

The Art We Wear

Wearing clothes is a uniquely human trait. Though the date of the origin of clothing is still debated, anthropologists have found evidence from lice that suggests that people started wearing clothes as early as 170,000 years ago and remnants of what are believed to have been needles made of animal bones that date nearly as far back as the oldest remnants of clothing.¹ Native Americans were also known to have made sewing needs from natural resources such as the agave plant.² The modern sewing needle was introduced in England in 1639, and Elias Howe invented the sewing machine in 1846.³

Since the early days of wearing clothes, humans have used them to express characteristics about themselves such as ethnic origin, tribe, wealth, and status. As society has progressed, fashion has progressed and has become an expression of creativity and personality. Because modern fashion relates closely to trends and fleeting popularity, designers take creative risks to produce something that will become popular among consumers. Consequently, fashion designers have advocated to have their works granted equivalent protections to those who create in other mediums such as literary and musical works. This paper will discuss the protection available for creativity in the realm of fashion across the globe and the barriers that prevent protection in nations that offer little.

Part I will discuss the evolution of fashion designing, the influencers that have driven changes in fashion and styles of dress, and early governmental actions to control access to fashion. Part II will define fashion law, including the stakeholders, and the development of regulatory regimes concerning fashion law in the United States and in Europe. Part III will discuss the current state of fashion design protection in the United States, the European Union and Asian nations. Finally, part IV will discuss the issue of counterfeiting across the world and propose that piracy should be treated similarly.

I. History of Fashion

A. In the Beginning

¹ Jan Viegas, *Humans First Wore Clothing 170,000 Years Ago*, Seeker: History (Jan. 6, 2011,

² *The Needle and Thread Plant*, Sci. Am. (June 1885), <https://www.scientificamerican.com/article/the-needle-and-thread-plant/> (last visited Dec. 13, 2018)

³ Kate McLaren, *The Sewing Needle: A History Through 16-19th Centuries*, NGV (Jun. 13, 2015), <https://www.ngv.vic.gov.au/the-sewing-needle-a-history-through-16-19th-centuries/>

In the early eras of fashion, styles of dress did not change much and lasted for periods as long as centuries.⁴ These long stints of time are called *Trachts*⁵. During this time of *Tracht* cycles, changes in fashion were typically specific to men's fashion and were prompted by military factors.⁶ For example, after a Swiss victory in the fourteenth century European men's fashion changed to imitate the Swiss.⁷ This happened again in the sixteenth century after a Spanish victory.⁸

Because women were not involved with the military, women's fashion was largely unaffected at this time. Women gradually became more "clothes conscience," however, often being influenced by the fashion of the royal court.⁹ Even in these early times, fashion innovators were protective of their creative expressions. For example, Queen Elizabeth I of England is acknowledged for being a leader in fashion and forbidding others from copying her style.¹⁰ Other royal courts across Europe, however, influenced fashion differently by requiring a certain dress code when individuals entered the courts or requiring courtiers to be dressed in a different suit each time they were in the presence of royalty.¹¹ Fashion was also important for romantic courting. The way a man was dressed became an indication of his wealth. Further, men exhibited their wealth by dressing their wives in ways that would indicate that he had afforded her the luxury of not working.¹²

As the competition to display status via one's clothing grew, aristocrats sought to distinguish themselves and establish their hierarchy through sumptuary laws, which are laws that place restrictions on certain individuals' right to enjoy certain luxuries. The sumptuary laws of the Elizabethan era were aimed at ensuring that the lower class could be distinguished from aristocrats.¹³ For example, one Elizabethan statute prohibited men whose social status was below

⁴ Herman Freudenberger, *Fashion, Sumptuary Laws, and Business*, 37 BUS. HIST. REV. 37, 39 (1963).

⁵ *Id.*

⁶ *Id.*

⁷ *Id.*

⁸ *Id.*

⁹ *See e.g. id.* at 39-40.

¹⁰ *Id.* at 40

¹¹ *Id.* at 39

¹² *Id.* at 40

¹³ *See Who Wears What I: Enforcing Statutes of Apparel*, issued at Greenwich, 15 June 1574, 16 Elizabeth I.

that of baron from wearing velvet outerwear, leopard fur, or silk embroidery unless in the presence of the Queen.¹⁴

In fact, it is the sumptuary laws of France throughout the mid sixteenth and early seventeenth centuries that can be credited with setting forth the path for Paris to become the world's fashion leader. Because he was unhappy with the large amounts of money the rich were sending to Italy for silks, Henry IV of France forbade the French from purchasing silks that were manufactured outside of France.¹⁵ Consequently, the French silk industry flourished, and France became the leading producer of luxury goods.¹⁶ By the second half of the 1600's, Paris was recognized across Europe as the center of fashion.¹⁷ French silk manufacturers sent models to Paris dressed in their latest styles to attempt to capture the attention of Parisian dressmakers.¹⁸ Parisian magazines were also very influential around Europe, and dressmakers often copied the styles in the magazines.¹⁹

Charles Frederick Worth, an Englishman born in 1825 who relocated to Paris at age twenty, is credited with being the world's first fashion designer. His success was due in large part to Empress Eugénie's, Napoleon III's wife, fondness of his designs.²⁰ Worth's award-winning designs from the mid to late 1800's are notable for using lavish fabrics and trimmings, their fit, and their inspiration from historical dress.²¹ Worth's fashion house, House of Worth, featured live models displaying his most recent designs and was visited by aristocrats from around the world.²² As copying became easier with advances in technology, France was prompted to promulgate laws that would protect his and other fashion houses' designs.²³

B. From Custom to Ready-to-Wear and the Rise of Piracy

¹⁴ *Id.*

¹⁵ Freudenberger, *supra* note 4, at 41.

¹⁶ *Id.* at 42

¹⁷ *Id.*

¹⁸ Pranjali Shirwaiker, *Fashion Copying and Design of the Law*, 14 J. INTELL. PROP. Rts. 113, 114 (2009).

¹⁹ *Id.*

²⁰ Jessa Krick, *Charles Frederick Worth (1825-1895) and the House of Worth*, The Met: Heilbrunn Timeline of Art History (Oct. 2004), http://www.metmuseum.org/toah/hd/wrth/hd_wrth.htm Metmuseum.org

²¹ *Id.*

²² *Id.*

²³ *Id.* at 115.

Thanks to the inventions of the Industrial Revolution, which occurred from the mid 1700's to mid 1800's, the garment industry became able to produce clothing much more quickly than before. As textile factories grew in proliferation, garments went from being bespoke and handmade to being mass produced in stock sizes, known as ready-to-wear clothing. This also meant that designs could be copied more quickly and in larger quantities.²⁴ The wealthy and upper class continued to have their clothes handmade, but they too contributed to the problem of copied designs by taking pictures from fashion magazines and catalogs to seamstresses and requesting the pieces be copied.²⁵

Department stores also came into proliferation in the late 1800's, which led to a greater number of and easier access to knock-off designs.²⁶ In 1902, Marshall Field's, one of the first department stores, advertised copied dresses for a third of the price of the *haute couture* version.²⁷ Department stores also helped to increase the demand for new designs. Styles no longer lasted for *Trachts*. Now that the public had greater access to and awareness of new styles, the demand for the latest and greatest fashion became insatiable, and new designs began to come out seasonally. This demand for new designs has grown exponentially throughout the twentieth and twenty-first centuries; there are now as many as fifty-two microseasons in fashion.

II. Fashion Law and Intellectual Property

As defined by Professor Susan Scafidi, academic director of Fordham Law's Fashion Law Institute, fashion law is the field that "embraces the legal substance of style."²⁸ This fairly new field involves issues that accompany fashion encompassing the entire system from the designer's original idea to the consumer's closet.²⁹ One of the main components of fashion law is intellectual property. Like all forms of intellectual property, fashion designs derive from the work of the mind; they are the result of creativity. Therefore, creators have a natural interest in protecting their creativity from piracy, the unauthorized copying of another's work.

²⁴ Dolores Monet, *Ready-to-Wear: A Short History of the Garment Industry*, Bellatory: Fashion Indus. And Hist. (Aug. 1, 2017), <https://bellatory.com/fashion-industry/Ready-to-Wear-A-Short-History-of-the-Garment-Industry>

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.*; *Haute couture*, or just *couture*, refers to custom-made clothing produced by fashion houses as opposed to ready-to-wear clothes, which are mass-produced for off-the-rack sale.

²⁸ URSULA FURI-PERRY, *THE LITTLE BOOK OF FASHION LAW* ix (ABA ed., 2010)

²⁹ *See id.*

A. Stakeholders

Because of the many components of fashion law, there are many stakeholders, several of which have conflicting interests. Fashion houses and their designers, driven by the theory of personhood and an attachment to things that are their own, are primarily interested in excluding others from benefitting from their goodwill and creativity. Manufacturers want to have low operation costs to ensure that they are able to sell their goods to retailers at low prices. Department stores and other retailers want to be able to offer a variety of styles and the latest and most popular styles for a price that their consumers are willing to pay. Consumers want to enjoy the latest and most popular styles, and most want to do so without paying *couture* prices. National lawmakers wrestle with balancing the competing policies of promoting innovation and creativity and the democratization of fashion. Finally, international policymakers seek to negotiate policies that will protect their creators when they sell their designs abroad as well as ensure that their nationals are able to enjoy the designs of creators from other countries.

B. Laying the Foundations of Fashion Intellectual Property Laws

1. Europe

As mentioned, advances in technology in the textile industry and the ubiquity of ready-to-wear fashion made copying an increasingly burdensome issue. Unsurprisingly, the fashion leader of the world was also the leader in fashion design protection. Formal legal protection for designs in France date back as early as 1711 to a law that prohibited workers in the silk trade from copying designs that had been given to them in confidence for the sole purpose of manufacture.³⁰ The French Revolution, however, overturned this and other laws establishing protection for silk designers until the Decree of the National Convention in 1793, which confirmed the existence of property rights for literary and artistic works.³¹ Although the language of the Decree was broad enough to cover fabric designs, it was unclear whether it did, highlighting the need for more specific legislation.³² In 1806, a new law was established that protected designs that were first deposited with the *Conseil de Prud'hommes*.³³ To deposit a design with the *Conseil*, the

³⁰ THE OXFORD HANDBOOK OF INTELLECTUAL PROPERTY LAW 188 (Rochelle C. Dreyfuss & Justine Pila eds., 2018).

³¹ *Id.*

³² *See id.*

³³ Translated as “Industrial Tribunal Board.”

manufacturer had to submit a signed and sealed sample.³⁴ If a dispute arose between manufacturers, the *Conseil* would open each sample packet and determine which manufacturer had priority.³⁵ The French courts applied the 1806 law to fashion designs until 1860 when they decided that the law did not apply because clothing was neither a work of art nor an invention.³⁶ Consequently, designers avoided seeking and enforcing protections through the courts until the early 1900's when an amendment to the law expanded the scope to include designers of ornaments, or apparel.³⁷ Important legal issues lacking much clarity during these early stages of formal protection in France were whether clothing designs constituted artistic or industrial designs and the appropriate standard of novelty required for protecting such designs.³⁸

2. United States

American lawmakers have been much more reluctant to offer protection for fashion designs. Although New York has now come to be recognized among the fashion world for its original designs, the U.S. has historically been known for heavily copying Parisian and other European designs.³⁹ Accordingly, protecting the designs of fashion designers has not historically been of high importance in the United States. Designers began to seek protection in America, however, as American designers grew into proliferation and as foreign designers began to expand to the American market.

Finding no *sui generis* protection for fashion designs and very little refuge in the American intellectual property regime, fashion designers and manufactures took matters into their own hands by establishing guilds and promulgating rules to govern themselves and to combat design piracy. The main purposes of such guilds were to protect the originators of fashion and styles against copying and to promote the sale, identification and recognition of original style.⁴⁰ That is, until the United States Supreme Court greatly limited fashion guilds' ability to make and enforce stringent rules. In *Fashion Originators' Guild of America, Inc. v.*

³⁴ THE OXFORD HANDBOOK OF INTELLECTUAL PROPERTY LAW, *supra* note 31, at 189.

³⁵ *Id.*

³⁶ Shirwaiker, *supra* note 18, at 115.

³⁷ *Id.*

³⁸ THE OXFORD HANDBOOK OF INTELLECTUAL PROPERTY LAW, *supra* note 31, at 189.

³⁹ Shirwaiker, *supra* note 18, at 115.

⁴⁰ *See Wm. Filene's Sons Co. v. Fashion Originators' Guild, Inc.*, 14 F. Supp. 353, 354 (D. Mass. 1936) (quoting the Fashion Originators' Guild's certificate of incorporation), *aff'd*, 90 F.2d 556 (1st Cir. 1937).

Federal Trade Commission, the Supreme Court held that the Fashion Originators' Guild's (FOGA) policies violated the Sherman and Clayton Acts governing antitrust.⁴¹ The FOGA policy at issue in this case prohibited members from selling textiles to buyers who sold copied designs. FOGA argued that the systematic copying of designs was tortious, a point the Court refused to confirm or deny.⁴² Instead, the Court stated that even if design piracy constituted a tort, FOGA's rule impermissibly restricted interstate commerce, given the guild's control of the market.⁴³ As the Court noted, members of the guild were responsible for producing sixty percent of all dresses made in the United States that sold wholesale at and above \$10.75.⁴⁴ This case was distinguished from an earlier Court of Appeals decision, *Wm. Filene's Sons Co. v. Fashion Originators' Guild*, wherein Judges Brewster and Wilson of the United States District Court for the District of Massachusetts and the First Circuit, respectfully, laid out the harms of fashion piracy—specifically as had been amplified by the rise of ready-to-wear fashion—and decided in favor of the guild.⁴⁵ Judge Brewster acknowledged that although most copyists violated no legal rights of original creators, piracy posed a significant harm to the manufacturers of original designs, and he referred to copyists' methods of undercutting original creators as “reprehensible.” In this case, the agreement was enforced and the guild prevailed in the action brought against it by a retailer that had breached the guild's agreement not to buy and sell pirated styles.⁴⁶ Here, the guild prevailed because, although the guild controlled a large portion of the New York market for women's dresses, it controlled only about six percent of the United States market for women's dresses, thus there was a reasonable market for the retailer outside of the guild.⁴⁷

III. Current Global Protection of Fashion Intellectual Property

Protection for fashion designs is one of the only areas where the U.S prefers low intellectual property protection. This is unsurprising, however, considering our history of not contributing much in terms of original designs but being known for copying European designs. It is surprising, however, considering the U.S. Constitution's inclusion of Congress's right to

⁴¹ *Fashion Originator's Guild of America, Inc. v. Federal Trade Commission*, 312 U.S. 457, 468 (1941).

⁴² *Id.*

⁴³ *See id.*

⁴⁴ *Id.* at 462; FURI-PERRY, *supra* note 29, at 8.

⁴⁵ *See Wm. Filene's Sons*, 90 F.2d at 558; FURI-PERRY, *supra* note 29, at 8.

⁴⁶ FURI-PERRY, *supra* note 29, at 8.

⁴⁷ *Wm. Filene's Sons Co.*, 90 F. 2d at 559; *Wm. Filene's Sons Co.*, 14 F. Supp. at 353.

encourage innovation.⁴⁸ Perhaps telling is the U.S.’s denial to include Article *6bis* of the Berne Convention in its Copyright Act, which offers moral rights to creators. Moral rights protect creators’ integrity in their works and give them a cause of action against any act that would be prejudicial to the creator’s reputation. Thus, it can be said that the U.S. does not regard creators’ pride or honor in their works to the same extent as does Europe and other adopters of *6bis*. This section will compare the available protection for fashion designs in the U.S., European Union, India and China.

A. United States

U.S. law has not become much, if any, more expansive for those seeking protection for fashion designs. This section will describe the barriers that fashion designers face in each area of intellectual property law. As will be discussed, no existing form of intellectual property protection is suitable for fashion designs. Still, attempts for *sui generis* protection have continuously failed despite there being *sui generis* protection for objects such as architectural designs, semiconductor chips, and vessel hull designs.⁴⁹ This is not for lack of effort, however, Congress has considered as many as seventy bills since 1914 that attempted to provide special protection for fashion designs.⁵⁰

1. Legislative Attempts

a. Design Piracy Prohibition Act

The Design Piracy Prohibition Act (DPPA) was first introduced in the U.S. House of Representatives in 2006.⁵¹ It was a bill to amend the Vessel Hull Design Protection Act (VHDPA), referred to earlier, to add protection for fashion designs. The Bill would have granted copyright protection to fashion designs, defined as the appearance as a whole of an article of apparel, including its ornamentation, for a term of three years.⁵² “Apparel” is defined as an article of clothing, various types of bags, belts, and eyeglass frames.⁵³ To receive protection,

⁴⁸ See U.S. CONST. art. I, § 8, cl. 8.

⁴⁹ Elizabeth F. Johnson, *Defining Fashion: Interpreting the Scope of the Design Piracy Prohibition Act*, 73 BROOKLYN L. REV. 729, 729 (2008)

⁵⁰ 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, 148 (2010)

⁵¹ *Id.*

⁵² Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007).

⁵³ *Id.*

designs would need to be registered within three months of being made available to the public.⁵⁴ Action could be brought against those who “make, have made, import, sell or distribute” any article that embodies a substantially similar copy of an original fashion design and was made with knowledge or reasonable grounds to believe that a design was protected.⁵⁵ The doctrines of secondary infringement and secondary liability would have also been grounds for action, and infringers could be liable for the greater of \$250,000 or \$5 per copy.⁵⁶ Further, any possible claims of infringement of other intellectual property rights would not be precluded.⁵⁷

In introducing the Bill, Representative Bob Goodlatte noted that the United States was one of the only industrialized nations to not offer protection for fashion designs.⁵⁸ As further motivation for passing the Bill, supporters made Congress aware of the estimated \$12 billion, 5% of the industry’s market, that was lost in revenues due to apparel design piracy the year the Bill was introduced.⁵⁹

The DPPA did not become law. One critique of the Bill was that it was not specific enough.⁶⁰ In the Bill, infringement would only be found for “substantially similar” designs. Some critics argued that this would lead to unpredictable court decisions since the term could be defined either too widely or too narrowly. These critics argue that “virtually identical” would have been a better standard.⁶¹ My response to this critique is that this could be said of most laws in a common law jurisdiction, and courts are equipped to create workable standards out of broadly written statutes. Indeed “substantially similar” is generally the standard for determining when literary and artistic works are infringing.⁶² “Virtually identical” would likely be too great a burden for creators to overcome, especially given that fashion designs are usually inspired by earlier works. Additionally, “virtually identical” would give copyists an easy escape route out of liability by making small, insignificant changes to a design.⁶³ Another critique of the Bill could be that a “substantially similar” standard could make designers vulnerable to liability for

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ 152 Cong. Rec. E472-02 (daily ed. Mar. 30, 2006) (statement of Rep. Goodlatte).

⁵⁹ Beltrametti, *supra* note 50, at 157.

⁶⁰ *See id.* at 165.

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.* at 166.

capitalizing on fashion trends. However, courts could quickly and deftly dispose of this concern by analogizing the issue to the copyright regime's idea expression dichotomy. Here, a trend could be analogized to an idea, which is not protectable.

A bigger issue for this proposed legislation, however, was that the fashion industry itself was not in agreement about the Bill.⁶⁴ Because the fashion industry is less concentrated than other areas of intellectual property law, evidenced by the many stakeholders mentioned earlier, there was an obvious disagreement between retailers of copied designs and *couture* designers. Retailers argued against the Bill, stating that it would result in an increase of frivolous and expensive lawsuits.⁶⁵ Contrarily, *couture* designers supported the Bill, arguing that they had suffered reputational harm because of the poor quality of pirated designs, in addition to lost revenue.⁶⁶

b. Innovative Design Protection and Piracy Prevention Act

A later attempt, introduced in 2010, also failed. Like the DPPA, the Innovative Design Protection and Piracy Prevention Act (IDPPPA) also proposed adding protection for fashion designs by amending the VHDPA. This time, the negative effects of piracy on innovation and the resultant lost jobs were highlighted when Senator Charles Schumer introduced the Bill to Congress.⁶⁷ The IDPPPA was intended to be narrower in scope than the DPPA and received the support of field academics as well as the Chamber of Commerce, which urged the House to pass the Bill "as expeditiously as possible."⁶⁸ Its definition of a fashion design was virtually the same as the DPPA's definition, "the appearance as a whole of an article of apparel, including its ornamentation," and including original elements or the original arrangement or placement of original or non-original elements."⁶⁹ The IDPPPA's definition of apparel was the same as in the DPPA.

This Bill would have protected articles that were the result of the designer's own creative endeavor and provided a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles for a term of three years, beginning after the design was

⁶⁴ *See id.* at 157.

⁶⁵ *Id.*

⁶⁶ *Id.*

⁶⁷ Courtney Daniels, *Made In America: Is The IDPPPA The Answer To The United States Fashion Industry's Quest For Design Protection?*, 20 U. MIAMI BUS. L. REV. 113, 136 (2011).

⁶⁸ *See id.* at 137.

⁶⁹ *Id.* at 138; H.R. 2033

made public.⁷⁰ Any article that was copied from a protected design and was “substantially identical” to the original would be infringing unless it was the result of independent creation or was created in a single copy for personal use.⁷¹ Unlike the DPPA, the IDPPPA had no registration requirement and required only that the public be notified that a design was protected with some variation of a “protected design” label.⁷² Without such label, creators could not bring an action for infringement.⁷³ This was a strength of the Bill, eliminating the waiting period and the temptation for the U.S. Copyright Office to judge the merit of a particular design. Additionally, the Bill required that infringement actions be plead with particularity, a requirement that only a few federal statutes are subject to.⁷⁴

Critiques of the Bill included that the “substantially identical” standard would be confusing to courts, which were not equipped to determine whether an article was infringing.⁷⁵ I would argue, however, that courts would meet this issue in the same way as it has met issues in other particularized areas of both intellectual property law and other areas of law, using expert testimony and trusting juries to reach the right result. “Substantially identical” requires more similarity than “substantially similar” and legislative history would show Congress’s intent for it to require less similarity than the DPPA’s “virtually identical” standard. The more considerable issue caused by the “substantially identical” standard, in my opinion, was that it may still be too great a burden for creators to overcome, again allowing copyists to skirt liability by making insignificant changes. This would render the law ineffective and leave fashion designers without adequate protection against piracy. This fear is less so than with the DPPA’s “virtually identical” standard, however. Here, we could trust that courts would recognize and rule according to the Bill’s purpose of increasing protection while still encouraging competition and creativity.

Another shortcoming of the Bill was its requirement that protectable designs be distinguishable and add non-trivial and non-utilitarian variation over prior designs for similar types of articles. This requirement is similar to the patent regime’s novelty and nonobvious

⁷⁰ Daniels, *supra* note 67, at 136, 138.

⁷¹ *Id.* at 143.

⁷² *Id.* at 140

⁷³ *Id.*

⁷⁴ *Id.* at 142.

⁷⁵ *Id.* at 143.

requirements, which, as will be discussed later, make the patent regime inadequate for protecting fashion designs.

The Innovative Design Protection Act (IDPA) of 2012 was similar, adding a written notice requirement from creators to accused infringers and other procedural requirements.⁷⁶ It too was unsuccessful.

The primary concern for the makers of these legislative efforts was finding the appropriate amount of protection for fashion designs that would not give any creator a monopoly on trends. Trends are important to the fashion realm, which relies heavily on appeal to consumers who drive trends. Thus, it is important that fashion designers are able to expand on and capitalize on trends. Additionally, none of these bills were to be applied retrospectively, which emphasizes U.S. lawmakers' disinclination to protect too much of the public domain.

2. Trademarks

Trademarks protect brand names and other identifiers that alert consumers to the source of a certain good or service. Thus, the scope of protection trademark law offers to fashion designs is thin. Nonetheless, it is likely the most used method of protection by fashion creators. Modern courts have shown a willingness to deem a variety of symbols capable of indicating source. In the recent and famous case of *Christian Louboutin v. Yves St. Laurent*, the United States Court of Appeals for the Second Circuit decided in favor of Christian Louboutin and held that his famous red sole had acquired secondary meaning, thus was worthy of trademark protection.⁷⁷ In so holding, the court disagreed with Yves St. Laurent (YSL) and the lower court that the red sole was not apt for trademark protection because it was aesthetically functional.⁷⁸ This aesthetic functionality doctrine adds an extra level of difficulty for those who seeking trademark protection in the fashion realm. According to the Supreme Court, a mark is functional if granting its exclusive use would put competitors at a significant non-reputation-related disadvantage.⁷⁹ The Second Circuit overturned the lower court's holding that color was *per se* functional among fashion cases, holding instead that a mark is aesthetically functional if it is

⁷⁶ Innovative Design Protection Act, S. 3523, 112th Cong. (2012).

⁷⁷ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 228 (2d Cir. 2012)

⁷⁸ *Id.* at 214.

⁷⁹ *Id.* at 220.

necessary to compete in the relevant market.⁸⁰ The court further stated that because of the difficulty of separating the source indicator from the aesthetic function of apparel, the inquiry is necessarily highly fact specific.⁸¹ Here, the Second Circuit decided that Louboutin's red sole had only acquired distinctiveness when it contrasted with the rest of the shoe⁸². The YSL shoe at issue, however, was monochromatic, thus not infringing.⁸³ The court therefore did not reach the issue of whether the red sole was aesthetically functional, leaving unclear the aesthetic functionality inquiry as it relates to fashion designs.⁸⁴

Trademark law only protects a mark that indicates source, offering no protection for the actual substance of the article. Under this regime, an infringer can copy an entire article without consequence as long as he switches the label to his own. On the other hand, trademark protection is potentially infinite, as long as right holders maintain registration requirements. This makes its protection desirable. Fashion designers have become creative with creating ways to make their designs appropriate for trademark protection, such as covering their designs with their logo and separately registering small parts of their logos. An example of this is Louis Vuitton holding separate trademark registrations for its LV mark and each of its three flower symbols.

3. Copyright

Copyright law offers protection to original works of art, but protection is not granted to works that serve a utilitarian purpose unless the items utility can be separated from its artistic elements.⁸⁵ Therefore, functionality is a barrier to copyright protection for fashion designs. Through copyright, creators are able to protect their sketches, patterns, and other two-dimensional aspects, such as ornamental elements and appliques, that are separable from the shape of an article.⁸⁶ Although clothes serve the obvious functions of providing warmth, protecting one from the elements, and modesty, modern day apparel is much more of an expression of art.⁸⁷ It remains difficult, however, to separate the functionality of a piece from the artistic elements. A recent decision from the United States Supreme Court discussed this issue

⁸⁰ *Id.* at 221, 224.

⁸¹ *Id.* at 222.

⁸² *Id.* at 227.

⁸³ *Id.*

⁸⁴ *Id.* at 228.

⁸⁵ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017)

⁸⁶ *See e.g. Eve of Milady v. Impression Bridal*, 957 F. Supp. 484, 489 (S.D.N.Y. 1997)

⁸⁷ *See Shirwaiker, supra* note 18, at 117.

and offered hope to those seeking copyright protection of their garments. In *Star Athletica v. Varsity Brands*, the complainants had several registrations for the two-dimensional designs of their cheerleading uniforms, which a rival uniform company copied. The court held that useful articles are eligible for copyright protection if the feature can be perceived as a two- or three-dimensional work of art separate from the useful article and would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article.⁸⁸ The Court held that the uniforms satisfied this requirement since the designs could be imagined on a canvas, noting that protection was extended only to the designs on the surface of the uniforms and that no protection extended to the shape or cuts of the uniforms.⁸⁹

Copyright law is unsuitable for protecting fashion designs because of the utilitarian function hurdle, which bars the protection of the shape and contour of an article. Additionally, the term of copyright protection is arguably far too generous for the purposes of fashion designs since fashion is fleeting, and its popularity usually only lasts for a season.

4. Other strategies for finding protection

Fashion creators also seek protection through design patents and trade dress, albeit largely unsuccessfully. A design patent is not a viable option for protecting fashion designs because of the high originality standards and because of the time and expenses needed to seek patent protection. As mentioned, fashion designs build significantly on previous designs. Further, fashion designers do not know which designs will be successful until they hit the market. Thus, creators have no way of know which designs will be worth the expense of seeking a patent. Further, trade dress is not a viable option because its ability to protect the design of apparel has been foreclosed by U.S. courts.⁹⁰

The cases mentioned in the subsections above illustrate the acrobatics that creators are required to perform to fit their issues into one of the available areas of intellectual property protection in the United States. Most times their issues do not fit these regimes, and creators in the fashion realm are thus left without any adequate protection. As mentioned, this void has prompted creators to become increasingly clever with their registrations but this protection is still

⁸⁸ *Star Athletica*, 137 S. Ct. at 1015.

⁸⁹ *Id.* at 1016.

⁹⁰ See e.g. *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 216 (2000)

deficient.⁹¹ Indeed a design's shape or cut could become an indicator of origin, yet it is left unprotected under current U.S. laws.⁹²

B. European Union

Fashion creators can find much more straightforward and encompassing protection in the European Union than in the United States. Since the passage of the European Community Design Protection Regulation in 2002, the EU has had a unified design protection system. Unlike the U.S. attempts to modify its copyright regime, this system of protection is *sui generis*, thus does not interfere with the constraints of previously established intellectual property rights.⁹³ The Regulation establishes two routes for protection: an automatic unregistered community design (UCD) and a registered community design (RCD).⁹⁴ Both the UCD and RCD grant to the creator the exclusive right to use their designs in commerce, take legal actions against infringers, and claim damages.⁹⁵ This protection is available uniformly across all EU member states.⁹⁶

The requirements for both UCD and RCD protection require that designs be “novel” and have an “individual character.”⁹⁷ To be novel, the design must have a new impression upon the consumer.⁹⁸ The RCD grants five years of protection with the option to apply for four more extensions of five years each.⁹⁹ The UCD grants three years of protection to designs that are made available to the public, starting from when the design was disclosed.¹⁰⁰ This is similar to the American trademark requirement that marks be in use, however, UCD disclosure need not be use in commerce. Displays in trade exhibitions and various media outlets also qualify.¹⁰¹

In determining infringement, designs that were independently created are not infringing. Further, in determining whether a UCD right exists, courts look to the overall impression on the

⁹¹ TFL, *A New Louis Vuitton Lawsuit Shows its Strategic Approach to Brand Protection*, The Fashion Law (Nov. 12, 2018), <http://www.thefashionlaw.com/home/a-new-louis-vuitton-lawsuit-shows-its-strategic-approach-to-brand-protection>

⁹² Jennifer Darcy, *Under-regulated or Under-enforced: Intellectual Property, the Fashion Industry and Fake Goods*, 35 EUR. INTELL. PROP. REV. 82, 88 (2013)

⁹³ See Beltrametti, *supra* note 50, at 168.

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.* at 170.

⁹⁸ *Id.*

⁹⁹ *Id.* at 169.

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

“informed user,” who is someone who has a good knowledge of designs of the relevant article previously available in the market.¹⁰²

C. Asia

India also has systems in place to offer intellectual property protection to fashion creators. The Fashion Foundation of India (FFI) works to protect the intellectual property rights of designers against piracy and copying. Only design houses may apply for membership to the FFI, and a jury of individuals who are “directly linked to fashion” review the applications.¹⁰³ India’s intellectual property regime also offers protection to fashion creators. As in America, two-dimensional designs are protected under India’s Copyright Act. India’s Design Act, however, protects the non-functional aspects of a design that have visual appeal such as its shape, pattern, ornamental elements, and patterns.¹⁰⁴

Perhaps unsurprisingly, protection for fashion designs has historically been rather weak in China, a nation known for high rates of piracy and counterfeiting. As of the late 1990’s, however, China has sought to become a fashion capital of the world. In its efforts, China boasts a unique strength of having the machinery and skill to make high fashion apparel because of its history of making Western fashion pieces that were outsourced there. Historically, the manufacturing of cheap, fast fashion goods were outsourced to China. However, those tasks are now sent to places where it is cheaper such as Thailand, India, and Cambodia, leaving China with the manufacturing of more high market goods.¹⁰⁵ Becoming a major fashion player in unique fashion designs is part of China’s “Made in China 2025” initiative, which hopes to make China the world’s technology center.

Fashion designs in China are governed by protection for applied arts. China protects works of applied arts only out of obligation to its Berne Convention membership, and neither its copyright nor patent laws reference applied arts. Because of this, Chinese courts have had difficulty defining the proper scope and terms for protecting applied arts.¹⁰⁶ In *(1999) Beijing No.2 Intermediate Court IP First Instance No. 145* the court defined works of applied art as

¹⁰² Darcy, *supra* note 92, at 90.

¹⁰³ Shirwaiker, *supra* note 18, at 119.

¹⁰⁴ *Id.* at 120.

¹⁰⁵ TFL, *The State of Fashion Design in China*, The Fashion Law (May 2, 2018), <http://www.thefashionlaw.com/home/the-state-of-fashion-design-in-china>

¹⁰⁶ Fiona Gu, *Protection of Works of Applied Art in China*, China Intell. Prop. (May 10, 2012), <http://www.chinaipmagazine.com/en/journal-show.asp?id=805>

“pieces of art with utilitarian functions.” The judge went on to say that an important feature of works of applied art is that it is independently both useful and artistic and neither its functionality nor its artistic feature can be separated.¹⁰⁷ Applying this to apparel, the judge used a sliding scale of functionality and aesthetic value and decided that even clothes consisting of a heightened form of expression such as unique cuts, shapes, or ornamentation, have intrinsic utilitarian function and can still be referred to as “clothes.” Thus, even when an article’s aesthetic value overshadows its functionality, such as Lady Gaga’s 2010 meat dress or Mugler Couture’s Fall 1995 oyster gown, it is to be recognized as a work of applied art. China grants foreign works of applied arts protection for 25 years beginning when the work is complete.¹⁰⁸

Similar to the United States’ history of fashion law and fashion design, China was once known for piracy and is now exploring the realm of fashion from the perspective of the creators of fashion designs. As such, it is yet to be seen how Chinese lawmakers will grapple with protecting their designers’ works. What is known is that over the past decade, China has been moving towards more intellectual property protection. It can be assumed that laws protecting fashion designs will be strengthened as well.

IV. The Piracy and Counterfeiting Issue

Despite there being little protection for pirated fashion designs in the United States, the nation has long treated counterfeiting as a serious offense. The Counterfeiting Act of 1984 imposes serious penalties on counterfeiting, an illegal economy accounting for over five percent of world trade.¹⁰⁹ Counterfeiting involves legitimate trademarks being used to label non-original merchandise. As discussed, piracy involves the exact copying of original merchandise. Essentially, one who makes an exact copy of an item is subject to the penalties set forth in the Counterfeiting Act if he then attaches a fraudulent label to the non-legitimate copy but faces no penalty for the exact copy without the fraudulent label. As has been argued by various academics, piracy is only slightly less an evil than counterfeiting. Indeed, a counterfeit item must

¹⁰⁷ Beijing No.2 Intermediate Ct. IP First Instance No. 145 (1999) (China)

¹⁰⁸ Reg. for the Implementation of Int’l Copy. Treaties, Art. 6 (1992) (China)

¹⁰⁹ FURI-PERRY, *supra* note 29, at 68.

be copied exactly—pirated—before the label is added, making it illegal. Therefore it is logical to treat both offenses similarly.¹¹⁰

A. Counterfeiting

Trademark laws are in place to protect consumers, allowing them to choose brands they trust. Counterfeit goods that fraudulently use one's trademark, especially on goods such as pharmaceuticals and automobile parts, pose high risks of harm to consumers. The consequences could be deadly. Counterfeit laws, however, encompass much more than these goods that pose serious threats to public safety and treat offenses equally for all goods, including apparel. Penalties include criminal action, civil seizure, and statutory damages.¹¹¹ This could be interpreted as an indication that lawmakers are not only concerned about the harms done to consumers but the harms done to the creators of the original goods as well. Indeed, the illegal counterfeiting economy is at least a \$250 billion business and is responsible for the loss of over 750,000 lost jobs.¹¹² Both piracy and counterfeiting involve imitating goods, which prevent creators from reaping the full benefits of their labor. This is exactly what intellectual property rights exist to prevent as well as preventing others from improperly benefitting from the creations of others. Therefore, it cannot be justified that creators in the fashion realm are left vulnerable to such acts. As Professor Scafidi remarked while speaking to Congress about the DPPA, “copies of a garment rather than its label remain beyond the reach of American law.”¹¹³

Additionally, recognizing that the illegal economy of counterfeiting is a global endeavor, many international treaties provide for systems to prevent the export and import of counterfeit goods.¹¹⁴ The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) Section 4, Article 51 requires that member states have systems in place to allow right holders to request that customs authorities suspend the release of goods believed to be infringing.¹¹⁵ Additionally, TRIPS states that counterfeit goods are not remedied by removal of the fraudulent

¹¹⁰ 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, 149 (2010)

¹¹¹ *Id.* at 150

¹¹² *Id.*

¹¹³ Monet, *supra* note 24.

¹¹⁴ *See e.g.* Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement].

¹¹⁵ *See* TRIPS Agreement Art. 51.

trademark.¹¹⁶ Removing the fraudulent trademark would make the good no longer counterfeit, but the good would still be a pirated copy, which would be legal under United States law.

B. Piracy and Fast Fashion

Another threatening industry to fashion designers is fast fashion. Fast fashion businesses quickly copy the designs of couture fashion houses and make the imitations widely available for a fraction of the cost at retailers such as Forever 21, Zara, and H&M as well as the private labels of department stores. Due to technological advances, these low-cost imitations are being produced increasingly quicker, often hitting the market many months before the originals.¹¹⁷ Copies hitting the market before the original is an issue because it usurps the original in the market, but it is also an issue because the appeal in the eyes of the consumer diminishes the more widely available a design is.¹¹⁸ Similar to the illegal economy of counterfeiting, these fashion pirates send the designs they wish to duplicate overseas to be copied. Samples of the knock-off item can be sent to retailers as quickly as two weeks.¹¹⁹ The knock-offs can be listed for sale online even quicker. Unlike counterfeiting, however, this business model is completely legal.

Proponents for this type of design piracy maintain that consumers should not be excluded from wearing popular styles and participating in trends solely because they cannot afford the couture brand.¹²⁰ The counterargument, however, is that allowing this type of piracy prevents fashion houses from being able to offer a more affordable line of their designs and license them to retailers that reach larger groups of consumers.¹²¹ Examples of this include the 2011 collaboration of Versace for H&M, and the November 2018 launch of Moschino by H&M.

Proponents of fast fashion piracy also argue that these low-cost imitations are of such bad quality that they do not substitute for the originals in the market. It is important to recall, however, that the quality of these pirated goods varies greatly. As mentioned, some of these

¹¹⁶ TRIPS Agreement Art. 46.

¹¹⁷ Beltrametti, *supra* note 110, at 226.

¹¹⁸ “From the moment the clientele sees a dress everywhere, they lose interest” (Francine Summa, lawyer for Yves Saint Laurent during dispute against Ralph Lauren)

¹¹⁹ Katherine B. Felice, *Fashioning A Solution for Design Piracy: Considering Intellectual Property Law in the Global Context of Fast Fashion*, 39 SYRACUSE J. INT’L. L. & COM. 219, 226 (2011).

¹²⁰ *Id.*

¹²¹ *Id.* at 227.

items are made for the private labels of department stores.¹²² Take for example a dress made for Bloomingdale's that was identical to a Tory Burch dress that retailed for \$750. The Bloomingdale's version retailed for \$260, which is much higher than what most Americans can afford to spend on a dress.¹²³ Assumedly, this knock off was of sufficient quality to substitute for the Tory Burch dress in the market.

CONCLUDING THOUGHTS

Nations have many interests to balance when setting forth intellectual property laws relating to fashion designs. Barriers to expansive protection in the United States include disagreements such as whether American law should encourage and reward innovators or promote social equality.¹²⁴ This requisite balance is not unique to the fashion realm, however. Admittedly, one difference may be that whereas granting creators of literary or artistic works the right to exclude others from copying too much of their work stifles other creators, it does not affect the consumers' access to the work. Contrarily, prohibiting others from recreating certain styles for prices that would make them much more available to the public does impact consumers. This cost to consumers seems to be a primary concern for those who oppose more expansive protection for creators of fashion. This consequence of protection is not foreign to consumers, however. Consumers bare these costs in the patent regime for a much longer term than would be necessary in the realm of fashion. Additionally, patents can exclude consumers from goods that are much more necessary than the latest styles, such as pharmaceuticals.

Some argue that minimal protection actually promotes innovation because creators are forced to continuously create new designs to stay ahead of copiers.¹²⁵ This argument fails to consider that creators will not continue to create if they will not be able to appreciate the return on their investments. The argument also ignores the fact that emerging designers cannot afford to enter a market where they cannot capitalize on their investments. Even amongst individuals in the fashion world there is disagreement about the proper regime for facilitating intellectual property protection, an issue of collective action. This issue must be overcome, however, as it is imperative that artists of all kinds enjoy protection of their creative works, despite the fact that their chosen medium is apparel. The U.S. has a while to go to reach this goal and to align its

¹²² *Id.* at 226.

¹²³ *See id.*

¹²⁴ FURI-PERRY, *supra* note 29, at 16.

policies of protecting fashion designs with other fashion capitals of the world, lest it risks missing out on the talent of creators who cannot afford to or do not wish to release their designs into a market that offers them little protection. Indeed, as mentioned, the U.S. Constitution recognizes the importance of promoting innovation and creativity.¹²⁶ Part of promoting creating and innovation includes encouraging new creators to enter the market.

¹²⁶ See U.S. CONST. art. I, § 8, cl. 8.