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## Copyright Subject Matter and a "Light" For Designers' Rights

Matteo Mancinella

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## COPYRIGHT SUBJECT MATTER AND A “LIGHT” FOR DESIGNERS’ RIGHTS

Matteo Mancinella†

### *Abstract*

*Copyright protection in the fashion industry is currently the focus of intense debate in the United States, particularly centered on the utility of special legislation to protect designs from knock-offs. This article focuses on the importance of copyright protection for fashion designers, and the obstacles to copyright currently faced by fashion designers.*

*What is the legal rationale for not providing copyright protection for fashion design? Why are designers’ creations not granted copyright protection? Unlike authors and musicians, fashion designers can only enjoy protection afforded by trademark for logos. Clothing is considered a “useful article”—not eligible for copyright protection—unless it is possible to separate its aesthetic elements from its function. The fact that form and function are usually so linked to each other makes copyright protection irrelevant, and thus design is easily at the mercy of counterfeiting. Herein lies the desire to legislate; but this issue divides the specialists, with some going so far as to argue that knock-offs are positive and stimulating for the fashion industry. This article will expound on this debate as it relates to the Fashion Design Bill, including an analysis of the European Design Law.*

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## I. INTRODUCTION

As of 2012, American intellectual property law provides insufficient protection for fashion design.<sup>1</sup> A fashion designer can register a trademark for his or her label and obtain all the advantages that this registration provides,<sup>2</sup> in addition to the trademark rights that come with the mark's use in commerce.<sup>3</sup> Intellectual property rights can also provide a protection for fashion designers through design patent, but the application process is costly and requires a lot of time.<sup>4</sup> Fashion designs change with every season, and thus designers cannot wait more than a few months to obtain protection for the next season's designs. But is there any protection for a garment under copyright law? Has Congress ever considered the possibility of offering protection for designs of useful articles?

In 1998 Congress, conscious of the boat manufacturers' concerns regarding illegal copying of boat hull designs,<sup>5</sup> enacted the Vessel

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1. See H.R. 5055, 109th Cong. (2006) (proposing amendments to Title 17 of the United States Code (codifying Copyright Act of 1976) in order to recognize copyright protection for fashion design). Over the years, the bill has been revisited several times but it has not been enacted yet. See Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011) [hereinafter IDPPPA], available at <http://www.gpo.gov/fdsys/pkg/BILLS-112hr2511ih/pdf/BILLS-112hr2511ih.pdf> (currently in hearings); Design Piracy Prohibition Act, H.R. 2196, 111th Cong. (2009) (stalled in committee hearings); Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007) (did not survive subcommittee hearings).

2. See, e.g., 15 U.S.C. § 1057(b) (2011) ("A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate."); *id.* § 1065 ("[T]he right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable . . ."); *id.* § 1072 ("Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof."); *id.* § 1111 ("[A] registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words 'Registered in U.S. Patent and Trademark Office' or 'Reg. U.S. Pat. & Tm. Off.' or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.").

3. 15 U.S.C. § 1127 ("The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.").

4. Loni Schutte, Comment, *Copyright for Couture*, 2011 DUKE L. & TECH. REV. no. 11, 2011, at ¶1, available at <http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1225&context=dltr>.

5. See generally *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (providing the "starting signal" for the lawmaker to enact the Vessel Hull Design Protection

Hull Design Protection Act (VHDPA).<sup>6</sup> The provisions of this Act do not provide copyright protection but instead represent a *sui generis* protection only to original vessel hull designs. Specifically, the provisions guarantee ten years of protection<sup>7</sup> for only the aspects of a boat design that make it original and ornamental,<sup>8</sup> and give the registrant the exclusive right to “make, have made, or import, for sale or for use in trade, any useful article embodying that design . . . and . . . sell or distribute for sale or for use in trade any useful article embodying that design.”<sup>9</sup> Similar to design patents, protection is not afforded to design features that are functional or utilitarian.<sup>10</sup>

After years of discussion, and increased litigation due to the copying of clothing by “fast fashion” houses, Congress discussed the possibility of extending protection under Chapter 13 of the Copyright Act of 1976 to fashion design.<sup>11</sup> Although Chapter 13 offers protection only for designs of vessel hulls, the Fashion Design Bill,<sup>12</sup> if enacted, would extend that protection to fashion designs as well, with some exceptions: for example, while the term of protection for vessel hull design is ten years,<sup>13</sup> the term for fashion design will be only three years.<sup>14</sup> Given brevity of fashion design cycles, this shorter term is considered sufficient to guarantee a designer exclusivity in his or her designs.

So why not provide copyright protection for fashion designs? This article argues in favor of such protection. This article will first discuss the doctrines of copyright law that render fashion design unprotectable, and then argue how fashion design can nevertheless

Act); *see also* Kevin Wimberly, *Vessel Hull Design Protection Act—What the Hull?*, FLORIDA IP TRENDS (Feb. 23, 2009), <http://www.floridaiptrends.com/2009/02/23/vessel-hull-design-protection-act-what-the-hull/>.

6. *See* 17 U.S.C. §§ 1301-1332 (2011) (added as part of the Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, 112 Stat. 2905 (1998)).

7. *Id.* § 1305(a) (“[T]he protection provided under this chapter for a design shall continue for a term of 10 years beginning on the date of the commencement of protection . . .”).

8. *Id.* § 1301(a)(1) (“The designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter upon complying with and subject to this chapter.”) (emphasis added).

9. *Id.* § 1308(1)-(2).

10. *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 238 (Fed. Cir. 1986).

11. *See* Schutte, *supra* note 4, ¶¶ 20-23.

12. *See* Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012) (extending protection to fashion design); *see also* IDPPPA, *supra* note 1.

13. 17 U.S.C. § 1305(a).

14. IDPPPA, *supra* note 1, § 2(a).

receive protection. This article will then discuss the European approach to protection for fashion design, and finally discuss the Fashion Design Bill that is currently moving through Congress.

## II. NON-PROTECTABLE CATEGORIES OF WORKS OF AUTHORSHIP UNDER COPYRIGHT LAW

### A. *The Genesis of the Idea/Expression Dichotomy and Judge Hand's Abstraction Test*

Ideas related to fashion design usually involve two important concepts, both separate but related at the same time: the designer's identity and the embodiment of the designer's ideas.<sup>15</sup> At the heart of a fashion designer's identity is his or her creative mind, and from the creative mind springs inspiration, sensitivity, and fantasy that mix and give shape to new and unique ideas. These creative ideas are expressed through the realization of a real and tangible object: the garment.

American copyright law, however, does not protect ideas; it protects only the original way in which ideas are expressed by the author.<sup>16</sup> Scholars have criticized the dichotomy between idea and expression ever since courts first made this distinction,<sup>17</sup> yet courts continue to embrace and even extend the doctrine.<sup>18</sup> Can an idea exist separate from an expression? This article will argue that they go hand in hand.

During the 19th century, courts considered idea and expression to be one and the same, and not separate concepts.<sup>19</sup> However, in the later part of that century, the Supreme Court in *Burrow-Giles Lithographics Co. v. Sarony* articulated the principle that any concrete

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15. David Adler, *Fashion Design & The Law: A Rulebook for Independent Designers & the Marketers Behind Them*, FASHION'S COLLECTIVE (July 30, 2012), <http://fashionscollective.com/FashionAndLuxury/07/fashion-design-the-law-a-rulebook-for-independent-designers-the-marketers-behind-them/>.

16. 17 U.S.C. § 102(b) (2011) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.").

17. See HUGH LADDIE, PETER PRESCOTT & MARY VITORIA, *THE MODERN LAW OF COPYRIGHT* ¶ 2.55, at 33 (1980); see also Edward Samuels, *The Idea-Expression Dichotomy in Copyright Law*, 56 TENN. L. REV. 321, 323-24 (1989), available at <http://www.edwardsamuels.com/copyright/beyond/articles/ideapt1-20.htm>.

18. Samuels, *supra* note 17, at 323-24.

19. See generally *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436).

and tangible incorporation of an idea (i.e., any expression and its manifestation) is protectable.<sup>20</sup> The earlier case of *Baker v. Selden*<sup>21</sup> is considered to have first articulated the dichotomy expressed in *Burrow-Giles*, but it did not explicitly distinguish between an idea and expression. Only subsequent cases interpreting *Baker* articulated the dichotomy,<sup>22</sup> though the Supreme Court itself verbally danced around the distinction between ideas and expressions, without clearly expressing a dichotomy.<sup>23</sup> The Second Circuit more clearly articulated it in the *Dymow v. Bolton*,<sup>24</sup> where the Court stated:

One of the entities or things which every author tries to insert in his copyrighted work is a set of ideas; yet ideas as such are not protected.

Just as a patent affords protection only to the means of reducing an inventive idea to practice, so the copyright law protects the means of expressing an idea; and it is as near the whole truth as generalization can usually reach that, if the same idea can be expressed in a plurality of totally different manners, a plurality of copyrights may result, and no infringement will exist.<sup>25</sup>

In *Nichols v. Universal Pictures Corp.*,<sup>26</sup> Judge Hand provided new nourishment to the doctrine, describing a procedure to differentiate an idea from an expression, based on the concept of “abstraction.”<sup>27</sup> Plaintiff Nichols copyrighted a play called “Abie’s Irish Rose,” which told the story of a young couple, from different religious faiths who married against their families’ wishes.<sup>28</sup> Universal Pictures later produced a movie based on this play, though the movie did not highlight the religious conflicts present in the play.<sup>29</sup> Judge Hand stated: “A comedy based upon conflicts between Irish and Jews, into which the marriage of their children enters, is no

20. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884); Richard H. Jones, *The Myth of the Idea/Expression Dichotomy in Copyright Law*, 10 PACE L. REV. 551, 554 (1990).

21. *Baker v. Selden*, 101 U.S. 99 (1879).

22. *See* Jones, *supra* note 20, at 555.

23. *Holmes v. Hurst*, 174 U.S. 82, 84-86 (1899).

24. *Dymow v. Bolton*, 11 F.2d 690 (2d Cir. 1926).

25. *Id.* at 691 (citing *Kalem Co. v. Harper Bros.*, 222 U.S. 55, 56 (1911); *Holmes*, 174 U.S. 82).

26. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

27. *See* STEPHEN M. MCJOHN, *INTELLECTUAL PROPERTY* 63-64 (3d ed. 2009); Jones, *supra* note 20, at 558.

28. *Nichols*, 45 F.2d at 120.

29. *Id.* at 120, 122.

more susceptible of copyright than the outline of *Romeo and Juliet*.<sup>30</sup> Thus, anyone is free to convey the same elements in different ways; as long as one depicts these elements in different forms, one cannot be found liable for copying. In contrast, infringement occurs if the author copies most of the dialogues, the characters’ features, as well as a particular sequence of scenes.<sup>31</sup> Judge Hand described levels of increased abstraction resulting in ever more increased generality in a work: “[T]here is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ‘ideas,’ to which, apart from their expression, his property is never extended.”<sup>32</sup>

Perhaps the strongest articulation of the idea/expression dichotomy can be found in *Mazer v. Stein*,<sup>33</sup> where the Court explicitly stated that copyright protection is granted, not to the idea, but only to the expression of an idea.<sup>34</sup> Afterwards, most cases involving *non-verbatim* copying were built on this idea/expression dichotomy.<sup>35</sup>

Congress codified the idea/expression dichotomy in the Copyright Act of 1976, where 17 U.S.C. § 102(b),<sup>36</sup> while not explicitly mentioning the word “expression,” considers it incorporated.<sup>37</sup> In addition, § 102(a) clearly and unequivocally states that copyright protection can be extended only to “original works of authorship.”<sup>38</sup>

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30. *Id.* at 122.

31. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54-56 (2d Cir. 1936); *see also* MCJOHN, *supra* note 27, at 64.

32. *Nichols*, 45 F.2d at 121.

33. *Mazer v. Stein*, 347 U.S. 201 (1954).

34. *Id.* at 217 (“[Copyright] protection is given only to the expression of the idea—not the idea itself.”).

35. *See, e.g.*, *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 434-35 (4th Cir. 1986) (holding that the idea of a poker video game cannot be copyrighted, but the particular shapes, sizes, colors, sequences, arrangements, and sounds that comprise a specific expression of the game can be); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 915 (2d Cir. 1980) (holding that the copied features of a simple game were solely the mechanical, utilitarian aspects of the toys); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971) (holding that the idea of a jeweled bee pin cannot be copyrighted, and only an exact copy of the pin at issue would constitute infringement); *Jones*, *supra* note 20, at 559.

36. 17 U.S.C. § 102(b) (2011).

37. *See Jones*, *supra* note 20, at 560.

38. § 102(a).

Copyright protection subsists, in accordance with this title, in *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



Yet some commentators rightfully argue that the idea/expression dichotomy is irrelevant to copyright law, because all expressions emanate from ideas.<sup>39</sup> Considering ideas and expressions as two different categories under copyright protection—non-copyrightable ideas and copyrightable expressions of those ideas—will not help judges determine which expressions are indeed protectable and whether these expressions have been infringed.<sup>40</sup>

### *B. The Functionality Exception in Copyright Law and a Brief Analysis of Some Recent Cases*

#### 1. What Does Copyright Mean for Functionality?

Functional elements of works are not subjected to copyright protection. Clothing is considered inherently functional, and thus various attempts to copyright articles of clothing have failed.<sup>41</sup> The

communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

*Id.* (emphasis added).

39. See, e.g., Jones, *supra* note 20, at 605-07.

40. See *id.* at 607.

Since “idea” and “expression” are simply labels applied to the conclusions reached after a court has examined particular expressions at issue in a case, merely invoking the dichotomy as justification would be circular. Reasons related to the originality and creativity involved in devising the form of a writing will need to be advanced. That the dichotomy appears to be part of a court’s decision-making process at all is an illusion. At best, the idea/expression dichotomy is superfluous; at worst, it disguises the court’s true reasoning as to which expressions are protectable.

*Id.*

41. See, e.g., *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 422 (5th Cir. 2005) (providing that clothing designs for casino workers were not copyrightable absent showing that they were marketable independently of their utilitarian function as casino uniforms); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995) (stating that clothing has an “intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information” and therefore is not copyrightable); *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 456 (2d Cir. 1989) (noting that a costume could not be protected as a “soft sculpture” because “[t]he intended depiction is in fact recognizable only when the costume is worn by a person”).

Copyright Act, in fact, provides for a peremptory classification of elements which are not protected by copyright.<sup>42</sup> The Supreme Court in *Baker v. Selden*<sup>43</sup> held that ideas cannot be copyrighted, and as mentioned above, was later codified in § 102(b). Specifically, the *Baker* Court held that possessing the copyright for a book does not provide its author with an exclusive right to prevent anyone from using the *system* described in the book<sup>44</sup>. Selden owned the copyright in a book<sup>45</sup> which

consist[ed] of an introductory essay explaining the system of book-keeping referred to, to which [were] annexed certain forms or banks, consisting of ruled lines, and headings, illustrating the system and showing how it is to be used and carried out in practice. This system effect[ed] the same results as book-keeping by double entry; but, by a peculiar arrangement of columns and headings, present[ed] the entire operation, of a day, a week, or a month, on a single page, or on two pages facing each other, in an account-book.<sup>46</sup>

Baker "use[d] a similar plan so far as results [were] concerned; but [made] a different arrangement of the columns, and use[d] different headings."<sup>47</sup> While Selden alleged that Baker made and used "account-books arranged on substantially the same system," he "fail[ed] to show that [Baker] has violated the copyright of Selden's book, regarding the latter merely as an explanatory work."<sup>48</sup>

Selden could not protect the accounting method inherent in the published tables because the method was indispensable from the overall bookkeeping system.<sup>49</sup> In addition, Selden tried to assert patent protection for this method, without actually obtaining a patent.<sup>50</sup> Copyright protection requires only originality,<sup>51</sup> whereas one of the key requirements of patentability is novelty of the invention.<sup>52</sup>

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42. 17 U.S.C. § 102(b) (2011).

43. *Baker v. Selden*, 101 U.S. 99 (1879).

44. *Id.* at 104.

45. *Id.* at 99-100 ("Charles Selden . . . in the year 1859 took the requisite steps for obtaining the copyright of a book, entitled 'Selden's Condensed Ledger, or Book-keeping Simplified,' the object of which was to exhibit and explain a peculiar system of book-keeping.").

46. *Id.* at 100.

47. *Id.*

48. *Id.* at 101; *see also* Samuels, *supra* note 17, at 326-27.

49. *Baker*, 101 U.S. at 104.

50. *Id.* at 102.

51. Jones, *supra* note 20, at 586.

52. 35 U.S.C. § 102 (2011).

Thus, copyright does not protect the use of a method or process but it might protect its explanation, and thus a manifestation of expressing the method or process. Furthermore, the Court, analyzing the difference between the use of a work and its explanation, stated:

[W]hilst no one has a right to print or publish [Selden's] book, or any material part thereof, as a book intended to convey instruction in the art, any person may practise and use the art itself which he has described and illustrated therein. The use of the art is a totally different thing from a publication of the book explaining it.<sup>53</sup>

The Court thus based infringement on the reason for which a copy is made.<sup>54</sup>

But an expression might also be uncopyrightable, through a line of reasoning known as the merger doctrine. The court in *Morrissey v. Proctor & Gamble Co.*,<sup>55</sup> held the work as not protected by copyright, and reasoned:

[T]o permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. In such circumstances it does not seem accurate to say that any particular form of expression comes from the subject matter. However, it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated.<sup>56</sup>

Summarized, *Morrissey* expresses that an idea and expression can be so closely linked as to be inseparable, and thus not be copyrightable.

Functional elements cannot be protected under copyright law but may be patentable. While an element that is original and creative is copyrightable, an element can *only* be granted patent protection if it is functional. Hence, whether copyright or patent law applies revolves around whether an element is functional or creative.<sup>57</sup> Yet a work can have a protected creative expression and be functional too.<sup>58</sup> It is crucial, however, to distinguish the protected expressive elements from the unprotected functional aspects.<sup>59</sup>

53. *Baker*, 101 U.S. at 104.

54. Samuels, *supra* note 17, at 327.

55. *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967).

56. *Id.* at 678-79.

57. MCJOHN, *supra* note 27, at 73-74.

58. *Id.* at 74.

59. *Id.* See also *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144-45 (2d Cir. 1987) (addressing whether a design for a bicycle rack could be granted a copyright).

More precisely, every creative element of a work has a function: a phrase in a poem can “awaken” feelings, for instance. Therefore, courts usually consider different factors to decide whether or not an element is functional. One such factor is whether the element improves the productivity of a process or whether the element is indispensable for compatibility with other work.<sup>60</sup> Another approach refers to the different categories listed in § 102(b),<sup>61</sup> for example, whether the elements represent a process or a system not subject to copyright protection.<sup>62</sup>

As can be seen from cases such as *Galiano v. Harrah’s Operating Co.*,<sup>63</sup> an essential factor in determining whether clothing is copyrightable is whether an element is functional or creative. The fact that functional elements are not protected by copyright is especially relevant in the context of technology, which has become increasingly vital and prominent in society. For example, today’s advancements in software allow us to record all events, both small and momentous.<sup>64</sup> More generally, the question is: what protection does copyright law provide for software, given the functional aspects of software?

## 2. Software Functionality: *Oracle v. Google* and the European Court of Justice Decision in *SAS v. World Programming Limited*

Copyright law considers clothing a useful article because of its natural utilitarian function.<sup>65</sup> This maxim, however, might be subject

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The court explained “conceptual separability,” relying on Prof. Denicola’s article, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741-42 (1983), and noted that “if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. . . . [W]here design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.” *Brandir Int’l, Inc.*, 834 F.2d at 1145. The court denied copyright protection to the RIBBON rack (the product in question), and stated that “the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements. This is true even though the sculptures which inspired the RIBBON Rack may well have been—the issue of originality aside—copyrightable.” *Id.* at 1147. The court added: “In creating the RIBBON Rack, the designer has clearly adapted the original aesthetic elements to accommodate and further a utilitarian purpose.” *Id.*

60. MCJOHN, *supra* note 27, at 75.

61. *Id.* at 73.

62. *Id.*

63. *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 415 (5th Cir. 2005).

64. MCJOHN, *supra* note 27, at 75.

65. STEPHEN M. MCJOHN, COPYRIGHT 136-37 (3d ed. 2012).

to some exceptions: for instance, a dress worn as a costume might serve more than a mere utilitarian function.<sup>66</sup> In contrast, however, while clothing can be considered a “useful article,” the same rule cannot be said for computer programs.<sup>67</sup> Computer programs,<sup>68</sup> though functional, are eligible for protection as literary works,<sup>69</sup> with some limitations.<sup>70</sup>

Copyright protection for computer programs raises several important questions: does copyright law protect programming languages, data and file formats, and/or the structure of a computer program? Since copyright protection under 17 U.S.C. § 102(b) does not cover processes, systems, or methods of operation, which parts of a computer program are copyrightable? More specifically, which, if any, of these parts may be copied without infringing copyright-rights?<sup>71</sup> Recent cases have touched on these questions<sup>72</sup> and have articulated some limits to the scope of protection for such programs.

In 2005, Sun Microsystems, the developer of the Java programming language, negotiated over several months the possibility of licensing Java application programming interfaces (APIs) to Google for use in developing Google’s Android smart phone operating system.<sup>73</sup> Sun Microsystems was subsequently acquired by Oracle, and Oracle then sued Google for infringing Java-related copyrights and patents.<sup>74</sup> The jury found that Google had infringed Oracle’s copyrights in the Java application programming interfaces

66. *Id.* at 137.

67. *Id.*

68. 17 U.S.C. § 101 (2011) (“A ‘computer program’ is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.”).

69. *Id.* (“‘Literary works’ are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.”). However, computer programs are subjected to copyright protection whether in source code, object code, or other form. *See generally* MCJOHN, *supra* note 65, at 128-33.

70. § 117; *see also* MCJOHN, *supra* note 27, at 76.

71. *See* Barry Sookman, *So You Want to Protect Computer Programs by Copyright, the Oracle v Google and SAS v WPL Cases*, BARRY SOOKMAN (June 3, 2012), <http://www.barrysookman.com/2012/06/03/so-you-want-to-protect-computer-programs-by-copyright-oracle-v-google-and-the-sas-v-wpl-cases/>.

72. *See, e.g.*, Oracle Am., Inc. v. Google Inc., 872 F. Supp. 2d 974 (N.D. Cal. 2012); Case C-406/10, SAS Inst. Inc. v. World Programming Ltd., 2012 E.C.R. (not yet published), available at <http://curia.europa.eu/juris/document/document.jsf?text=&docid=122362&pageIndex=0&doclang=EN&mode=doc&dir=&occ=first&part=1&cid=710990>.

73. *Oracle Am., Inc.*, 872 F. Supp. 2d at 978.

74. *Id.* at 975.

(APIs), but was unable to resolve whether Google's copying was fair use, a defense to the infringement claim.<sup>75</sup> In the second phase of the trial, however, the jury did not find any patent infringement by Google.<sup>76</sup> Specifically, the jury found that Android, Google's smart phone operating system, did not infringe two Oracle patents.<sup>77</sup> In the end, however, the district court rejected Oracle's claims of infringement of the APIs:

To accept Oracle's claim would be to allow anyone to copyright one version of code to carry out a system of commands and thereby bar all others from writing their own different versions to carry out all or part of the same commands. No holding has ever endorsed such a sweeping proposition.<sup>78</sup>

The Java API "is composed of keywords and other symbols and a set of pre-written programs to carry out various commands."<sup>79</sup> Judge Alsup distinguished the function that each command carries out from the specific code used to implement that command, and held that while the underlying code could be copyrighted,<sup>80</sup> the names and structure of the commands are intrinsically tied to their operation, and thus are functional and cannot be copyrighted.<sup>81</sup>

This decision is of vital importance, since it might change how software programmers will use programming languages, including Java,<sup>82</sup> when developing their own programs. In October 2012, both Oracle and Google filed notices of appeals to the United States Court of Appeals for the Federal Circuit.<sup>83</sup> In February 2013, Oracle filed its opening brief.<sup>84</sup> The litigation is ongoing, and it is also quite possible that this case may even reach the U.S. Supreme Court in the next few years.

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75. *Id.* at 975-76; *see also* Sookman, *supra* note 71.

76. Brittany Horth, *Jury Decides Google Did Not Infringe Oracle Patents but Question of Whether APIs Can Be Copyrighted Remains*, JOLT DIG. (May 30, 2012), <http://www3.law.harvard.edu/journals/jolt/2012/05/30/oracle-america-inc-v-google-inc/>.

77. U.S. Patent No. RE38,104 E (filed Mar. 3, 1999); U.S. Patent No. 6,061,520 (filed Apr. 7, 1998).

78. *Oracle Am., Inc.*, 872 F. Supp. 2d at 1002.

79. *Id.* at 977.

80. *Id.* at 997.

81. *Id.*

82. Horth, *supra* note 76.

83. Plaintiff Oracle America, Inc.'s Notice of Appeal, *Oracle Am., Inc.*, 872 F. Supp. 2d 974 (No. 3:10-cv-03561-WHA); Notice of Appeal, *Oracle Am., Inc.*, 872 F. Supp. 2d 974 (No. 3:10-cv-03561-WHA).

84. Opening Brief and Addendum of Plaintiff-Appellant, *Oracle Am., Inc. v. Google Inc.*, No. 13-01021 (Fed. Cir. Feb. 13, 2013).

Recently, the European Court of Justice (ECJ) also decided that the functionality of software cannot receive copyright protection.<sup>85</sup> This case raised several questions, among them whether Article 1(2) of Directive 91/250<sup>86</sup> must be interpreted to mean that the functionality of a computer program represents a form of expression and, thus can receive copyright protection.<sup>87</sup> The ECJ said no, and stated:

[N]either the functionality of a computer program nor the programming language and the format of data files used in a computer program in order to exploit certain of its functions constitute a form of expression of that program for the purposes of Article 1(2) of Directive 91/250.

...

Consequently, ... Article 1(2) of Directive 91/250 must be interpreted as meaning that neither the functionality of a computer program nor the programming language and the format of data files used in a computer program in order to exploit certain of its functions constitute a form of expression of that program and, as such, are not protected by copyright in computer programs for the purposes of that directive.<sup>88</sup>

By deciding that functionality of software cannot receive copyright protection, the ECJ set limitations on the ways in which vendors can bind customers under licensing agreements<sup>89</sup>:

[T]he owner of the copyright in a computer program may not prevent, by relying on the licensing agreement, the person who has obtained that licence from determining the *ideas and principles which underlie all the elements of that program* in the case where that person carries out acts which that licence permits him to perform and the acts of loading and running necessary for the use of the computer program, and on condition that that person does not infringe the exclusive rights of the owner in that program.<sup>90</sup>

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85. See Case C-406/10, *SAS Inst. Inc. v. World Programming Ltd.*, 2012 E.C.R. (not yet published), available at <http://curia.europa.eu/juris/document/document.jsf?text=&docid=122362&pageIndex=0&doclang=EN&mode=doc&dir=&occ=first&part=1&cid=710990>.

86. Council Directive 91/250 on the Legal Protection of Computer Programs, art. 1, 1991 O.J. (L 122) 42, 44 (EC), available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:1991:122:0042:0046:EN:PDF>.

87. Horth, *supra* note 76.

88. *SAS Inst. Inc.*, 2012 E.C.R. ¶¶ 39, 46.

89. Richard Chirgwin, *Software Functionality Not Subject to Copyright: EU Court*, THE REGISTER (May 3, 2012), [http://www.theregister.co.uk/2012/05/03/wpl\\_vs\\_sas\\_eu\\_court/](http://www.theregister.co.uk/2012/05/03/wpl_vs_sas_eu_court/).

90. See *SAS Inst. Inc.*, 2012 E.C.R. ¶ 59 (emphasis added).

In addition, in citing Article 5(3) of Directive 91/250 on the legal protection of computer programs<sup>91</sup> the ECJ stated that “[i]deas and principles which underlie any element of a computer program, including those which underlie its interfaces, are not protected by copyright under [Article 1 of Directive 91/250].”<sup>92</sup> Thus, in contrast to the holding in *Oracle*, in the European Union a company can license the code that implements the functionality of a programming language, and reuse that code verbatim without violating copyright law.<sup>93</sup>

This holding that a competitor of SAS can develop a product that “incorporates features of SAS” by using SAS’s own language represents a significant success “for software developers in Europe and should mean ‘owners’ of [programming] languages . . . cannot claim ownership of programs built using a specific language.”<sup>94</sup>

### 3. Useful Articles: The Distinction Between Separability and Functionality

Copyright law does not protect ideas but only those original and creative works of authorship “fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>95</sup> This means that, if painted today, the canvas that has painted upon it *The Birth of Venus* would receive copyright protection, even though it is an embodiment (“*tempera*”) of an idea that Botticelli had in his mind. And all creative works, of course, are inherently based on, and incorporate, ideas. For example, the artistic technique of fresco, a method of laying pigment into fresh plaster, was masterfully applied by two of the most famous artists of the Italian High Renaissance Art: Raffaello Sanzio da Urbino (known as Raphael), in painting one of his *magna opera* *La Scuola di Atene* (1508-1511),<sup>96</sup> and Michelangelo di Lodovico Buonarroti Simoni

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91. Council Directive 91/250, *supra* note 86, art. 5.

92. See *SAS Inst. Inc.*, 2012 E.C.R. ¶ 31.

93. See Lawrence Latif, *EU Court Rules Programming Languages Cannot Be Copyrighted*, THE INQUIRER (May 2, 2012), <http://www.theinquirer.net/inquirer/news/2172127/eu-court-rules-programming-languages-copyrighted>.

94. *Id.*

95. 17 U.S.C. § 102(a) (2011).

96. Pope Giulio II commissioned *La Scuola di Atene* (The School of Athens) from Raphael, who painted it in the Pope’s private library, called *Stanza della Segnatura*. Raphael realized four frescoes, one for each wall, each depicting a humanistic art: *La Scuola di Atene* is dedicated to philosophy, and walls represent Theology, Justice, and Poetry. See *Room of the*



(commonly known as Michelangelo), in his masterpiece *Il Giudizio Universale* (1536-1541).<sup>97</sup> Both paintings embody the fresco method of painting, but if painted today the fact that both embody this method would still allow them to be protected: “[I]n truly creative works, the aesthetic features of the work either dominate or may be separated from the ideas or methods embodied therein.”<sup>98</sup> At the time these works were painted, however, they were unprotected not because of the nature of their embodiment, but because there was no copyright law.

Following this line of reasoning, Congress amended the Copyright Act with the explicit intention to prevent copyright protection for useful articles.<sup>99</sup> A “useful article” is protectable only if its aesthetic peculiarities are separable from its utilitarian function,<sup>100</sup> in which case only the aesthetic aspects can receive copyright protection.<sup>101</sup> Unlike trademark law, “in copyright law it is precisely the utilitarian and non-aesthetic aspect of apparel and shoes that leaves fashion design unprotected from copying.”<sup>102</sup> Professor

*Segnatura* (1508-1511), VATICAN MUSEUMS, [http://mv.vatican.va/3\\_EN/pages/SDR/SDR\\_03\\_SalaSegn.html](http://mv.vatican.va/3_EN/pages/SDR/SDR_03_SalaSegn.html) (last visited Feb. 23, 2013).

97. Michelangelo painted *Il Giudizio Universale* (The Last Judgment) on the altar wall of the Sistine Chapel. It was commissioned by Pope Clement VII, who died before it was completed. BERNADINE BARNES, MICHELANGELO’S LAST JUDGMENT: THE RENAISSANCE RESPONSE 4-5 (1998).

98. Martin P. Michael, Partner, Sonnenschein Nath & Rosenthal LLP, PowerPoint Panel Presentation at the Intellectual Property Owners Annual Meeting 2007: US Copyright Law—Separability/Functionality: A Big Hurdle for Most Industrial Designs, slide 4 (Sept. 11, 2007), available at <http://www.ipo.org/AM/Template.cfm?Section=Calendar&Template=/CM/ContentDisplay.cfm&ContentID=16122> (explaining the distinction between separability and functionality).

99. *Id.* slide 5.

100. *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144-45 (2d Cir. 1987).

101. 17 U.S.C. § 101 (2011) (“[T]he design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified *separately from*, and are *capable of existing independently of*, the utilitarian aspects of the article.”) (emphasis added); see also *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) (holding that decorative belt buckles could be copyrighted because of their primary ornamental aspects that were conceptually separate from their subsidiary utilitarian function).

102. Jeannie Suk, *Little Red (Litigious) Shoes*, N.Y. TIMES (Jan. 21, 2012), [http://www.nytimes.com/2012/01/22/opinion/sunday/louboutin-and-the-little-red-litigious-shoes.html?\\_r=0#](http://www.nytimes.com/2012/01/22/opinion/sunday/louboutin-and-the-little-red-litigious-shoes.html?_r=0#). The question of whether a color could be trademarked by a fashion designer was addressed by federal courts in 2012. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012). The fashion house Christian Louboutin had applied for and obtained a valid trademark for a particular shade of red, placed on the soles of women’s high-end shoes. *Id.* at 211-13. Yves Saint Laurent (YSL), in 2011, introduced a line of shoes that also featured red soles. *Id.* at 213. Louboutin requested a temporary injunction

Buccafusco claims that copyright law usually involves works creating an aesthetic interest that involves sight and sounds, whereas touch and taste generally accompanies invention protected under patent law.<sup>103</sup> Yet one could envision extending copyright protection to works of authorship that appeal to all the senses: sight, smell, taste, touch, and hearing.

Knowing if a work is a useful article is important especially because of different interpretations of the separability doctrine, which governs the “general exclusion of functionality from copyright.”<sup>104</sup> Courts have articulated different approaches to the separability rule: most require conceptual separability,<sup>105</sup> which means that one is able to conceptualize the creative element of a work as existing on its own, separate from the functional object the creative element is associated with. Other courts require physical separability<sup>106</sup>: “[W]e have not doubted that when a component of a useful article can actually be removed from the original item and separately sold, without adversely impacting the article’s functionality, that *physically* separable design

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prohibiting YSL from selling red-soled shoes, *id.* at 213-14, but district court Judge Marrero denied the request, holding that a color cannot be trademarked in fashion: “[Color] elementally performs a creative function; it aims to please or be useful, not to identify and advertise a commercial source.” *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F.Supp.2d 445, 452 (S.D.N.Y. 2011), *aff’d in part, rev’d in part, and remanded by Christian Louboutin S.A.*, 696 F.3d 206. Some commentators criticized the trial court decision for not clarifying when a color is a design element and when it is a trademark. *Louboutin v YSL: Lay Off My Red-Soled Shoes*, THE ECONOMIST (Aug. 20, 2011), <http://www.economist.com/node/21526357>. The decision also runs contrary to cases that have held the color could be trademarked. *See, e.g.*, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (green-gold color for dry cleaning press pads could be trademarked); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (pink color for fiberglass insulation was not barred from trademark registration); *Société des Produits Nestlé S.A. v. Cadbury UK Ltd.*, [2012] EWHC (Ch) 2637 (Eng.) (purple color for chocolate wrappers was allowed to be registered as trademarks). The Second Circuit also disagreed with the Judge Marrero. *See Christian Louboutin S.A.*, 696 F.3d 206. It did not grant the injunction; instead, it remanded the case to the district court holding that Louboutin had a valid trademark (although only for the red shoe soles, and not for a shoe that is entirely red, as YSL’s supposedly infringing shoe was). *See id.* at 228-29. At the same time, Louboutin lost on the same issue against Zara in the France’s highest court—Cour de Cassation. *See Charlotte Cowles, Christian Louboutin Loses Another Red-Sole Lawsuit, This Time in France*, THE CUT (June 11, 2012, 3:00 PM), <http://nymag.com/thecut/2012/06/louboutin-lost-another-red-sole-lawsuit.html>.

103. Christopher J. Buccafusco, *Making Sense of Intellectual Property Law*, 97 CORNELL L. REV. 501, 505-06 (2012).

104. MCJOHN, *supra* note 27, at 81.

105. *See, e.g.*, *Jovani Fashion, Ltd. v. Fiesta Fashions*, No. 12-598-cv, 2012 WL 4856412 (2d. Cir. Oct. 15, 2012); *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004).

106. *See Michael, supra* note 98, slides 10-20.

element may be copyrighted.”<sup>107</sup> While the functional aspects of a work can be protected by a patent, the same functional elements cannot receive both patent and copyright protection.<sup>108</sup>

Conceptual separability is illustrated in cases such as *Gay Toys, Inc. v. Buddy L Corp.*<sup>109</sup> in which the district court found a toy airplane not protectable by copyright because toys are useful articles that permit “a child to dream and to let his or her imagination soar”.<sup>110</sup> The Court of Appeals reversed, stating:

[A] toy airplane is merely a model which portrays a real airplane. To be sure, a toy airplane is to be played with and enjoyed, but a painting of an airplane, which is copyrightable, is to be looked at and enjoyed. Other than the portrayal of a real airplane, a toy airplane, like a painting, has no intrinsic utilitarian function.

This interpretation is supported by legislative history as well. . . . The function of toys is much more similar to that of works of art than it is to the “intrinsic utilitarian function” of industrial products.

Indeed, under the district court’s reasoning, virtually any “pictorial, graphic, and sculptural work” would not be copyrightable as a “useful article.”<sup>111</sup>

Similarly, one court found that nose masks are not “useful articles” as defined by 17 U.S.C. § 101,<sup>112</sup> and are therefore protectable as sculptural works.<sup>113</sup> As in *Gay Toys*, the Third Circuit reversed the lower court’s decision, noting:

That nose masks are meant to be worn by humans to evoke laughter does not distinguish them from clearly copyrightable works of art like paintings. When worn by a human being, a nose mask may evoke chuckles and guffaws from onlookers. When hung on a wall, a painting may evoke a myriad of human emotions, but we would not say that the painting is not copyrightable because

107. *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 329 (2d Cir. 2005) (emphasis added).

108. *Mazer v. Stein*, 347 U.S. 201, 218 (1954) (“The copyright protects originality rather than novelty or invention-conferring only ‘the sole right of multiplying copies.’ . . . The dichotomy of protection for the aesthetic is not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents.”) (footnote omitted).

109. *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970 (6th Cir. 1983).

110. *Id.* at 973 (quoting *Gay Toys, Inc. v. Buddy L Corp.*, 522 F. Supp. 622, 625 (E.D. Mich. 1981)).

111. *Gay Toys, Inc.*, 703 F.2d at 973.

112. *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 670 (3d Cir. 1990).

113. 17 U.S.C. § 102(a)(5) (2011) (listing sculptural works as subject matter protected by copyright).

its artistic elements could not be separated from the emotional effect its creator hoped it would have on persons viewing it. The utilitarian nature of an animal nose mask or a painting of the crucifixion of Jesus Christ inheres solely in its appearance, regardless of the fact that the nose mask’s appearance is intended to evoke mirth and the painting’s appearance a feeling of religious reverence.<sup>114</sup>

Prior to the passage of the 1976 Copyright Act, C.F.R. § 202.10(c) provided the definition for a useful article, describing it as one in which its “sole intrinsic function” is its utility.<sup>115</sup> Section 101 of the 1976 Copyright Act, however, only uses the words “intrinsic function” to describe useful articles.<sup>116</sup> In *Kieselstein*, the Court observed that: “Congress in the 1976 Act may have somewhat narrowed the sweep of the former regulations by defining a ‘useful article’ as one with ‘an intrinsic utilitarian function,’ . . . instead of one, in the words of the old regulations, with utility as its ‘sole intrinsic function’ . . . .”<sup>117</sup>

Courts therefore need not determine whether an article’s function is solely utilitarian. Rather, an article with an intrinsic utilitarian function is eligible for copyright protection if its artistic characteristics can be separated and can independently exist as a work of art, separate from the function of the article.<sup>118</sup>

An example of an article that is intrinsically utilitarian that at the same time has artistic characteristic is fabric: designs printed on fabric can be copyrighted.<sup>119</sup> Yet, incongruously, the design of a dress,

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114. *Masquerade Novelty, Inc.*, 912 F.2d at 671.

115. 37 C.F.R. § 202.10(c) (19) (repealed 1978) (“If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.”)

116. THOMAS G. FIELD, JR., INTRODUCTION TO INTELLECTUAL PROPERTY: CASES & MATERIALS 191 (2003).

117. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (citing 17 U.S.C. § 101 (1976); 37 C.F.R. § 202.10(c) (1977) (repealed 1978)).

118. *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411 (2d Cir. 1985). The court stated that an article with ornamental features is not copyrightable. *Id.* at 418. Judge Newman’s dissenting opinion took a different approach, affirming that the distinction between function and aesthetics, indispensable to obtain copyright protection, is only conceptual. *Id.* at 422. Hence the ornamental characteristics should be copyrightable if function and aesthetics are conceptually separable for a reasonable observer. *Id.* In this case, the features should be protected by copyright because an observer could see the mannequins’ ornamental qualities without envisaging the function of the mannequins themselves. *Id.* at 422-423.

119. See, e.g., *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 490 (2d Cir. 1960).

which can exist independently as a work of art, cannot be copyrighted. This is so because copyright law has not budged from the stance that the main purpose is “just” to cover a person’s body, and decoration is only a secondary purpose.<sup>120</sup> Lack of protection creates a fertile breeding ground for design piracy. To avoid design piracy, the law should be better to protect fashion designers’ rights.

### III. IS A NEW ERA FOR DESIGNERS STARTING? THE E.U. DESIGN REGULATION AND THE AMERICAN FASHION DESIGN BILL

#### A. *The E.U. Community Design Regulation: A Breath of Fresh Air for European Design*

In 2001 the European Council adopted the Community Design Regulation.<sup>121</sup> This Regulation provides a uniform system of protection for designs.<sup>122</sup> While the intent of this Regulation is to improve the free movement of goods, it has the consequential effect of combating counterfeiting,<sup>123</sup> a problem that certain Community Member States have been attempting to tackle on their own.<sup>124</sup>

120. See Charles F. Reidelbach & Christina Wilson, *Protect Your Work: Copyright Your Clothing Designs*, HIGGS, FLETCHER & MACK LLP NEWSLETTER, Apr. 2002.

121. See Council Regulation 6/2002, 2002 O.J. (L 3) 1 (EC) [hereinafter Community Design Regulation], available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:003:0001:0024:EN:PDF>; see also Commission Regulation 2245/2002, 2002 O.J. (L 341) 28 (EC), available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:341:0028:0053:EN:PDF> (implementing Community Design Regulation).

122. Community Design Regulation, *supra* note 121, art. 3(a).

123. In Europe and especially in France, which provides the strongest standard of protection, original designs can receive protection; but because most clothing lacks originality, most fashion designs are freely imitated. See Guillermo C. Jimenez, *Fashion Law: Overview of a New Legal Discipline*, in FASHION LAW: A GUIDE FOR DESIGNERS, FASHION EXECUTIVES, AND ATTORNEYS 3, 16-17 (Guillermo C. Jimenez & Barbara Kolsun eds., 2010); Donald L. Kreindler, *Selling and Buying: Commercial Agreements in the Fashion Sector*, in FASHION LAW: A GUIDE FOR DESIGNERS, FASHION EXECUTIVES, AND ATTORNEYS, *supra*, at 170.

124. On May 9, 2012, the Italian Minister of Economic Development, Infrastructure, and Transport, received a plan to combat counterfeiting from the Anti-Counterfeiting National Council (CNAC). See *Lotta Contraffazione: Presentato Piano Strategico, CNAC Individua Priorità* [Combating Counterfeiting: Presenting the Strategic Plan and Identifying Priorities], MINISTERO DELLO SVILUPPO ECONOMICO (May 14, 2012), [http://www.uibm.gov.it/index.php?option=com\\_content&view=article&id=2005757%3Alotta-contraffazione-presentato-piano-strategico-cnac-individua-priorita-&catid=10%3Anotizie&lang=it](http://www.uibm.gov.it/index.php?option=com_content&view=article&id=2005757%3Alotta-contraffazione-presentato-piano-strategico-cnac-individua-priorita-&catid=10%3Anotizie&lang=it) (It.). The strategic plan lists a set of priorities to combat counterfeiting that were identified by thirteen committees operating under the CNAC, 150 experts, and more than seventy organizations from the enterprise, consumer, and government sectors. *Id.* The CNAC’s President enunciated macro priorities in six areas: communication and information, enforcement, reinforcement of the territorial defense, company training, combating counterfeiting on the Internet, and protection of the “Made in Italy” label from the effects of

Counterfeiting, however, is an expensive, global problem,<sup>125</sup> and

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foreign encroachment. *Id.* The Council of Legal Experts divided the most pressing issues into two categories: legislative measures and organizational/institutional measures. *Id.* Action plans for the anti-counterfeiting efforts presented in the Strategic Plan will be submitted by the end of 2012. *Id.* In addition, the Italian Ministry of Economic Development—General Directorate for Combating Counterfeiting—Italian Patent and Trademark Office (UIBM) and the National Association of Italian Municipalities (ANCI) signed on December 30, 2010 an agreement that establishes territorial initiatives aimed at promoting, coordinating and monitoring activities to combat counterfeiting and to manage computerized data. See *Anticontraffazione—Disponibile L'Avviso Pubblico per i Comuni [Anti-Counterfeiting—Public Notice for Municipalities]*, MINISTERO DELLO SVILUPPO ECONOMICO, [http://www.uibm.gov.it/index.php?option=com\\_content&view=article&id=2005911%3Aanticontraffazione-disponibile-lavviso-pubblico-per-i-comuni-&lang=it](http://www.uibm.gov.it/index.php?option=com_content&view=article&id=2005911%3Aanticontraffazione-disponibile-lavviso-pubblico-per-i-comuni-&lang=it) (last visited Feb. 24, 2013) (It.). This agreement allocates resources amounting to € 1.5 million to municipalities for anti-counterfeiting actions; the municipalities have requested financing for activities relating to prevention and combating of counterfeiting, for promoting a culture of legality, and for dissemination of accurate information on counterfeit products. *Id.* To ensure participation by municipalities in the agreement, and to give maximum publicity on the national level, ANCI has prepared and published a notice addressed to the Italian Municipalities. *Id.* On Monday, October 22, 2012, Censis—an Italian research institute—presented in Rome the results of its counterfeiting research. *Ricerca Censis—MSE Sulla Contraffazione [Censis-MSE Counterfeiting Study]*, MINISTERO DELLO SVILUPPO ECONOMICO (Oct. 12, 2012), [http://www.uibm.gov.it/index.php?option=com\\_content&view=article&id=2006012%3Aricerca-censis-mse-sulla-contraffazione&lang=it](http://www.uibm.gov.it/index.php?option=com_content&view=article&id=2006012%3Aricerca-censis-mse-sulla-contraffazione&lang=it) (It.). The presentation was an important opportunity to evaluate and assess various policies and interventions in the fight against counterfeiting and actions to be undertaken in the near future. *Id.* The research conducted by Censis—three years in the making—analyzes the extent and harmful economic effects (in terms of lost tax revenue, lost jobs, etc.) of counterfeiting phenomenon, which now extends to more and more sectors: clothing, footwear, jewelry, toys, cosmetics, medicines, and many others. *Id.* According to the survey, counterfeiting is considered the cause of 110,000 lost jobs and a loss of €1.7 billion in revenue for the treasury. See *Falso, in Italia Brucia 100mila Posti di Lavoro [Counterfeits, in Italy Effect 100,000 Jobs]*, CORRIERE DELLA SERA (Oct. 22, 2012, 12:33 PM), [http://www.corriere.it/cronache/12\\_ottobre\\_22/costi-contraffazione\\_2fc520cc-1c32-11e2-b6da-b1ba2a76be41.shtml](http://www.corriere.it/cronache/12_ottobre_22/costi-contraffazione_2fc520cc-1c32-11e2-b6da-b1ba2a76be41.shtml) (It.). Counterfeiting significantly affects various sectors of the Italian economy: counterfeiting in cosmetics, for example, increased at least 15 times in 10 years. See *id.*

On January 24, 2013, the European Parliament endorsed a new Regulation 5129/2013/EC which sets out customs procedures for goods suspected of infringing intellectual property rights and replaces Council Regulation 1383/2003, 2003 O.J. (L196) 7 (EC). The new Regulation will come into force on January 1, 2014. See generally Desiree Fields & Rohan Massey, *New EU Counterfeit Goods Regulation*, JD SUPRA LAW NEWS (Jan. 28, 2013), <http://www.jdsupra.com/legalnews/new-eu-counterfeit-goods-regulation-73695/>; Axel H. Horns, *New Proposal for EU Regulation Concerning Customs Enforcement Of Intellectual Property Rights*, KSNH: LAW (Jan. 11, 2013), <http://blog.ksnh.eu/en/2013/01/11/new-proposal-for-eu-regulation-concerning-customs-enforcement-of-intellectual-property-rights/>.

125. See *The Truth About Counterfeiting*, INT'L ANTI-COUNTERFEITING COALITION, <http://www.iacc.org/about-counterfeiting/the-truth-about-counterfeiting.php> (last visited Feb. 24, 2013) (“In Fiscal Year 2011, US Customs & Border Protection (CBP) and Immigration & Customs Enforcement (ICE) seized nearly \$200 Million worth of counterfeit goods intended for sale in the United States.”). Counterfeiting also contributes to unemployment, costs U.S. businesses billions annually, and reduces tax revenue. See *About Counterfeiting*, INT'L ANTI-COUNTERFEITING COALITION, <http://www.iacc.org/about-counterfeiting/> (last visited Feb. 24,

uniformity of protection across the European Union removes one easy route for counterfeiters.

This new legislation is especially significant in light of the increasing importance of designs and models in European commerce.<sup>126</sup> In some countries, like Italy,<sup>127</sup> design underlies the

2013). In addition, the growth of counterfeiting is also due to a consumer complicity. *See the Truth about Counterfeiting*, INT'L ANTI-COUNTERFEITING COALITION, <http://www.iacc.org/about-counterfeiting/the-truth-about-counterfeiting.php> (last visited Feb. 24, 2013) (“[Trafficking of counterfeit goods] is driven in part by CONSUMER DEMAND.”). *See generally* PEGGY CHAUDHRY & ALAN ZIMMERMAN, *THE ECONOMICS OF COUNTERFEIT TRADE: GOVERNMENTS, CONSUMERS, PIRATES AND INTELLECTUAL PROPERTY RIGHTS* 63-74 (2009); PAUL R. PARADISE, *TRADEMARK COUNTERFEITING, PRODUCT PIRACY, AND THE BILLION DOLLAR THREAT TO THE U.S. ECONOMY* (1999); THORSTEN STAAKE & ELGAR FLEISCH, *COUNTERING COUNTERFEIT TRADE: ILLICIT MARKET INSIGHTS, BEST PRACTICE STRATEGIES, AND MANAGEMENT TOOLBOX* 47-65 (2008).

In 2011, the American fashion house Tory Burch LLC was awarded \$164 million in damages against forty-one counterfeiters for selling online counterfeiting products bearing the Tory Burch trademark. *See* Owen J. McKeon, *District Court Awards Tory Burch \$164 Million in Anti-Counterfeiting Litigation*, IP LAW ALERT (June 13, 2011, 12:34 PM), <http://www.iplawalert.com/2011/06/articles/ecommerce/district-court-awards-tory-burch-164-million-in-anticounterfeiting-litigation/>. On October 3, 2012 Tory Burch LLC filed a complaint for trademark infringement against Creative Eyewear Inc., claiming that the sunglasses manufacturer has made a fake version of her sunglasses by using unauthorized reproduction of her registered trademark. Plaintiff’s Complaint for Damages, *Tory Burch LLC v. Creative Eyewear, Inc.*, No. 12 CIV 7422 (S.D.N.Y. Oct. 3, 2012), 2012 WL 4513173; *see also* Victoria Slind-Flor, *Apple, Tory, Restoration Hardware: Intellectual Property*, BLOOMBERG (Oct. 4, 2012, 9:01 PM), <http://www.bloomberg.com/news/2012-10-04/apple-tory-restoration-hardware-intellectual-property.html>. More recently, Tory Burch LLC filed a complaint against Bluebell Accessories for allegedly selling knock-offs with the designer’s signature “TT” logo. Original Complaint, *Tory Burch LLC v. Bluebell Accessories, Inc.*, No. 1:13-cv-01941-RA (S.D.N.Y. Mar. 22, 2013), 2013 WL 1285764.

The Federal Court of Canada awarded two luxury goods companies CA\$2.48 million in damages. *See* *Louis Vuitton Malletier S.A. v. Singga Enters. (Can.) Inc.*, 2011 FC 776 (Can. Ont.), available at <http://decisions.fct-cf.gc.ca/en/2011/2011fc776/2011fc776.pdf> (finding trademark infringement by the defendants and awarding damages to plaintiffs Louis Vuitton and Burberry); *see also* *The Federal Court Applies Its New Summary Trial Rules in the Largest Anti-Counterfeiting Award in Canadian History*, SMART & BIGGAR/FETHERSTONHAUGH (July 27, 2011), [http://www.smart-biggars.ca/en/articles\\_detail.cfm?news\\_id=473](http://www.smart-biggars.ca/en/articles_detail.cfm?news_id=473). This decision represents the largest Canadian award in a trademark and copyright counterfeiting case. Jessica Braude & Jessica Fingerhut, *Landmark Counterfeiting Case Awards Louis Vuitton and Burberry \$2.5 Million in Damages*: *Louis Vuitton Malletier S.A. v. Singga Enterprises (Canada) Inc.*, CASSELS BROCK LAW. (July 21, 2011), [http://www.casselsbrock.com/CBArticle/Landmark\\_Counterfeiting\\_Case\\_Awards\\_Louis\\_Vuitton\\_and\\_Burberry\\_2\\_5\\_Million\\_in\\_Damages\\_\\_i\\_Louis\\_Vuitton\\_Malletier\\_S\\_A\\_v\\_Singga\\_Enterprises\\_Canada\\_Inc\\_\\_i\\_](http://www.casselsbrock.com/CBArticle/Landmark_Counterfeiting_Case_Awards_Louis_Vuitton_and_Burberry_2_5_Million_in_Damages__i_Louis_Vuitton_Malletier_S_A_v_Singga_Enterprises_Canada_Inc__i_).

126. *See, e.g., International Filings up in 2012, Says WIPO*, SOCIETÀ ITALIANA BREVETTI (Mar. 27, 2013), <http://www.sib.it/en/news-and-events/news/957.html> (noting that international design applications grew in 2012 from the previous year, with a total 12,454 applications, with the top four countries of origin being Germany (31.7%), Switzerland (19.6%), France (11.4%) and Italy (7.4%, with a 46.1% growth from 2011)).

127. The inscription on the *Palazzo della Civiltà Italiana*, also known as the Square Colosseum, in Rome, Italy, reads: “A nation of poets, artists, heroes, saints, thinkers, scientists,

excellence of a product and manifests an artistic heritage that merits strong protection. For several sectors of the Italian economy, including the furniture, footwear and clothing industry, as well as other areas of arts and crafts, the protection of industrial design assumes a vital importance.<sup>128</sup> Design is an integral part of ideas artistic and cultural expression, and defines a country's artistic identity and contribution to the world. Sometimes, a design object can even be considered as a work of art.<sup>129</sup> As such, many countries are associated with particular styles that embody their cultural traditions, sometimes based on specific historical events.<sup>130</sup> For example, Scandinavian design is easily identifiable by its simple and unique style, incorporating minimalism, functionalism, and the use of wood.<sup>131</sup> Swedish design registrations cover a wide variety of

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sailors, transmigrants." (translated from Italian by the author).

128. See Marina Benassi, *Una Nuova Tutela dall'Europa per Modelli Industriali e Design* [A New Protection from Europe for the Industrial Models and Design], ALTALEX (Feb. 5, 2002), <http://www.altalex.com/index.php?idnot=4058> (It.).

129. On September 13, 2012 the Court of Milan addressed copyright as applied to industrial design. See Trib., 13 Settembre 2012, Foro it. 2012, V, Sezione Specializzata (It.), available at <http://www.trevisancunzo.com/static/upload/cou/court-of-milan—decision-no.-9917.12.pdf>. The court held that the "Panton Chair", the famous plastic chair produced by furniture manufacturer Vitra, cannot be reproduced because it is protected as a work of art. *Id.* at 39. This case further established the criteria to follow in order to distinguish an object of design as a work of art. The court stated that Panton chair is unanimously recognized a capacity which represents also the artistic trends of the constitutive movement of the post-war industrial design. *Id.* at 34. The court ordered the defendant High Tech to withdraw all the copies from the market and to pay damages to Vitra. *Id.* at 50-51.

130. In Italy in the 1950s, aviation engineers established themselves as designers. Two iconic designs, the *Vespa*, and the *Lambretta* (also two of the most important postwar scooters) were designed by Corradino D'Ascanio and Cesare Pallavicino, both aeronautical engineers and not motorcycle designers. See Alberto Bassi, *L'America in Italia: L'Aspetto del Design Durante il Boom Economico* [America in Italy: The Look of Design During the Economic Boom], ALBERTO BASSI (Feb. 7, 2011), <http://www.albertobassi.it/?p=76> (It.). In the field of airplane design, Filippo Zappata designed some of the most beautiful seaplanes in aeronautical history. *Id.* He is most well-known for the BZ308 (a four-engine, 80-passenger plane for civil aviation) commissioned by Italian mechanical manufacturer Breda in the late 1940s. *Id.*

131. Scandinavian design is well-known as a symbol of perfect *liaison* between functionality and aesthetics. See generally Katrín Eyþórsdóttir, *The Story of Scandinavian Design: Combining Function and Aesthetics*, SMASHING MAG. (June 13, 2011), <http://www.smashingmagazine.com/2011/06/13/the-story-of-scandinavian-design-combining-function-and-aesthetics/>. It arose as a reaction to the artistic movements immediately prior. The design appeared at the beginning of 1900s as "decorative art." This term carries with it an aesthetic meaning, by implying a new approach to work based on mass production at low cost. The people of Northern Europe are very linked to their roots and traditions, which explains the high use of wood in Scandinavian industrial production. Indeed, Sweden and Norway are densely forested which permit an unlimited quantity of timber. In the past centuries stone was difficult to extract from the frozen ground, and houses that were built with it were not easy to heat. For these reasons, the use of wood became common even before the Viking Age. The



products,<sup>132</sup> such as a truck that received design protection for the actual vehicles as well as for toy versions.

Recognizing the importance of design protection, the World Intellectual Property Organization (WIPO) provides a registration system for industrial designs through the Hague Agreement Concerning the International Registration of Industrial Designs.<sup>133</sup> Registering a design provides protection in all countries that are signatories to the Hague Agreement, and is accomplished by filing a single application in one language and paying one set of fees.<sup>134</sup> The protection provided by the Hague Agreement, however, is limited to member countries, such as Denmark and Norway; key markets, such as Sweden, are not members. The Hague Agreement is also limited to industrial designs.<sup>135</sup>

Before enactment of the new Regulation, the European legal landscape was not uniform with respect to design protection.<sup>136</sup> The

Vikings were extraordinary shipbuilders who developed incredible techniques in order to guarantee a long life to their wooden houses, thanks to their knowledge about wood which gave it a spiritual meaning. *See generally Arte e Cultura Svezia, Norvegia, Danimarca* [Art and Culture of Sweden, Norway, and Denmark], LA GUIDA VERDE MICHELIN, [http://viaggi.viamichelin.it/web/Cultura/Svezia\\_Norvegia\\_Danimarca/Arte\\_e\\_cultura](http://viaggi.viamichelin.it/web/Cultura/Svezia_Norvegia_Danimarca/Arte_e_cultura) (last visited Oct. 26, 2012) (It.).

132. *See Designs*, SWEDISH PATENT & REGISTRATION OFFICE (PRV), [www.prv.se/en/Designs/](http://www.prv.se/en/Designs/) (last visited Oct. 2, 2012).

133. The Hague System for the International Registration of Industrial Designs, administered by the International Bureau of the World Intellectual Property Organization (WIPO), is based on three separate Acts: the London Act of June 2, 1934, the Hague Act of November 28, 1960, and the Geneva Act of July 2, 1999. *See Hague Agreement Concerning the International Registration of Industrial Designs*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/treaties/en/registration/hague/> (last visited Feb. 24, 2013).

134. *See Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement*, ch. 2, r. 7 (as in force on January 1, 2012), *available at* [http://www.wipo.int/export/sites/www/hague/en/legal\\_texts/pdf/hague\\_common\\_regulations.pdf](http://www.wipo.int/export/sites/www/hague/en/legal_texts/pdf/hague_common_regulations.pdf). Because the European Union is a signatory to the Hague Agreement, it is possible to obtain industrial design protection under WIPO, in addition to Community design protection. *See International Registrations Designating the European Community (EC)*, OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS & DESIGNS), <http://oami.europa.eu/ows/rw/pages/RCD/protection/intRegistrations.en.do> (last updated July 9, 2008).

135. *See Hague Agreement Concerning the International Registration of Industrial Designs*, *supra* note 133.

136. Intellectual property exclusive rights conferred by the national laws have a territorial nature. In relation to intra-Community trade, this connotation determines a fragmentation of the European market in many sub-national markets. More specifically, in matters of design, the diversity of national laws determined different forms of protection for the holders of the same rights within the European Union. This uncomfortable situation changed the conditions of competition and hence an action from the lawmaker was evident. *See* DEBORA BRAMBILLA, LA FORMA DEL PRODOTTO E LA SUA TUTELA [THE SHAPE OF A PRODUCT AND ITS PROTECTION]

same pair of shoes or glasses could be protected in one country but not in another, or was not even protected at all, or they could be protected in various ways, depending on the member state from which they are exported.<sup>137</sup> This state of uncertainty caused a lack of trust and hindered trade among the Community's member states.<sup>138</sup>

The Council Regulation protects a design in two different ways: as a registered Community design (RCD) and as an unregistered Community design (UCD).<sup>139</sup> A designer acquires UCD protection automatically by making a design available in any member state.<sup>140</sup> In contrast, to obtain RCD protection, a designer must register at the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) in Alicante, Spain.<sup>141</sup> By virtue of the UCD, an original design enjoys protection just because it exists and is disclosed. Under the previous regime, filing a design/model application was not an efficient approach, and did not adapt to the needs of many industrial sectors due to costs, timing, and the protection's duration.<sup>142</sup> The UCD protection lasts three years "from the date on which the design was first made available to the public within the Community."<sup>143</sup> While it is not necessary to file an application to protect an unregistered design, doing so provides de

18-19 (2011), *available at* <http://dspace-unipr.cilea.it/bitstream/1889/1563/1/tesi%20dottorato%20BRAMBILLA.pdf> (It.).

137. Benassi, *supra* note 128.

138. Entrepreneurs, disappointed and concerned about the inadequacy of national laws to protect them against the phenomenon of counterfeiting, demanded action from the Community lawmaker, who replied with the Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the Legal Protection of Designs, 1998 O.J. (L289) 28 (EC). This Directive was followed by Community Design Regulation of 12 December 2001 and the Commission Regulation (EC) 2245/2002 of 21 October 2002 implementing the Regulation. *See generally* BRAMBILLA, *supra* note 136, at 18-29.

139. *See How to Obtain Protection*, OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS & DESIGNS), <http://oami.europa.eu/ows/rw/pages/RCD/protection/protection.en.do> (last updated Apr. 21, 2008).

140. *See Unregistered Community Designs*, OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS & DESIGNS), <http://oami.europa.eu/ows/rw/pages/RCD/protection/UCD.en.do> (last updated Apr. 24, 2008).

141. *See generally* OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS & DESIGNS), <http://oami.europa.eu/ows/rw/pages/index.en.do> (last visited Feb. 25, 2013).

142. The design/model application did not meet the needs of the footwear and clothing industries which, by their nature, are linked to seasonal fashion cycles. *See* Benassi, *supra* note 128.

143. Community Design Regulation, *supra* note 121, art. 11(1) (titled "Commencement and Term of Protection of the Unregistered Community Design").

facto evidence that the protection actually exists. Furthermore, the triennial automatic term conceived by the new Regulation compensates for the lack of protection that some entrepreneurs and craftsmen experienced prior.

In comparison, an RCD can be protected “for a period of five years as from the date of the filing of the application. The right holder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing.”<sup>144</sup> RCD provides designers with an exclusive right that covers the external appearance of a product or parts thereof.<sup>145</sup> The Regulation defines a “design” as an “appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.”<sup>146</sup> In order to receive a protection, a design shall be “new and has individual character.”<sup>147</sup> The protection includes “any design which does not produce on the informed user a different overall impression.”<sup>148</sup> “[T]he degree of freedom of the designer in developing his design”<sup>149</sup> is the element that will be considered in assessing the scope of protection.

The new design Regulation also includes some limitations. For instance, one cannot obtain protection for “features of appearance of a product which are solely dictated by its technical function”<sup>150</sup> and

features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.<sup>151</sup>

Additionally, a design cannot be protected that “is contrary to public policy or to accepted principles of morality.”<sup>152</sup>

One commentator makes a sound recommendation that the United States needs to establish an independent body of law to

144. *Id.* art. 12 (titled “Commencement and Term of Protection of the Registered Community Design”).

145. See OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET, *supra* note 139.

146. Community Design Regulation, *supra* note 121, art. 3(a).

147. *Id.* art. 4.

148. *Id.* art. 10(1).

149. *Id.* art. 10(2).

150. *Id.* art. 8(1).

151. *Id.* art. 8(2).

152. *Id.* art. 9.

regulate the protection of fashion designs in order to harmonize international intellectual property laws and avoid conflict with the useful arts doctrine.<sup>153</sup> In the short term, however, an extension of existing copyright protection would meet emerging needs.<sup>154</sup>

*B. The Innovative Design Protection Act of 2012: Is it Really What Designers Need?*

The fashion industry is one of the largest and most profitable in the global economy, comprising almost four percent of global gross domestic product.<sup>155</sup> Recent data on sales of apparel, provided by the U.S. Bureau of Economic Analysis, shows a constant annual growth since 1945.<sup>156</sup> In 2008, a considerable portion of Wal-Mart's annual revenues came from the sale of clothing.<sup>157</sup> Beginning in the 1990s, the industry witnessed several mergers of fashion houses;<sup>158</sup> Louis Vuitton, for example, was able to buy several prestigious brands and has become even stronger in the market.<sup>159</sup> Thanks to this exponential and continuous growth, fashion house owners are some of the richest people in the world,<sup>160</sup> and the fashion industry has been able to strongly shape popular culture.<sup>161</sup>

153. 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, 168 (2010).

154. *Id.*

155. Jimenez, *supra* note 123, at 6.

156. See *Innovative Design Protection and Piracy Prevention Act: Hearing on H.R. 2511 Before the Subcomm. on Intellectual Property, Competition, and the Internet of the H. Comm. on the Judiciary*, 112th Cong. 75 (2011) [hereinafter *IDPPPA Hearing*], available at [http://judiciary.house.gov/hearings/printers/112th/112-46\\_67397.PDF](http://judiciary.house.gov/hearings/printers/112th/112-46_67397.PDF) (statement of Christopher Sprigman, Professor of Law, University of Virginia School of Law).

157. See Jimenez, *supra* note 123, at 6.

158. *Id.* at 7.

159. See *id.*; Suzy Wetlaufer, *The Perfect Paradox of Star Brands: An Interview with Bernard Arnault of LVMH*, HARV. BUS. REV., Oct. 2001, at 117, 118.

160. According to The Forbes World's Billionaires List of 2012, three owners of renowned fashion brands appear in the top ten list: Bernard Arnault (Louis Vuitton Moët Hennessy (LVMH)) in fourth position (\$41 billion net worth), Amancio Ortega (ZARA España, S.A.) in fifth position (\$37.5 billion net worth), and Stefan Persson (H & M Hennes & Mauritz AB) in eighth position (\$26 billion net worth). See *The World's Billionaires 2012*, YAHOO! FINANCE (Mar. 7, 2012, 12:18 PM), <http://finance.yahoo.com/news/the-world%E2%80%99s-billionaires-2012.html?page=all>. The most recent Forbes's calculations in March 2013 place Amancio Ortega in third position with \$57 billion, Bernard Arnault in tenth position with \$29 billion, and Stefan Persson in twelfth position with \$28 billion. See *The World's Billionaires*, FORBES, <http://www.forbes.com/billionaires/list/> (last visited Mar. 8, 2013).

161. See, e.g., MARK TUNGATE, *FASHION BRANDS: BRANDING STYLE FROM ARMANI TO ZARA* (2d ed. 2008) ("Fashion is too prevalent to be considered trivial. Even when you say

Unlike authors and musicians, fashion designers cannot obtain copyright protection for their creative output; they can only protect their logos, by trademark. In fashion, only jewelry can receive copyright protection because they are considered miniature sculptures. Clothing is considered a “useful article”—and thus not eligible for copyright protection—because copyright law holds that it is not possible to separate the unique design traits of clothing from its functionality.<sup>162</sup>

This lack of protection has resulted in the birth of some brands that produce “knock-offs” of luxury brands sold at a lower price, and these companies are not subjected to any legal consequence for doing so. Is counterfeiting not the same as knocking-off? Is a knock-off always legal? Knocking-off in many countries—including the United States—may be either legal or illegal depending on what part of garment and how much is “borrowed.”<sup>163</sup> Counterfeiting is an “aggravated” form of infringement where a party deliberately and knowingly misappropriates intellectual property of another by making a copy of an original good (usually protected by a trademark, but may also include copyrighted products) with the intent to mislead the consumer as to the product’s origin.<sup>164</sup> The Copyright Act attaches a criminal liability to this kind of willful infringement,<sup>165</sup> but because fashion designs cannot be copyrighted, they can be freely copied, without being subjected to any legal consequence for doing so. These counterfeit products often become available within weeks after the original comes to market. Sometimes, they are sold even before the

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you’re not interested in fashion, you’ve been forced to confront it. Fashion is everywhere. What you choose to wear or not to wear has become a political statement. You don’t buy clothes—you buy an identity.” (quoting fashion photographer Vincent Peters)).

162. *But see* *Boyd’s Collection, Ltd. v. Bearington Collection, Inc.*, 360 F. Supp. 2d 655, 661 (M.D. Pa. 2005). *Boyd’s* held that clothing for a toy Teddy Bear was not a useful article, because “[c]lothing on a bear replicates the form but not the function of clothing on a person”. *Id.* The court reached this conclusion after explaining the difference between clothing for a human being—that “may be worn by an individual to cover and protect his or her body”—and clothing for toys. *Id.* The court stated:

The clothing on a teddy bear obviously has no utilitarian function. It is not intended to cover embarrassing anatomical aspects or to protect the bear from exterior elements. Rather, it is intended and serves only to modify the appearance of the bear, to give the doll a different “look and feel” from others.

*Id.*

163. Jimenez, *supra* note 123, at 16-17. *See generally* TIM PHILLIPS, KNOCKOFF: THE DEADLY TRADE IN COUNTERFEIT GOODS (2007).

164. *See id.* at 17.

165. 17 U.S.C. § 506 (2011).

original.<sup>166</sup>

Both counterfeiting and knock-offs represent the real plague of the fashion industry. Even though it is arduous to determinate the precise size of the counterfeit market and, consequently, the effects of counterfeiting, industry experts are aware of the seriousness of this problem.<sup>167</sup> The available data, which can shed light on the significance of this phenomenon, come from police raids and customs authorities' discoveries.<sup>168</sup> There is not even an agreement on factors

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166. See MOISÉS NAÍM, *ILLCIT: HOW SMUGGLERS, TRAFFICKERS, AND COPYCATS ARE HIJACKING THE GLOBAL ECONOMY* (Anchor Books 2006) (2005). In the first chapter, titled "The Wars We Are Losing," the author relates some interesting but worrisome information:

The Chinese version of Bill Clinton's autobiography *My Life* that hit the streets in July 2004, months before the official, licensed translation, was obviously a grotesque forgery. Its appearance served as a welcome of sorts, introducing the former president to one of the more dubious honors of modern writerly fame. In Colombia, for instance, an entire cottage industry specializes in unlicensed copies of the works of the country's great novelist Gabriel García Márquez. In 2004 a master copy of the Nobel Prize winner's first novel in ten years vanished without a trace from the printing press. Days later, a pirate edition could be found on Bogotá sidewalks, its text accurate but for the final revisions that García Márquez, a perfectionist, had been waiting until the last moment to turn in.

*Id.* at 1.

167. See, e.g., MICHEL CHEVALIER & PIERRE LU, *LUXURY CHINA: MARKET OPPORTUNITIES AND POTENTIAL* 175-94 (2010).

Everything today, from cognac to mineral water, can be, and very often is, counterfeited. Luxury is one of the most popular sectors for counterfeiters, because it is cheap to copy and easy to sell. In 2000, the Global Anti-Counterfeiting Group reported that 11% of the world's clothing and footwear was fake, and the World Customs Organization believes that the fashion industry loses up to US\$9.2 billion per year to counterfeiting. In 2004, the European Commission reported that trade in counterfeit clothing, footwear, perfume and toiletries reduced the European Union's gross domestic product by more than US\$6 billion each year and cost 10,800 jobs, with the figures increasing every year.

*Id.* at 175.

168. See, e.g., Raymond W. Kelly, Commissioner of the New York City Police Department, Keynote Address at the 5th Annual Harper's Bazaar Anti-Counterfeiting Summit Mar. 16, 2009).

In the last two years, the Police Department has seized \$25 million worth of goods and \$2 million from personal and professional bank accounts. We've had 100 establishments deemed to be criminal nuisances and 67 were shut down. Last year alone we made more than 2,000 arrests for trademark counterfeiting. But until we change the central dynamic of the industry, namely rich rewards and absurdly low risk, we'll be hard pressed to do more than manage a tidal wave of counterfeits flooding the market here in New York. This is a sobering fact.

*Id.* In 2012 the U.S. Customs and Border Protection seized \$511million worth of counterfeit fashion goods, most of them from China. See Dhani Mau, \$511 Million Worth of Counterfeit Handbags and Wallets Was Seized in 2012, *FASHIONISTA* (Mar. 7, 2013),

necessary to calculate the scale of counterfeiting.<sup>169</sup> It is clear that fashion designers need legal protection. Creating such protection is the subject of ongoing debates.<sup>170</sup> The Fashion Design Bill<sup>171</sup> seems incapable of garnering broad agreement.<sup>172</sup>

If the bill is enacted, what some companies are doing—living parasitically off the creativity of other designers—would be illegal. This will probably open a Pandora box of costly lawsuits, but at the same time it will guarantee much needed protection, especially for independent and small emerging designers.<sup>173</sup>

The Fashion Design Bill, like the Vessel Hull Design Protection Act, creates protection for articles (the first one for clothing, while the second one for boat hull) that otherwise cannot receive copyright protection. The Fashion Design Bill creates three new legal standards<sup>174</sup>: first, if designs are demonstrably “unique, distinguishable, non-trivial and non-utilitarian variation over prior designs”<sup>175</sup> they will be sufficiently original to receive protection; second, the term “substantially identical” will be the infringement standard;<sup>176</sup> and third, it creates a heightened pleading standard, such that the plaintiff bears the burden of proving that the design is protectable, that the infringing product is substantially identical, and that “the defendant saw or otherwise had knowledge of the protected

<http://fashionista.com/2013/03/511-million-worth-of-counterfeit-handbags-and-wallets-was-seized-in-2012/>.

169. CHAUDHRY & ZIMMERMAN, *supra* note 125, at 9-11.

170. See Layne Randolph, *IDPA: U.S. Debates the Pros and Cons of Copyright Protection for Fashion Design*, LAYNE RANDOLPH (Jan. 23, 2012), <http://laynerandolph.com/?p=93> (providing an analysis of the two different positions between those who feel the necessity to guarantee copyright protection to fashion designers and those who do not).

171. See IDPPPA, *supra* note 1. See generally Beltrametti, *supra* note 153; Laura Fanelli, Note, *A Fashion Forward Approach to Design Protection*, 85 ST. JOHN'S L. REV. 285 (2011).

172. See IDPPPA Hearing, *supra* note 156, at 77-90 (comments of Kal Raustiala, Professor of Law, University of California at Los Angeles School of Law, and Christopher Sprigman, Professor of Law, University of Virginia School of Law).

The IDPPPA is likely to do little to benefit designers, but will prove a boon for lawyers. It will give rise to many questionable lawsuits against designers, manufacturers, distributors, and retailers. This will act as a tax on business and an impediment to entrepreneurs. And as a result, the IDPPPA is likely to raise the price that consumers pay for clothes.

*Id.* at 77-78.

173. See Christina Binkley, *The Problem with Being a Trendsetter*, WALL ST. J. (Apr. 29, 2010), <http://online.wsj.com/article/SB10001424052748704423504575212201552288996.html>.

174. Sheba Sheikh, *Fashion Law and the IDPPPA*, THE FASHION GRID (Mar. 23, 2012), <http://www.thefashiongrid.com/home/2012/3/23/fashion-law-and-the-idpppa.html>.

175. IDPPPA, *supra* note 1, § 2(a)(2)(B).

176. *Id.* § 2(e).

design.”<sup>177</sup>

The new law would provide the fashion designer with protection for three years.<sup>178</sup> This time period, considered suitable for the cyclical nature of fashion, will permit designers not only to introduce their original clothing without being imitated with impunity by fast-fashion retailers,<sup>179</sup> but also allows the garments to enter the public domain within a reasonable time. Only if the article of clothing is considered substantially identical designers are entitled to claim infringement.<sup>180</sup>

In conclusion, it is important to note that although designers can obtain trademark and trade dress protection, these intellectual property rights are likely not accessible for young designers. It takes time and money to show secondary meaning, which is fundamental for trademark protection.<sup>181</sup> In addition, the lack of time and money make young designers an easy prey for design pirates, who reduce the profits of these young designers by impacting sales of the designers' garments.<sup>182</sup> Fashion luxury brands such as Prada, Loro Piana, Armani, or Valentino may see their profits decrease due to counterfeiting or knock-offs, but they can rely on the success of their brands, which are well-known thanks to shrewd, wise and expensive investments in advertising, research and development and above all, in high quality's products. All of these efforts take time, which many young designers need, especially in an industry where they are at the base of a pyramid whose top is filled with famous designers that “paint” the seasonal trends. The lack of protection provided by intellectual property rights makes their efforts even more difficult.<sup>183</sup> Although copying of a design might be seen as “endemic and

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177. *Id.* § 2(g).

178. *Id.* § 2(d).

179. *See* Sheikh, *supra* note 174.

180. This is a stark contrast from the current legislation where the defendant does not need to produce an identical copy. *Id.* Infringement exists only when the work is substantially similar. *Id.* An exception to this rule is provided for sound recordings. 17 U.S.C. § 114(b) (2011) (“The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording.”); *see also* MCJOHN, *supra* note 27, at 148.

181. Loni Schutte, Note, *Copyright for Couture*, 2011 DUKE L. & TECH. REV. no. 11, at 1-2 (2011), available at <http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1225&context=dltr>.

182. *Id.* at 2-3.

183. *Id.* at 3.



condoned”<sup>184</sup> this stealing of identity in the fashion industry cannot be accepted as a justification. A garment should be more than just a piece of fabric behind a window, which anyone can copy. It represents a way of communicating and expressing the designer’s soul through design. That is why it has to be original.

Therefore, why should there be greater copyright protection in fashion law? In other words, is the Fashion Design Bill necessary? One answer is, “because it’s really tough for designers out there whose labels and logos don’t mean anything to the public yet—the emerging designers who have to sell their designs and can’t just sell their names—get copied all the time, and therefore need some kind of protection.”<sup>185</sup>

### C. *What Opponents Think about the Fashion Design Bill? A Comparison with the E.U. Design Regulation*

Opponents of intellectual property protection for fashion designers, in criticizing the European Design Law, argue that just a few designers have registered their designs and that there had not been an increase in lawsuits.<sup>186</sup> Although these critics recognize that the E.U. law has had little effect, they believe that a similar law in the United States could have a harmful and detrimental impact.<sup>187</sup> The European Commission, in order to incentivize the use of the E.U. law and defeat this paradox,<sup>188</sup> decided to take measures by preparing the Sectorial Intellectual Property Rights Guide<sup>189</sup> for small and medium enterprises (SMEs).

European research on why SMEs have been reluctant to use the new design protection Regulation shows lack of knowledge, money, inadequate investments in innovation, and difficult procedural requirements.<sup>190</sup> This research shows that the primary reasons why

184. Brian Hilton, Chong Ju Choi & Stephen Chen, *The Ethics of Counterfeiting in the Fashion Industry: Quality, Credence and Profit Issues*, 55 J. BUS. ETHICS 345, 353 (2004).

185. Bloomberg Law, *Scafidi Says Fashion Copyright to Increase Consumer Options*, YOUTUBE, at 2:00-2:18 (Sept. 26, 2011), <http://www.youtube.com/watch?v=395ADDsICwU> (interview with Susan Scafidi, Professor of Law and Director of Fashion Law Institute, Fordham University School of Law).

186. See *IDPPPA Hearing*, *supra* note 156, at 85.

187. *Id.*

188. Roya Ghafele, *Resolving the Paradox of Innovation in Europe’s Fashion Industry—The Need of a Practical Guide*, 42 IPR HELPDESK BULLETIN, Apr.-June 2009, at 2.

189. *Id.*; Fanelli, *supra* note 171, at 311; Agnieszka Turynska, *How to Make Ends Meet—Sectorial IPR Guides for SMEs*, 41 IPR HELPDESK BULLETIN, Jan.-Mar. 2009, at 3.

190. Turynska, *supra* note 189.

SMEs do not use the new laws are lack of funds and information, rather than any perceived weakness or discrepancy in this legislation.<sup>191</sup> The European Commission has responded with four guidelines<sup>192</sup>—one for each sector: textiles and clothing, leather, footwear, and furniture—that demonstrate its belief in the efficacy of this law.<sup>193</sup>

Opponents of the E.U. law criticize it for not having been able to eradicate design piracy.<sup>194</sup> Nobody expected immediate results, but the law has proven to be a necessary step in combating a growing problem that targets both creativity and originality, and thus strikes the fashion industry at its core.<sup>195</sup>

In their attempt to argue that the Fashion Design Bill is unnecessary, detractors assert that copying helps the industry.<sup>196</sup> They argue that simply because a fashion copy looks like an original, does not mean it competes for the same customers.<sup>197</sup> A consumer who purchases a fake Louis Vuitton wallet, for example, may not be able to afford the \$500 genuine article.<sup>198</sup> Therefore, the argument goes, the two items are not in the same market segment.<sup>199</sup> This reasoning is certainly questionable. Who can guarantee that a person who can

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191. *Id.*

192. IPEUROPWARE, INTELLECTUAL PROPERTY, A BUSINESS TOOL FOR SMES: A GUIDE FOR THE FOOTWEAR INDUSTRY (2009), available at <http://www.innovaccess.eu/files/handbooks/footwear-ingles.pdf>; IPEUROPWARE, INTELLECTUAL PROPERTY, A BUSINESS TOOL FOR SMES: A GUIDE FOR THE FURNITURE INDUSTRY (2009), available at <http://www.innovaccess.eu/files/handbooks/footwear-ingles.pdf>; IPEUROPWARE, INTELLECTUAL PROPERTY, A BUSINESS TOOL FOR SMES: A GUIDE FOR THE LEATHER INDUSTRY (2009), available at <http://www.innovaccess.eu/files/handbooks/leather-ingles.pdf>; IPEUROPWARE, INTELLECTUAL PROPERTY, A BUSINESS TOOL FOR SMES: A GUIDE FOR THE TEXTILE INDUSTRY (2009), available at <http://www.innovaccess.eu/files/handbooks/textile-ingles.pdf>. The guides explain the important role that intellectual property rights should have for SMEs, analyze the way to use them in a proper way, give advice on intellectual property strategies, and explain how SMEs can create value and make money by using intellectual property rights.

193. See Fanelli, *supra* note 171, at 312 n.189.

194. See, e.g., *IDPPPA Hearing*, *supra* note 156, at 85.

195. Steven Kolb, Chief Executive Officer of the Council of Fashion Designers of America (CFDA), said after the verdict came down in the *Tory Burch* case: “Counterfeiting not only robs the designer of what is rightfully theirs, but also negatively impacts the American economy and the jobs associated with designers’ investments.” Kelly O’Reilly, *Tory Burch Awarded \$164 Million in Anti-Counterfeiting Suit*, NBC N.Y. (June 10, 2011, 2:09 PM), <http://www.nbcnewyork.com/blogs/threadny/THREAD-Tory-Burch-Awarded-164-Million-in-Anti-Counterfeiting-Suit-123639144.html>.

196. See *IDPPPA Hearing*, *supra* note 156, at 75.

197. *Id.* at 84.

198. *Id.*

199. *Id.*

afford the original would not instead buy a copy? Wealth is not always the determining factor. Some models are so well imitated that it is difficult to recognize the original from the fake, and thus a person who can afford an original may be just as content with the knock-off. So, the two products can, in fact, compete with each other in the same market. And above all, as long as the fake exists, each consumer will have the opportunity to choose.<sup>200</sup> Choosing the imitation promotes the “business” of knocking-off rather than counteracts it.

#### IV. CONCLUSION

The E.U. law should be regarded as an example that can serve to facilitate the implementation and enforcement of pending U.S. design legislation. It is unlikely that the Fashion Design Bill, if enacted, will become the panacea for all knocking-off. It would, however, represent a step forward in protecting the intellectual property rights for the fashion industry. At the very least, it would create a new incentive to discourage knocking-off, which operates exactly like plagiarism for literary copying: as a theft of creativity.<sup>201</sup> Only time will tell whether or not this law is capable of abolishing—or only mitigating—protracted copyright abuses.

The U.S. Constitution seeks to “promote the Progress of Science and the useful Arts, by securing for limited Times to Authors . . . the exclusive right to their Respective Writings.”<sup>202</sup> Justice Stewart, in interpreting this clause, said:

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200. New York City Councilmember Margaret Chin is collecting signatures for a petition in support of proposed legislation to make purchasing fake goods a crime (currently only selling a fake is illegal). The bill, if enacted, will be a significant public deterrent and should make it easier for the police to combat counterfeiting. See *Make It Illegal to Buy Counterfeit: Pass Trademark Counterfeit Legislation*, SIGNON.ORG, <http://signon.org/sign/make-it-illegal-to-buy> (last visited Mar. 25, 2013).

201. Marcus Valerius Martialis (c.A.D. 40-c.A.D. 104) was the first Latin classical poet to use the term *plagiarius* to refer to literary theft. BILL MARSH, PLAGIARISM: ALCHEMY AND REMEDY IN HIGHER EDUCATION 31 (2007); Katharina de la Durantaye, *The Origins of the Protection of Literary Authorship in Ancient Rome*, 25 B.U. INT’L L.J. 37, 71-72 (2007). In his epigrams, he used to accuse other poets of copying his works: “[C]um se dominum vocabit ille, / [D]icas esse meos manue missos / [H]oc si terque quaterque clamitaris / [I]npones plagiario pudorem.” (“[W]hen that fellow calls himself their owner, say that they are mine, set forth from my hand. If thrice and four times you shout this, you will shame the plagiarist.”); “[U]na est in nostris tua, Fidentine, libellis / [P]agina, sed certa domini signata figura, / [Q]uae tua traducit manifesto carmina furto.” (“There is one page of yours, Fidentinus, in a book of mine—a page, too, stamped by the distinct likeness of its master—which convicts your poem of palpable theft.”). 1 MARTIAL, EPIGRAMS 62-63 (T. E. Page, E. Capps & W. H. D. Rouse eds., C. A. Ker trans., 1919).

202. U.S. CONST. art. I, § 8, cl. 8.

The immediate effect of our copyright law is to secure a fair return for an "author's" creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good. "The sole interest of the United States and the primary object in conferring the monopoly," this Court has said, "lie in the general benefits derived by the public from the labors of authors."<sup>203</sup>

Yet one significant and immensely creative group is excluded: fashion designers. Copying fashion designs represents a degradation of creativity, intuition, inspiration, and, consequently, the death of an ingenuity that only human beings are able to release and give form to. Loss of the creativity of designers is, in turn, a loss to society.<sup>204</sup> In this sense, we should carefully reflect on the scope and origin of these copyrights, and remember why they have been guaranteed.

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203. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932)).

204. The Statute of Anne, an act of the British Parliament, was the first one to provide for copyright regulated by the government and courts. *See* Act for the Encouragement of Learning (Statute of Anne), 1710, 8 Ann., c. 19 (Gr. Brit.). This statute, also known as the Copyright Act of 1709, was created "for the Encouragement of Learned Men to Compose and Write useful Books." *Id.* ch. 1. *See generally* GLOBAL COPYRIGHT: THREE HUNDRED YEARS SINCE THE STATUTE OF ANNE, FROM 1709 TO CYBERSPACE 7-168 (Lionel Bently, Uma Suthersanen & Paul Torremans eds., 2010); *see also* Jack Lynch, *The Perfectly Acceptable Practice of Literary Theft: Plagiarism, Copyright, and the Eighteenth Century*, 24 COLONIAL WILLIAMSBURG no. 4, Winter 2002-03, at 51, available at <http://www.writing-world.com/rights/lynch.shtml>.