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## Coco Way Before Chanel: Protecting Independent Fashion Designers' Intellectual Property Against Fast-Fashion Retailers

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# COCO WAY BEFORE CHANEL: PROTECTING INDEPENDENT FASHION DESIGNERS' INTELLECTUAL PROPERTY AGAINST FAST-FASHION RETAILERS

Tiffany din Fagel Tse \*

“It is better to fail in originality, than to succeed in imitation.”

Herman Melville, novelist and poet<sup>1</sup>

Before Coco Chanel, her name was Gabrielle.<sup>2</sup> Starting as a small business owner and milliner, Gabrielle transformed a single shop on Paris’s Rue Cambon to a \$6.8 billion international fashion house.<sup>3</sup> While Gabrielle Chanel’s story cultivates an optimistic beacon for aspiring fashion designers, times have changed. Gabrielle did not live in a world of fast-fashion and mass knock-off retailers when she started as an emerging independent designer.<sup>4</sup> Current intellectual property laws in the United States do not provide adequate protection

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<sup>1</sup> *Herman Melville*, BRAINYQUOTE, <http://bit.ly/1TNro1g> (last visited Nov. 20, 2015).

<sup>2</sup> LISA CHANEY, *COCO CHANEL: AN INTIMATE LIFE*, at xi (2011).

<sup>3</sup> *See id.* at 72; *see also Chanel*, FORBES, <http://onforb.es/1Q3vYBN> (last visited Nov. 20, 2015) (ranking Chanel as the 85th most valuable brand in the world).

<sup>4</sup> *See* Suzanne Jacobs, *How Fast Fashion Got Even Faster in 2015*, GRIST (Dec. 17, 2015, 10:07 AM), <http://bit.ly/1NljkOC>; *see also Coco Chanel Biography*, BIO, <http://bit.ly/1N4XELK> (last visited Jan. 18, 2016).

for emerging independent designers, who remain vulnerable to retailers.<sup>5</sup> From lawsuits arising from musical theft to artistic counterfeiting, it appears the government is an advocate of originality.<sup>6</sup> Current laws defend artists who not only spend the resources to protect their ideas, but also punish those who unlawfully steal these creations.<sup>7</sup> Nevertheless, fashion design remains a realm of art that has yet to inspire the government toward stricter protection rights.<sup>8</sup>

Since 2003, Max Cattaneo, an independent designer based in New York City and owner of Wowch, has been selling eclectic apparel on his personal website along with made-to-order designs on e-commerce website Etsy.<sup>9</sup> In 2008, Cattaneo discovered actor James Franco was wearing a remarkably similar Wowch graphic t-shirt design in the comedy film “Pineapple Express.”<sup>10</sup> Cattaneo corresponded with several New York attorneys, who unanimously advised him that nothing could be done and his case was frivolous.<sup>11</sup>

In 2013, Cattaneo experienced a similar predicament, but this time, he took matters into his own hands.<sup>12</sup> When browsing the Internet, Cattaneo noticed Urban Outfitters’ cat leggings were undoubtedly similar to a pair of cat leggings he designed in 2010.<sup>13</sup> Urban Outfitters, an American multinational retail company, is also known for their eclectic designs with an emphasis on creativity.<sup>14</sup> For several months, Cattaneo contacted Urban Outfitters to remove the leggings from their inventory.<sup>15</sup> Only when the internet media company BuzzFeed asked Urban Outfitters for a quote on their alleged infringement did

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<sup>5</sup> See Kal Raustiala & Christopher Springman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1689 (2006) (discussing the need stricter of intellectual property laws and protection rights for the fashion industry).

<sup>6</sup> See Copyright Act of 1976 § 102, 17 U.S.C. § 102 (2012). Copyright laws require “some minimal degree of creativity.” *Feist Publ’n, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

<sup>7</sup> See Copyright Act § 504. Copyright law allows the copyright owner “to recover the actual damages suffered by him or her as a result of the infringement.” *Id.*

<sup>8</sup> See Christine Quilichini, *Haute Couture Legislation: Tailor Made High Fashion Design Protection in the United States*, 4 U.P.R. BUS. L.J. 228, 231 (2013) (analyzing problems on current fashion design protection).

<sup>9</sup> *General Info*, WOWCH, <http://bit.ly/1qKXH62> (last visited Nov. 13, 2015); see also Max Wowch, *About WOWCHNYC*, ETSY, <http://etsy.me/1S1HBvj> (last visited Nov. 20, 2015); see also Chavie Lieber, *Beyond Elle Woods: The Rise of Fashion Law*, RACKED (Jan. 15, 2015, 11:00 AM) [hereinafter Lieber, *Beyond Elle Woods*], <http://bit.ly/1SueVKz>.

<sup>10</sup> Lieber, *Beyond Elle Woods*, *supra* note 9.

<sup>11</sup> *Id.*

<sup>12</sup> Katie Notopoulos, *Urban Outfitters Pulls Copycat Leggings from Its Site*, BUZZFEED (June 27, 2013, 1:53 PM), <http://bzfd.it/1Nlkf4>.

<sup>13</sup> *Id.*

<sup>14</sup> *Fostering Creativity*, URBN, <http://bit.ly/1N4YPuJ> (last visited Jan. 18, 2016) (“Creativity is in the fabric of all we do.”).

<sup>15</sup> Notopoulos, *supra* note 12.

the retailer subsequently remove the cat leggings from their website.<sup>16</sup> Urban Outfitters commented “it [was] never [their] intention to offend other designers and small businesses” and publicly apologized for their actions.<sup>17</sup>

While Cattaneo eventually prevailed against Urban Outfitters, there are still many emerging independent designers who lack the legal support and financial resources for potential litigation costs to take on large infringing retailers. Although Urban Outfitters withdrew the cat leggings after a news outlet contacted them about their potential infringement, many independent designers have not been able to win their battles and thus, have had their businesses and brands harmed.<sup>18</sup>

This Comment will first analyze and critique current intellectual property laws for fashion designs in the United States. Although trademark laws, trade dress, copyright laws, and patent laws are meant to protect an artist’s work, they come short when providing full protection for fashion designs. Second, this Comment will discuss international fashion design protection frameworks, particularly in the European Union and in France. Intellectual property laws that protect fashion designs have proven to be relatively successful in Europe, but unfortunately cannot be mimicked in the United States. Third, this Comment will examine the effect of the fast-fashion phenomenon on independent designers’ growth in the fashion industry.<sup>19</sup> Finally, this Comment will provide suggestions to improve intellectual property protection for emerging independent designers. This section will dispel the notion that fashion designs are labeled as utilitarian works and will subsequently apply the same logic Congress used to pass the Architectural Work Copyright Protection Act of 1990 (“AW-CPA”) under the Copyright Act. Amending the Copyright Act to include fashion designs will allow independent designers the opportunity to fair competition in the demanding and competitive fashion industry.

## I. CURRENT PROTECTION LAWS FOR FASHION DESIGNS IN THE UNITED STATES

The fashion industry is a \$1.2 trillion global industry and consumers in the United States spend more than \$250 billion on fashion merchandise a year.<sup>20</sup> Over 1.9 million people are employed in fashion industries in the United

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<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> Fast-fashion is defined as merchandise made quickly and in reaction to the current season’s trends and styles. See *Fast Fashion – Terms of Interest to the Fashion Industry*, APPAREL SEARCH (Jan. 1, 2009), <http://bit.ly/1Yqo3o5>.

<sup>20</sup> CAROLYN B. MALONEY, J. ECON. COMM., THE ECONOMIC IMPACT OF THE FASHION INDUSTRY 1 (2015), <http://1.usa.gov/1RPPxmK>.

States, which shows its valuable influence on the economy.<sup>21</sup> The fashion industry can best be described as a fast-moving consumer good industry, as designs often change quickly and “consumers generally do not know what fashion they will be wearing until they buy it.”<sup>22</sup> Fashion companies must often be quick-thinking when designing new styles and creating trends to coincide with competitors and to please consumers.<sup>23</sup> Since trends emerge quickly and fast-fashion retailers are growing in popularity, certain styles can last between two to four weeks.<sup>24</sup> The fashion industry has also expanded over the last 25 years to include more specialized fields of fashion advertising, web-designing, and research development.<sup>25</sup> Nonetheless, what lies in the center of the fashion industry are its designers.

In September 2012, Senator Chuck Schumer (D-NY) proposed the Innovative Design Protection Act (“IDPA”).<sup>26</sup> The IDPA would grant copyright protection to fashion designs, “one of the most important, common, and accessible sources for artistic expression in the nation.”<sup>27</sup> Under the IDPA, designs would receive copyright protection for three years if they are “the result of a designer’s own creative endeavor” and “provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.”<sup>28</sup> A fashion design would be limited to the “appearance as a whole of an article of apparel, including its ornamentation” of a designer’s original and creative venture.<sup>29</sup>

After its introduction in 2012, the IDPA was referred to the Committee on the Judiciary, which seemed in favor of the bill but articulated several concerns to its passing.<sup>30</sup> The Committee was primarily concerned the IDPA would affect consumer access to affordable apparel.<sup>31</sup> Julia Wang, menswear designer and graduate of Parsons School of Design, addresses the potential effect on consumers voiced by the Committee.<sup>32</sup> Wang recognizes the importance of

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<sup>21</sup> *Id.*; see also Press Release, LeadFerret, LeadFerret Releases a Directory of Contacts in the Fashion and Apparel Industry (Jan. 16, 2014) [hereinafter LeadFerret Press Release], <http://bit.ly/1S5Wgb5>.

<sup>22</sup> TIM JACKSON & DAVID SHAW, MASTERING FASHION MARKETING 89 (2009).

<sup>23</sup> *Id.* at 24.

<sup>24</sup> *Id.* at 27.

<sup>25</sup> MALONEY, *supra* note 20, at 6; see also LeadFerret Press Release, *supra* note 21 (stating the directory is valuable for marketing campaigns).

<sup>26</sup> See The Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012).

<sup>27</sup> S. REP. NO. 112-259, at 2 (2012).

<sup>28</sup> The Innovative Design Protection Act of 2012 § 2(a), S. 3523.

<sup>29</sup> *Id.*

<sup>30</sup> See S. REP. NO. 112-259, at 9.

<sup>31</sup> *Id.* at 10.

<sup>32</sup> E-mail from Julia Wang, Menswear Fashion Designer, to Tiffany Tse, J.D. Candidate, Catholic Univ. of Am. Columbus Sch. of Law (July 29, 2015, 11:22 AM) [hereinafter

knockoff retailers, saying a “19 year old non-trust fund baby picking up an Alexander Wang knock-off bag at Forever 21 is never going to be able to afford the real thing.”<sup>33</sup> The Committee commented if the IDPA were to pass, retailers would ultimately increase costs, “which could be borne by middle-income consumers.”<sup>34</sup> What Wang and the Committee are saying is true. The reality is that fashion retailers have found ways to produce apparel cheaply and quickly, which is appealing to the majority of consumers.<sup>35</sup>

A second concern articulated by the Committee was that the IDPA could potentially decrease innovation as “copying may generate rapid demand for new designs as older, copied designs lose some of their appeal.”<sup>36</sup> The bill was passed out of the Senate Judiciary Committee in 2012 but was never enacted and was not introduced in the following year.<sup>37</sup> Since the beginning of 2013, fashion designers have been without legislative support to protect their artistic creations.<sup>38</sup>

It is important to note the differences between an in-house designer and an independent designer. Fashion labels and apparel manufacturing companies often employ in-house clothing designers.<sup>39</sup> The fashion house typically owns the right to the design for apparel designed by an in-house designer.<sup>40</sup> Louis Vuitton, an internationally recognized French luxury fashion label, appoints a creative director as their in-house designer to revamp its brand and track its progress with popular trends.<sup>41</sup> After 16 years as the creative director, Marc Jacobs left Louis Vuitton and was replaced by the former Balenciaga creative director, Nicolas Ghesquière.<sup>42</sup> Independent designers, on the other hand, typi-

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E-mail from Julia Wang] (on file with author).

<sup>33</sup> *Id.*

<sup>34</sup> S. REP. NO. 112-259, at 10.

<sup>35</sup> Arielle Cohen, *Designer Collaborations as a Solution to the Fast-Fashion Copyright Dilemma*, 11 CHI.-KENT J. INTELL. PROP. 172, 182 (2012) (finding consumers will choose to buy from a fast-fashion retailer or a better known designer instead of a mid-level and independent designer).

<sup>36</sup> S. REP. NO. 112-259, at 10.

<sup>37</sup> The Innovative Design Protection Act of 2012, S. 3523; *see also* Quilichini, *supra* note 8, at 252 (stating the bill was introduced and referred to the Committee on the Judiciary but no further action has been taken).

<sup>38</sup> Tyler Baker & Christine Steiner, *Fashion Designers: Legally Naked?*, ART L. BLOG (Feb. 10, 2012), <http://bit.ly/22pMRxt>.

<sup>39</sup> Chad Morrison, *Who Hires Fashion Designers?*, DESIGN TRAINING, <http://bit.ly/1S1J0Xx> (last visited Jan. 25, 2016); NIRUPAMA PUNDIR, *FASHION TECHNOLOGY: TODAY AND TOMORROW* 5 (2007).

<sup>40</sup> Morrison, *supra* note 39; *see also* PUNDIR, *supra* note 39, at 5.

<sup>41</sup> *See Nicolas Ghesquière*, LOUIS VUITTON, <http://vuitton.lv/23pRIVa> (last visited Nov. 19, 2015).

<sup>42</sup> Suzy Menkes & Eric Wilson, *Marc Jacobs to Leave Louis Vuitton*, N.Y. TIMES (Oct. 2, 2013), <http://nyti.ms/1MqkM7E>; *see also* Nadya Masidlover & Christina Passariello, *Louis Vuitton Appoints Ghesquière as Creative Director*, WALL ST. J. (Nov. 4, 2013, 12:56

cally work for themselves by either designing custom pieces for a specific client or launching their own brand.<sup>43</sup> Many independent designers, who generally sell and market their designs on websites like Etsy, rarely have the financial resources to start their own label, let alone open their own boutique.<sup>44</sup>

According to the Bureau of Labor Statistics, there are approximately 19,040 fashion designers in all fashion design related industries in the United States.<sup>45</sup> Of these fashion designers, 7,730 work in Apparel, Piece Goods, and Notions Merchant Wholesalers, 2,540 work in Cut and Sew Apparel Manufacturing, 2,460 work in Management of Companies and Enterprises, 1,640 work in Specialized Design Services, and 1,550 work in Motion Picture and Video Industries.<sup>46</sup> The U.S. Small Business Administration's table of small business size standards for apparel manufacturing is 500 employees.<sup>47</sup> Independent designers, who are also small business owners, are the most vulnerable in regards to the privacy of their designs. While there are laws that guarantee full protection for artists, musicians, and filmmakers, fashion designers are not as protected as their creative counterparts.<sup>48</sup> Trademark, trade dress, copyright, and patent laws protect creative works, but these various forms of intellectual property are inadequate when applied to fashion designs.<sup>49</sup>

#### A. Trademark and Trade Dress Law Have Limited Ability to Protect Fashion Designs.

##### *i. Trademark Laws and Fashion Design*

Among all intellectual property laws, trademarks appear to be the prevailing law to protect fashion designers and their designs. According to the Restatement (Third) of Unfair Competition, a trademark is “a word, name, symbol,

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PM), <http://on.wsj.com/1Sc8UZf>.

<sup>43</sup> Melinda Gaines, *Salaries of a Clothing Designer*, CHRON, <http://bit.ly/20wndb2> (last visited Jan. 17, 2016).

<sup>44</sup> BARNEY WARF, ENCOUNTERS AND ENGAGEMENTS BETWEEN ECONOMIC AND CULTURAL GEOGRAPHY 73 (2012); see also *Learn How to Sell on Etsy*, ETSY, <http://etsy.me/1Wof9ZL> (last visited Nov. 13, 2015) (explaining Etsy is an easy to use website to sell designs with no monthly fees).

<sup>45</sup> Bureau of Lab. Stats., *Occupational Employment and Wages, May 2015*, U.S. DEP'T OF LAB. (Mar. 30, 2016), <http://1.usa.gov/1VOvPZN>.

<sup>46</sup> *Id.*

<sup>47</sup> U.S. SMALL BUS. ADMIN., TABLE OF SMALL BUSINESS SIZE STANDARDS 8 (2015) [hereinafter SMALL BUSINESS STANDARDS], <http://1.usa.gov/1SulbC9>.

<sup>48</sup> Raustiala & Springman, *supra* note 5, at 1689.

<sup>49</sup> *Id.* (discussing that copying of styles by fast fashion retailers violates intellectual property rights of fashion designers).

devise, or other designation, or a combination of such design designations, that is distinctive of a person's goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others."<sup>50</sup> This can mean the intertwining of the letter 'C' to symbolize Chanel and the overlapping 'YSL' arrangement for Yves Saint Laurent.<sup>51</sup> While registering a trademark with the United States Patent & Trademark Office ("USPTO") is not required for protection, registration can cost more than \$1,500 and typically takes between 18 to 36 months to process.<sup>52</sup>

In 1946, the Lanham Act was enacted and expanded trademark law "beyond source-identification."<sup>53</sup> The Lanham Act protects fashion designs by widening the scope of a trademark to encompass the certain elements of a product, such as its "size, shape, color, or design."<sup>54</sup> While the expansion has helped many designers obtain a legal remedy against those who have infringed their trademark, there are still problems that arise for fashion designers under current trademark laws.<sup>55</sup>

First, trademark protection only applies to identifiable elements of a design and not the entire design.<sup>56</sup> For most famous fashion houses, trademarks are used to distinguish themselves not only from competitors, but also from imitators.<sup>57</sup> This particular approach allows a fashion house to put its trademark all over a piece of clothing in order to receive trademark protection. For example, Burberry, a British luxury brand, owns a trademark for their famous plaid print, which is incorporated in their designs.<sup>58</sup> Unfortunately, independent designers seldom use this approach to protect the entirety of their design because they have less brand recognition among consumers.

Second, the Lanham Act requires a high standard of distinctiveness, which can be difficult to prove as an up-and-coming designer.<sup>59</sup> Trademark laws can

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<sup>50</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (AM. LAW INST. 1995).

<sup>51</sup> CC, Registration No. 4,105,557; Y S L, Registration No. 1,711,127.

<sup>52</sup> See *Trademark FAQs*, CARR FERRELL LLP, <http://bit.ly/1SKbPT9> (last visited Nov. 13, 2015); see also Lori Lapidario, *How Much Does it Cost to Trademark a Business Name?*, LEGALZOOM, <http://bit.ly/20wpmDw> (last visited Jan. 24, 2015).

<sup>53</sup> Lanham Act of 1946, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified at 15 U.S.C. §§ 1051 et seq.); *The Devil Wears Trademark: How the Fashion Industry Has Expanded Trademark Doctrine to Its Detriment*, 127 HARV. L. REV. 995, 1000-01 (2014) [hereinafter *The Devil Wears Trademark*].

<sup>54</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992); see also *The Devil Wears Trademark*, *supra* note 52, at 1002.

<sup>55</sup> See, e.g. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012).

<sup>56</sup> Lanham Act § 45.

<sup>57</sup> Sunila Sreepada, *The New Black: Trademark Protection for Color Marks in the Fashion Industry*, 19 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1131, 1137 (2009).

<sup>58</sup> BURBERRY LIMITED, Registration No. 4,123,508.

<sup>59</sup> Lanham Act § 2(f).



protect various aspects in fashion designs to create brand recognition, such as logos, pictures, colors, product shapes, and slogans.<sup>60</sup> Trademarks help designers spread brand awareness in the fashion market and have the purpose of protecting a design's true source.<sup>61</sup> Under the Lanham Act, to establish a violation of either a registered mark or an unregistered mark, the plaintiff must demonstrate that (1) it has a valid and legally protectable mark, (2) it is the owner of the mark, and (3) the defendant is using the mark to identify goods or services that causes a likelihood of confusion.<sup>62</sup>

To determine whether a mark is valid and legally protectable, it must be distinctive.<sup>63</sup> In *Abercrombie & Fitch Co. v. Hunting World, Inc.*, the Second Circuit outlined the primary test courts use to determine the distinctiveness of a trademark.<sup>64</sup> The *Abercrombie* court determined whether the registered 'Safari' trademark used by Abercrombie & Fitch Co. ("Abercrombie"), for their sporting line was associated with other 'Safari' expressions, such as 'Minisafari' and 'Safariland.'<sup>65</sup> Hunting World, Inc., an apparel company, used similar 'Safari' expressions in their sportswear, and Abercrombie sued for trademark infringement.<sup>66</sup>

The Second Circuit explained marks are classified as either (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful.<sup>67</sup> Generic marks can be 'born' generic or become generic over time through overuse.<sup>68</sup> Generic marks receive no protection under current trademark laws because they are typically not seen as specific to a certain brand or designer.<sup>69</sup> Suggestive, arbitrary, and fanciful marks are deemed distinctive and, therefore, may be protected.<sup>70</sup> De-

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<sup>60</sup> See *The Role of Trademarks in Marketing*, WIPO MAG., Feb. 2002, at 10, 10, <http://bit.ly/1S3dUdi>.

<sup>61</sup> *The Devil Wears Trademark*, *supra* note 52, at 1000.

<sup>62</sup> *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 210 (3rd Cir. 2000); Lanham Act § 32(1).

<sup>63</sup> Lanham Act § 2(f).

<sup>64</sup> See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976).

<sup>65</sup> *Id.* at 7.

<sup>66</sup> *Id.*

<sup>67</sup> *Id.* at 9.

<sup>68</sup> See Lanham Act § 14(3). An example of a generic mark is Speedo. The term originated from the name of the brand, Speedo International Ltd., but is now used interchangeably to identify swim briefs, regardless of the brand. See *Genericized Trademark*, DANA B. TASCHNER, <http://bit.ly/1VOAMSt> (last visited Nov. 16, 2015).

<sup>69</sup> *Two Pesos*, 505 U.S. at 767 (citing *Chevron Chem. Co. v. Voluntary Purchasing Grps., Inc.*, 659 F.2d 695, 702 (5th Cir. 1981)) ("[T]rademark law requires a demonstration of secondary meaning only when the claimed trademark is not sufficiently distinctive of itself to identify the producer; the court held that the same principles should apply to protection of trade dresses.")

<sup>70</sup> *Id.* at 768.

scriptive marks are protected only if they have acquired secondary meaning, which refers to a consumer's ability to associate the particular mark with the source (e.g., a fashion house).<sup>71</sup> The court in *Abercrombie* found 'Safari' was a descriptive mark and had not acquired secondary meaning because consumers did not typically associate 'Safari' with Abercrombie.<sup>72</sup> Thus, Hunting World did not infringe on Abercrombie's trademark.<sup>73</sup>

The most recent development in trademark law involving fashion designs occurred after the *Christian Louboutin v. Yves Saint Laurent Am.* decision.<sup>74</sup> To many fashionistas, Christian Louboutin's ("Louboutin"), "bright, lacquered red outsole" distinguishes their shoes from other shoe designs.<sup>75</sup> Louboutin sued Yves Saint Laurent ("YSL") for trademark infringement after YSL used a similar color for the soles of their shoes.<sup>76</sup> Relying on the Supreme Court's decision in *Qualitex Co. v. Jacobson Prods., Co.*, the Second Circuit ultimately found that a color is protectable as a trademark if it "acts as a symbol that distinguishes a firm's goods and identifies their source, without serving any other significant function."<sup>77</sup> This case marked a huge success for the fashion industry, as Louboutin prevailed in protecting their distinguishable red-sole shoes in the fashion market.<sup>78</sup>

Aside from trademark infringement, fashion designers may be able to protect their marks through dilution claims.<sup>79</sup> Dilution is defined as "the lessening of the capacity of a famous mark to identify and distinguish goods or services."<sup>80</sup> There are two types of dilution: dilution by blurring and dilution by tarnishment.<sup>81</sup> Dilution by blurring occurs when there is a "similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark," therefore resulting in the trademark not being able to act as a strong source identifier.<sup>82</sup> Dilution by tarnishment occurs when a famous mark has its reputation harmed due to a similar mark.<sup>83</sup> While trademark dilution provides some protection for fashion designs, it does not fully protect design-

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<sup>71</sup> *Nat'l Mineral Co. v. Bourjois Inc.*, 62 F.2d 1, 3 (7th Cir. 1932).

<sup>72</sup> *Abercrombie*, 537 F.2d at 11.

<sup>73</sup> *Id.*

<sup>74</sup> *Louboutin*, 696 F.3d at 206.

<sup>75</sup> *Id.* at 213.

<sup>76</sup> *Id.*

<sup>77</sup> *Id.* at 214 (quoting *Qualitex Co. v. Jacobson Products, Co.*, 514 U.S. 159, 166 (1995)).

<sup>78</sup> *Id.* at 228.

<sup>79</sup> Lanham Act § 43(c).

<sup>80</sup> *Id.* § 45.

<sup>81</sup> *Id.* § 43(c)(2); *see also* *Biosafe-One, Inc. v. Robert Hawks*, 524 F.Supp.2d 452, 466 (5th Cir. 2007)

<sup>82</sup> Lanham Act § 43(c)(2)(B).

<sup>83</sup> *Id.* § 43(c)(2)(C).

ers who have just entered the fashion market.<sup>84</sup> Trademark dilution requires “the lessening of capacity of a famous mark” and for independent designers, their ‘mark’ has yet to become famous.<sup>85</sup> When bringing a trademark dilution suit, these relatively unknown designers will not be able to prove their marks are famous. Thus, dilution laws provide little to no protection for independent fashion designers.<sup>86</sup>

*ii. Trade Dress and Fashion Design*

Fashion designers can also invoke trade dress to protect their works. Trade dress protects a product’s total image and its overall appearance.<sup>87</sup> Hermés International, a French, high-end fashion house, has a registered trade dress with the USPTO for the overall appearance of the Hermés Birkin bag, which includes the bottom and sides of the bag coupled with its triangular profile.<sup>88</sup> Trade dress is not restricted to registered trademarks and can include unregistered words and “features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques” that the public has come to associate with a single name.<sup>89</sup> For a designer to rely on federal law to protect their unregistered trade dress, he or she must prove their design is unusual and memorable, and likely to serve as a designator of origin of the product.<sup>90</sup>

In *Wal-Mart Stores, Inc. v. Samara Bros.*, a clothing designer of children’s apparel, Samara Bros., brought action for infringement of an unregistered trade dress against Wal-Mart Stores, Inc., (“Wal-Mart”).<sup>91</sup> Samara Bros. stated Wal-

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<sup>84</sup> See Natalya Y. Belonozhko, *Famous Trademarks in Fashion: Why Federal Trademark Dilution Law Favors a Monopoly over Small Business Success*, 51 WILLAMETTE L. REV. 365, 387-89 (2015) (arguing small businesses are not as protected by the Federal Trademark Dilution Law because they cannot satisfy the commercial strength and inherent distinctiveness factors).

<sup>85</sup> See Lanham Act § 43(c)(2)(A).

<sup>86</sup> Belonozhko, *supra* note 84, at 406; see e.g., *Harlem Wizards Ent. Basketball, Inc. v. NBA Props., Inc.*, 925 F.Supp. 1084, 1097 (D.N.J. 1997) (finding a trademark with inherent distinctiveness and commercial strength are factors that are favored to determine a trademark infringement suit).

<sup>87</sup> *Blue Bell Bio-Med. v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989); see also Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C.L. REV. 471, 484 (1997) (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.3d 966, 980 (11th Cir. 1983)).

<sup>88</sup> The mark consists of the configuration of a handbag, having rectangular sides a rectangular bottom, and a dimpled triangular profile, Registration No. 3,936,105; see also Complaint at 1, *Hermés Int’l v. Emperia, Inc.*, Case No. 2:14-cv-03522 (C.D.Cal. May 7, 2014).

<sup>89</sup> *John H. Harland Co.*, 711 F.2d at 980.

<sup>90</sup> Lanham Act § 43(a)(3); Dinwoodie, *supra* note 87, at 490.

<sup>91</sup> *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 207 (2000) (holding that in

Mart copied their garments, “with only minor modifications” to produce so-called “knockoffs.”<sup>92</sup> To succeed in a trade dress infringement claim, the plaintiff must show its trade dress is either “inherently distinctive” or the trade dress acquired distinctiveness through secondary meaning.<sup>93</sup> The design distinctiveness requirement sets a very high standard. Since independent designers have yet to establish themselves in the fashion community, this requirement can be difficult for them to surpass, as they are required to prove the “consuming public identifies the dress with the specific producer” instead of the product itself.<sup>94</sup> To determine ‘secondary meaning,’ courts evaluate six factors: “(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark’s use.”<sup>95</sup> Most often, it takes a substantial amount of time and resources for a designer to “acquire distinctiveness through secondary meaning” because consumers are frequently unable to recognize the work of an unknown designer.<sup>96</sup>

The strength of a designer’s mark in a typical trademark or trade dress case affects the likelihood that consumers will be confused as to the source of products that have noticeably similar marks.<sup>97</sup> This can be difficult for emerging independent designers to accomplish. If another designer decides to adopt a specific mark, there is a high probability that consumers will mistakenly associate the second designer’s product with the stronger mark. Trademark law and trade dress have had their benefits when protecting designs in infringement suits since the Lanham Act. Nevertheless, these laws only go so far in protecting a designer’s work. Consumers will have to be able to distinguish between certain designs and will ultimately recognize a brand-name designer instead of someone who is new to the fashion industry. Trademark laws cannot fully protect independent fashion designers, who are unable to prove the ‘distinctiveness’ requirement because they are less prominent in the fashion world.

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an action of unregistered trade dress under the Lanham Act, the respondent is required to show that its product’s design had acquired secondary meaning to prove that it was distinctive).

<sup>92</sup> *Id.* at 207-08.

<sup>93</sup> *Id.* at 210-11; Lanham Act § 43(a)(3).

<sup>94</sup> Karina K. Terakura, *Insufficiency of Trade Dress Protection: Lack of Guidance for Trade Dress Infringement Litigation in the Fashion Industry*, 22 U. HAW. L. REV. 569, 588 (2000).

<sup>95</sup> *Centaur Comme’ns, Ltd. v. A/S/M Comme’ns, Inc.*, 830 F.2d 1217, 1222 (2d Cir. 1987).

<sup>96</sup> *Wal-Mart Stores*, 529 U.S. at 211.

<sup>97</sup> *Versa Prods. Co., Inc. v. Bifold Co. Mfg. Ltd.*, 50 F.3d 189, 204 (3rd Cir. 1995) (finding the likelihood of confusion could be found only if consumers rely on the product’s configuration to identify the producer of the goods).

## B. Copyright Laws Have Limited Ability to Protect Fashion Designs.

Under current copyright laws, protection extends to “original works of authorship fixed in any tangible medium.”<sup>98</sup> The Copyright Act protects “(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.”<sup>99</sup> A copyright is valid for the life of the author plus 70-years.<sup>100</sup> At first glance, it appears fashion design would fit under the fifth category, “pictorial, graphic, and sculptural works,” but it is, nonetheless, not fully protected because fashion designs are considered a ‘useful article.’

Under copyright law, a useful article has “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>101</sup> In 1949, the Copyright Office broadened the scope of copyrighted articles to include architectural works, but still classified fashion design’s function as utilitarian.<sup>102</sup> Under the Copyright Act, the ‘useful article’ doctrine fails to protect fashion designs as clothing serves as a “‘decorative function,’ so that the decorative elements of clothing are generally ‘intrinsic’ to the overall function, rather than separable from it.”<sup>103</sup> The Copyright Act does not register copyrights in “three-dimensional aspects of clothing or costume design,” because clothes contained “no artistic authorship separable from their overall utilitarian shape.”<sup>104</sup> The Copyright Act does not protect certain elements because they are considered utilitarian works.<sup>105</sup> Moreover, current copyright laws may protect the particular design of the article of clothing but not the article of clothing itself.<sup>106</sup>

To receive protection, a work must also meet the requirement of originali-

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<sup>98</sup> Copyright Act § 102(a).

<sup>99</sup> *Id.*

<sup>100</sup> *Id.* § 302(a).

<sup>101</sup> *Id.* § 101.

<sup>102</sup> Lynsey Blackmon, *The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion*, 35 PEPP. L. REV. 107, 131 (2007) (quoting Safia A. Nurbhai, *Style Piracy Revisited*, 10 J.L. & POL’Y 489, 497 (2002)).

<sup>103</sup> *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed.Appx. 42, 45 (2d. Cir. 2012).

<sup>104</sup> *Registrability of Costume Design*, 56 Fed. Reg. 56,530, 56,530 (Nov. 5, 1991).

<sup>105</sup> Digital Millennium Copyright Act of 1998 § 502(4), 17 U.S.C. §1302(4) (2012).

<sup>106</sup> *A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Cts., Internet & Intell. Prop. of the H.R. Comm. on the Judiciary*, 109th Cong. 209-10 (2006) [hereinafter *Fashion Design Hearing*] (prepared statement of the U.S. Copyright Office).

ty.<sup>107</sup> Copyrights protect “original works of authorship fixed in any tangible medium of expression.”<sup>108</sup> For a work to be considered “original,” it must be “independently created by the author (as opposed to copied from other works), and possess at least some minimal degree of creativity.”<sup>109</sup> Since the originality requirement for copyright is a lower threshold than the ‘novelty’ threshold required for a design patent, copyright appears to be the most practical and attainable form of protection for fashion designers.

While existing copyright laws in the United States provide protection over original prints and patterns, unique color arrangements, and novel combinations of elements used in apparel, it does not protect the entire design itself.<sup>110</sup> Whereas copyright laws are meant to protect artistic creativity and incentivize innovation, fashion designs are still deemed as utilitarian.<sup>111</sup> Based on current trends, courts have tiptoed around the utilitarian issue and have chosen to accept fashion designs as utilitarian and not an artistic work.<sup>112</sup>

### C. Patent Laws Have Limited Ability to Protect Fashion Designs.

The USPTO grants patents to an inventor for a limited amount of time in exchange for the disclosure of his or her invention.<sup>113</sup> Similar to copyright protection, patent protection extends only to specific artistic objects that possess certain prerequisite features.<sup>114</sup> In order for the USPTO to grant a patent, an invention must meet five requirements: (1) the patentable subject matter requirement, (2) the utility requirement, (3) the novelty requirement, (4) the description requirement, and (5) the non-obviousness requirement.<sup>115</sup> While an attorney is not always required to file a patent application, the application process can be considered expensive and timely once issued by the USPTO.<sup>116</sup>

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<sup>107</sup> Copyright Act § 102(a).

<sup>108</sup> *Id.*

<sup>109</sup> *Feist*, 499 U.S. at 345; *see also* Copyright Act § 102.

<sup>110</sup> *Galiano v. Harrah’s Opening Co., Inc.*, 416 F.3d 411, 419 (5th Cir. 2005) (noting that the U.S. Copyright Office does not register garment designs even if they contain ornamental features because they are useful articles); *see also* Christiane Schuman Campbell, *Protecting Fashion Designs Through IP Law*, BYLINED ARTS. (Apr. 14, 2015), <http://bit.ly/23z2ntm>.

<sup>111</sup> *Galiano*, 416 F.3d at 414.

<sup>112</sup> *Id.*

<sup>113</sup> Patent Act of 1952 § 154, 35 U.S.C. § 154 (2012); Biana Borukhovich, Note, *Fashion Design: The Work of Art That Is Still Unrecognized in the United States*, 9 WAKE FOREST INTELL. PROP. L.J. 155, 163 (2009).

<sup>114</sup> Patent Act § 101; Borukhovich, *supra* note 113, at 163.

<sup>115</sup> Patent Act §§ 101-103, 112; Borukhovich, *supra* note 113, at 163.

<sup>116</sup> U.S. PAT. & TRADEMARK OFF., USPTO FEE SCHEDULE (2014), <http://1.usa.gov/1qGbt9E>. The filing fee for a utility patent is \$280, which does not include search fees (\$600), examination fees (\$720), or post-allowance fees (\$960). *Id.* at 1-2.

Under the United States Patent Act, there are three types of patents: utility patents, design patents, and plant patents.<sup>117</sup> A utility patent protects the idea or function of an invention, whereas a design patent protects the overall ornamental appearance of an innovative design of a product.<sup>118</sup> Design patents protect “new, original, and ornamental design for an article of a manufacture.”<sup>119</sup> Under design patent laws, an ornamental design may be protected if it is considered novel and non-obvious.<sup>120</sup> Design patents can sometimes exclude other companies from using their designs for at least 14 years, “if not in perpetuity, should those designs acquire distinctiveness during the design patent protection period.”<sup>121</sup> If a fashion design meets the five requirements, a designer would need to submit his or her application, including drawing or photographs, to the USPTO. This means that a fashion designer will mostly apply for a design patent because they will want to protect the overall appearance of their design.

There are two major obstacles fashion designers must overcome in order to qualify for a design patent. First, before a patent examiner issues a patent, the examiner must determine if the design is new and non-obvious as compared to the prior art.<sup>122</sup> The statutory provision for non-obviousness states a patent may not be obtained when “the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.”<sup>123</sup> In *KSR International Co. v. Teleflex Inc.*, the Court held that to evaluate the non-obviousness requirement, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”<sup>124</sup> Fashion designs rarely fulfill this requirement when filing for a patent regardless of their unique artistic features.<sup>125</sup> Moreover, even if the USPTO grants a designer his or her patent, its protection only extends to the

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<sup>117</sup> *General Information Concerning Patents*, U.S. PAT. & TRADEMARK OFF. (Oct. 1, 2014), <http://1.usa.gov/1WpTqki>. Plant patents protect “whoever invents or discovers and asexually reproduces any distinct and new variety of plant,” and are not within the scope of this Comment. Patent Act § 161.

<sup>118</sup> MPEP § 1502.01 (9th ed. Rev. 7, Nov. 2015).

<sup>119</sup> Patent Act § 171.

<sup>120</sup> *Id.* §§ 102-103.

<sup>121</sup> Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & TECH. 251, 253 (2011). Non-design patents typically run for 17 years. Patent Act § 154.

<sup>122</sup> Patent Act § 103.

<sup>123</sup> *Id.*

<sup>124</sup> *KSR Int. Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007).

<sup>125</sup> M. C. Miller, *Copyrighting the “Useful Art” of Couture: Expanding Intellectual Property Protection for Fashion Designs*, 55 WM. & MARY L. REV. 1618, 1627 (2014).

non-function elements of a functional design.<sup>126</sup> This means that only certain aspects of a design can receive protection with a patent, instead of the design as a whole.

Second, a standard patent for fashion design purposes will typically take anywhere between eight- to twenty-months for the USPTO to process.<sup>127</sup> From the time a designer files a patent to the time the patent is approved essentially “render[s] them largely impractical for the fashion industry, where a fashion season cycles through in a matter of months.”<sup>128</sup> Compared to other forms of intellectual property protection, patents can be quite costly for an independent designer coupled with the inconvenient application process when trends usually change every month.<sup>129</sup> The fast-trend culture of the fashion industry does not coincide with the lengthy process required to receive a design patent from the USPTO.<sup>130</sup> By the time a designer receives his or her patent, a fast-fashion retailer will already have that specific design in stores, and consumers will have already moved onto the next trend. Independent designers invest significantly when starting their own brand and spend a substantial amount of time developing their designs.<sup>131</sup> Design patents are not only inconvenient because of the lengthy application process, but also are considered inapplicable because an entire fashion design cannot be protected.

## II. INTERNATIONAL FASHION DESIGN PROTECTION FRAMEWORKS

In comparison to the intellectual property laws in Europe, the United States seems to be behind in protecting its fashion designs. Advocates of stricter protection rights suggest mimicking the European Union’s (“EU”) and French intellectual property laws.<sup>132</sup> Although European laws provide some guidance on tackling fashion piracy issues, there are still many concerns that are unique to the United States’ legal culture and economy.

### A. EU Intellectual Property Laws are Unlikely to Work in the United States.

Since 2003, the EU has been offering design protection in the form of regis-

<sup>126</sup> *Id.*

<sup>127</sup> Lauren Indvik, *Why Patent-Holding Designs Still get Knocked Off: A Case Study with Alexander Wang*, FASHIONISTA (Dec. 18, 2013), <http://bit.ly/1XrPqOm>.

<sup>128</sup> *Id.*

<sup>129</sup> Gene Quinn, *Design Patents: The Under Utilized and Overlooked Patent*, IPWATCHDOG (Dec. 20, 2011), <http://bit.ly/1VOInQZ>.

<sup>130</sup> *See* Indvik, *supra* note 127.

<sup>131</sup> Alec Leach, *How Can Independent Brands Succeed in 2015?*, HIGHSNOBIETY (Aug. 4, 2015), <http://bit.ly/1S1SCN5>.

<sup>132</sup> *See* Julie P. Tsai, *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK L. REV. 447, 467-68 (2005).



tered and unregistered Community Design.<sup>133</sup> Registered Community Designs have “an exclusive right covering the outward appearance of a product,” which results “from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation. The fact that the right is registered confers on the design great certainty should infringement occur.”<sup>134</sup> When a design protection is registered, it is automatically registered in every state within the EU.<sup>135</sup> All protected designs are listed in a searchable database, allowing designers to see if their work violates other designs in the market.<sup>136</sup> An unregistered Community Design has similar characteristics of a registered Community Design, but grants the owner a shorter term of protection of three years.<sup>137</sup> Unlike a registered Community Design, unregistered designs may be infringed by copying, with “no recourse for independent creation.”<sup>138</sup> From the moment a design is created, hence an unregistered design, it is automatically given three years of protection from when it is made available to the public.<sup>139</sup>

However, the EU’s design anti-piracy framework may translate differently when applied in the United States. The American civil litigation system is evidently stronger in comparison to Europe’s system.<sup>140</sup> Implementing a system that allows unregistered protection of designs will increase design piracy litigation.<sup>141</sup> Although the Community Design System may help fashion houses bring infringement lawsuits to light, independent designers lack the financial resources and legal support to fight potential lawsuits.<sup>142</sup> Small business owners are unlikely to withstand “the cost of an attorney, court fees, and the time necessary,” which are significant variables to the United States’ uniquely litigious culture.<sup>143</sup>

## B. French Intellectual Property Laws Are Unlikely to Work in the United

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<sup>133</sup> *Id.* at 465-66.

<sup>134</sup> *General Questions*, OFF. FOR HARMONIZATION IN THE INTERNAL MKT., <http://bit.ly/1T1HaTS> (last visited Jan. 24, 2016).

<sup>135</sup> *Id.*; Tsai, *supra* note 132, at 466.

<sup>136</sup> Mauro Paiano & Ann Critchell-Ward, *The Harmonization of Intellectual Property Rights Throughout the European Union*, N.J. LAWYER, Oct. 2003, at 36, 39.

<sup>137</sup> Tsai, *supra* note 132, at 466-67.

<sup>138</sup> *Id.* at 467.

<sup>139</sup> *Id.* at 466-67.

<sup>140</sup> *Fashion Design Hearing*, *supra* note 106, at 86 (statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law).

<sup>141</sup> Lisa J. Hedrick, *Tearing Fashion Design Protection Apart at the Seams*, 65 WASH. & LEE L. REV. 215, 254-55 (2008).

<sup>142</sup> *Id.*

<sup>143</sup> *Id.* at 255.

States.

Another suggested model to improve protection laws in the United States is the French Intellectual Property Code (“French IP Code”).<sup>144</sup> The French IP Code protects original works, including those that “reflect the personality of their author” and expressly lists “the creations of the seasonal industries of dress and articles of fashion” as a protected work of the mind.<sup>145</sup> France’s current copyright laws provide protection to “original fashion designs automatically on the date of creation, regardless of registration.”<sup>146</sup> While French laws do not require the element of originality like copyright laws in the United States, they grant copyright protection once “the design becomes popular with the general public.”<sup>147</sup> This is hugely problematic for independent designers who have not established themselves in the apparel industry. Independent designers have yet to “[become] popular with the general public” and if the French IP Code is adopted in the United States, independent designers will continue to be at risk of design piracy.<sup>148</sup>

### III. THE FAST-FASHION PHENOMENON AND ITS EFFECT ON EMERGING INDEPENDENT DESIGNERS

Unfortunately for fashion designers, the ability to copy designs has only grown with the advancements in fashion production and technology.<sup>149</sup> The median annual wage for a fashion designer is \$64,030, with the lowest ten percent earning less than \$33,260 and the top ten percent earning more than \$129,380.<sup>150</sup> A good percentage of fashion designers are self-established independent business owners.<sup>151</sup> As of 2014, the Bureau of Labor Statistics estimated there were 23,100 total professional fashion designers in the U.S. apparel

<sup>144</sup> Francesca Montalvo, *Protecting Fashion a Comparative Analysis of Fashion Design Copyright Protection in the US and Europe*, CARDOZO ARTS & ENT. L. J. BLOG (Sept. 19, 2014), <http://bit.ly/1VOIM5Z>.

<sup>145</sup> Code de la propriété intellectuelle [C. Intell. Prop.] art. L112- 2(14) (Fr.); Holger Gauss et al., *Red Soles Aren’t Made for Walking: A Comparative Study of Europe Fashion Laws*, 5 LANDSLIDE, no. 6, July/Aug. 2013, at 1, 2, <http://bit.ly/1N6Cg91>.

<sup>146</sup> Emma Yao Xiao, *The New Trend: Protecting American Fashion Designs Through National Copyright Measures*, 28 CARDOZO ARTS & ENT. L.J. 417, 426 (2010).

<sup>147</sup> Borukhovich, *supra* note 113, at 168.

<sup>148</sup> *Id.*

<sup>149</sup> Susan Scafidi, *Intellectual Property and Fashion Design*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE 115, 117 (Peter K. Yu ed., 2006).

<sup>150</sup> U.S. DEP’T OF LAB., BUREAU OF LAB. STATS., OCCUPATIONAL OUTLOOK HANDBOOK 2016-17 EDITION: FASHION DESIGNERS – PAY (2015), <http://1.usa.gov/1T1Khv4>.

<sup>151</sup> U.S. DEP’T OF LAB., BUREAU OF LAB. STATS., OCCUPATIONAL OUTLOOK HANDBOOK 2016-17 EDITION: FASHION DESIGNERS – WORK ENVIRONMENT (2015), <http://1.usa.gov/25XxuB1> (“About 1 in 4 fashion designers were self-employed in 2014.”).

manufacturing industry.<sup>152</sup> Breaking into the fashion design industry is very competitive.<sup>153</sup> Moreover, the cost of production and ultimate selling price of their designs may vary. Each designer goes through the same process of developing, building, and cutting patterns to oversee production.<sup>154</sup> Once a designer accumulates enough resources to launch and produce her own brand, it is crucial that other fashion houses or retailers do not copy her designs so she can distinguish herself in the fashion market.

Due to recent developments in modern technology, entire looks can be photographed during Paris's Fashion Week and "emailed to a factory in China for a sample within hours."<sup>155</sup> The most notoriously known copier of fashion designs is Forever 21.<sup>156</sup> Forever 21, a fast-fashion retailer and Fortune 500 company, has over 480 stores across the world.<sup>157</sup> Forever 21's quick turnover model typically takes a few weeks for a product to be sold in their stores, whereas a typical designer's process ranges between 1.5 to 2 years from the point of initial design to the point of production.<sup>158</sup> A party to more than fifty lawsuits over the last three years, Forever 21 has been at the center of the debate over stronger protection laws for fashion designs.<sup>159</sup>

It is important to distinguish between a knockoff and a counterfeit. A counterfeit is "a nearly exact duplicate of an item sold with the intent to be passed off as the original."<sup>160</sup> An example of a counterfeit can usually be found in black markets, where one can typically buy designer bags and products for a very inexpensive price.<sup>161</sup> Although the quality between a counterfeited design

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<sup>152</sup> U.S. DEP'T OF LAB., BUREAU OF LAB. STATS., OCCUPATIONAL OUTLOOK HANDBOOK 2016-17 EDITION: FASHION DESIGNERS – JOB OUTLOOK (2015), <http://1.usa.gov/1SLnQIa>.

<sup>153</sup> Fflur Cadwaladr Owen, *Breaking into fashion: how I've built up my skills*, THE GUARDIAN (Mar. 30, 2012, 7:40 AM), <http://bit.ly/1qmmRqN>.

<sup>154</sup> E-mail from Julia Wang, *supra* note 32.

<sup>155</sup> Irene Tan, *Knock it off, Forever 21! The Fashion Industry's Battle against Design Piracy*, 18 J.L. & POL'Y 893, 899 (2010) (citing Teri Agins, *Copy Shops: Fashion Knockoffs Hit Stores Before Originals as Designers Seethe*, WALL ST. J., Aug. 8, 1994, at A1).

<sup>156</sup> *Id.* at 915; see also Nicole Giambarrese, *The Look for Less: A Survey of Intellectual Property Protections in the Fashion Industry*, 26 TOURO L. REV. 243, 243 (2010) ("[T]hese designs were readily imitated and instantaneously reproduced by other designers for discount stores, such as Forever 21.").

<sup>157</sup> *Forever 21*, FORBES, <http://onforb.es/1YqzTyH> (last visited Apr. 11, 2016). Forever 21 currently has over \$4.4 billion in revenue and more than 30,000 employees working worldwide. *Id.*

<sup>158</sup> Tan, *supra* note 155, at 914.

<sup>159</sup> Amy Odell, *Forever 21's Ability to Copy Designer Clothes Could Be in Jeopardy*, N.Y. MAG. (Apr. 13, 2009, 9:45 AM), <http://thecut.io/1NlvQxK>. Prominent designers and fashion houses, such as Diane von Furstenberg, Anna Sui, and Anthropology have filed over 50 lawsuits against Forever 21 from 2007 to 2010. *Id.*

<sup>160</sup> Ferrill & Tanhehco, *supra* note 121, at 254.

<sup>161</sup> Margaret E. Wade, *The Sartorial Dilemma of Knockoffs: Protecting Moral Rights Without Disturbing the Fashion Dynamic*, 96 MINN. L. REV. 336, 340 (2011).

and the original may be different, the design and logos of a counterfeited product are virtually parallel to the original.<sup>162</sup> On the other hand, a knockoff is “a close copy of the original design, mimicking its elements, but is not sold in an attempt to pass as the original.”<sup>163</sup> An example of a knockoff is when a product has a close-to-exact design, which can include the shape, pattern, and materials, and is typically sold for a less expensive price.<sup>164</sup> For example, Forever 21 has been accused of being a knockoff retailer, by mimicking designers’ products for the last few decades.<sup>165</sup> The fast-fashion phenomenon allows the production of cheaply priced imitations of runway styles after only a few weeks of their introduction.<sup>166</sup>

The recent expansion of affordable and trendy fashion by knockoff retailers has increased concern among the designer community.<sup>167</sup> Established and successful designers are progressively voicing their opinions to the government.<sup>168</sup> Diane von Furstenberg, established fashion designer and president of the Council of Fashion Designers of America, has been the predominant supporter of increasing design protection rights for fashion designers in the United States.<sup>169</sup> Her recent advocacy to strengthen intellectual property protection laws for the fashion industry has led to the filing of lawsuits in five states in order to protect brands and prevent infringers from copying fashion designs.<sup>170</sup> While von Furstenberg has helped increase public awareness on the impact of fast-fashion retailers, independent designers are beginning to voice their opinions as well.<sup>171</sup>

Feral Childe, a self-established and independent fashion label, sued Forever 21 in 2011 for copyright infringement.<sup>172</sup> Feral Childe takes pride in their use of natural fibers and upcycled fabrics in their designs, guaranteeing all their clothing is made with “thoughtful choice of materials and attention to quality construction to make smart, wearable silhouettes for forward-thinking wom-

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<sup>162</sup> *Id.*

<sup>163</sup> Ferrill & Tanhehco, *supra* note 121, at 254.

<sup>164</sup> Wade, *supra* note 161, at 340.

<sup>165</sup> Tan, *supra* note 155, at 901; *see also, e.g.*, Amended Complaint at 1, Felt Hildy, LLC v. Forever 21, Inc., No. LACV11-5819 (C.D.Cal. Aug. 4, 2011).

<sup>166</sup> Scafidi, *supra* note 149, at 117.

<sup>167</sup> *See* Tan, *supra* note 155, at 899-901

<sup>168</sup> *See* Diana von Furstenberg, *Von Furstenberg: Fashion Deserves Copyright Protection*, L.A. TIMES (Aug. 24, 2007), <http://lat.ms/1Scgd2Q>.

<sup>169</sup> *CFDA Members: Diane von Furstenburg*, COUNCIL OF FASHION DESIGNS ASS’N, <http://bit.ly/1SKjtgi> (last visited Oct. 23, 2015).

<sup>170</sup> Danica Lo, *Designer Sues*, N.Y. POST (Mar. 29, 2007, 9:00 AM), <http://nyp.st/1Q3FRiG>.

<sup>171</sup> *Id.*

<sup>172</sup> Complaint at 2, *Felt Hildy*, No. LACV11-5819 (C.D.Cal July 14, 2011), 2011 WL 4662815.

en.”<sup>173</sup> Feral Childe claimed Forever 21 “misappropriated one of Feral Childe’s unique, hand-drawn designs, slapped it on a wide range of product[s], and distributed and sold said product to the public through its brick and mortar and online retail outlets.”<sup>174</sup> Alice Wu and Moriah Carlson, head designers of Feral Childe, commented that their elaborate process takes “months to develop just one of their textile prints.”<sup>175</sup> Since many of Feral Childe’s prints are purely original and cannot be found in any textile or fabric store, Feral Childe registers each of its prints with the Copyright Office.<sup>176</sup> Under current copyright laws, Feral Childe’s textile prints are subject to copyright protection, but the overall garment design is not.<sup>177</sup> Feral Childe’s claim against Forever 21 was settled in 2012, making them one of many independent designers who sued Forever 21 over the last 27 years.<sup>178</sup>

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<sup>173</sup> *About Us*, FERAL CHILDE, <http://bit.ly/1TNH9FC> (last visited Oct. 23, 2015).

<sup>174</sup> Complaint at 2, *Felt Hildy*, No. LACV11-5819.

<sup>175</sup> Jenna Sauer, *How Forever 21 Keeps Getting Away with Designer Knockoffs*, JEZEBEL (July 20, 2007, 4:20 PM), <http://bit.ly/1ScgO4K>.

<sup>176</sup> *Id.*

<sup>177</sup> See *supra* notes 103–106 and accompanying text.

<sup>178</sup> Sauer, *supra* note 175.



Figure #1: Feral Childe (left) and Forever 21 (right)<sup>179</sup>

Jamie Spinello, a jewelry artist and designer in Austin, Texas, started her own fashion label and has been selling her designs since 2007.<sup>180</sup> In 2012, Spinello noticed a necklace she had designed and sold on Etsy was for sale on Nasty Gal, “a global online destination for fashion-forward, free-thinking girls.”<sup>181</sup> Spinello immediately hired a lawyer, who sent Nasty Gal a cease-and-desist letter and informed the company its necklace is an infringement of Spinello’s original.<sup>182</sup> Nasty Gal’s in-house counsel reported that they had no knowledge the necklace was a copy of Spinello’s design and placed the blame on their supplier, a third-party vendor.<sup>183</sup> In June 2014, Spinello filed a complaint against Nasty Gal in the District Court of California for copyright infringement.<sup>184</sup> In return for infringing on her copyrights, Spinello asked Nasty Gal to pay \$150,000 in damages per infringement.<sup>185</sup> Spinello also demanded all profits Nasty Gal had gained in connection with the sale of her designs.<sup>186</sup>

<sup>179</sup> See Emma Grady, *Is Forever 21 an Eco-Fashion Design Thief?*, TREE HUGGER (July 16, 2011), <http://bit.ly/20wBdBG>. Figure #1 demonstrates the strong similarity between Feral Childe’s design and Forever 21’s potentially infringing design. *Id.*

<sup>180</sup> *Bio*, JAMIE SPINELLO, <http://bit.ly/20wBfcE> (last visited Nov. 16, 2015).

<sup>181</sup> Sam Levin, *Nasty Gal Rip-Off: See How One Company Responds to Copyright Theft Allegations*, E. BAY EXPRESS (Jan. 9, 2014), <http://bit.ly/1Mqwe3d>. Etsy is an online market place for “creative entrepreneurs” to sell goods, generally directly to individual consumers. See *About Etsy*, ETSY, <http://etsy.me/20wBiFo> (last visited Jan. 16, 2016). Nasty Gal is a “global online destination for fashion-forward, free-thinking girls.” *About Us*, NASTY GAL, <http://bit.ly/1N5aEBg> (last visited Nov. 16, 2015).

<sup>182</sup> Levin, *supra* note 181.

<sup>183</sup> *Id.*

<sup>184</sup> Complaint at 1-2, *Spinello v. Nasty Gal, Inc.*, No. 2:14-cv-04645 (C.D.Cal. June 17, 2014), 2014 WL 3445475.

<sup>185</sup> *Id.* at 9.

<sup>186</sup> *Id.* at 11.

Spinello's case was ultimately settled out of court, similar to Feral Childe and other lawsuits against Urban Outfitters and Forever 21.<sup>187</sup>

The lack of copyright protection is significantly burdensome for independent designers newly emerging in the fashion industry, especially if they are faced with a lawsuit against a deep-pocketed retailer.<sup>188</sup> Designers will eventually lose profits and recognition from their designs because they are "copied by big box fast-fashion copyist or better known designers."<sup>189</sup> Independent designers most likely price their designs inexpensively, as they are trying to establish a new business and want to attract a variety of customers.<sup>190</sup> Additionally, the average consumer will choose to purchase designs from well-known, established brands instead of an independent designer because of "the status associated with that designer or because they are unaware of the independent's designers version."<sup>191</sup> When a fast-fashion retailer, like Forever 21 or Nasty Gal, produces relatively similar and comparatively inexpensive articles of clothing, consumers ultimately choose the retailer instead of the original designer.<sup>192</sup>

#### IV. RECOMMENDED SOLUTION: EXPAND THE ARCHITECTURAL WORKS COPYRIGHT PROTECTION ACT TO INCLUDE FASHION DESIGNS

In 1990, the Architectural Works Copyright Protection Act ("AWCPA") amended the Copyright Act of 1976 to protect 'architectural works.'<sup>193</sup> Congress was motivated to amend the Copyright Act to include architectural works after adhering to treaty requirements surfacing from the Berne Convention for the Protection of Literary and Artistic Works ("Berne Convention").<sup>194</sup> After the Berne Convention, the United States was compelled to include architectural works within the protected subject matter under the Copyright Act.<sup>195</sup> Before

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<sup>187</sup> *Has the Fast Fashion Cycle Created a Ex-Post Licensing System?*, THE FASHION LAW (Nov. 11, 2015), <http://bit.ly/1SuxAWO>.

<sup>188</sup> Cohen, *supra* note 35, at 182.

<sup>189</sup> *Id.*

<sup>190</sup> See Suzy Hansen, *How Zara Grew into the World's Largest Fashion Retailer*, N.Y. TIMES (Nov. 9, 2012), <http://nyti.ms/22q2btZ> (explaining how Zara used low prices to establish itself as a company and attract customers).

<sup>191</sup> Cohen, *supra* note 35, at 182.

<sup>192</sup> See generally Wade, *supra* note 161, at 340-43 (finding that in 2006 the lost of revenue due to counterfeiting and fashion piracy was approximately \$12 billion).

<sup>193</sup> Architectural Works Copyright Protection Act of 1990 §§ 701-706, Pub. L. No. 101-650, 104 Stat. 5133 (1990) (codified at scattered sections of 17 U.S.C.).

<sup>194</sup> Raphael Winick, *Copyright Protection for Architecture After the Architectural Works Copyright Protection Act of 1990*, 41 DUKE L.J. 1598, 1612 (1992).

<sup>195</sup> *Id.*

the AWCPA, entire buildings could not be protected.<sup>196</sup> Instead, only separable decorative or artistic elements of a building could be protected under copyright laws.<sup>197</sup> Congress should extend the Copyright Act to cover fashion designs by applying the same reasoning used to encompass architectural works under the AWCPA.

#### A. Fashion Designs Should Be Treated as Artistic Works.

Before this article proposes why the Copyright Act should extend to fashion designs, it is important to recognize fashion designs as artistic works instead of purely utilitarian. Once Congress accepts fashion designs as artistic creations, legislators will be more inclined to include this particular subject matter as protectable under copyright laws. Critics argue stricter design protection laws would “hold back the field of fashion, as expanding the use of patents and copyright in any field would inevitably slow that field’s forward movement.”<sup>198</sup> This concern stems from the idea that fashion is constantly changing and improving based on old designs.<sup>199</sup> Designers may be deterred from re-inventing former trends if protected by strict intellectual property laws, thus diminishing innovation in the fashion community.<sup>200</sup> If the United States continues to treat fashion designs as inferior in comparison to its artistic counterparts, American designers may decide to take advantage of the EU’s better protection laws, which will ultimately harm the American economy.<sup>201</sup> Intellectual property laws adequately protecting fashion designs could also incentivize designers to create new elements of fashion that have not yet been introduced, as they will not be legally able to base their works on a copyrighted, trademarked, or patented design.

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<sup>196</sup> Before 1990, the Copyright Act categorized buildings as utilitarian and therefore, could not receive copyright protection. *See* Winick, *supra* note 194, at 1601-02.

<sup>197</sup> *Id.* at 1610.

<sup>198</sup> Emily Zanotti, *What’s the Role of Intellectual Property in Fashion Design?*, REAL CLEAR POL’Y (Feb. 7, 2014), <http://bit.ly/1qkiegN>.

<sup>199</sup> *Id.*

<sup>200</sup> *Cf.* Robin Abcarian, *Love It or Hate It, A ‘Fair Lady’ in Gap’s Skinny Pants*, L.A. TIMES (Sept. 23, 2006), <http://lat.ms/1VONfp7> (outlining Gap’s “Keep it Simple” Campaign, that reinvented Aubrey Hepburn’s skinny jeans and turtleneck look from the 1957 movie “Funny Face”).

<sup>201</sup> *See, e.g.*, Silvia Beltrametti, *Evaluation of the Design Piracy Prohibition Act: Is the Cure Worse than the Disease? An Analogy with Counterfeiting and a Comparison with the Protection Available in the European Community*, 8 N.W. J. TECH. & INTELL. PROP. 147, 168 (2010) (arguing the United States should mimic the European design protection system to adequately protect fashion designs); Tsai, *supra* note 132, at 464, 467 (finding the recognition American designers receive from established European fashion houses in the international market, and arguing fashion designs are threatened when copied based on the little legal recourse in the United States).



After examining and comparing trademark, trade dress, copyright, and patent law, it is clear there is no adequate form of full design protection for designers in the fashion industry in the United States. The fashion design process is a relatively complex timeline of events.<sup>202</sup> Before a dress is bought in a store, whether the store is a boutique or a high-end retailer, the dress must be designed knowing it will be approved, produced, and showcased in fashion shows, magazines, commercials, and red-carpet events around the world months or even years later.<sup>203</sup> A fashion designer has the important task to predict styles and trends that have yet to start, years in advance.<sup>204</sup> In comparison to a fashion designer's artistic counterparts, such as a visual artist and even a poet, there seems to be no current United States law ensuring fashion designers the same basic protection.<sup>205</sup> The most controversial criticism is that fashion design is considered a utilitarian product and therefore, unable to achieve full protection from intellectual property laws.<sup>206</sup>

Fashion is different for every person. For some, fashion is purely utilitarian, such as wearing a thick wool jacket to keep warm in the wintertime or a micro-fiber tank top to alleviate sweat while working out on a humid summer day. For others, fashion is an art form. Fashion critics saw Lady Gaga's meat made dress by designer Franc Fernandez at the 2010 MTV Video Music Awards as an artistic expression of Lady Gaga's political views on the American government's "Don't Ask, Don't Tell" policy.<sup>207</sup> An outfit can symbolize the many personality traits of a wearer, both to himself or herself and to the public. Due to the discrepancies between each consumer on the importance and value of clothing, style, and overall fashion—many people, including scholars, wonder the age-old question: Is fashion a utilitarian or artistic creation?

Courts are reluctant to expand intellectual property laws to include fashion designs because clothes have always been seen as utilitarian with artistic elements.<sup>208</sup> In *Nat'l Theme Prod., Inc. v. Jerry B. Beck, Inc.*, the Southern District Court of California found costumes are copyrightable to the extent that "they have features which can be identified separately and are capable of existing independently as a work of art."<sup>209</sup> Recently, courts have become more accept-

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<sup>202</sup> ERIN CADIGAN, *SOURCING AND SELECTING TEXTILES FOR FASHION: SOURCING AND SELECTION* 112 (2014). The fast fashion phenomenon allows retailers to spend 3-6 months for the entire design process, which normally ranges 6-9 months.

<sup>203</sup> *Id.*

<sup>204</sup> *Id.*

<sup>205</sup> Miller, *supra* note 125, at 1625.

<sup>206</sup> *Id.*

<sup>207</sup> Jillian Mapes, *Lady Gaga Explains Her Meat Dress: 'It's No Disrespect'*, BILLBOARD (Sept. 13, 2010), <http://bit.ly/1Vk8Zec>.

<sup>208</sup> Miller, *supra* note 125, at 1631.

<sup>209</sup> *Nat'l Theme Prod., Inc. v. Jerry B. Beck, Inc.*, 696 F.Supp. 1348, 1352 (S.D.Cal.

ing of allowing elements of designs where they are “physically or conceptually” separable from the useful article.<sup>210</sup> Although courts are increasingly becoming more liberal when allowing certain designers to protect their designs and obtain a remedy, they are still reluctant to address fashion designs as an art form.<sup>211</sup>

Valerie Steele, Director of the Museum at the Fashion Institute of Technology, stated in a *Wall Street Journal* article that “fashion is really seen as the bastard child of capitalism and female vanity.”<sup>212</sup> Even the Editor-in-Chief of *Vogue USA*, Anna Wintour, said that “what I often see is that people are frightened about fashion...Just because you like to put on a beautiful Carolina Herrera dress or a pair of J brand blue jeans instead of something basic from K-Mart, it doesn’t mean you’re a dumb person.”<sup>213</sup> Compared to other art forms, fashion is labeled as “the bastard child” not only in the public’s view, but also in the legal context.<sup>214</sup>

Our society has long celebrated fashion designs as artistic creations. The Metropolitan Museum of Art (“The Met”), hailed as the birthplace of fashion exhibitions, has hosted several exhibits featuring not only fashion’s role in art history, but also the major influences of fashion designers.<sup>215</sup> In 2005, the Met showcased the work of Coco Chanel, “one of the most revered designers of the twentieth century,” and displayed more than fifty garments and accessories designed by Chanel.<sup>216</sup> In 2011, another iconic artist, Alexander McQueen, was also showcased at The Met.<sup>217</sup> The Met acknowledged McQueen “challenged and expanded the understanding of fashion beyond utility to a conceptual expression of culture, politics, and identity.”<sup>218</sup> Chanel and McQueen are considered two of the most influential designers in fashion history and their fashion houses continue to be popular among the consumer market as well as in the art

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1988).

<sup>210</sup> See *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F.Supp.2d 542, 547 (S.D.N.Y. 2011); see also *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005).

<sup>211</sup> Cohen, *supra* note 35, at 177.

<sup>212</sup> Virginia Postrel, *Fashion as Art*, WALL ST. J., Sept. 11-12, 2010, at W3 (statement of Valerie Steele, Director, Fashion Institute of Technology Museum).

<sup>213</sup> TatianaTheAnonymousModel, *The September Issue Less Than Flattering?*, JEZEBEL (May 28, 2009, 5:40 PM), <http://bit.ly/1SLwo1u> (quoting *The September Issue* (A&E Indie Films 2009)).

<sup>214</sup> Postrel, *supra* note 213, at W3 (statement of Valerie Steele, Director, Fashion Institute of Technology Museum).

<sup>215</sup> Suzy Menkes, *Gone Global: Fashion as Art?*, N.Y. TIMES (July 4, 2011), <http://nyti.ms/1MsjXv7>.

<sup>216</sup> *Chanel*, METRO. MUSEUM ART, <http://bit.ly/1UX1flg> (last visited July 15, 2015).

<sup>217</sup> *Alexander McQueen: Savage Beauty*, METRO. MUSEUM ART, <http://bit.ly/1WoqyIX> (last visited July 15, 2015).

<sup>218</sup> *Id.*

world.<sup>219</sup> In December 2015, The Met hosted an exhibit, “Fashion and Virtue: Textile Patterns and the Print Revolution,” displaying the development of textile patterns and decorations starting from the Renaissance until the 16<sup>th</sup> century.<sup>220</sup> Looking at how the art world and even the courts view fashion, it seems as though there is a growing trend of fashion designs as an artistic work and, therefore, ought to be entitled the same protection rights as their artistic counterparts.

#### B. The AWCPA Should Expand to Include Fashion Designs.

Congress passed the AWCPA to extend copyright protection to architectural designs, another group of works with both utilitarian and artistic elements.<sup>221</sup> The AWCPA protects architectural drawings along with their three-dimensional counterparts.<sup>222</sup> It protects an architectural work during the life of the designer plus 50-years after his or her death.<sup>223</sup> Before the AWCPA, architectural blueprints could be unlawfully copied under the Copyright Act.<sup>224</sup> Furthermore, the Copyright Act made it lawful when a person obtained the blueprints and constructed what these blueprints showed.<sup>225</sup> The 1990 amendment is inconsistent with fashion designs, where the design drawing can be protected, but not the entire garment itself. Congress’ justification to pass the AWCPA was that architecture not only has utilitarian functions but also is aesthetically pleasing.<sup>226</sup> If copyright laws can extend to architectural works, they should also extend to fashion designs. There is a clear inconsistency in regards to protection laws between these two areas of art, which are very similar in theory.<sup>227</sup>

Under the AWCPA, an ‘architectural work’ is defined as “the design of a building as embodied in any tangible medium of expression, including a build-

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<sup>219</sup> Olivia Lidbury, *Can You Guess the Coolest Fashion and Beauty Brands?*, TELEGRAPH (Sept. 28, 2015, 11:47 AM), <http://bit.ly/1WoqGYW>.

<sup>220</sup> *Fashion and Virtue: Textile Patterns and the Print Revolution*, METRO. MUSEUM ART, <http://bit.ly/1SK18T0> (last visited July 15, 2015).

<sup>221</sup> Architectural Works Copyright Protection Act of 1990 §§ 701-706, Pub. L. No. 101-650, 104 Stat. 5133.

<sup>222</sup> Copyright Act § 101.

<sup>223</sup> H.R. REP. No. 101-735, at 24 (1990).

<sup>224</sup> *Id.* at 11.

<sup>225</sup> *Id.* at 19.

<sup>226</sup> Aleksandra M. Spevacek, *Couture Copyright: Copyright Protection Fitting for Fashion Design*, 9 J. MARSHALL REV. INTELL. PROP. L. 602, 610 (2009).

<sup>227</sup> *See, e.g.*, Raustiala & Springman, *supra* note 5, at 1745 (“Indeed, in architecture, a field directly analogous to fashion design, copyright law has already been changed to provide protection where none previously existed.”).

ing, architectural plans, or drawings.”<sup>228</sup> This includes “the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.”<sup>229</sup> In order for a building to be protected under the AWCPA, it must satisfy a two-part test:

First, an architectural work should be examined to determine whether there are original design elements present, including overall shape and interior architecture. If such design elements are present, a second step is reached to examine whether the design elements are functionally required. If the design elements are not functionally required, the work is protectable without regard to physical or conceptual separability.<sup>230</sup>

When drafting this test, Congress wanted to avoid the ‘conceptual separability’ test, which is typically used to determine whether an “artwork or creative design is separable from utilitarian aspects of the work.”<sup>231</sup> Nevertheless, the two-part test outlined in the AWCPA closely resembles the conceptual separability test Congress sought to avoid.<sup>232</sup> At the core of the AWCPA’s two-part test, one would have to prove “the design elements are not functionally required,” which can be interpreted as parallel to separating utility from a creative design in the conceptual separability test.<sup>233</sup> Under the conceptual separability test, if an artwork’s intrinsic function is utilitarian, it will not receive protection.<sup>234</sup> However, if an artwork includes elements that are separate from its utility, these features may receive protection.<sup>235</sup>

In *Galiano v. Harrah’s Operating Co., Inc.*, the Fifth Circuit applied the conceptual separability test to determine whether the fashion design can be separated from its utilitarian purpose.<sup>236</sup> The court used a two-pronged test to determine ‘conceptual sustainability’: (1) “whether the asset for which the creator seeks copyright protection is a ‘useful article’” and (2) “whether the ‘design incorporates [pictorial, graphic, or sculptural] features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’”<sup>237</sup> The test applied by the Fifth Circuit in *Galiano* seems analogous to the two-part test outlined in the legislative history of the AWCPA to determine whether copyright laws may protect a building.<sup>238</sup> If Congress allowed architectural works to receive the protection by essentially

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<sup>228</sup> Copyright Act § 101.

<sup>229</sup> *Id.*

<sup>230</sup> H.R. REP. NO. 101-735, at 20-21.

<sup>231</sup> *Galiano*, 416 F.3d at 416 (holding designs were not copyrightable absent showing they were marketable independently of their utilitarian function as casino uniforms).

<sup>232</sup> H.R. REP. NO. 101-735, at 21.

<sup>233</sup> *Id.*

<sup>234</sup> *Galiano*, 416 F.3d at 416.

<sup>235</sup> *Id.*

<sup>236</sup> *Id.*

<sup>237</sup> *Id.*

<sup>238</sup> H.R. REP. NO. 101-735, at 20-21.

acknowledging architectural designs have both utilitarian and artistic elements, the same logic should be applied to fashion designs.

Similar to fashion designs, architectural works also have elements of separability and originality. First, architectural works function similarly to fashion designs in regards to the separability element.<sup>239</sup> After the Copyright Act was amended to include architectural works, a useful article can receive protection when incorporated features are identified separately from the work and are also capable of existing independently from the utilitarian qualities of the work.<sup>240</sup> Congress ought to apply this exact logic to fashion designs. While an architectural work may be decorative and elaborate, it also has the utilitarian function of providing adequate shelter for safety and security.<sup>241</sup> Comparable to fashion design, a down-filled parka has the utilitarian function of providing warmth during a frigid winter, and can also be uniquely decorative or elaborate.<sup>242</sup>

Congress, as discussed, has attempted to avoid the conceptual separability test used to evaluate works that have artistic and utilitarian elements. The AWCPA does not require the courts to apply the conceptual separability test when evaluating the copyrightability of architectural works.<sup>243</sup> Congress should expand the AWCPA to include fashion design due to the fact that architectural works and fashion designs are analogous in terms of separability.

Second, architectural works and fashion designs share similar features in regards to the originality element. Under the AWCPA, architectural works do not receive protection over an “individual standard feature,” but it covers “the overall form as well as the arrangement and composition of spaces and elements in the design.”<sup>244</sup> The AWCPA should encompass this idea to fashion designs. When designing apparel, each piece may not be considered ‘original’ on its own. The individual elements of a leather jacket including the tassels on the jacket, a metal zipper, the trimmings around jacket made of suede, or the leather itself can be seen as distinctive on their own. Consistent to an architectural work, all buildings are made with doors, like all jeans are made with thread and textiles. It is the combination of materials that makes a building or an article of clothing unique and demonstrates originality by the artist. The

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<sup>239</sup> Spevacek, *supra* note 226, at 614 (“Both fashion and architecture share their mythical and ritualistic qualities as well.”).

<sup>240</sup> Todd Hixon, *The Architectural Works Copyright Act of 1990: At Odds with the Traditional Limitations of American Copyright Law*, 37 ARIZ. L. REV. 629, 642 (1995).

<sup>241</sup> U.S. AREA OFF. OF HABITAT FOR HUMANITY INT’L, A PATTERN BOOK FOR NEIGHBORLY HOUSES: DETAILS AND TECHNIQUES FOR BUILDING AND RENOVATING NEIGHBORLY HOUSES 1 (2007), <http://bit.ly/1UX1DwS>.

<sup>242</sup> Susanna Kim, *Will That \$700 Winter Jacket Keep You Warmer?*, ABCNEWS (Jan. 22, 2014), <http://abcn.ws/1ViP3b1>.

<sup>243</sup> H.R. REP. NO. 101-735, at 20.

<sup>244</sup> Copyright Act § 101.

AWCPA classifies the totality of an architectural work to qualify as “original.”<sup>245</sup> Similarly, if a fashion designer combined ‘unoriginal’ materials to make a unique article of clothing, her designs should be allowed the same protection as a building constructed by the same ‘unoriginal’ materials used to construct many buildings.

### C. Fashion Law Illustrates a Promising Future for Fashion Design Protection.

Simply put, the lack of full protection laws for fashion designers and their designs gravely threatens innovation.<sup>246</sup> In June 2015, Fordham University: School of Law, the Fashion Law Institute, and the Council of Fashion Designers of America announced the world’s first academic degrees in fashion law, sponsored by Diane von Furstenburg and Professor Susan Scafidi.<sup>247</sup> Since the growing trend of more specialized areas of the law, it is not surprising the fashion industry will now have a legal field dedicated to protecting the interests of a trillion-dollar industry. Professor Scafidi, President of the Fashion Law Institute, believes that “while the United States has deliberately denied copyright protection to the fashion industry over the past century, other nations such as France have integrated fashion into their intellectual property systems, which results in ‘more mature and influential design industries.’”<sup>248</sup> Professor Scafidi recognized the need for a fashion law program, stating “fashion companies have in-house counsel, but they aren’t specialized in fashion.”<sup>249</sup> Both Diane von Furstenburg and Professor Scafidi acknowledge the growing problem of knock-off and counterfeiting retailers due to the lack of adequate protection under existing laws.<sup>250</sup>

Congress recognized the lack of protection for the architectural industry after the United States signed on to the Berne Convention, which subsequently

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<sup>245</sup> H.R. REP. NO. 101-735, at 21. The originality standard “does not include requirements of novelty, ingenuity, or [a]esthetic merit.” *Id.*

<sup>246</sup> See, e.g., Chavie Lieber, *Fordham Law Announces First Academic Degree in Fashion Law*, RACKED (June 22, 2015, 12:16 PM) [hereinafter Lieber, *Fashion Law Degree*], <http://bit.ly/1oSfW7C>; Susanna Monseau, *The Challenge of Protecting Industrial Design in a Global Economy*, 20 TEX. INTELL. PROP. L.J. 495, 508 (2012) (“[T]he socio-economic effects of counterfeiting on society are to decrease innovation, employment, foreign direct investment, and trade and economic growth...”); Leslie J. Hagin, *A Comparative Analysis of Copyright Laws Applied to Fashion Works: Renewing the Proposal for Folding Fashion Works into the United States Copyright Regime*, 26 TEX. INT’L L.J. 341, 343 (1991) (“Imitation may well be draining the lifeblood out of the United States apparel industry.”).

<sup>247</sup> Rosemary Feitelberg, *Fordham Sets First Academic Degrees in Fashion Law*, WWD (June 22, 2015), <http://bit.ly/1S1Wgq6>.

<sup>248</sup> *Fashion Design Hearing*, *supra* note 106, at 83 (prepared statement of Susan Scafidi, Visiting Professor, Fordham Law School).

<sup>249</sup> Lieber, *Fashion Law Degree*, *supra* note 247.

<sup>250</sup> *Id.*

led to amendments extending protection to architectural works under the Copyright Act.<sup>251</sup> Although independent designers may not have the financial resources and legal support to make change, fashion houses understand the impact of America's lax intellectual property laws and are continually advocating for stricter laws. The fashion industry cannot compete on a global level without better protection laws for its designers. The lack of protection laws will not only harm a designer's incentive to produce innovative garments, but can also affect the United States' fashion market if designers decide to take their business to another country with stricter laws.

## V. CONCLUSION

The fast-fashion phenomenon poses a grave threat to both independent and highly recognized designers. While established designers may be able survive the monetary hit of design piracy, the malleable career of an emerging designer may never stand a chance. Since Congress failed to pass the IDPA in 2012 and it was not reviewed again in 2013, it appears the United States Government will not become an ally of fashion designers in the near future. In comparison to the intellectual property laws in Europe, the United States seems to be behind in protecting its fashion designers. Nevertheless, the AWCPA illuminates a hopeful future for fashion designers and their artistic creations. Additionally, the recent awareness and education in fashion law will ultimately help independent designers as legal professionals and advocates become more involved in protecting their businesses.

With the growing trend in the fashion industry especially in regards to protecting artistic originalism among designers, it is clear Congress will need to implement stricter protection laws. Emerging independent designers, like Cattaneo and Spinello, are just two designers among many who could potentially file suits after investing their time and money to start their own labels. If independent designers are continually losing battles against knock-off retailers, who can afford legal protection and will not be punished for their actions, their businesses will suffer and there will be no incentive to create new designs. Fashion design students like Wang, who plans to start her own menswear label in the future, only have the option to copyright textiles and patterns, but will not receive protection for the entirety of her designs.<sup>252</sup>

Fashion is a trillion-dollar industry and should have the same protection as its artistic counterparts. Although current laws allow the protection of certain part of an article of clothing, it should extend to the actual apparel itself. The

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<sup>251</sup> Winick, *supra* note 194, at 1612.

<sup>252</sup> E-mail from Julia Wang, *supra* note 32.

United States should apply the same logic after amending the Copyright Act to include architectural works and expand protection to fashion designs. If Gabrielle Chanel walked into a Forever 21 store and discovered dozens of remarkably similar tweed suits mass-manufactured using polyester and priced drastically lower- would her iconic Chanel suit have reached the level of recognition and prestige that it holds today? Would her self-made fashion empire have ever existed? Designers, like Gabrielle Chanel, are the heart of the fashion industry, and if we continue to ignore their hard work and dedication, iconic pieces like Chanel's classic tweed suit may not exist today.