Fashioning copyright protection for apparel in the US

Shannon M Nestor from Covington & Burling LLP dresses us in this season's copyright protection

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The fashion world may already be focusing on what people will be wearing in 2012, but here now in 2011, the industry may finally be afforded the opportunity to take full advantage of intellectual property (IP) protections never before provided within the US. Pieces of legislation proposing copyright protection for apparel have come and gone, but the latest one, this time from the Senate, may embody the compromises necessary to pass both houses of Congress, thus affording copyright protection to fashion designs and bringing the US in-line with regimes already in place throughout the world. Although the 111th Congress failed to pass this latest iteration of a fashion design copyright bill, the continued drive to implement this kind of legislation suggests that a similar bill may come up again in the 112th session.

Unlike in Europe, the US affords no direct IP protection for fashion design. There are limited protections available via patent and trademark law, but the US copyright regime provides little protection to apparel, save for some protection for the designs on the material itself. Traditional copyright, however, provides almost no protection for the design of an article of apparel as a whole, because clothing and fashion accessories historically have been treated as "useful articles"[1] and thus not capable of being afforded copyright protection. This Senate bill, like the others before it, seeks to fill that gap. Such protection would, according to the bill's proponents, stop the rampant knocking-off of popular designs and permit designers to reap the economic benefits of their endeavors without fear of being copied by another retailer.

The 'Innovative Design Protection and Piracy Prevention Act'

Senate Bill 3728, known as the Innovative Design Protection and Piracy Prevention Act, was unanimously passed out of the Senate Judiciary Committee in December 2010 and thereafter was placed on the Senate calendar, but ultimately was never voted on.[2] The bill marked the fifth time that such legislation had been proposed in Congress, but was the first time that such a bill had made it out of committee. It was also the first time that such a bill had support from both the Council of Fashion Designers of America – a major industry supporter of previous fashion design copyright legislation – and the American Apparel and Footwear Association – a major industry opposer of previous bills.[3] Although there has been buzz for these bills before, most notably in Spring and Summer 2009 when many designers and industry observers testified before Congress in support of the House of Representatives Bill 2196; the fact that this bill finally came out of committee and made it onto the Senate calendar suggests that some version of a fashion design copyright bill will eventually pass through Congress and become law. In addition to the new name, the Senate bill also contains some new additions, deletions, and compromises from the House bill.[4]

Designs protected under the Act

As with prior versions, the Senate bill would amend Chapter 13 of the Copyright Act, a chapter which currently provides copyright protection solely to vessel hulls, another "useful article" that recently has been afforded copyright protection in the US. Like the previous bills, this Senate version of the proposed legislation would provide a relatively short period of protection of three years for any particular fashion design. This short period contrasts with the longer protection periods afforded to boat hulls under the same chapter of the Copyright Act (ten years of protection). Much longer periods are bestowed on works eligible for copyright protection as defined under section 102 of the Copyright Act, like art work, literature or sound recordings, which now get protection for life of the author of the work plus 70 years; or for corporate copyright owners, 95 or 120 years of protection depending on the circumstances of publication and creation.

Senate Bill 3728 defines "fashion design" as "the appearance as a whole of an article of apparel, including its ornamentation." As defined in the bill, articles of apparel capable of being afforded copyright protection include: clothing; gloves; footwear; headgear; handbags

and purses; wallets; bags and suitcases; belts; and eyeglass frames. The protected design includes both original elements and/or the "original arrangement or placement of original or non-original elements," similar to traditional copyright protections for compilations. Like all works which are afforded copyright protection, the design must have originality. However, the proposed legislation enforces a higher standard for originality, in contrast to the de minimus threshold for originality that usually is required of protected works. Under the Act, a fashion design must: (1) be created by the designer as a "result of a designer's own creative endeavor" as well as (2) embody an "unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles."

This higher threshold of originality may eliminate many designs from ever qualifying for protection under the proposed bill, no matter the potential for counterfeiting or copying by others in the industry. Fashion designers known for their minimalist designs may be unable to seek copyright protection under this legislation. Furthermore, designers will not be able to get protection for any design created before enactment of the legislation.

Carve-outs

As with the other versions of the bill, there are carve-outs for non-infringing articles and uses. The "carve-outs" specifically define those uses that are not infringing of otherwise protected designs, just like traditional copyright fair use carve-outs. These carve-outs include independently created works and works which are "not substantially identical in overall visual appearance to and as to the original elements of a protected design," as well as use of illustrations or pictures of protected designs in advertisements, books, magazines, and the like. The carve-outs for illustrations and pictures would allow for commentary on the protected fashions so that, for example, industry magazines could publish articles about the newest designs.

What is new to this version of the bill is an explicit carve-out for home sewers. The Act specifically permits home sewers to "produce a single copy of a protected design," so long as the sewer uses that copy for personal use or for the use of an "immediate" family member. Thereafter, any home-sewn copy must not be offered for sale or use in trade during the three years of copyright protection. Even though the Act would permit copying at home, it explicitly does not authorise the "publication or distribution of instructions or patterns for the copying of a protected design." Presumably, this provision would prevent both home sewers from disseminating instructions to fellow sewers – often done through popular sewing internet bulletin boards[5] – as well as pattern companies from selling patterns that purport to knock-off runway fashions, even though all of this would be for the home sewer's own use.

Notable deletions to Senate Bill 3728

This time round, the purposed legislation does not include two important provisions from earlier versions: (1) an explicit carve-out for "trends", and (2) a registration requirement and creation of a searchable database for fashion designs. The previous House version of the bill specifically exempted designs that reflected trends as being non-infringing of any otherwise protected design. The deletion of the "trends" exception leaves it up in the air as to whether a trend, which had been defined as a "newly popular concept, idea, or principle," embodied within a design would be protected under the Act; or whether the definition of "trends" as a "concept, idea, or principle" not capable of being afforded protection is redundant, since copyright law traditionally does not protect concepts, ideas, or principles.

The Act also does not contain a requirement for a designer registering an article of apparel with the Copyright Office to receive copyright protection.[6] Commentators criticised earlier versions of the fashion copyright bill for including this requirement because it mandated registration for protection

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when the traditional copyright regime does not. The registration itself could also prove too burdensome and costly for designers without access to sophisticated legal advice.

As there is no longer a registration requirement, the three years of protection afforded by the Act would start to run from the time when the design in question is first made public. Most major fashion houses preview their collections months ahead of the buying season for their clothes. For example, New York Fashion Week 2011 was February 10–17, and the shown collections were for Fall and Winter 2011–2012. Therefore, major industry players would need to carefully consider when and how they make their collections public to properly maintain their copyright protections and to ensure that any lawsuit for infringement is timely.

What a lawsuit for infringement will look like under the Act

Also new to this version of the fashion design bill are the standards for infringement of any protected design, and how lawsuits regarding that alleged infringement must be pled. This time, the bill borrows from trademark law and imposes a "substantially identical" standard for infringement. A design will be found to be infringing when it is "so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial." This test appears to be a compromise from the various tests proposed throughout the drafting of the earlier versions of the fashion design bill.

Interestingly, the Act also includes a heightened pleading standard for lawsuits. Any claims brought for infringement of protected designs will have to be "plead with particularity" and must establish: (1) that the would-be plaintiff's design is protected by the Act, (2) that the defendant's design infringes on that protected design, and (3) that the protected design was available in a location or locations, and for an amount of time that it can be "reasonably inferred" that the defendant saw or had knowledge of the protected design. Failure to meet this heightened pleading standard will undoubtedly result in an early dismissal of the case. Attorneys for fashion designers therefore will need to carefully review the facts of each case before bringing suit, or risk not only dismissal of that case, but potentially sanctions as well for bringing frivolous litigation.

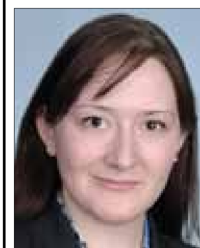
What to look for in 2011 and beyond

While the future for fashion in 2011 looks to be neon bright, the future of copyright protection for fashion design is still murky. The Senate's most recent proposal appears to be the best compromise that has come out of the US Congress so far, and in light of the number of times that a fashion bill has been proposed in both houses, it appears increasingly more likely that legislation for copyright protection of fashion designs will eventually be enacted. Fashion designers, and their legal counsel, should pay close attention in the coming months to the 112th Congress for any signs that this legislation is back on the (cutting) table.

Footnotes

1. 17 U.S.C. § 101 (defining "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information").
2. The bill's history can be reviewed at <http://www.govtrack.us/congress/bill.xpd?bill=s111-3728>.
3. See <http://www.cfda.com/schumer-introduces-legislation-to-protect-fashion-design> for the CFDA's press release regarding S. 3728.
4. The details of House of Representatives Bill 2196 (the "Design Piracy Prohibition Act") were discussed in my April 2010 Copyright World article, "Who are you wearing?" For the purposes of this article, all citations will be to S. 3728 unless otherwise stated.
5. See, e.g., <http://sewing.patternreview.com/cgi-bin/contestreport.pl?ContestID=140> for details regarding a fashion "knock-off" contest for home sewers.
6. See H.R. 2196, § 2(f) regarding the creation of a fashion design copyright database and the requirements for registration through that database.

Author



Shannon M Nestor is a senior litigation associate at Covington & Burling LLP. Her intellectual property practice focuses on copyright, patent, trademark, and Internet-related matters, and she has represented clients at the International Trade Commission, Trademark Trial and Appeal Board, and the World Intellectual Property Organization.