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Knock it Off, Forever 21! The Fashion Industry's Battle Against Design Piracy

Irene Tan

KNOCK IT OFF, FOREVER 21! THE FASHION INDUSTRY'S BATTLE AGAINST DESIGN PIRACY

*Irene Tan**

INTRODUCTION

For the Presidential Inauguration Ball, First Lady Michelle Obama wore a stunning ivory-colored one-shoulder chiffon gown adorned with Swarovski crystals.[1] An emerging young designer, Jason Wu, created the dress as a one-of-a-kind piece for Mrs. Obama with no intention of reproducing versions of it for sale.[2] Nonetheless, in a matter of days, fast-fashion retailers[3] were selling copies of the dress online.[4] This phenomenon is

* J.D. Candidate, Brooklyn Law School, 2011; B.S., Cornell University, 2006. The author wishes to thank her parents Ni Ju Chun and Jeng Tan, her sister Miranda, her brother Daniel, and her nephew Isaac, for their constant love and support. The author also thanks her faculty advisor, Professor Susan Scafidi, and the members of the *Journal of Law and Policy* for their help and assistance.

[1] Cheryl Lu-Lien Tan, *Jason Wu's "Dream-Like" Vision for Michelle Obam*a, WALL ST. J., Jan. 21, 2009, http://blogs.wsj.com/runway/2009/01/21/jason-wus-dream-like-vision-for-michelle-obama.

[2] *Id*.

[3] This Article uses fast-fashion retailers to describe retail chains like Forever 21, H&M, and Zara, which are able to provide recent fashion trends on an expedited schedule and at discounted prices. *See* discussion *infra* Part I and III.

[4] Gina Salamone, *Fashion's Copycats are Having a Ball Knocking Off Michelle Obama's Gown*, N.Y. DAILY NEWS, Jan. 21, 2009, http://www.nydailynews.com/lifestyle/fashion/2009/01/22/2009-01-22_fashions_copycats_are_having_a_ball_knoc.html. Fast-fashion retailer, Faviana, began recreating the dress within hours of its debut on national television. *Id*. Two days after President Obama's inauguration ceremony, EdressMe was selling copies of

known as design piracy or "knocking off"[5] and is "standard operating procedure for many [companies] both large and small."[6] The "blatant copying of another's designs is akin to counterfeiting without affixing the fake designer label."[7] While counterfeiting is illegal, design piracy is an unregulated phenomenon that is rampant in the fashion industry.[8] Intuitively, it may seem unfair that fashion copycats can "knock off" a designer's work when they have not expended the time, energy, and financial investment required to create it;[9] however, as of now, the practice of design piracy is entirely legal in the United States.[10]

While other countries protect fashion designs,[11] the United

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Wu's dress online. Olivia Barker, *Obama Fashion Stimulus Plan is Already Yielding Results*, USA TODAY, Jan. 27, 2009, http://www.usatoday.com/life/lifestyle/fashion/2009-01-26-obama-fashion-stimulus_N.htm. A.B.S. had its own version of the dress available in department stores just in time for prom season. *Id.*

[5] *See* Christine Magdo, Protecting Works of Fashion from Design Piracy 1 (2000) (unpublished comment, *available at* http://leda.law.harvard.edu/leda/data/36/MAGDO.html#fnB14); *see also* H. Shayne Adler, Note, *Pirating the Runway: The Potential Impact of the Design Piracy Prohibition Act on Fashion Retail*, 5 HASTINGS BUS. L.J. 381, 382 (2009) (defining design piracy as "when an individual or manufacturer produces an imitation of a designer item at lower costs").

[6] Safia A. Nurbhai, Note, *Style Piracy Revisited*, 10 J.L. & POL'Y 489, 490 (2002) (citing J. JARNOW ET AL., INSIDE THE FASHION BUSINESS: TEXT AND READINGS 28 (4th ed. 1987)).

[7] Stop Fashion Piracy, http://www.stopfashionpiracy.com (last visited Jan. 21, 2010).

[8] *Id.* (noting that design piracy has become a "way of life in the garment business"); *see also* Biana Borukhovich, Note, *Fashion Design: The Work of Art that is Still Unrecognized in the United States*, 9 WAKE FOREST INTELL. PROP. L.J. 92, 92–93 (2008).

[9] S. Priya Bharathi, *There Is More than One Way to Skin a Copycat: The Emergence of Trade Dress to Combat Design Piracy of Fashion Works*, 27 TEX. TECH L. REV. 1667, 1667 (1996).

[10] *Id.*

[11] France has afforded copyright protection to clothing since 1793. Jennifer E. Smith, *Flattery or Fraud: Should Fashion Designs Be Granted Copyright Protection?*, 8 N.C. J.L. & TECH. ONLINE EDITION 1, 4 (2007). "[M]any other nations—Europe, Japan, even India—have responded to the

States has become a safe haven for design piracy.[12] Under the current intellectual property regime, American designers have limited recourse against fashion copycats for blatantly "knocking off" their work.[13] Despite relentless lobbying by high profile fashion designers and the Council of Fashion Designers of America ("CFDA"),[14] Congress has repeatedly refused to enact legislation protecting fashion designs.[15] Nonetheless, the fashion industry continues to clamor for protection against design piracy, and Congress is currently considering whether to extend copyright protection to fashion designs in the form of the Design Piracy Prohibition Act (hereinafter the "DPPA").[16]

The DPPA,[17] if passed, would extend copyright protection to fashion designs for a three-year period.[18] Jason Wu is among the congregation of designers lobbying Congress to pass the DPPA, which would protect his future designs from being copied for a

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increased speed of information and advances in copying technology by extending legal protection to fashion design." Susan Scafidi, *Design Piracy Prohibition Act: Historical Regression*, COUNTERFEIT CHIC, Mar. 10, 2008, http://www.counterfeitchic.com/2008/03/design_piracy_prohibtion_act_h.php.

[12] *A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. 77 (2006) [hereinafter *Hearing on H.R. 5055*] (statement of Susan Scafidi, Visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University).

[13] *See* Peter K. Schalestock, *Forms of Redress for Design Piracy: How Victims Can Use Existing Copyright Law*, 21 SEATTLE U. L. REV. 113, 113 (1997).

[14] The CFDA is a not-for-profit trade association comprised of American fashion designers. Council of Fashion Designers of America, About CFDA, http://www.cfda.com/category/about/ (last visited Jan. 21, 2010).

[15] *See, e.g.*, S. 1957, 110th Cong. (2007); H.R. 2033, 110th Cong. (2007); H.R. 5055, 109th Cong. (2006).

[16] *See* Design Piracy Prohibition Act, H.R. 2196, 111th Cong. § 2 (2009).

[17] When discussing the DPPA, this Article refers to H.R. 2196. The DPPA was originally introduced in the 109th Congress as H.R. 5055. In April 2007, Representative Delahunt reintroduced the legislation as H.R. 2033. In August 2007, Senator Schumer introduced a similar bill as S. 1957. None have passed as of this writing. *See* discussion *infra* Part IV.A.

[18] H.R. 2196 § 2(d).

limited period of time so that he may reap some of the benefits of his investment.[19] After years of allowing design piracy to spread at the expense of the fashion industry and designers,[20] Congress should pass legislation aligning United States copyright protection with that of other nations, and to alleviate the burden placed on emerging young designers.[21]

In the absence of copyright protection, designers have turned to alternative theories, such as trade dress, to protect their work.[22] Trade dress is traditionally defined as the "overall appearance of labels, wrappers, and containers used in packaging a product."[23] Over time, the definition has expanded to include "a combination of any elements in which a product or service is presented to the buyer."[24] More simply, trade dress protects the overall appearance of a product. Designers are hoping courts will extend trade dress protection to a fashion design's "shape, color, font, size, styling, layout, design, language, and [overall] appearance" in order to prevent fast-fashion retailers from "knocking off" their designs.[25]

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[19] Renata Espinosa, *Design Piracy Prohibition Act Reintroduced in Congress*, FASHION WIRE DAILY, May 1, 2009, http://www.fashionwiredaily.com/first_word/news/article.weml?id=2615. In fact, a number of designers for Mrs. Obama, including Narciso Rodriguez, Maria Cornejo, and Thakoon Panichgul have also lobbied Congress to pass the DPPA. *Id.*

[20] *See* Susan Scafidi, *Fashion's Financial Fiction*, COUNTERFEIT CHIC, Jan. 27, 2009, http://www.counterfeitchic.com/2009/01/fashions_financial_fiction.php.

[21] *See* Lauren Howard, Article, *An Uningenious Paradox: Intellectual Property Protections for Fashion Designs*, 32 COLUM. J.L. & ARTS 333, 334 (2009).

[22] *See, e.g.*, Complaint at 15–16, Express LLC v. Forever 21, Inc., No. 09-CV-04514 (C.D. Cal. June 23, 2009) [hereinafter *Express* Complaint]; Complaint at 11–13, Trovata, Inc. v. Forever 21, Inc., No. 07-CV-01196 (C.D. Cal. Oct. 15, 2007) [hereinafter *Trovata* Complaint]; Magdo, *supra* note 5 at 9–16.

[23] J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 8-1 (4th ed. 2009) (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16, cmt. a (1995)).

[24] J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 8-1 (4th ed. 2009).

[25] *Express* Complaint, *supra* note 22, at 15.

Trade dress is a difficult argument to make in the fashion context because designers must prove secondary meaning.[26] In order to prove secondary meaning, a fashion designer must show that, "in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself."[27] In other words, consumers must associate the fashion design with the designer. In this Article's example, Jason Wu would have to establish that consumers associate the one-shoulder ivory-colored chiffon gown with him as its source.

Despite the difficulty of arguing secondary meaning, a successful trade dress claim can have significant results. If designers can succeed in obtaining trade dress protection for fashion designs, it will greatly reduce the degree to which fashion copycats can "knock off" a designer's work.[28] Furthermore, if trade dress is used to protect designers against design piracy, it may also render the DPPA legislation unnecessary.[29]

This Article argues that trade dress is not a viable defense against design piracy, and, therefore, Congress should pass the DPPA in order to adequately address the rising design piracy problem. Part I discusses the problem of design piracy within the fashion industry. Part II discusses current intellectual property protection for fashion designs. Part III discusses trade dress infringement as a cause of action in the recent litigation against Forever 21, Inc. ("Forever 21") in *Trovata, Inc. v. Forever 21, Inc*. Part IV discusses the pending DPPA

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[26] Lynsey Blackmon, Comment, *The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion*, 33 PEPP. L. REV. 107, 126–27 (2007) ("[T]he Supreme Court made the possibility of trade dress protection for fashion designs virtually unattainable in any case.").

[27] *See* Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 851 n.11 (1982).

[28] *See* Amy Odell, *Trovata Fights Forever 21 with Music, Forever 21 Fights Back with Apple Cobbler*, N.Y. MAG., June 14, 2009, http://nymag.com/daily/fashion/2009/05/trovata_fights_forever_21_with.html.

[29] *See* discussion *infra* Part IV.

legislation. Part V discusses the impracticability of trade dress as adequate recourse against design piracy for fashion designers and suggests that Congress adopt the DPPA, which proposes extending copyright protection to fashion designs.

I. THE FASHION INDUSTRY

The United States fashion industry is a multi-billion dollar industry.[30] The industry affects an array of people ranging from designers to "fabric manufacturers, printers, the people who produce paper for making patterns, the shippers who ship the merchandise, the truckers who truck, design teams, fabric cutters, tailors, models, seamstresses, sales people, merchandising people, advertising people, publicists, [and] those who work for retailers."[31] Design piracy threatens the livelihood of hundreds of thousands of people[32] employed by the United States fashion industry,[33] and costs designers hundreds of millions of dollars in revenue each year.[34]

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[30] C. Scott Hemphill & Jeanni Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1148 (2009) (noting the fashion industry has annual U.S. sales of more than $200 billion); Jennifer Mencken, Note, *A Design for the Copyright of Fashion*, 1997 B.C. INTELL. PROP. & TECH. F. 121201 (1997), http://www.bc.edu/bc_org/avp/law/st_org/iptf/articles/index.html; Nurbhai, *supra* note 6, at 489 (estimating the fashion industry generated $784.5 billion in sales in 1999); Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1693 (2006) (noting the global fashion industry sells over $750 billion of apparel annually).

[31] *Hearing on H.R. 5055*, *supra* note 12, at 11 (statement of Jeffrey Banks, Fashion Designer).

[32] *Id.*; *see also* Press Release, Congressman Jerrold Nadler, Delahunt, Goodlatte and Nadler Reintroduce Legislation to Combat Design Piracy (May 2, 2009) [hereinafter Nadler Press Release] *available at* http://nadler.house.gov/index.php?option=com_content&task=view&id=1238&Itemid=115 ("It has been estimated that counterfeiting merchandise, as a whole, is responsible for the loss of 750,000 American jobs . . . .").

[33] *See id.* at 9.

[34] *See Design Law—Are Special Provisions Needed to Protect Unique Industries: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. 25

On average, a single collection takes six to twelve months to create and costs nearly $6 million to produce;[35] however, design piracy prevents designers from earning a return on that investment.[36] Today, it is significantly easier and faster for fashion copycats to "knock off" designers.[37] Previously, "a designer had exclusive use of his design for a limited period of time because of the time required for a pirate to produce and market copies."[38] Because of modern technology, a design can now go from the runway to retail stores within a matter of days.[39] Now, a photograph taken at a fashion show in Paris can be emailed to a factory in China for a sample within hours.[40]

(2008) [hereinafter *Hearing on Design Law*] (statement of Narciso Rodriguez, Designer).

[35] *Id.* (statement of Narciso Rodriguez, Designer). According to fashion designer, Narciso Rodriguez, "[t]o design and fabricate my 250 piece collection it takes six to twelve months. The fall and spring runway shows cost on average $800,000 to stage. The fabric another $800,000, the work room that develops the patterns and garments another $1,500,000. The travel budget for design and fabric development is $350,000 and marketing is another $2,500,000. There are so many aspects of a fashion business that make it risky in the best of circumstances, and the pirates are only making it riskier." *Id.*

[36] Thakoon Panichgul, an American fashion designer, explains "we find our ability to [build a career] is undermined by pirates who, instead of laying out the money we do for research, pattern makers, to mount runway shows, etc [sic], they just copy the end product of all our investments and, by virtue of having a cost free design, sell our design in the market place cheaper than we can." Nadler Press Release, *supra* note 32; *see also* Adler, *supra* note 5, at 382.

[37] *Id.*

[38] Schalestock, *supra* note 13, at 115.

[39] Nurbhai, *supra* note 6, at 490 (citing Mencken, *supra* note 30, at n.75).

[40] *Id.* at 114 (citing Teri Agins, *Copy Shops: Fashion Knockoffs Hit Stores Before Originals as Designers Seethe*, WALL ST. J., Aug. 8, 1994, at A1); *see also Hearing on H.R. 5055*, *supra* note 12, at 79 (statement of Prof. Susan Scafidi) ("Digital photographs from a runway show in New York or a red carpet in Los Angeles can be uploaded to the internet [sic] within minutes, the images viewed at a factory in China, and copies offered for sale online within days—months before the designer is able to deliver the original garments to stores.").

The advent of modern technology has increased the rate of design piracy so that copies of the dress can reach stores before the originals and at a fraction of the cost.[41] In other words, the designer cannot profit from his work because the person selling the item in the retail stores is not the one who designed it.[42] A representative for the CFDA stated that "[a]lthough a designer can spend tens of thousands to mount their runway show to reveal their new lines, they frequently don't even recoup their investments. Their designs are stolen before the applause has faded [because] software programs develop patterns from photographs taken at the show and automated machines then cut and stitch copies of designers work from those patterns."[43]

For example, designer Narcisco Rodriguez testified before Congress that one of his gowns sold approximately 7 to 8 million copies; however, only 40 of the gowns sold were originals.[44] Because almost all of the gowns were "knock offs," Rodriguez did not benefit from the sales of those 7 million gowns despite having expended the time, energy and resources to create his gown.[45] As a result, "knock offs" and pirated

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[41] *See* Schalestock, *supra* note 13, at 114.

[42] *See, e.g.*, Ronald Urbach & Jennifer Soussa, *Is the Design Piracy Protection Act a Step Forward for Copyright Law or Is It Destined to Fall Apart at the Seams?*, 16 METROPOLITAN CORP. COUNS. 28 (2008); *see also* Elizabeth F. Johnson, Note, *Defining Fashion: Interpreting the Scope of the Design Piracy Prohibition Act*, 73 BROOK. L. REV. 729, 729 (2008) (describing the design piracy of Zac Posen's 2006 Academy Awards Show black gown for Felicity Huffman and Marc Bouwer's Golden Globe Awards coral dress for Marcia Cross).

[43] Urbach and Soussa, *supra* note 42 (citing Megan Williams, *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, 312 (2007).

[44] *Hearing on Design Law*, *supra* note 34, at 22 (statement of Narcisco Rodriguez).

[45] For a similar account, *see* Mary Angela Rowe, *Proposed New Law Sparks Rift in U.S. Fashion Industry*, REUTERS, July 17, 2009, http://www.reuters.com/article/idUSTRE56G4NI20090717 ("'We had other designers coming and shopping in our stores. I felt like crying afterwards because I knew they were buying samples (to copy),' said [Maria] Cornejo. 'They're basically putting their hand in my head, which is my bank, and stealing

imitations can cause significant harm to emerging designers, especially when such large investments are required on the front-end of the design process.[46]

Meanwhile, many retailers have created a profitable living "knocking off" designers.[47] For example, Forever 21, a Fortune 500 company, is considered by some as the "most notorious copyist retailer"[48] and is the target of over fifty lawsuits for copyright and trademark infringement.[49] Dana Foley, a designer with a Lower East Side boutique, said Forever 21 has copied her twice.[50] One of the designs was not even in stores yet.[51]

Foley is only one of the many designers that Forever 21 "knocked off." A recent trade dress infringement lawsuit stands out amongst the numerous copyright and trademark infringement suits against Forever 21.[52] This Article will study the trade dress infringement case in depth,[53] and analyze the viability of trade dress as a means of recourse against design piracy.[54]

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ideas. It's basically robbery.'").

[46] *See* Adler, *supra* note 5, at 382; *see also* discussion *supra* Part I (costing approximately $6 million to create a single collection).

[47] Schalestock, *supra* note 13, at 114–15 ("Two major design pirates have been attributed with $50 million and $200 million, respectively, in annual revenue from their knockoff sales.").

[48] Hemphill & Suk, *supra* note 30, at 1172.

[49] *Id.* at 1173; Amy Odell, *Forever 21's Ability to Copy Designer Clothes Could Be in Jeopardy*, N.Y. MAG., Apr. 13, 2009, http://nymag.com/daily/fashion/2009/04/forever_21s_ability_to_copy_de.html ("[C]ompanies including Diane von Furstenberg, Anna Sui, and Anthropologie have filed over 50 lawsuits against Forever 21 over the last three years relating to copyright infringement.").

[50] Associated Press, *Bill Would Extend Copyright Rules to Fashion*, MSNBC, Aug. 8, 2007, http://www.msnbc.msn.com/id/20183923. Foley says "[i]t cuts our legs out from underneath us in terms of building a brand, an identity." *Id.* Foley's dresses cost $300 to $400, while the Forever 21 version sells for only $29.99. *Id.*

[51] *Id.*

[52] *See, e.g.*, *Express* Complaint, *supra* note 22; *Trovata* Complaint, *supra* note 22.

[53] *See* discussion *infra* Part III.

[54] *See* discussion *infra* Part V.

II. THE CURRENT STATE OF PROTECTION FOR FASHION DESIGNS

United States law does not offer any substantive safeguards against fashion design copying.[55] While fashion designers may receive some protection under the current intellectual property regime,[56] these safeguards are very limited and do not explicitly protect the group of designers that are most vulnerable to design piracy—unrecognized, emerging young designers.

A. Copyright Protection

Although the Copyright Act covers an array of creative works including literature, music, motion pictures, sound recordings, and architecture,[57] it currently does not protect fashion designs.[58] Significantly, the "useful articles" doctrine precludes copyright protection to fashion designs that are used to cover and protect one's body.[59] A "useful article" is defined as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."[60] The legislative history of the 1976 Copyright Act explains that the purpose of excluding useful articles from copyright protection was "to draw as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design."[61] Examples of uncopyrightable

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[55] *See* discussion *infra* Part II.

[56] Steven Wesiburd et al., *The Design Piracy Prohibition Act*, N.Y.L.J., Jan. 20, 2009, http://www.dicksteinshapiro.com/files/upload/DesignPiracy Prohibition.pdf.

[57] 17 U.S.C. § 102 (2006).

[58] *Id.* (limiting copyright protection to original works of authorship fixed in any tangible medium of expression that are created as (1) literary works; (2) musical works; (3) dramatic works; (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).

[59] *Id.* § 101; *see also* Johnson, *supra* note 42, at 734 ("Generally, courts have considered clothing to be 'useful articles' and therefore not protected by the Copyright Act."); Nurbhai, *supra* note 6, at 499–500.

[60] 17 U.S.C. § 101.

[61] H.R. REP. NO. 94-1476, at 55 (1976).

works cited in the legislative history include "[t]he shape of an automobile, airplane, ladies' dress, food processor, [and a] television set."[62] Congress' explicit mention of a "ladies' dress" in the list of useful articles examples is indicative of the hurdles facing the fashion industry in defining fashion designs as something more than just clothing.[63]

The Copyright Act, however, does provide an exception for designs that are "separable and independent of the utilitarian function of the article."[64] Separability can be interpreted as "either physical separability or conceptual separability."[65] For example, in *Mazer v. Stein*, the Court held that a statuette forming the base of a lamp could be copyrighted because the artistic elements of the lamp were separable from the utilitarian functions of the lamp.[66] Therefore, theoretically speaking, fashion designs should also be eligible to receive copyright protection if they contain "some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of the article."[67] Historically, courts have generally considered fashion designs as physically and conceptually inseparable from the article of clothing, and, therefore,

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[62] *Id.*

[63] The "useful articles" doctrine "expresses Congress' desire to limit the ability of manufacturers to monopolize designs dictated solely by the function the article is to serve, such that the first manufacturer to adopt the design would have the exclusive right to produce those kinds of products." Anne Theodore Briggs, Article, *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, 24 HASTINGS COMM. & ENT. L.J. 169, 181 (2002); *see also* Knitwaves Inc., v. Lollytogs Ltd., 71 F.3d 996, 1006 (2d Cir. 1995) (explaining the purpose of the functionality doctrine is to "prevent[] trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature") (quoting Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 164 (1995)).

[64] Magdo, *supra* note 5.

[65] *Id.*

[66] Mazer v. Stein, 347 U.S. 201, 212–13 (1954). *Cf.* Norris Indus., Inc. v. Int'l Tel. Corp., 696 F.2d 918, 923–24 (11th Cir. 1983) (holding that automobile hubcaps are not protected as sculptural works because hubcaps are useful articles).

[67] Schalestock, *supra* note 13, at 118 (citing 17 U.S.C. § 101 (1996)).

incapable of receiving copyright protection under the "useful articles" exception.[68]

Despite the court's categorization of fashion designs as useful articles, the purpose of a fashion work is different from that of a piece of clothing used to cover and protect.[69] Instead, a fashion work, like a beautiful ball gown, is a piece of art.[70] For instance, Jason Wu's inaugural ball gown is now part of an exhibit in the Smithsonian's National Museum of American History in Washington.[71] The Copyright Act should be amended to extend copyright protection to fashion works because it is the best method of addressing design piracy.[72] Congressional legislation is currently pending that would amend the Copyright Act to protect fashion works, which this Article addresses in further detail below.[73]

B. Patent Law Protection

Patents protect the inventor of "any new, original and ornamental design for an article of manufacture"[74] for fourteen years.[75] To be eligible for a patent, a work must be a new

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[68] Nurbhai, *supra* note 6, at 500; Urbach & Soussa, *supra* note 42, at 28; *see* Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 216 (2000); *see also* Poe v. Missing Persons, 745 F.2d 1238, 1241 (9th Cir. 1984); Aldridge v. Gap, Inc., 866 F. Supp. 312, 314 (N.D. Tex. 1994); Blackmon, *supra* note 26, at 129 (noting that copyright protection does not exist for garments because of their useful nature); Briggs, *supra* note 63, at 183 (noting that "[C]lothing is clearly a 'useful article,' whether one considers its function to be protecting its wearer from the elements, ensuring modesty, or symbolizing occupation, rank or status").

[69] *Hearing on H.R. 5055*, *supra* note 12, at 79 (statement of Prof. Susan Scafidi).

[70] *Id.* at 80.

[71] Kate Philips, *First Lady's Inaugural Gown Installed*, N.Y. TIMES, Mar. 9, 2010, http://thecaucus.blogs.nytimes.com/2010/03/09/first-ladys-inaugural-gown-installed.

[72] *See* discussion *infra* Part IV.

[73] *See id*.

[74] 35 U.S.C. § 171 (2006).

[75] *Id.* § 173.

invention and must advance beyond the prior art in a way that is non-obvious.[76] Courts have generally held that fashion works fail to meet these criteria. As such, patents are not a viable solution to design piracy.[77]

Moreover, design patents are "ill-suited for fashion designs for other practical reasons, including (1) the patent application process is costly, lengthy and the prospects of protection are uncertain and (ii) design patent protection lasts for fourteen years, which is too long to fit sensibly in the fast-paced fashion market."[78] When compared to the relevant life span of most fashion works, patents take a long time to obtain and are prohibitively expensive.[79] The Patent and Trademark Office takes an average of twenty-two months to review each design patent after application,[80] and almost half of those applications get rejected.[81] Because the relevant life span of most fashion designs is one season, which lasts approximately three to six months, obtaining a patent for a fashion design is fruitless.[82] Therefore, fashion designers do not normally seek patents for their designs.[83]

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[76] *Id.*

[77] *See* 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, 355 (1991); Urbach & Soussa, *supra* note 42, at 28.

[78] Urbach & Soussa, *supra* note 42, at 28.

[79] *See* Hagin, *supra* note 77, at 355.

[80] *Id.* at n.110.

[81] Magdo, *supra* note 5 at 6–7 (citing Richard G. Frenkel, *Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-TRIPS Era*, 32 LOY. L.A. L. REV. 531, 541 (1999)).

[82] *See* Hagin, *supra* note 77, at 355 n.110.

[83] *See* Susan Scafidi, *Intellectual Property and Fashion Design*, *in* 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 115, 122 (Peter K. Yu ed., 2006) ("For most fashion designs, however, the patentability requirements of novelty, utility, and nonobviousness, the expense of prosecuting a patent, and above all the amount of time required to obtain a patent make this form of protection impractical if not impossible.").

C. Trademark Protection

Trademark law offers some protection to fashion designers.[84] A trademark is "any word, name, symbol, or device, or combination thereof"[85] that is adopted and used by a manufacturer or merchant "to identify his goods and distinguish them from those manufactured and sold by others."[86] Trademark protects words, emblems, logos or symbols such as the Nike swoosh or the interlocking Chanel double-C logo.[87] However, trademark protection would not protect emerging designers because their names and logos are not yet recognizable to a broad range of consumers.[88] Furthermore, trademark protection does not protect the overall look of a design.[89]

D. Trade Dress Protection

Given the current intellectual property scheme, fashion designers are attempting to use trade dress to protect their work.[90] Trade dress, like trademarks, is embodied under the Lanham Trademark Protection Act §43(a) ("Lanham Act"), which states:

> 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 misleading description of fact, or false or misleading representation of fact which . . . [i]s likely to cause confusion, or to cause mistake, or to

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[84] *See* Lanham Trademark Protection Act § 43(a), 15 U.S.C. § 1125(a) (2006).

[85] *Id.* § 1125(a)(1).

[86] *Id.* § 1127.

[87] Scafidi, *supra* note 83, at 121; Urbach & Soussa, *supra* note 42, at 28.

[88] Scafidi, *supra* note 83, at 121.

[89] *See* 15 U.S.C. § 1125(a).

[90] *See, e.g.*, *Express* Complaint, *supra* note 22; *Trovata* Complaint, *supra* note 22.

> deceive . . . as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or . . . 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 likely to be damaged by such an act.[91]

The distinction between trade dress and trademarks is largely historical, which has essentially disappeared over the years.[92] A trademark infringement claim focuses on whether a discrete symbol functions as a mark and whether the defendant's mark is likely to cause confusion.[93] In contrast, a trade dress infringement claim focuses on whether the "plaintiff has defined the trade dress as the total image or overall impression of [the] plaintiff's product, package and advertising," and whether the defendant's trade dress is likely to cause confusion with the plaintiff's trade dress.[94]

Over the years, trade dress has evolved through three different forms. The traditional definition of trade dress was "limited to the overall appearance of labels, wrappers, and containers used in packaging a product."[95] Gradually, trade dress expanded to include "a combination of any elements in which a product or service is presented to the buyer."[96] The combination of elements creates a visual image that is capable of acquiring

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[91] 15 U.S.C. § 1125(a); *see also* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 776 (1992) (Stevens, J., concurring) ("[T]he [Supreme] Court interprets this section [§ 43(a)] as having created a federal cause of action for infringement of an unregistered trademark or trade dress and concludes that such a mark or dress should receive essentially the same protection as those that are registered.").

[92] J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 8-2 (4th ed. 2009).

[93] *Id.* at 8-3.

[94] *Id.* at 8-7.

[95] *Id.* at 8-2.

[96] *Id.* at 8-4.

exclusive legal rights as a type of trade dress.[97] The third type of trade dress covers the shape and design of the product.[98] Generally, trade dress is most commonly used to protect a product's "total image and overall appearance"[96] of the product "as well as that of the container and all elements making up the total visual image by which the product is presented to customers."[99] Essentially, trade dress protects a product's overall look and feel.[100]

A party may claim trade dress protection for a unique combination of features, even though others may have used each of the features previously.[101] For example, courts have granted trade dress protection to a variety of designs, such as "a china pattern, fishing reel design, a restaurant's ambience, a television commercial's theme, and the style of a rock group's musical performance."[102] At issue here is whether the trade dress protection can be extended to the overall appearance of a dress like the one First Lady Michelle Obama wore to the Inauguration Ball.

To prevail in a trade dress infringement claim, the plaintiff must demonstrate that (i) the trade dress is nonfunctional; (ii) the trade dress is distinctive; and (iii) the infringing product creates a likelihood of confusion.[103] This Article will discuss each of

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[97] *Id.*

[98] Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 764 n.1 (1992); Knitwaves Inc., v. Lollytogs Ltd., 71 F.3d 996, 1005 (2d Cir. 1995).

[99] *Knitwaves*, 71 F.3d at 1005 (citing Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 58 F.3d 27, 31 (2d Cir. 1995)).

[100] *Two Pesos*, 505 U.S. at 764 n.1.

[101] Paddington Corp. v. Attiki Importers & Distribs., Inc. 996 F.2d 577, 584 (2d Cir. 1993) ("One could no more deny protection to a trade dress for using commonly used elements than one could deny protection to a trademark because it consisted of a combination of commonly used letters of the alphabet.").

[102] Bharathi, *supra* note 9, at 1679–80.

[103] *Two Pesos*, 505 U.S. at 763; *see also* MCCARTHY, *supra* note 92, at 8-4.50 ("'Trade dress' is an expansive concept, and has been held to include such things as: the cover of a book; a magazine cover design; the layout and appearance of a mail-order catalog; the registration process for a trade fair; the appearance and decor of a chain of Mexican-style restaurants; the method

these elements in detail below.

1. Non-Functionality

If the trade dress of a product is functional, then it falls outside the scope of protection."[104] A trade dress is considered functional "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article [or] if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage."[105]

2. Distinctiveness

The trade dress of a product must be distinctive.[106] Trade dress is distinctive if it is "inherently distinctive" or has "acquired distinctive" status through secondary meaning.[107]

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of displaying wine bottles in a retail wine shop; the use of a lighthouse as part of the design of a golf hole; the appearance of a teddy bear toy; a Christmas tree ornament in the shape of a bubble-blowing Santa Claus; a Rubik's cube puzzle; the shape of a classic automobile; the appearance of a lamp; the design of a doorknob; the shape of a flashlight; the 'G' shape of the frame of a GUCCI watch; the appearance of four models of CARTIER luxury watches; the design of jewelry modeled on a plumeria flower; the design of a line of childrens' clothing; the overall design of a sports shoe; the design of a handbag; the shape and appearance of the head of a golf club; the appearance of a video game console; the appearance of a casino table for four-hand poker; a combination of features of a folding table; the appearance of a water meter; the appearance of a bathroom scale; the design of a MIXMASTER kitchen stand mixer; a fish-shaped cracker; the design of a pop-up irrigation sprinkler; the design of a medical instrument; the decor, menu and style of a restaurant; the 'Marlboro Man' western cowboy motif; wine with picture of Marilyn Monroe on the label; and even the distinctive performing style of a rock music group.").

[104] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 164–65 (1995).

[105] *Id.* at 165.

[106] *Id.*

[107] RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (1995); *see* discussion *infra* Part II.D.ii.a; *see also Qualitex*, 514 U.S. at 163 (citations omitted) (finding secondary meaning where "in the minds of the public, the primary significance of a product feature . . . is to identify the

Marks that are "arbitrary," "fanciful," or "suggestive" are inherently distinctive.[108] Acquired distinctiveness is not only a mark that is descriptive, but one that consumers can use as a source identifier.[109]

Distinctiveness of product packaging trade dress may be either inherent or acquired.[110] However, in *Wal-Mart v. Samara Brothers*, the Court held that product design trade dress must show secondary meaning.[111] In other words, the Court held that clothing cannot be inherently distinctive.

i. The Significance of Wal-Mart v. Samara Brothers

In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, Samara Brothers, Inc. ("Samara") manufactured a line of children's clothing.[112] Wal-Mart Stores, Inc. ("Wal-Mart") hired a competing manufacturer to produce clothing that copied the overall Samara look using photographs of Samara garments.[113] Wal-Mart then sold these outfits under their own label "Small Steps" at a cheaper price.[114] J.C. Penney, a store that sold Samara's clothing under contract with Samara, called Samara's offices to complain that they had seen Samara's garments on sale at Wal-Mart for a lower retail price than allowed under their contract.[115] When Samara investigated the complaint, it discovered that Wal-Mart was selling copies of its garments under its own label "Cuties by Judy."[116]

Samara filed suit against Wal-Mart alleging trade dress

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source of the product rather than the product itself").

[108] Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 210–11 (2000).

[109] *Id.* at 211.

[110] *Id.* at 214–15.

[111] *Id.* at 216.

[112] Samara Bros. v. Wal-Mart Stores, Inc., 165 F.3d 120, 122 (2d Cir. 1998).

[113] *Id.*

[114] *Id.*

[115] *Id.* at 123.

[116] *Id.*

infringement.[117] The Supreme Court held that when a trade dress is found in the packaging of a product, it can be inherently distinctive;[118] however, when the trade dress' product design or configuration itself is in question, secondary meaning is required.[119] The Supreme Court's requirement of secondary meaning has made it extremely difficult for fashion designers to succeed on a trade dress infringement claim.

ii. Secondary Meaning

To establish secondary meaning, one must show the trade dress is a source identifier.[120] For example, if the Michelle Obama gown is a trade dress, then Jason Wu must show that consumers associate the one-shoulder ivory-colored chiffon dress with Swarovski crystals with his name. Secondary meaning evidence can include (but is not limited to): significant sales, consumer testimonials, long-term relatively exclusive use of the trademark in the industry, survey evidence of consumer association, substantial numbers of customers, proof of an infringer's copying and extensive or substantial advertising.[121] The problem is that secondary meaning is extremely challenging for fashion designers to prove.[122] Fashion works have a short life cycle, and, therefore, it is extremely hard for a designer to show that consumers identify the trade dress with a specific source to establish secondary meaning.[123] As a result, it is extremely

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[117] *Id.*

[118] Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 210–11 (2000).

[119] *Id.* at 211.

[120] RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. a (1995); Urbach & Soussa, *supra* note 42, at 28.

[121] Karina K. Terakura, Comment, *Insufficiency of Trade Dress Protection: Lack of Guidance for Trade Dress Infringement Litigation in the Fashion Design Industry*, 22 U. HAW. L. REV. 569, 588 (2000) (citing Centaur Commc'ns, Ltd. v. A/S/M Commc'ns, Inc., 830 F.2d 1217, 1222 (2d Cir. 1987)).

[122] *See generally Express* Complaint, *supra* note 22; *Trovata* Complaint, *supra* note 22.

[123] *See* Urbach & Soussa, *supra* note 42, at 28.

difficult for an unknown design to establish secondary meaning.[124] This precludes emerging fashion designers from obtaining trade dress protection and even if the designer can establish secondary meaning, fashion copycats, presumably, will have proceeded to the next current fashion design by the time the case is brought before a court.[125]

3. Likelihood of Confusion

Lastly, the plaintiff must show the trade dress causes a likelihood of confusion.[126] Likelihood of confusion arises "whenever consumers are likely to assume that a mark or trade dress is associated with another source or sponsor because of similarities between the two marks or trade dresses."[127] Courts employ two different tests and consider a variety of factors when deciding whether there is a likelihood of consumer confusion: the Second Circuit's *Polaroid* test[128] and the Ninth Circuit's *Sleekcraft* factors.[129] This Article will focus on the *Sleekcraft* factors because both trade dress cases against Forever 21[130] are

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[124] *Id.*

[125] *See Trovata* Complaint, *supra* note 22; *see also* Urbach & Soussa, *supra* note 42, at 28; Susan Scafidi, *Faithfully Yours (and Yours, and Yours):* McQueen v. Madden, COUNTERFEIT CHIC, Oct. 8, 2009, http://counterfeitchic.com/2009/10/faithfully-yours-and-yours-and-yours.html.

[126] Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 780 (1992).

[127] Rain Bird Corp. v. Hit Prods. Corp., No. 02-CV-09422, 2004 U.S. Dist. LEXIS 20790, at *13 (C.D. Cal. 2004) (quoting Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc., 944 F.2d 1446, 1456 (9th Cir. 1991)).

[128] Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961). In the Second Circuit, the courts consider the *Polaroid* factors: (1) strength of the prior owner's mark or dress; (2) degree of similarity between the national product's trade dress and the trade dress of the knockoff product; (3) proximity of the products in the market; (4) likelihood that the prior owner will bridge the gap; (5) actual confusion; (6) bad faith of knockoff company; (7) quality of defendant's product; and (8) sophistication of the buyer. *Id.*

[129] AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 n.11 (9th Cir. 1979).

[130] *See* discussion *infra* Part III.

litigated in district courts within the Ninth Circuit.[131]

In the Ninth Circuit, courts use the *Sleekcraft* factors in analyzing a likelihood of consumer confusion claim.[132] The eight *Sleekcraft* factors are:

> (1) similarity of the marks; (2) proximity of the goods; (3) marketing channels; (4) defendant's intent in electing its mark; (5) strength of plaintiff's mark; (6) evidence of actual confusion; (7) type of goods and the degree of care likely to be exercised by purchasers; and (8) likelihood of expansion of the product lines.[133]

The Ninth Circuit has held that the proximity of goods, the similarity of the marks and the marketing channels used are the three most important factors in the *Sleekcraft* analysis.[134]

For many years, trade dress protection was associated with product infringement suits.[135] However, fashion designers' attorneys have attempted to use trade dress as a defense against design piracy, especially in light of the influx of fashion copycats in recent years.[136] Forever 21 is currently facing two dress suits, one of which this Article will now examine in depth.

III. TRADE DRESS INFRINGEMENT LITIGATION AGAINST FOREVER 21

Discount clothing retailer, Forever 21, faced two separate lawsuits brought by fashion designers alleging clothing design trade dress infringement.[137] Do Won Chang and Jin Sook Chang

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[131] *See Express* Complaint, *supra* note 22; *Trovata* Complaint, *supra* note 22.

[132] *Sleekcraft*, 599 F.2d at 348–49.

[133] *Id.* at 348 n.11.

[134] GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1205 (9th Cir. 2000).

[135] *See, e.g.*, Samara Bros. v. Wal-Mart Stores, Inc., 165 F.3d 120, 122 (2d Cir. 1998).

[136] *See, e.g.*, *Express* Complaint, *supra* note 22; *Trovata* Complaint, *supra* note 22.

[137] *See Express* Complaint, *supra* note 22; *Trovata* Complaint, *supra* note 22.

founded Forever 21 in 1984 when the entrepreneurial couple opened their first store in downtown Los Angeles.[138] Now, twenty-five years later, Forever 21 is one of the fastest growing clothing retailers with almost 500 stores around the world.[139] The company's net worth is in excess of $2 billion dollars,[140] and it is the 376th largest private company in the United States.[141]

Forever 21 has become synonymous with trendy clothing items, low prices, and high turnover rates.[142] It markets itself to "trend savvy shoppers," where the "greatest value" can be purchased[143] for the most recent men's and women's fashion trends.[144] A typical Forever 21 location will turnover twenty percent of its stock every week in order to make room for the newest trends.[145]

Forever 21's success can be largely attributed to its quick turnover.[146] It is capable of moving product to market within a few weeks, in comparison to midmarket competitors like Gap, Old Navy and Urban Outfitters, which need three months to take an item from design to rack.[147] For designers, the design process takes even longer, ranging from 18 to 24 months for the initial design to reach production.[148] It is this constant turnover of

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[138] Soyoung Ho, *Forever 21 Fortune*, FORBES, Apr. 29, 2009, http://www.forbes.com/2009/04/29/billionaire-retail-forever21-korea-rich-09-wealth.html.

[139] *Id.*

[140] *Express* Complaint, *supra* note 22, at 6.

[141] Ho, *supra* note 138.

[142] Adler, *supra* note 5, at 391.

[143] Plaintiff's Notice of Motion and Motion for Summary Judgment at 2, Trovata, Inc. v. Forever 21, Inc., No. 07-CV-01196 (C.D. Cal. June 9, 2008) [hereinafter *Trovata* Summary Judgment Motion].

[144] *Id.*

[145] Adler, *supra* note 5, at 391.

[146] *See* Jincey Lumpkin, *The Fashion Slinger: Forever 21 is Forever in Lawsuits*, FASHION LAWYER BLOG, Jan. 30, 2008, http://fashionlawyerblog.com/?p=371.

[147] *Quick-Fashion Retailer Forever 21 Redefining Retail*, RETAIL SAILS, July 27, 2009, http://retailsails.com/2009/07/27/quick-fashion-retailer-forever-21-redefining-retail.

[148] *Id.*

lower quality copies of high-end designs that makes Forever 21 the "most notorious copyist retailer."[149] Over the years, it has been the defendant in over fifty lawsuits for copyright and trademark infringement.[150]

Between 2007 to 2008, Forever 21 has been sued by Anna Sui for seventeen articles of clothing, Anthropologie for ten articles, Bebe Stores for twenty-eight articles, Carole Hochman for a nightgown with a "Marilyn Monroe" fabric design, Diane von Furstenberg for four wrap dresses and one blouse, Haraujku Lovers for clothing with "Heart and Heart/Box design" print, Harkham Industries for a dress with the "Shadow Fern" design, and Trovata for six articles of clothing.[151] All of these lawsuits ended in settlement.[152]

In comparison, only two copyright and trademark infringement lawsuits have been filed against Forever 21's competitor, H&M.[153] This vast discrepancy in lawsuits can be attributed to the fact that H&M "engage[s] in loose design 'referencing' by borrowing high fashion ideas and interpreting them for the masses," while Forever 21 generally copies a design to the very last detail.[154] Judge Dolinger for the United States District Court for the Southern District of New York reprimanded Forever 21 for its deceptive conduct, noting "the extraordinary litigating history of this company . . . raises the most serious questions as to whether it is a business that is predicated in large measure on the systematic infringement of competitors' intellectual property."[155]

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[149] Hemphill & Suk, *supra* note 30, at 1172.

[150] *Id.*; Ho, *supra* note 138.

[151] Hemphill & Suk, *supra* note 30, at 1174 tbl.1.

[152] Izzy Grinspan, *Lawsuits: Ever-Slippery Forever 21 Settles with Trovata*, RACKED, Oct. 12, 2009, http://ny.racked.com/archives/2009/10/12/lawsuits_forever_21_keeps_perfect_record_settle_with_trovata.php.

[153] Hemphill & Suk, *supra* note 30, at 1173.

[154] Victoria Elman, Note, *From the Runway to the Courtroom: How Substantial Similarity is Unfit for Fashion*, 30 CARDOZO L. REV. 683, 686 (2008).

[155] Memorandum and Order at 11, Anthropologie, Inc. v. Forever 21, Inc., No. 07-CV-7873 (S.D.N.Y. March 13, 2009).

Recently, attorney Frank Colucci brought two federal trade dress infringement cases on behalf of his clients against Forever 21.[156] This Article will now analyze the trade dress claim in *Trovata, Inc. v. Forever 21, Inc.*

A. Trovata, Inc. v. Forever 21

On October 15, 2008, Trovata, Inc. ("Trovata") filed a complaint against Forever 21 in the Central District of California alleging federal trade dress infringement, false designation of origin, false advertising in violation of the Lanham Act, common law unfair competition, false advertising and dilution in violation of California state and federal statutes.[157]

Trovata is a clothing design and manufacturing company that was founded in 2001.[158] Trovata quickly earned a name for itself in the fashion industry by winning numerous awards for its trendy, fashion forward garments.[159] Its men's and women's clothing lines are sold exclusively at high-end specialty stores, such as Barney's New York, Louis Boston, Colette, Harvey Nichols, Ron Herman and American Rag.[160] Trovata has made millions of dollars in sales of its products.[161]

The Trovata look is called "twisted preppie,"[162] meaning the

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[156] *See Express* Complaint, *supra* note 22; *Trovata* Complaint, *supra* note 22. The *Express* case is still pending.

[157] *Trovata* Summary Judgment Motion, *supra* note 143, at 2.

[158] *Id.* at 3. The founders of Trovata are Jeff Halmos, Sam Shipley, Josia Lamberto-Egan, and John Whitledge.

[159] *Trovata: Label Overview*, NYMag.com, Sept. 7, 2007, http://nymag.com/fashion/fashionshows/designers/bios/trovata. In 2005, Trovata was awarded the Ecco Domani Fashion Foundation award and the CFDA/Vogue Fashion Fund award. *Id.* Trovata was also featured in fashion and industry magazines, such as *Vogue, GQ, DNR, Woman's Wear Daily, and Rolling Stone* for its distinctive and fashionable products and designs. *Trovata* Complaint, *supra* note 22, at 4.

[160] *Trovata* Summary Judgment Motion, *supra* note 143, at 4.

[161] *Trovata* Complaint, *supra* note 22, at 4.

[162] Transcript of Order Granting in Part and Denying in Part Plaintiff's Motion to Compel and Defendant's Motion to Compel at 3, Trovata, Inc. v.

designers "take things that are very, very old and they give them a little twist to make them more modern."[163] Trovata alleges that its customers identify its designs through the use of uneven-shaped and mismatched buttons and stripes,[164] a "T" design label featuring a "unique floral design" and "quirky" care instructions,[165] and "Frankenstein" stitching.[166] Trovata argues its trade dresses consist of the various combinations of these elements to create a unique overall appearance for each garment.[167] Trovata's attorney, Frank Colucci, analogizes the Trovata Trade Dresses to a combination of notes, chords, sharps and flats. "[T][he designer] takes notes, chords, sharps and flats and combines them and arranges them to make original music."[168] In other words, Trovata concedes that the mismatched buttons, stripes and stitching have been used before, but that the combination of these elements creates a unique and original look that constitutes a trade dress.

In February 2007, Trovata first discovered that Forever 21 was selling garments in its stores that allegedly copied its trade dresses.[169] Trovata contends Forever 21 infringed seven of its trade dresses (collectively, the "Trovata Trade Dresses").[170]

Forever 21, Inc., No. 07-CV-01196 (C.D. Cal. Dec. 9, 2008) [hereinafter *Trovata* Order on Motions to Compel].

[163] *Id.*

[164] *Trovata* Summary Judgment Motion, *supra* note 143, at 3.

[165] *Id.* at 4. The care instructions read: "If you want this thing to last, I would suggest to machine wash with similar colors cold, do not use chlorine bleach, tumble dry low. Iron if needed. I know you already know all this. –Sam." *Id.* at 5. The "T" design label is registered with the United States Patent and Trademark Office ("USPTO"). *Id.* at 4.

[166] *Trovata* Order on Motions to Compel, *supra* note 162, at 8 (describing "Frankenstein" stitching as the following: "[T]he idea is that someone wore this shirt and tried to repair it themselves—and this is a bad job that they did on repairing . . . . It's called Frankenstein or Frankenstitch because it looks like the stitching on the monster").

[167] *Trovata* Summary Judgment Motion, *supra* note 143, at 3–4.

[168] Odell, *supra* note 28.

[169] *Trovata* Complaint, *supra* note 22, at 9.

[170] *Id.* at 6–9. The seven trade dresses are: (1) the "Fife S/S Voile Blouse"; (2) the Luge Hoodie; (3) the "Berber Polo—Four Stripes"; (4) the

For the sake of brevity, this Article will only discuss one of the seven Trovata Trade Dresses: the Fife S/S Voile Blouse. Trovata argued that the Fife S/S Voile Blouse is a protectable trade dress because its overall appearance is created using a unique combination of five different elements: evenly spaced dots in a box pattern, ruffles on a short-sleeve opening, mismatched buttons, and two-hole buttons with contrasting burgundy thread and stripe patterns.[171] When the Fife S/S Voile Blouse is compared to the Forever 21 garment, the designs are almost indistinguishable to a viewer, and, therefore, Trovata sought an injunction against the sale of the defendant's item.[172]

However, in order to establish trade dress protection, Trovata had the burden of proving three things.[173] First, Trovata needed to show that the trade dresses it claimed were nonfunctional.[174] Second, Trovata needed to show that the trade dresses it claimed acquired distinctiveness through secondary meaning.[175] Lastly, Trovata needed to show that under the *Sleekcraft* factors, Forever 21's garments created a likelihood of confusion.[176] Because a designer is required to establish all three elements in order to obtain trade dress protection, it is difficult for designers to prevail on such a claim.

First, Trovata argued the Fife S/S Voile Blouse trade dress is not functional because none of the design elements are essential to the function of the clothing with which they are used, and that they create an "arbitrary overall visual impression."[177] Second, Trovata argued that its trade dress has

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"Merchant S/S Henley"; (5) the "Highlands"; and (6) the "Outpost Cardigan," which comes in two color schemes. *Id.* The "Outpost Cardigan" is a cardigan with horizontal stripes and multi-color buttons. *Id.* at 8.

[171] *Id.* at 6.

[172] *Id.* at 18–20.

[173] *See* discussion *supra* Parts II.D.i-iii.

[174] *See* discussion *supra* Part II.D.i.

[175] *See* Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 216 (2000) (holding that product design trade dresses must establish secondary meaning).

[176] *See* discussion *supra* Part II.D.iii.

[177] *Trovata* Summary Judgment Motion, *supra* note 143, at 10.

acquired distinctiveness through secondary meaning as evidenced by its rise in popularity in the fashion industry,[178] and Forever 21's exact copying of its trade dresses.[179] Lastly, Trovata argued that there is a likelihood of confusion between the Fife S/S Voile Blouse Trade Dress and Forever 21's garment because (1) the products are identical;[180] (2) both retailers sell fashion-forward apparel;[181] and (3) Forever 21 intentionally copied its trade dress.[182]

In response, Forever 21 alleged that the Fife S/S Voile Blouse trade dress is functional in both an aesthetic and utilitarian sense.[183] First, Forever 21 alleged that the Fife S/S Voile Blouse trade dress is functional in the aesthetic sense because "there are a limited number of pleasing stripe patterns, dot patterns, silhouetting accents, [and] types of buttons."[184] In addition, Forever 21 contended that the Fife S/S Voile Blouse trade dress is also functional in the utilitarian sense because ruffles on short-sleeve openings "provide a more comfortable fit for the wearer," and striped patterns are used to create a wider or slimmer appearance.[185] Forever 21 argued that competitors would be put at a significant non-reputational disadvantage in the sale of similar designs if the court granted the Fife S/S Voile Blouse injunction because it would preclude them from using certain combinations of stripes, dots, ruffles, and buttons.[186] More simply, if the court found in favor of Trovata on the Fife

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[178] *Id.* at 20. Some courts have found that if a product with a particular trade dress becomes popular in a short period of time, it can be distinctive through secondary meaning in a matter of months. *See, e.g.*, Eliya Inc. v. Kohl's Dep't Stores, 82 U.S.P.Q.2d 1088, 1094 (S.D.N.Y. 2006).

[179] *Trovata* Summary Judgment Motion, *supra* note 143, at 12–13.

[180] *Id.* at 14.

[181] *Id.*

[182] *Id.* at 15.

[183] *Id.* at 6.

[184] Defendant's Answer to Plaintiff's Complaint for Copyright Infringement, Trade Dress Infringement, and Unfair Competition at 29, Express, Inc. v. Forever 21, Inc., No. 09-CV-04514 (C.D. Cal. June 23, 2009) [hereinafter Defendants' Answer to *Express* Complaint].

[185] *Id.* at 10.

[186] *Id.* at 9–10.

S/S Voile Blouse trade dress, Forever 21 would be competitively disadvantaged because it could not use those key elements that are not attributable to Trovata's reputation in the fashion industry.

Second, Forever 21 argued that Trovata failed to demonstrate secondary meaning evidence, such as domestic advertising, domestic expenditures or sales figures concerning the products at issue, to support an inference that the style or style features achieved mark recognition.[187] Forever 21 argued that the likelihood of consumer confusion is low because the products at issue bear the Forever 21 trademarks and are marketed only in Forever 21 retail stores or on their website.[188]

Third, Forever 21 argued that Trovata customers are unlikely to believe that products bearing Trovata's trademarks actually originate from Forever 21, particularly given the considerable price difference.[189] Furthermore, Forever 21 pointed out that the marketing channels used by Forever 21 and Trovata are "unquestionably distinct"[190] because Forever 21's products are sold only in its retail stores and on its website while Trovata sells its products in high-end department stores.[191] Lastly, Forever 21 argued that Trovata's customers are sophisticated consumers[192] who are attentive to details such as location, price, and labeling, and are therefore less likely to be confused as to the sources of the products that they purchase.[193]

On May 27, 2009, U.S. District Court Judge James V. Selna announced a mistrial after two tumultuous years of litigation.[194] The eight-person jury was unable to reach a verdict as to whether Forever 21 knowingly infringed on Trovata's trade

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[187] *Id.* at 11–12.

[188] *Id.* at 16.

[189] *Id.* at 19.

[190] *Id.* at 5.

[191] *Id.*

[192] *Id.*

[193] *Id.*

[194] Izzy Grinspan, *Jury Hijinks Lead to Mistrial in* Trovata vs Forever 21, RACKED, May 27, 2009, http://la.racked.com/archives/2009/05/27/jury_hijinks_lead_to_mistrial_in_trovata_vs_forever_21.php.

dresses.[195] In other words, at least half of the jury did not believe that Forever 21 knowingly "knocked off" Trovata's trade dresses. Shortly after, the parties settled.[196] Although this is certainly a loss for fashion designers seeking some form of protection for their work, this is the furthest a design piracy case has ever proceeded against Forever 21.[197]

Nonetheless, it is unsurprising that trade dress failed in this instance, even though the garments are indistinguishable. First of all, trade dress is a confusing legal doctrine for juries to grasp.[198] Second, the disputed articles of clothing, are relatively unremarkable.[199] Third, Trovata is a relatively new player in the fashion industry.[200] This case demonstrates how difficult it is for a fashion designer to succeed on a trade dress claim.

IV. THE DPPA

Given the unlikelihood of using trade dress to protect fashion designers against design piracy, Congress should pass the Design Piracy Prohibition Act.

A. The History of the DPPA

On March 30, 2006, Representative Robert Goodlatte (VA) introduced H.R. 5066,[201] commonly known as the DPPA, in the House of Representatives.[202] The DPPA seeks to amend Title 17

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[195] *Id.*

[196] Amy Odell, *Trovata's Suit Against Forever 21 Ultimately Has No Effect on Knockoff Regulations*, N.Y. MAG., Oct. 13, 2009, http://nymag.com/daily/fashion/2009/10/trovatas_suit_against_forever.html#ixzz0YkYYXx9z.

[197] *Id.*

[198] *See* MCCARTHY, *supra* note 92.

[199] In contrast, Jason Wu's dress is a ball gown worn on national television by a prominent figure in society. Salamone, *supra* note 4.

[200] *Trovata: Label Overview*, *supra* note 159.

[201] H.R. 5055, 109th Cong. (2d Sess. 2007). H.R. 5055 is substantively identical to H.R. 2033. Adler, *supra* note 5, at 381, n.45.

[202] *Id.* (as introduced to the H.R., Mar. 30, 2006).

to extend copyright protection for fashion designs.[203] The bill defines a "fashion design" as "the appearance as a whole of an article of apparel, including its ornamentation."[204] Additionally, the bill defines an "article of apparel" as "an article of men's, women's, or children's clothing, including undergarments, outerwear, gloves, footwear, and headgear, handbags, purses, and tote bags, belts, and eyeglass frames."[205] Under the Act, the designer must register the fashion design within three months of being made public.[206] The Act would grant a fashion design three years copyright protection.[207]

On July 27, 2006, the House held subcommittee hearings in the House Subcommittee on the Courts, Internet and Intellectual Property.[208] The hearing featured expert testimonies from attorneys, designers, and industry experts attesting to the benefits and dangers of extending copyright protection to fashion design.[209] Ultimately, the bill was rejected.[210]

B. The Act Revisited

On April 30, 2009, the 111th Congress reexamined the

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[203] *Id.*

[204] *Id.* § 1(a)(2)(B).

[205] *Id.*

[206] *Id.* § 1(b)(3).

[207] *Id.* § 1(c).

> Proponents of the legislation have explained that the purpose of the legislation is to protect designs of *haute couture* during the period of time in which such high-end clothing is sold at premium prices of thousands of dollars and to prevent others from marketing clothing with those designs at substantially lower prices during that initial period, thereby undercutting the market for a hot new fashion design. Because the peak demand for such designs is relatively short-lived, a 3-year term is considered adequate to satisfy the designer's reasonable expectation of exclusivity.

Hearing on H.R. 5055, *supra* note 12, at 210 (prepared statement of U.S. Copyright Office).

[208] *Hearing on H.R. 5055*, *supra* note 12.

[209] *Id.*

[210] H.R. 5055, *supra* note 12.

DPPA.[211] H.R. 2196 defines a "fashion design" as "the appearance as a whole of an article of apparel, including its ornamentation; and []includes original elements of the article of apparel or the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel."[212] The bill defines "apparel" as "an article of 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."[213] Notably, the major distinction between H.R. 5055 and H.R. 2196 is the refined definition of fashion design. Under H.R. 2196, copyright protection is extended to "original elements of the article of apparel or the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel."[214] In other words, if H.R. 2196 is passed, fashion designers would receive protection for a wider array of work including the elements, placement and overall appearance of a piece of clothing.

Currently, the bill is still pending in Congress.[215] The DPPA should be passed because copyright protection is the most viable solution to addressing design piracy. Furthermore, "it would promote and protect our nation's entrepreneurs by ensuring a just and fair marketplace at home, and a level playing field abroad."[216]

V. CONCLUSION

Fashion designers need some form of legal protection for their work and trade dress is not the solution. Only an established designer would have a viable trade dress argument

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[211] Design Piracy Prohibition Act, H.R. 2196, 111th Cong. (1st Sess. 2009).

[212] *Id.* § 2(a)(2)(B).

[213] *Id.*

[214] *Id.*

[215] *Id.*

[216] Nadler Press Release, *supra* note 32.

because of the difficult secondary meaning requirement for product design trade dresses.[217] However, established designers are not the ones that need protection from design piracy. Instead, emerging young designers are the group of individuals that need to be protected from being "knocked off" because they do not have any legally protected trademarks to which they can resort.[218] Furthermore, emerging designers are less likely to succeed on trade dress "because they are relatively unknown and their designs are unfamiliar to the public."[219] Therefore, trade dress does not provide adequate recourse for designers against design piracy.

Congress should pass the DPPA instead of forcing fashion designers to turn to alternative theories, like trade dress, to protect their work against design piracy. While the purpose of the American intellectual property scheme is to encourage and reward individuals, the current regulatory policy for fashion designs clearly fails to protect many designers from design piracy. Until Congress adopts the DPPA, fashion designers must fend for themselves while fast-fashion retailers profit at their expense. The result is contradictory to the foundation of our intellectual property regime and should be amended to ensure the prosperity of the American fashion industry.

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[217] Scafidi, *supra* note 125.

[218] *Id.*

[219] *Id.*