

Between the Seams, A Fertile Commons: An Overview of the Relationship Between Fashion and Intellectual Property

By Christine Cox
and Jennifer Jenkins



A Norman Lear Center Conference

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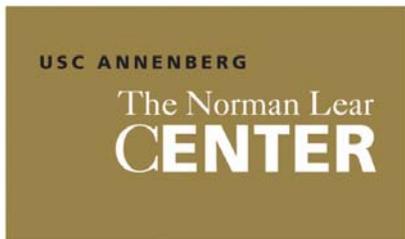
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CENTERTAINMENT
Exploring Implications of the Convergence of Entertainment, Commerce, and Society

The Norman Lear Center

Founded in January 2000, the Norman Lear Center is a multidisciplinary research and public policy center exploring implications of the convergence of entertainment, commerce and society. On campus, from its base in the USC Annenberg School for Communication, the Lear Center builds bridges between schools and disciplines whose faculty study aspects of entertainment, media and culture. Beyond campus, it bridges the gap between the entertainment industry and academia, and between them and the public. Through scholarship and research; through its fellows, conferences, public events and publications; and in its attempts to illuminate and repair the world, the Lear Center works to be at the forefront of discussion and practice in the field.



Ready to Share: Fashion & the Ownership of Creativity

On January 29, 2005, the Norman Lear Center held a landmark event on fashion and the ownership of creativity. "Ready to Share: Fashion & the Ownership of Creativity" explored the fashion industry's enthusiastic embrace of sampling, appropriation and borrowed inspiration, core components of every creative process. Presented by the Lear Center's HCreativity, Commerce & Culture^H project, and sponsored by ^HThe Fashion Institute of Design & Merchandising/^HFIDM^H, this groundbreaking conference featured provocative trend forecasts, sleek fashion shows and an eclectic mix of experts from fashion, music, TV and film. Discussion sessions covered fashion and creativity, intellectual property law, fashion and entertainment and the future of sharing.

Creativity, Commerce & Culture

When art is created for commercial purposes, who owns it? Once it's in the hands of consumers, what rights do they have to change it? Headed by Lear Center senior fellows David Bollier and Laurie Racine, Creativity, Commerce & Culture explores the new digital environment and the impact of intellectual property rights on innovation and creativity.



The Fashion Institute of Design & Merchandising/FIDM

The Fashion Institute of Design & Merchandising/FIDM is an internationally recognized college that prepares students for leadership in the global industries of Fashion, Visual Arts, Interior Design and Entertainment. As an accredited institution granting Associate of Arts degrees and providing Advanced Study programs in 14 industry-specific majors, FIDM has equipped more than 30,000 students over the last 30 years to become skilled professionals. FIDM is headquartered in a state-of-the-art campus in downtown Los Angeles, with additional campuses in Orange County, San Diego and San Francisco. The FIDM Museum houses one of the nation's finest costume collections dating from the 18th century, as well as ethnic costumes and selections from top fashion designers.

Author Biographies



Christine Cox

Christine Soares Cox is an attorney with Parker, Hudson, Rainer & Dobbs LLP in Atlanta. She practices in the areas of intellectual property, franchising and general commercial litigation. Cox is a graduate of Duke University School of Law, where she was Editor in Chief of the *Duke Law & Technology Review*. She is the author of several articles on intellectual property and communications law issues, ranging from the ownership of copyrights in digital reproductions of freelance articles to privacy concerns regarding enhanced 911 technology.



Jennifer Jenkins

Jennifer Jenkins is a Lecturing Fellow teaching intellectual property at Duke Law School and serves as Director of Duke's Center for the Study of the Public Domain, where she heads its Arts Project, analyzing the effects of intellectual property on cultural production ([Hwww.law.duke.edu/cspd/artsprojectH](http://www.law.duke.edu/cspd/artsprojectH)). As a lawyer, she was a member of the team that defended the copyright infringement suit against the publisher of the novel *The Wind Done Gone*, a parodic rejoinder to *Gone With the Wind*. As an artist, Jenkins cowrote *Nuestra Hernandez*, a fictional documentary addressing copyright and appropriation, and she has authored several short stories.

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"Imagine for a moment that some upstart revolutionary proposed that we eliminate all intellectual property protection for fashion design. No longer could a designer secure federal copyright protection for the cut of a dress or the sleeve of a blouse. Unscrupulous mass-marketers could run off thousands of knock-off copies of any designer's evening ensemble, and flood the marketplace with cheap imitations of haute couture. In the short run, perhaps, clothing prices would come down as legitimate designers tried to meet the prices of their free-riding competitors. In the long run, though, as we know all too well, the diminution in the incentives for designing new fashions would take its toll. Designers would still wish to design, at least initially, but clothing manufacturers with no exclusive rights to rely on would be reluctant to make the investment involved in manufacturing those designs and distributing them to the public. The dynamic America fashion industry would wither, and its most talented designers would forsake clothing design for some more remunerative calling like litigation. All of us would be forced either to wear last year's garments year in and year out, or to import our clothing from abroad.

Of course, we don't give copyright protection to fashions ... We never have."

– Jessica Litman, *Digital Copyright*¹

Introduction

Each month, *Marie Claire* magazine presents a feature devoted to fashion knockoffs called "Splurge vs. Steal." A \$195 Lilly Pulitzer halter top is compared with a \$15.00 version by Newport News.² \$175 Theory shorts are juxtaposed with a \$39.50 look-alike from the Gap.³ Though the designer version usually looks more tasteful or well-made, many shoppers are quite happy to obtain "the look" while saving several

hundred dollars. Newport News and the Gap can adapt the more expensive designs, and consumers can "dress for less," because clothing designs generally are not protectable under current United States intellectual property regimes.

We often are told that intellectual property protection is necessary to stimulate creativity and innovation. It provides incentives by allowing creators to control access to their works and demand payment for them. Without these incentives – the argument goes – people will be unable to profit from their works and will stop creating. Yet, despite the lack of intellectual property protection for fashion, style houses continue to make money, and designers continue to develop new looks every season. Creativity thrives in the absence of intellectual property protection.

What can we learn from this seeming paradox? This paper will examine the reasons why fashion design generally is not protectable under existing intellectual property regimes, and consider how the fashion experience might inform ongoing debates about desirable levels of intellectual property protection in other creative industries.

Why Not Fashion?

In recent years, the scope of U.S. intellectual property protection has expanded greatly in a variety of fields. Patents now are granted over plant varieties and common business methods, areas for which the U.S. Patent and Trademark Office previously had been hesitant to issue protection. Copyright terms have been extended to a staggering length of time – life plus 70 years – far longer than the 14-year term originally contemplated by the drafters of the Constitution. Powerful industry lobbies continue to push for ever stronger intellectual property protections.

Despite these recent expansions that have benefited, among others, the biotech, pharmaceutical, movie and recording industries, the fashion industry receives little protection under current U.S. intellectual property laws. This is not to say that certain fashion houses have not tried to obtain intellectual property protections for their designs, for valiant efforts have been made in this regard. While these efforts have succeeded in protecting limited design elements, however,

fashion design as a whole receives little to no protection. Knockoff goods are a huge part of the fashion industry and are accepted as common practice. With a system that tries its best to forbid sampling and remixing at every turn, how can such an extensive and fertile commons be allowed to exist?

Fashion designs, particularly for clothing, fall between the seams of traditional intellectual property protections.⁴ Copyrights generally are not granted to apparel because articles of clothing, which are both creative and functional, are considered "useful articles" as opposed to works of art. Design patents are intended to protect ornamental designs, but clothing rarely meets the demanding criteria of patentability, namely novelty and nonobviousness. Trademarks only protect brand names and logos, not the clothing itself, and the Supreme Court has refused to extend trade dress protection to apparel designs. Congress repeatedly has declined to enact legislation that would provide sui generis design protection.

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Fashion designs are not unprotected merely because they fall into a legal limbo between intellectual property schemes, however. Both policymakers and courts have been guided by compelling policy reasons to limit design protection.⁵ They have expressed concerns that, while such protection might benefit certain designers, it could create monopolies in the fashion industry that would stifle the creativity of future designers, hinder competition and drive up prices for consumer goods. Designers could demand payment for design elements that currently are free, and this cost would be borne by others in the industry and by the public. The less affluent would not be able to afford the range of fashions they currently enjoy.⁶ Therefore, policy advisors have been unconvinced that "new protection will provide substantial benefits

to the general public which outweigh removing such designs from free public use."⁷ As one judge put it, "Congress and the Supreme Court have answered in favor of commerce and the masses rather than the artists, designers and the well-to-do."⁸

Copyright

Copyright law is used to protect artistic creations, including music, films, paintings, photographs, sculptures and books.⁹ While U.S. copyright law protects "applied art," such as artistic jewelry, patterns on dinnerware or tapestries, it does not protect "useful articles," such as automobiles or television sets that, while attractively shaped, are primarily functional.¹⁰ Apparel designers have tried to obtain copyright protection for their designs by suggesting that clothing is a type of sculptural work. However, copyright law generally has not provided protection for wearable designs because clothing is considered a useful article that (among other things) protects its wearer from the elements, provides modesty and decorates the body.

While copyright law normally does not protect useful articles, it does protect aesthetic elements of a useful article if those features amount to works of art "that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."¹¹ This "separability" rule was developed in the landmark 1954 case of *Mazer v. Stein*,¹² in which the Supreme Court held that Balinese statuettes that formed the bases of lamps were copyrightable because the aesthetic work in question (a statuette) was separable from the useful article (a lamp). The statuettes could be copyrighted as independent works of art even though they also could be used as lamp bases.¹³

While lamps with statuette bases offer a relatively easy example of separability, it is much more difficult to separate aesthetic elements of most fashion designs, particularly clothing designs, from their function. An unusual neckline, flared sleeve or cinched waist – while attractive and creative – serve the utilitarian function of dressing the human form, and are not likely to be considered separable and independent works of art.

Accordingly, both Congress and the courts have said that clothing design is not subject to copyright protection. The legislative history to the Copyright Act explicitly stated that copyright protection would not be extended to "ladies' dress" unless it had some element that was physically or conceptually distinguishable from its form.¹⁴ And courts have "long held that clothes, as useful articles, are not copyrightable."¹⁵

There have been a few unusual cases involving fashion designs in which courts have found aesthetic form separable from function. One such case, *Kieselstein-Cord v. Accessories by Pearl*, involved the design of high-end belt buckles.¹⁶ Registered with the Copyright Office as "original sculpture and design," the Kieselstein-Cord belt buckles widely were recognized as innovative jewelry designs and even made their way into the Metropolitan Museum of Art's permanent collection.¹⁷ Knockoffs of the belt buckle designs subsequently were created in common metals by Accessories by Pearl, and Kieselstein-Cord sued for copyright infringement.¹⁸

The district court found that the belt buckles did not meet the separability standard required for protection because the artistic features were not separable readily from the utilitarian buckle.¹⁹ The Second Circuit reversed the decision, noting that the separability standard does not require "physical" separability but also may include "conceptual" separability.²⁰ The notion of conceptual separability (which was introduced in the legislative history to the current Copyright Act), allowed the *Kieselstein-Cord* court to discern between the aesthetic design of the belt buckles and their utilitarian function. The court concluded that the separable aesthetic elements should be copyrighted:

We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist ... Pieces of applied art, these buckles may be considered jewelry, the form of which is subject to copyright protection.²¹

However, the Second Circuit retreated from its expansive reading of conceptual separability a few years later in *Carol Barnhart v. Economy Cover Corp.*, in which the court held that mannequins used to display clothing were merely useful articles and did not have aesthetic elements that were conceptually separable from their utilitarian functions.²²

In rare cases, an apparel design may be copyrightable as a separable work of art when it hardly functions as clothing at all. For example, one court found that a clear plastic swimsuit filled with crushed rock and displayed as part of a modern art exhibit could be copyrightable as soft sculpture:

Nothing in our legal training qualifies us to determine as a matter of law whether [the swimsuit] can be worn as an article of clothing for swimming or any other utilitarian purpose. We are also unable to determine merely by looking at [the swimsuit] whether a person wearing this object can move, walk, swim, sit, stand, or lie down without unwelcome or unintended exposure.²³

As one commentator observed, "given that the object was filled with crushed rock, one wonders if it might have been more 'useful' as an anchor than a swimsuit."²⁴ Another court upheld copyrights in certain costumes that were unsuitable as clothing – these included a "Rabbit In Hat" costume that "does not readily permit the wearer to sit, recline, or maneuver easily" and a "Tigress" costume that "cannot be worn without a separate body covering underneath as it is too narrow to cover a woman's chest and contains no sides or bottom."²⁵ But in almost all other cases, clothing falls outside of the bounds of copyright protection.

Although clothing designs themselves are not copyrightable, designs on the surface of clothing, which are capable of being independent works of art (such as paintings or drawings), have been extended copyright protection.²⁶ Fabric designs, patterns for knit sweaters, designs printed on dresses and lace designs on wedding gowns have been held to constitute copyrightable subject matter.²⁷ When granted, copyrights for these works are often "thin," offering protection only from designs that are confusingly similar to the original.²⁸

On the whole, then, copyright law affords little protection for clothing designs. Aside from protection for surface designs and a few exceptions that have been recognized by the case law, the design of clothing itself generally is considered ineligible for copyright protection because it is extremely difficult to separate the artistic from the functional elements.²⁹ As a result, some fashion designers have turned to other intellectual property regimes, such as design patents, to try to secure protection for their designs.

Design Patents

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Design patents are an extension of patent law that protects the ornamental features of an invention.
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Patent law provides protection for new and useful processes, machines, products and compositions of matter through utility patents.³⁰ Design patents are an extension of patent law that protects the ornamental features of an invention. In the most current version of the patent statute, design patents are governed by §171, which states: "[W]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor[sic], subject to the conditions and requirements of this title."³¹ The "conditions and requirements" referred to in §171 are those of patentability. All patentable inventions and designs must be (1) novel³² and (2) nonobvious,³³ or not readily apparent to someone skilled in the art. Inventions subject to a utility patent have an additional requirement of "utility," meaning that the invention must serve some useful purpose.³⁴ In contrast, design patents are intended to protect the "ornamental" portion of an item, which must be separable from its function.³⁵ While the scope of a utility patent is defined by the patent's claims, comprised of written text and figures, a design patent is defined only by its drawings,³⁶ as a result, the scope of design patent protection is limited more than that of utility patents.

When granted, design patents provide 14 years of protection for the invention, compared to 20 years of protection for utility patents.³⁷

Although patent law typically is associated with the realms of science and technology, members of the fashion industry have tried to use design patents to gain protection for their apparel designs. It has been extremely difficult, however, for clothing designers to obtain design patents because apparel designs – though ornamentally different from one era to another – rarely merit patent protection.

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First, there are few elements of clothing design that are novel and nonobvious enough to be distinguishable from previous types of clothing. The standard, as articulated by the Second Circuit, is that "conception of the design must demand some exceptional talent beyond the skill of the ordinary designer."³⁸ For instance, bell bottoms made a resurgence in the late 1990s, incarnated as "boot cut" pants. Though more modest in girth than bell bottoms, boot cut pants clearly were not novel and were obvious in terms of the prior art. As a result, no design patents could have been issued for boot cut pants.

Second, design patent protection issues only when the design is not dictated by the function of the product and is primarily ornamental.³⁹ As noted in the copyright section of this paper, it is difficult to separate design from function in the clothing context. In the example discussed above, even ornamental features such as the boot cut shape serve the utilitarian purpose of protecting the wearers' legs.

While clothing manufacturers generally have not been able to take advantage of design patents due to the demanding novelty and nonobviousness requirements, athletic shoe manufacturers have been

able to obtain design patents and have been responsible for much of the design patent litigation in the fashion context. Design patents on athletic shoes have been upheld even when some of the features in the design also served a useful purpose.⁴⁰ Such protection can be rather limited, however, applying only to the design as pictured in the patent application.⁴¹ And although design patents have been granted to shoes on numerous occasions, courts have not upheld these patents consistently.⁴²



Trademarks are symbols used to identify the origin of a product in a commercial context.



Even if fashion designers were to develop a design that met the standards of novelty and nonobviousness, the process of obtaining a patent (which tends to take around two years) would in most cases be too long and expensive to make patent protection a practical alternative. By the time the designer secured the patent, it would be useless because the commercial lifespan of the design would have lapsed.

Trademark

Trademarks are symbols used to identify the origin of a product in a commercial context. By identifying the source of the product, trademarks serve an important consumer protection function. In contrast to copyrights and design patents, which are used to protect the artistic and ornamental aspects of a product, trademarks protect only the link between the product and its source, not the product itself. If the makers of knockoff goods affix their own trademarks to their products, then trademarks actually can serve to distinguish knockoffs goods from originals and minimize consumer confusion.

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To be a registrable trademark, a name or symbol must be able to identify and distinguish a product from other goods in commerce.⁴³ Marks that are arbitrary or fanciful qualify for trademark registration almost immediately, while marks that are descriptive, including surnames, must acquire "secondary meaning" before they may be registered.⁴⁴ Secondary meaning is a specific type of distinctiveness that is acquired through use of the trademark in the marketplace and requires the formation of a link in the mind of the consumer between the trademark symbol and the company for which it is serving as a signifier. So, while fanciful marks for clothing, such as "Banana Republic," are easily registrable, descriptive marks such as "Tommy Hilfiger" require a considerable amount of investment before they may become registered trademarks.

Protection against trademark infringement has been a key objective for many fashion houses. As knockoff purses bearing "Kate Spade" and "Gucci" labels are sold around the world at bargain prices, it is easy to understand fashion designers' concerns about trademark infringement. Consumers may believe that the knockoff goods, which are inevitably of lower quality, actually were produced by the company. Some designers have seen blatant attempts to adopt confusingly similar trademarks, as in Gianni Versace's case against the holder of the "A.V. by Versace" and "Alfredo Versace" marks.⁴⁵ In a more striking case of infringement, Calvin Klein sued a Hong Kong manufacturer for sale and distribution of goods that the company had rejected for quality reasons but were sold overseas with the trademark still attached.⁴⁶ But infringement suits have been filed not only against unknown knockoff companies; Coach sued Ann Taylor for, among other things, an imitation of Coach's trademarked hanging tag.⁴⁷ The *Coach* court held that Ann Taylor's

hanging tag was confusingly similar to, and infringed, the one used by Coach.⁴⁸

On occasion, certain elements of clothing design also serve as distinctive indicators of the clothing brand, and are eligible for trademark protection. For example, Levi Strauss has a registered trademark in the stitching pattern on the back pocket of its jeans, and successfully has prevented other jean manufacturers from using confusingly similar patterns.⁴⁹ But Levi Strauss' trademark protection only extends to the stitching pattern, and not to the design of its jeans in general. Thus, while trademark law may be used to prevent counterfeiting or misleading production of goods, it is not a useful tool to protect clothing designs per se.

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"Trade dress" refers to the unique design or packaging of a product, such as the distinctive curve of a Coca-Cola bottle.

Trade Dress

Trade dress protection is a relatively recent extension of trademark law. "Trade dress" refers to the unique design or packaging of a product, such as the distinctive curve of a Coca-Cola bottle. Trade dress originally referred to the design of a product's package, but the scope of trade dress has expanded dramatically so that it now "involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques."⁵⁰ Although certain types of trade dress may be registered with the Trademark Office, most remain unregistered and must be protected by § 1125(a) of the Lanham Act.⁵¹ This statutory section forbids the use of any similar trade dress that is likely to cause confusion, mistake or deception.⁵²

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In 2000, the Supreme Court declined to extend trade dress protection to clothing designs in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*⁵³ In this case, a children's clothing manufacturer sued the retail chain over the sale of knockoff one-piece seersucker outfits for children. The Court held that the outfits were not protected by trade dress law, and confirmed that product designs are only protectable if they acquire secondary meaning as a trademark, such that "in the minds of the public, the primary significance of a [product design] is to identify the source of the product rather than the product itself."⁵⁴ Fashion designs rarely will have secondary meaning because they are not intended to identify the source of the product, but instead aim to make the product more useful or appealing.⁵⁵ In addition, most fashion designs would be too short-lived to achieve secondary meaning. The Court maintained this high threshold for trade dress protection in order to benefit both competition and consumers, stating that "[c]onsumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves."⁵⁶

A federal court recently applied the *Wal-Mart* holding in a case involving purses.⁵⁷ Design house Louis Vuitton alleged that Dooney & Bourke's "It Bag" with multicolored "DB" monograms on white or black backgrounds infringed Vuitton's trade dress in its similar looking bags. The court held that, while Vuitton had trademark rights in the Vuitton marks themselves,⁵⁸ it did not have trade dress rights in the overall look of its bags. Among other things, the court was concerned that excessive trade dress protection would hinder competition:

Louis Vuitton created a new look and now seeks to preclude others from following its lead. If Louis Vuitton succeeds, then it will have used the law to achieve an unwarranted anticompetitive result. It is well established that the objective of trademark law is not to harm competition.⁵⁹

Indeed, trademark laws seek to safeguard competition, and as the Supreme Court has observed, "copying is not always discouraged or disfavored by the laws which preserve our competitive economy."⁶⁰

Conclusion

This paper began with a quote from intellectual property scholar Jessica Litman, in which she transposes the traditional argument in favor of expansive intellectual property protection to the fashion industry. According to the traditional argument, without intellectual property protection, artists will lack incentives to create and creative industries will wither. It is a powerful argument, and one that has been extremely successful in justifying new rights – the music and film industries have used it to secure (among other developments) a 20-year extension to the copyright term and a new right to control access to digital works. When applied to the fashion industry, however – as Litman's quote brilliantly illustrates – the theory doesn't hold. Despite the lack of intellectual property protection (or perhaps because of it), designers continue to create and the industry continues to grow.

Fashion's counterexample challenges the idea often reflexively accepted by policymakers and courts that "more rights" automatically ensure "more creativity" and less rights will choke it. In the fashion industry, the absence of rights actually may feed the creative process. Fashion designers are free to borrow, imitate, revive, recombine, transform and share design elements without paying royalties or worrying about infringing intellectual property rights. Of course, fashion designers are not the only creators who draw on previous works in order to create. "Culture ... grows by accretion, each new creator building on the works

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of those who came before."⁶¹ If the 12-bar Blues, boy-meets-girl story, or the works of Shakespeare and Mozart were copyrighted, much of the music, films and novels we enjoy today would be illegal. In any creative sector, granting excessive rights could stifle creativity, because every right asserted takes away "raw materials" from future creators.



If the 12-bar Blues, boy-meets-girl story, or the works of Shakespeare and Mozart were copyrighted, much of the music, films and novels we enjoy today would be illegal.



Fashion's counterexample also challenges the dominant business model in other creative industries that relies on zealously preventing unauthorized or unpaid uses of content. With fashion, the constant frenzy of creation and imitation may actually drive rather than destroy the market for original goods. Perhaps the ubiquity of a design makes owning the original more desirable and prestigious. Perhaps designers recoup costs by marketing to high-end consumers who want the brand name and quality of the original, while knockoff goods serve those who would not buy couture anyway.

Is fashion the exception or should it be the rule? Does fashion flourish in a less protective climate because of unique mechanics of creativity and marketing, or are we overprotecting in other creative sectors? Either way, the questions are crucial. As this paper has described, intellectual property has been expanding rapidly in recent years, driven by the argument that more protection will spur greater creativity and save creative industries from extinction. But what if this isn't true? What if these expansions might actually harm the very creativity and industries they seek to protect?

We are currently in the midst of critical debates about optimal levels of intellectual property protection. The fashion experience can inform these debates with important insights into how the creative process works

and how different business models function, and merits further, careful examination.

¹ Jessica Litman, *Digital Copyright: Protecting Intellectual Property on the Internet* (Amherst, New York: Prometheus Books, 2000), 105-06.

² "Splurge vs. Steal," *Marie Claire*, July 2005, 154.

³ *Id.*

⁴ A number of law review articles have made this observation, and argued that fashion designs should enjoy greater protection under various intellectual property schemes. *See, e.g.*, Anne Theodore Briggs, *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, 24 HASTINGS COMM. & ENT. L. J. 169 (2002); Safia A. Nurbhai, *Style Piracy Revisited*, 10 J.L. & POL'Y 489 (2002); Jennifer Mencken, *A Design for the Copyright of Fashion*, 1997 B.C. INTELL. PROP. & TECH. F. 121201 (1997); Peter K. Schalestock, *Forms of Redress for Design Piracy: How Victims Can Use Existing Copyright Law*, 21 SEATTLE U. L. REV. 113 (1997); Rocky Schmidt, *Designer Law: Fashioning a Remedy for Design Piracy*, 30 UCLA L. REV. 861 (1983).

⁵ *See, e.g.*, H.R. REP. NO. 1476, 94th Cong., 2d Sess. 50 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5668; *Fashion Originators' Guild of America, Inc. v. Federal Trade Commission*, 312 U.S. 457 (1941); *Cheney Bros. v. Doris Silk Corp.* 35 F.2d 279 (2d Cir. 1929); Policy Decision, Registrability of Costume Designs, 56 Fed. Reg. 56530-02 (Nov. 5, 1991).

⁶ Addressing proposed design protection legislation in 1914, one Congressman remarked: "The trouble with this bill is that it is for the benefit of two parties; that is, the enormously rich who want to display their splendid apparel that they can wear in this country that the ordinary riff-raff ought not to be allowed to wear, and those rich concerns who have these extra and selected designers to design these special patterns for those elite." Hearings on H.R. 11321, 63d Cong. (1914).

⁷ Testimony of the Department of Justice, Hearings on H.R. 2223, 94th Cong. (1975), H.R. REP. NO. 1476 at 50.

⁸ *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989, 999 (Weinstein, J., dissenting) (2d Cir. 1980).

⁹ 17 U.S.C. § 102(a) (2001).

¹⁰ 17 U.S.C. § 101 (2001); H.R. REP. NO. 94-1476 at 55. Under the current Copyright Act, a useful article is "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."

¹¹ 17 U.S.C. § 101 (2001).

¹² 347 U.S. 201 (1954).

¹³ *Id.* at 218.

¹⁴ H.R. REP. NO. 94-1476 at 55. Congress explained the reasoning behind this "separability" rule as follows:

[T]he Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.

¹⁵ *Whimsicality v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989). The *Whimsicality* court further denied the plaintiff's claim that the costumes at issue in the case were not useful articles but could instead be classified as soft sculptures, stating that "the word sculpture implies a relatively firm form representing a particular concept. The costumes in question have no such form [W]e conclude therefore that these costumes do not constitute sculpture." *Id.* at 456.

¹⁶ *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989 (2d Cir. 1980).

¹⁷ *Id.* at 991.

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Id.* at 993.

²¹ *Id.*

²² *Carol Barnhart v. Economy Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985).

²³ *Poe v. Missing Persons*, 745 F.2d 1238, 1242 (9th Cir. 1984).

²⁴ *Schalestock*, *supra* note 4, at 123.

²⁵ *National Theme Prods., Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1350 (S.D. Cal. 1988).

²⁶ *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995).

²⁷ *Knitwaves*, 71 F.3d at 1002; *Peter Pan Fabrics Inc. v. Brenda Fabrics Inc.*, 169 F. Supp. 142 (S.D.N.Y. 1959); *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065 (S.D.N.Y. 1995); *Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484 (S.D.N.Y. 1997).

²⁸ See H.R. REP. NO. 94-1476 at 55.

²⁹ See Melville Nimmer, 1-2 NIMMER ON COPYRIGHT §2.08.

³⁰ 35 U.S.C. § 101 (2001).

³¹ 35 U.S.C. § 171 (2001).

³² 35 U.S.C. § 102 (2001).

³³ 35 U.S.C. § 103 (2001).

³⁴ 35 U.S.C. § 101 (2001).

³⁵ 35 U.S.C. § 171 (2001).

³⁶ 37 C.F.R. § 1.153(a).

³⁷ 35 U.S.C. § 173 (2001).

³⁸ *Neufeld-Furst & Co v. Jay-Day Frocks*, 112 F.2d 715 (2d Cir. 1940).

³⁹ *L.A. Gear v. Thom McAn*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

⁴⁰ *Id.* Upholding a design patent on a sneaker, the court stated: "[T]he utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article."

⁴¹ *Payless Shoesource v. Reebok International*, 998 F.2d 985, 990 (Fed. Cir. 1993).

⁴² *Briggs*, *supra* note 4, at 178.

⁴³ 15 U.S.C. § 1052 (2001).

⁴⁴ *Id.*

⁴⁵ *A.V. By Versace v. Gianni Versace*, 126 F. Supp. 2d 328 (S.D.N.Y. 2001).

⁴⁶ *Calvin Klein Industries, Inc. v. BFK Hong Kong, Ltd.*, 714 F. Supp. 78 (S.D.N.Y. 1989).

⁴⁷ *Coach Leatherware Company, Inc. v. Ann Taylor, Inc.*, 933 F.2d 162 (2d Cir. 1991).

⁴⁸ *Id.* at 170.

⁴⁹ *Lois Sportswear v. Levi Strauss & Co.*, 799 F.2d 867 (2d Cir. 1986).

⁵⁰ *Two Pesos v. Taco Cabana*, 505 U.S. 763, 765 n.1 (1992).

⁵¹ 15 U.S.C. § 1125(a) (2001).

⁵² *Id.*

⁵³ 529 U.S. 205 (2000).

⁵⁴ *Id.* at 211 (internal citation omitted).

⁵⁵ *Id.* at 213.

⁵⁶ *Id.*

⁵⁷ *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415 (S.D.N.Y. 2004).

⁵⁸ There was no infringement of Vuitton's marks because Dooney & Bourke used its own "DB" mark, making it obvious to consumers that the Dooney & Bourke bags were not Vuitton bags. *Id.* at 440.

⁵⁹ *Id.* at 420 (emphasis in original).

⁶⁰ *TraFFix Devices v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001).

⁶¹ *White v. Samsung Electronics*, 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J. dissenting).