Hung out to Dry: Clothing Design Protection Pitfalls in United States Law

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by

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art 'ärt n. 4 a : the conscious use of skill and creative imagination especially in the production of aesthetic objects; also: works so produced1
design di-'zIn n. 6 : the arrangement of elements or details in a product or work of art 7 : a decorative pattern 8 : the creative art of executing aesthetic or functional designs2

I

Introduction

The distinction between art and design has historically been between fine art and the lesser or useful arts. Sadly, clothing design tends to fall in the latter category and is largely unprotected under United States ("U.S.") law, despite the U.S.' general trend toward longer, stronger intellectual property protection in many other categories. Apparel constitutes about 0.4% of U.S. Gross Domestic Product, a small but important segment of the U.S. economy. The majority of clothing sold in the United States is manufactured in low-wage countries and purchased from discount retail stores. Discount clothing is the fastest growing segment of the apparel sector, with sales rising by 15% to $60 billion over the 1998 – 2000 period. Additionally, an estimated 75% of all shoes purchased in the United States are bought at discount retailers such as Wal-Mart. In order to compete effectively in the discount retail space, U.S. apparel companies are under extreme pressure to reduce costs. One way to do this is to produce knockoffs of popular apparel designs using less expensive materials and outsourcing labor abroad. This is an acceptable practice in this country as for the most part; clothing design is unprotected as an intellectual property right. While one has only to look at the recent controversy over the distribution of black berets to all members of the U.S. Army to realize the importance of clothing to Americans’ sense of identity, it has also been ingrained in the American psyche that excellent clothing design is appreciated but not worth paying for. This article will explore the shortcomings in

2. Id.
current patent, copyright, and trademark laws with respect to clothing designs; discuss the reasons why design legislation has often been introduced in this country but never enacted; and, finally, argue that the enactment of clothing design protection laws would benefit both U.S. consumers and clothing designers.

II

Clothing Design Protection Under Patent Law

"It is with some trepidation that I venture to determine what is the 'ordinary skill' of designers of intimate articles of feminine apparel because such skill, at least to a mere man, seems to have no ordinary limitations."\(^3\)

Utilitarian items, such as clothing, are the proper realm of patent law. Under its umbrella of coverage are utility patents, design patents, plant patents, and business method patents. Historically, clothing designs have obtained some protection under both utility patent and design patent protection.

A. Utility Patents

Patents typically protect works of scientific or engineering merit, or in Constitutional language, "discoveries" in the "useful arts."\(^4\) The first patent statute was enacted in 1790, assigning the task of determining whether inventions were "sufficiently useful and important" to merit a patent to a distinguished group of federal officers: the Secretary of State, the Secretary of War and the Attorney General.\(^5\) Patent laws have evolved continually from that time, balancing a delicate tension between "grant[ing] a monopoly for every trifling device"\(^6\) and encouraging innovation and the disclosure of trade secrets. In the current patent statute, The Patent Act of 1952 ("The Patent Act"), patentable inventions are divided into four general categories: processes, machines, articles of manufacture,\(^7\) or

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6. Id. at § 5 (citing Justice Bradley in Atlantic Works v. Brady, 107 U.S. 192 (1883)).
7. Id. at § 1.02. ("[I]t is the residual class of 'product' patent—encompassing all man-made items not found in substantially the same form in nature that are neither machines nor compositions of matter.")
Classifications of matter. Classification into a category is of little importance to the rights the patent owner obtains; it is generally conceded that the categories of machine, articles of manufacture and composition of matter together include the vast majority of manmade structures, referred to as “product” patents. Examples of utility patents granted for clothing include: “[b]ra with straps for matching clothing,” “odor absorbing clothing,” and a cape with a special pocket by which the cape can be folded into a pillow or used to store gloves when not so folded.

In order to be eligible for utility patent protection, an invention must satisfy several criteria set forth in sections 102 and 103 of the Patent Act. These requirements are generally reduced to four standards: originality, utility, novelty, and nonobviousness. The first requirement, originality, limits the filing of patent applications only to the true inventor of an invention. This requirement restricts patent grants to the first person or persons who discovered the invention and not to a subsequent inventor or someone who has surreptitiously appropriated the invention. This requirement is of particular importance in the U.S. patent system, where patent rights are granted on a “first to invent” basis rather than on a “first to file” basis, the prevailing international standard. The second requirement, utility, mandates that an invention must perform a positive benefit to society. This is measured by a three-part test: the invention must be capable of producing the intended result, perform some minimum human purpose, and not serve a purpose that is illegal, immoral or contrary to public policy. The third requirement, novelty, “lies at the heart of the patent system” and requires a stringent showing that all of the features of a proposed invention (1) were not patented or otherwise described in a printed publication anywhere in the world more than one year prior to the filing of the patent application, (2)
were not known or used in the U.S. more than one year prior to the filing of the patent application, and (3) were not previously invented by a U.S. inventor more than one year prior to the filing of the patent application.\textsuperscript{19} If an invention is not novel, it is unpatentable.\textsuperscript{20}

Finally, the inventor must also demonstrate a fourth requirement, nonobviousness.\textsuperscript{21} Nonobviousness requires that the invention not be “obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”\textsuperscript{22} In other words, the invention should not be readily apparent to the average person skilled in that field based on previously disclosed inventions.\textsuperscript{23} To determine whether a claimed invention was obvious, the following factors are considered: the scope and content of the prior art, the differences between the prior art and the patent claims at issue, and the level of ordinary skill in the pertinent art.\textsuperscript{24} Secondary factors, such as the degree of commercial success of the invention, whether the invention satisfied a long-felt need, and whether others expressed skepticism that the invention could be made, may also be considered in the obviousness determination.\textsuperscript{25}

After satisfying the four tests outlined above, the invention must then be disclosed and described in the patent application. The patent must disclose both how to make and how to use the invention in a manner such that a person “skilled in the art” could reproduce and use the invention.\textsuperscript{26} In exchange for this disclosure, the inventor receives the exclusive right to manufacture and sell the invention for a period of twenty years.\textsuperscript{27} The patent claims determine the scope of protection afforded by a utility patent, with an emphasis on the literal

\textsuperscript{19} Id. at § 3.01; see also 35 U.S.C. § 102 (a), (b), (e), and (g).
\textsuperscript{20} Id. at § 3.01.
\textsuperscript{22} Id.
language of the claims. Claims are therefore of key importance and are drafted as broadly as possible to prevent others from designing around the patent claims to create a non-infringing product. For example, U.S. Patent No. 6,212,686 for an "Expandable shirt collar" has 17 claims. The first claim is broadest and describes the invention as it currently exists. The other 16 claims are narrower dependent claims and describe alternate methods of achieving the same result, including use of different materials and different methods of attaching the collar to the neckline of the shirt.

Should the patent issue, the inventor has the right to sue unauthorized manufacturers of the invention for infringement, regardless of whether the infringement is innocent or intentional. In order to determine whether a patent has been infringed, the court conducts an infringement proceeding. During this proceeding, the court will determine the exact meaning of the patent claims and compare the accused device to the patent claims to determine whether every limitation set forth in the patent claim is present in the infringing device either literally or by a substantial equivalent. Therefore, in order to avoid a finding of infringement, a copyist must design around the claims of a utility patent, creating a product that is essentially a good substitute for the patented invention rather than an exact replacement.

Because redesigns of existing patents are often difficult to achieve, clothing designs that qualify for utility patent protection generally receive strong protection, particularly if the underlying utility patent technology dictates the outward appearance of the article. The weakness of utility patents for clothing, however, is that there is nothing to restrict a copyist from designing a garment with a similar appearance but a different underlying technology. For example, in Flanagan v. Continental Apparel Corp., while three of the defendant's sports bras were similar enough to the plaintiff's to

30. Id.
31. Id.
32. See Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995).
warrant the plaintiff filing for patent infringement, only one of the bras was ultimately deemed infringing.\(^ {35}\) To obtain a monopoly on the appearance of the invention, inventors must look to design patent law.

## B. Design Patents

Congress enacted the first design patent laws in 1841.\(^ {36}\) The subject matter covered by these laws included:

any new and original design for the printing of woolen, silk, cotton, or other fabrics . . . any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture.\(^ {37}\)

In order to obtain such a patent, a showing had to be made that the inventor had invested time, effort and expense to develop the design and that the design had not been known or used by others prior to the filing.\(^ {38}\) A design patent initially afforded protection for only seven years, while utility patents received protection for fourteen years.\(^ {39}\) In the latest revision of design patent laws, The Patent Act, Congress changed the lengthy list of covered subject matter to a simple statement that “any new, original, and ornamental design for an article of manufacture”\(^ {40}\) is eligible for protection for a fourteen year term,\(^ {41}\) six years less than the twenty year term granted utility patents.\(^ {42}\)

Design patents are a strange compromise between copyright, trademark and patent protections. While the threshold requirement

\(^{35}\) Id. at *19.

\(^{36}\) Chisum, supra n. 5, at § 1.04.

\(^{37}\) Id.

\(^{38}\) Id.

\(^{39}\) Id.


\(^{42}\) 35 U.S.C. § 154(a)(2) (2000). There is not much legislative history to be found as to how Congress determined the length of design patent protection. In a 1914 hearing on proposed design legislation, The Commission of Patents, who had proposed a period of 20 years of protection, justified his choice as follows: “I do not particularly care as to the length of time, but it seemed to me that perhaps 20 years was not unreasonable.” Registration of Designs: Hearing on H.R. 11321 Before the House Comm. on Patents, 63d Cong. (1914) (statement of Hon. Thomas Ewing, U.S. Commissioner of Patents).
for a copyright is a minimum standard of originality, design patents require a stricter combination threshold standard of originality, novelty, and nonobviousness, and also require that the design be ornamental. Design patents do not require a showing of utility as is required for utility patents. Indeed, articles dictated solely by considerations of function are barred from design patent protection, similar to functionality restrictions in trademark law. The litmus test for functionality of design patents has been formulated as follows:

the design of a useful article is deemed to be functional when the appearance of the claimed design is ‘dictated by’ the use or purpose of the article. . . . When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.

Just because a design consists of some utilitarian elements will not result in a denial of protection so long as the design viewed as a whole is not dictated by the utilitarian purpose.

While demonstrating that a design is not dictated by functionality concerns is one challenge, the primary difficulty clothing designs have faced in achieving design patent protection is demonstrating nonobviousness. In the clothing design field, the standard courts have applied is whether the design would be obvious to a skilled dressmaker “who has, or is chargeable with, knowledge of the prior art.” The judiciary developed this standard to set a very high bar for new designs. “[M]ore is required for a valid design patent than that the design be new and pleasing enough to catch the trade; it must be the product of ‘invention,’ by which is meant that conception of the

43. Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 2.01[A] (Lexis Publg. 1999) (“Originality in the copyright sense means only that the work owes its origin to the author, i.e., is independently created, and not copied from other works.”); see also *Alfred Bell & Co. Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951) (“[N]othing in the Constitution commands that copyrighted matter be strikingly unique or novel.”).
45. *See In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993) (“Unlike an invention in a utility patent, a patented ornamental design has no use other than its visual appearance.”).
49. *Id.* (deeming valid a design patent for an athletic shoe even though some of the design elements added to the cushioning and support features of the shoe).
design must demand some exceptional talent beyond the skill of the ordinary designer." Varying the scale of a prior known design is not sufficient, nor is combining known design elements in a novel way. In fact, the nonobviousness standard is so demanding that even new clothing designs that do not incorporate any known design elements can still fail to qualify for design patent protection. Some courts have expressed doubts that clothing could ever qualify for design patent protection, and there is some suggestion that the main use for design patents is not to protect design but rather as a fallback for inventions that cannot obtain utility patent protection.

If a clothing design is able to qualify for design patent protection, the scope of protection can be substantial. Design patents have a single claim and the scope of protection "is limited to what is shown

51. Id. (citing Nat Lewis Purses, Inc. v. Carole Bags, Inc., 83 F.2d 475 (2d Cir. 1936)).
52. Nat Lewis Purses, Inc., 83 F.2d at 476 (finding invalid a design patent for a compact purse because "no more was really involved than changing the size" of a prior design).
53. Neufeld-Furst & Co., Inc., 112 F.2d at 716 (finding that plaintiff's dress design was merely a combination of dress design elements known in the prior art and therefore invalid); see also H.W. Gossard Co., 143 F. Supp. at 143 (denying protection for the novel arrangement of an elastic trim on a girdle which encircled the leg and then angled toward the front panel of the girdle).
54. White v. Lombardy Dresses, Inc., 40 F. Supp. 216 (S.D.N.Y. 1941) (holding that a style of "junior type" dresses by Syd Novak knocked off by the Defendant for $5 U.S. dollars ("USD") did not satisfy the novelty and nonobviousness standards, even though the dresses did not contain known dress design elements nor were they combinations of prior known dress designs).
55. H.W. Gossard Co., 143 F. Supp. at 143 ("In fact, it has been said that to invent anything in the way of a new dress design, however temporarily attractive such design may be, becomes almost impossible when one considers the enormous amount of fashion advertising, design service, magazines, and the host of skillful and intelligent dressmakers." (citations omitted); Lombardy Dresses, 40 F. Supp. at 217 ("In this case alone we have the claim made by Novak that he has conceived dozens of inventions of dresses. Each season, the claim is made, that invention after invention is brought forth, yet, the state of the art makes the correctness of such assertion more than doubtful, and while the granting of the patent carries the weight which is attached to such act of the government, the facts on the trial and the state of the art duly proved, makes one wonder how any patent on such dresses can be obtained provided true invention is required. A dress may be new, original and attractive and yet not be patentable unless this faculty of invention is likewise present.").
56. H.R. Comm. on Pat., Registration of Designs: Hearing on H.R. 11321, 63d Cong. 97 (May 27, 1914) (statement of E. W. Bradford, Esq., Representing the National Design Registration League, Washington D.C.) (discussing the example of a clothesline holder which had obtained design patent protection but which Bradford could find nothing "ornamental or attractive" about it); see Levi Strauss & Co. v. Golden Trade S.r.L., 1995 WL 710822 at *9 (S.D.N.Y. Dec. 1, 1995) (deeming several claims in a utility patent on stonewashing denim that related to the end appearance of the fabric invalid and more properly the subject of design patent law).
in the application drawings." In order to prove infringement of a design patent, it is not necessary to show that the infringing design is identical to the original, but that it must be similar enough "such that an ordinary observer would be likely to purchase one thinking it was the other." When making the comparison, a court should consider the design in its entirety, and compare the accused design to the claimed design and not to the commercial embodiment of the design in a product. Additionally, infringement of a design patent cannot be disclaimed by prominently labeling a look-alike product with another trademark.

This "ordinary observer" test is clearly difficult to apply and the results are often very subjective. In *Avia Group International v. L.A. Gear California, Inc.*, the Federal Circuit upheld the district court's finding that defendant's emulation of the plaintiff's tennis shoe sole was similar enough to infringe the design patent, although not exact in every detail. In *Rockport Company, Inc. v. Deer Stags, Inc.*, the court found that the design patent for walking shoes was infringed even though the defendant's shoes had altered the shape of the mud guard as well as the "double layer of shoe extending from the bottom of the eyestay to between the second and third eyelets." In *Aerogroup International v. Marlboro Footworks*, the court engaged in a detailed comparison of the soles of five of defendant's shoes against plaintiff's design patent and ultimately determined four were not infringing and one possibly was, though the exact reason for this conclusion is not entirely clear.

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57. *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988) ("Design patents have almost no scope."); see also *L.A. Gear*, 988 F.2d at 1122 ("A patented design is ordinarily claimed 'as shown,' that is, by its drawing.").


60. *L.A. Gear, Inc.*, 988 F.2d at 1125.

61. 853 F.2d 1557 (Fed. Cir. 1988).

62. *Id.* at 1565-66 ("[W]e have in the incriminated or accused sole copying of the swirl effect, copying of the separate coloration and configuration of the pivot point, though without the red dot.").


64. *Id.* at 195-96.


66. *Id.* at *3-4. The court noted the distinguishing aspects of plaintiff's sole were its border, closely spaced horizontal lines and diamond shaped recesses. All of defendant's soles, including the possibly infringing heel, had significant variations, including a large diamond in the middle of each heel. *Id.* at *8-13.
C. Patent Law as a Model for Design Protection

While utility patents continue to serve a purpose for clothing designs, which are functional in some way beyond mere decoration of the body, this protection covers only a small percentage of the clothing designs created. Design patents, while intended to provide broader protection, are difficult to obtain because of the nonobvious requirement. However, even if design patents were easier to obtain, they are an unattractive form of design protection for the clothing industry for many reasons. First, the expense involved in obtaining a design patent can be considerable. In addition to paying attorney fees to draft the patent application, the applicant must also pay filing and issuance fees. The current fee for filing a design patent application with the U.S. Patent and Trademark Office ranges from $160 to $320 USD and the issuance fee ranges from $220 to $440 USD. Also, each design patent must be subjected to a lengthy examination process before the design patent is issued, with common delays at the patent office. In 1975, the Patent Office had a goal of reducing average pendency for design patent applications to 18 months. In 1997, the average pendency for a patent application was 22.2 months with a goal to reduce pendency to 12 months or less for all inventions. With the business lifespan of the average clothing design lasting only one season (a few months to a year at most) design patent protection would come far too late to be of much value.

67. U.S. Patent and Trademark Office, Patent Filing Fees, Patent Post-Allowance Fees <http://www.uspto.gov/web/offices/ac/qs/ope/1999/fee20001001.htm> (accessed May 5, 2001). Note that in 1914, when design patent fees were only $10 ($178 in 2001 USD) for a 3-year term of protection, designers considered the fee “absolutely prohibit[ive]” and a proposal to lower the fee to $1 ($17.85 in 2001 USD) was even considered exorbitant. Registration of Designs, supra n. 56, at 211.


70. Reebok Intl. v. J. Baker, Inc., 32 F.3d 1552, 1558 (Fed. Cir. 1994) (The court determined the scope of the remedies for infringement based upon whether the patentee and the infringer were still selling the patented item. Reebok was no longer manufacturing the SHAQ I shoe by the time its design patent was issued. Upon the issuance of the patent, Reebok sued Baker who had begun manufacturing the infringing shoes during the pendency of the design patent. Since neither Reebok nor Baker was manufacturing SHAQ I shoes by the time the suit was instituted, the court found that an injunction against sale of 33,000 pairs of infringing shoes still in Baker’s stock was unwarranted. Reebok’s reputation would not be harmed by the sale and could be addressed by money damages.).
The patent process favors inventions with a long or unlimited commercial life, primarily in the utility patent arena. Utility patent applicants receive several advantages that design patent applicants do not. For example, a utility patent applicant may opt for a one-year provisional patent in which the inventor submits a simpler application containing a description and drawings of the invention and pays a lower fee. Under the provisional patent process, the inventor also gains an experimental period in which to determine the marketability of the invention. No such opportunity to test the waters is afforded for design patent applicants. Likewise, while utility patent applicants are allowed to use their inventions in an experimental way more than one year before filing a patent application without risk of a novelty challenge, no such defense is recognized for design patents.

These limitations only add to designers’ frustrations with the patent system. After many years of failing to shoehorn clothing designs into the rigid design patent scheme presumably intended for their protection, designers have sought a more sympathetic ear from other forms of intellectual property protection.

III
Clothing and Copyright

"Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art."74

U.S. copyright law applies to “original works of authorship fixed in any tangible medium of expression” that are created under the guise of eight enumerated categories of works recognized by the 1976 Copyright Act ("the Copyright Act").75 While clothing does not fit

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71. 35 U.S.C. § 111(b) (West 2000); see also supra. n. 67.
73. In re Mann, 861 F.2d at 1582 ("We see no way in which an ornamental design for an article of manufacture can be subject to the 'experimental use' exception applicable in the case of functioning machines, manufactures, or processes. Obtaining the reactions of people to a design—whether or not they like it—is not 'experimentation' in that sense. In the case of a design, if market testing shows that it has no appeal and the design is changed, the result is a new and different design; the original design remains just what it was.").
75. 17 U.S.C. § 102(a) (2000). The eight categories of works are: literary works; musical works; dramatic works; pantomimes and choreographic works; pictorial, graphic and sculptural works; motion pictures and audiovisual works; sound recordings; and architectural works.
readily under any category in this list, the best fit would likely be “pictorial, graphic and sculptural works,” i.e., clothing as a wearable sculpture.76 If this classification were available, clothing would be placed on a par with other works of art. Clothing designers would obtain the benefits of a relatively easy and inexpensive registration process and the risk of overprotection and stifling of creativity would be minimized through fair use and independent origination defenses. However, this form of copyright protection is not available to clothing designers, due primarily to a policy known as the “useful articles doctrine” which limits copyright protection for items with a functional as well as artistic purpose. There are also objections on artistic grounds as to whether clothing design really ought to qualify as “art.”

A. The Useful Articles Doctrine

Section 113 of the Copyright Act, informs us that there is an important exception to the protection of works in the pictorial, graphic and sculptural category. “This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under [federal or state] law.”77 This statement is commonly known as the “useful articles” doctrine and expresses Congress’ desire to limit the ability of manufacturers to monopolize designs dictated solely by the function the article is to serve, such that the first manufacturer to adopt the design would have the exclusive right to produce those kinds of products.78 The rationale of the useful articles doctrine is an attempt to draw a line in the sand between copyright

76. Note, however, an argument could be made that clothing designs might be classified as a type of “architectural works” under § 102(a)(8). 17 U.S.C. § 102(a)(8). However, § 101 defines architectural work as “the design of a building” and clothing as a “wearable building” is more of a stretch than clothing as a “wearable sculpture” (although some analogies could be drawn between foundation garments and building frames). 17 U.S.C. § 101 (2000).
78. While the legislative history does not give an exact rationale for the useful articles doctrine, a “useful article” is defined in § 101 of the 1976 Copyright Act as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” See generally H.R. Rpt. 94-1476, at 54 (Sept. 3, 1976) (reprinted in 1976 U.S.C.C.A.N. 5659, 5667 (mentioning the Mazer v. Stein, 347 U.S. 201, opinion as a basis for much of the useful articles doctrine)); Mazer, 347 U.S. at 217-18 (recognizing that there is some tension between patent law and copyright law as to the protection of useful articles but determining that copyright protection for useful articles can exist regardless of patent law protection).
and patent law.

The useful articles doctrine is an important consideration when dealing with works of "applied art,"[79] where artistic works are merged with functional items normally covered under patent law. Examples of applied art include artistic designs printed onto fabrics or wallpaper, tiles, or other media. The concern in applied art situations is whether the work must qualify for protection under patent law, copyright law, or perhaps both. Before the enactment of the 1976 Copyright Act, the leading case on the subject of applied art was *Mazer v. Stein*, in which the Supreme Court determined that a sculptured lamp base could be subject to copyright protection because the base, when separated from the lamp, had artistic merit.[80] Congress adopted the *Mazer* approach in the drafting of the 1976 Copyright Act and devised a "separability" test for useful articles in which one looks at the item in question to determine whether the "pictorial, graphic, or sculptural" parts of the work can be either physically or conceptually separated from the utilitarian, functional parts of the work.[81] The parts of the work that can be physically removed and displayed as works of art or that can be thought of separately as artistic works are protected under copyright law, while the overall combination of the copyrighted and functional parts is not.[82] Congress gives us the example of silver flatware with a floral design on the handle.[83] The design of the eating utensil part of the flatware, being a useful article that does more than convey its appearance or information, is not protected, but the floral design itself is protected.[84] Therefore, a copyist could produce floral flatware

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79. See J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 Duke L.J. 1143, 1146 n. 7 (1983) ("Applied art is not defined by any copyright legislation, although nearly all domestic copyright laws expressly mention applied art among the works protected."); see also H.R. Rpt. 94-1476, at 54 (reprinted in 1976 U.S.C.C.A.N. at 5667) ("In accordance with the Supreme Court’s decision in *Mazer v. Stein*... works of applied art encompass all original pictorial, graphic and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection.").

80. 347 U.S. at 218.

81. See H.R. Rpt. 94-1476, at 55 (reprinted in 1976 U.S.C.C.A.N. at 5668) ("Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.").

82. Id. ("[C]opyright protection would extend only to [the copyrighted] element and would not cover the over-all configuration of the utilitarian article as such.").


84. Id.
nearly identical to the original without fear of infringement, so long as the handle incorporated a sufficiently different floral design and the flatware was not otherwise protected under design patent or trademark law.

Clothing is clearly a “useful article,” whether one considers its function to be protecting its wearer from the elements, ensuring modesty, or symbolizing occupation, rank or status. Clothing is much more than decoration for the body. Thus, in order for a clothing design to qualify as protected under U.S. copyright law, the design must meet the separability test outlined above. Some aspects of clothing design will easily meet this test. For example, a cabled design on a sweater, a geometric design to be printed on fabrics or an image screen printed on a T-shirt could all be separable from the garment, and therefore, copyrightable. The difficulty with this test for clothing, however, lies in the fact that the majority of skill in designing clothing lies in determining the correct shape and fit of the clothing, i.e. creating a flattering neckline, designing the drape of a sleeve, or tailoring a suit. These are all elements that cannot be physically separated from the clothing itself and are difficult, if not impossible, to separate conceptually.

Conceptual separability is not an easy concept to understand or formulate a consistent test for, as witnessed by the Second Circuit’s trio of opinions on the matter. In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, the Second Circuit determined that a belt buckle design could be copyrightable. The court applied a conceptual separability test where an item could be copyrightable if the decorative or aesthetically pleasing aspect was “primary” and the utilitarian function is “secondary.” In this case, the belt buckles were at times worn as decorative jewelry on other parts of the body. The court determined that the frequency of the utilitarian use versus the

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88. As Germano Celant describes, “The cut is the soul of clothing. It severs the endless thread of a garment as the simple container and portrait of the human figure and transforms it into a creative act, a language that builds new objects.” Germano Celant, *To Cut is to Think*, in *Art/Fashion* 22 (Germano Celant ed., 1997).
89. 632 F.2d 989 (2d Cir. 1980).
90. *Id.* at 993.
91. *Id.*
frequency of aesthetic use was not a factor.92

Five years after Kieselstein-Cord, a dissenting judge in the Second Circuit advanced a second conceptual separability test in Carol Barnhart Inc. v. Economy Cover, Corp.93 In this case, Barnhart had designed dress forms for the display of clothing which the court ultimately deemed uncopyrightable under the useful articles doctrine.94 The test for conceptual separability advanced by the dissent was whether “the article [stimulates] in the mind of the [ordinary, reasonable] beholder a concept that is separate from the concept evoked by the utilitarian function.”95 Clearly, this is a very subjective test, involving the ordinary observer's personal conception of what constitutes art. The dissenting judge realized this and could only lament that “as long as ‘conceptual separability’ determines whether the design of a useful article is copyrightable, some threshold assessment of art is inevitable.”96

Finally, in Brandir International, Inc. v. Cascade Pacific Lumber Company,97 the Second Circuit had to determine whether a curved S-shape bike rack could qualify as a sculpture.98 The court framed the test for conceptual separability this time as whether the design elements could be identified as reflecting the designer's artistic judgment and not dictated by functional influences.99 In this instance, there was no copyright protection in the work because the court deemed the S-shaped curves in the bike rack were mandated by its functional purpose and, therefore, did not involve the designer's artistic judgment.100

This tangled spaghetti of separability tests is confusing and subjective to say the least. A clothing designer choosing to assert copyrightability for her creations therefore has three options: argue for complete copyrightability of the designs addressing each of the separability tests; find a way to define the designs as something other than a useful article and avoid the separability tests altogether or settle for partial copyrightability for judicially recognized separable aspects of the designs. Designers have used all three tactics.

92. Id.
94. Id. at 412.
95. Id. (Newman, J., dissenting).
96. Id. at 423 (Newman, J., dissenting).
97. 834 F.2d 1142 (2d. Cir. 1987).
98. Id.
99. Id. at 1145.
100. Id. at 1148.
B. Working Around the Useful Articles Doctrine: Clothing As Art

To avoid the useful articles doctrine, clothing designers have attempted to argue that their designs are not useful articles at all, but rather, works of art that just happen to fit the body. In the Ninth Circuit case of *Poe v. Missing Persons*,\(^{101}\) the designer of a swimsuit made of clear plastic and filled with crushed rock made for an art exhibition, successfully sued for copyright infringement when a member of a rock band wore the swimsuit on the band's album cover.\(^{102}\) The *Poe* court reversed a finding of summary judgment for the band based on the useful articles doctrine finding that the swimsuit was a work of art and not a useful article and therefore protected under copyright law.\(^{103}\) The court suggested that evidence useful to distinguish between works of art and useful articles includes: expert evidence; the creator's intent when making the work (i.e., did the creator intend to make a work of art that just happens to look like clothing or did the creator intend to create clothing which was eventually recognized as art); custom and usage in the art trade regarding such articles; and the marketability of the item as a work of art.\(^{104}\)

While *Poe* was a welcome recognition that clothing design can sometimes achieve the status of art, subsequent cases in the Ninth Circuit indicate that *Poe* is likely to be a rare exception. The recent case of *Lim v. Green*,\(^{105}\) demonstrates that the *Poe* exception for clothing will not extend to works that have been mass-produced or that were designed with the intent that they might someday be mass-produced. In *Lim*, Lim claimed that his “Scarf Cap” designed for motorcycle riders was a “soft sculpture.”\(^{106}\) The court quickly dismissed this argument because Lim designed the Scarf Cap with the intent that Harley Davidson might be interested in purchasing the design for its line of motorcycle accessories and because Lim had caused the item to be mass-produced.\(^{107}\) As much of clothing is

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101. 745 F.2d 1238 (9th Cir. 1984).
102. *Id.* at 1241.
103. *Id.* at 1242.
104. *Id.* at 1243.
106. *Id.* at *3.
107. *Id.* Note that this formulation of the useful articles doctrine contradicts the legislative intent. Legislative commentary on the useful articles doctrine states, “works of ‘applied art’ encompass all original pictorial, graphic and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent
designed to be mass-produced, the *Poe* argument cannot be used as a protection mechanism in the large majority of cases. One interpretation of the *Poe* test, demonstrating its limited coverage, is that copyright protection will only attach to shapes that are "independent of the human body shape (beyond mere accentuation of a feature, such as padded shoulders)."\(^{108}\)

Other circuits have developed their own lines of cases on the issue of clothing as art. In *Whimsicality v. Rubie's Costume Company*,\(^ {109}\) the Second Circuit utilized the separability test developed in *Brandir* to determine that Halloween costumes were not copyrightable because "the very decorative elements that stand out [are] intrinsic to the decorative function of the clothing."\(^ {110}\) *Whimsicality* was cited in *Knitwaves, Inc. v. Lollytogs, Ltd.* for the proposition that "clothes are not copyrightable" because they are useful articles\(^ {111}\) as well as in cases from other circuits.\(^ {112}\) The *Knitwaves* court, however, did recognize copyright infringement for sweater designs of leaves and acorns, because fabric designs are considered "writings" and are therefore protected under copyright law.\(^ {113}\)

The Third Circuit has yet another view. In *Masquerade Novelty, Inc. v. Unique Industries, Inc.*,\(^ {114}\) the court determined that animal nose masks were copyrightable as soft sculptures because their only utility was in evoking a humorous response.\(^ {115}\) The court indicated that evoking a human response is a function served by many copyrightable works.\(^ {116}\) "The utilitarian nature of an animal nose mask or a painting of the crucifixion of Jesus Christ inheres solely in its protection." H.R. Rpt. 94-1476, at 54 (1976) (reprinted in 1976 U.S.C.C.A.N. at 5667).

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109. 891 F.2d 452 (2d Cir. 1989).
110. *Id.* at 455.
111. 71 F.3d 996, 1002 (2d Cir. 1995), aff'd, 1996 U.S. App. LEXIS 30737 (2d Cir. Nov. 22, 1996) (citing *Whimsicality*, 891 F.2d 452, 455 (2d Cir. 1989)); see also *Adelman v. Summers & Gordon, Inc.*, 112 F. Supp. 187, 189 (S.D.N.Y. 1934) ("There are no provisions in the Copyright Law for protecting fashions for dresses. The right to make and sell an artistically designed garment may under proper circumstances be obtained by a design patent issued from the Patent Office but not by copyright.").
113. *Knitwaves*, 71 F.3d at 1003 (citations omitted).
114. 912 F.2d 663 (3d Cir. 1990).
115. *Id.* at 669.
116. *Id.* at 771.
appearance, regardless of the fact that the nose mask’s appearance is intended to evoke mirth and the painting’s appearance a feeling of religious reverence." 117 From the diverse opinions of the Second, Third and Ninth Circuits, we see that clothing as art is still very much a judgment of the eye of the beholder.

C. U.S. and International Perceptions of Design as Art

One might reasonably inquire as to why the U.S. is so opposed to granting artistic status to functional objects and seems obsessed with separating the useful from the artistic via stringent separability standards. While a division of copyright and patent law might be one explanation, another explanation comes from the art world.

The line between artist and artisan has always been an indistinct one, ceaselessly renegotiated. On the one hand, it is the job of the artisan to make objects designed for use and convenience, whereas the work of the artist is regarded as non-instrumental – you can't do anything with a painting except look at it – and, when it is successful, it is valued, not simply for the opulence of its materials or its decorative appeal or its technical expertise (although it may share all these qualities with artisanal work), but for its adherence to a set of higher values which have been elaborated by experts in art history and aesthetics. These values, certainly since the time of Kant, have been explicitly defined as non-instrumental, as values of disinterested design, sensibility, style and imagination, removed from the practical concerns of everyday life.118

Garment design has traditionally been viewed as artisanal rather than artistic and has enjoyed varying degrees of appreciation in the art world throughout history.119 In early history, garment designers were looked down upon as servants because of the intimate nature of the relationship between the garment and its wearer and valued lower on the social ladder than painters or architects.120 The status of fashion designers steadily improved, beginning in the 1850’s with the rise of couturier Charles Worth and continued into the 1900’s with the Arts

117. Id. at 671.
118. Peter Wollen, Addressing the Century, Addressing the Century: 100 Years of Art & Fashion 7 (Hayward Gallery, ed. 1998).
119. Id. at 8.
120. Id.
and Crafts revival. However, fashion still remained a curious sort of "art" well into the Twentieth Century. In 1954, when photographer Cecil Beaton wrote a history of fashion and the decorative arts, he felt it necessary to defend himself against the charge of being a "propagandist of frivolity" because "both in England and America, fashion is viewed with a jaundiced eye." Now, in the Twenty-First Century, we are still attempting to define the value of clothing design and much controversy has erupted over the display of fashion retrospectives in traditional art museums.

Ironically, adding to the confusion over whether fashion is art is the fashion world's viewpoint that clothing as "art" has a negative connotation. "The suspicion grows that the... definition of art/fashion is something so avant garde that it is unwearable. Genuine fashion must be functional and, therefore, can only be classified as applied art or craft. If a garment is not wearable, it is not fashion." Indeed, many fashion designers do not think of themselves as "artists." This non-artist designation, however, is not

121. Id. at 8-9.
123. The "Giorgio Armani" Retrospective (Guggenheim Museum, New York City, N.Y., Oct. 20, 2000 – Jan. 17, 2001); compare Deborah Sugerman, Behind the Scenes, MPLS-St. Paul 211 (Aug. 1, 2000) ("[Fashion] is becoming more accepted by academics, whether they look at it as art or more anthropologically."); (quoting Mark Schultz, co-curator of Goldstein Gallery at the University of Minnesota) with Roberta Smith, Memo to Museums: Don't Give Up on Art, N.Y. Times § 2, at 1 (Dec. 3, 2000) ("I'm not sure that Mr. Armani's development merits a museum exhibition, especially a museumwide one. He seems to be less an innovator than a brilliant tailor."); Judith Shulevitz, Armani Speaks Softly, Carries Big Stick, Slate Mag. (Oct. 25, 2000) ("That will probably be the take-away from the Guggenheim show too—they tried to tell you it had something to do with art, but you knew all along it was just about the clothes.").
124. Suzy Menkes, Playing to the Galleries: Wannabe Art; Fashion's Crossover Moments, Intl. Herald Trib. 12 (Oct. 13, 1998); see also Commercial Interludes, Women's Wear Daily 6 (Mar. 15, 1999) ("[F]ashion is a business, and once the exhausted fashion flock disperses and the Carrousel du Louvre lies dormant, everyone wants the clothes to sell.").
125. See Snapshot: Introducing the Dutch Masters; Bored of Versace? Tiring of Mcqueen? Fear Not, Says Josh Sims — Holland's New Breed of Conceptual Fashion Designers are out to Save the Day, Indep. 9 (Jan. 14, 2001) ("Viktor Horsting and Rolf Snoeren of Viktor & Rolf balance out the uneasy art-fashion equation. 'Some experimental fashion can be really ridiculous, but it's important for us that our clothes are wearable,' says Snoeren. 'We trained as fashion designers, but our work has had the attention of the art world. This isn't art for the art world. Perhaps it's art for the fashion world.'"); Menkes, supra n. 124 ("Miuccia Prada, who is always prepared to push fashion to its limits, says that she herself is nervous about going over the edge. 'My job is fashion,' she says. 'Any time I feel myself getting too 'artsy,' I go back to my fashion roots. Of course you see what is happening in art and that influences you. But we have our art foundation. Maybe I'm wrong, but I want to keep them separate.'"); CNN Larry King Weekend, Fashion Designer Karl Lagerfeld Talks about His Friendships with Princess
an admission that designers are less talented than artists or that their works are any less valuable. Rather, this view recognizes that art and design are different paradigms that serve different purposes and are inspired by different muses. The following comments from fashion designers provide some insight on this view.

What I do is not art—it is a commercial creation. I'm the exact opposite of an artist; everything I do is about what is happening at the last possible second. Fashion is perishable. . . . Maybe good fashion design . . . is a kind of art. It is certainly a form of artistic expression.126

[O]ur work is only made to be consumed, worn, used. An artist may escape from reality to fantasy. We are not allowed to forget the body.127

While the U.S. has opted for a function-free standard of "art" under copyright law, other countries have adopted an entirely different approach. France, for example, has adopted a "unity of art" approach in which "every test of aesthetic creation that 'would allow industrial art to be separated from real art' [has been rejected]."2 While France also struggled with the definition of art, attempting to keep a line of demarcation between its sui generis design laws and

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127. Id. (comment of Christian LaCroix).
128. J.H. Reichman, Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976, 1983 Duke L.J. 1143, 1157 (1983). Note also that French copyright law enumerates clothing designs as one of the types of works it protects. See UNESCO, Law on the Intellectual Property Code <http://www.unesco.org/culture/copy/copyright/france/page1.html#p1> (accessed May 6, 2001) (translation of French copyright law) ("The following, in particular, shall be considered works of the mind within the meaning of this Code: . . . 14. creations of the seasonal industries of dress and articles of fashion. Industries which, by reason of the demands of fashion, frequently renew the form of their products, particularly the making of dresses, furs, underwear, embroidery, hats, shoes, gloves, leather goods, the manufacture of fabrics of striking novelty or of special use in high fashion dressmaking, the products of manufacturers of articles of fashion and of footwear and the manufacture of fabrics for upholstery shall be deemed to be seasonal industries.").
copyright laws, ultimately France decided to grant designers protection under both schemes. However, they added incentives to use the design protection by affording evidentiary advantages as to proof of ownership, transfers of title and restricting competition.\textsuperscript{129} This decision has not been without controversy, in that “[m]any . . . were dismayed to see the laws of literary and artistic property expand to protect the designs of such articles as plastic salad bowls, drinking glasses, fireplace grates, a hair brush, the luggage rack of a motor scooter, and the hexagonal head of a lubricating pump.”\textsuperscript{130} Opponents of the unity of art approach have generally adopted one of two different schemes. The “duality of art” approach is typified by Italy, where copyright is reserved for art that has an independent existence from functional concerns, while useful articles could be protected under \textit{sui generis} design laws.\textsuperscript{131} The other position is typified by Germany where a limited number of exceptional designs are protected under copyright law but the rest are covered under \textit{sui generis} design laws.\textsuperscript{132}

While the intellectual property laws of European countries in particular have evolved to cover functional articles, we are still highly suspicious of such protection in the United States. There are no indications that we will change this policy in the near future. However, there have been some advances in further dissecting useful articles to locate artistic elements worthy of protection.

\textbf{D. Working Around the Useful Articles Doctrine: Partial Protection}

For the lucky few aspects of clothing design that are able to pass the physical and conceptual separability tests of the useful articles doctrine, copyright law provides a good deal of protection. Fabric designs, in particular, have benefited from copyright protection.\textsuperscript{133} In \textit{Peter Pan Fabrics v. Brenda Fabrics},\textsuperscript{134} the District Court for the Southern District of New York found that a fabric design consisting

\textsuperscript{129} \textit{Id.}
\textsuperscript{130} \textit{Id.} at 1159.
\textsuperscript{131} \textit{Id.} at 1161.
\textsuperscript{132} \textit{Id.}
\textsuperscript{134} 169 F. Supp. 142 (S.D.N.Y. 1959).
of images suggestive of the Near East was entitled to copyright protection "both as a work of art and as a print." This decision contrasted with historical notions that fabric designs were not protected under copyright law. Sweater designs, such as cable patterns and color motifs, have also had a good deal of protection against infringement, as have lace designs and jewelry.

The distinction between protection for separable elements of the clothing design but not for the clothing itself can be quite confusing. Interestingly, in the case of *Eve of Milady v. Moonlight Design, Inc.*, the court, in its off-the-record infringement analysis, went beyond a comparison of the two lace patterns involved in the case to a determination of the similarity of the wedding dresses in which the lace patterns were incorporated, including the fullness of the skirts, the necklines, the kick-pleats, and the V point of the sleeves. This analysis tends to rebut the presumption that comparison of clothing designs as a whole is too difficult and subjective for judges to accomplish.

While fabric patterns and design motifs, such as appliqués, sweater embellishments or lace patterns, are protected under copyright law, this is not a great deal of protection for the clothing

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135. *Id.* at 143.
136. See *Verney Corp. v. Rose Fabric Converters Corp.*, 87 F. Supp. 802 (S.D.N.Y. 1949) ("While the design may have been properly registered as a print for an article of merchandise, plaintiff, by printing it on the fabric from which the dresses are manufactured, uses the design as a part of the article of merchandise itself.").
139. See *Boucher v. Du Boyes, Inc.*, 253 F.2d 948 (2d Cir. 1958) (deeming costume jewelry copyrightable subject matter under *Mazer*, 347 U.S. 201); but see *Judith Ripka Designs v. Preville*, 935 F. Supp. 237 (S.D.N.Y. 1996) (determining no infringement for two lines of "ancient inspired" jewelry composed of jewelry elements which had been around "for ages"); *DBC of N.Y., Inc. v. Merit Diamond Corp.*, 768 F. Supp. 414 (S.D.N.Y. 1991) (denying copyright protection for a diamond ring design composed of elements well-known in the jewelry trade, such as marquise cut diamonds, trillions and a knife-edged shank).
141. *Id.* at *13-31.
designer. A knockoff designer cannot replicate the copyrighted fabric or motif exactly but can design a fabric pattern or motif that is extremely similar. When this similar fabric or motif is used in an identical copy of the overall garment design (which in most cases is not protected and can be copied with impunity), the result is a near-perfect copy of the original garment.

E. The Idea-Expression Dichotomy Hurdle

An interesting side note to the to the disappointing protection for clothing design provided by the useful articles doctrine, is that designers also face copyright protection hurdles under the idea-expression dichotomy in copyright law. Section 102(b) of the Copyright Act provides that “[i]n no case does copyright protection . . . extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.”142 This doctrine has been restated as “copyright protects the expression of an idea but not the idea itself.”143 The implications of this doctrine for designers are illustrated in the case of Russell v. Trimfit, Inc.144 In Russell, the designer had copyrighted two drawings of unusual sock designs.145 One sock design had a separate compartment for the big toe.146 The other design had separate compartments for each toe.147 Trimfit, a major sock manufacturer, began manufacturing socks identical to Russell’s drawings and Russell brought suit for copyright infringement.148 The court determined that Russell’s copyright only entitled her to protection against copying of the drawings themselves.149 Since Trimfit did not copy her drawings in the advertising or packaging of their product, Russell had no claim for copyright infringement.150 Thus, courts are not likely to extend copyright protection to clothing surreptitiously through protection of drawings or pattern pieces.151

143. Craig Joyce et al., Copyright Law 125 (5th ed. 2000).
145. Id. at 92.
146. Id.
147. Id. at 92-93.
148. Id. at 93.
149. Id. at 93-94.
150. Id. at 95.
CLOTHING DESIGN PROTECTION PITFALLS IN UNITED STATES LAW

F. Copyright Law as a Model for Design Protection

Clearly, existing copyright law is insufficient to address the needs of the clothing design industry. Some argue that this is entirely appropriate as the danger that copyright law would be used to allow designers to monopolize common design elements and stifle creativity is too great.\(^\text{152}\) Copyright law, however, is the most attractive of the existing intellectual property protections for a number of reasons. First, works claiming copyright protection do not need to be registered to be protected,\(^\text{153}\) nor are they required to display the copyright symbol.\(^\text{154}\) As it is common in the clothing trade to produce a variety of designs (sometimes thousands of designs per year\(^\text{155}\)) and let the market decide which designs are valuable,\(^\text{156}\) this would alleviate the burden on designers to register all of their designs, including the unsuccessful ones, to obtain protection. A designer could simply register the design once it had been infringed and sue for copyright infringement.

A second reason why copyright protection is desirable as the model for design protection is the limited scope of copyright protection. Copyright is not a fourteen year exclusive monopoly on a design or any confusingly similar forms of that design, as would be granted in design patent law. While the length of protection for copyrighted works is considerably longer than that afforded to design


\(^{154}\) See 17 U.S.C. § 401(a) (2000) ("[A] notice of copyright as provided by this section may be placed on publicly distributed copies.") (emphasis added). Note, however, that encouragement to provide copyright notice is provided by § 401(d) in that notice will negate a defense for the reduction of actual or statutory damages based on innocent infringement.

\(^{155}\) Registration of Designs, supra n. 56, at 211 (statement of Mr. M. Hefti, Vice President of the Embroidery and Lace Manufacturers’ Association of New Jersey, estimating the number of designs produced by a smaller designer at 1,500-2,000 per year). The number of designs produced by larger manufacturers of fabric and lace may be as many as 60,000 – 80,000 per year. Id. at 89 (statement of W.B. Bradford, representing the National Design Registration League).

\(^{156}\) Id. at 105 (statement of W.B. Bradford, Representing the National Design Registration League) ("Many of the designs we pick out and think are worth registering . . . prove unpopular . . . and the ones we do not think worth registering are the very ones that the public buy.").
patents, one could argue that registration of designs will not reduce the public domain pool of design elements because copyright protection would extend only to the particular expression or combination of elements and not to the individual design elements themselves. Additionally, under principles of fair use, designers would be free to use the same or similar design elements of others so long as the total combination of the elements is not an exact copy of the original design. Just as copyright law has encouraged and not stifled creativity in the fine arts and music, it is capable of providing the same benefits to clothing design.

Despite the persuasiveness of this argument, current copyright law does not support such protection. Designers, scorned by the copyright system, have resorted to trademark and unfair competition laws.

IV
Clothing Design Protection Under Trademark Law

"Regretfully, the body of law relating to the Lanham Act has developed into a tangled morass ... Courts struggling to move mountains often find they have only affected minuscule changes in trademark jurisprudence and occasionally have created their own likelihood of confusion."\(^{158}\)

Trademark protection is a very attractive form of intellectual property protection for clothing designers for two main reasons. First, the duration of protection is potentially unlimited so long as the "word, name, symbol, or device, or any combination thereof"\(^{159}\) continues to serve as a source indicator for consumers. Secondly, because of the overlap between federal trademark law and common law trademark law, federal registration is not a prerequisite for protection.\(^{160}\) Clothing designers have typically made use of the

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157. 17 U.S.C. § 302 (2000) ("Copyright ... subsists from its creation and ... endures for a term consisting of the life of the author and 70 years after the author's death.").
160. 15 U.S.C. § 1115(a) (2000) ("[This act] shall not preclude another person from proving any legal or equitable defense or defect ... which might have been asserted if such mark had not been registered."). However, the Lanham Act does provide many incentives for registration. See e.g. id. (affording prima facie evidence of validity of the registered mark).
trademark system to police the marks they employ in labeling their goods. For example, Ralph Lauren's trademarks "POLO" and the logo of a polo player have been upheld against infringement on numerous occasions.\footnote{161} Since many designers outsource the manufacturing of their clothing to other countries, protection of these marks is critical to prevent international trademark piracy and the importation of gray market goods into the U.S.\footnote{162}

In addition to protection for labels, trademark law is sometimes employed to protect the design of a product itself, under the rubric of trade dress protection. "Trade dress" refers to either the packaging or dressing of a product or the design of the product itself and has been accorded trademark protection due to the broad definition of registrable marks under § 2 of the Lanham Act.\footnote{163} While trade dress can be registered as a trademark,\footnote{164} trade dress infringement actions are generally brought under § 43(a) of the Lanham Act, which functions as an unfair competition law for unregistered goods.\footnote{165} In order to achieve protection under § 43(a), the trade dress must be nonfunctional\footnote{166} and the infringer's product must be likely to cause confusion.\footnote{167} Courts have also imposed the requirement that the trade dress be distinctive.\footnote{168} Clothing designs have faced hurdles under all three of these requirements.


162. See A.V. by Versace, Inc. v. Gianni Versace, S.p.A., 126 F. Supp. 2d 328 (S.D.N.Y. 2001) (granting a preliminary injunction against a U.S. manufacturer's sale of goods bearing the marks "Alfredo Versace" and "A.V. by Versace" both in the U.S. and abroad); Calvin Klein Industries, Inc. v. BFK Hong Kong, Ltd., 714 F. Supp. 78 (S.D.N.Y. 1989) (allowing an injunction against sales of jeans labeled with the Calvin Klein label both in the U.S. and abroad when Calvin Klein canceled the manufacturing contract after many of the jeans had been produced. The court deemed that such a broad injunction was necessary to protect Calvin Klein's international licensing contracts.).


164. If trade dress is registered, infringement actions can be instituted under § 32 of the Lanham Act.

165. See Coach Leatherware Co., 933 F.2d at 168.


167. Id. § 1125(a)(1)(a).

168. See Wal-Mart, 529 U.S. at 210 ("Nothing in § 43(a) explicitly requires a producer to show that its trade dress is distinctive, but courts have universally imposed that requirement, since without distinctiveness the trade dress would not 'cause confusion . . . as to the origin, sponsorship, or approval of [the] goods,' as the section requires.").
A. The Functionality Barrier

The U.S. Supreme Court clarified the test for trade dress functionality in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*\(^{169}\) Here, the Court reiterated the test established in *Qualitex Company v. Jacobson Products Company*,\(^{170}\) explaining that functionality is a broad concept, which includes consideration of whether the feature claimed is a competitive necessity but also whether the feature “is essential to the use or purpose of the device or when it affects the cost or quality of the device.”\(^{171}\) If a design is determined to be functional, it will be ineligible for Lanham Act protection, regardless of the secondary meaning it has achieved with consumers.\(^{172}\)

The functionality bar in trademark law applies not only to features of utility, but also to features that are “aesthetically functional.”\(^{173}\) Aesthetic functionality inheres in a product when a “design feature is so important to the value of the product to consumers that continued trademark protection would deprive them of competitive alternatives.”\(^{174}\) When a design is found to be aesthetically functional, courts often severely limit the scope of protection for such designs under trademark law. For example, in *Wallace International Silversmiths, Inc. v. Godinger Silver Art Company*,\(^{175}\) the court found that a Baroque pattern for silverware could only be enforced as a trademark as to a particular expression of the pattern and not to preclude Baroque silverware patterns in general.\(^{176}\)

Clothing designs are generally found to be aesthetically functional because the “primary purpose is aesthetic—to enhance the [garments’] ornamental appeal—rather than to identify the [garments] as [products of a particular producer.]”\(^{177}\) As such, a clothing designer cannot obtain a monopoly over the use of design elements in general but can enforce trademark rights to the extent

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172. *Id.* at 34-35.
173. See generally *W. T. Rogers Co. v. Keene*, 778 F.2d 334 (7th Cir. 1985) (finding that a hexagonal design for office supply trays was not aesthetically functional because it was not essential for competition).
174. *Id.* at 347.
175. 916 F.2d 76 (2d Cir. 1990).
176. *Id.* at 78-82. Note that the court’s analysis sounds oddly similar to the idea/expression dichotomy in copyright law.
177. *Knitwaves*, 71 F.3d at 1006.
necessary to prevent consumer confusion. In making the
determination between the aesthetically functional elements and the
protected trademark elements, it appears that courts have been
subconsciously influenced by the useful articles doctrine in copyright
law. Trade dress cases often show greater deference to separable
design features rather than designs comprised of an overall concept
with no separable elements. For example, in Coach Leatherware
Company v. AnnTaylor, Inc., the Second Circuit denied a finding of
trade dress infringement when AnnTaylor mimicked the details of
Coach handbags because the court felt that granting a broad
protection to ornamental design elements in the bags would
excessively chill competition. Four years later in Knitwaves, the
Second Circuit held that Knitwaves could not prevent Lollytogs from
manufacturing “fall motif[s]” for sweaters in general but could restrict
Lollytogs use of particular combinations of squirrels, acorns and
leaves, which were confusingly similar to Knitwaves’ designs. Even
the recent ruling from the Supreme Court in Wal-Mart Stores, Inc. v.
Samara Brothers, Inc., demonstrates this dichotomy. In Wal-Mart,
the Court denied trade dress protection for the total concept of one-
piece children’s seersucker outfits decorated with appliqués, but yet
the lower courts noted the potential challenge of copyright
infringement for the appliqués. There is no express reason for these
distinctions. Seemingly the courts are concerned that with the lengthy
protection afforded by trademark law, it is better to err on the side of
cautions and limit trade dress protection to design elements that can
be concretely identified.

B. The Confusion Barrier

Evidence of consumer confusion, the second requirement in a §
43(a) suit, can also be difficult for infringed clothing designs to
demonstrate. For some courts, this requirement is intertwined with

178. 933 F.2d at 171.
179. Knitwaves, 71 F.3d at 1006. Note that the court in Knitwaves ultimately did not
find trade dress infringement had occurred.
180. 529 U.S. 205. The court did not specifically address the functionality doctrine in
this opinion.
181. 165 F.3d 120, 132 (2d Cir. 1998), rev’d on other grounds, 529 U.S. 205. Note that
here, the Second Circuit, possibly evidencing a trend toward greater trade dress protection
for clothing, found that Samara’s trade dress was distinctive in that it involved
the combination of a variety of unique design elements and that consumer confusion was
likely based on the extent of the copying done by Wal-Mart.
the aesthetic functionality determination. The *Knitwaves* court, for example, found that because some of the design elements were aesthetically functional, they could not serve as source indicators and therefore consumers could not be confused by similar uses of those design elements. Generally, tests for confusion under trademark law involve an analysis of factors set forth by the Second Circuit's *Polaroid* decision. These factors include strength of plaintiff's mark, degree of similarity between plaintiff's and defendant's marks, proximity of the products; likelihood that plaintiff will bridge the gap, evidence of actual confusion; defendant's good faith in adopting the mark, quality of defendant's product or service, and sophistication of buyers. In *Coach Leatherware*, the standard for consumer confusion was set very high, with the court indicating that similarity of appearance or consumer surveys were not dispositive of the issue. In *Hermes International v. Lederer de Paris Fifth Avenue, Inc.*, however, the court found that confusion could result even if consumers were not confused at the time of purchase as to whether they were purchasing a genuine item or a knockoff. Post-sale confusion, where an outside observer might think the knockoff purchaser had purchased an original, could also support a finding of consumer confusion. Thus, while the confusion analysis is somewhat unpredictable, it appears to be difficult to demonstrate if the trade dress is not already well known to consumers, a requirement addressed by the third prong of trade dress protection.

C. The Distinctiveness Barrier

The final requirement for trade dress protection is distinctiveness. The United States Supreme Court has determined that trade dress is distinctive when the "intrinsic nature [of the trade dress] serves to identify a particular source." In *Two Pesos, Inc. v.*
Taco Cabana, Inc., the Court found that the unregistered trade dress of a Mexican restaurant was inherently distinctive and did not require a showing of secondary meaning. This decision provided hope that courts might construe the distinctiveness requirement for trade dress flexibly and incorporate greater design protection within its realm. One commentator suggested that clothing designs would qualify for such protection. These hopes were dashed, however, by the Supreme Court's *Wal-Mart* decision, which distinguished the *Two Pesos* case as applying only to cases of product packaging and indicated that product design, including clothing design, is not inherently distinctive and requires secondary meaning. "To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." One commentator has suggested that this bright-line rule that product designs can never be inherently distinctive does not take account of the range of possible designs available and deals clothing manufacturers a "double whammy" in their attempts to obtain design protection. Defenders of *Wal-Mart* insist that the Court correctly declined to create a test for inherent distinctiveness for trade dress, because such a test would be impossible to apply uniformly.

The short-lived nature of most clothing designs makes a showing of secondary meaning nearly impossible and thus most clothing designs will fail to qualify for trade dress protection. Consumers are very unlikely to be able to attribute a particular clothing design to a particular designer, without the aid of trademarks, labels or a substantial advertising campaign. This would place a tremendous

191. *Id.* at 776.
193. See *Wal-Mart*, 529 U.S. at 212 ("[D]esign, like color, is not inherently distinctive."); *Yankee Candle v. Bridgewater Candle*, 107 F. Supp. 2d 82 (D. Mass 2000) ("The Supreme Court's recent decision in *Wal-Mart* ... crushed most, if not all, of the life out of plaintiff's statutory trade dress claim.").
195. See Stuart M. Riback, *Product Design Trade Dress, Where do We Go from Here?*, 90 Trademark Rep. 563, 566 (2000) (The double whammy arises because the nature of the clothing industry is not to package products, therefore disqualifying clothing manufacturers from the easier to obtain product packaging trade dress and raising the bar for product design trade dress.).
burden on the clothing designer to advertise extensively the attributes of every design created which could very well be economically impossible. The recent case of Lim v. Green demonstrates that in order to satisfy secondary meaning requirements, consumers must associate the design with a particular manufacturer and not merely be aware that the design has existed previously. State unfair competition laws or misappropriation laws may be similarly unavailing. While these laws may have less stringent requirements than those imposed by the Lanham Act, at least one case has held that when the subject matter of protection falls clearly under federal law, the state law is preempted.

D. Trademark Law as a Model for Design Protection

The Supreme Court’s Wal-Mart decision puts trade dress for clothing in a highly suspect position. Perhaps the Court is attempting to foreclose any notion that design protection will be afforded through trademark law. While the Court seems to recognize the need for trade dress protection in certain cases, it is still a highly suspect classification of trademark law. In TrafFix Devices, the Court “caution[s] against misuse or over-extension of trade dress” and asserts that “copying is not always discouraged or disfavored by the laws which preserve our competitive economy.”

Trademark and trade dress protection, however, might not be the ideal remedy for the protection of clothing designs. Unlimited protection for certain features of designs could radically impact competition and unduly limit designer creativity. It is also unclear how trademark or trade dress protection for clothing design would serve a consumer protection function. So long as the knockoff manufacturer identifies his copies with the manufacturer’s own label (and not the trademark of the original designer) the likelihood of consumer confusion is small. The price of the garment and the channel of commerce in which it is purchased (retail discount store, street vendor or unofficial websites) would also be further clues as to whether a design is original. The long history of knockoff designs in

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197. 243 F.3d 548 (table), 2000 WL 1693680 (finding that consumer association of the plaintiff’s Scarf Cap design with the motorcycle industry in general is not sufficient to support secondary meaning).

198. Aldridge v. The Gap, Inc., 866 F. Supp. 312, 314 (N.D. Tex. 1994) (finding that designs for children’s clothing fell within the subject matter of copyright law and that therefore state misappropriation laws were preempted).

199. 532 U.S. at 29.
the United States is another argument against consumer confusion. Americans are so used to purchasing knockoffs that one could argue that there is an implied presumption that most affordable clothing is a knockoff rather than an original design. Even proponents of the extension of trade dress protection to the fashion industry recognize that there are some practical considerations with the use of design as a trademark and that litigation and enforcement could be difficult under this model.200

If trademark is the model to be used, however, there are ways to creatively apply existing trademark law to design protection. For example, as trademark rights are generally lost when the mark is no longer used, one could argue that the unlimited protection may not be as much of a threat. Instead of long-term monopolies, the design elements might frequently change hands as designers evolve through different phases of their careers, reviving old fashions and creating new ones. Courts have yet to recognize these possibilities, though, and lacking protection under any established intellectual property scheme, frustrated designers have turned to Congress.

V  

Sui Generis Protection for Clothing Design

"Not much sympathy is wasted on the vultures which hang over the field of battle, waiting to feast on the fallen, even though they be hungry and 'it is their nature to.'"201

In an attempt to combat rampant design piracy, various types of design legislation have been introduced in Congress at least 88 times since 1914.202 Design protection was even included in the draft text of

200. See Karina K. Terakura, Insufficiency of Trade Dress Protection: Lack of Guidance for Trade Dress Infringement Litigation in the Fashion Design Industry, 2001 U. Haw. L. Rev 569, 615 (2001) ("A distinct style of one designer may be obvious to those who shop at Neiman Marcus, but not so obvious to those who shop at Wal-Mart. Similarly, identification of high-fashion designer clothing may be easy for those who read fashion magazines and are aware of developing trends, yet confusing for those who do not read, watch, or even care about fashion styles. It may be impossible to require every jury to possess such an in-depth and sophisticated appreciation of the fashion world, but that is what is necessary to understand, recognize and distinguish all the various designers’ trade dress styles.")


202. See S. 2502, 105th Cong. (1998); H.R. 2696, 105th Cong. (1997); H.R. 1790, 102d
the current U.S. copyright statute when it was proposed in 1975.\footnote{H.R. 2223, 94th Cong. (1975).} This legislation suggested that a “Title II” be added to U.S. copyright law affording protection for “original ornamental design[s] of . . . useful article[s].”\footnote{Id. at Title II § 201(a).} However, the legislation contained an express exclusion that “[p]rotection under this title shall not be available for a design that is . . . (e) composed of three-dimensional features of shape and surface with respect to men’s, women’s and children’s apparel, including undergarments and outerwear.”\footnote{Id. at Title II § 202(e).} Legislation nearly identical to Title II, including the exclusion of protection for clothing, was introduced as late as 1991.\footnote{See H.R. 1790, 102d Cong. (1991).} The legislative history of these proposed design rights reveals a tapestry of interwoven vested interests, and a perplexed Congress struggling to balance a desire to promote innovation with concerns for the poorest members of society. Design protection is extraordinarily controversial and even small steps toward this end, such as the creation of a U.S. Design Council to encourage innovation in design, have proved fruitless.\footnote{H.R. 4673, 103d Cong. (1994).}

The most common argument against design protection, as seen in the legislative history, is that strong design protection will significantly increase the cost of ordinary consumer goods. This increase in cost will either arise as a result of higher royalties being paid to designers, or in the form of increased costs for discount manufacturers to attempt to “design around” protected designs and fend off lawsuits.\footnote{H.R. Subcomm. on Intell. Prop. & Jud. Admin. of the Jud. Comm., Design Innovation and Tech. Act of 1991, 102d Cong. 142-43 (Jan. 29, 1992) (testimony of Rhonda J. Parish, Asst. General Counsel, Wal-Mart Stores, Inc., on behalf of the Intl. Mass Retail Assn.).} In this context, clothing often gets lumped together with protection for replacement parts for machines necessary to our daily functioning, such as automobiles. Congress is reasonably concerned with preventing manufacturers from charging monopoly prices for replacement parts, particularly for items upon which consumers depend the most and for which maintenance and repair of the items serves a public safety interest. It is unfortunate
that clothing design should be grouped with replacement parts in these discussions. While clothing is a necessity in daily life, particular styles of clothing usually are not. There are a wide variety of clothing styles to choose from in a range of prices, depending largely on the quality of the materials used. For the limited circumstances where clothing is a necessity to accomplish a certain task, such as space suits, bulletproof vests, and hard hats for construction workers, the analogy to replacement parts may be more appropriate. Nevertheless, these items are also more likely to be protected under patent laws.

The difficulty with grouping replacement parts with clothing design is illustrated in Congressional hearings on proposed design legislation in 1914. A replacement parts manufacturer for stoves (which played a major role in heating homes at that time) objected to the legislation on the following grounds:

Right here is a bill that is just as much as anything else would be and more relating to the cost of living . . . every man would have to pay more for necessities like that. Why, I do not know of a single article that would raise the cost of living like that would because it is an absolute necessity.

Responding to this argument, the Commissioner of Patents replied:

Personally, I have not the slightest interest in the section [of the bill relating to exclusions for replacement parts manufacture]. The people I want to see protected are the designers of textiles, the hat designers, the shoe designers — the people who are dealing with the matter from the artistic side. I think the objections that are raised about these repair parts are probably very much exaggerated.

In order for clothing design protection laws to succeed, it is necessary to divorce clothing designs from the baggage of the replacement parts question. It may also be necessary to enact protection that only applies to clothing designs, as was done in the case of vessel hull designs. If the question of replacement parts cannot be sufficiently resolved, individual *sui generis* protection for every field in which design is a competitive element may be the trend of the future.

210. *Id.* at 49-50.
211. *Id.* at 50 (statement of Hon. Thomas Ewing, U.S. Comm. of Pat.).
Even if clothing design can be divorced from the replacement parts question, clothing faces its own unique forms of attack that have more to do with psychology than economics. Sumptuary laws, which attempt to regulate either the appearance or behavior of society, are an interesting historical chapter of the history of clothing design. Sumptuary laws have taken on a wide range of forms over many centuries, but the two basic premises of sumptuary laws as they relate to clothing are that certain symbols ought to be preserved as class indicators and certain extravagant expenditures ought to be prohibited either as "unholy" or economically unsound. An early example of these laws is from the "Laws of Solon" in classical Greece, which restricted conspicuous consumption at funerals, limited the size of the funeral procession, the amount of food consumed and even the number of mourning shawls a widow could wear. Similar laws developed in Europe and Asia, and sumptuary laws were a part of colonial life in the early U.S. Sumptuary laws as they relate to clothing fell into disuse in the U.S. around the middle of the eighteenth century. One would hardly expect that such laws would appear in modern society, particularly in a country such as the U.S. where few restrictions on class movement exist and an emphasis on equality of opportunity is ingrained in the country's history. However, some contend that sumptuary laws are not merely an historical artifact. One commentator has argued that strict enforcement of modern trademark laws is a form of sumptuary law. Clearly, some in Congress agree with this assessment and it has impeded the development of design legislation.

At the 1914 design legislation hearings, a representative of the National Design Registration League made the following argument in support of strong design protection laws:

[Pirates] take that popular design of high-priced goods and reproduce it in cheap material and put it on the market, the

214. Id. at 18.
215. Id. at 23. (For example, feudal laws in China and Europe restricted the taming of falcons and the wearing of furs to the upper classes.).
216. Id. at 39. (A 1651 Massachusetts Bay colony law prohibited luxury items such as gold or silver lace, gold or silver buttons, silk hoods or scarves, and 'great boots' to those with an annual income of less than $200.).
217. Id.
result being that the ladies going into their laundries see the clothing of their colored cooks and wash girls trimmed with the same pattern of lace they use on their expensive garments... she will not wear the same style of lace and embroidery that is used by the servants in her household.219

Representative Callaway was clearly unimpressed by this argument and, after it was noted that 75 percent of goods manufactured in the U.S. were imitations of original designs,220 facetiously inquired:

The trouble with this bill is that it is for the benefit of two parties; that is, the enormously rich who want to display their splendid apparel that they can wear in this country that the ordinary riff-raff ought not to be allowed to wear, and those [sic] rich concerns who have these extra and selected designers to design these special patterns for those elite. I think, too, the public ought to be cut out. I think those rich elite ought to be segregated in this country and have the immensely rich off in one place and the ordinary riffraff ought not to be allowed to come and eat with them. Is not that the whole sum and substance of [this bill]?221

Unfortunately, the sumptuary law problem will continually be an impediment to clothing design protection laws. Overcoming these objections may require a resort to economic analysis. One commentator has suggested that certain laws, in which we allow people of wealth to obtain status symbols unavailable to the masses, may reduce the amount of waste spent by less affluent members of society in making investments toward, but failing to obtain, these same symbols.222 One could also attempt to alleviate these concerns through the nature of design protection provided. For example, design patent-type protection and trademark-type protection would provide a broader, more monopolistic protection than would copyright-type protection. Copyright-type protection could include infringement defenses such as fair use223 and independent

220. Id. at 94.
which would allow a greater flexibility of use and lessen concerns about exclusivity and class mobility.

Other concerns with *sui generis* design legislation entail Constitutional and administrative questions. The Constitutional issue arises as a result of the Patent and Copyright Clause of the Constitution which provides: "The Congress shall have 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." While "writings" and "discoveries" are clearly covered, it is unclear whether designs fall within these categories. When this issue arose in committee hearings for proposed Title II design protection in the 1976 Copyright Act, a copyright attorney indicated that the scholarly weight of authority felt that designs did meet this test. The interrogating Congressman, however, felt that the Patent and Copyright Clause was not a strict mandate from the framers that only "writings" and "discoveries" could be covered, but rather an illustration of the types of legislation that Congress could enact. Regardless of which interpretation is accepted, it appears that Constitutional concerns regarding design protection are likely to be minimal, as evidenced by Congress' willingness to enact paracopyright design legislation for semiconductor chips and boat hulls.

Administrative concerns are not so easy to resolve. One objection to design legislation is that it would require the creation of yet another government agency for intellectual property protection and would duplicate functions already served by the patent, copyright and trademark offices. Some aspects of design protection would inherently overlap with protections currently provided in all three of these areas as noted above. However, a new government agency may not be necessary. Conceptually, it would be possible to incorporate design protection under the administration of an existing agency so long as the existing scheme of protection and the design legislation

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224. *Nimmer on Copyright, supra* n. 43, at § 13.01[B] n.35.
227. Id. at 999.
could peacefully coexist. The copyright office is a particularly attractive organization for this purpose, given the large variety of intellectual property works it has come to encompass.231

Perhaps the largest obstacle to enacting clothing design legislation is the adamant opposition from a powerful segment from the very entity it aims to protect, the U.S. clothing industry. Opposition can be traced to two main factors: a resistance to change entrenched business methods that have evolved due to the history of design piracy in the U.S.,232 and an inferiority complex about the ability of American design to compete with European design. The latter proposition is well supported by the history of American clothing design, in which numerous examples can be found of the frequent theft of European design by Americans.233 Examples can also be seen in the legislative history of the 1914 design protection act where a representative of the National Design Registration League had the following to say:

I have been told by some manufacturers, when this matter has been presented to them, "Oh, we can not live . . . unless

231. For example, protection for computer software was a problem before copyright embraced protection for computer programs as "literary works," despite overlap between copyright law and patent law for these works. See 17 U.S.C. § 102(a)(1) (2000); H.R. Rpt. 94-1476, at 54 (Sept. 3, 1976) (reprinted in 1976 U.S.C.C.A.N. at 5667). The Copyright Office has also recently enlarged its duties with respect to the area of software as a result of the enactment of the Digital Millennium Copyright Act, which includes restrictions on the manufacture and sale of anti-circumvention technologies designed to overcome the technological safeguards of copyrighted works. 17 U.S.C. § 1201 (Supp. 2001).


233. See Winning Ways, Inc. v. Holloway Sportswear, Inc., 903 F. Supp. 1457, 1459 (D. Kan. 1995) ("Utilizing competitors' design features is common practice in the fashion industry."); James Laver, Costume & Fashion 246 (rev. ed. 1995) ("Before 1930 it had been the habit of buyers (especially American buyers) to purchase several dozen copies of each selected model shown in Paris and resell them to a wealthy clientele. But after the Slump the American authorities imposed a duty of up to 90 per cent on the cost of the original model. Toiles (i.e., patterns cut out in linen) were allowed in duty-free. Each toile was supplied with full directions for making it up, and although the original dress may have cost a hundred thousand francs, it was now possible to sell a simplified version for as little as fifty dollars."); Biography, "Edith Head" (A&E, Mar. 27, 2001) (television broadcast) (American designer Edith Head never let on that the costumes she "designed" for Audrey Hepburn in Roman Holiday were mainly those of French designer Hubert de Givenchy.); Biography, "Calvin Klein" (A&E, Mar. 25, 2001) (television broadcast) (In his early work for design houses in New York, Calvin Klein was sent to Europe to sketch designs from the runways for reproduction in the United States.).
we copy our competitors’ designs. We can not produce designs like they do in Europe.” I always feel a little ashamed of an American who will make that acknowledgement because I believe that with the right kind of protection and the right kind of encouragement, the United States of America can lead in designing as it can lead in everything else.\textsuperscript{234}

Eighty-eight years have passed from the time this statement was made and not much progress has been made to encourage American clothing designers to be more “original” in their creations. Congress cannot be blamed for not providing the opportunity, however. Even in the 1991 design legislation that excluded clothing, Congress had not forgotten about the textile industry:

MR. SANGMEISTER. The only other question I would have then... is, particularly last year there was a lot of questioning... due to concern about the garment industry, and yet I see specifically they are excluded in this section 1002. Is there any particular reason for that?

MS. CASTLE. Mr. Chairman, if I might answer that, the garment industry has always requested that it be excluded from the legislation. Following the various iterations of this bill and amendments to the copyright law, they have determined that their protection is sufficient under other intellectual property statutes, and they do not wish to be included in the legislation. So we have simply continued that exclusion which was originally at their request.\textsuperscript{235}

Thus, it is apparent that until the concerns of American clothing designers who desire stronger design protection laws are given more weight than those American manufacturers who desire to continue the status quo, the likelihood that any clothing design protection statute will be enacted is very slim. The impetus for such a statute would have to come from either a societal or Congressional determination that original American clothing design is valuable and worthy of encouragement or from considerations of international comity.

Congress may be particularly pressured to enact clothing design

\textsuperscript{234} Registration of Designs, supra n. 56, at 97 (statement of E. W. Bradford, Esq., Representing the National Design Registration League, Washington D.C.).

\textsuperscript{235} Design Innovation and Tech. Act of 1991, supra n. 208 (statement of Rita L. Castle, chairwoman, the Design Coalition, accompanied by Bruce Lehman, attorney, Swidler & Berlin).
legislation, in light of the U.S.' obligations as a signatory of the World Trade Organization's "Agreement on Trade-Related Aspects of Intellectual Property Rights" ("TRIPS Agreement"). Article 25(2) of the TRIPS Agreement provides:

Each Member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.

A minimalist interpretation of this provision would suggest only that some kind of low-cost protection for textile designs is required. Accepting this interpretation, arguably the U.S. is meeting its obligations under TRIPS because some design protection for textiles is afforded through design patents, copyrights and trademarks. Also, because the guiding principles of TRIPS are national treatment and the reduction of trade barriers, it is hardly a trade barrier if foreign and U.S. designers receive the same limited protection in the U.S. However, if one interprets this provision more broadly as expressing a policy that clothing designs should enjoy the maximum level of protection possible, on a par equal to other forms of intellectual property, the U.S. is in gross breach of its obligations. This is not a new complaint. The impetus for the introduction of the 1914 design legislation was explained as follows:

The thing that interested me in the bill and which started me is the pressure we have from abroad largely, the feeling in France, Belgium, and other European nations that are particularly prominent as artistic people, that we do not offer a fair protection to their designs... In many countries they can put a number of designs into a single envelope and pay one fee... and here it costs $1 for each design under this bill.


238. See 33 I.L.H. at 93.

239. Registration of Designs, supra n. 56, at 49 (statement of Hon. Thomas Ewing, U.S. Comm. of Pat.).
While the U.S. has historically been able to loosely interpret Article 25(2) up to now, this might change within the next few years. The World Trade Organization ("WTO") notes in its 2001 report that textile and clothing products must be fully integrated into WTO rules by December 31, 2004, and that this will require a dramatic reduction on quotas of imported clothing currently imposed by Canada, the European Union, Norway, and the U.S. With a potential flood of imported clothing to enter the U.S., strong clothing design protection laws would be one way to restrict imports and protect domestic industries.

Clothing design legislation could also have a positive impact for consumers. While some clothing designs might increase in price as a result of design protection laws, a good many more might decrease. This result is suggested by the nature of the clothing design industry. Currently, with no design protection laws, a designer must act quickly and charge a premium for new designs before the goods are copied and sold at lesser cost. This result has distorted the fashion industry significantly. As one fashion commentator explains:

Fashion houses, often headed by international conglomerates, make substantial financial losses on their haute couture collections, but these highly-publicized, glamour-laden events provide the label prestige, which make their numerous licensed goods so commercially lucrative. Diffusion lines, consumer products and—most significantly of all—perfume sales, continue to earn top designers high salaries.

If design protection laws were implemented, designers could charge less for each design, knowing that their investment would be returned over a longer period of time. The fashion industry would obviously benefit from clothing design protection in many ways. For example, buyers from the designer would be more willing to purchase in large quantities, because the risk of lower-priced alternatives

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241. *Registration of Designs*, supra n. 56, at 156 (statement of Mr. Richard H. Waldo, Bus.Manager, Good Housekeeping Mag.).

entering the market would be decreased.\textsuperscript{243} Also, there is some suggestion that \textit{haute couture} buyers are more likely to commission designs from countries where there is strong design protection, because there is a greater chance that the design is truly original and not a knockoff from some other source.\textsuperscript{244}

Concerns about monopolies on design elements and the stifling of creativity through design legislation could be addressed through careful drafting. In this regard, the U.S. might consider drafting a design protection statute similar to that adopted by the United Kingdom.\textsuperscript{245} These provisions demonstrate a balance between design protection and public domain concerns. United Kingdom design registration provisions are similar to copyright provisions in that a design right comes into existence upon creation, and the protection it extends is not an absolute monopoly but rather a right to prevent copying.\textsuperscript{246} The design right does not apply to surface decoration or textile designs, which are instead covered by copyright law.\textsuperscript{247} Design right protection is also much shorter than that accorded copyrights, patents, or trademarks, lasting 10 years from first marketing of the design, or a maximum of 15 years from date of creation and subject to compulsory licensing after five years of use.\textsuperscript{248} While these provisions would arguably satisfy the needs of most clothing designers, it does not appear that they have been of great effect in the United Kingdom. One commentator has noted that the United Kingdom "has become a major producer of counterfeit goods, particularly in the clothing sector."\textsuperscript{249} Therefore, the U.S. might also wish to incorporate strong enforcement provisions in any clothing design registration statute.

Without action of any kind toward the protection of clothing

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\item \textsuperscript{243} \textit{Registration of Designs, supra} n. 56, at 154 (statement of Mr. Richard H. Waldo, Bus. Manager, Good Housekeeping Mag.).
\item \textsuperscript{244} \textit{Id.} at 211 (statement of Mr. Peter Gouled, Representing the Embroidery and Lace Mfrs. Assn. of N.J.) ("A number of garment manufacturers . . . who want exclusive patterns, come to us and say . . . 'We can never feel that you have exclusive patterns, that you actually originate.'").
\item \textsuperscript{246} Ulla Vad Lane-Rowley, \textit{Using Design Protection in the Fashion and Textile Industry} 43 (John Wiley and Sons 1997).
\item \textsuperscript{247} \textit{Id.} at 44.
\item \textsuperscript{248} \textit{Id.} at 45.
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design, the U.S. risks the further deterioration of its already struggling apparel industry. Since 1997, the U.S. textile and apparel industry has been steadily hemorrhaging jobs, with an estimated 177,000 jobs lost since 1997. In particular, New York City's apparel industry was devastated by the September 11 attacks and is now trying to rebuild itself through pleas to consumers to buy clothing with the “Made in New York” label. While much of these job losses are due to the internationalization of the apparel industry and the outsourcing of labor to foreign countries, protection of clothing design could help to revive the industry. We could do much more to increase the number of designers in this country as well as attract foreign designers to create in the United States. Even if designers continue to outsource labor to foreign countries, an increase in the number of designers could create jobs in other areas such as marketing and sales. An increase in the number of designers could also result in a greater diversity of clothing designs for consumers and design competition would help to keep clothing prices affordable. Also, if ultimately American design achieves the same cachet as European design, clothing “Made in the U.S.A.” could be a highly desired international brand advantage (rather than just a patriotic sentiment) that could help increase the number of labor-intensive jobs in this country as well.

Granted, copy protection for designs would involve a change in current fashion business practices. “Today, under the postmodern rubric of ‘referencing,’ copying flourishes so openly that nobody bothers to question it.” The practice is not limited to knockoff designers. As noted recently, a vest in the spring 2002 collection designed by Nicholas Ghesquiere for Balenciaga was a nearly identical copy of a vest the little-known designer Kaisik Wong created in 1973. While designers seem to appreciate the artistic freedom


252. See Robin Givham, Continental Divide: Why Don’t Europeans Cotton to American Designs? The New York Shows Offer No Satisfying Answers, Wash. Post C1 (Feb. 19, 2002) (quoting a unidentified retail consultant as saying “American fashion is not perceived in the world at large as a quality designer product. . . . America is associated with cowboys and Indians and jeans. We’re not associated with major designer clothing collections.”).


254. Id.
that comes with open copying, the rub comes in the lack of recognition when their designs are reinterpreted by others. As knitwear designer Lily Chin explains, “[I]f my name is not attached to my creation, something is taken away from my reputation. After all, the bigger picture is that it’s really me that’s being sold.” Even if one does not agree that designers ought to own a right in their creations sufficient to prevent the use of those designs by others, a right of attribution seems unquestionable. Yet current U.S. intellectual property laws do not provide even this small measure of recognition.

VI
Conclusion

Clothing design protection in the U.S. is a controversial proposition, that involves consideration of principles of free competition, promoting creativity, reducing class mobility restrictions, and defining roles and limitations for patent, copyright and trademark law. The market distortions suffered by the fashion industry as a result of design piracy have long called for a remedy, but as yet the U.S. is unwilling to deliver. While currently affording protection to surface decoration, fabric design, and labels, U.S. law is woefully incomplete when it comes to protection of the “soul” of the clothing design, the cut, and overall appearance. Whether this decision is based on an assessment of artistic merit or a concern for public welfare, it is an unjustifiable distinction for treating clothing designs less favorably than other forms of intellectual property. Pressure from the international community may ultimately drive the U.S. to correct this injustice, but it would be far better for the U.S. to remedy this problem on its own initiative and to provide encouragement and respect for the American design industry.

255. E-mail from Lily Chin to Anne Briggs (Nov. 26, 2001) (on file with author).
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