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## Fashion Frustrated: Why the Innovative Design Protection Act is a Necessary Step in the Right Direction, But Not Quite Enough

Casey E. Callahan

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# FASHION FRUSTRATED: WHY THE INNOVATIVE DESIGN PROTECTION ACT IS A NECESSARY STEP IN THE RIGHT DIRECTION, BUT NOT QUITE ENOUGH

## INTRODUCTION

In 2007, Proenza Schouler, headed by designers Jack McCullough and Lazaro Hernandez, released a capsule collection with Target through the store's Go International Designer Collective.<sup>1</sup> In 2011, Target re-released some of the items from the collection,<sup>2</sup> an action that can certainly be attributed to the prior success of the collection itself, but also one that can be attributed to the explosive success Proenza Schouler has seen within the last several years.<sup>3</sup> Much of this success is thanks to the PS1, a shoulder bag retailing for between \$1,695 and \$9,250 in its mid-range size<sup>4</sup> that became the "It" bag of the fashion world immediately upon its release in 2008 and has yet to see any hint of a decline.<sup>5</sup> However, in the same year, Target released a \$34.99 messenger bag that looked alarmingly similar to the PS1—so similar, in fact, that it was brought to the attention of the PS1 designers, who were not very happy about it.<sup>6</sup> Shirley Cook, CEO of Proenza Schouler, voiced their frustration by saying, "So our product is in Target right now, and then this bag comes out . . . It's just disappointing, especially from someone we worked with."<sup>7</sup> In addition to the betrayal of a former collaborator, Proenza Schouler is additionally—and rightfully so—concerned with what the existence of the Target bag could do to its business. "[W]hy save up and buy ours when you can buy theirs right away?" lamented McCullough, who hoped that Target would stop selling the bag.<sup>8</sup> However, when Target was asked about the matter, their spokesman simply stated, "It always has been and continues to be the policy of Target to respect the intellectual property rights of others."<sup>9</sup> Although this sounds like a very corporate and unapologetic response, it is not untrue:

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1. Ceci Guicciardi, *Addressing Fashion's Intellectual Property Conundrum*, BUS. OF FASHION (July 26, 2011), <http://www.businessoffashion.com/2011/07/fashions-intellectual-property-conundrum.html>; Cathy Horyn, *Proenza Schouler Doesn't Care for Target's Messenger*, N.Y. TIMES ON THE RUNWAY BLOG (Mar. 25, 2011), <http://runway.blogs.nytimes.com/2011/03/25/proenza-schouler-doesnt-care-for-targets-messenger/>.

2. Megs Mahoney Dusil, *Target Takes on Proenza Schouler's PS1*, PURSEBLOG (Mar. 25, 2011), <http://www.purseblog.com/debates/target-takes-on-proenza-schoulers-ps1.html>.

3. *Proenza Schouler—2011 CFDA Designer of the Year*, SHOPSTYLE BLOG (June 7, 2011), <http://blog.shopstyle.com/Proenza-Schouler---2011-CFDA-Designer-Year-17827195>.

4. PROENZA SCHOULER, <http://www.proenzaschouler.com/shop/ps1/medium-1> (last visited Aug. 25, 2012).

5. Megs Mahoney Dusil, *Proenza Schouler PS1*, PURSEBLOG (July 20, 2009), <http://www.purseblog.com/trends/proenza-schouler-ps1.html>.

6. Horyn, *supra* note 1.

7. *Id.* (internal quotation marks omitted).

8. *Id.* (internal quotation marks omitted).

9. *Id.* (internal quotation marks omitted).

Target did not violate anyone's intellectual property rights in releasing its messenger bag, regardless of how similar it was to the PS1, or any other bag for that matter, because such rights do not exist. Currently, it is completely legal for someone to replicate another fashion designer's creation, so long as they do not try and pass it off as the real thing.<sup>10</sup>

If this seems unfair and at odds with our justice system, that's because it is. The logic and underlying basis for intellectual property protection is to foster creativity and innovation by giving those creators and innovators the rights of ownership over what they create.<sup>11</sup> It places a tangible value on ideas by granting such rights.<sup>12</sup> Conversely, not granting these rights, or not providing an adequate means for enforcing them, not only sends the message that what is created does not have value, it also deters creators from producing new ideas. Such is the case presently for fashion designers. The lack of protection for their products and designs places them in a disadvantaged class within the intellectual property system, without the same rights that are given to musicians, artists, filmmakers, and other creators.

Fortunately, there is hope for designers. In September 2012, a bill known as the Innovative Design Protection Act (IDPA) was introduced to the Senate.<sup>13</sup> The bill, a revised version of the previous Innovative Design Protection and Piracy Prevention Act (IDPPPA),<sup>14</sup> would give copyright protection to fashion designs, provided they meet certain standards.<sup>15</sup> Though the bill would likely not completely eliminate piracy in the fashion industry, it would certainly have a substantial impact on reducing and deterring such activity, saving the industry and the American economy billions of dollars that are lost every year due to design piracy.<sup>16</sup> However, although

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10. See 18 U.S.C. § 2320 (2006). Selling or trafficking in counterfeit goods is a crime under federal law, as long as the goods or their packaging contains a counterfeit marking of some kind that is "identical" or "substantially indistinguishable" to a registered trademark. *Id.*

11.

The major branches of intellectual property are premised on achieving some public good or public interest. Patents encourage innovation. Copyrights reward creators of cultural works. Trade secret laws allow people to rely on confidential disclosures. Trade marks and service marks inform the consuming public. These underlying values have passed tests of time within the culture, and they have been reaffirmed by legislatures and by courts.

HOWARD C. ANAWALT, *IP STRATEGY: COMPLETE INTELLECTUAL PROPERTY PLANNING, ACCESS AND PROTECTION* § 1:1 (West 2012).

12. Existing copyright law provides for monetary damages for infringement, as well as other remedies. See 17 U.S.C. § 504 (2006).

13. See Innovative Design Protection Act (IDPA), S. 3523, 112th Cong. (2012).

14. See Innovative Design Protection and Piracy Prohibition Act (IDPPPA), H.R. 2511, 112th Cong. (2011).

15. IDPA, S. 3523.

16. Silvia Beltrametti, *Evaluation of the Design Piracy Prohibition Act: Is the Cure Worse than the Disease? An Analogy with Counterfeiting and a Comparison with the Protection Available in the European Community*, 8 NW. J. TECH. & INTELL. PROP. 147, 150 (2010).

the IDPA is an improvement on multiple prior proposals for legislation,<sup>17</sup> and while it is the most suitable solution thus far, it is not without flaws and still needs improvement.

In Part I of this note, I will explain how the IDPA came to be, through its prior versions, as a result of the lack of protection for designers. In Part II, I will explain why the IDPA is necessary, what kind of effects it will have on the fashion industry, and address some of the claims made by critics of the bill. In Part III, I will propose how the bill can, and should, be improved by changes that would make it even more effective.

## I. BACKGROUND OF THE IDPA

### A. THE LACK OF COPYRIGHT PROTECTION FOR FASHION DESIGNERS

Currently in American law, there is virtually no legal protection for fashion designers and their creations.<sup>18</sup> The three available avenues for protection are design patents, trade dress and trademark, and copyright. If a designer obtains a patent, it lasts for fourteen years<sup>19</sup> and the holder of the patent is permitted to prevent others from any use or sale of the design.<sup>20</sup> However, in order for a design to be eligible for a patent, it must be a “new, original, and ornamental design for an article of manufacture,”<sup>21</sup> and most fashion designs are unable to meet the necessary standard for being “novel” and “nonfunctional.”<sup>22</sup> Additionally, the lengthy duration of protection for design patents is unnecessary for most fashion designs because of the very rapid turnover of trends from season to season.<sup>23</sup>

Trademarks and trade dress are also not an adequate solution for fashion designs. Trademarks apply only to the name or logo of the designer, but not to the design itself.<sup>24</sup> Under the Lanham Act, trademark protection applies to “any word, name, symbol, device or any combination thereof” that is used by the trademark holder “to identify and distinguish his or her goods . . . from those manufactured or sold by others.”<sup>25</sup> Thus, a designer or

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17. More than seventy bills for fashion design copyright protection have been presented to Congress, but all have failed. Emma Yao Xiao, *The New Trend: Protecting American Fashion Designs Through National Copyright Measures*, 28 CARDOZO ARTS & ENT. L.J. 417, 432 (2010).

18. Lynsey Blackmon, *The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion*, 35 PEPP. L. REV. 107, 120 (2007).

19. 35 U.S.C. § 173 (2006).

20. Xiao, *supra* note 17, at 429 (citing 35 U.S.C. § 271).

21. 35 U.S.C. § 171 (2006).

22. Laura C. Marshall, *Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Digital Piracy Prohibition Act*, 14 J. INTELL. PROP. L. 305, 311–12 n.35 (2007).

23. Xiao, *supra* note 17, at 431.

24. Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & TECH. 251, 277 (2011).

25. 15 U.S.C. § 1127 (2006).

brand's logo is protected, but the overall design of an item is not.<sup>26</sup> Accordingly, protection under trademark law prohibits someone from placing a designer's logo on an item or from copying an item that has the designer's logo, but what about items that do not incorporate the logo into their design, or brands that do not have logos at all? Although there are many fashion designers and brands that rely on their instantly recognizable logos, such as Chanel's interlocking C's<sup>27</sup> or Louis Vuitton's "LV" monogram,<sup>28</sup> there are far more designers, especially smaller brands, that do not. Proenza Schouler's PS1 does not contain a visible mark, nor does it display the brand's name other than on a small hanging tag.<sup>29</sup> What distinguishes the bag is its design—which does not earn protection under trademark law.<sup>30</sup> Although some may argue that an easy solution for brands such as Proenza Schouler is to simply create a logo and incorporate it in their designs, to compel such a requirement not only puts more of a burden on the creative process,<sup>31</sup> it does not address the root of the matter. Counterfeiting is a huge problem,<sup>32</sup> and while trademark law does provide protection against it,<sup>33</sup> it is not just their brand names or logos that designers are trying to protect—they are seeking protection for their creations, and trademark law, for most designs, does not provide what they need.<sup>34</sup>

Trade dress, on the other hand, does protect the appearance of an article,<sup>35</sup> but in order for the protection to apply, the article must be so distinctive that it has become well recognized by consumers as being associated with its brand.<sup>36</sup> This requires the item to be in the marketplace

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26. Xiao, *supra* note 17, at 430.

27. CHANEL, <http://www.chanel.com/fashion/#8-bags-chanel-accessories-1> (last visited Aug. 25, 2012).

28. LOUIS VUITTON, [http://www.louisvuitton.com/front/#/eng\\_US/Collections/Women/Icons](http://www.louisvuitton.com/front/#/eng_US/Collections/Women/Icons) (last visited Aug. 25, 2012).

29. *Proenza Schouler PS1—Shop Online*, PROENZA SCHOULER, <http://www.proenzaschouler.com/shop/ps1/medium-1/ps1-medium-leather-23.html?color=Black> (last visited Aug. 25, 2012).

30. Ferrill & Tanhehco, *supra* note 24.

31. Xiao, *supra* note 17, at 430–31.

32. Counterfeiting results in estimated losses of billions of dollars per year. Beltrametti, *supra* note 16, at 150.

33. See 18 U.S.C. § 2320(a), (e)(1) (2006).

34. Not even Louis Vuitton is fully protected: its "Murakami" bag consisted of the LV monogram in several bright colors over a white background. Dooney & Bourke later released their "It-Bag," which contained the Dooney & Bourke monogram in similar bright colors, also on a white background and made of similar materials. The District Court found that the bags were not "confusingly similar" and, therefore, there was no infringement. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415 (S.D.N.Y. 2004). However, on appeal, the appellate court remanded to the trial court on the issue of likelihood of confusion, but the trial court did not directly address it. See Sara R. Ellis, *Copyrighting Couture: An Examination of Fashion Design Protection and Why the DPPA and IDPPPA are a Step Towards the Solution to Counterfeit Chic*, 78 TENN. L. REV. 163, 175 n.129 (2010) (citing *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 500 F. Supp. 2d 276 (S.D.N.Y. 2007)).

35. Blackmon, *supra* note 18, at 124 ("[T]he doctrine of trade dress has the potential to protect replicas of designer apparel without the logo affixed.").

36. Ferrill & Tanhehco, *supra* note 24.

for a significant period of time, perhaps several years, which does little to protect newer brands or smaller designers who do not have a broad market reach. Additionally, the Supreme Court has held that “design, like color, is not inherently distinctive” for the purposes of trade dress protection because the purpose of an item’s design is to make it more useful, not to indicate its source.<sup>37</sup>

Copyright law in the United States arises out of Article I, Section 8, Clause 8 of the Constitution, which gives Congress the power to grant copyrights to “Authors and Inventors” for “their respective Writings and Discoveries” for the purpose of promoting the “Progress of Science and useful Arts.”<sup>38</sup> Although the language of the clause would appear to incorporate fashion designs under copyright protection, they are excluded from the Copyright Act because of their characterization as being “useful”—the Act protects “useful article[s],” but only their elements “that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”<sup>39</sup> Unfortunately, it is nearly impossible to separate the utilitarian aspects of fashion designs from their non-useful elements that would be entitled to protection because the two tend to be one and the same—articles of clothing are deemed useful because they protect the body and keep it warm,<sup>40</sup> but it is the design of the articles themselves that require copyright protection.

Without copyright protection, the fashion industry and its members suffer constant economic losses.<sup>41</sup> Fashion in the United States is a \$350 billion industry.<sup>42</sup> As such, it is a vital portion of our nation’s economy and commerce; and yet, by not protecting the industry’s assets—its products—American businesses lose up to approximately \$250 billion per year.<sup>43</sup> As articulated above by Mr. McCullough, many consumers are likely to buy the cheaper copy than the designer original if given the opportunity.<sup>44</sup> Allen Schwartz, a designer whose business specializes in producing knockoffs of dresses worn by celebrities to red carpet events, has said, “If [you] can put a well-made, great-looking suspender pant in a store for \$190 and it’s sitting 20 feet away from a similar suspender pant by Donna Karan that retails for

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37. Susanna Monseau, *European Design Rights: A Model for the Protection of All Designers from Piracy*, 48 AM. BUS. L.J. 27, 46 (2011) (citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212, 213 (2000)).

38. U.S. CONST. art. I, § 8, cl. 8.

39. 17 U.S.C. § 101 (2006) (defining “pictorial, graphic, and sculptural works”); see C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1185 (2009).

40. Beltrametti, *supra* note 16, at 153.

41. See Blackmon, *supra* note 18, at 109 n.5.

42. *A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Prop. of the H. Comm. on the Judiciary*, 109th Cong. 11 (2006).

43. Blackmon, *supra* note 18, at 109 n.5.

44. See *supra* pp. 1–2.

\$450, which do you think the average consumer is going to want?”<sup>45</sup> While it may be true that in cases of a large disparity in price between original and copy—a \$3,000 designer dress versus a \$50 copy, for example—it is unlikely the designer suffers a loss because the purchaser of the copy probably would not have been a customer of the designer anyway; rather, it is the mid-level designers that have the most complaints of instances of design copying.<sup>46</sup> A dress made by Foley & Corinna that retailed for only a few hundred dollars was copied by Forever 21, and the existence of the copy caused Foley & Corinna to suffer reduced sales.<sup>47</sup> One customer, who had spent more than \$1,200 for four of the dresses to be worn by bridesmaids in her wedding, returned them after seeing the copies in Forever 21 for \$40 each.<sup>48</sup> Designer Anna Corinna stated, “When one of our designs gets knocked off, the dress is cheapened—customers won’t touch it.”<sup>49</sup> Similar cases have been reported by other designers, such as a handbag designer who sold her bags for \$130, only to find that one customer did not purchase one because Abercrombie & Fitch was selling an identical one for \$30,<sup>50</sup> and a scarf designer whose retailer stopped renewing its order of her \$190 silk scarves when it found knockoffs available for \$10.<sup>51</sup> Such cases have grown so prevalent that Alexis Bittar, who won the highly prestigious CFDA Award for Accessory Designer of the Year in 2010, notably commented, “When I won the award, I thought, great, this is like I’m declaring I’m someone to knock off.”<sup>52</sup>

The lack of protection not only affects designers, but customers as well. When The Row, a design label owned and run by Mary-Kate and Ashley Olsen, debuted its first line of handbags last year, one of the most noteworthy pieces in the collection was an alligator backpack with a \$35,000 price tag.<sup>53</sup> To the surprise of many, the backpack was the first in the collection to sell out, despite its hefty price.<sup>54</sup> Now, imagine if you were

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45. Blackmon, *supra* note 18, at 119.

46. Hemphill & Suk, *supra* note 39, at 1176.

47. *Id.* at 1175.

48. Maggie Overfelt, *When Piracy is Legal*, CNNMONEY BLOG (Apr. 28, 2008, 9:20 AM), [http://money.cnn.com/2008/04/23/smbusiness/whos\\_stealing\\_piracy\\_legal.fsb/index.htm](http://money.cnn.com/2008/04/23/smbusiness/whos_stealing_piracy_legal.fsb/index.htm).

49. *Id.*

50. Ellis, *supra* note 34, at 188.

51. *Id.*

52. Susan Berfield, *Forever 21’s Fast (and Loose) Fashion Empire*, BUSINESSWEEK (Jan. 19, 2011), <http://www.businessweek.com/stories/2011-01-19/forever-21s-fast-and-loose-fashion-empire>.

53. Nicole Phelps, *Calling All Glam Backpackers: The Row’s Bags Arrive at Barneys*, STYLE (July 14, 2011), [http://www.style.com/peopleparties/parties/scoop/newyork-071411\\_The\\_Row\\_Handbags\\_Party/](http://www.style.com/peopleparties/parties/scoop/newyork-071411_The_Row_Handbags_Party/). The backpack has also been listed in some places with a price of \$39,000. Hilary Moss, *The Row Backpack Rings in at \$35,000*, HUFFINGTON POST (July 15, 2011, 7:30 PM), [http://www.huffingtonpost.com/2011/07/15/the-row-backpack\\_n\\_900040.html](http://www.huffingtonpost.com/2011/07/15/the-row-backpack_n_900040.html).

54. Ellie Krupnick, *The Row’s \$39,000 Alligator Backpack Sold Out*, HUFFINGTON POST (Oct. 3, 2011, 7:14 PM), [http://www.huffingtonpost.com/2011/10/03/the-row-backpack-sold-out\\_n\\_992606.html](http://www.huffingtonpost.com/2011/10/03/the-row-backpack-sold-out_n_992606.html).

one of the lucky few to have spent the equivalent of some people's yearly salary on the backpack, only to discover not too much later that someone else was selling an exact replica—or, at least, a replica similar enough to be mistaken for the real thing—for a much lower price that many more people could afford.<sup>55</sup> What was once a unique prized possession becomes commonplace and not nearly as extraordinary. In this way, the lack of copyright protection over designs also hurts the consumer. To some, purchasing articles from designer labels is equally a matter of status as it is substance—a consumer may shop from a certain label because he or she likes the style, but also enjoys the elite privilege of wearing a certain designer's creation. Accordingly, the consumer is willing to pay a higher price for the privilege, essentially paying to become a member of an exclusive “club” of a luxury brand. A certain bag, coat, or pair of shoes can be as much of a status symbol as a car or a house,<sup>56</sup> and in rare cases like The Row's backpack, can cost just as much.<sup>57</sup> When such items lose their exclusive appeal, they lose their value to the consumer, who may think twice about purchasing them. In turn, the designer once again suffers the consequences.

Along with substantial economic consequences, the lack of protection has other pitfalls. Perhaps most importantly is the effect it has on designer innovation and creation.<sup>58</sup> There are plenty of those who may think that fashion designs do not deserve protection because fashion is “just clothes,” meant merely to cover the body, and therefore not entitled to the same protection afforded to works of art, music pieces, or films.<sup>59</sup> Such a statement is akin to saying that paintings are nothing more than wall coverings, or a sculpture by Michelangelo is nothing more than a hat rack. Just because these works may also serve such functions does not take away their copyright protection, and just because fashion can be used functionally should not entirely bar it from protection either. Anyone who says fashion is not art has never seen a work of couture,<sup>60</sup> or anything from Alexander McQueen's Spring/Summer 2010<sup>61</sup> or Marchesa's Fall 2011 collection.<sup>62</sup>

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55. To the best of this author's knowledge, the backpack has not been copied—yet.

56. “Status handbags, you see, are a lot like housing. After the rise of the \$1,000 purse, fashion's equivalent of the \$1 million studio, there inevitably comes talk of a backlash.” Eric Wilson, *Is this It for the It Bag?*, N.Y. TIMES, Nov. 1, 2007, <http://www.nytimes.com/2007/11/01/fashion/01BAGS.html>.

57. The starting price for a 2012 BMW 135i coupe is \$39,300. BMW, <http://www.bmwusa.com/standard/content/vehicles/2012/1/135icoupe/default.aspx> (last visited Aug. 25, 2012).

58. Hemphill & Suk, *supra* note 39, at 1176.

59. *Id.* at 1162.

60. Works from couture collections are often displayed in art museums around the world. See Harold Koda & Richard Martin, *Haute Couture*, METRO. MUSEUM ART, [http://www.metmuseum.org/toah/hd/haut/hd\\_haut.htm](http://www.metmuseum.org/toah/hd/haut/hd_haut.htm) (last visited Aug. 25, 2012); *The Golden Age of Couture*, V&A, [http://www.vam.ac.uk/vastatic/microsites/1486\\_couture/index.php](http://www.vam.ac.uk/vastatic/microsites/1486_couture/index.php) (last visited Nov. 9, 2012).

61. See *Look 25—Spring 2010 Ready to Wear: Alexander McQueen*, STYLE.COM, <http://www.style.com/fashionshows/detail/slideshow/S2010RTW-AMCQUEEN/#86> (last visited



Nonetheless, like fine art, fashion has its levels of sophistication and complexity. Who hasn't looked at the splattered paintings of Jackson Pollock<sup>63</sup> or Mark Rothko's simple painted rectangles<sup>64</sup> and thought, "I could do that"? In this vein, people vary in their judgment of the artistic value afforded to some works over others, but this difference in opinion is still an opinion—even if it may be shared by the masses—and a judgment of low artistic value does not equate to a lower entitlement of copyright protection. There are no varying levels of protection, only the presence of protection or a lack thereof,<sup>65</sup> and seeing one work as more deserving over another does not equate to the latter being denied protection. Put another way, one may think that a top hit on the radio is not "good" music, but that does not mean that the song does not deserve the same protection enjoyed by other music.

The same should be true for fashion. Although the McQueen and Marchesa examples provided above may seem more similar to works of art than, say, a sweater or a pair of pants, it does not and should not result in one receiving protection while the others do not.<sup>66</sup> If a designer knows that his creations are going to be copied, he is inclined to put less effort and creativity into the articles that he produces.<sup>67</sup> Putting one's blood, sweat, and tears into a project is less enticing when someone else can copy it with no repercussions. However, the security that copyright protection provides would serve to incentivize designers to create, thus providing benefits to

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Nov. 15, 2012); *see also* *Look 40—Spring 2010 Ready to Wear: Alexander McQueen*, STYLE.COM [http://www.style.com/fashionshows/complete/slideshow/S2010RTW-AMCQUEEN?event=show1982&designer=design\\_house43&trend=&iphoto=39#slide=39](http://www.style.com/fashionshows/complete/slideshow/S2010RTW-AMCQUEEN?event=show1982&designer=design_house43&trend=&iphoto=39#slide=39) (last visited Nov. 15, 2012). Selections from the Spring/Summer collection were included among other McQueen designs in a four-month exhibit at The Metropolitan Museum of Art in 2011. *Alexander McQueen: Savage Beauty*, THE METROPOLITAN MUSEUM OF ART, <http://blog.metmuseum.org/alexandermcqueen/about/> (last visited Nov. 15, 2012).

62. *See Look 26—Fall 2011 Ready to Wear: Marchesa*, STYLE.COM, [http://www.style.com/fashionshows/complete/slideshow/F2011RTW-MARCHESA?event=show2262&designer=design\\_house982&trend=&iphoto=25#slide=25](http://www.style.com/fashionshows/complete/slideshow/F2011RTW-MARCHESA?event=show2262&designer=design_house982&trend=&iphoto=25#slide=25) (last visited Oct. 9, 2012); *see also* *Look 23, Fall 2011 Ready to Wear: Marchesa*, STYLE.COM, [http://www.style.com/fashionshows/complete/slideshow/F2011RTW-MARCHESA?event=show2262&designer=design\\_house982&trend=&iphoto=22#slide=22](http://www.style.com/fashionshows/complete/slideshow/F2011RTW-MARCHESA?event=show2262&designer=design_house982&trend=&iphoto=22#slide=22) (last visited Oct. 9, 2012). "The labor that goes into [these dresses]—hand-draped fabric, hand-affixed stones, hand beading, hand embroidery, probably even hand tattering—is so intense that they're more like individual productions than mere clothing." Emily Holt, *Review: Marchesa Fall 2011 Ready-to-Wear*, VOGUE ONLINE, <http://www.vogue.com/collections/fall-2011/marchesa/review/> (last visited Nov. 15, 2012).

63. *See* Jackson Pollock, *Number 1, 1950 (Lavender Mist)*, NAT'L GALLERY OF ART, available at <http://www.nga.gov/feature/pollock/painting1.shtm>.

64. *See* Mark Rothko, *No. 4, 1964*, NAT'L GALLERY OF ART, available at <http://www.nga.gov/feature/rothko/late2.shtm>.

65. *See* 17 U.S.C. § 102 (2006) (stating what works are covered by copyright protection).

66. That is, so long as the sweater and pair of pants meet the standard for "original" and "distinctive" as provided for in existing copyright law. 17 U.S.C. § 1301(a).

67. Hemphill & Suk, *supra* note 39, at 1176.

consumers and industry as a whole by placing more innovative and original designs on the market.<sup>68</sup>

The lack of copyright protection also distorts innovation.<sup>69</sup> Designers that have been granted trademark or trade dress protection tend to favor designs that utilize these protections, thereby resulting in a proliferation of designs containing a brand's logo.<sup>70</sup> One only needs to look at the present and past collections of Louis Vuitton handbags to see how heavily the brand utilizes its trademark protection.<sup>71</sup> If a brand "can prohibit copies of designs that employ its trademark . . . but not a similar work that lacks the logos, it has an incentive to employ the logo."<sup>72</sup> Although such behavior is done to protect the economic interest of the brand, it does so at the expense of innovation within the industry.<sup>73</sup> By limiting themselves to logo-heavy articles, designers put a self-imposed cap on their creativity, resulting in fashion becoming less about self-expression and more about brand advertisement: "Such 'logoification' affects the communicative vocabulary that fashion provides, pulling fashion toward a status-conferring function and away from the communication of diverse messages."<sup>74</sup> Thus, without copyright protection, designers, consumers, and the industry itself suffer the consequences.

## B. THE DPPA

For almost one hundred years, Congress has been presented with over seventy bills proposing various forms of copyright protection for fashion designers.<sup>75</sup> None of the bills were successfully passed,<sup>76</sup> and other efforts to give designers copyright protection have failed as well.<sup>77</sup> The Design Piracy Prohibition Act (DPPA) was introduced to Congress three times, once in 2006 and 2007, and again in 2009.<sup>78</sup> The bill never made it further than the House Committee on the Judiciary, but it gained support and additional sponsors as it progressed.<sup>79</sup> The DPPA would have provided

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68. *Id.* at 1177.

69. *Id.* at 1176.

70. *See id.* at 1177.

71. *See* LOUIS VUITTON, [http://www.louisvuitton.com/front/#/eng\\_US/Collections/Women/Handbags](http://www.louisvuitton.com/front/#/eng_US/Collections/Women/Handbags) (last visited Oct. 9, 2012).

72. Hemphill & Suk, *supra* note 39, at 1177.

73. *Id.* at 1177–78.

74. *Id.* at 1178.

75. Xiao, *supra* note 17, at 432.

76. *Id.*

77. Blackmon, *supra* note 18, at 129–30. The Fashion Originator's Guild of America, in 1935, required members to swear against selling copied designs. At one point, it controlled a majority of the women's clothing market, until it was struck down by the Supreme Court for violating the Sherman Anti-Trust Act; it shut down soon after. *Id.*

78. Ellis, *supra* note 34, at 183–84.

79. *Id.* at 184. The last incarnation of the DPPA, in 2009, had twenty-three sponsors, more than the two previous versions. *Id.*

protection under 17 U.S.C. § 1301<sup>80</sup> for designs of “apparel,”<sup>81</sup> which would be protected under the DPPA so long as they were “original.”<sup>82</sup> Additionally, under a DPPA provision amending § 1310, each design was only entitled to protection if it was successfully registered with the Copyright Office.<sup>83</sup> If protection was granted, it would last for three years,<sup>84</sup> and the design would be recorded in a freely and publicly searchable electronic database.<sup>85</sup> With regard to “infringing article[s],”<sup>86</sup> the DPPA provided three exceptions: (1) where the design is original and “not closely and substantially similar in overall visual appearance to a protected design”; (2) if the design is simply reflecting a current trend; and (3) if the design is a “result of independent creation.”<sup>87</sup> Damages for infringement could be up to \$250,000,<sup>88</sup> but it provided protection against liability if the alleged infringer had no knowledge that the design was under copyright protection.<sup>89</sup> Although the DPPA was endorsed by the Council of Fashion Designers of America (CFDA), it was opposed by the American Apparel & Footwear Association (AAFA).<sup>90</sup> One of the main concerns and criticisms surrounding the DPPA was the potential for an influx of frivolous lawsuits due to the vague “substantial similarity” standard.<sup>91</sup> Although supporters of the DPPA provided evidence from Europe, where similar copyright protections have been put in place without an accompanying influx,<sup>92</sup> this was not enough to keep the bill moving forward.<sup>93</sup>

The other fatal flaw of the DPPA was its registration requirement. It mandated that a design be registered within six months of when it was made

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80. H.R. 2196, 111th Cong. § 2(a)(1) (2009).

81. *Id.*; Monseau, *supra* note 37, at 51.

82. “Original” is defined as “the result of the designer’s creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.” 17 U.S.C. § 1301(b)(1) (2006).

83. H.R. 2196, § 2(f)(1).

84. *Id.* § 2(d); *see* Blackmon, *supra* note 18, at 136.

85. H.R. 2196, § 2(j).

86. “Infringing article[s]” were defined as those “the design of which has been copied from a design protected under this chapter.” *Id.* § 2(e).

87. *Id.*; *see also* Xiao, *supra* note 17, at 433.

88. This figure does not include compensation for any lost profits and attorney’s fees, which also would have been recoverable. Blackmon, *supra* note 18, at 137–38.

89. 17 U.S.C. § 1309(c) (2006).

90. Louis S. Ederer & Maxwell Preston, *The Innovative Design Protection and Piracy Prevention Act—Fashion Industry Friend or Faux?*, LEXISNEXIS CMTY. COPYRIGHT & TRADEMARK L. (Jan. 31, 2011, 5:47:00 AM), <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>.

91. Ashley Froese, *Update from the IDPPPA Trenches: Interview with US Fashion Attorney Charles Colman*, CANADA FASHION L., <http://canadafashionlaw.blogspot.com/2011/07/update-from-idpppa-trenches-interview.html> (last visited Oct. 7, 2012).

92. In the Courts of Appeal of France in 2005, only ten out of 308 infringement cases were related to registered fashion designs. *Stop Fashion Piracy*, ARTS FASHION FOUND., <http://www.arts-of-fashion.org/stopdesignpiracy.html> (last visited Aug. 26, 2012).

93. Ederer & Preston, *supra* note 90.

public,<sup>94</sup> and in order to register, the designer had to submit a “brief description of the design” so that, if the design was approved by the Copyright Office as being sufficiently “original,” it could be added to an electronic searchable database that would be free and open to the public.<sup>95</sup> Opposition to the registration requirement was primarily based on the role of the Copyright Office: concern over its capacity to judge aesthetics<sup>96</sup> and a potentially unmanageable flood of applications.<sup>97</sup> Additionally, some worried that the registration requirement would favor large design houses at the expense of smaller designers, because larger companies, with the help of savvy attorneys, would be inclined to register a number of designs that were not especially original just because they could, while smaller designers would have to struggle to innovate without the fear of an impending lawsuit.<sup>98</sup> Although many designers, alongside the CFDA, endorsed the DPPA, the conflicts over the registration requirement and other provisions combined with opposition by the AAFA kept it from moving forward in Congress.<sup>99</sup>

### C. THE IDPPPA

In August of 2010, after the CFDA and AAFA were finally able to reconcile their differences, Senator Schumer and ten other co-sponsors introduced to the Senate the Innovative Design Protection and Piracy Prevention Act (IDPPPA).<sup>100</sup> The IDPPPA retained some of the features of the DPPA, such as the three-year time period for protection, the “originality plus novelty” standard for qualifying for protection,<sup>101</sup> and the exemption for items that are the “the result of independent creation.”<sup>102</sup>

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94. H.R. 2196, 111th Cong. § 2(f)(1) (2009).

95. *Id.* § 2(f)(3), (j). Under existing copyright law, if the Copyright Office denies the request for registration, the applicant is permitted to submit an appeal within three months, and if rejected again, could request judicial review. *See* 17 U.S.C. §§ 1313(b), 1321(b) (2006). Under the DPPA, fashion designs were included under the “Designs Protected” for the purposes of the appeals process. *See* H.R. 2196, § 2(a).

96. “[D]etermining the aesthetic as opposed to the functional in an item of clothing is arguably much more difficult and much more subjective than in matters concerning boat hulls or lamps or other such subject matter.” *Analysis of The Design Piracy Prohibition Act (H.R. 2033/S. 1957); Introduced in the 109th Congress*, LEXISNEXIS CMTY. COPYRIGHT & TRADEMARK L. (June 3, 2008, 2:21:47 PM), [http://www.lexisnexis.com/community/copyright-trademarklaw/blogs/fashionindustrylaw/archive/2008/06/03/analysis-of-the-design-piracy-prohibition-act-\\_2800\\_h.r.-2033\\_2f00\\_s.-1957\\_29003b00\\_-introduced-in-the-109th-congress.aspx](http://www.lexisnexis.com/community/copyright-trademarklaw/blogs/fashionindustrylaw/archive/2008/06/03/analysis-of-the-design-piracy-prohibition-act-_2800_h.r.-2033_2f00_s.-1957_29003b00_-introduced-in-the-109th-congress.aspx).

97. Ederer & Preston, *supra* note 90.

98. Monseau, *supra* note 37, at 54.

99. Ederer & Preston, *supra* note 90.

100. *Id.*

101. Susan Scafidi, *IDPPPA: Introducing the Innovative Design Protection and Piracy Prevention Act, a.k.a. Fashion Copyright*, COUNTERFEIT CHIC (Aug. 6, 2010), <http://counterfeitchic.com/2010/08/introducing-the-innovative-design-protection-and-piracy-prevention-act.html>.

102. IDPPPA, H.R. 2511, 112th Cong. § 2(e)(2) (2011).

However, it was the substantial changes from the DPPA that made the IDPPPA matter. First, it defined an “original” design as a “unique, distinguishable, non-trivial, and non-utilitarian variation over prior designs.”<sup>103</sup> It also defined the standard of infringement as being “substantially identical,” instead of “substantially similar.”<sup>104</sup> “Substantially identical” means that the article is “so similar in appearance as to be likely to be mistaken for the protected design” and that the only differences between the two are slight enough to be considered “trivial.”<sup>105</sup> The IDPPPA also removed the registration requirement.<sup>106</sup> However, perhaps the most notable difference was the heightened pleading standard for plaintiffs claiming infringement on their design, which requires them to show that their design is original and thus qualified for protection,<sup>107</sup> that the allegedly infringing article is substantially identical to the protected design, and that the defendant had access to or was aware of the protected design.<sup>108</sup> By adding the heightened pleading standard, along with more specific definitions of originality and infringement, the IDPPPA not only provided a more narrow applicability of the bill but also allayed many of the concerns that surrounded the DPPA.<sup>109</sup>

With the combined endorsement of the CFDA and the AAFA, the IDPPPA was enthusiastically received within the fashion industry,<sup>110</sup> but was also received with a fair amount of criticism.<sup>111</sup> However, many of the bill’s critics based their opposition not on the bill itself, but on the theory that fashion designs do not deserve copyright protection in the first place because design piracy and copying promotes innovation, thus benefitting the fashion industry.<sup>112</sup> Both critics and supporters of the bill have stated that because of its narrow tailoring, only a small number of designs will qualify for protection.<sup>113</sup> Other critics claimed that the bill’s heightened standard of pleading will not deter a flood of frivolous lawsuits.<sup>114</sup> Despite

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103. *Id.* § 2(a)(2).

104. *Id.*; H.R. 2196, 111th Cong. § 2(e) (2009).

105. IDPPPA, H.R. 2511, § 2(a)(2).

106. Ederer & Preston, *supra* note 90.

107. IDPPPA, H.R. 2511, § 2(a)(2).

108. *Id.* § 2(g)(2)

109. See Froese, *supra* note 91; Ederer & Preston, *supra* note 90.

110. Ederer & Preston, *supra* note 90. The CFDA alone is made up of over four hundred designers of women’s and men’s apparel, jewelry, and accessories. *CFDA Members*, COUNCIL FASHION DESIGNERS AMERICA, <http://www.cfda.com/members> (last visited Aug. 26, 2012).

111. See Ederer & Preston, *supra* note 90.

112. See Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1717–34 (2006); Cherie Yang, *The IDPPPA: A Cure Worse Than Its Illness?*, COLUM. BUS. L. REV. ONLINE (Nov. 28, 2010), <http://cblr.columbia.edu/archives/11401>.

113. Froese, *supra* note 91.

114. Staci Riordan, *IDPPPA Will Not Prevent Frivolous Litigation*, FOX ROTHSCHILD: FASHION L. BLOG (Sept. 28, 2010), <http://fashionlaw.foxrothschild.com/2010/09/articles/fashion-law/idpppa-will-not-prevent-frivolous-litigation/>.

its critics and their arguments, which will be addressed later, the IDPPPA was largely well received<sup>115</sup> and in December 2010, the Senate Committee on the Judiciary voted unanimously for the bill to proceed to the Senate floor.<sup>116</sup> It was reported to the Senate, but Congress adjourned before the bill came to a vote.<sup>117</sup> In July 2011, the IDPPPA was introduced to the House of Representatives by Rep. Bob Goodlatte<sup>118</sup> and was referred to the House Committee on the Judiciary.<sup>119</sup> In October 2011, it was endorsed by the U.S. Chamber of Commerce.<sup>120</sup> Rep. Goodlatte, along with the entire House Judiciary Committee, received a letter from the Chamber's executive vice president of government affairs voicing support for the bill, commending its capacity for providing adequate protection for fashion designs while precluding unnecessary lawsuits and additional burdens and deterring design piracy.<sup>121</sup> However, although such an endorsement seemed like a good sign for its likelihood to move forward, the bill languished after being referred to the Subcommittee on Intellectual Property, Competition, and the Internet at the end of August 2011.<sup>122</sup>

#### D. THE IDPA

The IDPA is largely the same as the IDPPPA, but includes some notable additions. Most significantly, it adds a notice provision very similar to the "take-down notices" that were implemented in the Digital Millennium Copyright Act<sup>123</sup>: if a designer whose design is entitled to copyright protection wants to bring a claim against an alleged infringer, he or she must first send them written notice that includes, among other

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115. "For years, fashion designers have been wishing, hoping, praying, lobbying for better copyright protection for their designs. Well, on [December 1st, 2010], the industry got a leg up in its long quest, when the Senate Judiciary Committee unanimously passed the Innovative Design Protection and Piracy Prohibition Act . . ." Vanessa O'Connell, *Project Copyright! Bill Giving IP Protection to Fashion Moves Forward*, WALL ST. J. LAW BLOG (Dec. 1, 2010, 5:56 PM), <http://blogs.wsj.com/law/2010/12/01/project-copyright-bill-giving-ip-protection-to-fashion-moves-forward/>.

116. Ellis, *supra* note 34, at 184.

117. *Id.*

118. 157 CONG. REC. E1314 (2011) (statement of Rep. Goodlatte), 157 Cong Rec E 1314 (LEXIS).

119. *112 Bill Tracking H.R. 2511*, LIBRARY OF CONG., <http://thomas.loc.gov/cgi-bin/bdquery/z?d112:HR02511:@@X> (last visited Jan. 29, 2013).

120. See Letter from R. Bruce Josten, Exec. Vice President of Gov't Affairs, U.S. Chamber of Commerce, to Bob Goodlatte, Chairman of the Subcommittee on Intellectual Property, Competition and the Internet, U.S.H.R. (Oct. 12, 2011), available at [http://www.counterfeitchic.com/Images/US\\_Chamber\\_letter\\_10-12-11.pdf](http://www.counterfeitchic.com/Images/US_Chamber_letter_10-12-11.pdf)

121. See *id.*

122. Cf. *112 Bill Tracking H.R. 2511*, LIBRARY OF CONG., <http://thomas.loc.gov/cgi-bin/bdquery/z?d112:HR02511:@@X> (last visited Jan. 29, 2013).

123. The Act provided liability exemptions for Internet service providers for transmitting or storing infringing material so long as they removed the material upon receiving notice from the copyright holder. See 17 U.S.C. § 512(c) (2010).

things,<sup>124</sup> a description of the protected design, a description of the allegedly infringing design, and the time in which the protected design became public so that access by the infringer could be presumed. The designer cannot commence an infringement action without sending notice, and in fact must wait twenty-one days after notice has been delivered to the alleged infringer before commencing the action.<sup>125</sup> The twenty-one day provision provides an opportunity for the matter to be settled without going to court, as the infringement action cannot be filed until the end of the twenty-one day period.<sup>126</sup> If settled in this manner, the defendant will not be liable for damages or profits accrued during the twenty-one day period.<sup>127</sup>

## II. WHAT THE IDPA MEANS FOR THE FASHION INDUSTRY

### A. IN THE DIGITAL AGE

Much like the piracy of music and films, the prevalence and convenience of the Internet has made copying fashion designs easier than ever before.<sup>128</sup> However, instead of albums and movies being illegally uploaded or downloaded online, fashion shows can be streamed online up to the minute, and websites such as Vogue.com and Style.com have photos of each runway look immediately after or within a few hours of each show.<sup>129</sup> There is also the recent addition within the last few seasons of show attendees themselves taking photos during the show and uploading them using social media such as Twitter, Facebook, and Instagram.<sup>130</sup> This is all is completely legal—it is only after the images are uploaded that the pseudo-illegal activity begins.<sup>131</sup> With the photos being accessible on the Internet by anyone all over the world, an image can be immediately sent to a factory that uses software to translate the design into a pattern, which is then mass produced and in stores for a fraction of the price of the original,

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124. Notice must also include the date when the protection began, specify how the design is entitled to protection under the IDPA, and how the alleged copy infringed under the standards of the IDPA. IDPA, S. 3523, 112th Cong. § 2(e) (2012).

125. *Id.* § 2(e).

126. *Id.*

127. *Id.*

128. Hemphill & Suk, *supra* note 39, at 1171.

129. See NOWFASHION, <http://nowfashion.com> (last visited Aug. 26, 2012); VOGUE ONLINE, <http://www.vogue.com/collections/> (last visited Aug. 26, 2012); STYLE, <http://www.style.com/fashionshows/> (last visited Aug. 26, 2012).

130. Lauren Indvik, *How Social Media is Transforming Fashion Week Coverage*, MASHABLE (Sept. 14, 2011), <http://mashable.com/2011/09/14/social-media-fashion-week-journalism/>; Stephanie Rosenbloom, *Following Fashion Week on Twitter*, N.Y. TIMES ON RUNWAY BLOG (Sept. 7, 2011, 1:59 PM), <http://runway.blogs.nytimes.com/2011/09/07/following-fashion-week-on-twitter/>; Elizabeth Holmes, *Style as Seen Through Rose-Colored iPhone App*, WALL ST. J. (Sept. 14, 2011), <http://online.wsj.com/article/SB10001424053111904265504576568582607940162.html>.

131. *Analysis of the Design Piracy Prohibition Act (H.R. 2033/S. 1957); Introduced in the 109th Congress*, *supra* note 96.

weeks or months before the original is available for purchase.<sup>132</sup> In addition to these “fast-fashion” copies being made at a very low cost, the speed at which they can be mass produced has another advantage: those producing the copies can wait and see which designs are popular and produce a copy and have it on the market before the popularity wanes.<sup>133</sup> Forever 21, “the most notorious copyist retailer,” has been faced with fifty-three suits for copyright or trademark infringement between 2003 and 2008.<sup>134</sup> In the realm of shoes, Jeffrey Campbell and ALDO are also well versed in the field of “fast-fashion” copying,<sup>135</sup> but interestingly, Jeffrey Campbell recently sued Forever 21 for infringement.<sup>136</sup>

As mentioned above, the use and ease of the Internet has increased the volume of fashion design copying and piracy, much like it has for music and film.<sup>137</sup> However, unlike those who engage in music and film piracy, those who use the Internet to facilitate fashion design piracy do not face punishment because there is no copyright protection for fashion designs.<sup>138</sup> Another key difference between piracy of film and music versus fashion design is that songs and movies are digitalized, so that the actual copyrighted material can be compressed into a file such as an MP3 and shared over the Internet.<sup>139</sup> Not so with fashion designs: no one is sending actual couture gowns or shoes via digital data over the World Wide Web. The Internet is used only as a means to facilitate and accelerate the act of piracy, but is not the channel on which the pirated articles are transmitted, such as with pirated music and movies.<sup>140</sup> Thus, it is more difficult to monitor and quantify the amount of fashion design piracy that occurs generally, not to mention the piracy that occurs with the help of the Internet.

Despite these differences, the underlying truth remains that the Internet makes copying intellectual property easier for music, film, and fashion design, and the reason why all—not some—should be granted copyright

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132. *Id.*

133. Hemphill & Suk, *supra* note 39, at 1171.

134. *Id.* at 1172–73.

135. Ironically, ALDO released its own copy of a Jeffrey Campbell design. Melissa Chai, *This or That: Aldo vs. Jeffrey Campbell*, STYLEBOROUGH (Nov. 2, 2011), <http://www.styleborough.com/2011/11/this-or-that-aldo-vs-jeffrey-campbell.html>.

136. *Jeffrey Campbell Knocks Off Prada While Suing Forever 21 For Copyright Infringement*, DEMI COUTURE (June 16, 2011, 12:22 PM), <http://demicouture.ca/2011/06/16/jeffrey-campbell-knocks-off-prada-while-suing-forever-21-for-copyright-infringement/>.

137. “Some estimates already suggest that the increasing ease of use of sites that offer free downloads, along with more ad hoc file-sharing, is already costing filmmakers globally billions of pounds a year.” *Movie Piracy: We Need a Hi-Tech Solution to Illegal Downloads*, GUARDIAN (Mar. 12, 2011), <http://www.guardian.co.uk/commentisfree/2011/mar/13/film-piracy-illegal-downloads-internet>.

138. *See supra* pp. 3–5.

139. Hemphill & Suk, *supra* note 39, at 1195.

140. *See id.* at 1171 (explaining the current common process of design piracy); Raustiala & Sprigman, *supra* note 112, at 1715.



protection remains the same: the “theory of incentives.”<sup>141</sup> Our legal system does not allow a person to photocopy an author’s book and sell it for his own personal economic gain, and it does not allow a person to obtain such copies for free or at a steep discount.<sup>142</sup> If it did, creators would have no incentive to continue creating.<sup>143</sup> This theory applies to all intellectual property, including fashion designs, and thus the same protection that applies to other works should apply to fashion designs as well. The IDPA provides that protection.

### B. ECONOMIC IMPACT

One of the major points of criticism of the IDPPPA, and inevitably the IDPA as well, is that it will do more harm than good. Professors Kal Raustiala and Chris Sprigman have been some of the most vocal critics of both bills, and of copyright protection for fashion design in general, based on their theory that copying and design piracy helps the fashion industry rather than harms it.<sup>144</sup> They argue that copying helps establish trends and then destroys them, resulting in trends having short lifespans, which then forces designers to continue to innovate.<sup>145</sup> However, their analysis is inaccurate in two ways, both of which illustrate a lack of understanding about how the fashion industry works. First, the credit given to copying is misplaced. It is not the copying that spurs innovation, but the nature of the industry—designers release multiple collections per year depending on the season<sup>146</sup> and each must be different, since what is popular for a spring/summer collection is likely not going to work for a winter collection. Designers draw inspiration from various sources, including the current societal climate<sup>147</sup> and the work of their peers—but they do not duplicate each others’ designs.<sup>148</sup>

Second, the prevalence of copying does not spur innovation; on the contrary, it hinders it.<sup>149</sup> When faced with the prospect that their design will be stolen immediately and used to yield profits for someone else before they even have a chance to put it on the market,<sup>150</sup> designers may ask

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141. Hemphill & Suk, *supra* note 39, at 1180.

142. *Id.*

143. *Id.*

144. See Raustiala & Sprigman, *supra* note 112.

145. *Id.* at 1722.

146. See generally VOGUE ONLINE, <http://www.vogue.com/collections/> (last visited Aug. 25, 2012) (containing all seasons’ collections from most high-fashion designers).

147. Hemphill & Suk, *supra* note 39, at 1158.

148. *Id.* at 1160–61.

149. *Id.* at 1160.

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Lazaro Hernandez, designer and a partner of Proenza Schouler, testified before the House Judiciary subcommittee in Intellectual Property, Competition and the Internet on behalf of the CFDA, outlining how his business has been damaged by copyists

themselves “why bother to create?”<sup>151</sup> Furthermore, when professors Raustiala and Sprigman claim that “some designers have lost sales to knockoffs, but the copying of designs has not been a serious threat to the survival of the industry,”<sup>152</sup> they casually gloss over a major point: that designers lose sales to knockoffs. What they fail to clarify is that while losing some sales to knockoffs may not substantially affect the business of a major design house or brand, it can be devastating for smaller and mid-level designers’ business.<sup>153</sup> Coco Chanel once said that “copying is the highest form of flattery.”<sup>154</sup> While such a statement may still be true today for a massive company like Chanel—that still has trademark protection to fall back on—Coco would likely not have the same opinion if she was a designer today. Technological advancements allowing for copying on a mass scale have turned it from a slight annoyance to something that could wipe out a designer’s entire business.<sup>155</sup> Additionally, if a designer, large or small, suffers losses great enough that they cannot cover their costs, they will be forced to charge consumers higher prices.<sup>156</sup>

Participation in fashion is inherently contradictory because it incorporates two social theories: differentiation and flocking.<sup>157</sup> Differentiation refers to the individual desire to express oneself as unique using fashion as a means of that expression.<sup>158</sup> However, fashion is implicitly collective in nature: it is a “group movement” that people choose to participate in because they desire to be part of a group, whether it be based on high fashion trends, fitting in with their peers, or simply partaking in a certain style they have seen and wish to emulate.<sup>159</sup> This “flocking,” paired with differentiation, drives trends and the fashion industry—although the two theories seem to be opposites, they become intertwined because people wish to differentiate themselves while flocking in order to maintain their individuality while still being part of a certain trend.<sup>160</sup> This theory of

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who are able to reproduce a runway design in a matter of a few days, before Proenza Schouler even receives its first order for the original design.

Julie Zerbo, *WWD on the IDPPPA*, FASHION LAW (July 18, 2011), <http://www.fashion-law.org/2011/07/wwd-on-idpppa.html>.

151. Beltrametti, *supra* note 16, at 163.

152. Kal Raustiala & Chris Sprigman, *Why Imitation is the Sincerest Form of Fashion*, N.Y. TIMES FREAKONOMICS BLOG (Aug. 12, 2010), <http://www.nytimes.com/2010/08/13/opinion/13raustiala.html>.

153. See *A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Prop. of the H. Comm. on the Judiciary*, 109th Cong. 14–16 (2006) (testimony of Jeffrey Banks, Fashion Designer).

154. Beltrametti, *supra* note 16, at 158.

155. *Id.*

156. *Id.* at 159.

157. Hemphill & Suk, *supra* note 39, at 1164.

158. *Id.*

159. *Id.*

160. *Id.* at 1165.

intertwinement is crucial in the fashion copyright context because it illustrates the difference between emulation through inspiration and straight copying.<sup>161</sup> This difference is what makes Raustiala and Sprigman's "copying drives innovation"<sup>162</sup> argument flawed. They incorrectly use the term "copying" as being interchangeable with "emulating"; or in other words, they treat differentiation and flocking as one and the same.

Furthermore, it is not just consumers that engage in these two patterns. It is undeniable that the fashion industry borrows from itself constantly—designers are often inspired by other designers,<sup>163</sup> whether it be from a prior season or from decades previous<sup>164</sup>—but there is a fine, yet very distinguishable line between "borrowing" or "being inspired by" and copying, and the existence of the former does not justify the permissibility of the latter.<sup>165</sup>

Some critics claim that the IDPA will result in lost jobs.<sup>166</sup> This claim is also mistaken. On the contrary, fast-fashion companies, such as Forever 21, or mass retailers, such as Target, will be forced to hire designers to create designs to take the place of the ones they would typically copy if they wish to keep their revenues up.<sup>167</sup>

### C. CURRENT CASES

Even if the IDPA does get passed and becomes law, the result of cases brought under it is still impossible to predict. We can only speculate how

People want to engage in flocking in a way that allows individual differentiation within it. They want to be part of a trend, but not be a replica of others who also join the trend. . . . Fashion consists of both human desires, to flock and to differentiate, in relation to each other.

*Id.*

161. *Id.* at 1166.

162. Raustiala & Sprigman, *supra* note 152.

163. See Hemphill & Suk, *supra* note 39, at 1160, 1168.

164. See *id.* at 1160 n.44; see Venessa Lau, *Can I Borrow That? When Designer "Inspiration" Jumps the Fence to Full-On Derivation, the Critics' Claws Pop Out*, W MAG. (Feb. 2008), [http://www.wmagazine.com/fashion/2008/02/fashion\\_derivations](http://www.wmagazine.com/fashion/2008/02/fashion_derivations) (noting examples of borrowing among designers, from current as well as older collections).

165. Hemphill & Suk, *supra* note 39, at 1153.

166. Staci Riordan, *The "Destruction of Affordable Fashion Bill" or IDPPPA Gets One Step Closer To Becoming Fashion Law*, FOX ROTHSCHILD: FASHION L. BLOG (Dec. 2, 2010), <http://fashionlaw.foxrothschild.com/2010/12/articles/design-piracy-prohibition-act/the-destruction-of-affordable-fashion-bill-or-idpppa-gets-one-step-closer-to-becoming-fashion-law/>.

167. When asked to address this criticism, Stephen Kolb, CEO of the CFDA replied,

I think it would have the opposite effect, in fact . . . because these places would have to hire more designers, it would create more potential jobs, if these types of places were forced to create their own designs. Places like Target, and Kohls, they're going to have to hire designers, and these days with so many kids wanting to go to fashion school and become designers, with Project Runway and everything else . . . they need jobs.

Interview with Stephen Kolb, CEO, CFDA, in N.Y., N.Y. (Dec. 6, 2011) (on file with author).

cases applying the bill will be decided, or how existing cases may have been decided differently under the IDPA.

One of the most prominent cases involving fashion within the last year was between two very famous brands: Christian Louboutin and Yves Saint Laurent (YSL).<sup>168</sup> Louboutin, whose shoes have become widely recognized because of their bright red soles, sued YSL for trademark infringement for putting similar red soles on certain YSL shoes.<sup>169</sup> The District Court held that allowing Louboutin to have an unlimited claim to the color red was far too broad and would hinder competition in the industry.<sup>170</sup> However, if Louboutin had been able to bring a claim under the IDPA, Louboutin would have to show that the YSL shoes in question were “substantially identical in overall visual appearance to and as to the original elements”<sup>171</sup> of one of Louboutin’s shoes. Since the red soles are unquestionably one of the “original elements” of Louboutin’s designs for the purposes of a copyright claim instead of trademark,<sup>172</sup> as long as one of the YSL shoes in question was otherwise substantially identical to one of Louboutin’s designs, Louboutin would have a better claim under the IDPA.<sup>173</sup>

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168. *Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011).

169. *Id.* at 449. To succeed in the trademark infringement claim, Louboutin had to prove that the red sole merited protection and that YSL’s use of the red sole was likely to cause consumer confusion. *Id.* at 450. Louboutin had obtained a trademark for the red sole in 2008, but the court denied Louboutin’s request for an injunction against YSL because it found that the red sole did not merit trademark protection. *Id.* at 448–49, 450, 457.

170. *Id.* at 454.

171. IDPA, S. 3523, 112th Cong. § 2(f)(5) (2012). This assumes that Louboutin’s shoes were found to be a “fashion design” that merited protection under the Act. *Id.* § 2(a)(2)(B).

172. *Id.* § 2(f)(5).

173. On November 14, 2011, the International Trademark Association (INTA) filed an amicus brief with the Second Circuit, stating that the District Court made two legal errors in its *Louboutin v. YSL* decision: first, that the court incorrectly interpreted Louboutin’s trademark registration as a general claim to the color red in designer shoes instead of the actual narrow definition provided in the registration for “a lacquered red sole on footwear” for the purpose of identifying the source of the shoes; and second, that the court erroneously applied the doctrine of aesthetic functionality to determine the validity of the red sole trademark, but without following that test with a determination that the use of the design is essential to effective competition. Brief for International Trademark Association as Amicus Curiae Supporting Appellants at \*1–2, *Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011) (No. 11-3303), 2011 WL 5833570. As a result of this error, the court found the red sole mark to be functional and therefore invalid. *Id.* at \*2. The INTA’s brief followed an amicus brief filed on October 24, 2011 by Tiffany & Co. stating that the District Court erred in its judgment by adopting a broad per se rule against granting trademark protection to any color used in a fashion design, even where the color has achieved such a secondary meaning that it has become associated with the brand, because it has been previously held that such cases were to be decided on a case-by-case basis. See Brief for Tiffany (NJ) LLC et al. as Amicus Curiae Supporting Appellants at \*4–5, *Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011) (No. 11-3303-cv), 2011 WL 5126167. The Court of Appeals agreed, finding that Louboutin’s red sole had acquired the requisite “secondary meaning” as a symbol that distinguishes and identifies Louboutin shoes, and granted a limited trademark to only red soles that *contrast* with the rest of the shoe. *Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.*, No. 11-3303-cv, 2012

Some of the claims against Forever 21 would probably have different outcomes as well. As of January 2011, Forever 21 had never been found liable for copyright infringement,<sup>174</sup> despite being sued more than fifty times.<sup>175</sup> This can partly be attributed to the fact that they settle most of the claims directed at them,<sup>176</sup> but it is likely that if there was better protection in place, more claims would be litigated and Forever 21 would probably lose many of them. The company appears to be well aware of this fact—they have accepted infringement settlements as merely a “cost of doing business,”<sup>177</sup> but may change their tune if they risked losing every claim. However, the numerous claims have already caused a slight change: the company has supposedly begun focusing on more in-house design.<sup>178</sup> However, the infringement will undoubtedly still continue, by Forever 21 and others,<sup>179</sup> unless the IDPA, or something quite similar to it, is enacted.

### III. HOW THE IDPA SHOULD BE CHANGED

#### A. SECTION 2(a)(2)(B)

Section 2(a)(2)(B) of the IDPA adds a definition for “fashion design” to the “Definitions” section of 17 U.S.C. § 1301.<sup>180</sup> The definition of a fashion design as stated in section 2(a)(2)(B) provides that it must consist of original elements<sup>181</sup> and that, among other requirements,<sup>182</sup> it must “provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.”<sup>183</sup> This section provides heightened pleading standards that plaintiffs must show when making infringement claims—they must prove that their design qualifies for protection under the bill in the first place by satisfying the requirements of the definition.<sup>184</sup>

Although this heightened standard is a good thing for the purposes of the bill, it is problematic in its practicability. Most troublesome of the

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WL 3832285, at \*1 (Sept. 5, 2012). Because the claim at issue concerned a monochromatic red shoe, the case was remanded for further decisions. *Id.*

174. See Berfield, *supra* note 52.

175. Hemphill & Suk, *supra* note 39, at 1173.

176. Berfield, *supra* note 52.

177. *Id.*

178. *Id.*

179. A collection of over 200 of the infringement complaints that have been made against Forever 21 and other companies can be viewed online. See *The Law, Culture, and Economics of Fashion: Intellectual Property Lawsuits Against “Fast Fashion” Firms*, Berkman Center for Internet and Society, HARV. L. SCHOOL, <http://hub.law.harvard.edu/fashion/> (last visited Aug. 25, 2012).

180. IDPA, S. 3523, 112th Cong. § 2(a)(2)(B) (2012).

181. If it does not contain original elements, then it must have “original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article.” *Id.* § 2(a)(2)(B).

182. *Id.* § 2 (a)(2)(B).

183. *Id.*

184. See *id.* § 2(h)(2).

requirements is the “non-trivial” element.<sup>185</sup> The word “trivial” is defined in the English language as meaning “commonplace, ordinary” or “of little worth or importance.”<sup>186</sup> However, section 2(a)(2)(B) does not provide any definition for “trivial” or guidance for how potential plaintiffs and courts are to determine whether an element of an article is “non-trivial” for the purposes of the bill, and although several provisions within the existing Copyright Act reference “trivial,”<sup>187</sup> it does not provide a definition or clarification of the term.<sup>188</sup> Further, while determining what is “trivial” or “non-trivial” may be easier to discern in other copyrightable works, fashion designs are different from other mediums—one aspect of the design may be small in nature, but could also be the component that distinguishes it.<sup>189</sup> The nature of fashion designs as tangible objects as opposed to works such as books, films, or songs make the concept of “trivial” much more open to various interpretations, and the vagueness of the term will undoubtedly lead to different interpretations not only across jurisdictions, but also between plaintiffs and judges.<sup>190</sup> An impassioned designer bringing an infringement claim may wholeheartedly believe that his design that has been copied contains elements that are not of little worth or importance in the slightest, but the presiding judge may see otherwise. Of course, differing opinions between plaintiffs and judges are typical in most court proceedings, and are certainly not reason enough to invalidate the language of legislation. However, the difference of opinion in fashion design copyright claims, and what makes fashion design such a unique category for intellectual property in general, is that the person making the claim is far more knowledgeable and familiar with the nature of the act in question than the judge may be.<sup>191</sup> A judge is likely not well versed in the fashion design process, nor familiar with the complex nature of bringing certain designs from the sketchpad to reality. Furthermore, the vagueness of the “non-trivial” qualification is even more problematic for designers on the receiving end of infringement claims. A designer accused of infringement who was merely following a trend by including a certain element in their design may be at a disadvantage if a judge, unaware of the element’s prevalence in many designs during the current and past seasons, decides that the element is not “commonplace” or “ordinary” and therefore finds the designer liable for infringement. The

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185. *Id.* § 2(a)(2)(B).

186. *Trivial Definition*, MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/trivial> (last visited Aug. 25, 2012).

187. See 17 U.S.C. § 1301(b)(1) (2006).

188. See 17 U.S.C. § 101 (2006).

189. See Shenlei Winkler, *Back to S. 3523: What is Trivial?*, SHENLEI WINKLER (Oct. 8, 2012), <http://shenlei.com/2012/10/08/back-to-s-3523-what-is-trivial/> (explaining how different changes made within the design process may be considered trivial).

190. See Ellis, *supra* note 34, at 198.

191. L.J. Jackson, *Some Designers Say Their Work Deserves Copyright Protection; Others Say it Would Harm the Industry*, ABA J. (July 1, 2011, 03:30 AM), [http://www.abajournal.com/magazine/article/the\\_genuine\\_article/](http://www.abajournal.com/magazine/article/the_genuine_article/).

IDPA should contain a clarification for “trivial,” specifying that it applies only to the provisions of section 2(a)(2)(B) or only to fashion designs if necessary; and that when determining “non-trivial,” the term should be considered in light not only of the entire design article in question, but also in light of the surrounding circumstances. These “circumstances” should incorporate current trends and seasons, therefore narrowing the application of the term and providing guidance for decision-makers who otherwise may not consider such factors in their determination.

The fine line of “non-trivial,” if not tread carefully, can result in wrongful liability or the lack of liability entirely.<sup>192</sup> Thus, who should rightfully decide? Fashion design infringement claims should not be judged by one person unfamiliar with the subject matter and its complexities, but instead by a panel of unbiased members of the industry, consisting not just of designers, but also buyers, editors, fashion lawyers and fashion law professors, members of the CFDA, AAFA, or other organizations, all of whom would be part of a larger committee from which panelists for each case would be chosen at random. The model for this solution is based on the Independent Film & Television Alliance in California (IFTA), which settles arbitration disputes arising out of film and television contracts.<sup>193</sup> Under current copyright law, parties who have agreed to do so can elect to have infringement disputes settled by arbitration.<sup>194</sup> Of course, both the IFTA and the arbitrator can only settle disputes when the parties have agreed to arbitration, typically via a clause within their agreement.<sup>195</sup> Applying this model to fashion design infringement claims would have its challenges, since the parties in dispute likely had no prior agreement, and may never have had any contact at all. The underlying theory behind the IFTA is what matters: a panel of impartial experts within the field who can provide substantive decisions.<sup>196</sup> With respect to claims arising under the IDPA, the statute should contain a provision giving parties to a fashion design infringement dispute the option to consent to arbitration before such a panel. Because the parties most likely had no original contract in which

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192. See Beltrametti, *supra* note 16, at 167 (expressing concern over fair enforcement in light of the ability, or lack thereof, of courts to discern originality in the wake of the broad spectrum of trends); Meaghan McGurrin Ehrhard, *Protecting the Seasonal Arts: Fashion Design, Copyright Law, and the Viability of the Innovative Design Protection & Piracy Prevention Act*, 45 CONN. L. REV. 285, 315 (2012) (“It is also very likely that courts would interpret ‘trivial’ very narrowly if left to their own devices.”).

193. See *Arbitration*, INDEPENDENT FILM AND TELEVISION ALLIANCE, <http://www.ifta-online.org/arbitration> (last visited Sept. 19, 2012).

194. 17 U.S.C. § 1321(d) (2006).

195. *Arbitration*, *supra* note 193. Arbitration under § 1321(d) is governed by Title 9. 17 U.S.C. § 1321(d); see 9 U.S.C. § 2 (2006).

196. See *Arbitration*, *supra* note 193.

they agreed to arbitration, the provision should require that all arbitration proceedings with respect to fashion designs be binding.<sup>197</sup>

### B. SECTION 2(c)

Section 2(c) of the IDPA amends 17 U.S.C. § 1303 to read, in relevant part, “The presence or absence of a particular color or colors or of a pictorial or graphic work imprinted on fabric shall not be considered in determining . . . infringement.”<sup>198</sup> Pictorial and graphic works are granted protection independently under existing copyright law,<sup>199</sup> and in the case of fashion designs thus far, prints are regarded as an independent element under the doctrine of separability because they can be separated from the utilitarian elements of the article—i.e., the design of the garment itself.<sup>200</sup> If art and graphics are granted copyright protection on their own, why would the existence of a graphic print on a piece of clothing not be considered a factor? In fact, the Copyright Office states that “artwork applied to clothing” is one example of a work of visual art that falls under copyright protection.<sup>201</sup> Therefore, the existence of a graphic print should be a factor, not for exclusion from protection, but inclusion when determining whether an allegedly infringing article is “substantially identical.”<sup>202</sup> When making such a determination, the existence of a “substantially identical” print should be one of the considerations within the “totality of the circumstances.”<sup>203</sup>

Certain prints used on a design or several designs within a collection can, in some cases, be the most distinctive and noticeable aspect of a certain design and can cause its success in the market.<sup>204</sup> Such graphic work can

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197. However, it could also provide an exception to the dispositive rule of § 1321(d) in order to allow the parties to appeal to the courts if necessary. *See* 17 U.S.C. § 1321(d) (“The parties shall give notice of any arbitration award to the Administrator, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates.”).

198. IDPA, S. 3523, 112th Cong. § 2(c) (2012).

199. 17 U.S.C. § 102(a) (2006). Under the law, “‘Pictorial, graphic, and sculptural works’ include . . . works of fine, graphic, and applied art, photographs, prints and art reproductions.” *Id.* § 101. The owner of the copyrighted work has exclusive rights over the use of the work. *Id.* § 106.

200. Hemphill & Suk, *supra* note 39, at 1185–86 (explaining the doctrine of separability); Lisa Pearson, Lauren Estrin, & Laura Miller, *From Fashion Catwalks to the Courts*, 179 COPYRIGHT WORLD, Apr. 2008, at 20, available at <http://kilpatricktownsend.com/~media/Files/articles/FromFashionCatwalkstotheCourts.ashx> (“As two-dimensional paintings or graphic works, prints and designs do not lose their copyrightability simply because they appear on a utilitarian article such as fabric . . . U.S. copyright law therefore clearly protects the original artwork adorning a Pucci print dress or Hermès scarf, despite the fact that they appear on useful articles.”).

201. U.S. COPYRIGHT OFFICE, INFORMATION CIRCULAR NO. 40, COPYRIGHT REGISTRATION FOR WORKS OF THE VISUAL ARTS 2 (2010), <http://www.copyright.gov/circs/circ40.pdf>.

202. IDPA, S. 3523, 112th Cong. § 2(f)(5) (2012).

203. *Id.* at § 2(h)(2).

204. For example, prints from Givenchy have grown in popularity after being worn by rappers Kanye West and Jay-Z. Maleana Davis, *Yup in My Givenchy Tee! Rappers Love Their Givenchy Print Tees*, GLOBAL GRIND (July 30, 2012), <http://globalgrind.com/style/rappers-wearing-givenchy-print-tees-photos>; Julie Zerbo, *The Kanye Effect*, FASHION L. (Nov. 7, 2012),



also, despite the use of computer technology, be incredibly detailed and intricate and require a high degree of artistic skill to produce.<sup>205</sup> Some designers develop one print or pattern for an entire season's collection and will incorporate the print into several items in the collection.<sup>206</sup> If someone were to copy the print on another design, the original designer would undoubtedly wish to file a claim for infringement. To disallow such a claim under legislation specifically devised and tailored to protect the creations of fashion designers seems counter-productive and wholly under inclusive. The designer's only recourse would be to bring a claim under § 501 for the graphic only, and then he or she would be relegated to the lower "substantially similar" standard<sup>207</sup> rather than the "substantially identical" standard of the IDPA.<sup>208</sup> If the design is in all other respects entitled to protection under the IDPA, it should not be excluded and forced to be subject to a lower level of protection. With these preexisting protections in mind, section 2(c) should be changed to remove the statement that pictorial or graphic work on a design shall not be considered for infringement. Again, note that the proposed change does not seek to change the copyright law regarding pictorial and graphic works.<sup>209</sup> Instead, it will simply allow the designer to make a potentially successful claim for infringement based on another's use or copying of the print on a design.

However, there would again need to be a highly specific pleading standard. For example, Oscar de la Renta's Pre-Fall 2009 collection contained two dresses with the same bright floral print in different colors.<sup>210</sup> This would not entitle Oscar de la Renta to make infringement claims on

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<http://www.fashion-law.org/2012/11/the-kanye-effect.html> ("Kanye is on top of his game, and he's a strong trendsetter. The result: an increased demand for Givenchy . . . Countless articles are dedicated to rappers, athletes and industry insiders who love Givenchy . . . Givenchy-printed tees and sweatshirts that is.").

205. See Alex Fury, *Queen of Prints: Meet the Extraordinary Designer Mary Katrantzou*, THE INDEPENDENT (Sept. 7, 2011), <http://www.independent.co.uk/life-style/fashion/features/queen-of-prints-meet-the-extraordinary-designer-mary-katrantzou-2354627.html> (explaining the designer's process of creating the prints for her collections).

206. See *Look 15–Spring 2012 Ready-To-Wear: Mary Katrantzou*, STYLE.COM, <http://www.style.com/fashionshows/complete/slideshow/S2012RTW-MKATRANTZOU/#15> (last visited Nov. 15, 2012); *Look 17–Spring 2012 Ready-To-Wear: Mary Katrantzou*, STYLE.COM, <http://www.style.com/fashionshows/complete/slideshow/S2012RTW-MKATRANTZOU/#17> (last visited Nov. 15, 2012); *Look 18–Spring 2012 Ready-To-Wear: Mary Katrantzou*, STYLE.COM, <http://www.style.com/fashionshows/complete/slideshow/S2012RTW-MKATRANTZOU/#18> (last visited Nov. 15, 2012); *Look 20–Spring 2012 Ready-To-Wear: Mary Katrantzou*, STYLE.COM, <http://www.style.com/fashionshows/complete/slideshow/S2012RTW-MKATRANTZOU/#20> (last visited Nov. 15, 2012).

207. "'Copying,' . . . is said to be shown by circumstantial evidence of access to the copyrighted work and substantial similarity between the copyrighted work and defendant's work." *Sid & Marty Krofft Television Prod., Inc. v. McDonalds Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977).

208. IDPA, S. 3523, § 2(f)(5).

209. 17 U.S.C. § 102(a) (2006).

210. See *Pre-Fall 2009*, OSCAR DE LA RENTA (Dec. 8, 2008), <http://www.style.com/fashionshows/complete/2009PF-ODLRENTA>.

any floral prints used by other designers, or even on floral prints using similar colors.<sup>211</sup> Rather, the claim would have to be based on the alleged infringer making a copy of one of the designs using the exact print or a print that was “substantially identical” to the original.<sup>212</sup> On the opposite hand, Alexander McQueen released a silk scarf with a skull print in 2003 that became the ultimate “It” accessory for several years,<sup>213</sup> spawning countless knock-offs,<sup>214</sup> and became even more iconic after McQueen’s suicide in 2010.<sup>215</sup> Despite this, the Alexander McQueen brand could not claim, even under the proposed change to section 2(c), that infringement occurred if someone else were to simply create a scarf with a skull print.<sup>216</sup> Given the common nature of the print and the skull symbol itself, regardless of how iconic McQueen’s skull scarf has become, how commonly it is associated with the brand, or whether the copy was completely identical, there could be no claim for infringement unless McQueen’s skull print itself was unique or distinctive.<sup>217</sup> With a higher standard, such as that for color, there is a limitation and prevention on certain designers obtaining an effective monopoly over commonplace colors, symbols, or motifs that would have the effect of hampering creativity and innovation rather than encouraging it.<sup>218</sup>

### C. SECTION 2(f)(5)

Section 2(f)(5) provides certain exceptions to infringement liability. First, section 2(f)(5) proposes to amend § 1309 to include an amended provision that reads, “In the case of a fashion design, a design shall not be deemed to have been copied from a protected design if that design—(A) is not substantially identical in overall visual appearance to and as to the original elements of a protected design. . . .”<sup>219</sup> The flaw in this provision

211. The IDPA requires design elements to be “original,” or, for “non-original” elements, to be arranged in the overall appearance of the article so as to be “a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs.” IDPA, S. 3523, § 2(a)(2)(B).

212. *Id.* § 2(f)(5).

213. Rajini Vaidyanathan, *Six Ways Alexander McQueen Changed Fashion*, BBC NEWS MAGAZINE, Feb. 12, 2010, <http://news.bbc.co.uk/2/hi/8511404.stm>.

214. *Id.*

215. Esther Adley & Imogen Fox, *Alexander McQueen Fans Flood to Shops to Pick up Mementoes of the Late Designer*, GUARDIAN, Feb. 12, 2010, <http://www.guardian.co.uk/lifeandstyle/2010/feb/12/alexander-mcqueen-fashion-designer-dies>.

216. Pearson, Estrin, & Miller, *supra* note 200, at 21.

217. For IDPA protection, “non-original” elements such as a skull print have to be “a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs.” IDPA, S. 3523, § 2(a)(2)(B).

218. Because the IDPA protects designs as a whole, protection could not be granted to elements that are commonplace or in the public domain. Kevin M. Burke & Steven Kolb, *A Case in Support of the Innovative Design Protection Act*, CAL. APPAREL NEWS (Oct. 11, 2012), <http://www.apparelnews.net/news/manufacturing/A-Case-in-Support-of-the-Innovative-Design-Protection-Act/> (using sleeves and cargo shorts as examples).

219. IDPA, S. 3523, § 2(f)(5).

lies in its vague language, namely the terms “substantially identical” and “overall.”<sup>220</sup> Although the bill provides a definition for “substantially identical” in an earlier provision,<sup>221</sup> the definition provided again uses “trivial” as a qualification, the complications of which were explained previously in this note.<sup>222</sup> Both “trivial” and “overall” are vague, and vagueness will lead to widely varying conclusions and, therefore, inconsistent precedents for later cases.<sup>223</sup> Although the “substantially identical” standard is an improvement on the “substantially similar” standard currently in place for infringing designs,<sup>224</sup> and the intent behind selecting such terms was likely so that the statute would not be so narrowly construed as to lead to unfair results, the use of such all-purpose language has the potential to do more harm than good.

Consequently, the more critical issue of section 2(f)(5) lies not in its text, but in its application. The provision, as well as the bill in its entirety, fails to specify whose standards the bill will be applied in accordance with.<sup>225</sup> Critics of the IDPA claim that because judges and attorneys in IDPA infringement cases are not familiar with the fashion industry, they should not be given the authority to make decisions that could have a substantial impact on the industry and its consumers.<sup>226</sup> Much like section 2(a)(2)(B) discussed above, to an untrained or unfamiliar eye, two articles of clothing may not appear to be “substantially” identical.<sup>227</sup> On the other hand, and potentially even worse, they may appear to be. One outcome could be personally devastating to a designer bringing a claim, while the other outcome could result in a high amount of damages, which could put

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220. *Id.*

221. *Id.* § 2(a)(2)(B).

222. *See supra* pp. 21–22.

223. Beltrametti, *supra* note 16, at 166 (explaining how the difficulty in determining originality could lead to courts “applying imprecise standards”).

224. “A design shall not be deemed to have been copied from a protected design if it is original and not substantially similar in appearance to a protected design.” 17 U.S.C. § 1309(e) (2006).

225. IDPA, S. 3523, § 2(f)(5), (h)(2).

226.

How would a judge determine whether or not a design is “substantially identical to another?” For example, does it have to be a line for line, color for color copy? Even fashion industry insiders are unclear about whether a given article of clothing could be considered “substantially identical”—it will be very intriguing to see how our fashionable judges interpret this.

Yang, *supra* note 112. *See also* Staci Riordan, *Breaking News: New Design Piracy Bill Introduced into Senate*, FOX ROTHSCHILD: FASHION L. BLOG (Aug. 6, 2010), <http://fashionlaw.foxrothschild.com/2010/08/articles/design-piracy-prohibition-act/breaking-news-new-design-piracy-bill-introduced-into-senate/>.

227. “What is ‘substantially identical?’ What does ‘substantially’ mean? . . . Leaving that judgment to a judge, a nonfashion person who doesn’t understand the business or industry history, is dangerous.” Jackson, *supra* note 191 (quoting Ilse Metchek, president of the Cal. Fashion Assoc.).

small designers out of business or require spreading the costs, resulting in driving up prices for consumers.<sup>228</sup>

During a hearing regarding the IDPPPA before the House Judiciary Subcommittee on Intellectual Property in July 2011, Rep. Mel Watt (D., N.C.) voiced this concern, asking advocates of the IDPPPA to provide a list of instructions that could be given to jurors specifying the difference between “substantially identical” and merely “inspired by.”<sup>229</sup> He went on to say, “[T]he proof in a case is going to rely on twelve uneducated, unsophisticated design people making those kinds of distinctions. Unless that can clearly be drawn, you are just going to have endless litigation . . . ,”<sup>230</sup>

Rep. Watt raises a valid point. Each case being decided by a different set of people, all whom are likely to be unfamiliar with not just the pieces in question but also the design process and the business as a whole, has poor consequences. Not only would it result in unjust outcomes, but also inconsistent ones that will only lead to further unjust outcomes, causing the purpose of the protection to be virtually useless and obsolete. As previously stated,<sup>231</sup> there needs to be a committee or organization put into place that can judge design piracy disputes, made up of members of the industry or individuals who have the ability and trained eye to accurately detect which designs have been unfairly copied and that ones that have not.

Additionally, section 2(f)(5) provides an exception for fashion designs that are “the result of independent creation.”<sup>232</sup> Independent creation has developed via case law as a defense to copyright infringement.<sup>233</sup> Considering that the bill is aimed to foster creativity while protecting designer’s creations,<sup>234</sup> the purpose behind making independent creation explicit for fashion designs is clear—considering the prevalence of trends in the fashion world, one should not be punished for creating something on his or her own, even if it is, by sheer coincidence, “substantially identical”<sup>235</sup> to

228. See Riordan, *supra* note 226 (questioning a judge’s ability to judge originality and arguing that raised clothing prices will result).

229. Zerbo, *supra* note 150.

230. *Id.*

231. See *supra* pp. 22–23.

232. IDPA, S. 3523, 112th Cong. § 2(f)(5) (2012).

233. Courts have historically used the test of access plus substantial similarity to show proof of copying in infringement cases. “By establishing reasonable access and substantial similarity, a copyright plaintiff creates a presumption of copying. The burden shifts to the defendant to rebut that presumption through proof of independent creation.” *Three Boys Music Corp. v. Michael Bolton*, 212 F.3d 477, 486 (9th Cir. 2000), *cert. denied*, 531 U.S. 1126 (2001).

234. 157 CONG. REC. E1314-02 (daily ed. July 13, 2011) (statement of Rep. Goodlatte).

235. The language of section 2(f)(5) uses “or” to separate between the two exceptions: so long as it is not “substantially identical . . . or is the result of independent creation,” it will not be deemed infringing. IDPA, S. 3523, § 2(f)(5) (emphasis added). Thus, even if the two designs were “substantially identical,” but the allegedly infringing design was shown to be “the result of independent creation,” it would be permissible. See *id.* The spread of popular trends in fashion make the section 2(f)(5) distinction and its exception necessary, and courts have noted the

another designer's creation. However, the IDPA does not provide any guidance for how independent creation in this case can be proven or what the standard of proof should be.<sup>236</sup> In order for the provision to be effective or functional in its application to fashion designs, there must be rules or qualifications to be met in order to satisfy the independent creation standard. How can a person prove he or she created something on his or her own? Furthermore, if the article the designer is being accused of copying was already on the market at the time, how can he or she prove that she did not know about it or was not influenced by it in creating his or her own design? Proof of access, though used as a factor in copyright infringement cases in the past,<sup>237</sup> is more or less irrelevant in the context of fashion designs because of the Internet.<sup>238</sup> There is a presumption of access, and providing sketches or other evidence detailing the design process may still not completely prove that a designer was or was not copying another design.<sup>239</sup> This may not be an easy problem for courts to solve, and a perfect solution may not exist—thus, the goal should instead be uniformity in decision-making. The IDPA should include some requirements or a standard for effective proof that would provide more explicit guidance than the “totality of the circumstances” consideration<sup>240</sup> in order to prevent arbitrary decisions by judges or widely differing decisions in cases with similar circumstances.

## CONCLUSION

The IDPA, though it would undoubtedly produce beneficial results, is not without its flaws. Nonetheless, the introduction of the IDPA, much like the IDPPPA before it, creates an opportunity to finally give fashion designers what they deserve. By improving upon the previous bill, the IDPA not only creates an even better and more suitable law, it brings the issue of fashion copyright to light again, raising awareness and sending the message that this is important—this is something that affects our economy, the jobs of many people, and quite literally, the clothes on our back. It is the

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possibility of identical independent creations and permitted such an exception in the past: “The first phrase of the infringing chorus consists of the same four notes as the first phrase of the copyrighted song; that particular sequence can be found in several earlier musical pieces and its spontaneous reproduction should be no cause for suspicion.” *Arnstein v. Edward B. Marks Music Corp.*, 82 F.2d 275, 277 (2d Cir. 1936).

236. IDPA, S. 3523, § 2(f)(5) (describing only that a work of independent creation is not infringing); *id.* § 2(h)(2) (requiring evidence that the alleged infringer knew of or saw the design, but remaining silent on how such evidence can or should be rebutted).

237. *See Three Boys Music Corp.*, 212 F.3d 477; *see Grubb v. KMS Patriots, L.P.*, 88 F.3d 1, 3, 5 (1st Cir. 1996).

238. *See supra* pp. 14–16.

239. *See Ilse Metchek, Industry Voices—A Response to the ‘New’ Bill to ‘Protect’ Fashion Design*, CAL. APPAREL NEWS (Oct. 4, 2011), <http://www.apparelnews.net/industry-voices-design-bill-response#tab1>.

240. IDPA, S. 3523, § 2(h)(2).

hope of the author that this time Congress will finally listen, and grant fashion designers the protection that they should have been given a long time ago.

*Casey E. Callahan\**

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\* B.A., New York University, Tisch School of the Arts, 2008; J.D. Candidate, Brooklyn Law School, 2013. I would like to thank my family and friends for their support and encouragement, and special thanks to Steven Kolb. Finally, thanks to the CFDA and all of the designers who continue to fight and inspire me to do the same.