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A Sui Generis System of Protection for Exceptionally Original Fashion Designs

Cover Page Footnote

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A SUI GENERIS SYSTEM OF PROTECTION FOR EXCEPTIONALLY ORIGINAL FASHION DESIGNS

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Despite the robust nature of the fashion industry, which has been largely unprotected by copyright, there is a clamor among certain sectors for stronger protection for fashion designs and the apparel manufactured from these designs. This article acknowledges that full-dress copyright protection is unnecessary, impracticable, and harmful; however, it proposes a middle-ground: a sui generis system of protection that only protects fashion designs and pieces of apparel that are exceptionally original, and does so only against other articles that are substantially identical.

This article provides a standard (“exceptionally original”) that will protect a fashion design only if it meets certain elements. It is argued that the “exceptionally original” standard, being so restrictive, will only protect a limited and select group of designs, and the proposed standard of infringement, being so high, would only prohibit slavish copies. This level of protection and high legal standard for infringement would encourage designers to be more innovative; it will make it easier for triers of fact to identify which designs are truly innovative (and thus deserving of being covered by the proposed sui generis system of protection); and most importantly, this high standard for protection and corresponding high standard for infringement will not chill creativity, since this sui generis system would only bring outside of the public domain a small, select, and exceptional class of designs.

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I. INTRODUCTION

The global apparel market was valued at US \$1.7 trillion in 2012 and employs approximately 75 million people.¹ In the United States alone, 280,000 fashion retail outlets, 3 million apparel industry workers, and 1 million footwear industry workers contributed to US \$361 billion in retail sales in 2013.² On average, every American in the United States that year spent \$1,141 on more than 64 garments.³ It is difficult to undervalue the significance of fashion apparel as a global economic force.

The fashion industry produces “a huge variety of creative goods in markets larger than those for movies, books, music, and most scientific innovations, and does so without strong [intellectual property] protection.”⁴ As this article will show, the laws on copyright, trademark, trade dress, and patent provide various forms and some amount of protection for different aspects of fashion design and apparel.⁵ Nevertheless, a debate still exists within the fashion industry and among legal scholars as to whether fashion design and apparel should be given full-dress copyright protection.

The debate over copyright protection for fashion designs and apparel did not start recently. Legislation to extend copyright protection to fashion design was proposed as early as 1914.⁶ “In 1930, the House of Representatives passed the Design Copyright Bill, which would have provided protection for dressmakers as well as designers of other useful

1. *Global Fashion Industry Statistics*, FASHION UNITED, <http://www.fashionunited.com/global-fashion-industry-statistics-international-apparel> [<http://perma.cc/47JJ-34BR>].

2. *Id.*

3. *Id.*

4. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1689 (2006).

5. For purposes of this article, “fashion design” shall be defined as “the appearance as a whole of an article of apparel, including its ornamentation,” and “apparel” shall mean “an article of . . . clothing, including undergarments, outerwear, gloves, footwear, and headgear; handbags, purses, wallets, tote bags, and belts; and eyeglass frames,” as lifted from the Innovative Design Protection Act of 2012, S. 3523, 112th Cong. § 2(a)(2) (2012).

6. Aleksandra M. Spevacek, Comment, *Couture Copyright: Copyright Protection Fitting for Fashion Design*, 9 J. MARSHALL REV. INTELL. PROP. L. 602, 612 (2009).

articles.”⁷ However, the Design Copyright Bill was never enacted.⁸ In 1962, 1963, and 1965, design protection bills that proposed protection for “original ornamental designs of useful articles” failed to pass in the House.⁹ The final version of the 1976 Copyright Act did not add design protection, with the House concluding that design protection would be better addressed separately.¹⁰ The 1980s saw the failure of the Industrial Innovation and Technology Act of 1987, the Industrial Design Anti-Piracy Act of 1989, and the Design Protection Act of 1989 due to fears of increased litigation and consumer harm.¹¹

The twenty-first century saw a new wave of proposals to extend protection to fashion design and apparel. In 2006 came House Bill 5055 to amend title 17 of the United States Code to provide protection for fashion design (“H.R. 5055”). H.R. 5055 was the foundation for later versions of similar bills,¹² the most recent of which will be discussed in more detail below. In 2007, the Design Piracy Prohibition Act (“DPPA”) was introduced.¹³ In 2009, DPPA was re-introduced as House Bill 2196, followed by the introduction of Senate Bill 3728, the Innovative Design Protection and Piracy Prevention Act (“IDPPPA”).¹⁴ As described by one commentator, the similarities between the DPPA and the IDPPPA are as follows:

7. Lisa J. Hedrick, Note, *Tearing Fashion Design Protection Apart at the Seams*, 65 WASH. & LEE L. REV. 215, 234 (2008).

8. *Id.* at 235.

9. *Id.* (citing S. REP. NO. 94-473, at 49 (1975)) (referring to the passage of Senate Bill 1884 in 1962, Senate Bill 776 in 1963, and Senate Bill 1237 in 1965).

10. *Id.* (citing *A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. On Courts, the Internet, and Intellectual Property of the H. Comm. On the Judiciary*, 109th Cong. 198–99 (2006)) (opening statement of Rep. Howard L. Berman, Ranking Member, Subcomm. On Courts, the Internet, and Intellectual Property) (stating that copyright revisions were enacted in October 1976 without design protection).

11. *Id.* at 235–36.

12. Sara R. Ellis, Comment, *Copyrighting Couture: An Examination of Fashion Design Protection and Why the DPPA and IDPPPA are a Step Towards the Solution to Counterfeit Chic*, 78 TENN. L. REV. 163, 182 (2010).

13. *Id.* at 183 (citing H.R. 2033, 110th Cong. (2007)).

14. *Id.* at 184 (citing H.R. 2196, 111th Cong. (2009); S. 3728, 111th Cong. (2010)).

Both bills would make the necessary addition of “an article of apparel” under the definition of useful articles in Chapter 13 [of] the Copyright Act. The bills would amend § 1301(a)(3) of the Copyright Act to include fashion as a protected category under the *sui generis* design protection located in Chapter 13 of the Copyright Act, a section of the Copyright Act currently limited to protecting boat hull design. In determining whether a design could obtain protection, each fashion design would be considered as a whole and would only include the original elements and their placement “in the overall appearance of the article of apparel”

The revisions are fairly comprehensive, defining apparel as: “(A) an article of men’s, women’s, or children’s clothing, including undergarments, outerwear, gloves, footwear, and headgear; (B) handbags, purses, wallets, duffel bags, suitcases, tote bags, and belts; and (C) eyeglass frames.” This list expands upon previous bills, which only listed “handbags, purses, and tote bags” as the types of carrying cases that would be protected.¹⁵

Perhaps the most significant addition proposed by the IDPPPA is the originality requirement, requiring that the elements of the design “(i) are the result of a designer’s own creative endeavor; and (ii) provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.”¹⁶ The IDPPPA also provides a rule of construction, specifically that “differences or variations which are considered non-trivial for the purposes of establishing that a design is subject to protection . . . shall be considered non-trivial for the purposes of establishing that a defendant’s design is not substantially identical,” to guide in the determination of the existence of infringement.¹⁷

With the above-mentioned proposals also failing enactment, the Innovative Design Protection Act of 2012 (“IDPA”), introduced during the 112th Congress, is the latest piece of legislation that tried, and similarly

15. *Id.* at 196–97 (footnotes omitted).

16. *Id.* at 197 (citing S. 3728, 111th Cong. § 2(a)(2) (2010)).

17. *Id.* at 198 (citing S. 3728, 111th Cong. § 2(a)(3) (2010)).

failed, to extend protection to fashion design and apparel.¹⁸ Its salient provisions propose the following additions to section 1301:

“(8) A ‘fashion design’—

“(A) is the appearance as a whole of an article of apparel, including its ornamentation; and

“(B) 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 that—

“(i) are the result of a designer’s own creative endeavor; and

“(ii) provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.¹⁹

....

“(10) The term ‘apparel’ means—

“(A) an article of men’s, women’s, or children’s clothing, including undergarments, outerwear, gloves, footwear, and headgear;

“(B) handbags, purses, wallets, tote bags, and belts; and

“(C) eyeglass frames.²⁰

“(11) In the case of a fashion design, the term ‘substantially identical’ means an article of apparel which is so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial.”; and²¹

....

“(c) RULE OF CONSTRUCTION.—In the case of a fashion design under this chapter, those differences or variations which are considered non-trivial for the purposes of establishing that a design is subject to protection under subsection (b)(8) shall be considered non-trivial for the purposes of establishing that a

18. Innovative Design Protection Act of 2012, S. 3523, 112th Cong. § 2(a)(2) (2012).

19. *Id.*

20. *Id.*

21. *Id.*

defendant's design is not substantially identical under subsection (b)(11) and section 1309(e)."²²

A reading of the above-cited provisions of the IDPA might lead one to think that it is simply too narrow—it would be very difficult to create a fashion design or piece of apparel that would merit protection under it. However, this article, among other things, aims to show that this characteristic is perhaps the IDPA's strength.

This article has three parts. Part II of this article shows the interaction between fashion design and the current IP Law system. It illustrates which aspects of fashion design and apparel are protected and which are not. Part III articulates why it is not necessary, beneficial, and practicable to give full-dress copyright protection to fashion. Part IV proposes a middle ground between full-dress copyright protection and the status quo: *a sui generis system that will protect only those fashion designs and pieces of apparel that are "exceptionally original."* This part will (1) define the term "exceptionally original" and present factors that can be used to determine whether a piece of apparel will fall within this definition; (2) provide a standard for infringement and show why this standard is appropriate; and (3) argue why pieces of apparel that are "exceptionally original" should be protected. Part V provides a brief conclusion.

II. FASHION DESIGN AND THE CURRENT INTELLECTUAL PROPERTY LAW REGIME

A. The Constitution

The "Intellectual Property Clause" of the United States Constitution states that Congress shall have the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."²³ This clause is the constitutional basis for the system of patents and copyrights, while the Commerce Clause²⁴ is the foundation for trademark regulation.²⁵

22. *Id.* § 2(a)(3).

23. U.S. CONST. art. 1, § 8, cl. 8.

24. U.S. CONST. art. 1, § 8, cl. 3.

25. *Intellectual Property*, LEGAL INFORMATION INSTITUTE, http://www.law.cornell.edu/wex/intellectual_property [<http://perma.cc/G885-6VBX>].

In general, the purpose of intellectual property (“IP”) law is to provide “an incentive to authors and inventors to produce works for the benefit of the public by regulating the public’s use of such works in order to ensure that authors and inventors are compensated for their efforts.”²⁶

B. Patent

In fulfillment of its constitutional mandate, patent law “offers the possibility of a limited period of exclusive rights to encourage research and development aimed at discovering new processes, machines, and compositions of matter, and improvements thereof.”²⁷ To obtain a utility patent, an invented article must meet five requirements: it must be a patentable subject matter, useful, novel, nonobvious, and its disclosure must be sufficient to enable others skilled in the art to make and use the invention.²⁸

More appropriate to fashion design is the system of design patents, because it protects the “aesthetic appearance of a product rather than its functional features.”²⁹ A design is patentable if it is novel, original, nonobvious, ornamental, and is not dictated by functional considerations.³⁰

“It has been extremely difficult, however, for clothing designers to obtain design patents because apparel designs — though ornamentally different from one era to another — rarely merit patent protection.”³¹ First, the requirements of novelty and nonobviousness are particularly difficult to meet, because “few elements of clothing design . . . are novel and nonobvious enough to be distinguishable from previous types of clothing.”³² For instance, the peplum skirt trend of Spring/Summer 2012 is actually a

26. *Id.*

27. ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 29 (6th ed. 2012).

28. *Id.*

29. *Id.* at 421.

30. *Id.* at 422.

31. Christine Cox & Jennifer Jenkins, *Between the Seams, A Fertile Commons: An Overview of the Relationship Between Fashion and Intellectual Property*, NORMAN LEAR CTR. 11 (Jan. 29, 2005), <http://learcenter.org/pdf/RTSJenkinsCox.pdf> [<http://perma.cc/9CDW-ZA3D>].

32. *Id.*

throwback to a 1980s skirt trend, when both frills and cinched waists were in vogue.³³ In turn, this fashion movement was a rebirth of a particular look from the 1940s, when small waists and full hips were accentuated by flared ruffles attached to bodice or jacket waists.³⁴ However, a review of some dresses from the 1870s to the 1880s would also show the presence of overskirts attached to dress or jacket waists, seemingly used to achieve an exaggerated feminine figure.³⁵ This demonstrates the difficulty in conceiving a truly novel and nonobvious fashion design and shows the cyclical nature of trends.

Second, “design patent protection issues [arise] only when the design is not dictated by the function of the product and is primarily ornamental.”³⁶ It would be very challenging for fashion designs and pieces of apparel to fulfill this requirement, as “it is difficult to separate design from function in the clothing context.”³⁷ Combine these two hurdles with a “lengthy processing time, high application cost, strict requirements that are vague and difficult to apply, and a long history of judicial hostility,”³⁸ and it can then be concluded that the system of design patents provides little protection to fashion design and pieces of apparel.

C. Trademark

The federal trademark statute, otherwise known as the Lanham Act, “protects words, symbols, and other attributes that serve to identify the nature and source of goods or services.”³⁹ The identifying mark, however, must serve an exclusively identifying purpose and cannot be a functional element of the product itself.⁴⁰ An important purpose of trademarks is to protect the consumer by identifying the source of the product he or she is

33. *See infra* Appendix A.

34. *See infra* Appendix A.

35. *See infra* Appendix A.

36. Cox & Jenkins, *supra* note 31, at 11.

37. *Id.*

38. MERGES ET AL., *supra* note 27, at 421.

39. *Id.* at 30.

40. *Id.*

purchasing.⁴¹ Historically, and as applied to modern practice, trademarks have served as a form of advertising; a trademark displayed on a good is an indication to the consumer that the good comes from a particular merchant, and it is also a guarantee of a certain level of quality.⁴²

Counterfeit articles bearing logos, distinctive prints, and names of famous fashion houses are sold around the world at a small fraction of the price of their genuine counterparts; hence, protection against trademark infringement is an ongoing concern for numerous fashion companies.⁴³ Apart from these identifying marks, certain elements of clothing design also serve as source-identifiers of pieces of apparel.⁴⁴ Levi Strauss, for instance, “has a registered trademark in the stitching pattern on the back pocket of its jeans, and successfully has prevented other jean manufacturers from using confusingly similar patterns.”⁴⁵ However, Levi Strauss’s trademark protection only extends to its distinct stitching pattern visible on its jean back pockets, and not to the design of the pants themselves.⁴⁶ This shows that while trademark law serves to protect consumers against confusion brought about by counterfeit articles, “it is not a useful tool to protect clothing designs per se.”⁴⁷

D. Trade Dress

The Lanham Act also protects “trade dress,” which is “the design and packaging of materials, and even the design and shape of a product itself, if the packaging or the product configuration serve the same source-identifying function as trademarks.”⁴⁸

However, in 2000, the Supreme Court denied trade dress protection to clothing designs in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*⁴⁹ This

41. Cox & Jenkins, *supra* note 31, at 12.

42. See MERGES ET AL., *supra* note 27, at 763.

43. See Cox & Jenkins, *supra* note 31, at 13.

44. *Id.* at 14.

45. *Id.*

46. *Id.*

47. *Id.*

48. MERGES ET AL., *supra* note 27, at 774.

49. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

case involved a clothing manufacturer that sued Wal-Mart over the sale of knockoff one-piece seersucker children's outfits. As IP scholars Christine Cox and Jennifer Jenkins succinctly summarized:

The Court held that the outfits were not protected by trade dress law, and confirmed that product designs are only protectable if they acquire secondary meaning as a trademark, such that "in the minds of the public, the primary significance of a [product design] is to identify the source of the product rather than the product itself." Fashion designs rarely will have secondary meaning because they are not intended to identify the source of the product, but instead aim to make the product more useful or appealing. In addition, most fashion designs would be too short-lived to achieve secondary meaning. The Court maintained this high threshold for trade dress protection in order to benefit both competition and consumers, stating that "[c]onsumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves."⁵⁰

A federal court applied the *Wal-Mart* holding in a case about purses.⁵¹ Design house Louis Vuitton alleged that the "It Bag" produced by Dooney & Bourke, which also had multi-colored two-letter monograms against a white or black background, infringed its trade dress in similar looking bags.⁵² "The court held that, while Vuitton had trademark rights in the Vuitton marks themselves, it did not have trade dress rights in the overall look of its bags."⁵³ The court was concerned that if Louis Vuitton had succeeded, "it will have used the law to achieve an unwarranted anticompetitive result. It is well established that the objective of trademark law is *not* to harm competition."⁵⁴

50. Cox & Jenkins, *supra* note 31, at 15 (footnotes omitted).

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

52. *Id.*

53. *Id.*

54. *Louis Vuitton Malletier*, 340 F. Supp. 2d at 420.

E. Copyright

Copyright law protects artistic expression in works such as music, films, paintings, photographs, sculptures, and books.⁵⁵ The elements necessary for a work to receive copyright protection are (1) originality; (2) fixation in a tangible medium of expression; and (3) authorship.⁵⁶ “While U.S. copyright law protects ‘applied art,’ such as artistic jewelry, patterns on dinnerware or tapestries, it does not protect ‘useful articles,’ such as automobiles or television sets that, while attractively shaped, are primarily functional.”⁵⁷ A “useful article” is an “article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁵⁸

Because clothes are considered useful articles, they are currently not protected by copyright laws.⁵⁹ However, copyright law does protect aesthetic elements of a useful article, such as clothing, “only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”⁶⁰

Mazer v. Stein elucidated upon the concept of separability.⁶¹ There, the U.S. Supreme Court held that “Balinese statuettes that formed the bases of lamps were copyrightable because the aesthetic work in question (a statuette) was separable from the useful article (a lamp).”⁶²

After *Mazer*’s “physical separability,” the notion of “conceptual separability” was later brought to light in *Kieselstein-Cord v. Accessories by Pearl, Inc.*⁶³ In *Kieselstein-Cord*, the Court of Appeals for the Second Circuit held that the “separability standard does not require ‘physical’

55. 17 U.S.C. § 102(a) (2012).

56. *Id.*

57. Cox & Jenkins, *supra* note 31, at 7.

58. 17 U.S.C. § 101 (2012).

59. MERGES ET AL., *supra* note 27, at 491–92.

60. *Id.*

61. See *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

62. *Id.* At 218.

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

separability but may also include ‘conceptual’ separability.”⁶⁴ Conceptual separability allowed the court to differentiate between the aesthetic design of the artful belt buckles subject of the litigation and their utilitarian function.⁶⁵ This led the court to conclude that the conceptually separable artistic elements of the belt buckles should be given copyright protection.⁶⁶

Overall, fashion design and pieces of apparel only receive little protection from copyright. While elements such as distinct patterns and prints on fabric surfaces,⁶⁷ along with a few articles of fashion such as the above-mentioned belt buckle, plastic swimsuits filled with crushed rock,⁶⁸ and unwieldy costumes,⁶⁹ are covered by this system of intellectual property, “the design of clothing itself generally is considered ineligible for copyright protection because it is extremely difficult to separate the artistic from the functional elements.”⁷⁰

III. WHY FASHION, IN GENERAL, SHOULD NOT BE GIVEN FULL-DRESS COPYRIGHT PROTECTION

Despite the fact that, as demonstrated above, the fashion industry operates in a “low-IP equilibrium” (meaning that the core forms of IP law—copyright, trademark, and patent—provide very limited protection for fashion design), this level of protection is politically stable.⁷¹ This regime of low-IP protection has remained unaltered for six decades.⁷² Perhaps it is because, among other things, IP law, especially trademark in particular, already shields against the most pernicious type of copying, i.e.,

64. Cox & Jenkins, *supra* note 31, at 8 (citing *Kieselstein-Cord*, 632 F.2d at 993).

65. *Id.*

66. *Id.*

67. *See, e.g.*, *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 492 (6th Cir. 2015).

68. *See Poe v. Missing Persons*, 745 F.2d 1238, 1241 (9th Cir. 1984).

69. *See Nat’l Theme Prods., Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1350 (S.D. Cal. 1988).

70. Cox & Jenkins, *supra* note 31, at 10 (citing 1-2 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.08).

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

72. *Id.*

counterfeiting.⁷³ Further, copyright law as it now stands already protects a significant aspect of artistry present in fashion: pictorial illustrations, graphics, prints on fabric and clothing surfaces, and articles that qualify as “applied art,” namely pieces of jewelry and other accessories.⁷⁴

Economically, a low-IP equilibrium has not harmed the fashion industry. As professors and IP scholars Kal Raustiala and Christopher Sprigman have observed, fashion is empirically anomalous: it is “a global industry that produces a huge variety of creative goods in markets larger than those for movies, books, music, and most scientific innovations, and does so without strong IP protection.”⁷⁵ Indeed, “[d]espite the lack of intellectual property protection for fashion, style houses continue to make money, and designers continue to develop new looks every season. Creativity thrives in the absence of intellectual property protection.”⁷⁶ It is doubtful, as argued by Raustiala and Sprigman,⁷⁷ that statutory change will improve the fashion industry’s performance because the fashion industry is already very creative and innovative.

Despite a low-IP equilibrium, fashion has remained to be a growing multibillion dollar industry, and the creative minds behind this industry do not cease to launch new collections and designs season after season.⁷⁸ Also, new designers and companies continuously enter the industry, infusing it with youth and innovation.⁷⁹ It seems that a major purpose of intellectual property law, which is to provide incentive to individuals “to produce works for the benefit of the public,”⁸⁰ remains fulfilled in the fashion industry

73. See Christine Cox & Jennifer Jenkins, *Between the Seams, A Fertile Commons: An Overview of the Relationship Between Fashion and Intellectual Property*, NORMAN LEAR CTR. 14 (Jan. 29, 2005), <http://learcenter.org/pdf/RTSJenkinsCox.pdf> [<http://perma.cc/9CDW-ZA3D>].

74. *Id.* at 7.

75. Raustiala & Sprigman, *Piracy Paradox*, *supra* note 71, at 1689.

76. Cox & Jenkins, *supra* note 73, at 5.

77. Raustiala & Sprigman, *Piracy Paradox*, *supra* note 71, at 1744.

78. *Id.* at 1689, 1693, 1699.

79. See Kal Raustiala & Christopher Sprigman, Response, *The Piracy Paradox Revisited*, 61 STAN. L. REV. 1201, 1221 (2009) [hereinafter Raustiala & Sprigman, *Paradox Revisited*] (“Even a cursory look at the fashion industry will reveal thousands of new and young designers competing for their place in the industry, seemingly undeterred by the prevalence of fashion copying—and, often, engaging in it.”).

80. *Intellectual Property*, LEGAL INFORMATION INSTITUTE, http://www.law.cornell.edu/wex/intellectual_property [<http://perma.cc/G885-6VBX>]. See

despite the lack of full-dress copyright protection.⁸¹ “The important point here is that all of the fashion industry’s growth and innovation has occurred without any intellectual property protection in the U.S. for its designs.”⁸²

Raustiala and Sprigman’s “induced obsolescence” theory provides great insight as to why full-dress copyright protection is not necessary for the fashion industry.⁸³ The theory supports the proposition that despite a low-IP equilibrium, there exists great incentive to continually create new fashion designs.⁸⁴ This theory, simply put, proposes that “copying helps to diffuse designs into the mainstream, where they lose their appeal for fashion cognoscenti.”⁸⁵ Further, “[t]he desire for new designs is ‘induced’ by this process.”⁸⁶ Since copying “erodes the positional qualities of fashion goods,” designers are driven to respond with new designs.⁸⁷ In addition, this system of copying, referencing, or appropriation “contributes to the rapid production of substantially new designs that were creatively inspired by the original.”⁸⁸ The multitude of variations resulting from this process, according to Raustiala and Sprigman, “contributes to product differentiation that induces consumption by those who prefer a particular variation to the original.”⁸⁹ This shows that there exists an incentive to create new fashion designs, as

generally ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* (6th ed. 2012).

81. Raustiala & Sprigman, *Paradox Revisited*, supra note 79, at 1203.

82. See *Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. 85–87 (2006), <http://www.gpo.gov/fdsys/pkg/CHRG-109hhrg28908/html/CHRG-109hhrg28908.htm> [<http://perma.cc/2G8R-7YMJ>] (statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (arguing that protection for fashion design is not needed because copying does not cause harm to the fashion industry, protection in Europe has had little effect, and protection will cause excessive litigation).

83. Raustiala & Sprigman, *Paradox Revisited*, supra note 79, at 1203.

84. *Id.*

85. *Id.*

86. *Id.*

87. Raustiala & Sprigman, *Piracy Paradox*, supra note 71, at 1722.

88. *Id.* at 1724.

89. *Id.*

well as articles inspired by the originals, despite a lack of full-dress copyright protection.⁹⁰

An economically robust fashion industry, existing measures that protect artistry in fashion design, a law that punishes counterfeiting, and the constant incentive to create new fashion designs lead to the conclusion that full-dress copyright protection is unnecessary for the fashion industry. Despite a low-IP equilibrium, the prime objective of intellectual property law—incentivizing individuals to create new works for the benefit of the public—remains accomplished.⁹¹

As previously explained, however, the fact that a piece of apparel is a useful article makes it impracticable for fashion design to be subsumed within the present scheme of copyright law.⁹² In addition, the requirement of originality poses a significant problem.⁹³ For a work to be protected by current copyright laws, it must exhibit a modicum of originality.⁹⁴ Yet “finding and defining originality in fashion is an extremely difficult, if not impossible, task.”⁹⁵ So much of fashion is derivative and is inspired by articles that have been previously designed and created.⁹⁶ It is an art and a craft that involves the use of the same materials, tools, concepts, and ideas throughout the decades, making it difficult for a designer to create something that has not been done in a similar way before.⁹⁷

The difficulty in determining whether a piece of apparel meets the Copyright Act’s standard for originality proves to be a challenge in enforcing copyrights. “If a court cannot determine the originality, then how could it fairly determine whether one design infringes upon another, or whether a design is substantially similar or whether a design is sufficiently original to qualify for copyright protection?”⁹⁸

90. *See id.*

91. Raustiala & Sprigman, *Paradox Revisited*, *supra* note 79, at 1203.

92. Cox & Jenkins, *supra* note 73, at 6.

93. *Design Piracy Prohibition Act*, *supra* note 82, at 13 (testimony of David Wolfe, Creative Director, The Doneger Group).

94. MERGES ET AL., *supra* note 80, at 29.

95. *See Design Piracy Prohibition Act*, *supra* note 82, at 13 (testimony of David Wolfe, Creative Director, The Doneger Group).

96. *See id.*

97. *See id.*

98. *Id.*

Hence, the useful article doctrine and the requisite element of originality for copyright protection reinforces the assertion that the current copyright statute is unsuitable for fashion design.

Moreover, giving full-dress copyright protection to a large body of fashion design is not beneficial to the industry because it would foster a highly litigious environment, with cases largely focused on whether a certain article is substantially similar to another such that it results in infringement.⁹⁹ “Drawing the line between inspiration and copying in the area of clothing is very, very difficult and likely to consume substantial judicial resources.”¹⁰⁰ At a significant disadvantage will be the young, innovative designers and small fashion companies who do not have the resources to support a staff of litigators tasked to fend off charges of infringement.¹⁰¹

With a considerably diminished public domain and constant threat of litigation comes the chilling effect on creativity.¹⁰² Sources of inspiration that were previously freely available for designers could likely become sources of liability if a certain designer is accused of creating an article substantially similar to the piece of apparel that inspired him or her.¹⁰³ Giving full-dress copyright protection to numerous kinds of apparel and fashion designs will give designers a monopoly over a concept or idea—most likely a concept or idea not even truly originated by him or her, but derived from an existing article long in the public domain, such as a cut of a pant leg, a silhouette of a dress, or a shape of a sleeve.¹⁰⁴

Indeed, “[t]he denial of copyright protection in fashion effectively has prevented monopolistic or oligopolistic control.”¹⁰⁵ “Legislators and judges

99. *Id.* at 87 (statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law).

100. *Id.*

101. *Design Piracy Prohibition Act*, *supra* note 82.

102. *See id.*

103. *See id.*

104. *See* George B. Sproles, *Analyzing Fashion Life Cycles: Principles and Perspectives*, 45 J. MKTG. 116, 116–17 (1981) (describing the cyclical nature of fashion—introduction and adoption by fashion leaders, increasing public acceptance (growth), mass conformity (maturation), and inevitable decline and obsolescence—and predicting how new fashions “represent relatively small styling changes rather than revolutionary or visually dramatic changes from the recent past”).

105. Aram Sinnreich & Marissa Gluck, *Music & Fashion: The Balancing Act Between Creativity and Control*, NORMAN LEAR CTR. 25 (Jan. 29, 2005), <http://learcenter.org/pdf/RTSSinnreichGluck.pdf> [<http://perma.cc/F6LS-T3J8>].

consistently have concluded that the public interest would be served best by denying copyright protection to designers, in effect promoting the free exchange of fashion ideas among a broad community of participants.”¹⁰⁶

The Register of Copyrights explained three potential anti-competitive effects of extending copyright to utilitarian objects in *Esquire, Inc. v. Ringer*:

First, in the case of some utilitarian objects, like scissors or paper clips, shape is mandated by function. If one manufacturer were given the copyright to the design of such an article, it could completely prevent others from producing the same article. Second, consumer preference sometimes demands uniformity of shape for certain utilitarian articles, like stoves for instance. People simply expect and desire certain everyday useful articles to look the same particular way. Thus, to give one manufacturer the monopoly on such a shape would also be anticompetitive [sic]. Third, insofar as geometric shapes are concerned, there are only a limited amount of basic shapes, such as circles, squares, rectangles and ellipses. These shapes are obviously in the public domain and accordingly it would be unfair to grant a monopoly on the use of any particular such shape, no matter how aesthetically well it was integrated into a utilitarian article.¹⁰⁷

As applied to pieces of apparel, shirt sleeves, pant legs, shoe shapes, skirt silhouettes, and so on are all primarily mandated by function—specifically, whether the cloth would fit the part of the anatomy it is meant to cover. Consumer preference, trends, and the market would also determine whether this season’s pants would have a wide leg or a skinny leg; whether skirts would be predominantly A-line or pencil; whether the stylish heel is chunky or stiletto; whether a purse is rectangular and structured or round and soft.¹⁰⁸ Despite the creativity of fashion designers, there are still a limited

106. *Id.*

107. *Esquire, Inc. v. Ringer*, 591 F.2d 796, 801 n.15 (D.C. Cir. 1978) (citing Brief for Appellant at 18–19, *Esquire*, 591 F.2d 796 (No. 76-1732); Note, *Protection for the Artistic Aspects of Articles of Utility*, 72 HARV. L. REV. 1520, 1532 (1959)).

108. See generally Susan O. Michelman, *Reveal or Conceal? American Religious Discourse with Fashion*, 16 FASHIONS & HYPES 76 (2003) (examining how religious views on the body can dictate societal standards of modesty and propriety, thereby influencing consumer fashion); Sproles, *supra* note 104, at 118–21 (discussing major competing perspectives of how consumers determine the course of new trends: upper class leadership theory, mass market theory, subcultural innovation theory, and the collective selection theory); James Laver, *Fashion and War*, 92 J. ROYAL SOC’Y ARTS 303, 303 (1944) (“The common view is that the cut of a dress, the shape

amount of basic shapes and silhouettes appropriate for clothing and apparel. To award a monopoly to a limited number of designers on the use of these basic shapes and silhouettes, whether as individual elements or combined in a single piece, would be to deprive others of the right to use them to create more works.

Granting full-dress copyright protection to fashion design would also drive up the prices of pieces of apparel. “Designers could demand payment for design elements that currently are free, and this cost would be borne by others in the industry and by the public.”¹⁰⁹ Moreover, the legal costs incurred due to avoiding infringement liability, or pursuing claims of infringement, would inevitably be passed on to consumers.¹¹⁰

IV. THE PROPOSAL: A POSSIBLE COMPROMISE OR MIDDLE GROUND

A. Pieces of Apparel that are “Exceptionally Original” Should be Given Sui Generis Protection

While current copyright law would require, among other things, originality for a work to be given protection, it is proposed that sui generis protection be extended to fashion design only if it possesses “exceptional originality.”¹¹¹ “As developed by the courts, originality entails *independent creation* of a work reflecting a *modicum of creativity*,”¹¹² and this threshold of creativity necessary to merit protection is quite low. Copyright law does not require that a work be “strikingly unique or novel. . . . All that is needed . . . is that the ‘author’ contributed something more than a ‘merely trivial’ variation, something recognizably ‘his own.’”¹¹³

of a hat, a waistline high or low, an angle of a feather, or the color of a trimming are things quite arbitrary, decided upon by a small group of designers sitting in Paris, London or New York, and imposed willy-nilly on an unsuspecting and herd-like public. The history of costume confutes this view completely. There is a rhythm in dress, there is a meaning in fashion. The designers only succeed in imposing their ideas if there is a relation between the fashion coming in and the whole consensus of economic, moral, religious and political pressures of the time.”)

109. Cox & Jenkins, *supra* note 73, at 6.

110. 17 U.S.C. § 505 (2012).

111. See *infra* text accompanying notes 115–17.

112. ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 429, 439 (6th ed. 2012).

113. *Id.* (citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102–03 (2d Cir. 1951)).

The problem with applying this low threshold of originality to fashion design is that it would potentially result in too many pieces of apparel being granted protection, thus depriving other designers of a rich public domain from which they could gain inspiration. Also, a low threshold of originality could give designers a monopoly over design elements that they did not independently create or originate. As mentioned above, so much of fashion is the result of the evolution of similar and recurring design elements, such that very little of today's fashion designs can actually be considered truly new.¹¹⁴

Hence, it is proposed that for fashion design to be given sui generis protection, it should possess a higher standard of originality—that of “exceptional originality.” The term “fashion design,” defined:

“(A) is the appearance as a whole of an article of apparel, including its ornamentation; and

“(B) 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 apparel¹¹⁵

Thus, exceptional originality would require that the fashion design is the result of a designer's own creative endeavor and provides a unique, distinguishable, nontrivial and non-utilitarian variation over prior designs for similar types of articles.¹¹⁶ This definition of “exceptional originality” is lifted from the definition of “fashion design” in the Innovative Design Protection Act of 2012.¹¹⁷ It is asserted that this standard of originality is higher than that in the Copyright Act,¹¹⁸ and is narrower in scope, therefore greatly restricting the number of articles it would protect.

Whereas the current generally applicable copyright statute only requires a modicum of creativity, which is just more than a “merely trivial”

114. See *supra* Parts II.B, III (discussing the “novelty” requirement for patent protection and the “originality” requirement for copyright protection, respectively).

115. Innovative Design Protection Act of 2012, S. 3523, 112th Cong. § 2(a)(2) (2012).

116. *Id.*

117. *Id.*

118. Sara R. Ellis, Comment, *Copyrighting Couture: An Examination of Fashion Design Protection and Why the DPPA and IDPPPA Are a Step Towards the Solution to Counterfeit Chic*, 78 TENN. L. REV. 163, 206 (2010).

variation of existing works,¹¹⁹ the standard of exceptional originality would require a “unique, distinguishable, non-trivial and nonutilitarian” variation over prior designs.¹²⁰ The use of the term “unique” would require that the design is the only one of its kind, or is connected with only one particular person.¹²¹ Making the definition apt to the subject matter of apparel, the use of the term “unique” would require that the fashion design is, upon its reduction to a fixed medium with sufficient specificity, the only variation of its kind upon prior designs for similar types of articles, and can be connected only to its designer.

The use of the term “distinguishable” means that the fashion design can be regarded as separate and different.¹²² Applying the term to fashion design, “distinguishable” would have to mean that the fashion design, upon its reduction to a fixed medium with sufficient specificity, can be perceived as separate and different from other variations over prior designs for similar types of articles. “Non-trivial”¹²³ would characterize the variation as one of significant worth. That the variation is non-utilitarian would mean that it merely pertains to the article’s appearance, and not its function. This is in contrast with the Copyright Act’s definition of “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”¹²⁴

In sum, a fashion design is exceptionally original if, upon reduction to a fixed and tangible medium with sufficient specificity, it is the result of a designer’s own creative endeavor; its variation over prior designs for similar types of articles is the only one of its kind; it can only be attributed to the designer; it can be regarded as separate and different; it is significant; and it pertains to the article’s appearance and not its function.

The requirement that the fashion design must be reduced to a fixed and tangible medium with sufficient specificity implies that a reduction to a rough sketch is not enough, because certain details such as material, method

119. 17 U.S.C. § 1301 (2008).

120. Innovative Design Protection Act, *supra* note 115.

121. *Unique*, MERRIAM-WEBSTER.COM, <http://www.merriam-webster.com/dictionary/unique> [http://perma.cc/8CYL-8U5K].

122. *Distinguish*, MERRIAM-WEBSTER.COM, <http://www.merriam-webster.com/dictionary/distinguish> [http://perma.cc/5LBH-QGC2].

123. *Trivial*, MERRIAM-WEBSTER.COM, <http://www.merriam-webster.com/dictionary/trivial> [http://perma.cc/DYP3-Z4F6].

124. 17 U.S.C. § 101 (2012).

of construction, and proportion cannot be easily discernible from a design sketch.¹²⁵ However, reduction to an actual piece of apparel would not be required, for designs and specifications could be misappropriated and the misappropriated design reduced to an actual piece of apparel, to the detriment of the original designer.¹²⁶ Hence, if the fashion design is reduced to a fixed, tangible, sufficiently permanent or stable medium of expression, with specifications as to material, method of construction, proportion, form, or other specifications sufficient for a person having ordinary skill in the art to produce a piece of apparel, the element of fixation for a fashion design should be deemed fulfilled. It is suggested that this more stringent form of fixation is appropriate for fashion design so that designers who merely sketch apparel designs, without providing more technical details, will not be able to gain a monopoly over the concepts embodied in their sketches.

Certain elements of the proposed definition of “exceptional originality” are subjective, and triers of fact would need certain factors with which to evaluate the existence of these elements. The elements that “the design is the result of a designer’s own creative endeavor” and that its variation over prior designs for similar types of articles “is the only one of its kind;” “can only be attributed to the designer;” “can be regarded as separate and different;” and “is significant” should be evaluated using the following four proposed factors.

1. A Negative Test

First, a negative test might prove helpful. The inability of an accused infringer or an expert to identify a prior work that could have just been copied by the original designer is an indication of exceptional originality. If, however, a prior work is shown to have nontrivial, insignificant differences with the subject fashion design, the claim of exceptional originality is negated. For example, using this test, no designer can claim that his or her

125. See Susan Orr & Margo Blythman, *The Process of Design is Almost Like Writing an Essay*, 22 WRITING CENT. J. 39, 49 (2002) (explaining that during the design process, a sketchbook is often used to experiment with creative designs; some of which will be further developed, while others will be abandoned).

126. See Brittany Lamb, Note, *The Federal Government’s Hand-Me-Downs: The Possibility of Protecting Fashion at the State Level*, 115 COLUM. L. REV. 127, 136 (2015) (citing *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 189–90 (S.D.N.Y. 1934)) (“It is undisputed that a *sketch* of a garment design is eligible for copyright protection, but the copyright only extends to the sketch itself and not the garment embodied in the sketch.”); *Unfair Competition—Appropriation of Another’s Labor—Copying of Fashion Designs Actionable on the Ground of Commercial Immorality*, 70 HARV. L. REV. 1117, 1118 (1957) (registering a sketch of a design does not prevent copying from the original garment or a model of the garment).

design for gladiator sandals is exceptionally original, for a perusal of books, paintings, or mosaics depicting ancient Roman apparel would show that gladiators wore footwear bearing a strong resemblance to today's gladiator sandals.¹²⁷ However, the "Scary Beautiful" shoes¹²⁸ created by artist Leanie van der Vyver and Dutch shoe designer René van den Berg, which feature massive front heels that "appear backwards on the foot, so the wearers [sic] feet point straight down the back, as if in ballet shoes, with their shin leaning against the front 'heel' end of the design to balance,"¹²⁹ is arguably a fashion design of exceptional originality. It is doubtful that one in the fashion industry could point to a prior work that could have been the source of this piece of apparel.

2. Expert Testimony

Second, fashion experts would be valuable in exposing prior works that could have been copied by one presenting himself or herself as a designer who created a fashion design of exceptional originality. One with greater industry knowledge and historical insight into the fashion business is better equipped to provide an evaluation as to whether a fashion design is truly original, or whether a variation is not the "only one of its kind."¹³⁰ A fashion expert would be able to say whether a fashion design is innovative, or whether it is a too-close reinterpretation of an article that surfaced at an earlier time or from a region abroad and can actually be attributed to another designer.¹³¹ One who has expertise in making cutting patterns for clothes and purses would be able to tell a jury whether the sewing patterns for a dress which is the subject of litigation contains a significant variation over the

127. See *infra* Appendix B.

128. See *infra* Appendix B.

129. Joanna Douglas, *The Scariest Shoes of All Time*, YAHOO! NZ (Oct. 10, 2012, 12:19 PM) <http://nz.lifestyle.yahoo.com/fashion/a/15080582/the-scariest-shoes-of-all-time/> [http://perma.cc/V7QQ-RC6Y].

130. See generally Lindsay M. King & Russell T. Clement, *Style and Substance: Fashion in Twenty-First-Century Research Libraries*, 31 ART DOCUMENTATION: J. ART LIBRARIES SOC'Y N. AM. 93 (2012) (reviewing the last decade's surge in fashion-related scholarship and research).

131. See, e.g., Victoria L. Rovine, *FIMA and the Future of African Fashion*, 43 AFR. ARTS 1 (2010) (commenting on African fashion designers in global markets and the influence of African forms on Western fashion designers, past and present); James Laver, *Fashion and War*, 92 J. ROYAL SOC'Y ARTS 303, 303 (1944) (speaking as a "well-known expert" on nineteenth-century costume).

sewing patterns for a dress claimed to have been copied.¹³² Though not always conclusive, expert testimony is a useful tool in evaluating details that might be missed by the untrained eye.¹³³

3. The Ordinary Consumer's Perspective

Third, the perspective of the ordinary consumer should be weighed alongside that of the expert witness. The ordinary consumer drives the market for apparel; accordingly, his or her opinion as to whether an article is exceptionally original should also be considered.¹³⁴ Also, if the ordinary consumer would prefer a copy because of its lower price over the original, that preference can indicate commercial harm.¹³⁵ If an ordinary buyer of purses can say, for example, that a variation made in a Gucci bag released during the Fall/Winter season of 2013 can actually be attributed to a variation undertaken by Chanel during the Spring/Summer season of 2009, that observation is a strong indication against exceptional originality.

4. Awards and Recognition

Fourth, the awards received by the designer for producing a particular piece of apparel may also be a factor in determining whether the fashion design is of exceptional originality. The weight to be given to this factor may be similar to that given to expert opinions. If a piece of apparel is lauded for characteristics echoing the elements of exceptional originality, such as

132. See e.g., Dawn O'Porter, *Vintage Veteran: Dawn O'Porter Interviews Vintage Fashion Expert William Banks-Blaney*, EVENING STANDARD (Mar. 18, 2015), <http://www.standard.co.uk/fashion/vintage-veteran-dawn-oporter-interviews-vintage-fashion-expert-william-banks-blaney-10115856.html> [<http://perma.cc/8ZNF-ALNT>] (“The shape and cut of a 1960s Courreges [shift dress] has become the basis for nearly every dress made in the 21st century with crisp tailoring, welted seams, a practical and user-friendly cut . . . [I]t is fashion DNA.”). Named “The Vintage King” by British Vogue, William Banks-Blaney authored 25 DRESSES: ICONIC MOMENTS IN TWENTIETH-CENTURY FASHION (2015), in which “each dress is looked at in forensic detail for its design and construction, its cut and embellishments, in order to evaluate the artistry of the individual couturier.” Synopsis and About the Author, AMAZON, <http://www.amazon.com/Twenty-Five-Dresses-William-Vintage/dp/1849494711> [<http://perma.cc/Y2QX-AYUJ>].

133. See generally King & Clement, *supra* note 130.

134. See Ronald E. Goldsmith, *Characteristics of the Heavy User of Fashionable Clothing*, 8 J. MKTG. THEORY & PRACTICE 21 (2000) (distinguishing “heavy” users—buyers who spent the most on new fashionable clothing—from “light” and nonusers, and finding that heavy users were more involved with fashion, more innovative and knowledgeable about new fashions, and more likely to act as opinion leaders for new fashions).

135. See generally *id.*

its variation over prior works “being the only one of its kind” and that it could “only be attributed to the designer,” or that the designer’s variation is “significant,” then the trier of fact is greatly assisted in his or her determination.

Having a high standard of originality would also ease the difficulty in determining whether a fashion design is original.¹³⁶ It was said that so much of fashion is derivative and is inspired by articles that have been previously designed and created, thus making it difficult for a designer to create something that has not already been done in a similar way.¹³⁷ Consequently, it would also be difficult, using standards in the current copyright law, to distinguish between a work that merely references prior works and works that are original. However, raising the standard to that of exceptional originality would make the task easier for triers of fact, for a piece of apparel that is the result of a designer’s own creative endeavor; with a variation over prior designs for similar types of articles that is the only one of its kind; that can only be attributed to the designer; that can be regarded as separate and different; and is significant would be susceptible to easier distinction from other pieces of apparel, as opposed to works that merely possess a “creative spark.” Whereas the latter standard for originality can be vague due to the multitude of existing fashion designs that demonstrate a modicum of creativity,¹³⁸ the former standard can be subject to easier interpretation because only a few works can achieve this high threshold.

B. Proposed Legal Standard for Infringement

Having proposed which fashion designs and pieces of apparel should be protected by a sui generis system of protection, it is also appropriate to suggest a standard for infringement. It is recommended that the standard for

136. See *Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. 13 (2006) (testimony of David Wolfe, Creative Director, The Doneger Group), <http://www.gpo.gov/fdsys/pkg/CHRG-109hhrg28908/html/CHRG-109hhrg28908.htm> [<http://perma.cc/2G8R-7YMJ>].

137. See *id.*; Kal Raustiala & Christopher Sprigman, Response, *The Piracy Paradox Revisited*, 61 STAN. L. REV. 1201 (2009) [hereinafter Raustiala & Sprigman, *Paradox Revisited*] (arguing the American fashion industry operates under an unusual legal regime in which design appropriation, whether it be point-by-point reproduction or derivative copying, is a pervasive aspect of the business).

138. See Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1724 (2006) [hereinafter Raustiala & Sprigman, *Piracy Paradox*] (“A regime of free appropriation contributes to the rapid production of substantially new designs that were creatively inspired by the original design.”).

infringement for fashion design be that of “substantially identical,” as it is defined in the IDPA.¹³⁹ “Substantially identical” means “an article of apparel which is so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial.”¹⁴⁰ For infringement to be found, it is not necessary that two pieces of apparel are so similar that one could not distinguish them; what is crucial in this standard is that one piece could be mistaken for the other.

The fashion industry develops due in large part to the constant adaptation and referencing of “trend features” among designers.¹⁴¹ A trend feature, as defined by Professor C. Scott Hemphill of Columbia Law School and Professor Jeannie Suk of Harvard Law School, is “some shared, recognizable design element such as a wrap dress, a fitted fringed jacket, a driving shoe, or a floral print.”¹⁴² On the other hand, differentiating features are “all design elements other than the trend feature that make the items within the trend nevertheless different from each other.”¹⁴³ A “substantially identical” standard for infringement, this article proposes, would allow adaptations of trend features, but would prohibit close copying of differentiating features, such that one article could be mistaken for the other. With the raised standard for infringement as proposed, only those that slavishly imitate an exceptionally original piece of apparel would be liable for infringement. Creativity is not chilled, and an exceptionally original fashion design can spur further creation, for it can be used as inspiration for designs that are merely similar but are not point-for-point copies of it.

The high standard for originality encourages creation of truly innovative works, while the high standard for infringement allows for a rich public domain from which one can obtain inspiration and from which designers can draw creative design elements freely. It is conceded that such a high standard of infringement might only encourage designers to make

139. Innovative Design Protection Act, *supra* note 115.

140. *Id.*

141. C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1149 (2009) (“People flock to ideas, styles, methods, and practices that seem new and exciting, and then eventually the intensity of that collective fascination subsides, when the newer and hence more exciting emerge on the scene. Participants of social practices that value innovation are driven to partake of what is ‘original,’ ‘cutting edge,’ ‘fresh,’ ‘leading,’ or ‘hot.’ But with time, those qualities are attributed to others, and another trend takes shape.”).

142. *Id.* at 1166.

143. *Id.*

minor alterations to designs of exceptional originality without being held liable for infringement.¹⁴⁴ However, since fashion design is so dependent on a limited number of possible variations,¹⁴⁵ to allow for a low standard of infringement would be to subject a possible minefield of creativity to monopoly. Indeed, so much of this craft builds upon what came before¹⁴⁶ that to prohibit any copying that is less than point-for-point imitation would be to chill creativity.¹⁴⁷ This is one of the reasons why a *sui generis* system of protection is appropriate for fashion—because while in other creative fields close imitations are considered harmful, for the fashion industry in particular it is these commonalities in creative elements that drive it and spur further creation.¹⁴⁸

This is not to say that protection for exceptionally original fashion design would be rendered meaningless by such a high standard for infringement. The value of this *sui generis* protection lies in the ability of fashion designers to prevent slavish copies of their works that would confuse their patrons.¹⁴⁹ It is akin to trademark law's prohibition of counterfeiting.¹⁵⁰ An argument that might be raised against this justification is that the customer of a designer of an exceptionally original work would not be confused because the original work that he or she desires comes at a price that is more expensive than some cheap imitation. However, it must be noted

144. See *id.* at 1181–82 (critiquing Raustiala & Sprigman's induced obsolescence theory and noting that it is important to distinguish close copying of a design from interpretation, inspiration, or homage).

145. See *Design Piracy Prohibition Act*, *supra* note 136 (“Fashion is a long tradition of crafts-people working with the same materials, tools, and concepts, which is what makes it difficult for someone to design something that has not been done in a similar or same way before. Current fashion is the product of generations of designers refining and redeveloping the same items and ideas over and over.”).

146. See *id.*

147. See Kal Raustiala & Christopher Sprigman, *Fashion Victims: How Copyright Law Could Kill the Fashion Industry*, NEW REPUBLIC ONLINE (Aug. 14, 2007), <http://www2.law.ucla.edu/raustiala/publications/Copyright%20Law%20Could%20Kill%20The%20Fashion.pdf> [<http://perma.cc/ZS3W-964K>].

148. Raustiala & Sprigman, *Piracy Paradox*, *supra* note 138, at 1775–77 (claiming that “fashion’s cyclical nature is furthered and accelerated by a regime of open appropriation”).

149. Christine Cox & Jennifer Jenkins, *Between the Seams, A Fertile Commons: An Overview of the Relationship Between Fashion and Intellectual Property*, NORMAN LEAR CTR. 14 (Jan. 29, 2005), <http://learcenter.org/pdf/RTSJenkinsCox.pdf> [<http://perma.cc/9CDW-ZA3D>].

150. *Id.*

that exceptional originality is not exclusive to high-end, costly, haute-couture fashion houses. An exceptionally original piece can be designed by a young designer running a start-up fashion company, and his or her slavish copyist can be another manufacturer producing pieces of apparel at the same affordable price point. Pernicious copying can then still be averted with this standard of infringement. Furthermore, it would also encourage designers of exceptionally original pieces of apparel to create variations of their own designs if they seek to have their names or labels associated with a broader range of products inspired by their exceptionally original creation. Having multiple variations of their exceptionally original pieces of apparel could possibly lead to articles with different price points, thus making their creations more accessible to a broader range of consumers.

C. Benefits of Granting Sui Generis Protection to “Exceptionally Original” Pieces of Apparel

Fashion designs that are exceptionally original should be given sui generis protection because doing so would encourage the creation of pieces of apparel that possess this standard of originality, thereby stimulating true creativity. Even Raustiala and Sprigman, who are staunch opponents of extending copyright protection to fashion designs, concede “it is surely possible that the fashion industry could be even more innovative than it is now,”¹⁵¹ and indeed, there is no harm in encouraging more creativity in an already highly productive industry.

Granting sui generis protection to fashion design “would also push fashion producers toward investment in design innovation and away from proliferation of brand logos by established firms making use of what legal protection is available.”¹⁵² It has not gone unnoticed that pieces of apparel splattered with logos, yet run-of-the-mill in terms of design per se, have become more widespread over the years.¹⁵³ This phenomenon can be attributed to the fact that “designers understand the value of logos as an anticopying device.”¹⁵⁴ Hemphill and Suk explain that “trademark protection accompanied by a lack of design protection thereby favors those

151. Raustiala & Sprigman, *Piracy Paradox*, *supra* note 138, at 1744.

152. Hemphill & Suk, *supra* note 141, at 1153–54.

153. *See id.* at 1177–78.

154. *Id.* at 1177.

firms that have strong trademarks and disproportionately encourages production of trademark-protected goods, such as articles with logos.”¹⁵⁵

After all, if Gucci can prohibit copies of designs that employ its trademark interlocked “G’s,” but not a similar work that lacks the logos, it has an incentive to employ the logo. It also encourages the production of types of items, such as handbags, for which logos (and trade dress) are highly complementary. Such “logoification” affects the communicative vocabulary that fashion provides, pulling fashion toward a status-conferring function and away from the communication of diverse messages.¹⁵⁶

In addition, “young designers attempting to establish themselves are particularly vulnerable to the lack of copyright protection for fashion design, since their names and logos are not yet recognizable to a broad range of consumers.”¹⁵⁷ Following, aspiring creators of exceptionally original fashion designs “cannot simply rely on reputation or trademark protection to make up for the absence of copyright.”¹⁵⁸

Giving *sui generis* protection to fashion designs that meet the suggested standard of originality would further encourage the creation of apparel that is creative and innovative in terms of overall design, as well as possibly reduce excessive use of and dependence on logos.¹⁵⁹

Another reason to grant *sui generis* protection to exceptionally original pieces of apparel is to ensure that originators of such fashion designs are protected from the commercial harm posed by copies that could be mistaken or substituted for their creations.¹⁶⁰ Copyists harm the market for good, particularly when the original article and the copy are within the same price bracket and can be afforded by consumers within the same market.¹⁶¹

155. *Id.*

156. *Id.* at 1177–78.

157. See *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) 78–84 (statement of Susan Scafidi, Professor of Fordham Law School), <http://www.gpo.gov/fdsys/pkg/CHRG-109hhr28908/html/CHRG-109hhr28908.htm> [<http://perma.cc/Q7TX-JBWF>].

158. *Id.*

159. See *id.*

160. See *id.* (“Copying is rampant in the fashion industry, as knockoff artists remain free to skip the time-consuming and expensive process of developing and marketing new products and simply target creative designers’ most successful models. The race to the bottom in terms of price and quality is one that experimental designers cannot win.”).

161. *Id.*

Furthermore, established fashion houses with resources to engage in anti-infringement lawsuits are not the main targets of copyists.¹⁶² The problem encountered by bag designer Jennifer Baum Lagdameo, as narrated by Fordham Law School Professor Susan Scafidi during a congressional hearing on the subject,¹⁶³ is enlightening and illustrative of the situation of many other small-scale designers:

Handbag designer Jennifer Baum Lagdameo co-founded the label Ananas approximately three years ago. A young wife and mother working from home, Jennifer has been successful in promoting her handbags, which retail between \$200 and \$400. Earlier this year, however, she received a telephone call canceling a wholesale order. When she inquired as to the reason for the cancellation, she learned that the buyer had found virtually identical copies of her bags at a lower price. Shortly thereafter, Jennifer discovered a post on an internet message board by a potential customer who had admired one of her bags at a major department store. Before buying the customer looked online and found a cheap, line-for-line copy of the Ananas bag in lower quality materials, which she not only bought but recommended to others, further affecting sales of the original. While Ananas continues to produce handbags at present, this loss of both wholesale and retail sales is a significant blow to a small business.¹⁶⁴

For a midrange designer such as Lagdameo, “the sales of the copy substitute for and hence reduce sales of the original.”¹⁶⁵ Hence, designers of exceptionally original works, who do not have the machinery and resources of large fashion houses, are at a greater risk for economic harm. Extending *sui generis* protection to their creations would discourage point-for-point copying that provides viable substitutes or creates confusion on the part of

162. *See id.* (“With the recent democratization of style, creative design originates from many sources and at all price levels. Fashion is now as likely to flow up from the streets as down from the haute couture, and reasonable prices are no guarantee against copyists. Some of the most aggressively copied designs are popularly priced . . .”).

163. *A Bill to Provide Protection for Fashion Design*, *supra* note 157.

164. *Id.*

165. Hemphill & Suk, *supra* note 141, at 1175.

consumers, thus lessening the possibility of market loss on the part of designers.

V. CONCLUSION

Fashion design drives one of the largest global industries; that industry spurs the economy and provides employment to millions. Although fashion design is afforded relatively low IP protection, it is largely productive in terms of profit and creative output. Yet even with this robust industry, there still remains a clamor for stronger protection of fashion designs and the apparel manufactured from these designs. As discussed, full-dress copyright protection is unnecessary, impracticable, and harmful due to several reasons: despite the lack of full-dress copyright protection, there exists enough creativity and incentive to support a continually growing industry that produces new works and new designers at a regular pace; current IP laws already provide some protection to fashion;¹⁶⁶ current copyright laws are incompatible with fashion due to the useful article doctrine¹⁶⁷ and the difficulty of distinguishing original from non-original works;¹⁶⁸ and providing full-dress copyright protection will likely increase litigation, chill creativity, and drive up costs.¹⁶⁹

This article therefore proposes a middle-ground: a *sui generis* system of protection that only protects fashion designs and pieces of apparel that are exceptionally original, and does so only against other articles that are substantially identical. The term “exceptionally original” is defined in this article as a fashion design that is, upon reduction to a fixed and tangible medium with sufficient specificity, the result of a designer’s own creative endeavor;¹⁷⁰ and its variation over prior designs for similar types of articles is the only one of its kind;¹⁷¹ can only be attributed to the designer;¹⁷² can be

166. *See supra* Part II.

167. *See supra* Part II.E.

168. *See supra* Part III.

169. *See supra* Part III.

170. *See supra* Part IV.A.

171. *See supra* Part IV.A.

172. *See supra* Part IV.A.

regarded as separate and different;¹⁷³ is significant; and pertains to the article's appearance and not its function.¹⁷⁴

This definition, being so narrow, will only protect a limited and select group of designs, and this standard of infringement, being so high, would only prohibit slavish copies.¹⁷⁵ This level of protection and high legal standard for infringement would lead to the following results: first, it would encourage designers to be more innovative and not merely recreate adaptations of prior works—for despite the fact that there are incentives to develop new designs, there is no harm in encouraging designers to strive for a higher level of innovation that focuses on apparel designs per se.¹⁷⁶ Second, the elevated standard of originality, due to its enumerated requisites, will make it easier for triers of fact to identify designs that are truly innovative, as opposed to the current vaguely-defined standard of “modicum of creativity” and the low threshold of protection it establishes.¹⁷⁷ Third, a high standard for protection and a high standard for infringement will not chill creativity, as many opponents of granting full-dress protection to fashion designs fear.¹⁷⁸ This sui generis system would only bring outside of the public domain a small, select, and exceptional class of designs, but would allow designers to reference and adapt these exceptionally original designs without fear of infringement liability, as long as they do not slavishly copy, point-for-point, the subject work that can serve as inspiration for other fashion designs.¹⁷⁹ This high standard of infringement would not render the proposed system of protection meaningless because it aims to protect against products that potentially harm the market of the original designs due to the confusion that could result from point-for-point copies. With only a small, limited selection of fashion designs and pieces of apparel that can be protected by this sui generis system, and a large body of clearly permissible copies or “inspired-by” works allowed, it is unlikely that there will be a proliferation of numerous lawsuits that would drive up prices. Only a few

173. *See supra* Part IV.A.

174. *See supra* Part III.

175. *See supra* Part IV.A–B.

176. *See supra* Part IV.C.

177. *See supra* Part IV.C.

178. *See supra* Part IV.C.

179. *See supra* Part IV.A–B.

designers will be able to genuinely claim that their designs meet the stringent standard of exceptional originality.¹⁸⁰ Hence, there will be a significantly lower number of viable plaintiffs willing to expend resources to pursue a charge of infringement that is not likely to meet that high legal standard.

This article suggests that the IDPA, along with its foreseeable future versions that adapt its definition of “fashion design” and standard for infringement, is a viable compromise between full-dress copyright protection and the status quo. By granting a monopoly only to a very limited number of works, this article’s proposal achieves a balance between granting protection to fashion designs and allowing for a rich public domain of design elements from which other designers can draw inspiration. This measure would appease both the original designers and those in the industry, as well as the academe who believe that for fashion to continue developing and prospering, it should not be deprived of an expansive and invaluable public domain.

180. *See supra* Part IV.A.

APPENDIX A

The Evolution of the Peplum Skirt

(1) The 1870s to 1880s¹⁸¹(2) The 1940s¹⁸²(3) The 1980s¹⁸³(4) Spring/Summer 2012¹⁸⁴

181. *The Peplum Through History*, DANDY LIONESS (Nov. 10, 2012, 11:01 PM), <http://dandylioness.com/2012/11/10/the-peplum-through-history/> [<http://perma.cc/VY3S-5HE7>].

182. *Vogue* 5356, VINTAGE PATTERNS WIKIA, http://vintagepatterns.wikia.com/wiki/Vogue_5356 [<http://perma.cc/4PAM-KLMJ>].

APPENDIX B

Ancient Roman Gladiators¹⁸⁵Stuart Weitzman Gladiator Sandals¹⁸⁶

183. *Vogue Individualist #1710 TAMOTSU Peplum Top & Slim Skirt Size 8 Circa 1987*, EBAY, http://www.ebay.com/itm/like/181906870927?ul_noapp=true&chn=ps&lpid=82 [<http://perma.cc/H4MS-PPSK>].

184. *New York Fashion Week Spring/Summer 2012 Trend Round-up*, TELEGRAPH (Sept. 15, 2011), <http://fashion.telegraph.co.uk/galleries/TMG8765199/New-York-Fashion-Week-springsummer-2012-trend-round-up.html> [<http://perma.cc/7Y5X-7KVT>].

185. DIGGING UP THE PAST, <http://www.diggingonline.com/pages/rese/arts/other/2010/pics/pompeigliadiator.jpg> [<http://perma.cc/CD4Q-KNKQ>].

186. *The Gladiator Sandal*, STUART WEITZMAN, http://www.stuartweitzman.com/store/item/?itemid=66003&gclid=CO7rvq_rLsCFYqPfgodujcAkg [<http://perma.cc/N42S-V76R>].



“Scary Beautiful” shoes by Leanie van de Vyver and Rene van den Berg¹⁸⁷

187. *Scary Beautiful*, CARGO COLLECTIVE (July 2012), <http://cargocollective.com/Leanie/Scary-Beautiful> [<http://perma.cc/MH53-V27N>].