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DESIGN PROTECTION IN THE UNITED STATES AND EUROPEAN UNION: PIRACY'S DETRIMENTAL EFFECTS IN THE DIGITAL WORLD

INTRODUCTION: THE CURRENT STATE OF THE FASHION INDUSTRY

The fashion industry is an international business that reaps profits of more than $750 billion annually.[1] Though the industry produces and markets apparel worldwide, the predominant creative centers are within Europe and the United States.[2] Indeed, in the United States alone, the fashion industry produces profits of more than $350 billion annually[3] and houses the headquarters of several major fashion producers[4] including Marc Jacobs, Vera Wang, and Ralph Lauren.

The fashion industry permeates popular culture both in the United States and throughout the European Union ("EU"). For example, in the United States, the movies *The Devil Wears Prada*[5] and *Confessions of a Shopaholic*[6] grossed $27,537,244[7] and $17,809,053[8] in their opening weekends, respectively. The season six premiere of *Project Runway*[9]—a reality television program that offers talented young designers an opportunity to compete and promote their careers in fashion[10]—attracted a rec-

1. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1693 (2006); *see* Safia A. Nurbhai, Note, *Style Piracy Revisited*, 10 J.L. & POL'Y 489, 489 (2001–2002) (noting "sales of general merchandise and apparel alone were estimated at $784.5 billion [] in 1999").

2. Raustiala & Sprigman, *supra* note 1, at 1693.

3. Megan Williams, Note, *Fashioning a New Idea: How the Design Piracy Prohibition Act is a Reasonable Solution to the Fashion Design Problem*, 10 TUL. J. TECH. & INTELL. PROP. 303, 304 (2007); *see A Bill To Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property*, 109th Cong. 9 (2006) [hereinafter *Hearing on H.R. 5055*] (testimony of Jeffrey Banks, Council of Fashion Designers of America).

4. Raustiala & Sprigman, *supra* note 1, at 1693.

5. THE DEVIL WEARS PRADA (20th Century Fox 2006).

6. CONFESSIONS OF A SHOPAHOLIC (Touchstone Pictures 2009).

7. *The Devil Wears Prada (2006)*, IMDB, http://www.imdb.com/title/tt0458352/ (last visited Mar. 3, 2012).

8. *Confessions of a Shopaholic (2009)*, IMDB, http://www.imdb.com/title/tt1093908 (last visited Mar. 3, 2012).

9. *Project Runway* (Lifetime television broadcast Aug. 20, 2010).

10. *See About "Project Runway" Season 9*, MYLIFETIME, http://www.mylifetime.com/shows/project-runway/season-8/about (last visited Mar. 3, 2012).

ord 4.2 million viewers in the United States.[11] The immense popularity of the show led to the production of several international versions in the United Kingdom ("UK"),[12] the Netherlands,[13] and Norway.[14]

Public awareness of high-end fashion gained through popular movies, magazines, and television stimulates the demand for designer and luxury goods[15] within U.S. and European culture.[16] Although media glamorizes the already illustrious fashion industry, the majority of fashion designers in the United States are self-employed[17] and earn modest wages, somewhere between $42,150 and $87,120 annually.[18] Furthermore, these small-business people face competition from large corporate entities that rapidly replicate their designs with minimal, if any, legal restraint.[19]

Design piracy—the replication of a designer's original patterns or conceptions[20]—is considered "a way of life in the garment business."[21] As the Supreme Court of New York noted in *Samuel Winston, Inc. v. Charles James Services, Inc.*,[22] such piracy is "indulge[d]" in the United

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11. R. Thomas Umstead, *'Project Runway' Sets Lifetime Ratings Record* (Aug. 21, 2009, 6:49 PM), http://www.multichannel.com/article/328207-_Project_Runway_Sets_Lifetime_Ratings_Record.php.

12. *See Project Runway*, SKY1 HD, http://sky1.sky.com/project-runway-2 (last visited Mar. 3, 2012).

13. *See Project Catwalk*, RTL.NL, http://www.rtl.nl/programma/projectcatwalk/home/ (last visited June 8, 2012).

14. *See Designerspirene USA*, TV3, http://www.tv3.no/program/designerspirene-usa-6 (last visited Mar. 3, 2012).

15. Nurbhai, *supra* note 1, at 489.

16. Laura C. Marshall, *Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act*, 14 J. INTELL. PROP. L. 305, 308 (2006–2007) (discussing style piracy).

17. BUREAU OF LABOR STATISTICS, U.S. DEPT. OF LABOR, OCCUPATIONAL OUTLOOK HANDBOOK: FASHION DESIGNERS 2 (2010–2011 ed.) [hereinafter OCCUPATIONAL OUTLOOK HANDBOOK], *available at* http://www.bls.gov/oco/pdf/ocos291.pdf.

18. In May 2008, the "median annual wages for salaried fashion designers were $61,160. The middle 50 percent earned between $42,150 and $87,120. *Id.* at 3. The lowest 10 percent earned less than $32,150, and the highest 10 percent earned more than $124,780." *Id.*

19. Marshall, *supra* note 16, at 308.

20. Nurbhai, *supra* note 1, at 489; *see also* 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, 345 (1991).

21. JEANNETTE A. JARNOW, MIRIAM GUERREIRO & BEATRICE JUDELLE, INSIDE THE FASHION BUSINESS: TEXT AND READINGS 150 (4th ed. 1987) (discussing style piracy). "Within the trade, this practice is know as 'knocking off,'" and some courts refer to it as "style piracy." Hagin, *supra* note 20, at 345.

22. Samuel Winston, Inc. v. Charles James Services, Inc., 159 N.Y.S.2d 716 (Sup. Ct. 1956).

States more "than much lesser offenses involving deprivation of one's rights and property."[23] Design piracy can have detrimental, even career ending, effects on fashion designers, especially young designers who have yet to establish a reputation in the industry and cannot withstand the financial losses resulting from design piracy.[24] In *Filene's Sons Co. v. Fashion Originators' Guild of America*,[25] the Court of Appeals for the First Circuit expressed the perilous effects of piracy on designers and the fashion industry: "[c]opying destroys the style value of dresses which are copied . . . [it] substantially reduces the number and amount of reorders which the original creators get," and "tends to increase the cost of their dresses and the prices at which they must be sold."[26]

To minimize these negative effects, the EU and several European nations, most notably France and the UK, successfully enacted legislation to protect fashion design.[27] In contrast, fashion remains one of the only creative industries in the United States that is not protected by intellectual property laws—a legal shortcoming that copyists routinely exploit.[28] Apart from ornamental features, fashion designs are not eligible for protection under current U.S. intellectual property laws, which encompass copyright protection,[29] trademarks,[30] and patents.[31] However, the federal

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23. *Id.* at 718.

24. *Hearing on H.R. 5055*, *supra* note 3, at 78 (testimony of Susan Scafidi, Professor, Fordham Law School).

25. WM. Filene's Sons Co. v. Fashion Originators' Guild of Am., 90 F.2d 556 (1st Cir. 1937).

26. *Id.* at 558.

27. Williams, *supra* note 3, at 304.

28. *Id.*

29. The Copyright Act of 1976 extends protection to:

> original works of authorship fixed in any tangible mediums of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: (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) sounds recordings; and (8) architectural works.

17 U.S.C. § 102(a) (2006).

30. The Lanham Trademark Act protects against consumer confusion and stipulates that

> (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or

Innovative Design Protection and Piracy Prevention Act ("IDPPPA"), introduced on August 5, 2010 by Senator Charles E. Schumer and ten co-sponsors,[32] not only protects American fashion designers, but also more closely aligns U.S. design law with that of its more progressive European counterparts and ensures that the United States complies with its obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS").

This Note considers the current state of design protection in the United States and its obligation, under international agreements, to enact laws that provide more meaningful protection for fashion designs. Part I examines the practice of design piracy in the fashion industry and its increased effects in the digital world. Part II introduces the provisions of the IDPPPA in relation to its failed predecessor, the Design Piracy Prohibition Act. Specifically, Part II concludes that the United States' obligations under the TRIPS Agreement, as well as international design law, require the United States to adopt the IDPPPA and extend copyright protection to fashion designs.[33] Part III examines divergent interpretations of the TRIPS Agreement and the inadequacy of protection available in the United States under current intellectual property laws. Part IV demonstrates that Member States should interpret the TRIPS Agreement broadly to better achieve its purported goal—to further the harmonization of

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> misleading description of fact, or false or misleading representation of fact, which—
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> > (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person or
> >
> > (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,
>
> shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125 (2006).

31. Design Patents may be obtained by "[w]hoever invents any new, original, and ornamental design for an article of manufacture" subject to certain conditions and requirements. 35 U.S.C. § 171 (2006).

32. Louis S. Ederer & Maxwell Preston, *The Innovative Design Protection and Piracy Prevention Act—Fashion Industry Friend or Faux?*, LEXISNEXIS COMMUNITIES (Aug. 25, 2010), http://www.lexisnexis.com/Community/copyright-trademarklaw/blogs/fashionindustrylaw/archive/2010/08/25/the-innovative-design-protection-and-piracy-prevention-act-fashion-industry-friend-or-faux.aspx.

33. Marshall, *supra* note 16, at 308, 319.

intellectual property laws worldwide.[34] It examines intellectual property regimes in European nations and demonstrates that current American law unreasonably impairs designers' ability to seek and obtain protection for their creative works.

I. DESIGN PIRACY: A HISTORICAL PROBLEM FURTHER COMPLICATED BY THE DIGITAL WORLD

Design piracy is a problem that "has long plagued the fashion field."[35] Following World War I and the concurrent growth of the high-end fashion industry, several "French couture houses tacitly sanctioned" limited design piracy.[36] In *The American Fashion Industry*, Jessie Stuart noted that

> when all fashion originated in Paris and 'just clothes' were made in the United [sic] States, the frank adapting and even copying of French styles was recognized and accepted. French models were bought with the actual or implied privilege of copying, since there were few original American styles.[37]

Although French couture houses seemingly allowed this form of design piracy, the remedial technology used to copy designs limited design pirates' ability to make and market copies quickly[38]—the process could take several weeks or even months.[39] One commentator elaborated on the time-consuming practice of appropriating French designs during the 1950s: "The manufacturers flew in from New York, laid the (couture) clothes out on a table, and measured each seam. They went back to New York to copy the dresses and then [the Chicago-based department store Marshall] Field's bought the copies."[40]

Significant advances in technology throughout the latter part of the twentieth century, namely digital photography and the internet, enabled almost instantaneous design piracy. In many instances, design pirates

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34. *Id.* at 319.

35. JESSIE STUART, THE AMERICAN FASHION INDUSTRY 28 (1951) (discussing style piracy).

36. Raustiala & Sprigman, *supra* note 1, at 1696. French couture houses "permitted a few American producers to attend their Paris runway shows in exchange for 'caution fees' or advance orders of couture gowns." *Id.*; STUART, *supra* note 35, at 28; *see also* TERI AGINS, THE END OF FASHION: THE MASS MARKETING OF THE CLOTHING BUSINESS 23–25 (1999).

37. STUART, *supra* note 35, at 28.

38. Raustiala & Sprigman, *supra* note 1, at 1696.

39. *See* Williams, *supra* note 3, at 306. For a more detailed description of the process of copying Parisian designs see AGINS, *supra* note 36, at 23–25.

40. Raustiala & Sprigman, *supra* note 1, at 1696.

may market and distribute their copies long before the original designer.[41] Design pirates no longer need to resort to secretive methods, such as sneaking sketch artists into fashion shows to sketch designs presented on the runway or rummaging through fashion houses' trash receptacles for discarded sketches to create course patterns of designs.[42] Instead, copyists can simply conceal digital cameras at fashion shows and produce and send digital photographs of designs before the models leave the runway.[43] Jeffrey Banks, a menswear fashion designer and former spokesman for the Council of Fashion Designers of America ("CFDA"), best described the rapid rate at which designs can be pirated, stating:

> In the blink of an eye, perfect 360 degree images of the latest runway fashions can be sent around the world. And of course, they can be copied. . . . [T]here are even software programs that develop patterns from 360 degree photographs taken at the runway shows. From these patterns, automated machines cut and then stitch perfect copies of a designer's work. Within days of the runway shows, the pirates at the factories in China and other countries where labor is cheap are shipping into this country those perfect copies, before the designer can even get his or her line into the retail stores. Since there is no protection in America, innovation launched on the runway—or the red carpet—is stolen in plain sight.[44]

The rapid rate at which designs can be copied and reproduced[45] gives fashion designers little, if any, opportunity to recoup their investments before their designs become unfashionable or, in the case of popular designs, before the market becomes saturated with cheaper copies.[46] A de-

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41. *Hearing on H.R. 5055*, *supra* note 3, at 77 (testimony of Susan Scafidi); *see also* Williams, *supra* note 3, at 304.

42. *See* Nurbhai, *supra* note 1, at 490. *See generally Hearing on H.R. 5055*, *supra* note 3, at 12 (testimony of Jeffrey Banks in which he describes how the internet has changed the way designs are copied and manufactured).

43. *Hearing on H.R. 5055*, *supra* note 3, at 11–12 (testimony of Jeffrey Banks).

44. *Id.*; *see also* Marshall, *supra* note 16, at 310.

45. The acceleration of the copying process as well as the "greatly increased commercial promotion" of styles has also increased the "life of a fashion"—a style's "introduction, acceptance, and decline." STUART, *supra* note 35, at 27. The "life of fashion" typically does not last longer than three months. Rocky Schmidt, Comment, *Designer Law: Fashioning a Remedy for Design Piracy*, 30 UCLA L. REV. 861, 868 (1982).

46. *Hearing on H.R. 5055*, *supra* note 3, at 82 (testimony of Susan Scafidi). Further, design piracy and the dissemination of cheaper copies not only injures designers financially, but may also irreparably harm their reputations because knockoffs are typically made from inferior materials. Lisa J. Hedrick, Note, *Tearing Fashion Design Protection Apart at the Seams*, 65 WASH. & LEE L. REV. 215, 217 (2008).

signer's investment can be significant; the initial design process—from initial sketches to final garment production[47]—typically takes between eighteen and twenty-four months,[48] and many young designers participate in every aspect of production, including pattern making and physical construction of the garment.[49] Moreover the capital required for the production of a new garment line is sizeable; industry professionals suggest that new designers begin with $1 to $5 million, however, many designers begin with considerably less.[50] Tuleh and Gunmetal launched lines in 1998 with initial investments of $225,000 and $300,000, respectively.[51] In contrast to these originators, design pirates can manufacture copies quickly with the aid of technological advances and endure minimal financial risk because they do not partake in the design process.[52] Furthermore, they can select designs based on their initial success or reception in the fashion community and make an enormous profit.[53] For example, in 1996, American fashion designer Narciso Rodriguez created a dress for Carolyn Bessette worn during her marriage ceremony to John F. Kennedy, Jr.[54] Rodriguez estimated that pirates produced an estimated eight million copies of the dress before he was able to market his design.[55] The copies' wide distribution greatly limited Rodriquez's ability

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> The design pirate, on the other hand, manufactures copies of the original designs and avoids the creative costs the original designer incurs. The presence of pirated copies on the market not only severely depreciates the value of the original designs, but also represents wholesale appropriation of the original designer's work without any corresponding compensation.

Schmidt, *supra* note 45, at 863.

47. Marshall, *supra* note 16, at 310.

48. OCCUPATIONAL OUTLOOK HANDBOOK, *supra* note 17, at 1.

49. Marshall, *supra* note 16, at 310.

50. MARY GEHLHAR, THE FASHION DESIGNER SURVIVAL GUIDE: START AND RUN YOUR OWN FASHION BUSINESS 34 (2008).

51. *Id.*

52. *See also Hearing on Design Law—Are Special Provisions Needed to Protect Unique Industries: Hearings Before the Subcomm. on Courts, the Internet and Intellectual Property of the House Comm. on the Judiciary*, 110th Cong. 22 (2008) [hereinafter *Hearing on Design Law*] (testimony of Narciso Rodriguez, Fashion Designer, Council of Fashion Designers of America) ("With no human or capital investments to make, when pirates copy they spend nothing. They can afford to make the copy in such quantities and low price levels that on just one of my 125 styles they could recoup what I might make on my entire collection.").

53. Hagin, *supra* note 20, at 345.

54. *Hearing on Design Law*, *supra* note 52, at 22 (testimony of Narciso Rodriguez).

55. *Id.*; *see also* Emily S. Day, *Double-Edged Scissor: Legal Protection for Fashion Design*, 86 N.C. L. REV. 237, 242 (2007).

to recoup his initial investment;[56] in total, Rodriguez sold a paltry forty dresses.[57] Though Rodriguez admittedly received greater notoriety from the publicity surrounding his design, he emphatically stated, "all the publicity and the knockoffs didn't pay my bills."[58]

Design piracy's effects are not only endured by luxury designers such as Rodriguez, but also extend to designers of less expensive apparel and accessories.[59] Jennifer Baum Lagdameo—a young wife and self-employed designer who cofounded the Ananas handbag label[60]—successfully promoted a handbag design with a retail value between $200 and $400.[61] However, in 2006, a wholesale buyer cancelled his order for Lagdameo's bag and opted instead to buy a less expensive near-perfect copy made from inferior materials.[62] Though Lagdameo continues to design handbags, the loss of wholesale sales has had damaging effects on her small business; she has experienced a loss in income and is less able to develop new works.[63] Because the United States offers fashion designers virtually no protection from design piracy, as discussed below, rampant copying threatens to quash the stylistic ingenuity of American designers, including Rodriguez and Lagdameo, and destroy their competiveness in the domestic as well as international fashion industries.[64]

I. THE PROPOSED INNOVATIVE DESIGN PROTECTION AND PIRACY PREVENTION ACT: PROTECTION AMERICAN FASHIONS DESIGNERS NEED

Since 1914, Congress has considered over seventy bills aimed at extending copyright protection to fashion designs.[65] Congress consistently opposed these bills, citing two main concerns: first, this form of legislation would extend copyright protection to useful articles, and second, it could potentially increase the number of monopolies in the fashion industry.[66]

Like its most recent failed predecessor the Design Piracy Prohibition Act ("DPPA"), introduced in 2007,[67] the IDPPPA would amend Chapter

56. *Hearing on Design Law*, *supra* note 52, at 22 (testimony of Narciso Rodriguez).
57. *Id.*
58. *Id.*
59. Day, *supra* note 55.
60. *Id.*
61. *Hearing on H.R. 5055*, *supra* note 3, at 78 (testimony of Susan Scafidi).
62. *Id.*
63. *Id.*
64. Hagin, *supra* note 20, at 343.
65. Schmidt, *supra* note 45, at 864–65.
66. *Id.* at 866.
67. The Design Piracy Prohibition Act was introduced on April 25, 2007 by Representative Delahunt for himself and three co–sponsors. H.R. 2033, 110th Cong. (2007).

13 of the Copyright Act and extend copyright protection to fashion designs[68] for a short three-year term.[69] Also, like its predecessor, only non-trivial and unique designs that "are the result of a designer's own creative endeavor" would qualify for protection[70]—commonplace designs and utilitarian aspects of a work would be relegated to the public domain.[71] Though similar to its predecessor with respect to term and scope, the IDPPPA contains several significant changes that make it a more viable and effective piece of legislation. Most notably, the IDPPPA is supported not only by the Council of Fashion Designers of America, but also by the American Apparel & Footwear Association ("AAFA"), which had previously opposed the DPPA.[72] These extremely influential organizations represent the creative talent of the industry as well as over seven hundred manufactures and suppliers that effectuate approximately 75 percent of the industry's business.[73] Further, the AAFA was the primary opponent of the DPPA and ardently criticized its lack of explicit guidelines, ill-defined protection standard, and ambiguous infringement standard. This fierce lobbying effort greatly contributed to the bill's failure.[74]

In an effort to create meaningful legislation supported by the industry it aims to foster, Senator Schumer consulted both the CFDA and AAFA and drafted the IDPPPA with the aim to create unambiguous standards and significant exceptions.[75] First, the proposed Act includes a substan-

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The bill proposed to extend copyright protection to fashion designs, including, but not limited to, garments, gloves, underwear, footwear, handbags, belts, and eyeglasses. *Id.* § 2(a)(2)(B); *see also* Williams, *supra* note 3, at 311.

68. If passed the Act would provide protection for "men's, women's, or children's clothing, including undergarments, outerwear, gloves, footwear, and headgear; handbags, purses, wallets, duffel bags, suitcases, tote bags, and belts; and eyeglass frames." S. 3728, 111th Cong. § 2(a)(2)(B) (2010).

69. Susan Scafidi, *IDPPPA: Introducing the Innovative Design Protection and Piracy Prevention Act, a.k.a. Fashion Copyright*, COUNTERFEIT CHIC (Aug. 6, 2010), http://www.counterfeitchic.com/2010/08.

70. S. 3728, 111th Cong. § 2(a)(2)(B)(i) (2010).

71. Scafidi, *supra* note 69; *see also* David Jacoby & Judith S. Roth, *Finally, A Fair Shake for Fashion Design*, LAW360, at 3 (Sept. 10, 2010), *available at* http://www.schiffhardin.com/binary/jacoby-roth-law360-091010.pdf.

72. Cathy Horyn, *Schumer Bill Seeks to Protect Fashion Design*, N.Y. TIMES (Aug. 5, 2010, 10:43 PM), http://runway.blogs.nytimes.com/2010/08/05/schumer-bill-seeks-to-protect-fashion-design/.

73. *Id.*

74. Ederer & Preston, *supra* note 32. The AAFA argued that under the DPPA "the Copyright Office would never be able to handle the flood of applications" and the Act's provisions were so vague that "the courts would spend years trying to define it, rather than enforcing it." *Id.*

75. Scafidi, *supra* note 69.

tially identical standard for infringement;[76] the party claiming infringement must show that the copied fashion article is so similar to a protected design that it is likely to be mistaken for it and that the copy contains only trivial dissimilarities in construction and design.[77] This heightened infringement standard,[78] as well as special pleading standards, will require aggrieved designers to plead with particularity and will considerably decrease the amount of frivolous litigation.[79] Second, the proposed Act parallels design protection laws enacted in the EU because it does not include a registration requirement. Thus, emerging designers need not partake in the time-consuming and cost-prohibitive registration process, which includes submitting an application for registration, a deposit, and an application fee to the Copyright Office,[80] to protect their designs.[81] Rather, financially frustrated designers can pursue infringement claims against copyists who target specific designs without registering every garment design they produce.[82] Finally, the IDPPPA includes a home sewing exception, which allows individuals to copy protected designs so long as the copy is intended for personal, noncommercial use.[83] This exception would effectively negate individuals' infringement concerns when producing their own clothing.[84] Additionally, as discussed in Part V, the IDPPPA may more closely align domestic and international intellectual property law with respect to fashion design rights and ostensibly ensure that the United States is in compliance with its international agreements.[85]

However, the proposed Act is not without its shortcomings, and several critics, most notably Staci Riordan, an attorney who specializes in fashion law and former chief operating officer of apparel companies,[86]

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76. Ederer & Preston, *supra* note 32.

77. Jacoby & Roth, *supra* note 71.

78. The substantially identical infringement standard is more stringent than the substantially similar infringement standard proposed under the DPPA. *Id.*

79. Scafidi, *supra* note 69.

80. 17 U.S.C. § 408 (2006).

81. Jacoby & Roth, *supra* note 71.

82. *Id.*

83. Ederer & Preston, *supra* note 32.

84. Scafidi, *supra* note 69.

85. Commenting on the proposed Act, Professor Susan Scafidi enthusiastically stated that it "brings the U.S. in line with IP law in other fashion design-producing countries." *Id.*

86. Staci Riordan, *Breaking News: New Design Piracy Bill Introduced into Senate*, FASHION LAW BLOG (Aug. 6, 2010), http://fashionlaw.foxrothschild.com/2010/08/articles/design-piracy-prohibition-act/breaking-news-new-design-piracy-bill-introduced-into-senate/.

have argued that judges are ill-qualified to determine whether a design is "unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles."[87] Moreover, critics contend that there is currently no adequate method of verifying whether a design is new and unique because there is no public database to conduct a search of previous designs.[88] Though these criticisms are well founded, the IDPPPA does not preclude the creation of a public database to conduct searches of previous designs and, without such legislation in place, there has never been a need for one. Further, judges have consistently determined whether an article is "new" and "original" when issuing design patents;[89] it is thus premature to declare that judges cannot create standards and rules applicable to the fashion industry.

II. THE TRIPS AGREEMENT AND THE IDPPPA: HARMONIZATION OF INTELLECTUAL PROPERTY RIGHTS[90]

The Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS")[91] is thus far "the most far-reaching and comprehensive legal regime ever concluded at the multilateral level in the area of intellectual property rights."[92] In 1994, the United States, as well as other members of the World Trade Organization,[93] signed the TRIPS Agree-

87. S. 3728, 111th Cong. § 2(a)(2)(B)(ii) (2010).

88. Riordan, *supra* note 86.

89. For instance, federal courts have determined whether design elements are inherent in prior art and thus not an appropriate subject for patent protection. Atlas Powder Co. v. Ireco, Inc., 190 F.3d 1342 (Fed. Cir. 1999) (holding the patent invalid because it would preclude the practice of a prior art).

90. Marshall, *supra* note 16, at 319.

91. The TRIPS agreement was negotiated during the Uruguay Round of talks of the General Agreement on Tariffs and Trade in 1986. DONALD G. RICHARDS, INTELLECTUAL PROPERTY RIGHTS AND GLOBAL CAPITALISM: THE POLITICAL ECONOMY OF THE TRIPS AGREEMENT 3 (2004). According to the World Trade Organization, the Uruguay Round negotiations prompted "the biggest reform of the world's trading system" since the creation of the General Agreement on Tariffs and Trade. *The Uruguay Round*, WORLD TRADE ORG. [WTO], http://www.wto.org/english/thewto_e/whatis_e/tif_e/fact5_e.htm (last visited Apr. 23, 2012). In all, 123 countries participated in the largest trade negotiation to ever take place. *Id.*

92. Carlos M. Correa & Abdulqawi A. Yusuf, *Introduction* to INTELLECTUAL PROPERTY AND INTERNATIONAL TRADE: THE TRIPS AGREEMENT, at xvii, xvii (Carlos M. Correa & Abdulqawi A. Yusuf eds., 1998).

93. The World Trade Organizations, established in 1995, is an "international organization whose primary purpose is to open trade for the benefit of all." *About the WTO*, WTO, http://www.wto.org/english/thewto_e/whatis_e/wto_dg_stat_e.htm (last visited June 8, 2012). The WTO provides "a forum for negotiating agreements aimed at reducing obstacles to international trade," "[administers and monitors] the application of the

ment in an effort to "harmonize international intellectual property rights."[94] To accomplish this harmonization, the TRIPS Agreement prescribes a minimum level of intellectual property protection each Member State must provide and creates international rules for compliance and enforcement.[95] Each Member State must comply with the minimum requirements of protection, however, they may, at their discretion, prescribe more extensive and comprehensive protection.[96] Further, Member States may determine the appropriate methods of implementing the TRIPS Agreement within their domestic legal systems.[97]

The scope of the TRIPS Agreement is incredibly broad—it covers almost all trade-related subjects, including banking, telecommunications, and AIDS treatments.[98] Article 25(2) focuses on the protection of textile designs and accounts for their short viability, typically no longer than three months, and the vast number of new designs introduced to the market each year;[99] it states:

> 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.[100]

This provision, and the amount of protection it affords to textile designs, has been interpreted both narrowly and broadly.[101] A narrow interpretation of this provision suggests that nominal, low-cost protection for

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WTO's agreed rules for trade in goods, trade in services, and trade-related intellectual property rights," and "[settles] disputes among . . . members regarding the interpretation and application of the agreements." *Id.* The WTO currently has 153 members, including the United States, the United Kingdom, France, Italy, and Spain. *Members and Observers*, WTO, http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm (last visited Mar. 3, 2012).

94. Marshall, *supra* note 16, at 320.

95. *Id.*

96. *Overview: the TRIPS Agreement*, WTO, http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (last visited Mar. 3, 2012).

97. *Id.*

98. *The Uruguay Round*, *supra* note 91.

99. M. BHASKARA RAO & MANJULA GURU, UNDERSTANDING TRIPS: MANAGING KNOWLEDGE IN DEVELOPING COUNTRIES 139 (2003).

100. Agreement on Trade-Related Aspects of Intellectual Property Rights, Marrakesh Agreement Establishing the World Trade Organization, arts. 25, 33, Annex 1C, Apr. 15, 1994, 869 U.N.T.S. 299.

101. Marshall, *supra* note 16, at 319; *see also* Anne Theodore Briggs, *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, 24 HASTINGS COMM. & ENT. L.J. 169, 209 (2001–2002).

fashion designs[102] through either industrial design law or copyright law is necessary.[103] Accepting this interpretation, the United States arguably meets its obligations under the TRIPS Agreement because it extends limited design protection for textiles through design patents, copyrights, and trademarks;[104] most notably, U.S. courts have held that designers can receive protection for ornamental elements of their works through design patents[105] and for artistic features that are separable from the overall appearance of a garment through copyrights.[106] Additionally, the current American design protection regime is consistent with one of the TRIPS Agreement's main goals—the reduction of trade barriers.[107] U.S. intellectual property law affords American and foreign designers the same limited protection for their creative works irrespective of their origin.[108]

However, if Article 25(2) is interpreted broadly as mandating protection for fashion designs comparable to other forms of intellectual property, the United States is in gross breach of its duties.[109] Fashion designers rarely, if ever, find effective protection for their creative efforts under current U.S. intellectual property law—specifically, designers have sought and failed to receive meaningful protection for all aspects of their innovative works under patent, trademark, and copyright law.[110]

Patent protection for fashion designs is often impracticable and—more often than not—impossible to attain.[111] Design patents extend a fourteen-year term of protection[112] to "new, original, and ornamental design[s] for an article of manufacture."[113] To qualify for design patent protection articles of manufacture must meet rigorous standards of innovation; they must not only be new and original, but also novel and nonobvious.[114] These qualifications were best articulated by the Court of Appeals for the

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102. Briggs, *supra* note 101, at 209.
103. RAO & GURU, *supra* note 99, at 139.
104. Briggs, *supra* note 101, at 209; *see also* Marshall, *supra* note 16, at 320.
105. *See* Schmidt, *supra* note 45, at 867.
106. *See* Williams, *supra* note 3, at 307.
107. Briggs, *supra* note 101, at 209.
108. *Id.*
109. *Id.*
110. Hedrick, *supra* note 46, at 217. For a discussion of other bodies of law, including the doctrines of unfair competition and misappropriation, conversion, and trade restrictions, and their failed application to design piracy cases, see Schmidt, *supra* note 45, at 869–72. For a discussion of trade dress in relation to fashion designs see Raustiala & Sprigman, *supra* note 1, at 1702–04 and Williams, *supra* note 3, at 307–08.
111. *See* Raustiala & Sprigman, *supra* note 1, at 1704–05; Nurbhai, *supra* note 1, at 502–03; Schmidt, *supra* note 45, at 867–68; Williams, *supra* note 3, at 308–09.
112. 35 U.S.C. § 173 (2006).
113. *Id.* § 171.
114. Schmidt, *supra* note 45, at 867.

Second Circuit in *Gold Seal Importers, Inc. v. Morris White Fashions, Inc.*,[115] in which the Court stated that

> it is not enough for patentability to show that a design is novel, ornamental and pleasing in appearance . . . it must be the product of invention; that is, the conception of the design must require some exceptional talent beyond the range of the ordinary designer familiar with the prior art.[116]

Theoretically, fashion designers can apply for design patents and receive protection for their creative works, however, designers often find these requirements insurmountable obstacles.[117] Specifically, many, if not all, fashion designs are reworkings of or references to previously existing garments.[118] As such, most designs cannot meet the high standards for originality required for patent protection.[119] Furthermore, design patents fail to provide practicable protection for fashion designs because the patent application process is time consuming—the average length of time between filing an application and receiving final approval or disapproval from the United States Patent and Trademark Office ("USPTO") is approximately two years.[120] This lengthy waiting period, coupled with the expense of preparing an application, discourages many designers from seeking patent protection.[121] Moreover, designs have a relatively short life span and may become unfashionable within a single season; consequently, a fashion work may completely lose its commercial value by the time the USPTO grants a design patent.[122] Appreciating the high originality standard and the length and expense of the application process, design patents are an ineffective means of fashion design protection.

Trademarks are also ill suited to protect creative fashion works from design piracy.[123] Trademarks protect fashion designers from the unau-

115. Gold Seal Imp. v. Morris White Fashions, 124 F.2d 141, 141 (2d Cir. 1941).

116. *Id.* at 142 (internal quotation marks omitted) (denying design patent protection for a handbag design).

117. Williams, *supra* note 3, at 308; *see also* Raustiala & Sprigman, *supra* note 1, at 1704 (noting that the average waiting period for patent application approval or disapproval is "more than eighteen months, on average").

118. Williams, *supra* note 3, at 308.

119. *Id.*

120. *Id.*

121. Schmidt, *supra* note 45, at 868.

122. Nurbhai, *supra* note 1, at 502; *see also* Raustiala & Sprigman, *supra* note 1, at 1705 (noting that patent protection is ill-suited for fashion designs given their short shelf-lifes).

123. *See* Raustiala & Sprigman, *supra* note 1, at 1700–04; Schmidt, *supra* note 45, at 868–69; Williams, *supra* note 3, at 307–08.

thorized use of their marks—"any word, term, name, symbol, or device, or any combination thereof"[124]—to distinguish apparel and prevent consumer confusion.[125] Thus, trademark protects fashion designers from counterfeiters—individuals who create original apparel and accessories, but represent these works as those of well-known designers by attaching their trademarks.[126] Design pirates, however, do not represent their apparel as that of the original designer. Instead, pirates simply copy designs and represent them as their own or promote them as manufactured by themselves but designed by a well-known designer.[127] Trademark law protects against the unauthorized use of a designer's mark,[128] not the underlying garment design.[129] Subsequently, trademark law only affords designers adequate protection against counterfeiters[130]—it does not prevent the vast majority of design pirates from deliberately and openly appropriating design elements of an original fashion work[131] and reaping the benefits of another's creative endeavors.

Finally, copyright law does not effectively protect fashion designs from piracy because it denies protection to "useful articles" defined as "having an intrinsic utilitarian function that is not merely to portray the appearance of the article."[132] Apparel serves an undeniably utilitarian purpose, that is to cover an individual's body and to protect him or her from the elements.[133] It is therefore likened to furniture and lighting fixtures under the current copyright regime and receives protection only to the extent that artistic features are separable.[134] This exiguous exception to the useful article doctrine affords minimal copyright protection for portions of fashion designs, including appliqués, embellishments, fabric patterns, and lace patterns,[135] but does not extend protection to the over-

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124. 15 U.S.C. § 1125 (2006).

125. Williams, *supra* note 3, at 307.

126. Schmidt, *supra* note 45, at 868; *see also* Williams, *supra* note 3, at 307.

127. Schmidt, *supra* note 45, at 868.

128. In some instances, most notably Burberry's trademarked plaid incorporated into the design of scarves and apparel and Louis Vuitton's "LV" mark on handbags, a fashion design "will visibly integrate a trademark to an extent that the mark becomes an element of the design . . . [f]or these goods, the logo is part of the design, and thus trademark provides significant protection against design copying." Raustiala & Sprigman, *supra* note 1, at 1701.

129. Williams, *supra* note 3, at 307.

130. Schmidt, *supra* note 45, at 869.

131. Raustiala & Sprigman, *supra* note 1, at 1701.

132. 17 U.S.C. § 101 (2006).

133. Celebration Int'l, Inc. v. Chosun Int'l, Inc., 234 F. Supp. 2d 905, 912 (S.D. Ind. 2002); *see also* Day, *supra* note 55, at 246.

134. Williams, *supra* note 3, at 309.

135. Briggs, *supra* note 101, at 191.

all design of a garment. For example, courts have extended copyright protection to costume hoods[136] and ornamented surfaces of belt buckles,[137] but not to an entire garment. Thus, copyists can create a fabric pattern or motif that is extremely similar to an original design and produce a near-perfect copy without impunity.[138]

Though the separability doctrine provides a modicum of protection for portions of designs, most artistic features are inseparable from the overall design of the garment; "the expressive elements in most garments are not 'bolted on' . . . but are instilled in the form of the garment itself—in the 'cut' of a sleeve, the shape of a pant leg, and the myriad design variations that give rise to the variety of fashions for both men and women."[139] The inseparable nature of these artistic elements from the functionality removes most fashion products from the realm of protection created by current copyright law.[140] Because American intellectual property laws only provide protection for portions of fashion designs and not the designs themselves, the United States fails to fulfill its obligations under the TRIPS Agreement and stifles the harmonization of international intellectual property rights.

III. A BROAD INTERPRETATION OF ARTICLE 25(2) OF THE TRIPS AGREEMENT: PROTECTIONIST TENDENCIES ABROAD AND BENEFITS TO THE FASHION INDUSTRY

A broad interpretation of Article 25(2) of the TRIPS Agreement that requires protection for fashion designs equivalent to other forms of intellectual property would further the harmonization of intellectual property rights by compelling the United States to more closely align its design law with that of its protectionist counterparts abroad. Specifically, a broad interpretation would reduce the differences in national criteria, imposed at the discretion of Member States, for determining design rights and ensuring that designs are afforded similar protection internationally. Subsequently, designs legally created or copied under the laws

136. *Celebration Int'l*, 234 F. Supp. 2d at 914 (holding that the hood of a tiger costume was separable from the clothing garment because it "was in no way required by the clothing garment aspect of the costume;" specifically, the hood of the costume depicting a tiger's head "could easily be removed from the hood, and the remaining garment's utility would be unaltered").

137. Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) (holding that the ornamented surfaces of belt buckles were conceptually separable because the "buckles rise to the level of creative art").

138. Briggs, *supra* note 101, at 192.

139. Raustiala & Sprigman, *supra* note 1, at 1700.

140. *Id.*

of one Member State, if exported, would be less likely to infringe the laws of another Member State.[141]

Several Member States of the TRIPS Agreements that boast strong fashion industries comparable to the United States have well-established fashion design protection laws, most notably France and the UK.[142] France, the recognized "epicenter of the fashion industry"[143] and originator of haute couture,[144] has afforded fashion designs protection since 1793.[145] Together, the amended Copyright Act of 1793 and Industrial Design Law of 1806 provide perhaps the most liberal copyright protection to fashion designs under the doctrine of the unitary art, which provides that copyright protection cannot be withheld based solely on the fact that the work serves a utilitarian function.[146] Unlike in the UK and elsewhere in the European community, French copyright law does not explicitly require a showing of originality for a design to gain protection;[147] rather, it provides protection at the moment the design draws significant attention from or becomes popular with the general public.[148]

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141. RAO & GURU, *supra* note 99, at 140.

142. 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, 166 (2008); *see also* Hagin, *supra* note 20, at 370–74.

143. Hagin, *supra* note 20, at 374.

144. Day, *supra* note 55, at 266.

> In France, haute couture confers legal permission to use the label only on those designers designated as such by the Chambre de commerce et d'industrie de Paris . . . recently the term has been loosely used to also include specific fashion that are custom created for an individual customer with high quality fabrics, using extensive hand construction and a seemingly excessive cost.

Id. at 266 n.179.

145. Borukhovich, *supra* note 142, at 167. The original Copyright Act of 1793 provided protection for fashion designs as an applied art. The French government has since extended additional protection, namely protection of nonfunctional designs and patterns, through this Act as amended in 1902 and the 1806 Industrial Design Law amended in 1909. Hagin, *supra* note 20, at 374; Anya Jenkins Ferris, Note, *Real Art Calls for Real Legislation: An Argument Against Adoption of the Design Piracy Prohibition Act*, 26 CARDOZO ARTS & ENT. L.J. 559, 573–74 (2008).

146. Borukhovich, *supra* note 142, at 167–68; *see also* Day, *supra* note 55, at 266.

147. Ferris, *supra* note 145, at 573; *see also* Day, *supra* note 55, at 266. Leslie J. Hagin stated that "originality is at least implicitly required under the French system." Hagin, *supra* note 20, at 374. Accordingly, "French courts determine originality on an ad hoc basis, looking to any works which may have inspired the design at issue." *Id.*

148. Day, *supra* note 55, at 266.

Further, French copyright-holders gain patrimonial[149] and moral[150] rights the moment they create a new article.[151] These unique features of French copyright law create unparalleled intellectual property protection for fashion designs[152] that lasts for an unspecified period of time—the duration of protection is determined on a case-by-case basis and typically lasts between eighteen months and two years.[153] Because of these well-established laws, French designers have been able to protect and develop their creative works throughout their careers; they have been able to use their protected designs as a form of branding for their fashion houses and have gained widespread recognition and acclaim.[154] This in turn has fostered the continued development and growth of the already mature French fashion industry.[155] Further, the French government imposes severe criminal penalties—fines in excess of €300,000 and imprisonment—for infringement of protected designs.[156] These penalties serve to deter the production of pirated fashion articles.

The UK, another country internationally recognized for its prosperous fashion industry, also provides protection for fashion designs albeit less extensive than that offered by France.[157] In the UK, fashion design protection is provided for by the 1988 Copyright, Designs and Patents Act of 1988 and the 2002 Community Design Regulation.[158] Specifically, these acts provide unregistered design rights,[159] registered design rights,[160] and copyright in artistic works.[161] This regime extends stronger

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149. Patrimonial rights consist of "the exclusive rights to represent, reproduce, sell or otherwise exploit the copyrighted work of art and to derive a financial compensation therefrom." Marshall, *supra* note 16, at 319.

150. A moral right "is essentially the right for the author to see both his name and his work of art respected;" this nonexpiring right is "granted exclusively to an author or artist and, at his death, to his heirs" and may not be transferred or sold. Marshall, *supra* note 16, at 319; Borukhovich, *supra* note 142, at 168.

151. Marshall, *supra* note 16, at 319; Ferris, *supra* note 145, at 574.

152. Day, *supra* note 55, at 266.

153. Ferris, *supra* note 145, at 574.

154. *Hearing on H.R. 5055*, *supra* note 3, at 83–84 (testimony of Susan Scafidi).

155. *Id.*

156. Marshall, *supra* note 16, at 319.

157. *See* Day, *supra* note 55, at 267; Hagin, *supra* note 20, at 370–73; Marshall, *supra* note 16, at 318; Borukhovich, *supra* note 142, at 168–69; Ferris, *supra* note 145, at 571–73.

158. Marshall, *supra* note 16, at 318.

159. An unregistered design right protects "any aspect of the shape or configuration of an article" of an original design, but "does not extend [to protect] surface decoration." Ferris, *supra* note 145, at 572.

160. A registered design right protects new designs that exhibit an individual character. *Id.*

legislative protection for registered designs than it does for unregistered designs and stipulates that a garment must relate back to a copyrighted drawing to receive copyright protection.[162] Registered designs can potentially receive protection for up to twenty-five years, whereas unregistered designs receive protection for a maximum of fifteen years.[163] Though less protective than their French counterparts, the design laws in the UK have encouraged the development of the domestic fashion industry by allowing designers to protect their signature garments and establish their careers.

In addition to the fashion design protection afforded by national laws in the UK and France, the 1998 European Directive on the Legal Protection of Designs ("Directive") obliges members of the EU to harmonize their domestic laws concerning industrial designs, including apparel designs, and to enact design protection laws.[164] The Directive prescribes minimal requirements for design protection and extends protection to "lines, contours, colours, shape, texture and/or materials"[165] of designs that are registered, display elements of novelty, and possess an individual character.[166] An ascertained design right grants the original designer the exclusive right to use his or her design and to prevent others from using it without consent.[167] Thus, the Directive prohibits the deliberate copying of another's designs and the creation of designs that are sufficiently similar to garments already in existence;[168] it extends protection for five-year periods, up to twenty-five years.[169] The Directive, in conjunction with national laws which may go beyond the minimal requirements set out in the Directive, prescribes effective mechanisms to reduce the market in

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161. *See* Day, *supra* note 55, at 267; Marshall, *supra* note 16, at 318.

162. Day, *supra* note 55, at 267.

163. An unregistered design right expires

> (a) fifteen years from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, whichever first occurred, or
>
> (b) if articles made to the design are made available for sale or hire within five years from the end of that calendar year, ten years from the end of the calendar year in which that first occurred.

Copyright, Designs, and Patents Act, 1988, c. 48, § 216(1) (Eng.).

164. Raustiala & Sprigman, *supra* note 1, at 1735; *see also* Day, *supra* note 55, at 266–68.

165. Council Directive 98/71, 1998 O.J. (L 289) 28 (EC).

166. Day, *supra* note 55, at 267.

167. Council Directive 98/71, *supra* note 165.

168. Day, *supra* note 55, at 267.

169. Council Directive 98/71, *supra* note 165.

pirated fashion articles in the European community and affords appropriate redress for designers whose creative works have been exploited by copyists. Moreover, these laws further the development of an already established and influential fashion industry by protecting creativity and innovation and by ensuring that designers reap the benefits of their labor.[170]

Like France, the UK, and members of the EU,[171] other countries that are not recognized for their thriving fashion industries, such as India,[172] provide intellectual property protection for fashion designs.[173] Nevertheless, the protection afforded to fashion designs by these countries is irrelevant once designers export their garments to the United States.[174] Indeed, the United States is one of the few countries with a significant intellectual property system that does not extend protection to fashion designs.[175] The United States' unwillingness to extend protection, specifically to functional articles, may be attributed to its view that fashion is not art.[176] Historically, in the United States and abroad, garment designers were considered artistically inferior to painters, sculptors, and architects because of the intimate relationship between the garments and their wearers.[177] The inferior status of fashion designers in Europe steadily improved, however, with the rise of couture fashion houses in France and

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170. *Hearing on H.R. 5055*, *supra* note 3, at 84 (testimony of Susan Scafidi).

171. Italy and Spain also boast well-established protection for fashion designs. For greater discussion of the national laws of Italy and Spain, see Day, *supra* note 55, at 267 and Marshall, *supra* note 16, at 317–18, respectively.

172. India's 2000 Design Act provides property rights in fashion designs and protection against infringement. Under Chapter 1 Section 2(d) (5) of the Act "design" means

> only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article . . . by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device.

The Designs Act, No. 16 of 2000, INDIA CODE (2000), *available at* http://india.gov.in/outerwin.php?id=http://indiacode.nic.in/rspaging.asp?tfnm=200016. "Where a Design or pattern covers the whole body of goods or is part and parcel of the goods themselves, it falls within the aforementioned definition." RAO & GURU, *supra* note 99, at 141–42.

173. Borukhovich, *supra* note 142, at 167.

174. *Id.* at 170.

175. *Id.*

176. Briggs, *supra* note 101, at 187–90.

177. *Id.* at 187.

the dominance of the Arts and Crafts movement[178] in the UK during the latter half of the nineteenth century. In response to these artistic trends and the public's perception, France and the UK altered their intellectual property laws to include artistic functional articles.[179] In contrast, the United States' view that fashion is purely functional has not evolved significantly and the law's lack of protection for useful articles reflects as much.[180]

The United States' unwillingness to extend protection, and its view that fashion is purely functional, negatively affects domestic and international fashion designers because their garments, when marketed in or exported to the United States, become easy prey for pernicious design pirates who face minimal repercussions. Further, designers are susceptible to piracy even if they do not explicitly market or export their garments; so long as an image of their work is available on the internet, American design pirates can easily produce substantially similar, if not identical, copies. Because the United States refuses to extend design protection, it not only discourages, but also impedes the purported goal of the TRIPS Agreement—to further the harmonization of international intellectual property rights.[181] The United States current intellectual property law does not secure adequate protection for the overall design of a fashion article as stipulated in Article 25(2) of the TRIPS Agreement; rather, it secures protection only for particular elements that are separable, including appliqués and embellishments.[182] Ultimately, the United States' reluctance to extend meaningful intellectual property protection to overall fashion designs, not only limited separable elements, unnecessarily impairs designers' opportunities to seek and obtain protection for their creative works. The current legal scheme forces international designers to either export their garments to the United States with knowledge that pirates may reproduce their successful designs without legal restraint or refrain from exporting and marketing their goods, thereby, losing attendant profits. Furthermore, U.S. law allows copyists to promote the sale of pirated designs; it allows copyists to reference the

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178. The Arts and Crafts movement "developed during the last decades of the 19th century, [and] was shaped by the ideas of art critic and writer John Ruskin and William Morris." FRED S. KLEINER & CHRISTIAN J. MAMIYA, GARDNER'S ART THROUGH THE AGES: THE WESTERN PERSPECTIVE 725 (12th ed. 2006). "Members of the Arts and Crafts movement dedicated themselves to producing functional objects with high aesthetic value for a wide public." *Id.*

179. Briggs, *supra* note 101, at 187–88.

180. *Id.*

181. *See* Borukhovich, *supra* note 142, at 170–71.

182. Briggs, *supra* note 101, at 191.

original designer's name in marketing materials and advertisements.[183] This dilemma, more than stifling designers worldwide and promoting a market in pirated goods, demonstrates that the United States is in gross breach of its duties under the TRIPS Agreement regardless of its broad or narrow interpretation.

If the United States does not extend protection to fashion designs and continues to provide a safe haven for copyists,[184] it may be subject to trade sanctions under the TRIPS Agreement. Member States may bring dispute settlement actions before the World Trade Organization's Dispute Settlement Body[185] if they believe another Member State is not performing its obligations satisfactorily.[186] The Dispute Settlement Body assembles an *ad hoc* panel that hears the complaint and adjudicates the matter; either party may appeal a decision to the standing Appellate Body.[187] Once the adjudication is final, the losing Member State must comply with the decision by revising its laws in accordance with the TRIPS Agreement.[188] If a Member States does not comply, the Dispute Settlement Board may authorize retaliation and trade sanctions.[189] Though no Member State has brought an action against the United States thus far, if the United States continues to deny meaningful intellectual property protection to fashion designs it may be susceptible to this form

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183. Nurbhai, *supra* note 1, at 515.

184. *Hearing on H.R. 5055*, *supra* note 3, at 77 (testimony of Susan Scafidi).

185. The Dispute Settlement Body "is composed of representatives of all WTO Members" and is responsible "for overseeing the entire dispute settlement process;" it has the authority "to establish panes, adopt panel and Appellate body reports, maintain surveillance of implementation of rules and recommendations and authorize the suspension of obligations under the covered agreements." *WTO Bodies Involved in the Dispute Settlement Process*, WTO, http://www.wto.org/english/tratop_e/dispu_e/disp_settlement_cbt_e/c3s1p1_e.htm (last visited Mar. 3, 2012).

186. *Settling Disputes*, WTO, http://www.wto.int/english/thewto_e/whatis_e/tif_e/disp1_e.htm (last visited Mar. 3, 2012).

187. The Appellate Body, established in 1995, "is a standing body of seven persons that hears appeals from reports issued by panels in disputes brought by the WTO Members," it "can uphold, modify or reverse the legal findings and conclusions of a panel, and Appellate Body Reports, once adopted by the Dispute Settlement Body (DSB), must be accepted by the parties to the dispute." *Appellate Body*, WTO, http://www.wto.org/english/tratop_e/dispu_e/appellate_body_e.htm (last visited Mar. 3, 2012). Members of the Appellate Body must have a "recognized standing in the field of law and international trade" and cannot be "affiliated with any government." *Settling Disputes*, *supra* note 186.

188. *Settling Disputes*, *supra* note 186.

189. *Id.*

of legal action, especially considering the advances in design copying technology.

CONCLUSION

The proposed IDPPPA would effectively extend American copyright protection to fashion designs and further the interests of both consumers and designers; it would not only allow fashion designers to compete more effectively in the international market, but would also better serve the purpose of copyright law—to secure "[t]he general benefits derived by the public from the labors of authors."[190] Indeed, the extension of American copyright protection would stimulate American innovation and simultaneously nullify designers' legitimate fear that pirates will replicate their successful designs without consequence.[191] Moreover, it would ensure that domestic and international designers are adequately recognized for their artistic endeavors and receive the rewards of their labors from the thriving fashion market in the United States. Though critics of fashion design protection, most notably Professors Kal Raustiala and Christopher Sprigman, argue that design piracy has contributed to the growth and creativity of the fashion industry and made fashion more affordable for the masses, American and international designers deserve, and have fought for, the same amount of protection afforded to artists in similar industries.[192] Furthermore, the extension of copyright protection through the IDPPPA would ensure that the United States does not breach its duties under the TRIPS Agreement, whether interpreted narrowly or broadly; it would create protection for fashion designs similar to other forms of intellectual property.

Katelyn Brandes[*]

190. Fox Film Corp. v. Doyal, 286 U.S. 123, 127, 52 S. Ct. 546, 546 (1932).

191. *See generally Hearing on H.R. 5055*, *supra* note 3 (testimony of Susan Scafidi).

192. *See* Kal Raustiala & Christopher Sprigman, *Why Imitation is the Sincerest Form of Fashion*, N.Y. TIMES, Aug. 13, 2010, at A23; Raustiala & Sprigman, *supra* note 1, at 1687–1777.

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