

Bringing Copyright Protection for Fashion Design Into the Fold

Over the past five years, the fashion industry has debated a reform to copyright law in the United States in order to extend protection to fashion design, which is not protected by any area of intellectual property law. Met with resistance from retail associations and consumer groups which seek to preserve the status quo in the United States of designs being freely copied, designers have tried unsuccessfully to pass several versions of a

bill which would amend the Copyright Act to provide protection for fashion designs.¹ In 2006, advocates for this change introduced the Design Piracy Prohibition Act (H.R. 2196), which would have provided a three-year term of protection for apparel designs.² While H.R. 2196 and other past attempts at expanding the Copyright Act to cover fashion design have stalled in committee, however, a bill introduced last August by Sen. Charles Schumer (D-N.Y.) went all the way to the Senate floor.³ In July 2011,

the House Subcommittee on Intellectual Property, Competition, and the Internet heard testimony from those in the fashion industry about the bill.⁴ The Innovative Design Protection and Piracy Prevention Act (IDPPPA) contains some provisions like those in H.R. 2196, but attempts to strike a balance between the competing perspectives, and remains the best hope for meaningful copyright protection for fashion design.



Background

In order to understand how the law could effectively be amended to encompass fashion design, it is important to first understand why copyright law currently excludes apparel from its purview. Clothing has traditionally been viewed as a “useful article” and thus not protected under copyright law with its focus on protection for creative original works. Specifically, a useful article is defined in the Copyright Act as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁵ Thus,

whether or not a product will be considered a useful article turns on whether the function of the article is inherently utilitarian, or whether it is exclusively aesthetic or informational.

The principal exception to the general rule that useful articles can not be protected under copyright law, however, is “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.”⁶ Because works that are “pictorial, graphic and sculptural” are protected under § 102 of the Copyright Act, if a utilitarian article has “pictorial, graphic or sculptural” aspects that can be physically or conceptually separated, then the article may be eligible for protection.⁷

By a strange twist of legislative history, the Copyright Act does contain an express provision of protection of original designs of one particular and unique type—vessel hulls.⁸ This special protection for ship designs was enacted in 1998 as Chapter 13 of the Copyright Act, entitled “Protection of Original Designs,” in response to the Supreme Court’s decision in *Bonito Boats v. Thunder Craft Boats Inc.*⁹ In that case, the Supreme Court struck down a Florida statute that proscribed boat hull copying. In response, Congress enacted Chapter 13.

Proposed Amendment to Chapter 13

Chapter 13 of the Copyright Act provides that 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 public may secure the protection provided by this chapter ...” and defines an “original design” as a design which is “the result of the designer’s creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.” The statute, however, dramatically circumscribes the potential reach of this broad language by explicitly limiting the definition of the type of “useful article” that may be protected to a vessel hull.

Given the potential for expanding Chapter 13, H.R. 2196 and the IDPPPA were drafted to amend Chapter 13 to extend protection to certain types of apparel designs with a three-year term of protection. The legislation would do so by amending the defini-



tion of “useful article” to add the provision “or an article of apparel.”¹⁰ The bill would also add definitions for “fashion design” and “apparel.” The term “apparel” would include articles of men’s, women’s, and children’s clothing including undergarments, outerwear, gloves, footwear, headgear, handbags, purses, totes, belts, and eyeglass frames.¹¹

Perhaps reflecting the controversy surrounding the concept of protecting fashion designs under copyright law, however, some of the bill’s provisions offer less protection for apparel than the law currently provides for vessel hulls. For example, while vessel hulls enjoy a 10-year term of protection, the bill only provides for a three-year term for apparel.¹² The rationale behind the three-year term is that this period is sufficient to protect high end “haute couture” designs when they are first introduced, supplying protection when designs are most likely to be copied and sold at a lower price.¹³ Also, because the nature of fashion design is such that trends come and go quickly, proponents of the bill have agreed that a three-year term is long enough to give the designer the exclusive protection it needs.

Differences Between Past Bills and the Currently Pending Bill

The IDPPPA is novel in that it offers less protection for fashion designs than the Copyright Act now confers on other creative works. In this way, it represents a compromise between the fashion designers and those who copy them.¹⁴ Unlike previous versions, the IDPPPA has been endorsed by two apparel trade associations: the Council of Fashion Designers of America (CFDA) and the American Apparel & Footwear Association (AAFA).¹⁵ Thus, the narrowly tailored proposal of the IDPPPA is more likely than its more extreme predecessors to eventually become law.

In some ways, the IDPPPA is consistent with its predecessor, H.R. 2196. Specifically, both bills provide for a short, three-year term of protection for new and original fashion designs (as opposed to the usual copyright term, which extends for decades).¹⁶ They also both impose a high standard to qualify for protection, requiring originality and novelty, leaving everything else in the public domain.¹⁷ Finally, both bills preserve the independent creation defense from Chapter 13 which provides that there shall not be liability if the designer can prove that she came up with an idea on her own, even if it would otherwise be infringing of another design.¹⁸

But the IDPPPA departs from the prior bills in important ways—primarily that it would prohibit only copies that are “substantially identical” to protected designs.¹⁹ This limited protection is a significant departure from the standard of “substantially similar” which applies to copyright infringement of other types of protected works and largely borrows from trademark law. By using the word “identical”

rather than “similar,” the bill would forbid only exact knock-offs of a protected design. Fashion retailers could continue to produce apparel that is on trend, and an item that is merely “inspired” by a protected design would not be considered infringing. However, if, upon close inspection, an average consumer could not tell the difference between the inspired design and the original, it would probably be considered an infringing copy.

The IDPPPA also differs from past bills, and from the current Copyright Act, in that it eliminates the registration requirement, a change that would benefit emerging designers.²⁰ The bill also imposes a heightened pleading standard (i.e., pleading with particularity) that is intended to discourage litigation and curb frivolous claims.²¹

Finally, the IDPPPA takes a fresh approach to other fashion design issues. For example, inadvertent buying or selling of illegal copies would not result in liability for retailers or consumers, and those sewing at home could copy a protected design for personal use.²²

Despite its narrow scope, the proposal has many detractors. These opponents argue that increasing copyright protection for fashion design will spur many frivolous lawsuits and that the law would be impractical and difficult to enforce. Opponents have also argued that the status quo of widespread copying is an accepted part of our society which ensures that fashion trends are accessible to those who cannot afford to wear designer fashions. Moreover, the constant cycle of innovation and copying helps to keep the economy moving.²³

On the other hand, as stated by a designer who testified in support of the bill in July, “[t]he fashion industry is already a tough business and it is getting tougher because of piracy.”²⁴ This testimony echoed the opinion of many in the business who are desperate for some kind of legal protection to curb the rampant knockoffs that plague designers in the United States.

On the whole, the IDPPPA appears to satisfy the interests of both the fashion designers and those who seek access to their handiwork. Thus, while this bill has not yet become law, the relative success of this most recent bill is a sign that fashion design may soon become part of the fold of copyright protection in the United States. **TFL**

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industries. Smith is the co-author of the 2008 edition of Protecting and Enforcing Copyright (MCLE Inc. 3rd ed. 2008) as well as several other articles about various aspects of copyright law. © 2011 Nicole Rizzo Smith. All rights reserved.

Endnotes

¹H.R. 2196, 111th Cong. (2009), available at thomas.loc.gov/cgi-bin/query/z?c111:H.R.2196, reintroduced to Congress on July 13, 2011, as H.R. 2511.

²*Supra*, note 1.

³S. 3728, 111th Cong. (2010), available at thomas.loc.gov/cgi-bin/query/z?c111:S.3728.

⁴nymag.com/daily/fashion/2011/07/proenza-schoulers-lazaro-herna.html; *supra* note 3.

⁵17 U.S.C. § 101.

⁶*Protection for Fashion Design: Hearing on H.R. 5055 Before the H. Subcomm. on Courts, the Internet, and Intellectual Property*, 109th Cong. 2d Sess. Hearings Before the House Subcomm. on Courts, the Internet, and Intellectual Property, 109th Cong. 197-219 (2006) (statement of U.S. Copyright Office).

⁷17 U.S.C. § 102(a)(5).

⁸17 U.S.C. § 1301(a). A “vessel” is a “craft that is designed and capable of independently steering a course on or through water through its own means

of propulsion; and that is designed and capable of carrying and transporting one or more passengers.” A “hull” is “the frame or body of a vessel, including the deck of a vessel, exclusive of masts, sails, yards, and rigging.”

⁹489 U.S. 141 (1989).

¹⁰*Supra*, note 3.

¹¹*Supra*, note 3.

¹²*Supra*, note 3.

¹³*Supra*, note 6.

¹⁴*See* runway.blogs.nytimes.com/2010/08/05/schumer-bill-seeks-to-protect-fashion-design/?partner=rss&emc=rss

¹⁵*Supra*, notes 4, 14.

¹⁶www.counterfeitchic.com/2010/08/introducing-the-innovative-design-protection-and-piracy-prevention-act.html

¹⁷*Supra*, note 16.

¹⁸*Supra*, note 16.

¹⁹*Supra*, note 16.

²⁰*Supra*, note 16.

²¹*Supra*, note 16.

²²*Supra*, note 16.

²³*See supra*, note 4.

²⁴*See supra*, note 4.

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licly funded construction projects, particularly when a contract was awarded to a nonunion contractor. They may even interview workers to determine whether the Davis-Bacon Act or a state or local equivalent is being violated. Employees, too, may report violations or enforce the Davis-Bacon Act through a civil lawsuit.

When it comes to penalties, an employer found to have violated prevailing wage requirements or failed to maintain records as required under the Davis-Bacon Act can face contract termination, debarment from future government contracts for up to three years, and the withholding of contract payments to satisfy any unpaid wages. Other potential damages under various prevailing wage statutes may include fines, penalties, liquidated damages, and an award of attorney's fees. Under some statutes, willful violations can result in criminal sanctions including imprisonment.

It is a challenging time to be in the construction industry. Nailing down the proper classifications by correlating the actual tasks performed by the worker to the statutory hourly base wage and fringe benefit rates applicable at the time the bid is solicited, will assist contractors in successfully navigating the prevailing wage laws. **TFL**

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