

## Free Fashion

Ashley M. Marshall

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“Fashion is a form of imitation that unites social classes and enables social equalization. The elite initiate a fashion and the mass imitate in efforts to obliterate external distinctions of class.”<sup>1</sup>

Georg Simmel

#### INTRODUCTION

Our current vision of fashion is viewed as a shared art form that may be enjoyed by all social classes. Fashion encourages a melting pot of collaboration from people that are influenced by creativity. At its core, fashion is innovative and it inspires people to foster that same self-expressive conduit.

Traditionally, fashion was a privilege and greatly restricted from certain classes. Indeed, Georg Simmel has proposed that in an open class society, the high class seeks to distinguish itself by adorning distinctive forms of dress, and in turn, the middle class adopts this form of dress to identify with the superior class’s status.<sup>2</sup> Currently, access to fashion is wide-reaching. However, recently proposed intellectual property legislation threatens access to fashion, and, if enacted, will create visible class distinctions that mimic those of our historical society.

Whether to extend copyright protection to fashion is an issue that has sparked much discussion from supporters and critics alike. The current state of fashion design protection is minimal. Generally, fashion design and accessories are not protected under copyright law. Nevertheless, many designers have been able to successfully and creatively design fashion. Designers are occasionally able to secure protection under the current trademark law and, in some very rare instances, under design patents. Many fashion designers have expressed extreme dissatisfaction with the lack of fashion design protection. Recently proposed legislation has surfaced in efforts to address designers’ concerns.<sup>3</sup>

The Innovative Design Protection and Piracy Prevention Act<sup>4</sup> (“ID3PA”) will amend Title 17 of the United States Code and extend copyright-like protection to fashion design.<sup>5</sup> The ID3PA will provide designers with a three-year term of protection for the garment itself and the unique design elements of the garment.<sup>6</sup> This would allow designers

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1. Georg Simmel, *Fashion*, 62 AM. J. OF SOC. 541, 541 (1957), available at <http://www.jstor.org/stable/2773129>.

2. *Id.* at 544.

3. S. 3728, 111th Cong. (2010).

4. *Id.* § 1.

5. *Id.* § 2(a).

6. *Id.* at § 2(d)(2).

to own the overall appearance of the garment<sup>7</sup> if the designs are unique and distinguishable from prior designs. The ID3PA will not require registration,<sup>8</sup> and such protection would apply only to original designs created after the enactment of the bill. Any previously created designs will fall into the public domain. The scope of infringement would only capture “substantially identical” designs, requiring a plaintiff to “plead with particularity”<sup>9</sup> the facts underlying their infringement claim. The “substantially identical” test is only applied to merely trivial aspects of the designs<sup>10</sup> and would require that designs be so similar that the infringing copy could be mistaken for the original. The penalty for false representation of an infringement action ranges from \$5,000 to \$10,000.<sup>11</sup>

I agree with the supporters of the ID3PA because the current copyright protection offered to designers is minimal at best. Nevertheless, I also hold the view that such protection is unnecessary. Ultimately, I will argue that the proposed legislation, the ID3PA, as drafted, is not the solution to the long debated issue of “whether copyright protection should be given to fashion design.”

This Comment will explore the often debated issues of why fashion design has been unable to obtain protection under the American intellectual property law regime. Part I of this comment will discuss the current state of fashion law protection. Part II will discuss the history of fashion law legislation; the goal is to provide a better idea of the precedent set by previously proposed fashion design legislation. Part III will return to the ID3PA and discuss more in-depth the logistics of the bill. This Section will answer the question, What is the ID3PA? Moreover, a discussion of the pros and cons of the ID3PA, and the theories behind the proposed legislation will further provide clarity as to the points made in Part II regarding past fashion design legislation. Next, Part IV will discuss in detail the effects of the ID3PA on various institutions including culture, creativity, innovation, and economics. Finally, Part V will discuss persuasively-argued points from both supporters and critics of the ID3PA

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7. *Id.* at § 2(b) (Language added to incorporate fashion design: “[a] fashion design is the appearance as a whole of an article of apparel, including its ornamentation; and includes original elements of the article of apparel or the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel.”).

8. *Id.* at § 2(i).

9. *Id.* at § 2(h).

10. *Id.* at § 2(b)(10). See also Tiffany W. Shimada, *Fashion Design under the Innovative Design Protection and Piracy Prevention Act*, [http://www.brinkshofer.com/files/fashion\\_designshimadaaba\\_ip\\_newsletterspring2011.pdf](http://www.brinkshofer.com/files/fashion_designshimadaaba_ip_newsletterspring2011.pdf) (last visited Oct. 30, 2012).

11. S. 3728, 111th Cong., at 9 (2010).

alike, and will provide a summary of the ultimate issue to be decided—the fate of the ID3PA. In discussing whether the ID3PA is really a step in the right direction for America, I will question if the ID3PA is the solution. Evaluating what should become of the ID3PA, I will propose a solution to the fictitious need for copyright protection of fashion design.

#### PART I: CURRENT STATE OF FASHION DESIGN PROTECTION

Fashion design protection under current intellectual property law is limited at best. It is no secret that fashion designers do not benefit from the same level of protection as their artistic peers in the world of visual arts, music, film, and dance.<sup>12</sup> Fortunately, there is a viable explanation for the difference. Fashion design is a much more complex type of property than visual arts, music, film, or dance. Fashion design is fluid, and exists in many different shapes and forms. A heavily debated topic, fashion design has yet to find a stable home within traditional intellectual property law.

##### A. Trademarks

The most notable form of protection offered to fashion design is trademark protection. The Lanham Act<sup>13</sup> provides protection to owners of valid trademarks and equips trademark owners with a cause of action for trademark infringement.<sup>14</sup> In order to state a claim under trademark law, a plaintiff must show three things: first, ownership of a valid registered trademark;<sup>15</sup> second, usage of the trademark in commerce without consent of the owner;<sup>16</sup> and lastly, evidence that such mark is identical or confusingly similar to that of the trademark owner.<sup>17</sup> This form of protection is seen most with designer handbags and designer logos.

In 2004, famous handbag designer Louis Vuitton sued Dooney & Burke for trademark infringement in the Southern District of New York.<sup>18</sup> The trial court denied Louis Vuitton's motion for preliminary injunction. In 2006, the Second Circuit Court of Appeals<sup>19</sup> reversed, holding that

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12. See generally 17 U.S.C. § 101 (2006).

13. 15 U.S.C. § 1051 (2006).

14. 15 U.S.C. § 1114 (2006).

15. See 15 U.S.C. § 1057(b) (2006) (certificate of registration gives rise to a statutory presumption that the mark is valid).

16. *Id.*

17. *Id.*

18. Louis Vuitton Malletier v. Dooney & Bourke, Inc., 340 F. Supp. 2d 415 (S.D.N.Y. 2004).

19. Louis Vuitton Malletier v. Dooney & Bourke, Inc., 454 F.3d 108 (2d Cir. 2006).

likelihood of confusion could be proven between Louis Vuitton's "Multicolore" mark and the pattern of Dooney & Burke's "It-Bag."<sup>20</sup>

Like Louis Vuitton, many designers have attempted to make their products and designs protectable by marking the entire piece with a trademark. Some have been successful and others are not. Even if a designer is able to prevail in a trademark infringement cause of action, only the trademark itself is protectable—not the entire design. The bottom line is that while trademark law is useful to protect brand names and logos, it generally does not protect the design itself. The Supreme Court has refused to extend trade dress and trademark protection to apparel designs. While trademark law is often used in attempts to prevent knock-off reproductions, it is just not a feasible and comprehensive option for fashion designers.

Most recently, in 2011, French footwear designer Christian Louboutin ("Louboutin") brought a trademark infringement suit against Yves Saint Laurent ("YSL") for producing shoes with the "lacquered red soles."<sup>21</sup> This case is distinguishable from the 2006 *Louis Vuitton v. Dooney & Burke* litigation,<sup>22</sup> and is arguably one of the most notable fashion law cases of 2011. The United States District Court denied Louboutin's motion for preliminary injunction.<sup>23</sup> In arriving at this decision, the court noted Louboutin's prior admissions that he chose the red sole not purely as a source identifier, but also to give his shoes "engaging and flirtatious" energy.<sup>24</sup> Further, the court opined that Louboutin had no cause of action for trademark infringement under the Lanham Act,<sup>25</sup> and doubted whether a color should be allowed trademark protection in the fashion industry. In an attempt to clarify its decision that color in the fashion world is unique, aesthetically functional, and not solely as a source identifier, the court proposed a hypothetical comparing Louboutin's exclusive use of the color red on shoe soles to Picassos' attempt to gain exclusive use of his "color of melancholy" during his Blue Period.<sup>26</sup> In coming to its decision, the court relied on one of YSL's arguments, which stated that not only were Louboutin's "lacquered red soles"

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20. *Id.* at 120.

21. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011).

22. *Id.* at 450 ("Color alone 'sometimes' may be protectable as a trademark, 'where that color has attained 'secondary meaning' and therefore identifies and distinguishes a particular brand.'") (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161, 163 (1995)).

23. *Id.* at 458.

24. *Id.* at 447.

25. *Id.* at 457.

26. *Id.* at 451.

unprotectable under trademark law, but they were also not original.<sup>27</sup> YSL went on to attack the originality of Louboutin's use of the red soles, stating that he copied the style from either "King Louis XIV's red-heeled dancing shoes or Dorothy's famous ruby slippers."<sup>28</sup>

As Justice Marrero pointed out, "fashion is dependent on colors."<sup>29</sup> Fashion designers need access to color to create, without restriction, the artistic designs for which they are recognized and celebrated. In closing, the court concluded that the fashion industry needed to use colors on outsoles without restriction to permit designers to make artistic choices in creating their designs.<sup>30</sup>

More than a year after the initial arguments, the United States Court of Appeals for the Second Circuit brought closure to the *Louboutin v. YSL* litigation.<sup>31</sup> The court upheld prior precedent in holding that the "District Court's holding that a single color can never serve as a trademark in the fashion industry, is inconsistent with the Supreme Court's decision in *Qualitex Co. v. Jacobson Products Co.*"<sup>32</sup> The court went on to hold that Louboutin's trademark on the red sole was a valid trademark.<sup>33</sup> Nonetheless, the court held that Louboutin's trademark was only enforceable because it had acquired secondary meaning. The court opined that protection could be found in "only those situations where the red lacquered outsole contrasts in color with the adjoining 'upper' of the shoe."<sup>34</sup> Consequently, YSL's design was not infringing on Louboutin's trademark.

The decision in the *Louboutin v. YSL* litigation highlights the highly controversial, yet accurate reality of the interplay of intellectual property law and its application to fashion design.

### B. Design Patents

To qualify for patent protection a design must be new, original, and non-obvious.<sup>35</sup> Design patents are intended to protect ornamental designs, but clothing rarely meets the demanding requirements of "novelty" and "non-obviousness" for patentability. While patents

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27. *Id.* at 457.

28. *Id.* at 447.

29. *Id.* at 454.

30. *Id.*

31. *Christian Louboutin, S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303-cv, 2012 WL 3832285 (2d Cir. 2012)

32. *Id.* at \*2.

33. *Id.*

34. *Id.*

35. 35 U.S.C. § 100 (2006).

successfully help designers protect articles such as eyeglasses, handbags, jewelry, and shoes,<sup>36</sup> such protection has yet to be successfully extended to fashion apparel and design. Further, even if patent protection were extended to fashion designs, it would prove unsuccessful. The patent application can be a financially burdensome and time-consuming process, often taking a year or more to obtain registration.<sup>37</sup> Fashion is fluid and “seasonal”<sup>38</sup> property; designers would not be able to wait that amount of time to secure the design patent.

### C. Copyrights

The Copyright Act provides that a useful article can only be copyrighted if the aspects of its original design can be separated from its utilitarian function.<sup>39</sup> Copyright law may protect elements of a garment, like the patterns or prints in its textiles or other materials, but garments and accessories themselves are usually considered functional and thus unprotected. Features that can be separately identified from the utilitarian aspects of the article of clothing may obtain protection.<sup>40</sup> The creative elements must stand alone from the functional aspects. Many designers have jumped through hoops to produce copyrightable fashion apparel. However, the harsh reality is that clothing is inherently useful in nature.

This is where the proposed legislation for fashion design protection attempts to change fashion design protection. The ID3PA will revise the definition of “useful article” to include an “article of apparel”<sup>41</sup>—extending protection to fashion design.

## PART II: HISTORY OF FASHION DESIGN PROTECTION LEGISLATION

To understand better, one must look at the history of fashion design protection, or the lack thereof, in American society.

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36. United States Patent and Trademark Office, *Class D02 Apparel and Haberdashery*, <http://www.uspto.gov/web/patents/classification/uspcd02/schedd02.pdf> (last visited Oct. 30, 2012).

37. See 35 U.S.C. §§ 100–57 (2006).

38. *Louboutin*, 778 F. Supp. 2d at 451–52.

39. See 17 U.S.C. § 101 (2006).

40. See *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 329 (2d Cir. 2005) (the court distinguished costumes from clothing, in that clothing has a single function, to cover the body, and costumes have multiple functions, to cover the body and the depict the appearance of the work); see also DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[B] (2012) (“Conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.”).

41. S. 3728, 111th Cong. § 2(a)(7) (2010).



### A. *Res Ipsa Loquitur*

The issue of extending protection to design is not a novel topic. One of the earliest efforts to extend protection to fashion design occurred in 1930, and was led by a private organization called the Fashion Originators' Guild of America ("Guild").<sup>42</sup> The Guild would register designers' fashion designs and compel retailers throughout the nation not to sell copies. If a retailer did sell a copy, the Guild would call for a boycott of that retailer. After operating successfully for several years, Filene's Basement department store brought suit against the Guild. Even after a prevailing defense against Filene's, the Supreme Court finally struck down the Guild in 1941 when the Guild came up against the Federal Trade Commission.<sup>43</sup>

Additionally, Americans have advocated for design protection since the early twentieth century. Dating back to as early as 1914, Congress has contemplated the idea of providing copyright protection to design.<sup>44</sup> Specifically in 1930, during the term of the 71st Congress, the House passed the Design Copyright bill.<sup>45</sup> However, the bill was not passed by the Senate. During the 87th, 88th, and 89th Congressional terms, the Senate again failed to pass legislation that proposed copyright protection for design.<sup>46</sup> While these early bills did not specifically extend to fashion protection, their failure to reach approval speaks to the legislature's intent to prevent protection of design. It was not until the 105th Congress that the legislature addressed design protection as part of the Digital Millennium Copyright Act,<sup>47</sup> specifically in the Vessel Hull Design Protection Act.<sup>48</sup>

### B. *Design Piracy Prohibition Act*

In 2006, Congressman Bob Goodlatte introduced the Design Piracy

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42. See Sara B. Marcketti & Jean L. Parsons, *Design Piracy and Self-Regulation: The Fashion Originators' Guild of America, 1932-1941*, 24 CLOTHING & TEXTILES RES. J. 214, 214-28 (July 2006).

43. See *Fashion Originators' Guild of Am. v. Fed. Trade Comm'n*, 312 U.S. 457 (1941).

44. Anya Jenkins Ferris, *Real Art Calls for Real Legislation: An Argument Against Adoption of the Design Piracy Prohibition Act*, 26 CARDOZO ARTS & ENT. L.J. 559, 564 (2008).

45. Vessel Hull Design Protection Act of 1997: Hearing on H.R. 2696 Before the Subcomm. on Courts and Intellectual Prop. of the H. Comm. on the Judiciary, 105th Cong. (1997) (Statement of Marybeth Peters, The Register of Copyrights), available at <http://www.copyright.gov/docs/hr2696.html>; See also H.R. 11852, 71st Cong. (1930).

46. Statement of Marybeth Peters, *supra*, note 45; S. 1884, 87th Cong. (1962); S. 776, 88th Cong. (1963); S. 1237, 89th Cong. (1965).

47. 17 U.S.C. § 512 (2006).

48. 17 U.S.C. § 501 (2006).

Prohibition Act (“DPPA”) in the House.<sup>49</sup> The DPPA aimed to amend Title 17 of the United States Code, specifically § 1301, providing that “a fashion design is subject to protection under this chapter.” The DPPA also served to amend § 1302(b) to include “an article of apparel” in the definition of “useful articles” subject to protection.<sup>50</sup> Protection was to be extended to those designs substantially similar<sup>51</sup> to the original designs—this language rightfully caused many people to cautiously approach the bill. The DPPA failed to pick up speed and many deemed it overly broad. Manufacturers and others protested that the bill would lead to “frivolous lawsuits.”<sup>52</sup> They believed that great time and effort would be spent determining who had the idea first and over what is meant by the ambiguous term “similar.” The DPPA’s fire slowly burned out and died in the subcommittee.

There is an important lesson to learn in the history of fashion law legislation: facts do not lie. It is apparent that the protection of fashion law has not worked in the last ninety-eight years for a reason.

#### PART III: THE INNOVATIVE DESIGN PROTECTION AND PIRACY PROHIBITION ACT

Since the fall of the DPPA, efforts led by Senator Schumer have resulted in the development of the ID3PA, the second bill proposed to extend copyright protection to fashion designers. Various notable changes set the ID3PA apart from the DPPA. First, designers would have to prove that their designs were truly original, that the defendant’s design was an infringement. In addition, designers would have to prove that the defendant had actual knowledge of the designers’ work. Also, similarities in color and patterns would be actionable ground for claims. Nevertheless, there is still much about the ID3PA that is unattractive (to be discussed in Part IV).

##### *A. Scope of the Innovative Design Protection and Piracy Prohibition Act*

The ID3PA is the collective efforts of Senator Schumer, his ten co-sponsors, the American Apparel & Footwear Association (“AAFA”), and the Council of Fashion Designers of America (“CFDA”) to transform American fashion design into protectable subject matter under copyright

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49. H.R. 5055, 109th Cong. (2006), available at <http://thomas.loc.gov/cgi-bin/query/z?c109:H.R.5055>.

50. *Id.*

51. 17 U.S.C. § 1301(b)(1) (2006).

52. See Julie Zerbo *Design Piracy Prohibition Act*, THE FASHION LAW, May 20, 2011, <http://www.fashion-law.org/2011/05/design-piracy-prohibition-act.html>, (last visited Oct. 30, 2012), (stating the American Apparel & Footwear Association was a strong opponent of the DPPA and later became a supporter of the ID3PA).

law. Senator Schumer introduced the ID3PA on August 5, 2010,<sup>53</sup> with the primary purpose of extending protection to fashion design.<sup>54</sup> Passed by the Senate Judiciary Committee on December 1, 2010,<sup>55</sup> the bill was an updated version of the 2006 Design Piracy Prohibition Act, which died in Congress. The ID3PA, more passionately known by its critics as the “Destruction of Affordable Fashion Act,”<sup>56</sup> will not only serve to provide designers with protection for sketches and images, but will also extend protection to the construction of the designs themselves. This legislation will have a drastic impact on how society shares in the world of fashion.

The ID3PA provides for a single narrow exception—the “Home Sewing Exception.”<sup>57</sup> This exception will expand the “fair use” provisions already in the Copyright Act. The exception will allow a person to create a single copy of a protected design for personal use or for the use of a close family member, but places a limitation on the sale of the copy. Unfortunately, this exception will only exempt the select few individuals who enjoy the hobby of sewing. Further, the single copy limitation will do nothing to preserve access to the social good of fashion. Access should be provided to the society as a whole and not a select few.

Despite strong support from groups like the CFDA and the AAFA, the ID3PA still failed to receive a vote on the Senate floor.<sup>58</sup> A closer examination of the effects the bill will have on culture, economics, and innovation will shed light on why this may be.

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53. Cathy Horyn, *Schumer Bill Seeks to Protect Fashion Design*, N.Y. TIMES (Aug. 5, 2010), <http://runway.blogs.nytimes.com/2010/08/05/schumer-bill-seeks-to-protect-fashion-design/>.

54. *Innovative Design Protection and Piracy Prevention Act: Official Summary*, OPENCONGRESS.ORG, <http://www.opencongress.org/bill/111-s3728/show> (last visited Oct. 30, 2012).

55. *Bill Summary & Status, Innovative Design Protection and Piracy Prevention Act*, LIBRARY OF CONGRESS, <http://thomas.loc.gov/cgi-bin/bdquery/z?d111:SN03728:@@X> (last visited Oct. 30, 2012).

56. Staci Riordan, *A Response to Bloomberg’s Law Interview of Susan Scafidi: IDPPPA Is Better Called The Destruction of Affordable Fashion Act*, FASHION LAW BLOG (Oct. 7, 2011), <http://fashionlaw.foxrothschild.com/2011/10/articles/fashion-law/a-response-to-bloomberg-laws-interview-of-professor-scafidi-idpppa-is-better-called-the-destruction-of-affordable-fashion-act/>; see also *Scafidi Says Fashion Copyright To Increase Consumer Options*, BLOOMBERG LAW PODCAST (Sept. 26, 2011), <http://www.youtube.com/watch?v=395ADDsICwU> [hereinafter Scafidi podcast].

57. S. 3728, 111th Cong. § (2)(h)(i) (2010).

58. *Innovative Design Protection Act Reintroduced*, COUNCIL FOR FASHION DESIGNERS OF AMERICA, (Sept. 12, 2012), <http://cfda.com/the-latest/innovative-design-protection-act-reintroduced> [hereinafter *Reintroduced*].

## PART IV: EFFECTS OF THE ID3PA

*A. Cultural Effects of the Innovative Design Protection and Piracy Prohibition Act*

It was common for earlier societies to implement sumptuary laws to prevent access to the culture of the higher class and to prohibit the lower classes' access to the "social good" of clothing and material design. The protections the ID3PA will offer are heavily criticized and often contrast fashion design protection to modern day sumptuary laws.<sup>59</sup> According to many critics, a strong possibility exists that this bill may change how society shares in the world of fashion design. Although the ID3PA protects designs, it also has the hopefully unintended consequence of restricting clothing that merely resembles the design. Consequently, the ID3PA will outlaw the more affordable imitations of high-end design. Whereas the blend of fashion design and fashion imitation is currently commonly shared among all people, the ID3PA literally removes this "common thread."

Additionally, two notable early twentieth century sociologists, Georg Simmel and Thorstein Veblen, provided meaningful commentary on the cultural effects of fashion protection.<sup>60</sup> They opined that fashion is adopted by social elites to distinguish themselves as a group from the lower classes, who inevitably admire and emulate the upper class. Thereupon, the upper classes look to new fashion in an attempt to set themselves apart from the lower classes.<sup>61</sup> Such action not only provides all individuals free access to fashion, it also promotes the need for new and innovative fashion design.

*B. Effects of the Innovative Design Protection and Piracy Prohibition Act on Innovation and Creative Minds*

"Promotion of innovation gives way to imitation necessary to invention itself and the very lifeblood of a competitive economy"<sup>62</sup>

Justice O'Connor

On November 16, 2011, Joanna Blakely held a presentation dealing with fashion and the democracy of style at New York University's

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59. Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 810 (2010).

60. See Thorstein Veblen, *The theory of the Leisure Class*, SOCIAL STRATIFICATION (1899) (David Grusky ed., 2008); see also Simmel, *supra* note 1, at 541.

61. Veblen, *supra* note 60.

62. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989).

Department of Media, Culture, and Communication. Blakely focused on “how the lack of intellectual property law serves as an incentive for innovation.”<sup>63</sup> Blakely reasoned that when knock-offs saturate the market, “they drive the fashion designers to new trends and customers to new purchases.”<sup>64</sup> Thus, copyists promote a faster establishment of global trends, and in turn, increase innovation.

It is often argued that copying will destroy designer’s incentive to foster innovation, when, in actuality, fashion firms and designers continue to innovate at a rapid pace, casting much doubt and a strong need for reconsideration of this theory. This argument leads to a very important question, Does originality really exist? For example, it is no secret that doubts exist in the world of fashion as to whether Diane von Furstenberg is truly responsible for the wrap dress.<sup>65</sup> History purports that U.S. fashion designer Claire McCardell in fact invented the first wrap dress in the 1940s.<sup>66</sup> This raises a serious question as to what, if any, design is original.

In 2011, in the midst of the Kate Middleton wedding dress fiasco, fashion designer Allen Schwartz began selling “royal-wedding-inspired” dresses.<sup>67</sup> Schwartz had very strong opinions about society labeling him as a copyist. He argued that just about anything “created in fashion . . . is the result of what is in the air.”<sup>68</sup> Schwartz stated that he usually “makes enough small changes with his dresses that it would be hard to call them identical to the original, even when they look alike.”<sup>69</sup> Johanna Blakely eloquently addressed these same issues in regards to designer Diane von

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63. Huan Vo, *Lack of copyright laws benefit fashion industry*, MESA LEGEND BLOG (Jan. 9, 2012), <http://www.mesalegend.com/news/lack-of-copyright-laws-benefit-fashion-industry-1.2739578>.

64. *Id.*

65. See *Diane Von Furstenberg, c. 1976.*, FIDM MUSEUM & GALLERIES, <http://blog.fidmmuseum.org/museum/2011/01/diane-von-furstenberg-c-1976.html> (last visited Oct. 29, 2012); but see Staci Riordan, *Breaking News: New Design Piracy Bill Introduced Into Senate*, FASHION LAW BLOG (Aug. 6, 2010), <http://fashionlaw.foxrothschild.com/tags/charles-schumer/> (“[S]o many designers mistakenly believe that their creation is new. But almost all the design we see these days pull inspiration from the art of past designers. A great example is Diane Von Furstenberg and the wrap dress. She claims to have invented it, but fashion history students know that McCardell introduced a wrap dress in the 1940’s.”) [hereinafter *Breaking News*].

66. *Breaking News*, *supra* note 65.

67. Eric Wilson, *Designers Revisit Copyright Protection*, N.Y. TIMES (July 15, 2011), available at <http://runway.blogs.nytimes.com/2011/07/15/designers-revisit-copyright-protection/#>.

68. *Id.*

69. *Id.*

Furstenberg.<sup>70</sup> Blakely noted that under the ID3PA, von Furstenberg's "iconic" wrap dress would not qualify for protection.<sup>71</sup> Ironically, von Furstenberg herself would also be a copyist. In essence, what Diane von Furstenberg has done is take the dress introduced to the world by designer Claire McCardell, changed the material, and added a pattern—insufficient efforts to achieve the necessary originality under the ID3PA.

*C. Economic Effects of the Innovative Design Protection and Piracy Prohibition Act*

The probability of unnecessary litigation was a concern in the DPPA, and is still a bright red flag in the ID3PA. Unsurprisingly, the majority of independent designers do not have the litigation funds to effectively challenge large fashion houses if accused of copyright infringement. Further, added litigation costs will raise the consumer price for the apparel.

While many supporters of the ID3PA reign praise to the "substantially identical" requirements of the bill, they neglect to note that this phrase is inherently vague—just as vague as the "substantially similar" language in the DPPA. With discretion to the court, litigation will be the only avenue for fashion designers to take in seeking interpretation. Critics of the ID3PA persuasively argue that "the ability to copy work adds to the fashion industry's economic success."<sup>72</sup> Many argue that if copying were illegal, the fashion cycle would occur very slowly, if at all.<sup>73</sup>

Finally, there are certain aspects of economic utility that exist in copying—what I like to call the "hidden benefits." For instance, revenue will decrease if fashion designs are unavailable to the average American. Even without knock-offs, it is highly unlikely that the profits of the designers would increase. Instead, intellectual property protections will slow the fashion cycle leading to higher prices to offset lack of demand for new trends. There will not be a need for new fashion because the fashion that exists would be unavailable. The bottom line is that no one will be able to create a "fashion design" that qualifies under the ID3PA,

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70. Johanna Blakely, *Diane von Furstenberg & Her Tragicomic Quest for Copyright Protection*, JOHANNA BLAKELY BLOG (Sept. 27, 2010), <http://johannablakley.wordpress.com/2010/09/27/diane-von-furstenberg-her-tragicomic-quest-for-copyright-protection/>.

71. *Id.*

72. See Ashlee Hodge, *Copyrights and the Fashion Industry: A Love-Hate Relationship?* 2 AM. U. INTELL. PROP. BR. at 26 (Summer 2010), available at <http://digitalcommons.wcl.american.edu/ipbrief/vol2/iss1/6/>; See also Kal Raustiala and Chris Sprigman, *Why Imitation Is the Sincerest Form of Fashion*, N.Y. TIMES (Aug. 12, 2010), available at <http://www.nytimes.com/2010/08/13/opinion/13raustiala.html>.

73. Hodge, *supra* note 72.

making it unnecessary, irrelevant, inherently time consuming, and financially burdensome.

*D. Re-introduction of the Innovative Design Protection and Piracy Prohibition Act as the Innovative Design Protection Act*

On September 12, 2012, Senator Charles Schumer introduced the Innovative Design Protection Act (IDPA) as a companion bill to the ID3PA legislation.<sup>74</sup> Just a few days later on September 19, 2012, the Senate Judiciary Committee passed the IDPA.<sup>75</sup> The bill is currently awaiting approval from the Senate floor, where the ID3PA failed to receive a vote.<sup>76</sup> Reiterating much of the language of the ID3PA, the IDPA also attempts to address many of the big critiques of the ID3PA. A notable addition would be the “safe harbor provision,”<sup>77</sup> which would require fashion designers to notify the accused infringer and wait twenty-one days before filing suit.<sup>78</sup> Also addressed in the IDPA, is the computation of damages. Under the IDPA, damages will not begin to accumulate until the safe harbor action provision is triggered and the potential infringer receives notice.<sup>79</sup>

This is now the third time in six years the fashion law bill has been introduced.<sup>80</sup> Each time, drafters and supporters alike believe the current version will be better than its predecessor.

PART V: RESOLUTION: IS THE INNOVATIVE DESIGN PROTECTION AND PIRACY PROHIBITION ACT A STEP IN THE CORRECT DIRECTION?

*A. Critics of the Innovative Design Protection and Piracy Prohibition Act*

While there are numerous reasons why the ID3PA is severely criticized, a few of the heavily debated issues include the self-dealing benefits to large fashion houses, increasing cost of fashion, and preserving fashion’s free culture.<sup>81</sup> Many believe that the ID3PA would

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74. S. 3523, 112th Cong. (2012); *Reintroduced, supra* note 58.

75. *Victory for Design Protection*, COUNCIL FOR FASHION DESIGNERS OF AMERICA, BLOG, (Sept. 21, 2012) <http://cfda.com/blog/victory-for-design-protection>.

76. *Reintroduced, supra* note 58.

77. Staci Riordan, Fashion Copyright Bill Moves to the Full Senate, FASHION LAW BLOG, (Oct. 1, 2012), <http://fashionlaw.foxrothschild.com/2012/10/articles/fashion-design-copyright/fashion-copyright-bill-moves-to-the-full-senate/>.

78. *Id.*

79. *Id.*

80. The DPPA was introduced in 2006, the ID3PA in 2010, and finally the IDPA in 2012.

81. Matthew Trost, *Lessons From Fashion’s Free Culture: Johanna Blakely*, TED BLOG (May 25, 2010), [http://blog.ted.com/2010/05/25/lessons\\_from\\_fa/](http://blog.ted.com/2010/05/25/lessons_from_fa/); See Michelle Mancino Marsh et. al., *Reintroduction of the Innovative Design Protection and Piracy Prohibition Act (IDPPPA)*

be a disservice to society.

### 1. Piracy Paradox

The “piracy paradox” emerged in the 2006 publication of University of Virginia Law Review by international property experts Chris Sprigman and Kal Raustiala.<sup>82</sup> In this article, they acknowledge that copying is not piracy, but in fact a celebrated homage. Further, they argue that the fashion industry operates within the realm of low intellectual property law protection, in which copying actually promotes innovation.<sup>83</sup> A 2010 article brought their original theory back to life.<sup>84</sup> Sprigman and Raustiala refreshed readers’ memories on the benefits of copying, reiterating the argument that copying generates more demand for new designs, since the old designs—the copied—are no longer unique. Thus, the copying will result in greater sales of the fashion designs—the piracy paradox.

#### *B. Supporters of the Innovative Design Protection and Piracy Prohibition Act*

Susan Scafidi is the “first professor ever to offer course work in Fashion Law.”<sup>85</sup> Scafidi advocates for the extension of legal protection for fashion design.<sup>86</sup> In an August 2010 post on her blog, Counterfeit Chic,<sup>87</sup> Scafidi first discusses the ID3PA.<sup>88</sup> Scafidi expresses her support for the ID3PA referencing it as a “step forward” in intellectual property law.<sup>89</sup> In a 2011 Bloomberg Law Podcast,<sup>90</sup> Scafidi expresses her concerns with the lack of copyright protection and reconfirms her support for the ID3PA. Scafidi specifically takes issue with counterfeited and copied designs

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*Refuels the Debate on Expanding the Scope of Copyright Protection in Fashion Design*, <http://www.kenyon.com/newspublications/publications/2011/11-2.aspx>.

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

83. *Id.*

84. Chris Sprigman & Kal Raustiala, *Is the Design Piracy Prohibition Act a Good Idea?*, FREAKONOMICS BLOG, (Mar. 12, 2010), <http://www.freakonomics.com/2010/03/12/should-fashion-be-protected-by-copyright-laws-a-guest-post/>.

85. Susan Scafidi, *Faculty Page*, FORDHAM UNIVERSITY SCHOOL OF LAW, <http://law.fordham.edu/faculty/susanscafidi.htm>.

86. *Id.*

87. *Id.*; Susan Scafidi, *IDPPA: Introducing the Innovative Design Protection and Piracy Prevention Act, a.k.a. Fashion Copyright*, COUNTERFEIT CHIC BLOG (Aug. 6, 2010), <http://www.counterfeitchic.com/2010/08/introducing-the-innovative-design-protection-and-prevention-act.html> [hereinafter *Fashion Copyright*].

88. *Fashion Copyright*, *supra* note 87.

89. *Id.*

90. Scafidi podcast, *supra* note 56.



“hitting the market” before the original fashion designs. She states that fashion works on a six-month time frame, meaning that the spring collection that hits the runway in October will not be available to the public until March. She goes on to say the ID3PA will allow short-term protection for fashion designs—three years. Unfortunately, three years is not short-term.

Fashion designers suggest that with creativity it is possible to design original clothing that is affordable and argue that copying is not the only way to bring fashion to the masses. However, the history of fashion law does not make this a persuasive argument.

### *C. What the Courts Have to Say About Fashion Design Protection*

In addition to the *Louis Vuitton* and *Louboutin* cases mentioned above, there have been a few other cases that have attempted to provide clarity on why fashion designers have been unsuccessful in securing intellectual property laws.

The *Whimsicality* cases implicitly support the assumption that clothing designs are not copyrightable.<sup>91</sup> In *Whimsicality Incorporated v. Rubie's Costume Company*, the issue was whether to extend copyright protection to Halloween costumes by classifying them as “soft sculptures.”<sup>92</sup> The Second Circuit rejected this characterization and found the costumes to be uncopyrightable clothing.<sup>93</sup> In *Whimsicality Incorporated v. Maison Joseph Bratt*, the court further clarified its decision in *Whimsicality I* by holding that the costumes’ utility of enabling its wearer to portray an animal made them “useful articles” and, therefore, not copyrightable subject matter.<sup>94</sup>

It is an understood principle that the “useful nature of clothing cannot be separated from its artistic nature.”<sup>95</sup> Therefore, it is impossible to extend copyright protection to clothing design.

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91. *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452 (2d Cir. 1989) [hereinafter *Whimsicality I*] (clothes, as useful articles, are not copyrightable); *Whimsicality, Inc. v. Maison Joseph Battat*, 27 F. Supp. 2d 456 (S.D.N.Y. 1998) [hereinafter *Whimsicality II*].

92. *Whimsicality I*, 891 F.2d at 454.

93. *Id.* at 456 (“The evidence demonstrates not only that the costumes were not soft sculpture, but that Whimsicality knew full well that no reasonable observer could believe that the costumes were soft sculpture.”).

94. *Whimsicality II*, 27 F. Supp. 2d at 463. (“Collateral estoppel precludes Whimsicality from asserting a copyright claim in this case. The enforceability of Whimsicality’s costume copyrights has already been litigated in Rubie’s.”).

95. Brandon Scruggs, *Should Fashion Design Be Copyrightable?*, 6 NW. J. TECH. & INTELL. 122, 127 (2007).

More than ten years after *Whimsicality I*, Justice Scalia provided more insight as to whether clothing design should be protectable. In *Wal-Mart v. Samara*<sup>96</sup>—a trademark infringement action—the analysis heavily focused on the unprotectability of fashion design. The Court reversed the Second Circuit Court of Appeals’ decision to uphold the district court’s judgment in favor of the clothing designer and held that product design is only entitled to protection as unregistered trade dress if it has acquired secondary meaning.<sup>97</sup> Scalia stated, “[c]onsumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves.”<sup>98</sup> In other words, “cheap knock-offs” allow access to the social good.

#### *D. Third Time’s a Charm: The Great Compromise*

When this Comment was written, the ID3PA was the current fashion law legislation. It was proposed in August 2010. At that time, I proposed that lawmakers take a proverbial third whack at the fashion law legislation. Now, just two years later, Congress has done just that with the IDPA. Unfortunately, the IDPA is the ID3PA reincarnated. The ID3PA, and now the IDPA, are not horrible ideas, but the poor construction of the bill hinders the future of fashion design protection. Lawmakers need to carefully review the case law and identify the issues. This approach should be similar to the way in which most, if not all professors, teach in law school—by issue spotting. The problem is not that we need a blanket exception for protecting fashion design under copyright law, or even trademark law for that matter. History has shown that design protection is not necessary for success within the fashion world. Nevertheless, a compromise may be in order to satisfy all parties. Below, I propose and provide solutions for the three major issues that concern fashion designers.

##### 1. Issue One: Knock-Offs

The first observation I have noted as the most prevalent issue, is the lighting speed at which knock-offs travel. Though burdensome, knock-offs hitting the streets before the models step foot off the runway is a solvable problem. I propose that fashion designers be provided with a

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96. *Wal-Mart, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000) (Wal-Mart contracted with designer to produce designs similar to those of the Samara Brothers designs. Once complete, Wal-Mart briskly sold the so-called knockoffs, generating more than \$1.15 million in gross profits. Jury found in favor of Samara on all of its claims).

97. *Id.* at 216.

98. Oral Argument of Justice Scalia, *Wal-Mart, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (No. 99-150), available at [http://www.oyez.org/cases/1990-1999/1999/1999\\_99\\_150](http://www.oyez.org/cases/1990-1999/1999/1999_99_150).

short window of time in which their designs cannot be replicated. This will give designers enough time to debut and distribute their collections to the market. The question then becomes one of time. How much time is appropriate to effectively satisfy or implement this solution? As we saw in the Scafidi Bloomberg Law Podcast,<sup>99</sup> fashion works on a six-month system. Designs hit the runway the season before they are distributed. Therefore, I propose that six, maybe seven months will suffice—a notable difference from the proposed three years that the ID3PA is seeking. The bottom line is that fashion designs limited from public exposure for three years will not be fashionable once available to the masses.

## 2. Issue Two: Department Stores

The second issue is the frequency at which “counterfeit couture” is sold by large chain department stores. Again, this is a fixable problem. I propose that these large chain department stores be required to obtain a license to re-make and distribute the fashion designers’ cost efficient fashionable knock-offs. Supporter of the ID3PA, Susan Scafidi, touches on the idea of licensing in passing in her 2010 blog post.<sup>100</sup> She proposes that the ID3PA will force designers to enter licensing agreements, stating the ID3PA “will force former copyist[s] to . . . at least sign licensing agreements—meaning more jobs for designers and more affordable clothing for consumers.”<sup>101</sup> I completely agree with Professor Scafidi that licensing would be a step in the correct direction. Nevertheless, I cannot agree that the ID3PA is necessary to achieve such a resolution. The bottom line is that a store like Forever 21 could be paying fashion designers to produce and distribute the copied designs that drape their racks. Maybe then, the quality of clothing would be better and this would certainly curb the massive amounts of litigation against the store.

## 3. Issue Three: If It’s Not Broke, Don’t Fix it

Finally, and admittedly my favorite option, is to do nothing. Not much more explanation is needed here. Throughout this Comment, I have provided numerous reasons and justifications for leaving the current state, or lack of, fashion design protection as is. Persuasive arguments exist as to why we simply do not need protection. First, there is nothing to protect and providing a solution to a non-existing problem is impossible. Second, because there is nothing to protect, frivolous

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99. Scafidi podcast, *supra* note 56.

100. *Fashion Copyright*, *supra* note 87.

101. *Id.*

litigation is inevitable. Finally, facts do not lie; history proves that innovation and creativity thrive in the free fashion culture for which America is legendary.

#### CONCLUSION

The ID3PA is unnecessary because since the beginning of time, the American fashion industry has thrived in a world of relaxed copying laws. Arguably, this is the reason the American fashion industry is so profitable. Because of copying, the latest styles are not restricted to the wealthy. Indeed, copying has played a major role in democratizing fashion. As a result, there is no shortage of innovation in the United States fashion industry. Fashion design legislation would undoubtedly be the responsible party for such a drought. Even with the additional provisions, the ID3PA and the IDPA still serve to offer copyright protection to a form of art that thrives on creativity and innovation as well as copying. In the world of fashion, the next big fashion trend will always be last season's dress with a fancy new belt.

ASHLEY MARSHALL\*

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\* I want to thank my friends and family for supporting me in every aspect of my life. Special thanks to my mother, Janice E. Marshall, who taught me at a very young age that the word "failure" did not belong in my vocabulary. Ashley Marshall was a member of the Marquette University Law School Class of 2012.