
FRESH LOOKS TURN SOUR: INTELLECTUAL PROPERTY PROTECTIONS FOR THE FASHION WORLD

ABSTRACT

Whether they want to admit it or not, everyone is a part of the fashion industry. Every day people get up and dress for the day, making the choice of what to wear: to dress for comfort, functionality, appearance, or any combination of factors. Perhaps it is this daily forced participation that drives a certain level of hostility towards the fashion industry.

While some people may find the fashion industry to be vain, or simply uninteresting, it remains a significant portion of the country's—and the world's—economy. Yet, the United States simply refuses to acknowledge its value. Repeated failures to pass legislation protecting innovative fashion design indicate that the federal government simply does not care about this type of innovation and creation.

*Designers are instead turning to the courts in attempt to enforce current laws, in creative ways, to find protection for this massive industry. The Supreme Court's ruling in *Wal-Mart Stores v. Samara Bros.* marked a monumental moment for all members of the fashion industry—innovators and imitators alike. When the Court ruled that apparel could be protected by trade dress, it established that unique apparel design is valuable and worthy of protection. The federal legislature should follow suit and acknowledge the value of innovative fashion design by passing legislation specifically protecting it.*

TABLE OF CONTENTS

I. Introduction	2
II. Design “Borrowers” and Knockoffs Face Backlash in Court	4
A. <i>Coach Inc. v. Sapatis</i>	4
B. <i>Louis Vuitton Malletier S.A. v. LY USA, Inc.</i>	6
C. <i>Wal-Mart v. Samara Brothers</i>	6
III. Intellectual Property Law Does Not Have the Right “Fit” for Fashion	7
A. Copyrights	7
B. Trademarks	8
C. Patents	9
IV. Failed Attempts at Federal Regulation	10
A. Design Piracy Prohibition Act	10
B. Innovative Design Protection Act of 2012	11

V. Current State of Federal Protection	12
VI. Combining Design Patents and Trade Dress	13
A. Pairing Design Patents and Trade Dress Is Tedious.....	13
B. Alterations to Designs May Sever Trade Dress Protection	14
C. Design Patents Are Not Fast Enough to Prevent Knockoffs.....	15
D. Impact on Design Cycle	15
VII. What to Do to Protect a New Design	17
VIII. Reward Fashion Design for the Creativity and Innovation it Requires	18

I. INTRODUCTION

Clothes are a necessity for any person in modern-day society.¹ Mark Twain said, “Clothes make the man. Naked people have little or no influence on society.”² Clothes are often used to express a person’s profession or personality.³ Fashion can transform clothes from a form of expression to an integral part of a person’s self; Coco Chanel proclaimed, “I don’t do fashion. I am fashion.”⁴ This need for functionality and expression prompted Americans to spend 3.3 percent of their total annual expenditures on fashion-related purchases in 2014.⁵ Ever evolving style and design trickles down from influential designers and fashion personalities to create a constant demand for new products.⁶ Simple searches on e-commerce

1. For example, Burger King required that a baby leave the restaurant for failing to conform to the restaurant’s “no shoes, no shirt, no service” policy. *See AP, Burger King Boots Shoeless Tot, Mom*, CBS NEWS (Aug. 6, 2009), <http://www.cbsnews.com/news/burger-king-boots-shoeless-tot-mom/>.

2. U.S. BUREAU OF LABOR STATISTICS, BLS SPOTLIGHT ON STATISTICS FASHION 1 (June 2012), http://www.bls.gov/spotlight/2012/fashion/pdf/fashion_bls_spotlight.pdf (quoting Mark Twain) [hereinafter BLS SPOTLIGHT].

3. *Id.* (“What people wear often characterizes who they are and what they do for a living.”).

4. Sarah Lindig, *Famous Words of Fashion’s Greatest*, HARPER’S BAZAAR (Feb. 6, 2014), <http://www.harpersbazaar.com/fashion/fashion-designers/50-famous-fashion-quotes> (quoting Coco Chanel).

5. BUREAU OF LABOR STATISTICS, CONSUMER EXPENDITURES—2014, at 2 (2015), <http://www.bls.gov/news.release/pdf/cesan.pdf>.

6. *See* Allison DeVore, Note, *The Battle Between the Courthouse and the Fashion House: Creating Tailored Solution for Copyright Protection of Artistic Fashion Designs*, 35 T. JEFFERSON L. REV. 193, 209–10 (2013); Laura Schumaker, *The High Price Behind Fashion*, 2 SYRACUSE SCI. & TECH. L. REP. 1, 6–7 (2010). The trickle down concept is even featured in the motion picture *The Devil Wears Prada*. *THE DEVIL WEARS PRADA* (20th Century Fox 2006). Miranda Priestly (played by Meryl Streep) explains to her new assistant, Andy Sachs (played by Anne Hathaway), how the color of Andy’s sweater trickled down from high-end fashion collections and into the mass markets. *Id.*

sites show the influence of high-end style innovations in the fashion industry at every level.⁷ For example, key design features of the Chanel 2.55 quilted flap bag can be identified in a bag (sponsored by musician Nicki Minaj) sold by K-Mart,⁸ or in a bag sold by aspirational brand Tory Burch.⁹

But what if a designer wants to protect a particular design or design element from imitation by fellow designers? Perhaps the design represents something deeply personal or is the result of a long and arduous process; regardless of the reasoning, innovative fashion design should be afforded protection under federal law. This Note will address the fashion industry's attempts to protect the creative process within the bounds of current federal laws and explore how federal law could be modified to provide more effective protections to the fashion industry.

First, this Note will review past successful design-protection case law.¹⁰ Second, this Note will review the various types of intellectual property protection and their application to the fashion industry.¹¹ Third, this Note will review past failed attempts at federal regulation.¹² Fourth, this Note will discuss the current state of protection and its challenges.¹³ Fifth, this Note will explore the combination of trade dress and design patents.¹⁴ Sixth, this Note will review what designers should do in the United States to best protect designs.¹⁵ Finally, this Note will end with a plea for the creation of further federal protection for fashion design.¹⁶

7. In 1955, Coco Chanel invented the 2.55 bag that featured a chain handle, quilted leather, and a top flap. See *Timeline*, INSIDE CHANEL, http://inside.chanel.com/en/timeline/1955_255-bag (last visited Oct. 7, 2015).

8. *Nicki Minaj Women's Quilted Crossbody Purse*, KMART, <http://www.kmart.com/nicki-minaj-women-s-quilted-crossbody-purse/p-042W008631221001P?prdNo=5&blockNo=5&blockType=G5> (last visited Oct. 7, 2015) (bag featuring quilting, top flap, and chain handle).

9. *Fleming Medium Bag*, TORY BURCH, http://www.toryburch.com/fleming-medium-bag/32149851.html?start=100&dwvar_32149851_color=600&cgid=handbags-view-all (last visited Oct. 7, 2015) (bag featuring quilting, top flap, and chain handle priced at \$465.00).

10. See *infra* Part II.

11. See *infra* Part III.

12. See *infra* Part IV.

13. See *infra* Part V.

14. See *infra* Part VI.

15. See *infra* Part VII.

16. See *infra* Part VIII.

II. DESIGN “BORROWERS” AND KNOCKOFFS FACE BACKLASH IN COURT

While design elements naturally trickle down from original designers, some companies use unique design elements of another company’s line as a blueprint for their own products rather than for inspiration.¹⁷ In past litigation, design houses used various principles of trademark law and The Lanham Act to thwart copycats and blatant knockoffs.¹⁸

A. Coach Inc. v. Sapatis

To combat design thieves, Coach—a producer of designer apparel and accessories, including handbags—resorted to hiring private investigators to locate and investigate counterfeit goods.¹⁹ When private investigators discovered vendors selling counterfeit goods at a flea market, Coach initially dealt directly with the vendors.²⁰ However, when the investigators returned to the flea market, 10 vendors still marketed counterfeit Coach goods (one vendor displayed roughly three dozen counterfeit Coach products).²¹ Investigators made five or six subsequent trips to the flea market and found counterfeit Coach items all but two times.²² Eventually, Coach brought a variety of intellectual property claims under state common law and federal statutes against the flea market, itself.²³ By engaging the larger party, the flea market, rather than each individual vendor, Coach could stop 30 separate illegitimate vendors at one time.²⁴

To prove contributory infringement, “Coach [had to] prove that [the owner] ‘(1) knew or had reason to know of the alleged infringement of Coach’s trademarks and copyrights at the Flea Market; (2) exercised sufficient control over the vendors engaged in the ongoing infringement; and (3) failed to take sufficient steps to stop

17. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 207–08 (2009). Wal-Mart sent photos of products from the Samara Brothers’ line of children’s clothing to a manufacturer to produce near exact copies. *Id.*

18. See, e.g., S. Priya Bharathi, Comment, *There is More than One Way to Skin a Copycat: The Emergence of Trade Dress to Combat Design Piracy of Fashion Works*, 27 TEX. TECH. L. REV. 1667, 1668 (1996) (“The protection that designers seek exists in the common-law doctrine of trade dress, ‘a hybrid of trademark and unfair competition law’ . . . embodied in section 43(a) of the Lanham Trademark Protection Act.”).

19. *Coach, Inc., v. Sapatis*, 994 F. Supp. 2d 192, 196 (D.N.H. 2014) [hereinafter *Coach I*].

20. See *Coach, Inc. v. Sapatis*, No. 12-cv—506—PB, 2014 WL 2930595, at *1 (D.N.H. June 27, 2014) [hereinafter *Coach III*].

21. *Id.* at *2.

22. *Id.* at *4.

23. *Coach I*, 994 F. Supp. 2d at 194.

24. *Coach III*, 2014 WL 2930595, at *6.

it.”²⁵ Contributory infringement is not a strict liability tort, meaning a plaintiff must show that the defendant did not take “reasonable remedial measures” to stop infringement by other known parties.²⁶ First, Coach needed to show that the flea market owner and the owner of the property on which the flea market was located “knew, or had reason to know, of particular instances of trademark and copyright infringement at the Flea Market.”²⁷ This threshold can be met through showing acts of willful blindness.²⁸ The court, in ruling on a motion for summary judgment, found there was sufficient evidence for a reasonable jury to conclude that the first requirement was met, where the flea market owner visited the infringing booths with Coach’s investigators.²⁹ The court then determined that the flea market owner had sufficient control over the vendors because the owner created and enforced policies that all vendors were bound to follow.³⁰ However, the court determined that the property owner did all he could to stop the counterfeit sales, so it was unlikely that he would be held liable for contributory infringement.³¹ The property owner showed this by distributing flyers (in multiple languages) to vendors informing them that counterfeit goods could not be sold on property, requiring vendors with counterfeit goods to leave, and by posting a sign that said “vendors, you are not allowed to sell counterfeit or any illegal items on these premises.”³²

25. *Id.* at *5 (quoting *Coach, Inc. v. Sapatis*, 27 F. Supp. 3d 239, 243–44 (D.N.H. 2014) [hereinafter *Coach II*]).

26. *Id.* (quoting *1-800 Contacts, Inc. v. Lens.com, Inc.*, 722 F.3d 1229, 1249 (10th Cir. 2013)).

27. *Coach II*, 27 F. Supp. 3d at 248.

28. *Id.* Willful blindness is defined as “[d]eliberate avoidance of knowledge of a crime, esp[ecially] by failing to make a reasonable inquiry about suspected wrongdoing despite being aware that it is highly probable.” *Willful Blindness*, BLACK’S LAW DICTIONARY (9th ed. 2009).

29. *Coach II*, 27 F. Supp. 3d at 248.

30. *Id.* at 249. Additionally, the owner “actively checked vendors in, assigned their spaces, verified their compliance with policies she had helped to create, and received their suggestions.” *Id.* As for the owner and lessor of the flea market’s land, the court found that while his ownership of the land was not enough to demonstrate control, the fact that he patrolled the flea market, answered its phone calls, sent e-mail responses to flea market customers, and resolved disputes between vendors, among other acts, was sufficient evidence of control over the flea market that a reasonable jury could find him liable. *Coach I*, 994 F. Supp. 2d at 199–200.

31. *Coach III*, 2014 WL 2930595, at *5. The issue of this particular motion was whether Coach could obtain a writ of attachment against the land owner’s real property pending trial. The court denied the motion because Coach was unable to “make a strong preliminary showing that it [would] succeed on the merits of its contributory infringement claims” against the owner. *Id.* at *7.

32. *Id.* at *1–2, *5.

While Coach did not technically win the case,³³ it achieved its goal of eliminating or drastically reducing the number of counterfeit goods sold at the flea market.³⁴ Another popular design brand, Louis Vuitton, simply used a trademark infringement claim to stop counterfeiters from selling bags with its world famous “LV” monogram logo.

B. Louis Vuitton Malletier S.A. v. LY USA, Inc.

Louis Vuitton prevailed in *Louis Vuitton Malletier S.A. v. LY USA, Inc.* by claiming trademark infringement coupled with a counterfeiting claim under various sections of the Lanham Act.³⁵ Under the trademark infringement claim, Louis Vuitton simply had to show that its mark (the “LV” logo and accompanying motifs³⁶) was (1) protectable³⁷ and (2) similar enough to the defendant’s product that it would likely confuse consumers.³⁸ Variations between the products did not bar protection.³⁹ Additionally, “post-sale confusion” supported Louis Vuitton’s claims—meaning that confused bystanders can prove infringement.⁴⁰

C. Wal-Mart v. Samara Brothers

Design misappropriation happens to more than designer labels.⁴¹ Samara Brothers, Inc. (Samara Brothers) produced children’s wear for JC Penney and other similarly-situated stores.⁴² Samara Brothers discovered that a third party, Judy-

33. Verdict, *Coach, Inc. v. Sapatis*, No. 12-CV-506-PB, 2014 WL 7406336 (D.N.H. Nov. 12, 2014).

34. *Coach III*, 2014 WL 2930595, at *6 (“The number of allegedly infringing vendors reported by Coach’s investigators generally declined over time.”).

35. *Louis Vuitton Malletier S.A. v. LY USA, Inc.*, 472 F. App’x 19, 21–22 (2d Cir. 2012).

36. *Louis Vuitton Malletier, S.A. v. LY USA*, No. 06 Civ. 13463(AKH), 2008 WL 5637161, at *2 (S.D.N.Y. Oct. 3, 2008).

37. For a trademark to be protectable it must be used in commerce as a way to distinguish or identify the source of a good or service. Ann Schofield Baker & Christopher Bovenkamp, *What is a Trademark Anyway?*, 45 *ADVOC. (TEX.)* 49, 50 (2008). Additionally, the trademark must be more unique than a generic term widely used to describe the good or service. *Id.*

38. *Louis Vuitton Malletier S.A.*, 472 F. App’x at 21.

39. *Id.* Courts use an eight-factor test developed by the Second Circuit Court of Appeals in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). See *Louis Vuitton Malletier S.A.*, 472 F. App’x at 21. Under this test, “[T]he threshold for infringement liability is not exact copying, but rather confusing similarity.” *Id.*

40. *Id.* (“The likelihood that the use of plaintiff’s marks would lead individuals other than purchasers of the knockoff products to believe that they were manufactured by the trademarkholder (so-called ‘post-sale confusion’) provides further support for the judgment of the district court.”).

41. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 207–08 (2009).

42. *Id.* at 207.

Philippine, Inc., produced garments based on photographs of Samara Brothers' designs and sold them to Wal-Mart, Kmart, and other similarly-situated stores.⁴³ While Samara Brothers filed a variety of intellectual property claims against the stores carrying Judy-Philippine's products, it focused on unregistered trade dress infringement for the bulk of its claims.⁴⁴ While the Supreme Court agreed that trade dress covers actual product design under the Lanham Act, it also held that only distinctive designs with secondary meaning⁴⁵ are protected.⁴⁶

III. INTELLECTUAL PROPERTY LAW DOES NOT HAVE THE RIGHT "FIT" FOR FASHION

While the three cases reviewed above demonstrate that it is possible for a fashion label to protect designs in court, current intellectual property laws do not provide sufficient protection for fashion designs overall. A review of the three main categories of intellectual property law demonstrates this determination.

A. Copyrights

Copyright protection is extended to "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."⁴⁷ Fashion design is not included as a work of authorship, so it does not generally receive any protection from duplication under federal copyright law.⁴⁸ The Copyright Act has expanded protection to cover different specific industries that originally fell outside the protection of the Act;⁴⁹

43. *Id.* at 207–08.

44. *Id.* at 208. Trade dress is a type of protection "that originally included only the packaging, or 'dressing,' of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product." *Id.* at 209.

45. *Id.* at 211 ("[A] mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs when, 'in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.'" (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982) (second alteration in original)).

46. *Id.* at 216.

47. 17 U.S.C. § 102(a) (2012).

48. *See id.* ("Works of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works."); *see* Linna T. Loangkote, Note, *Fashioning a New Look in Intellectual Property: SUI Generis Protection for the Innovative Designer*, 63 HASTINGS L.J. 297, 303 (2011).

49. The most recently added category was architectural works, which was added in 1990

however, fashion design remains outside the protection of the Act in general.⁵⁰

Certain aspects of fashion design are protected by the Act, but these aspects must be compartmentalized from one another to find protection.⁵¹ There will be no protection for the design as a whole, even if each aspect is individually protected.⁵² Protectable aspects must be a pictorial, graphic, or sculptural feature able to exist independently and identified separately from the utilitarian purpose of the garment.⁵³ The ability to separately identify an element is demonstrated by either showing that the element is physically separable (can be removed from the garment) or conceptually separable (artistic features that do not add to utilitarian function of the garment) from the garment as a whole.⁵⁴

B. Trademarks

Trademark laws generally protect words, logos, package design, or combinations of distinguishing characteristics that identify a product's manufacturer.⁵⁵ Trademark protection also covers trade dress—commonly known as product packaging.⁵⁶ Trade dress now also includes actual product design—if the design is distinctive and has secondary meaning.⁵⁷ However, “elements that do not identify source and origin of apparel and accessories do not qualify for protection under the U.S. Trademark Act.”⁵⁸ Distinctive aspects of a garment are protectable if they indicate the source of the product, for example, a unique dress style or shape is protectable⁵⁹—think the wrap dress and Diane Von Furstenberg.⁶⁰

through the Architectural Works Copyright Protection Act. Pub. L. No. 101-650, § 703, 104 Stat. 5089, 5133 (codified as amended at 17 U.S.C. § 102); *see* Loangkote, *supra* note 48, at 303–04.

50. N. Elizabeth Mills, *Intellectual Property Protection for Fashion Design: An Overview of Existing Law and a Look Toward Proposed Legislative Changes*, 5 SHIDLER J. L. COMM. & TECH. 24, 25 (2009), http://digital.law.washington.edu/dspace-law/bitstream/handle/1773.1/438/vol5_no5_art24.pdf?sequence=1.

51. *Id.*

52. *Id.* at 26.

53. Oliver Herzfeld, *Protecting Fashion Designs*, FORBES (Jan. 3, 2013), <http://www.forbes.com/sites/oliverherzfeld/2013/01/03/protecting-fashion-designs/>.

54. *Id.*

55. JANE C. GINSBURG, JESSICA LITMAN & MARY L. KELVIN, TRADEMARK AND UNFAIR COMPETITION LAW 17 (Robert C. Clark et al. eds., 4th ed. 2007).

56. *Id.*

57. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000).

58. Herzfeld, *supra* note 53.

59. *Id.*

60. Lizze Crocker, *Diane von Furstenberg: How I Learned to Love My Wrap Dress*, THE DAILY BEAST (Oct. 27, 2014), <http://www.thedailybeast.com/articles/2014/10/27/diane-von-furstenberg-how-i-learned-to-love-my-wrap-dress.html>.

Yet even distinctive aspects may not be protectable under trade dress, if they are considered functional.⁶¹ Even then, the application of trade dress to actual product design is limited; the Supreme Court stated, “Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as patent or copyright protects an item, it will be subject to copying.”⁶²

C. Patents

Patents are designed to protect inventors from other people selling the inventor’s creation in the United States.⁶³ Patent types include utility, design, and plant.⁶⁴ Design patents require that the design is “new, original, nonobvious and ornamental.”⁶⁵ Additionally, if the feature is not considered ornamental and approaches functionality, then the design is not eligible for a design patent.⁶⁶ While design patents seem like an answer for fashion design protection, designers have to pick and choose what original or novel aspects of the design to protect.⁶⁷ Even if possible, attempting to cover an entire item’s design with a design patent is ill advised; a slight alteration to the overall design by a copycat is permissible, since the design would no longer be identical.⁶⁸ Designers must gamble and guess which design elements are likely to be copied and which are not, due to any number of factors.⁶⁹ However, design patents can be issued relatively quickly⁷⁰ and last up to 14 years, making them a possible source of protection for innovative fashion design elements.⁷¹

61. *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001).

62. *Id.*

63. GINSBURG, *supra* note 55, at 18.

64. *Id.*

65. *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 903 F. Supp. 1457, 1460 (D. Kan. 1995) (citing *Sidewinder Marine, Inc. v. Starbuck Kustom Boats and Products, Inc.*, 597 F.2d 201, 207–208 (10th Cir. 1979); 35 U.S.C. § 171).

66. See Elizabeth Ferrill & Tina Tanheco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J. L. & TECH. 251, 278–79 (2011).

67. Erin Geiger Smith, *Fashion Designers Look to Patents to Fight Knockoffs*, REUTERS (Sept. 12, 2013), <http://www.reuters.com/article/2013/09/12/us-usa-fashion-newyork-patents-idUSBRE98B0H420130912>.

68. *Id.* (“If a design patent covers an entire design, those who copy it can generally escape liability as long as there are some differences between its product and the original.”).

69. *See id.*

70. Alis Anita Manaila, *Design Patents are a Boon for the Fashion Industry*, CREATIVE ARTS ADVOCATE, <http://www.creativeartsadvocate.com.php53-23.ord1-1.websitetestlink.com/design-patents-are-a-boon-for-the-fashion-industry/> (last visited Oct. 7, 2015).

71. Ferrill & Tanheco, *supra* note 66, at 253.

IV. FAILED ATTEMPTS AT FEDERAL REGULATION

Congress recognized the difficulty of applying existing federal intellectual property law to the fashion design industry and attempted to enact new legislation multiple times within the past 10 years.⁷² However, no proposed bill became law and the fashion industry remains relatively unprotected.⁷³

A. *Design Piracy Prohibition Act*

In 2006, Congress attempted to address the issue of design protection for fashion designs by proposing an amendment to the Copyright Act—the Design Piracy Prohibition Act.⁷⁴ Adding a specific form of design protection to Chapter 13 of the Copyright Act would be appropriate; that chapter already covers very specialized areas of design, such as the design of vessel hulls.⁷⁵ The bill would have amended 17 U.S.C. § 1301 to include protection for “an article of apparel.”⁷⁶ Additionally, it would define fashion design:

A ‘fashion design’ is the appearance as a whole of an article of apparel, including its ornamentation. . . .

The term ‘apparel’ means—

“(A) an article of men’s, women’s, or children’s clothing, including undergarments, outerwear, gloves, footwear, and headgear;

“(B) handbags, purses, and tote bags;

“(C) belts; and

“(D) eyeglass frames.⁷⁷

The period of protection proposed took the fashion industry’s short lifecycle into consideration and limited protection to three years.⁷⁸ The proposed legislation suggested a strong deterrent for infringers—the greater of \$250,000 or \$5 per copy.⁷⁹ It seems reasonable that violators would weigh the cost of knocking off the

72. *See infra* Parts IV.A, IV.B.

73. *See infra* Parts IV.A, IV.B.

74. 152 Cong. Rec. E472 (extension of remarks Mar. 30, 2006) (statement of Rep. Goodlatte) (introducing the Design Piracy Prohibition Act).

75. *Id.*

76. Design Piracy Prohibition Act, H.R. 2033, 110th Cong. § 2(a)(2)(A) (2007).

77. *Id.*

78. *Id.* § 2(c).

79. *Id.* § 2(g).

design and paying the fine with the cost of developing an original design. Because of the structure of the penalty, violators would be penalized at least \$250,000 and would suffer an even greater fine as the sales of the product reached over 50,000 units.⁸⁰

Members of both the House of Representatives and the Senate introduced identical versions of the Design Piracy Prohibition Act⁸¹ and “[t]he House Subcommittee on Courts, the Internet, and Intellectual Property held hearings on the bill on July 27, 2006.”⁸² Despite this effort, the Act never became law. Had Congress enacted it, fashion designers would have three months, starting from the time a design is made public, to register a new design. Then designers would be able to limit and control who used and distributed their registered designs in the marketplace for three years.⁸³

Undeterred by the Act’s past failure, Representative Bill Delahunt reintroduced the bill in 2009 to the House of Representatives alongside 23 cosponsors.⁸⁴ Again, Senator Charles Schumer introduced a nearly identical act into the Senate.⁸⁵ And once again, Congress failed to enact either version.

B. *Innovative Design Protection Act of 2012*

In 2011, protection for fashion design became a topic for Congress to address once more.⁸⁶ An updated version of the Design Piracy Prohibition Act was

80. *Id.*

81. *Compare id.* §§1, 2(a)–(h), with Design Piracy Prohibition Act, S. 1957, 110th Cong. (2007).

82. JESSICA G. JACOBS, CONG. RESEARCH SERV., COPYRIGHT PROTECTION FOR FASHION DESIGN: A LEGAL ANALYSIS OF THE DESIGN PIRACY PROHIBITION ACT, H.R. 2033 1 n.2 (2007), http://www.ipmall.info/hosted_resources/crs/RS22685_070628.pdf.

83. *Id.* at 4.

84. Design Piracy Prohibition Act, H.R. 2196, 111th Cong. (2009). Cosponsors included Representatives Bob Goodlatte, Jerrold Nadler, Darrell E. Issa, Sheila Jackson-Lee, Mary Bono Mack, James F. Sensenbrenner, Jr., Debbie Wasserman Schultz, Howard Coble, Daniel B. Maffei, Anthony D. Weiner, Charles B. Rangel, Robert Wexler, Maxine Waters, Steve Cohen, Carolyn B. Maloney, George Miller, Rosa DeLauro, Lynn Woolsey, Mike Quigley, Trent Franks, Pedro R. Pierluisi, Thomas J. Rooney, and Adam B. Schiff. *Cosponsors: H.R. 2196—111th Congress (2009–2010)*, CONGRESS.GOV, <https://www.congress.gov/bill/111th-congress/house-bill/2196/cosponsors?q=%7B%22search%22%3A%5B%22%5C%22hr2196%5C%22%22%5D%7D&resultIndex=4> (last visited Oct. 2, 2015). The cosponsors included 16 Democrats and 7 Republicans. *Id.*

85. *Compare* H.R. 2196, with Innovative Design Protection and Piracy Prevention Act, S. 3728, 111th Cong. (2010).

86. *See* Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012); Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011).

reintroduced as the Innovative Design Protection Act in 2011.⁸⁷ Revisions altered the original bill after consultations with industry representatives; after further compromised changes were made, the legislation was re-introduced to congress.⁸⁸ However, the Innovative Design Protection Act of 2012 was never passed into law.⁸⁹

V. CURRENT STATE OF FEDERAL PROTECTION

After the failure of the Design Piracy Prohibition Acts and Innovative Design Protection Act of 2012, fashion designers are without federal support.⁹⁰ Worse than being forgotten, Congress considered protecting the value of innovative fashion design and determined that it does not warrant protection. Why is this type of creation and innovation less deserving than others? Is it because the majority of business comes from apparel for women over the age of 16?⁹¹ Is it because some people view fashion as silly or superficial?

Designers are not waiting for validation from Congress to protect their designs.⁹² For example, designer Mary Katrantzou found that cheaper, mass retailers were copying many of her designs—including her signature prints.⁹³ The discount brands were sometimes creating near replicas within a month—saturating the market with poor quality product that diluted the demand and value for Katrantzou’s product.⁹⁴ Katrantzou responded by experimenting with unique and hard to imitate materials in her designs.⁹⁵ Katrantzou is not the only designer relying on fabric innovation to prevent imitators.⁹⁶ Proenza Schouler created a unique fabric for a pleated skirt that required the development of hundreds of swatches to get the perfect, unique style.⁹⁷

87. See H.R. 2511; 157 Cong. Rec. E1314, (extension of remarks July 13, 2011) (statement of Rep. Goodlatte) (introducing the Innovative Protection and Piracy Prevention Act).

88. S. 3523.

89. See 17 U.S.C. § 1301 (2012); Jeanette Cuzella, Note, *Fast Fashion: A Proposal for Copyright Protection of 3D-Printed Apparel*, 13 COLO. TECH. L.J. 369, 382 (2015). Only vessel hulls and related terms are identified, nothing related to fashion design is defined.

90. See Cuzella, *supra* note 89.

91. BLS SPOTLIGHT, *supra* note 2, at 2.

92. See Meenal Mistry, *Style That Can't Be Copied*, WALL ST. J., Jan. 31–Feb. 1, 2015, at D1–D2.

93. *Id.* at D1.

94. *Id.* at D2.

95. *Id.* (noting that Katrantzou is using “guipure (a dense, decorative form of lace) and embroidered jacquards that she has custom-made in Swiss mills”).

96. *Id.*

97. *Id.*

VI. COMBINING DESIGN PATENTS AND TRADE DRESS

Beyond using new and unique design techniques, designers could also combine existing types of intellectual property law. In the absence of any single protection for the work and creative efforts of fashion designers, pairing design patents and trade dress is a good way to patch together some sort of meaningful protection for the fashion industry.⁹⁸ Design patents are generally issued quickly (in contrast to utility patents), and processed within a year of the application.⁹⁹ The relatively quick issuance of design patents makes their use feasible for the fashion industry and its quick production cycle.¹⁰⁰ However, design patents only last for 14 years, so their application to some of the most innovative and iconic designs (think the wrap dress) would fall short of the amount of protection the designs warrant.¹⁰¹ To extend the period of protection, the design patent could be paired with trade dress. Remember though, trade dress requires secondary meaning.¹⁰² “To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”¹⁰³ During the period of coverage under the design patent, the product design can acquire the secondary meaning required for trade dress protection of the actual product design.¹⁰⁴ Assuming that the design is used continuously and does not become generic, the combination of design patent and trade dress protection could provide the design a lifetime of protection.¹⁰⁵

A. Pairing Design Patents and Trade Dress Is Tedious

Trade dress application is tedious and difficult to maintain. As a branch of trademark rights, trade dress must comply with the principles of trademark law. One key aspect of trademark law is the abandonment or non-use of a trademark.¹⁰⁶ Non-use of a trademark for three consecutive years results in prima facie evidence of the mark’s abandonment.¹⁰⁷ Additionally, a mark must actually be used in trade

98. See Ferrill & Tanhehco, *supra* note 66, at 299; Herzfeld, *supra* note 53.

99. Manaila, *supra* note 70.

100. *Id.*

101. *See id.*

102. Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 216 (2009).

103. Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 851 n.11 (1982) (citing Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118 (1938)).

104. Herzfeld, *supra* note 53.

105. *See id.*

106. 15 U.S.C. § 1127 (2012).

107. *Id.*

and not simply as a token use to reserve trademark rights.¹⁰⁸ Applying this concept of abandonment to the fashion industry is problematic. It reasons that to keep any trade dress protection, the product design must be sold regularly every three years, regardless of current market demand.¹⁰⁹ Additionally, trademarks (and trade dress) can become generic if the trademark is not protected or becomes widely used to denote a product by multiple brands.¹¹⁰ For example, Chanel created the quilted, flap bag, with chain handle, but never stopped any other brand from using any of these features or combination of these features.¹¹¹ Because there was no push to stop other brands from using these design elements, Chanel lost any ability to claim exclusive use of these elements—even though Chanel first created each of these design elements for handbags.¹¹²

B. Alterations to Designs May Sever Trade Dress Protection

Additionally, slight changes to the original design could create complications for protection under trade dress. Minor alterations made to trademarks (and trade dress) while maintaining the same overall commercial impression is called “tacking.”¹¹³ Tacking a newer trademark onto an older trademark allows the newer mark to maintain the same priority date of the old mark, preventing a different brand from using the change in design to steal priority of the overall design.¹¹⁴ To tack two trademarks, the original and new marks must create the same continuing commercial impression.¹¹⁵ When examining the marks, they must be more than “confusingly similar” to qualify as the same continuing expression.¹¹⁶ This standard is “considerably higher” than the standard used to compare competing marks in a likelihood of confusion analysis.¹¹⁷ This limited concept of tacking indicates that alterations to the trade dress would likely result

108. *Id.*

109. *See id.*

110. *Id.* § 1064(3).

111. *See supra* notes 7–9 and accompanying text.

112. *See* § 1064(3).

113. *KeyCorp v. Key Bank & Tr.*, 99 F. Supp. 2d 814, 819 (N.D. Ohio 2000).

114. *See Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1047–48 (9th Cir. 1999); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 19 (AM. LAW INST.1995) (priority in a mark is granted to the manufacturer who has used the mark first in commerce).

115. *George & Co. v. Imagination Entm’t Ltd.*, 575 F.3d 383, 402 (4th Cir. 2009); *Brookfield Commc’ns, Inc.*, 174 F.3d at 1048 (“[T]acking should be allowed if two marks are so similar that consumers generally would regard them as essentially the same. Where such is the case, the new mark serves the same identificatory function as the old mark.”).

116. *George & Co.*, 575 F.3d at 402.

117. *Brookfield Commc’ns, Inc.*, 174 F.3d at 1048.

in a loss of priority and defeat the purpose of taking the time and effort to obtain the trade dress protection in the first place.¹¹⁸ Slight changes to the trade dress are reasonable and predictable as fashion trends change; it would be likely that designs would also change to some extent on even the most classic styles. Even with the tacking doctrine, the protections afforded by the Lanham Act for trade dress would not sufficiently protect many fashion designs as they alter over time.

C. Design Patents Are Not Fast Enough to Prevent Knockoffs

It seems that as access to images of designer fashions increases, so does the speed of knockoff productions. Major events (such as award shows) introduce new and cutting-edge designs that are knocked off as early as the next day.¹¹⁹ Some designers actually specialize in fast knockoffs of current, high-fashion designs, like Allen B. Schwartz.¹²⁰ Schwartz creates a “replica” of a designer style and an accompanying sketch within three hours of a dress’s premiere.¹²¹ Remember that design patents take roughly one year to obtain,¹²² so designers do not have time to protect fresh designs with a design patent. Without a patent, a design is completely vulnerable to people, like Mr. Schwartz, who make quick copies to reap the benefits of another designer’s hard work and creativity. Additionally, it is impossible to gain the secondary meaning necessary for trade dress protection because a copied style is no longer distinctive of the original designer.¹²³

D. Impact on Design Cycle

Given the tedious nature of combining trade dress and design patents, the combined application could have a real impact on the design cycle. Would design production at all levels be hesitant to produce products? That year long wait for design patents could impact the number of collections that high-end designers produce.¹²⁴ Chanel currently produces six collections every year.¹²⁵ Waiting for design patents for all six shows could impact the brand’s ability to produce new designs and present them at shows if certain garments take the full year to gain a

118. *See id.* at 1048–49.

119. *See, e.g.,* Tom, *Celebrity Dress Knockoffs and Replicas*, THE CELEBRITY DRESSES (Apr. 21, 2014), <http://www.thecelebritydresses.com/blog/2014/04/270/>.

120. *Id.*

121. *Id.*

122. Manaila, *supra* note 70.

123. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2009).

124. *See* Ferrill & Tanhehco, *supra* note 66, at 297–98.

125. *FAQ Fashion*, CHANEL, http://www.chanel.com/en_US/fragrance-beauty/FAQ-28105 (last visited Oct. 9, 2015).

design patent.¹²⁶

At the highest level of fashion, haute couture¹²⁷ design is the most innovative—and thus at high risk for duplication. Haute couture must be presented twice a year and presented for the press.¹²⁸ Waiting for design patent recognition may not be possible when the designation of haute couture requires a certain number of pieces presented bi-annually.¹²⁹ Because these designs must be presented to the press to carry the exclusive label of haute couture, they face an even greater risk of being knocked off when images of the designs are readily available on the Internet mere moments after the presentation.¹³⁰ People like Schwartz are lurking and waiting for the most respected in the industry to do the difficult work for them, then copy it and reap instantaneous benefits of another person's talent and hard work.¹³¹

Accusations of stealing designs are thrown around the fashion industry at all levels. Increased use of intellectual property protections, in the form of a design patent-trade dress combination, mean increased litigation and increased money spent defending designs.¹³² “Roberto Cavalli had a small meltdown over Michael Kors's Fall 2014 collection, accusing the *Project Runway* mentor and his million-dollar commercial fashion operation of ‘stealing’ the works of other brands, including Cavalli's, Celine, Hermes, Louis Vuitton and Tory Burch.”¹³³ Unclear and patched-together protections will result in over-protective, wealthy designers simply proceeding to litigation over the smallest of claims, meaning smaller, less financially stable designers could have a hard time combating even meritless

126. See Manaila, *supra* note 70.

127. *Haute Couture*, MERRIAM-WEBSTER, <http://www.merriam-webster.com/dictionary/haute%20couture> (last visited Oct. 7, 2015) (defining haute couture as “the houses or designers that create exclusive and often trend-setting fashions for women; *also*: the fashions created”).

128. *FAQ Fashion*, *supra* note 125 (answering question: What is Haute Couture?).

129. See *id.*

130. See *id.*; Alexandra Manfredi, Note, *Haute Copyright: Tailoring Copyright Protection to High-Profile Fashion Designs*, 21 CARDOZO J. INT'L & COMP. L. 111, 118 (2012) (“[L]ive Internet and television broadcasts of runway fashion shows and red carpet events enable low-cost contract manufacturers throughout the world to begin working on imitation designs almost instantaneously.”).

131. See Tom, *supra* note 119.

132. See *Innovative Design Protection and Privacy Prevention Act: Hearing on H.R. 2511 Before the Subcomm. on Intellectual Property, Competition, and the Internet*, 112th Cong. 76 (2012) (statement of Christopher Sprigman, Professor of Law, University of Virginia School of Law).

133. Emily Zanotti, *Design Patents Are a Poor Match for High Fashion*, R STREET (Mar. 5, 2014), <http://www.rstreet.org/2014/03/05/design-patents-are-a-poor-match-for-high-fashion/>.

claims.¹³⁴ It seems that while creating unclear standards for the most susceptible high-end brands, wide-spread application of design patents used in conjunction with trade dress protections would deter smaller designers from taking a chance on a design, for fear that it would spark litigation with some designer.¹³⁵

[D]esigners who would most need to protect their work—upcoming and independent labels whose clothes are knocked off most often by consumer-driven fashion entities—would hardly be able to afford the time and fortune that initial paperwork and follow-up litigation would cost; no designer can afford to wait months for a single design to pass through a government initiation process, when runway shows are a bi-annual staple.¹³⁶

VII. WHAT TO DO TO PROTECT A NEW DESIGN

Currently there are limited options for fashion designers to protect new and innovative designs.¹³⁷ Designers should attempt to federally register for any intellectual property protection that could be applicable to each and every design for the greatest chance at protection.¹³⁸ Yet this may not be realistic for many designers, particularly new designers without a significant amount of cash on hand.¹³⁹ Since 2009, designers have increasingly used design patents for intellectual property protection.¹⁴⁰ However this process is a gamble; trying to figure out what aspects to patent is a detailed process that is best done by a team.¹⁴¹ This type of expertise can be expensive and comes from years of experience in the industry—once again putting newer designers at a significant disadvantage.¹⁴² Still, new designers can benefit from design patents if the concept is approached carefully.¹⁴³ If a new designer knows to get a design patent for a great new design and is willing to wait until the patent is issued, that designer can compete on the same level with the biggest names in fashion.¹⁴⁴ However, the designer must be business savvy to know to do this and what design aspects to patent. Design patents seem to be the way designers are going for protection, not out of usefulness, but

134. *Id.*

135. *Id.*

136. *Id.*

137. *See supra* Parts IV, V.

138. Herzfeld, *supra* note 53.

139. Zanotti, *supra* note 133.

140. Geiger Smith, *supra* note 67.

141. *See id.*

142. *See id.*

143. Manaila, *supra* note 70.

144. *See id.*

because of a lack of better alternatives.¹⁴⁵

VIII. REWARD FASHION DESIGN FOR THE CREATIVITY AND INNOVATION IT REQUIRES

Innovation and creativity are things that should be rewarded.¹⁴⁶ The general principles behind intellectual property law support this idea; people that create something new should be able to protect that creation.¹⁴⁷ This idea allows people from all stations in life to succeed based on talent and ideas. Why should the fashion industry be any different? It is a large industry with retail sales reaching \$426.6 billion from January to August 2013.¹⁴⁸ Even stock market investors are recognizing the big business of fashion design.¹⁴⁹ Design house Michael Kors topped Bloomberg Markets' annual rankings of best initial public offerings of 2011—beating out tech giant Facebook.¹⁵⁰ Fashion designers want better protections and there is no reason why this industry is less deserving of protection than any other industry. The federal government needs to take this into consideration and pass a law to protect American industry. The European Union found a way to provide increased protections for fashion design, so why not the United States?¹⁵¹ By passing federal legislation, the United States will remain an attractive market for the fashion industry.¹⁵² If the United States wants the fashion industry to bring its jobs and profits to the United States, then it must first show the fashion industry that the government values the industry by creating more design protections.¹⁵³

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145. *Id.*

146. *See* U.S. CONST. art. I, § 8, cl. 8.

147. *See id.*

148. Manaila, *supra* note 70.

149. *See* Lee Spears & Elizabeth Wollman, *Luxury Beats Tech as Michael Kors Tops IPO Ranking*, BLOOMBERG (July 17, 2012), <http://www.bloomberg.com/news/articles/2012-07-17/luxury-beats-tech-as-michael-kors-tops-ipo-ranking>.

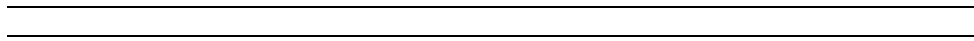
150. *Id.*

151. Manaila, *supra* note 70. The European Union passed legislation that gives original designs three years of unregistered protections and provides additional protection, for up to 25 years, if the design is officially registered. *Id.*

152. *See* 152 Cong. Rec. E472 (extension of remarks Mar. 30, 2006) (statement of Rep. Goodlatte) (introducing the Design Piracy Prohibition Act).

153. *See id.*

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