Fashion Runways Are No Longer the Public Domain: Applying the Common Law Right of Publicity to Haute Couture Fashion Design

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by

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Introduction

Under present United States intellectual property law, clothing design is not protected by federal copyright, trademark/trade dress, or patent law, nor is it protected by any state intellectual property regime. Certain aspects of clothing are capable of being protected—a logo under trademark law, a non-useful decoration that is attached to a piece of clothing under copyright law—but currently the entire garment itself (sometimes referred to as a "fashion work") can be copied and distributed at will. Indeed, current United States law explicitly sanctions fashion design piracy; some courts have even deemed it a "right" necessary to the avoidance of a monopoly on clothing designs. As a result of this right, the cost to original creators of designs by pirates runs to the hundreds of millions of dollars per year. This is even more than the piracy of sound recordings, whose industry can claim copyright protection and polices its rights in a draconian fashion.

To try to deal with design piracy, the fashion industry has come up with various ways to protect itself, including attempting to expand the doctrine of trade dress protection to garments. This strategy, however, was hamstringed by a unanimous United States Supreme Court in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* In addition, the fashion industry has repeatedly attempted to change the copyright statute (approximately 74 attempts since 1910, as of 1983), employed aggressive advertising, marketing, and use of logos to build customer identification and desire, and used import bans and quotas on foreign-manufactured garments. However, these remedies have had varying degrees of success and still do not address the main

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1. To give an example of the damage that well-organized design pirates can do, one major pirate has been attributed with $50 million in annual revenue from its knockoff sales, and another with $200 million. Peter K. Schalestock, Student Author, *Forms of Redress for Design Piracy: How Victims Can Use Existing Copyright Law*, 21 Seattle U. L. Rev. 113, 114 (1997).


4. Rocky Schmidt, Comment, *Designer Law: Fashioning a Remedy for Design Piracy*, 30 UCLA L. Rev. 861, 864-65 (1983). Perhaps out of exhaustion in the industry, since 1984 there have been no legislative attempts to amend the Copyright Act to include fashion design. The two bills that were introduced to amend the Act to cover industrial designs of useful articles, H.R. 902, 101st Cong. (1989) and H.R. 1790, 102nd Cong. (1991), specifically exempted "designs composed of three-dimensional features of shape and surface with respect to... apparel."
problem: the time and creativity that a designer invests in a new design are appropriated by free riders, who saturate the market for the design with cheaper, lower quality copies, sometimes bringing the design to market before the original. Some firms, such as ABS, openly and notoriously build their reputations on copying the haute couture creations of major designers and rushing cheap imitations to market literally overnight. The head of ABS, Allen B. Schwartz, has admitted that he will watch fashion events such as the Academy Awards telecast, sketch the dresses that the stars parade down the red carpet, and "the next day decide which of the gowns will be 'adapted' or 'interpreted.'"

In any other artistic field, this shameless wholesale copying would be unthinkable. Forgers of the visual arts and pirates of sound recordings and motion pictures receive criminal as well as civil penalties for their endeavors. Protection for fashion works through copyright and other methods, including moral and neighboring rights, without the creation of monopolies or the stifling of competition, exists in other countries in which fashion is a large sector of the economy, such as France and the United Kingdom. Given the lucrative nature of the United States fashion industry and its increasingly high profile in people's daily lives, one would think that Congress would be happy to give it some protection. In fact, given the national treatment provisions of the Berne Convention and TRIPS Agreement of the World Trade Organization ("WTO"), Congress may not be able to consider fashion design protection merely at its whim for much longer — our current position as one of

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6. See e.g. Copyright Act, 3 Eliz. 2, c. 5, §§ 3(1), 48(1) (1956) (Eng.) (United Kingdom protects garment design as long as it can be related back to a copyright drawing); Copyright Laws and Treaties of the World (France), item 18, at 1-3 (UNESCO 2000) (Since 1952, French copyright law has protected garment designs without any showing of originality.).
8. Fashion itself has become almost a separate form of entertainment, although its rise to prominence has been because of the incredible expansion of the film and recording industry and the public's fascination with their stars. Any major film opening or industry awards ceremony is now a fashion show; many people tune in to the Academy Awards telecast solely to see what the stars are wearing. Indeed, the first question that Melissa and Joan Rivers ask during the stars' entrance on the red carpet is who designed the outfits they are wearing. Celebrities shout designers' names like greetings to the crowd.
the few countries with a major intellectual property law regime that does not protect fashion works violates the terms of these treaties. However, current protection of fashion design in the United States through traditional intellectual property law is at an impasse.

Yet, there could be a way to get around it. The common law doctrine of the right of publicity or personality, which arises in most states out of the tort of invasion of privacy and which is a strong body of law in jurisdictions dealing with the entertainment industry such as California and the Ninth Circuit, could potentially be applied to haute couture.\(^\text{10}\) I will focus on haute couture because it is the most innovative area of fashion design and is closer to what is generally considered “art” than everyday \textit{prêt-a-porter} clothing. Also, because of its high price\(^\text{12}\) the potential counter-arguments that protection of fashion design would diminish the amount of choice in clothing styles that ordinary consumers have would be dealt with, since haute couture is a small sector of the fashion market.

The right of publicity currently allows celebrities — mostly musicians, singers and actors — to protect against the unauthorized appropriation not only of their physical image but also of the overall projection of their performing style, the “essence” of their fame. Under this regime, a designer would have a tort action against a design pirate for misappropriation of identity or intrusion on his or her right of publicity, as this is physically expressed in the design and ethos of a couturier garment. Protection for high fashion under a right of publicity would serve two purposes: (a) the protection of the commercial value of a designer’s services and reputation, and (b) the protection of the artistic value of the creations. On this latter point, the right of publicity is one of the closest things that United States law presently has to European moral or neighboring rights law, and application of the doctrine could potentially bring us into full national treatment compliance with TRIPS and the Berne Convention.

This paper will first discuss the history of the non-protection of fashion design in the United States, looking at copyright,

\(^{10}\) I will use the terms “fashion design” and “fashion work” to refer to an entire garment.

\(^{11}\) Haute couture, literally “high tailoring” in French, refers to handmade clothing, fitted to the client’s measurements and styled according to her taste. The result is a gorgeous, unique garment, considered an example of fashion at its most elevated art form. See \textit{The Grand French Haute Couture Houses} \textless \url{http://www.elegantlifestyle.com/haute_couture.htm} \textgreater (accessed Apr. 27, 2001).

\(^{12}\) The average price of a haute couture garment made in one of the French houses is $16,000-20,000. \textit{Id}.
trademark/trade dress, and design patent law. Then, an overview of the right of publicity and its traditional application in the performing arts is given, followed by an application of the right of publicity doctrine to the protection of haute couture design. Finally, the paper examines how the right of publicity can overcome federal preemption and antitrust objections in order to fit within the present United States intellectual property regime.

I

Everyone's Wearing the Emperor's Clothes:

A. Copyright

Clothing has never been protected under federal copyright law. Although the cases and Congressional hearings on clothing design protection do not indicate any judicial or legislative doubt about the creative nature of fashion, what has trumped in-depth consideration of the time, energy and aesthetic genius required to be a leading fashion designer has been the conclusion that all clothing is a "useful article" and therefore not protected by copyright. Never mind that useful articles, such as aesthetically designed, mass-market teakettles created for Target, or lamps with statuettes for bases, are granted copyrights every day. Never mind that, with the commodification of the world's largest entertainment industry, the United States has made art's traditional "use" — to please and entertain — incredibly lucrative yet simultaneously more accessible to people of all income levels. Clothing, even zany runway creations, is useful because it keeps us from going naked, protects us from the elements and signals our station in society. It is useful because everyone needs it every day.

13. About 100-150 hours of manual work are required to make a day outfit such as a suit. For an evening gown, the time investment is closer to 1000 hours, even more if there is extensive embroidery involved. See id.
15. Although for these types of "useful" (in the everyday sense of the word) articles to receive copyright protection, they must survive analysis under the conceptual separability doctrine, in which only those aspects of the object that are artistic beyond the object's functional qualities are granted protection. See generally id.
16. For example, in Alexander McQueen's runway show during London's Fashion Week, 2001, this designer sent out one model wearing a skirt covered with mussel shells and another wearing a large castle made of wood perched on her shoulder. Larissa MacFarquhar, The Mad Muse of Waterloo, The New Yorker 100, 103 (Mar. 19, 2001).
The Copyright Act grants only limited protection to useful articles. Section 101 of the statute defines useful articles as "having intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." The design of a useful article is granted protection as a pictorial, graphic, or sculptural work "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." Moreover, the exclusive right granted in Section 106 to reproduce a copyrighted pictorial, graphic or sculptural work includes the right to reproduce the work in useful or non-useful articles. This does not give the owner of a copyright in a work that portrays a useful article any greater or lesser rights with respect to the making, distribution, or display of the useful article than those afforded to such works under the Copyright Act, other statutes, and existing court decisions. What this means is that copyright in a pictorial, graphic, or sculptural work is not affected if the work is employed as the design of a useful article; however, the intent of Congress and the Register of Copyrights is not to extend copyright protection to the manufacture of useful articles themselves. Thus, holding a copyright in the drawing of a design for a dress does not give the artist the exclusive right to make dresses of the same design.

Because a fashion work is meant to turn an everyday article into an artistic whole, it has been impossible, thus far, to fit fashion into this limited useful article protection. Creative seekers of protection have tried unsuccessfully to argue that a Halloween costume, for instance, is not a useful article but a "soft sculpture." After all, what is "useful," in the regular sense of the word, about dressing as a stegosaurus? An uncreative court held that costumes are indeed useful articles because they are still, essentially, clothing. Subsequently, the Copyright Office issued a cryptic Policy Decision on the Registrability of Costume Designs, declaring that masks are

19. Id. This definition incorporates the holding in Mazer, 347 U.S. 201, discussed below. Haute couture would seem to fit under this definition quite well.
21. Id. § 113(b).
24. Id. at 456.
registrable as pictorial or sculptural works. Nevertheless, the Policy Decision stated that costumes are to be treated as useful articles and granted protection only upon a finding of separable artistic authorship. The distinction between masks and costumes exists, according to the Copyright Office, because masks "generally portray their own appearance" and, therefore, fall outside the definition of a useful article, while costumes "serve a dual purpose of clothing the body and portraying their appearance. Since clothing the body serves as a useful function, costumes fall within the literal definition of useful article." When faced with this level of obtuse hair-splitting about the definition of "useful," it is no wonder that lobbyists have been unsuccessful in their 73 attempts since 1914 to amend the Copyright Act to include fashion design.

Meanwhile, designers have pursued protection through the courts. The first modern challenge to the lack of copyright protection given to clothing arose in Cheney Brothers v. Doris Silk Corp. in which the creator of hand-painted silk fabric, outraged that his competitor was copying his best-selling designs and undercutting his price on the market, brought suit in the Second Circuit for commercial injury caused by unfair competition. The plaintiff sought protection for his designs only during the eight- or nine-month "season" during which such designs catch the public eye. Judge Learned Hand described the short-lived nature of the silks' popularity and stressed the short marketing time frame under which the plaintiff operated. He further stressed how neither copyright nor design patent protection was available to the fabric, making it "easy for any one to copy such [designs] as prove successful, and the plaintiff, which is put to much ingenuity and expense in fabricating them, finds itself without protection of any sort for its pains." Nevertheless, Judge Hand perceived a slippery slope in offering protection to designs only during their season of fashionability and held that, in the absence of explicit statutory or common law protection, "a man's property is limited to the chattels which embody

26. Id.
27. Id.
28. Schmidt, supra n. 4, at 865.
29. 35 F.2d 279 (2d Cir. 1929), cert. denied, 281 U.S. 728 (1930).
30. Id. at 279.
31. Id.
32. Id.
33. Id.
his invention. Others may imitate these at their pleasure." Only Congress could grant protection against the imitation of an object, through either the Copyright Act or patent laws, and thereby create a monopoly in its design. Except for non-functional features of a creation, people are free to copy the original. Otherwise, granting a monopoly over a useful article without congressional authority would be unconstitutional.

The next main case dealing with the intersection of art and useful articles was *Mazer v. Stein.* There, the plaintiff manufactured lamps whose base consisted of a statue of a Balinese dancer; the statue had been registered for copyright as "a work of art." The defendant copied both the lamp and the base. When the plaintiff brought suit for copyright infringement, the defendant responded by saying that copyright protection could not be extended to the base statue because it was a useful article — although it was highly decorative, it was still a lamp base and therefore useful. The Supreme Court held that a work of art that had been incorporated into the design of a useful article could indeed be copyrighted, and that such a work does not lose copyright protection upon being embodied in the useful article. The Court went on to state that the following factors make no difference for this analysis: (1) the potential availability of design patent protection for the same subject matter; (2) the artist's intention as to the commercial application and mass production of the design; (3) the aesthetic value of the design, or its total lack thereof; and (4) the fact that the design, in its useful embodiment, was mass-produced and merchandised commercially on a nationwide scale.

Although the *Mazer* court language could be construed as granting protection to original clothing designs, subsequent decisions have held that it does not. The rule laid down by Judge Hand in

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34. *Id.* at 280 (citations omitted).
35. *Id.* at 281.
36. *Id.* at 280.
37. *Id.*
38. 347 U.S. 201.
39. *Id.* at 202.
40. *Id.* at 203.
41. *Id.* at 205.
42. *Id.* at 217.
43. *Id.* at 217-18.
Cheney Brothers has persisted, and only fashion designs that can be identified separately from the fashion work itself can receive a copyright; the overall configuration of the utilitarian object is not protected.\textsuperscript{45} Since a fashion work is an entire piece of clothing that consists of a creative whole, it has been deemed too conceptually difficult to separate out its copyrightable aspects from its utilitarian ones.\textsuperscript{46}

Besides citing the useful nature of clothing as a barrier to copyright protection, Congress and the courts fear that extending copyright protection to fashion would lay the groundwork for monopolies in the apparel market.\textsuperscript{47} Since exclusive use of a copyrighted article is inherent in the grant of protection,\textsuperscript{48} holders of a copyright in garment designs would be able to prevent use of their creations entirely, or license the use of their designs on potentially onerous terms.\textsuperscript{49} Courts have expressed particular concern that protection for fashion designs would price lower-income consumers out of the market for the newest trends, and that design piracy is therefore a socially desirable form of competition.\textsuperscript{50} Given all of these concerns, it appears that copyright protection for fashion works is still just a dream, despite some admirable suggestions for reform that would balance the interests of designers and consumers.\textsuperscript{51}

B. Trademark and Trade Dress

Protection of fashion design under trademark and trade dress law has been another route designers have used to mitigate the flood of copies of their works. However, this area of intellectual property law has proven ineffective in preventing copying of an entire garment.\textsuperscript{52} Moreover, the United States Supreme Court dealt protection via trade dress theory a setback in 2000 when it narrowly


\textsuperscript{46} See id.

\textsuperscript{47} Schmidt, supra n. 4, at 866.


\textsuperscript{49} Schmidt, supra n. 4, at 866-67.

\textsuperscript{50} See Millinery Creators' Guild v. FTC, 109 F.2d 175, 177 (2d Cir. 1940), aff'd, 312 U.S. 469 (1941); see also Cheney Bros., 35 F.2d at 281.

\textsuperscript{51} See Schmidt, supra n. 4, at 875-80 (arguing for a special copyright for garment designs, available for one year and subject to a compulsory license for this term, beginning as soon as the design is available to the public).

\textsuperscript{52} See generally Knitwares Inc. v. Lollytogs Ltd., 71 F.3d 996 (2d Cir. 1995) (holding that trade dress protection is only available for designs that serve as an identifier of the designer).
construed its own previous rulings on the scope of trade dress and denied a children’s clothing maker protection for its garments. As the law stands currently, trademark and trade dress theory offer only limited solace to designers of couture fashion.

Trademark law has been successful in protecting logos, names, and other emblems that are placed on garments (and accessories), but cannot be applied to an entire garment, unless the entire garment meets the criteria for protection under the Lanham Act or state trademark law. In order to receive a trademark or trade dress protection for an entire garment, the garment must be either inherently distinctive — that is, its intrinsic nature serves to identify its particular source — or it must acquire distinctiveness through secondary meaning — that is, its significance is to identify the product’s source rather than the product itself. Courts often rely on consumer surveys and expert testimony to determine whether a mark or trade dress has acquired secondary meaning. They also consider a number of non-exclusive factors, but above all the most important ingredient in the acquisition of secondary meaning is the time the product spends on the market building up consumer recognition of its source.

Generally, an entire garment is not considered inherently distinctive in and of itself such that it identifies its particular source because the design of the garment is limited in its possible shapes by the form of the human body. The facets of the garment that help us identify who designed it — the mussel shells for Alexander McQueen, bold stripes for Sonia Rykiel, clean, simple lines for Calvin Klein — are usually separable from the physical dress itself (and, in Sonia Rykiel’s case, perhaps eligible for a trademark on their own). Additionally, because it takes time on the market for a mark to build up secondary meaning — usually longer than the three-month season that garments are marketable due to the ephemeral nature of style — it is, therefore, nearly impossible for a garment itself to

54. Id. at 209.
57. See Bharathi, supra n. 45, at 1681.
58. The main secondary meaning factors are discussed in more detail below at pages 111-13. See infra nn. 69-81 and accompanying text.
59. See Bharathi, supra n. 45, at 1682.
60. Id. at 1683.
61. See Schmidt, supra n. 4, at n. 59.
acquire it.

Trade dress law would appear to be more conducive to the protection of fashion works. Trade dress is a “hybrid of trademark law and unfair competition,”62 traditionally referring to a product’s packaging,63 but now encompassing a product’s overall image, its “design and appearance.”64 This new definition includes the product’s shape, color, graphics, packaging, and label.65 Courts have found that a china pattern, a fishing reel design, a restaurant’s ambience, a television commercial’s theme, and a rock group’s musical performance style, among other things, may be protected under trade dress.66 Trade dress, like trademark law, is concerned with consumer confusion about a product’s source or affiliation and is governed by the Lanham Act.67 To claim protection, a plaintiff must offer factual proof that the trade dress is inherently distinctive or has acquired secondary meaning, and that a defendant’s competing product is “confusingly similar” to the plaintiff’s.68

Unlike trademark law, trade dress’ focus on a product’s “look and feel” appears to make it readily applicable to fashion design protection.69 The Supreme Court’s decision in Two Pesos, Inc. v. Taco Cabana, Inc. appeared to support this application by holding that there was no basis in the Lanham Act for treating inherently distinctive trade dress differently from inherently distinctive verbal or symbolic trademarks,70 and that requiring secondary meaning for inherently distinctive trade dress undermined the Lanham Act’s purposes in that it would hinder a producer’s ability to improve or maintain its competitive position, or to enter the market at all.71 By clearing up the conflict among the circuit courts regarding whether secondary meaning was an alternative or additional requirement to a

63. See Landscape Forms, Inc. v. Columbia Cascade Co., 70 F.3d 251, 253 (2d Cir. 1995) (quoting Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 58 F.3d 27, 31 (2d Cir. 1995)).
65. See Bharathi, supra n. 45, at 1679.
66. See id. at 1680 nn. 104-08.
67. See id. at 1679.
68. See 15 U.S.C. § 1125(a); Bharathi, supra n. 45, at 1681 nn. 115-16.
69. See generally Bharathi, supra n. 45 (applying trade dress law and the rule from Two Pesos, 505 U.S. 763 to the protection of fashion design).
70. Two Pesos, 505 U.S. at 774.
71. Id.
showing of inherent distinctiveness, *Two Pesos* seemingly cleared the way for its application to haute couture fashion design, since these garments are usually inherently distinctive enough for consumers to identify the garment with its source, the designer, without the burden of having to be on the market for a significant period to build up secondary meaning.

However, the Supreme Court’s recent decision in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*[^72] limited the *Two Pesos* rule to trade dress, not product design. *Wal-Mart Stores* held that, to be protected under the Lanham Act, an unregistered product design will be considered distinctive (and therefore eligible for trade dress protection) only upon a showing of secondary meaning.[^73] In this case, the “product design” related to one-piece, seersucker children’s outfits decorated with appliques of hearts, flowers, and fruit, designed by Samara Brothers and sold under contract to stores such as JCPenney.[^74] Wal-Mart sent photographs of Samara Brothers’ garments to its supplier and requested copies of the garments.[^75] Wal-Mart then sold the knockoffs at a price lower than Samara Brothers’ garments’ price at JCPenney’s, generating $1.15 million in gross profits.[^76] Samara Brothers was notified of the knockoffs’ existence when a buyer for JCPenney’s complained that she had seen what she thought were Samara Brothers garments on sale at Wal-Mart for less than what JCPenney’s “was allowed to charge under its contract with Samara [Brothers].”[^77] The District Court jury found for Samara Brothers, and both the District Court and the Second Circuit denied Wal-Mart’s motion for judgment as a matter of law.[^78]

Nevertheless, despite Wal-Mart’s blatant appropriation of the “look and feel” of Samara Brothers’ clothing and the undercutting of its price, the Supreme Court found that producers will supposedly be adequately protected if courts require a showing of secondary meaning for product *design*, not product packaging, because design can be protected by other areas of the law (copyright and design patent).[^79] The Court agreed that requiring secondary meaning and

[^73]: Id. at 216.
[^74]: Id. at 207.
[^75]: Id.
[^76]: Id. at 208.
[^77]: Id.
[^78]: Id.
[^79]: Id. at 214. It did not seem to matter to the Supreme Court that those aspects of Samara Brothers’ outfits that could receive copyright protection — the heart/fruit/flower...
drawing a distinction between this case and Two Pesos would force courts to “draw difficult lines between product-design and product-packaging trade dress” and that there would be some “hard cases on the margin,” such as glass Coca-Cola bottles. However, in the event of close cases the Court urged courts to “err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.” Once again, an avenue of protection for clothing design was foreclosed, since the short timeframe of clothing’s marketability more or less precludes its attaining a secondary meaning until the item is no longer “in fashion,” at which point a suit to protect it would be meaningless.

C. Design Patent

United States design patent law grants protection to “new, original and ornamental design[s] for an article of manufacture.” The purpose of design patents is to protect elements that give a “distinctive appearance” to articles of manufacture, in either their configuration or ornamentation. At first glance it would appear that garment designs would fit well within the design patent schema. However, to be eligible for a design patent a garment design would have to meet the requirements of novelty, non-obviousness, originality, be ornamental, and meet the test of invention. Courts have consistently held that garment designs do not meet these requirements.

Furthermore, design patent law imposes a time schedule that would make it impossible for fashion design to qualify for a design patent, even if the patent law were amended to cover garments. The process of acquiring a patent is lengthy, mostly because the prior art search, which determines whether the patentability requirements

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appliques — were already covered; the problem lay not in Wal-Mart’s appropriation of the appliques but the entire piece of clothing. See id. at 207-13. Consumers were not just purchasing the appliques; they were purchasing the outfit that was enhanced and made more aesthetic by the appliques. See id. at 213-14. The outfit was what drove Wal-Mart’s $1.15 million in gross profits. Id. at 208.

80. Id. at 215.
81. Id.
83. Id. § 171.
84. Schmidt, supra n. 4, at 867.
85. Id. at 867.
86. Id. at 867-68 n. 43 (listing cases holding that garment designs do not meet the requirements of patentability).
87. Id. at 868.
have been met, may take several years to complete. 88 Again, since a fashion work's fashionability life span is usually only three months long, protection for it via a design patent would come too late, if ever.

II

Our Clothing, Our Selves: How the Right of Publicity Could Protect Haute Couture Fashion Design

So far we have seen how the traditional avenues of intellectual property law do not adequately protect clothing design. Presently, designers can build and keep their reputations not via a protective period for their creative expressions, but by constantly producing new designs and creating customer desire and loyalty through advertising and marketing. This process is extremely expensive, time-consuming, 89 and frustrating when one knows that Allen B. Schwartz, the couture knock-off king, is hovering over his television preparing copies of your most innovative looks as celebrities or models parade them down the runway. 90 You, the designer, have put yourself into these designs — what can you do?

The answer may lie in the very fact that designers do put themselves into their designs — the clothing they create expresses their ethos, their views on aesthetics, popular culture and beauty, which is what they wish to convey to the world and what they believe will sell. In other words, clothing embodies fashion designers' public projections of themselves and their identities. In the fashion world, this expression of a designer's identity is seen most readily in her haute couture designs: the made-to-order, very expensive creations in which a designer can experiment with cut, shape, fabric, and color; the creations that people love to contemplate but few actually wear. Haute couture can be crazy or classic, but, above all, it is the essence and epitome of creativity in fashion design.

It is clear that both designers and the public consider haute

88. Id.

89. An original designer's costs for design of a new line is about 2-4% of sales. There are five seasons per year in the fashion world for which designers must generate new lines. Id. at n. 18-19.

90. Schwartz even names his knockoffs for the celebrity who was wearing the original; for instance, the pink, spaghetti strap Ralph Lauren dress that Gwyneth Paltrow wore when she accepted her Academy Award for Best Actress in 1999 was reincarnated as "Gwyneth," on sale at department stores for about $250. ABS sold 10,000 copies of "Gwyneth." See Claire Bickley, Knock-Off the Oscar Rack, Toronto Sun O6 (Mar. 26, 2001).
couture to be art.\footnote{1} Millions of people watch television broadcasts of awards shows such as the Academy Awards in order to ponder and critique the outfits that the celebrities wear; millions consume magazines from Vogue to People in order to admire the photographs of and advertisements for the clothing depicted therein. Two of the most successful blockbuster museum exhibitions in New York City in the past decade were the Gianni Versace exhibit at the Metropolitan Museum of Art's Costume Institute in 1997, and the Giorgio Armani exhibit at the Guggenheim Museum in 2000. The genius, in the Romantic spirit of the term, that is readily apparent in haute couture has appeared to have escaped only the consciousness of judges and Congresspersons, who insist on classifying it as "useful" because it prevents people from being naked\footnote{2} and may keep them warm.

Because designers put themselves into their clothing designs, the body of United States law that may offer protection against the unlicensed copying of haute couture is the right of publicity.

A. An Overview of the Right of Publicity

The right of publicity arose out of the invasion of privacy torts, particularly, invasion of privacy based on misappropriation of identity, that stemmed from Samuel Warren and Louis Brandeis' seminal law review article.\footnote{3} Although its germ was in the misappropriation of identity tort, which seeks to compensate an individual for the emotional distress she suffered from an unauthorized use of her identity, the right of publicity aims at providing redress for "the economic harms that accompany the unauthorized exploitation of an [individual's persona]."\footnote{4} The right of publicity arose in the 1950s, as "celebrity," as we understand the term, quickly became a commodity, spread by the advance of various

\footnote{1} According to the Versace website, Versace's couture line, Atelier Versace, "represents the closest link between Versace and art as each piece is individually tailored and unique." Versace Atelier \url{<http://www.versace.com/atelier>} (accessed Apr. 23, 2001).

\footnote{2} Although in the case of the dress by Chanel that Jennifer Lopez wore to make her presentation at the 2001 Academy Awards, it can also enhance the fact that we are all, in the words of comedienne Rita Rudner, Naked Beneath My Clothes: Takes of a Revealing Nature (Penguin Audiobooks 1992).

\footnote{3} See Samuel D. Warren & Louis Brandeis, The Right to Privacy, 4 Harv. L. Rev. 193 (1890). The four torts that arose from the right to privacy are (1) unreasonable intrusion upon the seclusion of another; (2) public disclosure of private facts; (3) false light portrayals; and (4) the misappropriation of an individual's name or likeness. See W. Page Keeton et al., Prosser and Keeton on the Law of Torts, § 117 at 849-68 (5th ed. 1984).

media technologies, including films and television. Courts began to recognize the right of publicity as a property-based cause of action, separate from the emotional distress-based actions, that compensated an individual for the impermissible use of her identity. Eventually, in the landmark case *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*, the doctrine shed the need for a showing of emotional injury, focusing instead on the investment that celebrities make in the economic viability of their public identities.

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Since the 1950s, the right of publicity has become an established doctrine in most jurisdictions, receiving federal recognition in 1977, and becoming a well-developed body of law in jurisdictions that are host to large sectors of the United States entertainment industry, specifically the Ninth Circuit. This circuit has applied the doctrine expansively, in a way that could help with its use in the protection of haute couture in four cases — *Motschenbacher v. R. J. Reynolds Tobacco Co.*, *Midler v. Ford Motor Co.*, *Waits v. Frito-Lay, Inc.*, and *White v. Samsung Electronics America, Inc.*

In *Motschenbacher*, the plaintiff, a famous race car driver, sued R. J. Reynolds for misappropriation of his name, likeness, personality and endorsement when the latter used a photograph of Motschenbacher's racing car in an advertisement for Winston cigarettes. Motschenbacher's car was decorated distinctively and was immediately recognizable to followers of his sport. R. J. Reynolds' advertising agent incorporated a stock photograph of the car into the advertisement, altering the car's number, adding a spoiler and the word “Winston” to it, but otherwise making no changes to

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95. *Id.* at 989.
96. 202 F.2d 866 (2d Cir. 1953).
97. Fleischer, *supra* n. 94, at 989. *Haelen Laboratory* was the first case to separate explicitly the emotional aspects from the economic aspects of the tort, and to coin the term “right of publicity.” 202 F.2d 866 (holding that individuals have a cognizable interest in the use of their identities through commercial exploitation, and this interest can be violated with or without attendant emotional injury).
98. Fleischer, *supra* n. 94, at 991.
99. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 569-78 (1977) (holding that the right of publicity is a valid cause of action, that the right can trump the First Amendment in certain situations, and that the right can encompass an entertainer's entire act).
100. 498 F.2d 821 (9th Cir. 1974).
101. 849 F.2d 460 (9th Cir. 1988).
102. 978 F.2d 1093 (9th Cir. 1992).
105. *Id.*
the car's overall appearance.\textsuperscript{106} Motschenbacher was driving the car in this particular photograph, though his facial features were not visible.\textsuperscript{107} Several fans and colleagues recognized the car when the ads ran on television and inferred that Motschenbacher was sponsored by Winston cigarettes.\textsuperscript{108} The district court granted summary judgment in favor of R. J. Reynolds, since the car's number was changed and Motschenbacher himself could not be discerned in the photograph.\textsuperscript{109} On appeal, the Ninth Circuit recognized the specific economic nature of the damages inflicted when an identity that has a commercial value is appropriated, stating, "It would be wholly unrealistic to deny that a name, likeness, or other attribute of identity can have commercial value."\textsuperscript{110} Moving away from previous California invasion of privacy decisions that emphasized mental or emotional damages to the plaintiff, the court concluded that

the California appellate courts would, in a case such as this one, afford legal protection to an individual's proprietary interest in his own identity. We need not decide whether they would do so under the rubric of 'privacy,' 'property,' or 'publicity'; we only determine that they would recognize such an interest and protect it.\textsuperscript{111}

The court concluded that, although Motschenbacher's likeness was not recognizable in the commercial, the distinctive markings of the car, which more or less was the plaintiff's identity during races, could (and did) lead to people inferring that he was endorsing Winston cigarettes.\textsuperscript{112}

In \textit{Midler}, the actress/singer Bette Midler sued Ford for exploiting her voice without her consent.\textsuperscript{113} Ford's advertising agency, co-defendant Young & Rubicam, had contacted Midler's manager regarding her singing a song as part of a new advertising campaign.\textsuperscript{114} Since Midler did not do commercials, her manager declined the request.\textsuperscript{115} Young & Rubicam then sought out Ula Hedwig, who had

\begin{enumerate}
\item[106.] Id.
\item[107.] Id.
\item[108.] Id.
\item[109.] Id. at 823.
\item[110.] Id. at 821, 825 n. 10.
\item[111.] Id. at 825-26 (footnotes omitted).
\item[112.] Id. at 827.
\item[113.] 849 F.2d at 461-62.
\item[114.] Id. at 461.
\item[115.] Id.
\end{enumerate}
been a backup singer for Midler for ten years, to sing the song, replicating Midler’s sound and performance style as closely as possible. Ford then aired the advertisement; people affiliated with both Midler and Hedwig noted that the song sounded “exactly” like Midler’s original version. Because Young & Rubicam had a license from the song’s copyright holder regarding its use, the sole issue in the suit was the protection of Midler’s voice. Although the district court described Ford’s and Young & Rubicam’s conduct as theft, it granted summary judgment for the defendants on the basis that it could find no legal principle preventing imitation of Midler’s voice.119

The Ninth Circuit found that because a voice cannot be copyrighted, federal copyright law did not preempt her claim: “[w]hat is put forward as protectable here is more personal than any work of authorship.” Furthermore, because Midler as a rule did not do commercials, there was no unfair competition by the defendants with the market for her voice. Also, California’s misappropriation of identity statute could not help her because the commercials did not use her name, voice, signature, photograph or likeness within the statute’s meaning. However, analogizing from Motschenbacher, the court found that the defendants had appropriated the “attributes” of Midler’s identity. Just as the advertisement in Motschenbacher suggested that he was in it, and therefore affiliated with the defendant’s product, the Ford ad suggested that Midler was affiliated with their product by emphasizing “signs and symbols” associated with her. Because a voice, especially that of a renowned singer, is a unique identifier in which the singer “manifests herself[,] ... [t]o impersonate her voice is to pirate her identity.” The court went on to limit its holding to protecting “a distinctive voice of a professional singer” that is “widely known and is deliberately imitated” from appropriation, and that such appropriation is a taking of the singer’s identity.

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116. Id.
117. Id. at 462.
118. Id.
119. Id.
120. Id.
121. Id. at 463.
123. Midler, 849 F.2d at 463.
124. Id.
125. Id.
126. Id.
127. Id. at 463-64.
Waits v. Frito-Lay, Inc. dealt with a similar issue as Midler — unauthorized appropriation of a singer’s voice via use of a sound-alike. The singer, Tom Waits, had consistently maintained a policy of not endorsing products throughout his career, and made this policy known to the public through various magazine, radio, and newspaper interviews, saying that, in his view, endorsement detracts from a musical artist’s integrity. Frito-Lay, wishing to use the tune of one of Waits’ songs with new lyrics that reflected the wordplay and rhyming of the original in a radio advertisement for SalsaRio Doritos, found a singer who would be able to convey the “feeling” of the song by singing it in Waits’ gravelly style. Despite concerns by some members of Frito-Lay’s advertising agency, Tracy-Locke, about the legal implications of running the ad, Frito-Lay nonetheless chose to air it.

Frito-Lay’s main defense rested on its challenge to the continued viability of Midler as good law in the wake of the Supreme Court’s decision in Bonito Boats, Inc. v. Thunder Craft Boats, Inc., which had affirmed and explained two earlier Supreme Court decisions, Sears Roebuck & Co. v. Stiffel Co. and Compco Corp. v. Day-Brite Lighting. Like the statute granting patent-like protection to boat hull designs that was found to be preempted by federal patent law because such designs were expressly excluded from the federal scheme, so should a challenge to the use of an imitation of a singer’s voice be preempted by federal copyright law. The Ninth Circuit disagreed with Frito-Lay’s reasoning, reminding it that the Supreme Court specifically cautioned in Bonito Boats against reading Sears and Compco for a “broad pre-emptive principle” and had backed away from this kind of sweeping interpretation in decisions subsequent to them. Not only had the Supreme Court affirmed in

128. Waits, 978 F.2d at 1096.
129. Id. at 1097.
130. Id.
131. Id. at 1098.
132. 489 U.S. 141 (1989) (holding that a Florida statute granting perpetual, patent-like protection to boat hull designs, a type of article that was expressly excluded from federal patent protection, was preempted by federal patent law because it directly conflicted with the requirements and underlying policy of the federal patent scheme). See infra, p. 126-27 for further discussion of federal preemption of state intellectual property statutes.
133. 376 U.S. 225 (1964) (holding that publicly known design and utilitarian ideas — here, the design of a floor lamp — are expressly unprotected by the federal patent law).
135. Waits, 978 F.2d at 1099.
136. Id. (citing Bonito Boats, 489 U.S. at 165).
Bonito Boats that the patent and copyright clauses of the Constitution do not automatically deprive states of the power to adopt rules for the protection of intellectual property, the Court also specifically recognized the states’ authority to protect entertainers’ right of publicity in Zacchini. Therefore, held the Ninth Circuit, the entire line of cases dealing with federal preemption of state copyright law up through Bonito Boats supported its holding in Midler. Because Waits’ voice is not copyrightable subject matter, his claim for appropriation of his identity as embodied in his voice was not preempted by federal copyright law, and the trial court correctly applied the elements of voice misappropriation as laid out in Midler. The Ninth Circuit affirmed the judgment for Waits.

The final case, White v. Samsung Electronics America, Inc., expanded further the boundaries of the right of publicity and appeared to cement the general theory of the right: that a celebrity’s investment in her public persona will be protected from appropriation. At issue in White was the use in a print ad for Samsung VCRs of a robot wearing a blond wig and an evening gown turning letters on a television game show set. The robot, through its hair and clothing, as well as the game board with its glowing letter tiles that the robot turned, deliberately referred to the game show “Wheel of Fortune” and its hostess, Vanna White. The ad was captioned, “Longest Running Game Show, 2012 AD,” drawing the connection that both the Samsung VCR and “Wheel of Fortune” would still be going strong at that date. Although Vanna White regularly endorsed various products, she was not consulted about the Samsung ads (unlike other celebrities used in the campaign), nor was she paid. White sued under California’s misappropriation of identity statute, the common law right of publicity, and section 43(a) of the Lanham Act. The Ninth Circuit affirmed the dismissal on summary judgment of her state statute and remanded her Lanham

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137. See U.S. Const. art. 1, § 8, cl. 8.
139. Id. at 1100.
140. See id.
141. See id. at 1112.
143. Id. at *3.
144. Id.
145. Id.
146. Id.
147. Id.
Act and common law right of publicity claims. The following discussion focuses on the court's analysis of the right of publicity claim.

Samsung defended against White's right of publicity claim by stressing that its advertisement had not used her name or likeness. However, the court countered that Samsung had not considered the Motschenbacher and Midler decisions and that a claim of injury to one's right of publicity did not only mean a misappropriation of the individual's name or likeness. The court emphasized that "[t]he right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable," and that "the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff's identity." Samsung had "directly implicated the commercial interests which the right of publicity is designed to protect" through its use of the robot-Vanna — how the appropriation occurred is not important, but rather whether the defendant appropriated. Treating the means of appropriation as dispositive would "eviscerate" the right and "fail to protect those plaintiffs most in need of its protection... The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice." Because the ad clearly referred to White in the specific setting for which she is famous, and White alleged appropriation of her identity, the court found that her claim should not have been dismissed on summary judgment.

Motschenbacher, Midler, Waits, and White demonstrate how the right of publicity has grown beyond the emotional injury requirement of the original invasion of privacy tort to encompass not only a celebrity's name, signature, or physical attributes, such as image or actual voice, but also performance style and attributes. Furthermore, it appears to survive some federal preemption issues, but survival in a specific case will depend on the facts and the area of federal intellectual property law under which a challenger claims encroachment. Although the right of publicity has been explored

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149. Id. at *5.
150. Id. at *8-9.
151. Id. at *9.
152. Id. at *10.
153. Id. at *11.
154. Id. at *13.
most deeply by the Ninth Circuit, other circuits are more or less in accord with the expansive interpretation of the right. Finally, with the Supreme Court's blessing in Zacchini, it appears that the right of publicity is ripe enough to be applied to other aspects of celebrity and entertainment beyond the performing arts — specifically, designers of haute couture.

B. Applying the Right of Publicity to Fashion Design

If a singer's performance style, a game show hostess' attire and stance, a race car driver's car, and a phrase introducing an actor can be deemed to be legally protected as extensions of an individual's public identity, then why shouldn't a designer's style, as evinced in his or her haute couture creations, be similarly protected? Let's see how the right would work when applied to the case of a designer.

First, since the right of publicity is a personal tort, the designer, not the corporation through which he or she markets creations, would be the only one with standing to sue. In the case of deceased designers, such as Coco Chanel, whose work is carried on by a head designer at the corporations they founded, either their heirs would have standing (since the right of publicity is descended in certain jurisdictions) or the head designer would have standing as the successor in interest to the right. It would make more sense for the head designer to bring the suit, since the work being copied would

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155. See e.g. Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (holding that the defendant's marketing of its portable toilets under the brand name "Here's Johnny," the phrase that was used each night on plaintiff Johnny Carson's television show to introduce him, without Carson's permission, constituted an impermissible appropriation of Carson's identity under the right of publicity); contra Stephano v. News Group Publications, Inc., 64 N.Y.2d 174 (1984) (holding that New York does not recognize a common law right of publicity).

156. The head designer makes design decisions for the overall look of all products the design house will produce, and often personally designs the couture items. Although the head designer will be able to incorporate his or her own personal design traits into works produced by the house, most of the products will continue to bear the qualities for which the original designer became famous—for example, although Karl Lagerfeld has taken over the artistic direction of the house of Chanel, the use of quilting, leather and gold braided chains on handbags, and certain brightly colored, soft fabrics accented with embroidery for suits carry on Coco Chanel's creative vision.

157. E.g. Martin Luther King, Jr. Ctr. for Soc. Change v. Am. Heritage Prod., Inc., 296 S.E.2d 697, 705 (Ga. 1982) (holding the right of publicity is distinct from the right of privacy, and therefore descendible under Georgia law); Cal. Civ. Code § 3344.1 (West 2001) (granting protection against the use of a deceased personality's name, voice, signature, photograph, or likeness on products or advertising, and granting possession of this interest to the deceased's spouse, children, grandchildren, or registered successor in interest); contra N.Y. Civ. Rights Laws § 50 (McKinney 2001) (right of publicity actionable only by living person).
really have been created by her, only incorporating traits that the
original designer created and that continue to live in the work made
by the present-day design house.

Second, the designer could sue for common law
misappropriation of the design traits that are the essence of his or her
work. The state common law publicity right is the applicable
document, since most state right of publicity statutes refer specifically
(and exclusively) to name, likeness, signature, or voice. The analysis
of the misappropriation would follow that in *Midler* and *Waits*:
whether the defendant deliberately imitated the designer’s “voice,”
i.e., the embodiment of his design ethos, instead of his style, and
whether the designer’s ethos was sufficiently distinctive and widely
known to give him a protected right in its use. The disputed design
traits would be those that are unique to the designer, that appear as a
theme throughout his work, that express his philosophy of aesthetics
and *Weltanschauung*.

Ultimately, the analysis of the traits would be similar to the
secondary meaning analysis for trade dress, that is, determining
whether purchasers of the fashions bearing the traits associate them
with the producer, the degree and manner of advertising of the traits,
the length and manner of use, and whether the use has been exclusive.
However, because the purpose of the action would be to
vindicate an individual creator’s commercial interest in his
personality as it is expressed in his designs, the analysis would have to
go beyond the ordinary secondary meaning analysis into almost an
art historian’s assessment of a particular artist’s signature style.
Although useful, traditional tools of the secondary meaning analysis
such as consumer surveys would not be necessary because in order to
bring a successful suit under the right of publicity, one usually has to
be well known already. Any type of secondary meaning analysis
would be applied to the designer’s fame, not to the individual works
whose misappropriation underlies the suit.

To give an example of how the traits could be discerned,
consider the couture evening dresses designed by the late Gianni
Versace (and his sister, heir and successor in interest to his design
house, Donatella Versace). Versace’s dresses are heavily influenced

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2001) (statutory right of publicity is only action available in New York).
160. *See* Bharathi, *supra* n. 45, at 1681-82, (citing *Levi Strauss & Co. v. Blue Bell,
Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985)).
by Classical mythology and art, employ long lines and bold colors with delicate, flowing fabric, are often accented with oversized, metal accoutrements, and are deliberately revealing and provocative in every sense of the word. His dresses are remarkably different from one another, but are definitely unmistakable as Versace. Each detail that makes them stand out as his probably could not be granted trademark or trade dress status, but they contribute to his unique imprimatur. The designs are embodiments of his bold, brash personality; they are his performance style, attributes of his identity. In analyzing the misappropriation of a Versace dress by a knockoff, a court would look at what makes Versace Versace, via expert testimony on and pictorial evidence of his collections and the elements that have been present in his style more or less consistently over time.

Third, the designer would sue copyists, such as Allen B. Schwartz, who deliberately copy haute couture and create the same thing, from inferior-quality fabric and other inputs, and sell it for much less money. The changes in fabric quality and color may distinguish the knockoff, but it would be clear what the knockoff is attempting to represent, as it was clear that the slightly altered race car in the disputed Winston cigarette ad belonged to Lothar Motschenbacher and was intended to refer to him. Although the designer and the knockoff artist are not competing directly in the same merchandise market, since consumers of ABS dresses are usually not also consumers of Versace, they are competing in the market for design talent and creativity. The reason knockoff artists are successful is not because their creations possess their own artistic vision, but because people consume them for the fact that they look

161. Indeed, his house's trademark is a gold-colored Medusa's head.

162. For example, the large gold safety pins that held together the left side of the dress that model Elizabeth Hurley wore to the 1994 Academy Awards.

163. A Versace gown's price can be around $20,000. An ABS gown is usually around $250.

164. The facts in Motschenbacher that the court found abhorrent are similar to ABS's practice of naming the knocked-off gowns for the celebrities who wore the originals, e.g., "Gwyneth" (for Gwyneth Paltrow), "Halle" (for Halle Berry), and "Ashley" (for Ashley Judd). ABS by Allen Schwartz, Celebrity Collection <http://www.absstyle.com> (accessed Apr. 23, 2001).

165. Upper middle-class consumers who could afford either an ABS gown or could stretch for a Versace for a truly special occasion could make a difference. Moreover, in markets for accessories such as shoes or handbags, there is probably a larger pool of consumers who could purchase either the high-end designer items or the design knockoffs (as opposed to counterfeits).
like the originals.\textsuperscript{166} This is the entire point of the knockoff industry. This is no different from Young & Rubicam's employing a Bette Midler sound-alike to sing one of her songs when it could not employ Midler herself (and paid the sound-alike much less for her services).

Fourth, the designer would seek damages in the amount of the fair market value of his services as a designer.\textsuperscript{167} Fair market value of design services is a more accurate assessment of what is stolen when a knockoff artist copies a couture designer than lost sales or profits, since, as was discussed above, the two do not compete for sales except from a limited number of consumers. The more well known the designer, the greater the damages would be.\textsuperscript{168} If the trial court found that the knockoff artist had acted with oppression, fraud, or malice, punitive damages might also be awarded.\textsuperscript{169} Since the action would be for the overall theft of the designer's public design identity, there would be no need to request an injunction and meet the burden of irreparable harm — the knockoff artist would be prevented from further copying of the designer's traits by enforcement of the judgment and through the Full Faith and Credit clause.

A designer's asserting his right of publicity would not preclude the knockoff artist from making clothing, but would prevent the knockoff from taking the designer's essence wholesale and profiting from it. Nor would it preclude one of the time-honored traditions of art: acknowledging the sources of one's creative inspiration while turning the sources into something entirely new. It would truly prevent creative identity theft.

III

Could It Work?

A number of potential obstacles to application of the right of publicity present themselves. The first is the possible preemption by federal intellectual property law. The Supreme Court has held that the right of publicity in and of itself does not conflict with and is not automatically preempted by federal intellectual property statutes.\textsuperscript{170}

\begin{itemize}
\item \textsuperscript{166} ABS is now a multi-million dollar company. \textit{ABS by Allen Schwartz, About Us} <http://www.absstyle.com/about> (accessed Apr. 23, 2001).
\item \textsuperscript{167} This was the measure used by the trial court and upheld on appeal in \textit{Waits}, 978 F.2d at 1111.
\item \textsuperscript{168} "Generally, the greater the fame or notoriety of the identity appropriated, the greater will be the extent of the economic injury suffered." \textit{Motschenbacher}, 498 F.2d at 825 n. 11.
\item \textsuperscript{169} \textit{Waits}, 978 F.2d at 1111.
\item \textsuperscript{170} See \textit{Zacchini}, 433 U.S. 562 (discussed \textit{supra} at note 99).
\end{itemize}
However, because the effect of application of the right to a designer’s signature traits would be to prevent outright copying of the designer’s garments, the Copyright, Patent, and Lanham Acts could be implicated. The three main cases on the subject of intellectual property preemption —  

*Sears Roebuck & Co. v. Stiffel Co.*, 171 *Compco Corp. v. Day-Brite Lighting, Inc.*, 172 and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 173 — have addressed state law protection of intellectual property that has been specifically denied protection by federal law.

In *Sears* and *Compco*, the items at issue were lamps, whose designs were originated by the plaintiffs and patented, which were copied and sold at a lower retail price by the defendants. 174 The trial courts found the defendants liable under Illinois unfair competition law. 175 The Supreme Court reversed, holding that because the lamps were unpatentable, they were in the public domain and the defendants had a right to copy them. 176 “To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public something which federal law has said belongs to the public.” 177 States may require that patented or unpatented goods be labeled to prevent customer confusion as to source, but they may not prohibit copying of an unpatented or uncopyrighted article or award damages for doing so. 178 *Bonito Boats* also dealt with a state statute granting patent-like protection, this time a Florida unfair competition statute forbidding the duplication of unpatented boat hulls. 179 The statute was held invalid under the Supremacy Clause because, by granting what was essentially perpetual patent protection, the state went beyond the balance between a limited property right in an idea and the public’s access to knowledge struck by the federal patent scheme. 180

Taken together, *Sears, Compco*, and *Bonito Boats* stand for the

171.  376 U.S. 225.
172.  376 U.S. 234 (following *Sears*, 376 U.S. 225).
173.  489 U.S. 141.
174.  The patents in both cases were found to be invalid at the trial court level, and the patents’ validity was not at issue before the Supreme Court. *Compco*, 376 U.S. at 235; *Sears*, 376 U.S. at 226.
175.  *Compco*, 376 U.S. at 236; *Sears*, 376 U.S. at 227.
177.  *Id.* at 231-32.
178.  *Id.* at 232-33.
179.  *Bonito Boats*, 489 U.S. at 144.
180.  *Id.* at 152.
principle that ideas that are in the public domain must remain there, and states may not "redirect inventive efforts away from the careful criteria of patentability developed by Congress over the last 200 years." Protection of designs under state unfair competition laws is limited only to the context where consumer confusion as to source is likely to result from the copying of a product's nonfunctional aspects that have acquired secondary meaning.

Using the right of publicity to protect designers would not necessarily raise preemption problems if the focus is on the misappropriation of design services, and not the copying of specific articles — although the misappropriation may take the form of an exact copy of a designer's work, usually it takes the essential elements and slightly alters their configuration, e.g., a change of color or use of a lower quality fabric. The theft is of the expression of the designer's personality, not of an idea, which was the cause of the Supreme Court's careful guarding of the federal patent laws in Sears, Compco, and Bonito Boats. Specifically, this expression is a combination of design traits that, when viewed together, represent a designer's identity. The knockoff artist would not be prevented from making a garment that included one trait, but from using them in the combination that signifies the original designer, just as the sound-alikes in Midler and Waits were not allowed to imitate the singers' voices in versions of the singers' own songs.

The protection granted to a designer's design traits by the right of publicity would be similar to the protection granted Zacchini's entire human cannonball act, for which the Supreme Court stated other forms of intellectual property protection were inadequate. If the designer's design identity can be entirely appropriated by someone else, there is no point in the designer's continuing to offer her design services to the public. Furthermore, as the Ninth Circuit discussed in Waits, the Copyright Act does not preempt the state right of publicity when the subject matter "does not come within the subject matter of copyright." Like Bette Midler's and Tom Waits' voices, clothing design traits are not subject matters of copyright.

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181. Id. at 157.
182. Id. at 158.
183. Zacchini, 433 U.S. at 575-76 (discussed supra at note 99) (Defendant news broadcasting company aired plaintiff's entire fifteen-second act, as filmed at a local carnival, on its newscast. The airing was held not to be newsworthy and therefore protectable by the First Amendment because it took away from the plaintiff the sale of his performance services to the public; without the right of publicity the plaintiff would have no means by which to recover against the broadcasting company.).
Since the elements used to determine whether appropriation has taken place are “different in kind” from those used in a copyright infringement case, federal copyright law would not preempt the misappropriation claim. The second primary objection to the protection of haute couture clothing under a right of publicity would be under antitrust law. Protecting a designer's identity as embodied in clothing would effectively grant the designer a monopoly over that specific combination of traits that evokes his personality. Indeed, antitrust concerns have traditionally been one of the reasons why the United States has declined copyright protection to clothing — having a limited number of protected designs on the market would limit consumer choice and raise prices. However, the present scheme of non-protection is already anti-competitive in that it serves as a barrier to entry into the field of clothing design by new designers — what is the point of being creative, innovative, and talented when your work will be copied and your price undercut almost as soon as you become popular? The public's clothing style consumption choices are circumscribed by having fewer competing designers from which to choose and from seeing similar articles of clothing on sale from different sources.

Granting protection to a designer's haute couture design identity and integrity would not be anti-competitive, at least not more so than the present situation. A grant of protection would create an incentive for designers to come up with their own design identities. This, in turn, would benefit consumers because there would be a wider array of styles from which to choose. Also, it would allow designers to expand their protected design traits into less expensive, prêt-a-porter lines. Consumers would then have increased access to previously unaffordable designs by famous designers, at a low price, and whose quality and originality will be assured.

IV
Conclusion

It is clear that fashion, no less than painting, sculpture, or music, is art, and that its creators are as deserving of some legal protection for their endeavors as painters, sculptors, composers, musicians, and
singers. For the United States to offer fashion design little protection under its copyright, trademark/trade dress, and design patent laws is ridiculous given that the United States' main export is arts and entertainment. The United States is home to a multi-billion-dollar fashion industry that is consistently put at a competitive disadvantage in the world market for fashion by lawmakers who cannot get past the idea that clothing is useful and nothing more. Moreover, these lawmakers are ignoring their duties under the TRIPS Agreement and Berne Convention, which promise national treatment to the creative products of their members. While the United States demands increased protection abroad for other types of intellectual property, it ignores the demands of a huge creative industry at home. This bizarre blindness towards the inherent artistry and creativity of high fashion can no longer be ignored.

Where other forms of United States intellectual property law have failed fashion, perhaps the right of publicity can compensate and protect a designer's creative identities. A designer's services — and the traits of a garment that consumers expect to indicate the presence of said designer's services — would be recognized as something unique and intimately connected to the designer, much like a singer's voice is intimately and personally connected to her. Because the right of publicity is a personal right, and existing federal intellectual property law does not protect the subject matter of fashion design, designers should be able to assert the right without encountering preemption problems. Furthermore, protection of a designer's design identity would increase competitiveness in the fashion market by allowing more designers, each with different identities, to enter the market and to expand into differently-priced lines of clothing. The result would be more fashion choices for consumers of a range of income levels.

Some who already oppose the right of publicity as a body of law of dubious merit may consider its application to haute couture fashion design to be a ridiculous expansion of an already ridiculous "right." If so, there is an easy solution — amend the Copyright Act to include protection for fashion works and put them into the existing pantheon of Art that the United States deems worthy of fostering. Assuage the anti-monopoly Jonahs by granting a very short term of protection, such as a year. But above all, as citizens of a civilized country that purports to nurture the arts, we must continue to cultivate true creativity. Applying the right of publicity to designers and their works would bless the fields of fashion with the affirmative protection they deserve.