME, https://www.mylifetime.com/shows/project-runway/about (last visited Dec. 15, 2018).

on a case-by-case basis by a panel of professionals with expertise in the fashion industry, just like in *Project Runway*.

Geographical, technological, political, social, and business-related changes and developments all impact how IP is created, exploited, and used.[200] Alternative Dispute Resolution (ADR) procedures offer flexible, non-confrontational processes and expert knowledge to resolve disputes, making them particularly appropriate for resolving IP issues.[201] ADR comprises many different mechanisms and practices to settle disputes between parties,[202] arbitration and mediation being only two of the possibilities. Arbitration is "a private mechanism for dispute resolution" which parties voluntarily agree to and which provides a final and binding award.[203] Mediation is a voluntary, confidential process, which although non-binding, assists the parties in reaching a mutually satisfactory settlement over a particular dispute through negotiations led by a neutral intermediary.[204] The main difference between arbitration and mediation is that in arbitration, there is an objective standard (the applicable law) determining the outcome of the negotiation, whereas the outcome of a mediation is entirely up to the parties. Resolving disputes through ADR has the potential to save designers not only money but also time, which is particularly important considering how fast trends change in the fashion industry when compared to how slow a judicial proceeding can be. In addition, traditional litigation usually erodes relations between

200. INT'L CHAMBER OF COMMERCE, THE ICC INTELLECTUAL PROPERTY ROADMAP 9–15 (2017), https://cdn.iccwbo.org/content/uploads/sites/3/2014/11/icc-IProadmap-intellectual-property-roadmap-current-emerging-issues-business-policymakers.pdf.

201. *Id.* at 64; Julia A. Martin, Note, *Arbitrating in the Alps Rather than Litigating in Los Angeles: The Advantages of International Intellectual Property-Specific Alternative Dispute Resolution*, 49 STAN. L. REV. 917, 921–36 (1997) (listing the advantages of solving IP disputes through ADR proceedings); *ADR Advantages*, WIPO, http://www.wipo.int/amc/en/center/advantages.html (last visited Dec. 15, 2018) (listing advantages of ADR proceedings).

202. Martin, *supra* note 201, at 919 ("Alternative dispute resolution describes a range of techniques used to resolve disputes outside of the courts.").

203. INT'L CHAMBER OF COMMERCE, *supra* note 200, at 65; *What is Arbitration?*, WIPO, http://www.wipo.int/amc/en/arbitration/what-is-arb.html (last visited Dec. 15, 2018).

204. INT'L CHAMBER OF COMMERCE, *supra* note 200, at 67; *What is Mediation?*, WIPO, http://www.wipo.int/amc/en/mediation/what-mediation.html (last visited Dec. 15, 2018).

designers or their brands, and in the case of IP disputes, has the potential of ending or limiting one's registered rights.[205] ADR mechanisms provide a wide array of benefits when compared to traditional litigation procedures, but what is particularly important in this context is that they allow the parties to choose judges with expert knowledge and certain backgrounds. If carefully chosen, these judges would be able to effectively assess which designs have been merely "inspired" by previous ones or are merely following a trend, and in which situations the designer has simply gone too far.

There is a global trend toward resolving IP disputes by ADR mechanisms,[206] and the fashion industry might be one of the areas that could benefit the most from these procedures. Although it is not possible to mandate disputes be resolved through ADR mechanisms unless both parties agree after a dispute arises or there is an agreement containing a clause in which both parties have agreed to resolve disputes through ADR, it could be possible to indirectly require it through the establishment of a self-regulatory organization and the issuance of industry best practices guidelines. For example, a new self-regulatory organization could be created,[207] the CFDA could strengthen and become such an organization, or the CFDA and

205. *See, e.g.*, Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., 696 F.3d 206, 228 (2d Cir. 2012) ("Because we conclude that the secondary meaning of the mark held by Louboutin extends only to the use of a lacquered red outsole that contrasts with the adjoining portion of the shoe, we modify the Red Sole Mark, pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, insofar as it is sought to be applied to any shoe bearing the same color 'upper' as the outsole. We therefore instruct the Director of the Patent and Trade Office to limit the registration of the Red Sole Mark to only those situations in which the red lacquered outsole contrasts in color with the adjoining 'upper' of the shoe.").

206. The World Intellectual Property Organization, an intergovernmental organization with 191 member states, provides a forum for IP "services, policy, information and cooperation." *Inside WIPO*, WIPO, http://www.wipo.int/about-wipo/en/ (last visited Dec. 15, 2018). It provides ADR services through its Arbitration and Mediation Center. *Alternative Dispute Resolution*, WIPO, http://www.wipo.int/amc/en/ (last visited Dec. 15, 2018). As one of the different international ADR centers offering IP dispute resolution, it is illustrative to study how its caseload has increased in the last couple of years. *See WIPO Caseload Summary*, WIPO, http://www.wipo.int/amc/en/center/caseload.html (last visited Dec. 15, 2018) (reflecting a trend of growth in its caseload since 2014).

207. *See Self-Regulatory Organization—SRO*, INVESTOPEDIA, https://www.investopedia.com/terms/s/sro.asp (last visited Dec. 15, 2018).

AAFA could either merge or collaborate to establish ADR panels in the same way that other organizations throughout different industries have.[208] A fashion industry self-regulatory organization could compel member retailers to resolve design infringement disputes through ADR as a requirement to maintain good status with the organization, or it could provide its own panel of experts, in a less drastic and more legal way than the Fashion Originators' Guild of America did from 1932 to 1941.[209]

The CFDA seems like the best candidate for this role, since it is a "not-for-profit trade association . . . whose membership consists of more than 500 of America's foremost womanswear, menswear, jewelry[,] and accessory designers."[210] It "has been criticised—often in private—for not doing enough to support members at every stage in their trajectory," because it focuses its efforts in supporting the most famous designers and those just starting, but not those in between.[211] Nevertheless, the association raised nearly $17 million in revenue in 2016,[212] and is still the largest association of fashion designers in the United States.[213] By stepping up as the fashion industry's self-regulator, the CFDA could not only draft best practices guidelines, but

208. *See, e.g.*, ADVERT. SELF-REG. COUNCIL, http://www.asrcreviews.org (last visited Dec. 15, 2018); *Uniform Domain-Name Dispute-Resolution Policy*, INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, https://www.icann.org/resources/pages/help/dndr/udrp-en (last visited Dec. 15, 2018).

209. The Fashion Originators Guild was an association of designers, manufacturers, and retailers of women's dresses who organized in 1932 to protect members from design piracy by refusing to sell any garments to shops and department stores that also sold copies of their designs. They created a registry where members would register their designs, a list of non-cooperating retailers to whom members refused to sell, an audit system, and a tribunal tasked with deciding whether a retailer was selling copied designs. *See* C. Scott Hemphill & Jeannie Suk, *The Fashion Originators' Guild of America: Self-Help at the Age of IP and Antitrust*, *in* INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP 159, 159 (Rochelle C. Dreyfuss & Jane C. Ginsburg eds., 2014); *see also* Fashion Originators' Guild of Am. v. FTC, 114 F.2d 80, 82 (2d Cir. 1940). In 1941, the Supreme Court sided with the FTC and held that the Guild's practices were a violation of federal antitrust law. Fashion Originators' Guild of Am. v. FTC, 312 U.S. 457, 467–68 (1941).

210. *About CFDA*, *supra* note 105.

211. Lauren Sherman, *What's Next for the CFDA?*, BOF (Sept. 14, 2017, 5:20 AM), https://www.businessoffashion.com/articles/intelligence/whats-next-for-the-cfda.

212. *Id.*

213. *About CFDA*, *supra* note 105.

also continue to lobby members of Congress to enact a bill to confer protection to fashion designs. It is hard to imagine that in this scenario, any conglomerate that owns several fashion powerhouses[214] would decline to endorse the guidelines and subject themselves to the bad publicity such an action would bring.

Regardless of how ADR in IP infringement cases is implemented, if ADR was mandated in such cases, those retailers or designers who do not wish to submit their infringement disputes to ADR-like mechanisms could, for example, be included in a "black list of fashion," be banned from advertising in major fashion magazines, or have at least some warning included next to their campaigns. Although nowadays Instagrammers and bloggers have arguably more influencing power over consumers than traditional print media,[215] fashion magazines still have strong trendsetting power and a strong online presence capable of influencing consumers' decisions.[216] Ideally, all actors in the fashion world should be more conscious about the negative impact knocking off someone's design has on that designer, so that even Instagrammers or influencers refuse to promote products that are not original creations of the retailer they are working with or with brands that have refused to submit their disputes to the proposed ADR panels. Of course, many practical considerations would have to be addressed, such as how the CFDA would obtain funds and what jurisdiction it would fall under, but thinking about an ADR-like panel to resolve fashion infringement issues is a first step toward devising a solution—a much-needed first step considering where we stand today.

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214. Nika Mavrody, *At a Glance: See How These Six Corporations Control the Luxury Fashion Industry*, FASHION SPOT (Apr. 30, 2014), http://www.thefashionspot.com/buzz-news/latest-news/401107-at-a-glance-see-how-these-six-corporations-control-the-luxury-fashion-industry/.

215. Karen Kay, *Does the Fashion Industry Still Need Vogue in the Age of Social Media?*, GUARDIAN (July 8, 2017, 7:03 PM), https://www.theguardian.com/fashion/2017/jul/08/does-fashion-industry-need-vogue-in-instagram-age.

216. *See* Limei Hoang, *Can Cost-Cutting Save Fashion Magazines?*, BOF (Aug. 8, 2016, 3:22 PM), https://www.businessoffashion.com/articles/intelligence/cost-cutting-fashion-magazines-hearst-time-inc-conde-nast.

Technical considerations, such as what would constitute infringement,[217] and procedural issues would have to be resolved first, but the ultimate decision would remain with a qualified panel of judges who work in the industry and possess the adequate background to tell two dresses apart.

This approach has the potential of not only expediting the resolution of fashion infringement issues, but also of giving independent fashion designers their day in court. As discussed in this Note, fashion designs are not adequately protected by the current legal system, which means that most times when a designer sees one of his creations being copied by another designer, he does not have legal recourse. But even when fashion designers can resort to the judicial system because they have a viable claim, oftentimes they will not have the economic means to hire a lawyer or to afford expensive (and extensive) litigation. Lowering the cost of access to justice would likely mean allowing designers to bring alleged infringers to justice, thus giving them a shot at holding the copycat accountable.

Another approach would be to create a small claims court for fashion design infringement issues. In October 2017, Representative Hakeem Jeffries introduced the Copyright Alternative in Small-Claims Enforcement Act (CASE)[218] before Congress with the purpose of amending the Copyright Act to create the Copyright Claims Board (CCB), a small claims board within the Copyright Office that would allow a copyright owner to litigate small-scale copyright infringement disputes without having to bring a federal claim.[219] The disputes would have a cap on damages of $15 thousand per work infringed and $30 thousand total.[220] The CCB would be staffed by qualified candidates—attorneys with at least seven years of legal

217. For example, it has been argued that a narrower "substantial similarity" test, similar to the one used when determining copyright infringement, would avoid a drastic departure from this element of the copyright infringement doctrine while still helping move from the almost non-existent protection for fashion designs. *See* Elman, *supra* note 79, at 708–15.

218. H.R. 3945, 115th Cong. (2017).

219. *Copyright Small Claims*, COPYRIGHT ALLIANCE, https://copyrightalliance.org/news-events/copyright-news-newsletters/copyright-small-claims/ (last visited Dec. 15, 2018).

220. *Id.*

experience—appointed by the Library of Congress upon the recommendation of the Register of Copyrights.[221] This new Board was intended to provide copyright holders a less expensive, faster solution when faced with infringement[222] and respond to a long-standing need to provide copyright owners an avenue to pursue small infringement issues without the expense of extensive federal litigation.[223] The bill is still being considered by Congress,[224] and it has already been subject to criticism.[225]

A similar small claims court could be created to give fashion designers a venue for resolving fashion infringement issues, providing them access to justice at lower costs than traditional litigation. Creating this institute within the Copyright Office's realm would require the adoption of one of the many proposed amendments to the Copyright Act to include fashion designs within its protectible subject matter. As discussed above, extending copyright protection might not be the best approach to protecting fashion designs, but giving designers at least one possible opportunity in which they can be heard represents a welcome departure from the current state of affairs.

Moreover, it might be possible to create a small claims court of this kind within another federal agency, such as the Federal

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221. H.R. 3945, 115th Cong. (2017).

222. *See* Kevin Madigan, *Small Claims Bill Aims to Empower Copyright Owners and Creators*, CPIP (Oct. 26, 2017), https://cpip.gmu.edu/2017/10/26/small-claims-bill-aims-to-empower-copyright-owners-and-creators/ (noting that "the cost of litigating a copyright infringement lawsuit with less than $1 million at stake was [in 2011] roughly $350,000" and that "it takes nearly a year and a half for cases to go to trial in the districts that see the highest volume of copyright complaints").

223. *See* Morgan E. Pietz, *Copyright Court: A New Approach to Recapturing Revenue Lost to Infringement: How Existing Court Rules, Tactics from the "Trolls," and Innovative Lawyering Can Immediately Create a Copyright Small Claims Procedure that Solves Bittorrent and Photo Piracy*, 64 J. COPYRIGHT SOC'Y U.S. 1, 6 (2017) (discussing the Copyright Office's recommendation that Congress "consider the creation of an alternative forum that will enable copyright owners to pursue small infringement matters and related claims arising under the Copyright Act" (citations omitted)).

224. *H.R. 3945: CASE Act of 2017*, GOVTRACK.US, https://www.govtrack.us/congress/bills/115/hr3945 (last visited Dec. 15, 2018).

225. *See, e.g.*, Scott Alan Burroughs, *CASE in Fact: Small-Claims Copyright Court Conundrums (Part II)*, ABOVE L. (Oct. 25, 2017, 4:16 PM), https://abovethelaw.com/2017/10/case-in-fact-small-claims-copyright-court-conundrums-part-ii/ (criticizing the language of the bill as proposed for failing to address many important issues).

Trade Commission[226] or the USPTO,[227] so as to separate it entirely from the copyright sphere; this would allow for the application of rules and principles different from the ones governing copyright law, so that the requirements of copyright law rendering it unsuitable to protect fashion designs could be bypassed. Of course, such an approach would require Congress to first create legislation conferring protection to fashion designs, and as evidenced by the many attempts to modify the Copyright Act, the U.S. fashion industry is far from seeing such a thing occur. If, however, Congress were able to devise a new solution, different from the previously discussed option of including fashion designs within the Copyright Act but closer to the approach followed in the European Union and capable of satisfying the different players' interests, then it would likely be easier to obtain support from the interested parties, which would in turn make its adoption more feasible. As discussed in this Note, this approach would primarily benefit emerging, independent designers who currently do not have an accessible venue to litigate infringement claims, as opposed to fashion brands and conglomerates that have the economic resources to at least decide whether they want to enforce their rights.

D. *Arguments Against a Stronger Fashion Design Protection*

Opponents of stronger fashion design protection consider maintaining a low IP-equilibrium as beneficial for the industry because it leads to innovation and advances. This is known as the "piracy-paradox" because it implies that low IP protection may "paradoxically serve the industry's interests better."[228] Supporters of this theory argue that piracy is actually beneficial for the industry in two different ways. First, because "free appropriation of clothing designs contributes to a more rapid obsolescence of designs" by lowering the prices of the items and

226. FED. TRADE COMM., https://www.ftc.gov (last visited Dec. 15, 2018).

227. *See* U.S. PAT. & TRADEMARK OFF., https://www.uspto.gov (last visited Dec. 15, 2018).

228. Raustiala & Sprigman, *supra* note 23, at 1717. *But see* Lauren Howard, Note, *An Uningenious Paradox: Intellectual Property Protections for Fashion Designs*, 32 COLUM. J.L. & ARTS 333, 335–56 (2009).

thus making them accessible to those who otherwise would not be able to afford them, which in turn "contributes to the rapid production of substantially new designs that were creatively inspired by the original design," this results in "product differentiation that induces consumption by those who prefer a particular variation to the original."[229] This has been called "induced obsolescence."[230] Even though proponents of this theory recognize that this might initially harm the originators, they also believe that originators might not be incentivized to break the low IP-equilibrium because given the way that trends and inspiration work in fashion, someone who creates a trend one season might end up copying one the next.[231]

Second, if the fashion industry seeks to maintain a cycle of "induced obsolescence" by creating different trends and styles every season, then it must make sure consumers are aware of how styles have changed from the previous season. A low-IP regime helps to communicate trends.[232] In what is known as "anchoring," "[w]idespread copying allows each season's output of designer apparel to gain some degree of design coherence. In doing so, copying helps create and accelerate trends" because "[c]opying helps to anchor the new season to a limited number of design themes, which are freely workable by all firms in the industry within the low-IP equilibrium."[233]

E. *Arguments in Favor of a Stronger Fashion Design Protection*

The most compelling reason why stronger protection is required for fashion law is that the main goal of IP protection is to foster innovation, and only by granting exclusive rights to those who invest their time, money, and effort into innovating

229. Raustiala & Sprigman, *supra* note 23, at 1722–24.

230. *See* KAL RAUSTIALA & CHRISTOPHER SPRIGMAN, THE KNOCKOFF ECONOMY: HOW IMITATION SPARKS INNOVATION 43–47 (Dave McBride ed., 2012).

231. Raustiala & Sprigman, *supra* note 23, at 1727.

232. *Id.* at 1728; *see also* RAUSTIALA & SPRIGMAN, *supra* note 230, at 47–49.

233. Raustiala & Sprigman, *supra* note 23, at 1728–29.

will we ensure that they continue to do so.[234] If piracy continues to be difficult to punish, those who create original fashion designs will make less profit because consumers will most likely buy the less-expensive option, and designers will not be incentivized to continue creating original designs or even enter the market at all.[235] The effect is that those designers who already have a strong trademark or trade dress protection—usually the bigger, better-known brands—will be incentivized to innovate in order to take advantage of the thousands of designers who will not be entering the market, likely those smaller, less-funded ones.[236] In addition, the current IP-equilibrium system is focused on status and luxury rather than fostering innovation, as evidenced in this Note. Stronger protection for fashion designers would likely lead to designers taking bigger risks and innovating more, instead of the usual luxury brands using already existing models and including their strong trademarks on them to prevent others from copying their designs.[237]

Moreover, the Supreme Court has acknowledged that "giving certain new and original appearances to a manufactured article may enhance its saleable value, may enlarge the demand for it, and may be a meritorious service to the public."[238] This recognizes that design plays a large part in the visual appeal of a product, and that it has the "potential to increase the impact and competitiveness of the product within a certain market sector."[239] The "piracy-paradox" does not distinguish between "close copies" and "trends," but this distinction is very important in the fashion industry, because only close copies are

234. *See* Hemphill & Suk, *supra* note 7, at 1174–80 (explaining why fast fashion copies pose a threat to innovation and deter designers from entering the market, and why the low-IP equilibrium in the fashion industry only encourages designers who are already protected to make innovative designs, therefore pushing consumers toward the consumption of luxury goods).

235. *See* Margaret E. Wade, Note, *The Sartorial Dilemma of Knockoffs: Protecting Moral Rights Without Disturbing the Fashion Dynamic*, 96 MINN. L. REV. 336, 357 (2011).

236. DE RUITER, *supra* note 187, at 62–63.

237. *Id.* at 63.

238. Gorham Co. v. White, 81 U.S. 511, 525 (1872).

239. SUTHERSANEN, *supra* note 197, at 4.

devastating to the market, whereas trends do not have such a detrimental effect.[240] Proponents of a more stringent fashion design protection believe that stronger protection should be granted only against "close copying." Trends do not deter consumers from buying the original design instead of copies, because they can still distinguish between the two items, whereas "close copies" decrease the attractiveness of buying the (usually) more expensive original over the cheap copy.[241]

Another reason supporting the conclusion that fashion designs should be subject to stronger protection is that there is no logical reason as to why other original creations, such as books, paintings, movies, and works of architecture receive strong protection, whereas fashion designs are completely ignored by the current legal system.[242] The required skills necessary to create fashion designs and products are comparable to those necessary to create any work of "fine art," and therefore there is no valid reason to deny them a similar protection.[243] Finally, it has been demonstrated that conferring stronger IP protection to fashion designs would help the industry grow,[244] which in the long term would benefit society as a whole.[245]

CONCLUSION

IP protection for fashion designs in the current legal system is only available to a select few brands and designers. First, as discussed in this Note, the traditional forms of IP protection are not suited to protect a fashion design in its entirety. However, designers with enough economic resources can choose to protect certain aspects of their designs. Second, even if a

240. DE RUITER, *supra* note 187, at 63.

241. *Id.* at 64.

242. *Id.* at 66; *see also* Wade, *supra* note 235, at 354, 356.

243. *See* Julie P. Tsai, Comment, *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK L. REV. 447, 461–63 (2005) (arguing and illustrating that fashion designers are artists).

244. Pytlak, *supra* note 41, at 296–98.

245. *Id.* at 298–300.

designer can obtain protection for a certain aspect of his design, he will likely be unable to enforce that right unless he has the economic resources to afford potentially extensive litigation. The current system thus prevents those fashion designers who do not have the same resources as better-established brands from protecting their creations. In light of recent changes in the fashion market, namely the advent of social media as a marketplace where designers can showcase their items for free and fast-fashion brands can obtain ideas for their next collection also free of charge, it is now more necessary than ever that Congress devise a solution to allow the fashion industry's creative minds to adequately protect the creations that took them so much time and effort to design. The sheer number of failed bills that sought to extend copyright protection to fashion designs shows that it might be time to craft a new solution, one that is particularly tailored to the fashion industry and not grounded in archaic doctrines that do not suit it. Congress could look across the Atlantic for inspiration, or turn the TV on when *Project Runway* is showing, but it owes emerging designers a solution that enables them to enter the market, innovate, and protect their rights against fashion predators and fast-fashion retailers.