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COUTURE COPYRIGHT: COPYRIGHT PROTECTION FITTING FOR FASHION  
DESIGN

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## ABSTRACT

The fashion industry does not need special, protective legislation. Laws are already in place that can serve to aid in the protection of fashion design. Legislation has extended copyright protection to architectural plans and their associated structures. This extension was based on rationale that is applicable, without revision, to fashion design. The practice of denying protection to fashion design is unsupported by law. In fact, courts already have the means to grant protection to fashion design. First, the court can grant protection through analogy to architectural works. Second, the court can clarify the separability test for utilitarian designs—a test which often disqualifies fashion designs from protection—choosing one test instead of the patchwork of tests that is now in existence.

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# COUTURE COPYRIGHT: COPYRIGHT PROTECTION FITTING FOR FASHION DESIGN

ALEKSANDRA M. SPEVACEK\*

## INTRODUCTION

“[F]ashion is born by small facts, trends, or even politics, never by trying to make little pleats and furbelows, by trinkets, by clothes easy to copy, or by the shortening or lengthening of a skirt.”<sup>1</sup>

As of 2006, the apparel industry employed roughly 893,000 workers in the United States.<sup>2</sup> That number has been declining, however, and the trend is expected to continue.<sup>3</sup> Much of the job loss can be traced to the influx of illegal competition in the fashion industry, which comes in the form of knock offs and pirated designs.<sup>4</sup> The United States Customs and Border Protection estimate that roughly 750,000 American jobs have been lost due to counterfeit merchandise.<sup>5</sup> In 2007, of the nearly \$200 million worth of counterfeit goods that were seized in the United States, apparel accounted for \$27 million, an 11% increase from the previous year.<sup>6</sup> These alarming numbers are on the rise despite the fact that the United States has laws to protect consumers and designers from counterfeit goods.<sup>7</sup>

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<sup>1</sup> ELSA SCHIAPARELLI, *SHOCKING LIFE* 113 (E.P. Dutton & Co., Inc. 1954). “All the laws about protection from copyists are vain and useless. The moment that people stop copying you, it means that you are no longer any good and that you have ceased to be news.” *Id.* at 67. Along the same line, iconic designer Coco Chanel once said “[t]he very idea of protecting the seasonal arts is childish. One should not bother to protect that which dies the minute it is born.” Susan Scafidi, *Intellectual Property and Fashion Design*, in 1 *INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE* 124 (Peter K. Yu ed., 2007) (quoting EDMONDE CHARLES-ROUX, *CHANEL AND HER WORLD: FRIENDS, FASHION, AND FAME* 377 (Daniel Wheeler trans., 2005)). Interesting, however, is the fact that Ms. Chanel was herself a plaintiff in a prolific 1930s French case against a notorious copyist. *Id.*

<sup>2</sup> U.S. DEPT OF LABOR, U.S. BUREAU OF LABOR STATISTICS, *OCCUPATIONAL OUTLOOK HANDBOOK* 300, 773 (Library ed. 2008).

<sup>3</sup> *Id.* at 300.

<sup>4</sup> See Randy Myers, *Counter Attack*, CFO MAGAZINE, June 2008, at 64; see also *Wm. Filene’s Sons Co. v. Fashion Originators’ Guild of Am., Inc.*, 90 F.2d 556, 557–58 (1st Cir. 1937) (noting that although “style piracy” and “design piracy” are sometimes used interchangeably, “‘style’ as applied to a dress refers to its general characteristics, such as the length of the skirt, the size of the sleeves, the height of the waist, etc., while ‘design’ as applied to a dress includes all the details involved in its makeup.”).

<sup>5</sup> Myers, *supra* note 4.

<sup>6</sup> *Id.* United States figures included, it is estimated that 7% of all goods sold globally are knock offs. *Id.* The value of those illegal goods is roughly \$ 600 billion. *Id.*

<sup>7</sup> See, e.g., 15 U.S.C. § 1125 (2006) (forbidding false designations of origin, false descriptions, and dilution of trademarks).

Unlike the counterfeiting of goods, design piracy is not prohibited by any United States law.<sup>8</sup> In the fashion industry profit is generated by the introduction of new products in the form of apparel design.<sup>9</sup> These profit-creating apparel designs,<sup>10</sup> however, can be pirated and made available earlier and cheaper, and no United States laws exist that give designers adequate recourse.<sup>11</sup>

This comment explores what non-legislative means are available for providing greater protection to fashion designs. Part I explains the fashion design process and the economic cycle on which it depends. Part I also explores the current state of design protection under trademark, patent, and copyright law, and recent unsuccessful legislative attempts to include fashion design in the Copyright Act. Part II compares architectural drawings to garment patterns and discusses how the rationale behind the Architectural Works Protection Act could apply to garment designs and their derivatives. Part III proposes that courts protect garment design by either 1) applying the rationale of previous decisions in architectural works cases to fashion designs, or 2) consolidating the countless useful article tests into one cognizable test and explicitly defining the use of clothing to ensure fair and consistent adjudication of protectability for fashion design.

## I. BACKGROUND

Piracy is not an issue exclusive to fashion design; its *continued prevalence*, without governmental sanctions, however, is novel to the industry. Susan Scafidi, a leading scholar in copyright and fashion design protection,<sup>12</sup> highlighted the unusual status of piracy in the fashion industry this way:

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<sup>8</sup> Samantha L. Hetherington, *Fashion Runways Are No Longer the Public Domain: Applying the Common Law Right of Publicity to Haute Couture Fashion Design*, 24 HASTINGS COMM. & ENT. L.J. 43, 44 (2001).

<sup>9</sup> Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1689 (2006).

<sup>10</sup> See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[H][1], at 2-143 to 2-144 (2009) (noting the difference between the terms “fabric design” and “dress design,” and defines “dress design” as “the design that graphically sets forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment.”). This comment adopts Nimmer’s definition of “dress design” and refers to it as garment design.

<sup>11</sup> See Raustiala & Sprigman, *supra* note 9, at 1699; Posting of Felix Salmon, *Susan Scafidi on Copyrighting Fashion*, to Portfolio.com, <http://www.portfolio.com/views/blogs/market-movers/2007/09/19/susan-scafidi-on-copyrighting-fashion> (Sep. 19, 2007, 12:00am EDT). Salmon, who vocalized his opposition to extending copyright protection to fashion design ceded this point, saying, “if a big retailer like Forever 21 wants to . . . copy . . . a young designer’s work, it should at least be willing to pay that designer something for her creativity and inspiration. But with the law as it stands, it seems, there’s no incentive for the retailer to do that.” Salmon, *supra*.

<sup>12</sup> See About Susan Scafidi, <http://about.counterfeitichic.com> (last visited Dec. 7, 2009). Susan Scafidi has testified in front of Congress as a proponent of the Design Piracy Prohibition Act. *Id.* Currently, Ms. Scafidi is a visiting professor at Fordham Law School. *Id.* She also taught at Southern Methodist University, Yale University and Georgetown University. *Id.* Ms. Scafidi authored WHO OWNS CULTURE? APPROPRIATION AND AUTHENTICITY IN AMERICAN LAW (2005) and also writes about fashion and intellectual property on her blog Counterfeit Chic. *Id.*

In historical terms, the pattern of industrial development in the United States . . . often commences with a period of initial piracy, during which a new industry takes root by means of copying. This results in the rapid accumulation of both capital and expertise. . . . Ideally, the pirate country begins to develop its own creative sector in the industry, which in turn leads to enactment of intellectual property protection to further promote its growth. This was the pattern followed in the music and publishing industries, in which the United States was once a notorious pirate nation . . . .

In the case of the American fashion industry, however, the usual pattern . . . is not present.<sup>13</sup>

This section first describes the different forms of legal protection currently available to fashion designers. An explanation of the process by which fashion designs are created is first given, as a full understanding of the process is necessary for proper analysis.

#### *A. Fashion Design*

On average, it takes between eighteen and twenty-four months for a designer's original concept to be produced in final form.<sup>14</sup> Before beginning to sketch, the designer first goes through the process of predicting what trends will be popular eighteen to twenty-four months later—when the garment is in final production.<sup>15</sup> This research generally begins with an investigation of color and textile trends.<sup>16</sup>

To predict coming color trends, experts from a variety of design industries hold a meeting, the outcome of which, an annual report, affects apparel, accessories, home furnishings and many other design-oriented product industries.<sup>17</sup> It is from this selection that designers choose a “color story,” between eight and twelve colors, on which they base their future designs.<sup>18</sup> After selecting the color story for the season, the designer can then proceed to review textile trends.<sup>19</sup> Similar to color trends, textile trends are calculated by services that research international fashion, street fashion, and stores in fashion-centric cities.<sup>20</sup>

Textile and color trending is not the only source of a designer's inspiration.<sup>21</sup> Designers study street fashion, trade magazines, and design reports to stimulate

<sup>13</sup> Scafidi, *supra* note 1, at 118 (footnote omitted).

<sup>14</sup> U.S. DEPT OF LABOR, *supra* note 2, at 298.

<sup>15</sup> *Id.*

<sup>16</sup> SHARON LEE TATE, *INSIDE FASHION DESIGN* 58 (Stephen Helba et al. eds., Pearson Education Inc. 5th ed. 2004).

<sup>17</sup> *Id.* at 111. The annual color report is generally supplied to designers by fiber and fabric companies and professional color services. *Id.* at 58. This report selects a variety of colors from a standard color system, the *Pantone® Textile Color System*, which is comprised of 1,701 colors. *Id.* at 115.

<sup>18</sup> *Id.* at 201.

<sup>19</sup> *Id.* at 58.

<sup>20</sup> *Id.* at 99 (referring to “the way young people experiment with existing garments, often recycling period pieces or customizing basics like denim garments and wearing them in new ways.”).

<sup>21</sup> *See id.* ch. 3 (discussing “Sources of Inspiration”).

their design ideas.<sup>22</sup> Visiting museums, studying ethnic costumes, keeping tabs on home furnishing trends, and collecting trims, fabrics, and garments may all be part of a designer's constant inspiration process.<sup>23</sup>

Only after the designer has inspiration and a color story on which to base a collection of designs can he or she begin to sketch the new garment designs.<sup>24</sup> These sketches serve as the "language of construction" in the fashion industry; this is how the designer communicates how the garment should be constructed to those involved in the physical creation of the design.<sup>25</sup> Sketches can take the form of stylized or technical flats.<sup>26</sup> Stylized flat are working sketches that depict a person wearing the design and are used as sales tools.<sup>27</sup> Technical flats, on the other hand, depict the technical qualities of the garments and "are considered the blueprints for sewing and producing articles of clothing."<sup>28</sup> These blueprints must accurately depict the many elements of complex garment designs.<sup>29</sup>

Once the ideas are on paper, the designer will then search for fabrics appropriate for the construction techniques, silhouettes, and trends on which the designer intends his or her designs to be based.<sup>30</sup> Once fabrics are chosen, the designer will then hand-make a sample version of the piece to be tailored to a fit model.<sup>31</sup> This preliminary version will be scrutinized and adjusted as the designer sees fit.<sup>32</sup> Only after all adjustments have been made will an article of clothing be manufactured using the desired construction techniques and fabric.<sup>33</sup>

A designer goes through this same process each time a new line of clothing is created. Generally, a designer creates five lines per year.<sup>34</sup> In addition to the extensive time commitment,<sup>35</sup> designers make a substantial monetary commitment to each line, spending 2 to 4% of the line's sales in funding the design process.<sup>36</sup>

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<sup>22</sup> *Id.* at 99, 104, 111.

<sup>23</sup> *Id.* at 126–127, 129.

<sup>24</sup> U.S. DEP'T OF LABOR, *supra* note 2, at 298.

<sup>25</sup> JAMI ARMSTRONG ET AL., FROM PENCIL TO PEN TOOL: UNDERSTANDING AND CREATING THE DIGITAL FASHION IMAGE 112 (Olga T. Kontzias et al. eds., Fairchild Publications, Inc. 2006).

<sup>26</sup> *Id.*

<sup>27</sup> *See, e.g., id.* at 94 figs.4.14 & 4.15, 112.

<sup>28</sup> *Id.* at 112.

<sup>29</sup> *Id.*

<sup>30</sup> U.S. DEP'T OF LABOR, *supra* note 2, at 298; *see also* TATE, *supra* note 16, at 243 (discussing the "fabrication" process).

<sup>31</sup> *See* U.S. DEP'T OF LABOR, *supra* note 2, at 299.

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*

<sup>34</sup> *Wm. Filene's Sons Co. v. Fashion Originators' Guild of Am., Inc.*, 90 F.2d 556, 558 (1st Cir. 1937) (stating that the apparel industry goes through five seasons: Spring, Summer, Fall, Winter, and Winter Resort).

<sup>35</sup> *See* Hetherington, *supra* note 8, at 43, n.13 (noting that it takes between 100-150 hours for a designer to make the original sample, and roughly 1000 hours of work to manually create an evening gown).

<sup>36</sup> *See* *Knitwaves Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 999 (2d Cir. 1995) (noting that the plaintiff, although a relatively small company, spends well in excess of \$1 million per year in the design and introduction of new products); *Wm. Filene's Sons*, 90 F.2d at 558, (noting that a designer would spend between \$30,000 and \$50,000 to create a single line in 1937); *A Bill to Provide Protection For Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. of the Judiciary*, 109th Cong. 12 (2006) [hereinafter *Hearing on H.R. 5055*] (statement of Jeffrey Banks, Fashion Designer) ("Whether you are an

Wide-spread availability of copies, however, will force an increase in either the percentage or the cost of future garments for both the consumer and the designer.<sup>37</sup>

Once a prototype is perfected, designers show the garments at fashion or trade shows.<sup>38</sup> It is at this point that the public, including copyists, finally has its first look at the new line.<sup>39</sup> From the moment a garment is publicly shown, its design becomes susceptible to less expensive, more quickly produced copies as compared to the original designs.<sup>40</sup> The Internet Age creates even more of a challenge, as pirates using the Internet have the ability to instantly access—and begin to copy—a design as soon as it is publicly shown.<sup>41</sup> These copies force designers to compete with what are essentially their own designs, which are sold for less and are accessible to a wider variety of people.<sup>42</sup>

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accessory designer or a star designer creating men's, women's, children's lines, you spend many thousands of dollars before you see your first order."); Rocky Schmidt, Comment, *Designer Law: Fashioning A Remedy For Design Piracy*, 30 UCLA L. REV. 861, 862 n.18 (1983) (citing Telephone Interview with Marty Staff, Vice-President of Sales, Polo Fashions (Feb. 17, 1983) (on file with The UCLA Law Review)).

<sup>37</sup> See *Wm. Filene's Sons*, 90 F.2d at 558. The *Filene's* court acknowledged that copying "destroys the style value" of the original garment. *Id.* "Women will not buy dresses at a good price at one store if dresses which look about the same are offered for sale at another store at half those prices." *Id.* As a result, there is a substantial reduction in demand, and therefore orders, for the original designer's garment. *Id.* The effect is felt by the original designer, who "cannot afford to buy materials in large quantities as they otherwise would. This tends to increase the cost of their dresses and the price at which they must be sold." *Id.*

<sup>38</sup> U.S. DEPT OF LABOR, *supra* note 2, at 299.

<sup>39</sup> See also TERI AGINS, *THE END OF FASHION: HOW MARKETING CHANGED THE CLOTHING BUSINESS FOREVER* 23–24 (First Quill ed. 2000). The author expounds on the anxiety created by the first public showing of a line and how it was present even in the 1900s. *Id.* In early 20th-century French Couturiers protected the value of their designs by prohibiting the press from circulating photos until after the clothing shown at the fashion shows were released to the public and allowing those in attendance of the shows to take notes only with "stubby gold pencils . . . handed out with the printed programs." *Id.* at 24. The author acknowledges how susceptible these protectionist measures were to leaks. *Id.* Shannon Rodgers, a dress designer working for a number New York dress makers, was quoted as saying, "[r]ight after the shows at Chanel or Christian Dior, I'd run to the nearest sidewalk café and start sketching the collection from memory." *Id.* (quoting Shannon Rodgers). Those sketches would ultimately be made into affordable versions of the couture pieces. *Id.*

<sup>40</sup> See Raustiala & Sprigman, *supra* note 9, at 1705. "Dior, who was one of the first couturiers to offer a mass-produced retail collection, fought a losing battle with the knockoff artists. As early as 1957, Dior wasn't moving fast enough; copies of Dior's hobble skirts were hanging on Macy's racks well before his couture customers got their originals." AGINS, *supra* note 39, at 24. In an attempt to mitigate the damage, Dior used advertising to reach his clientele, begging them to "wait for perfection." *Id.* However, the copying problem, and the havoc it wreaks on the bottom line of designers, isn't a problem of the past. Salmon, *supra* note 11 (quoting Susan Scafidi). Carolyn Bessette-Kennedy wore a wedding gown, designed by Narciso Rodriguez. *Id.* (quoting Susan Scafidi). The dress caught the public's eye, and copyists swung into action. *Id.* (quoting Susan Scafidi). A single copyist sold roughly 80,000 copies of the dress. *Id.* (quoting Susan Scafidi). "[B]y the time Narciso was able to produce the dress, he sold about 45." *Id.* (quoting Susan Scafidi).

<sup>41</sup> See Alain Coblenze, esq., *Design Piracy Prohibition Act: The Proponents' View*, CAL. APPAREL NEWS, August 24–30, 2007, at 12.

<sup>42</sup> See Scafidi, *supra* note 1, at 125.

To understand the damage inflicted by pirated copies of original garments, one must understand the economic fashion cycle.<sup>43</sup> “[I]n modern sociological and economic terms, the cycle begins when high-status individuals or early adopters acquire an item. That item becomes a social signaling device, provoking demand among lower status individuals or outsiders . . . . As more consumers purchase the item, however, it loses its signaling value.”<sup>44</sup> The effect of lower cost, more widely accessible items on the designer’s originals is that the signaling value is much more quickly dissipated.<sup>45</sup> Profits, and in turn a designer’s ability to stay in business, depend on a system that protects consumer demand for the original design.<sup>46</sup>

The fashion cycle is complete when the original individuals or early adaptors “move on to new expensive or rare objects of desire in order to differentiate themselves” from the later adapters.<sup>47</sup> Disruption occurs, however, when designers are unable to recover their monetary investment from the previous design and thus cannot afford to create the next desired object.<sup>48</sup> Instead of completing the fashion cycle, the design’s desirability dies prematurely.<sup>49</sup>

Designers have attempted to thwart the short-circuiting of the fashion cycle by seeking protection for their designs through various forms of intellectual property law, including trademark, patent, and copyright laws.<sup>50</sup>

### B. Trademark Law

Trademark laws are intended to protect marks that are used to identify the origin of products from being used on unrelated goods in a way that would confuse consumers.<sup>51</sup> As such, trademark law does not protect the copying of a garment’s

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<sup>43</sup> See *id.* at 130 n.60 (“Note that the term ‘fashion cycle’ is also used more generally to describe the periodic return of certain style trends, such as short or long hemlines, to the forefront of fashion, as well as the length of time between such stylistic revivals.”).

<sup>44</sup> *Id.* at 125. For example, in 1994, Dior produced its Lady Dior handbag, which sold for \$1,200. AGINS, *supra* note 39, at 48 “French First Lady Bernadette Chirac gave the Princess of Wales a Dior bag in 1995 and she began carrying it everywhere, within full view of the paparazzi. . . . and more than 100,000 Lady Diors flew off the shelves in 1997.” *Id.*

<sup>45</sup> Raustiala & Sprigman, *supra* note 9, at 1719.

<sup>46</sup> SYLVAN GOTSHAL, *THE PIRATES WILL GET YOU: A STORY OF THE FIGHT FOR DESIGN PROTECTION 4* (Alfred Lief ed., Columbia Univ. Press 1945).

<sup>47</sup> Scafidi, *supra* note 1, at 125.

<sup>48</sup> See H. REP. NO. 105-436, at 13 (1998) (stating that the “most important” reason for passing the Vessel Hull Design Protection Act, which granted sui generis protection to boat hulls, was an economic one: “if manufacturers are not permitted to recoup at least some of their research and development costs, they may no longer invest in new, innovative boat designs that boaters eagerly await.”).

<sup>49</sup> Raustiala & Sprigman, *supra* note 9, at 1719–20.

<sup>50</sup> See *Express, LLC v. Fetish Group, Inc.*, 424 F. Supp. 2d 1211, 1224–25, 1228–29 (C.D. Cal. 2006) (holding that, although the utilitarian aspects of a camisole could not be protected, lace and embroidery elements were copyrightable because they were irrelevant to the utilitarian aspects of the camisole); *Rockport Co. v. Deer Stags, Inc.*, 65 F. Supp. 2d 189, 194–197 (S.D.N.Y. 1999) (finding infringement of a design patent for a shoe); *Polo Fashions, Inc. v. Extra Special Prods., Inc.*, 451 F. Supp. 555, 560–563 (S.D.N.Y. 1978) (finding trademark infringement where a famous designer’s logo was used by the defendant in a “confusingly similar” way).

<sup>51</sup> See 15 U.S.C. § 1125(a)(1)(A)–(B) (2006).

design, only the logo under which the clothing is sold.<sup>52</sup> The Lanham Act, which governs trademark law, sets out the elements needed for a court to find infringement.<sup>53</sup> A plaintiff alleging trademark infringement must first prove that its mark—registered or not—merits protection under the Lanham Act.<sup>54</sup> If the plaintiff is able to prove its mark meritorious of protection, plaintiff must then establish that there is a likelihood of confusion.<sup>55</sup> Likelihood of confusion means simply “that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.”<sup>56</sup> The factors weighed to determine if a likelihood of confusion exists are “the strength of the plaintiff’s mark, the degree of similarity between both the marks and the products . . . the competitive proximity of the products, the degree of care likely to be exercised by consumers, the presence of actual confusion and the motive of the alleged infringer in adopting the mark.”<sup>57</sup> Under this test, better-known designers with recognizable logos may be afforded protection<sup>58</sup> while designers who have yet to establish a strong logo are left at a disadvantage.<sup>59</sup>

### C. Design Patent Law

Design Patent law protects “new, original and ornamental design for an article of manufacture.”<sup>60</sup> Design patent protection applies to “the configuration or shape of an article, to the surface ornamentation on an article, or to both.”<sup>61</sup> One could argue that design patents seem, at first blush, to be the most fitting form of protection for fashion design. The courts, however, disagree and have consistently found that

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<sup>52</sup> *Id.*; see Hetherington, *supra* note 8, at 51–55 (discussing trademark law as it relates to the fashion industry).

<sup>53</sup> 15 U.S.C. § 1125(a)(1)(A)–(B).

<sup>54</sup> Beverly Hills Design Studio (N.Y.) Inc. v. Morris, 126 F.R.D. 33, 35 n.1 (S.D.N.Y. 1989) (citing Thompson Med. Co. v. Pfizer Inc., 753 F.2d 208, 212–13 (2d Cir. 1985)).

<sup>55</sup> *Id.* (citing Yarmuth-Dion, Inc. v. D’ion Furs, Inc., 835 F.2d 990, 993 (2d Cir. 1987)).

<sup>56</sup> Mushroom Makers, Inc. v. R.G. Barry Corp., 580 F.2d 44, 47 (2d Cir. 1978) (citing Maternally Yours, Inc. v. Your Maternity Shop, Inc., 234 F.2d 538, 542 (2d Cir. 1956)).

<sup>57</sup> Polo Fashions, Inc. v. Extra Special Prods., Inc., 451 F. Supp. 555, 558 (S.D.N.Y. 1978) (Helene Curtis Indus., Inc. v. Church & Dwight Co., 560 F.2d 1325, 1330 (7th Cir. 1977)).

<sup>58</sup> See, e.g., Louis Vuitton Malletier v. Dooney & Bourke, Inc., 454 F.3d 108, 116 (2d Cir. 2006) (finding the color and design combination in the Louis Vuitton mark, as used on a handbag, protected by trademark because it was “inherently distinctive” and had “acquired secondary meaning.”); *Polo Fashions*, 451 F. Supp. at 558 (listing the strength of the plaintiff’s mark as one of the factors to be considered when determining liability).

<sup>59</sup> See Scafidi, *supra* note 1, at 121 (“Even if a famous designer’s new line is knocked off, consumers may still be willing to pay higher prices for the trademarked version. Emerging designers, by contrast, cannot depend exclusively on brand recognition for protection against design piracy.”). The author went on to quote a young designer who explained the problem as she sees it: “[Famous designers] can just sell their trademarks. We [unknown designers] have to sell our designs.” *Id.* (citing Interview by Susan Scafidi with Gabi Asfour, designer for the label ThreeAsFour (Sept. 27, 2005)).

<sup>60</sup> 35 U.S.C. § 171 (2006).

<sup>61</sup> U.S. PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 1502, ¶ 15.43 (8th ed., 7th rev. 2006).

fashion design does not meet the requirements for patentability: a novel, non-obvious invention.<sup>62</sup>

Satisfying the patent requirements has proven to be a difficult task.<sup>63</sup> A garment design will be considered “obvious” if the design would have been obvious to a person with ordinary skill in the area of garment design at the time the garment design was disclosed.<sup>64</sup> It is nearly impossible for a garment to achieve this standard.<sup>65</sup>

The incompatibility between design patents and garment design does not stop at the technical requirements. The process for obtaining a design patent can take longer than the time during which the garment is popular.<sup>66</sup> It was recently estimated that a design patent takes roughly sixteen months to issue.<sup>67</sup> In an industry that introduces new designs five times per year, the time frame for obtaining patent protection, and the standards that must be met to obtain the protection, are not appropriate.<sup>68</sup>

#### *D. Copyright Law*

The Copyright Act extends protection to “original works of authorship fixed in any tangible medium of expression.”<sup>69</sup> Copyrightability is determined using a two-pronged test: 1) the work must be original to the author, and 2) the work must be at least minimally creative.<sup>70</sup> The threshold level of creativity required is very low, so that even a nominal amount of creativity will be enough.<sup>71</sup>

To satisfy the fixation requirement, a work must be “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated.”<sup>72</sup>

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<sup>62</sup> 35 U.S.C. §§ 101, 103, 171; *L.A. Gear, Inc. v. Thom Mcan Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993) (“A patented design must meet the substantive criteria of patentability, including non-obviousness in accordance with the law of 35 U.S.C. § 103.” (citing 35 U.S.C. § 171)).

<sup>63</sup> *See, e.g., Neufeld-Furst & Co. v. Jayday Frocks, Inc.*, 112 F.2d 715, 715 (2d Cir. 1940) (per curiam).

<sup>64</sup> *See Izzo Golf, Inc. v. King Par Golf Inc.*, 561 F. Supp. 2d 334, 338 (W.D.N.Y. 2008).

<sup>65</sup> *See White v. Lombardy Dresses, Inc.*, 40 F. Supp. 216, 217 (S.D.N.Y. 1941) (“It is apparent however, that to ‘invent’ anything in the way of a new dress design, although temporarily attractive such design may be, becomes almost impossible when one considers the enormous amount of fashion advertising, design service, magazines and the host of skilful [sic] and intelligent dressmakers.”).

<sup>66</sup> *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 190 (S.D.N.Y. 1934) (“[D]esigns and patterns usually are short-lived and with the conditions and time incidental to obtaining the patent, this protection comes too late, if at all.”).

<sup>67</sup> U.S. PATENT AND TRADEMARK OFFICE, ELECTRONIC INFORMATION PRODUCTS DIVISION, DESIGN PATENTS REPORT, <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/design.htm#Desc> (last visited Dec. 8, 2009).

<sup>68</sup> *See Wm. Filene’s Sons Co. v. Fashion Originators’ Guild of Am., Inc.*, 90 F.2d 556, 558 (1st Cir. 1937).

<sup>69</sup> 17 U.S.C. § 102(a) (2006).

<sup>70</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (citations omitted).

<sup>71</sup> *Id.* at 345. Courts have recognized that originality differs from novelty. *Id.* (“[A] work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.”); *see also Mazer v. Stein*, 347 U.S. 201, 218 (1954) (“The copyright protects originality rather than novelty or invention . . .”), *superseded by statute*, Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541.

<sup>72</sup> 17 U.S.C. § 101.

Fixation must occur for only more than a “transitory duration.”<sup>73</sup> Like the originality requirement, the fixation requirement is generally easily met.<sup>74</sup>

Useful articles are not protected by copyright.<sup>75</sup> 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.”<sup>76</sup> If the work is found to be a useful article, protection only extends to the portions of the article that are creative and “separable from the utilitarian aspects of the work.”<sup>77</sup> This is now known as the concept of separability.<sup>78</sup>

Despite the fact that architectural designs are generally composed of elements that cannot be separated from their utilitarian functions,<sup>79</sup> architectural designs are still afforded protection.<sup>80</sup> This is so because the definition of useful article excludes

<sup>73</sup> *Id.*

<sup>74</sup> See *Williams Elecs., Inc. v Artic Int'l, Inc.*, 685 F.2d 870, 876–77 (3d Cir. 1982) (holding that a video game, embodied in ROM, met the fixation requirement even though audiovisual images are transitory and ROM is not humanly readable).

<sup>75</sup> 17 U.S.C. §§ 101, 102(a)(5).

<sup>76</sup> *Id.* § 101.

<sup>77</sup> *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 416 (5th Cir. 2005).

<sup>78</sup> See *Mazer v. Stein*, 347 U.S. 201, 218 (1954), *superseded by statute*, Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541; Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 715 (1983). It was in *Mazer* that the concept of separability emerged. *Mazer*, 347 U.S. at 218. In *Mazer*, the court upheld a regulation that granted copyright protection to “works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned . . .” *Id.* at 212 (quoting 37 C.F.R. § 202.8(a) (1949)). Concerned that *Mazer* would allow *all* utilitarian articles to be copyrighted, the Register of Copyright issued a new regulation. See 37 C.F.R. § 202.10(c) (1960). The new regulation stated:

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

*Id.* The regulation was in effect until the Copyright Act of 1976. Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541; *Fabrica, Inc. v. El Dorado Corp.*, 697 F.2d 890, 892 (9th Cir. 1983). The new regulation was difficult to apply, however, and courts struggled with whether the function of an article was solely utilitarian or only partly utilitarian. *Fabrica*, 697 F.2d at 893. In 1976, the Copyright Act changed the “useful article” limitation to say that works of artistic craftsmanship would be protected, “insofar as their form but not their mechanical or utilitarian aspects are concerned.” 17 U.S.C. § 101 (defining “[p]ictorial, graphic, and sculptural works”). The new regulation also specified that a useful article’s design would be “considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” *Id.* Under the Copyright Act of 1976, courts are no longer required to decide whether an article’s function is solely utilitarian. See *id.* “Now, if an article has *any* intrinsic utilitarian function, it can be denied copyright protection except to the extent that its artistic features can be identified separately and are capable of existing independently as a work of art.” *Fabrica*, 697 F.2d at 893.

<sup>79</sup> See 1 NIMMER & NIMMER, *supra* note 10, § 2.08[D][2][a], at 2-118 (discussing whether architectural designs qualify as useful articles).

<sup>80</sup> 17 U.S.C. § 102(a)(8); see also 17 U.S.C. § 101 (defining “architectural works” as “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings” and including “the overall form as well as the arrangement and composition of spaces and elements in the design” as protected elements of the work).

from its scope works that “merely portray the appearance of the article” or “convey information.”<sup>81</sup> The purpose of an architectural design is to do just that: to convey information regarding the design of a building.<sup>82</sup> Protection is available not only against unauthorized copying of the protected plan,<sup>83</sup> but also against unauthorized copying of a building’s construction that was based on protected plans.<sup>84</sup> While courts considering architectural design cases are not required to apply the separability test, legislative history claims to respect the functionality exclusion by extending protection to architectural works only when “the design elements are not functionally required . . . .”<sup>85</sup>

Another type of work that Copyright Law treats differently than an original work is a derivative work.<sup>86</sup> Unlike an original work, which is subject to a low standard of originality,<sup>87</sup> a derivative work is subject to a much more stringent test of originality.<sup>88</sup> In order to be granted protection, a derivative work is subject to two limitations.<sup>89</sup> First, the derivative’s original elements must be more than trivial.<sup>90</sup> Second, the protection granted to a derivative work must be limited to elements not found in the original work.<sup>91</sup> As such, only the features contributed by the author of the derivative work that are non-trivial and original are protected.<sup>92</sup>

The owner of a copyrightable work does not have to register the work in order to acquire copyright protection.<sup>93</sup> Rather, copyright protection exists in a work upon its creation.<sup>94</sup> In order to sue for infringement, however, either registration or pre-

<sup>81</sup> 17 U.S.C. § 101.

<sup>82</sup> See *Infodek, Inc. v. Meredith-Webb Printing Co.*, 830 F. Supp. 614, 623 (N.D. Ga. 1993) (“[T]he intrinsic function of a technical drawing is to convey information, and, by definition, a useful article that conveys information is not subject to the useful article exception.” (*Eales v. Env'tl. Lifestyles, Inc.*, 958 F.2d 876, 879–80 (9th Cir. 1992))).

<sup>83</sup> 17 U.S.C. § 101; see *Herman Frankel Org. v. Tegman*, 367 F. Supp. 1051, 1053 (E.D. Mich. 1973).

<sup>84</sup> 17 U.S.C. § 101; cf. *Entm't Research Group v. Genesis Creative Group*, 122 F.3d 1211, 1222 (9th Cir. 1997) (“[T]o reproduce or transform an already existing work into another medium or dimension—though perhaps quite difficult and intricate decisions—is not enough to constitute the contribution of something ‘recognizably his own.’” (citations omitted)).

<sup>85</sup> H. REP. NO. 101-735, at 20–21 (1990).

<sup>86</sup> 17 U.S.C. §§ 101, 106(2). A derivative work is one “based upon one or more preexisting works, such as a[n] . . . art reproduction . . . or any other form in which a work may be recast, transformed, or adapted,” or one “consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship.” *Id.* § 101.

<sup>87</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

<sup>88</sup> See *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980); see also 1 NIMMER & NIMMER, *supra* note 10, § 3.03[A], at 3-8–3-9 (listing “a change in medium (metal to plastic), and scale or size of a work of sculpture . . . making an obvious arrangement of pre-existing cutting designs on a crystal baby bottle” as examples of changes to preexisting works that are “too minimal to warrant the recognition of a new and separate copyright as a derivative.”).

<sup>89</sup> *Durham*, 630 F.2d at 909.

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> 17 U.S.C. § 102(a) (2006) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression . . .”).

<sup>94</sup> 17 U.S.C. § 102(a).

registration is required.<sup>95</sup> If the Copyright Office denies a registration, such a rejection does not preclude a plaintiff from succeeding on a copyright claim.<sup>96</sup> A certificate of registration creates the presumption that the work is protectable.<sup>97</sup> However, “[s]imply because a work is copyrighted does not mean every element of that work is protected.”<sup>98</sup> One of the ways through which a work can be deemed unprotectable is the merger doctrine.<sup>99</sup>

Copyright will not protect the part of the work that is an idea or a concept “regardless of the form in which it is described, explained, illustrated, or embodied in such work.”<sup>100</sup> The merger doctrine dictates that if an author’s expression is impossible to separate from the underlying idea, the idea and expression have merged and protection is not available.<sup>101</sup> The test for merger is whether “protection of expression would inevitably accord protection to an idea.”<sup>102</sup>

### *E. Fashion-Copyright Legislation*

The idea that original fashion designs warrant copyright protection is not a recently conceived notion. The assertion that protection of fashion design is important is evidenced by the fact that Congress has addressed the issue repeatedly since 1914.<sup>103</sup> The 91st through 94th Congresses specifically added design protection to the bill that became our current Copyright Statute.<sup>104</sup> The Senate’s version of its 1975 Copyright Revision Bill afforded design protection its own title.<sup>105</sup> Ultimately, however, design protection was excluded from the Copyright Revision Bill.<sup>106</sup>

After the Copyright Act of 1976 was enacted, congressional leaders continued to introduce design protection bills.<sup>107</sup> The first revision of the Copyright Act occurred in 1998 when Congress enacted the Vessel Hull Design Protection Act (“VHDPA”).<sup>108</sup>

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<sup>95</sup> 17 U.S.C. § 411(a) (“[N]o civil action for infringement of the copyright in any United States work shall be instituted until pre-registration or registration of the copyright claim has been made in accordance with this title.”).

<sup>96</sup> *See id.*; *Beverly Hills Design Studio (N.Y.) Inc. v. Morris*, 126 F.D.R. 33, 38 (S.D.N.Y. 1989).

<sup>97</sup> *Boisson v. Banian, Ltd.*, 273 F.3d 262, 268 (2d Cir. 2001) (citing *Gaste v. Kaiserman*, 863 F.2d 1061, 1065 (2d Cir. 1988)).

<sup>98</sup> *Id.*

<sup>99</sup> *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 111 (2d Cir. 2001) (“[I]f there is just one way to express an idea, the idea and expression are said to merge, and the expression is not protectable.” (citing *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 322 (2d Cir. 1996)).

<sup>100</sup> 17 U.S.C. § 102(b); *see also Baker v. Selden*, 101 U.S. 99, 103 (1880) (“The copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before.”).

<sup>101</sup> *Yurman Design*, 262 F.3d at 111.

<sup>102</sup> *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991).

<sup>103</sup> *See, e.g., Hearing on H.R. 5055, supra* note 36, at 198 (statement of Mary Beth Peters) (“Congress has taken up the matter on repeated occasions since 1914.”).

<sup>104</sup> *Id.* (statement of Mary Beth Peters).

<sup>105</sup> *Id.* (statement of Mary Beth Peters) (citing S. 22, 94th Cong. (1975); S. REP. NO. 94-473 (1975)).

<sup>106</sup> *Id.* at 199 (statement of Mary Beth Peters).

<sup>107</sup> *Id.*

<sup>108</sup> 17 U.S.C. §§ 1301–1332 (2006).

Congress enacted the VHDP, however, without considering whether its scope should be broadened to other useful articles.<sup>109</sup>

On March 30th, 2006, H.R. 5055 was introduced to Congress.<sup>110</sup> The bill proposed an amendment to the VHDP to provide protection to fashion design.<sup>111</sup> Hearings were held to discuss the bill on July 27th, 2006, but a debate on the issue was never brought to the House floor and H.R. 5055 was thus never put to a vote.<sup>112</sup>

The 110th Congress saw an almost identical bill, H.R. 2033, introduced on April 25th, 2007.<sup>113</sup> Although it was referred to a subcommittee on May 4th, 2007,<sup>114</sup> the bill was once again abandoned and cleared at the end of the Congressional session.<sup>115</sup>

## II. ANALYSIS

### A. Copyrightability Test for Architectural Works

When Congress addressed the policy considerations behind granting protection to architectural designs, it expressed an understanding that, while architecture is useful, its function is “interpreted aesthetically,” with “conviction and sensitivity” to the extent that the functionality is subsidiary to such interpretation.<sup>116</sup> Congress quoted Michael Graves, a famous modern architect, that architecture incorporates “the three-dimensional expression of the myths and rituals of society.”<sup>117</sup> Congress concluded that the legislation protecting architectural designs was meant to guard such expressions.<sup>118</sup>

The legislation excludes from protection only standard features and the copyrightability of architectural works is not determined by a separability test.<sup>119</sup> Instead, Congress suggested that the test for architectural works ask first if there are concrete expressions of original design components.<sup>120</sup> If such components exist, it was envisioned that the test asks whether the components are functional necessities.<sup>121</sup> If the components were not functionally required, the work would be copyrightable, regardless of separability requirements.<sup>122</sup>

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<sup>109</sup> Orit Fischman Afori, *Reconceptualizing Property in Designs*, 25 CARDOZO ARTS & ENT. L.J. 1105, 1126 (2008).

<sup>110</sup> Design Piracy Prohibition Act, H. REP. NO. 5055, 109th Cong. (2006).

<sup>111</sup> *Id.*

<sup>112</sup> *Hearing on H.R. 5055, supra* note 36, at 1; *see also* 2006 BILL TRACKING H.R. 5055 (2006) (providing the legislative chronology of H.R. 5055).

<sup>113</sup> Design Piracy Prohibition Act, H. REP. NO. 2033, 110th Cong. (2007).

<sup>114</sup> 153 CONG. REC. H 4175 (daily ed. Apr. 25, 2007) (statement of Rep. Delahunt).

<sup>115</sup> *See* 2008 BILL TRACKING H.R. 2033.

<sup>116</sup> *See* H. REP. NO. 101-735, at 18 (1990) (quoting ADA LOUISE HUXTABLE, ARCHITECTURE, ANYONE? (1986)).

<sup>117</sup> *Id.* at 19 (quoting MICHAEL GRAVES, BUILDINGS AND PROJECTS 1966–1981 11 (1982)).

<sup>118</sup> *Id.* at 19.

<sup>119</sup> T-Peg, Inc. v. Vt. Timber Works, Inc., 459 F.3d 97, 110 (1st Cir. 2006).

<sup>120</sup> Oravec v. Sunny Isles Luxury Ventures L.C., 469 F. Supp. 2d 1148, 1165 (S.D. Fla. 2008), *aff'd*, 527 F.3d 1218 (11th Cir. 2008).

<sup>121</sup> H. REP. NO. 101-735, at 20–21.

<sup>122</sup> *Id.* at 21.

Fashion design, like architecture, is simply a form which function dictates; it is the embodiment of ideas, politics, and trends found outside of the fashion industry.<sup>123</sup> Both fashion and architecture share their mythical and ritualistic qualities as well.<sup>124</sup> Despite the congressional passion for the “conviction and sensitivity” of architects, Congress has denied similar relief for fashion designers,<sup>125</sup> whose designs embody the very same characteristics.

### *B. Garments as Derivatives of Copyrightable Designs*

Many copyright infringement cases based on copying of actual garments are unsuccessful because courts classify the garments as useful articles.<sup>126</sup> Of the claims not dismissed for that reason, a large portion fail after the court finds the plaintiff’s underlying designs unoriginal and therefore unprotected.<sup>127</sup> As discussed below, the underlying rationale for either determination can be a contortion of prior case law. What is more, these prior outcomes are many times incompatible with each other and the purpose of the Copyright Act.<sup>128</sup>

#### *1. The Useful Article Determination*

When a fashion designer sues for copyright infringement of a design, courts will often find that the first prong of infringement, ownership of a valid copyright, is not satisfied because the work is a useful article.<sup>129</sup> For a work to be considered a useful article, it must have a utilitarian function separate from the expression of its own appearance or to convey information.<sup>130</sup>

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<sup>123</sup> See SCHIAPARELLI, *supra* note 1, at 113.

<sup>124</sup> See *supra* note 117 and accompanying text; YUNIYA KAWAMURA, FASHION-LOGY 43 (2005) (“[F]ashion is an ideology . . . a myth, and it may be defined as beliefs, attitudes and opinions all of which can be tightly or loosely related.”).

<sup>125</sup> See, e.g., 2008 BILL TRACKING H.R. 2033 (indicating that the most recent attempt to enact the Design Piracy Prohibition Act died in Congress).

<sup>126</sup> See, e.g., Beverly Hills Design Studio (N.Y.) Inc. v. Morris, 126 F.D.R. 33, 38 (S.D.N.Y. 1989) (“[The] patterns were used to cut fabric for the manufacture of garments. They did not reflect [plaintiff’s] ‘artistic judgment exercised independently of functional influences,’ [sic] but were functional products not eligible for copyright protection.”).

<sup>127</sup> See, e.g., Entm’t Research Group, Inc. v. Genesis Creative Group, Inc., 122 F.3d 1211, 1223 (9th Cir. 1997).

<sup>128</sup> Masquerade Novelty, Inc. v. Unique Indus., Inc., 912 F.2d 663, 670 (3d Cir. 1990) (“Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article’s utilitarian function.” (footnote omitted)).

<sup>129</sup> See *Beverly Hills Design Studio*, 126 F.D.R. at 38; see also Chosun Int’l, Inc. v. Chrisha Creations, Ltd., 413 F.3d 324, 327 (2d Cir. 2005) (stating that the district court criticized the different tests for separability as being “too inconsistent to afford meaningful guidance” and concluded that “no elements of the costumes could possibly be separated from their utilitarian function as devices with which to masquerade.”).

<sup>130</sup> 17 U.S.C. § 101 (2006).

The existence of numerous separability tests has created an unfortunately inconsistent approach to separability.<sup>131</sup> The United States Court of Appeals for the Second Circuit employs three different separability tests. One test asks which features, those that are utilitarian or artistic, are primary and which are subsidiary.<sup>132</sup> Another asks if the article "stimulates in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function."<sup>133</sup> Yet another examines whether the artistic design was significantly influenced by the work's functional needs.<sup>134</sup>

In *Pivot Point International, Inc. v. Charlene Products*, the United States Court of Appeals for the Seventh Circuit created a test that it felt synthesized the Second Circuit's tests, which asked whether "artistic aspects of an article can be 'conceptualized as existing independently of their utilitarian function.'"<sup>135</sup> This new *Pivot Point* test, however, was haphazardly followed.<sup>136</sup> In light of differing judicial opinions of the *Pivot Point* test, the United States Court of Appeals for the Fifth Circuit declined to apply the test, and instead used a likelihood-of-marketability test.<sup>137</sup>

Knowing the utility of an object is essential to the decision of whether the object is, in fact, utilitarian because all separability tests revolve around whether the object is serving its utilitarian function.<sup>138</sup> Courts deciding the copyrightability of objects that are not clothing have freely defined the functions of the objects at issue.<sup>139</sup> In the context of fashion designs, however, few courts have discussed what exactly a garment's utilitarian function is.<sup>140</sup> The application of a separability test does not refer to the actual function of clothing, and the analysis becomes fluid, seemingly in order to comply with oft-cited assertion that clothing design is not copyrightable.<sup>141</sup> This assertion, which many courts accept as a *per se* rule, was merely contained in

<sup>131</sup> See *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987); *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting); *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980).

<sup>132</sup> *Kieselstein-Cord*, 632 F.2d at 993.

<sup>133</sup> *Carol Barnhart*, 773 F.2d at 422.

<sup>134</sup> *Brandir*, 834 F.2d at 1145.

<sup>135</sup> 372 F.3d 913, 931 (7th Cir. 2004) (quoting *Carol Barnhart*, 773 F.2d at 418).

<sup>136</sup> See, e.g., *Stanislawski v. Jordan*, 337 F. Supp. 2d 1103, 1113 (E.D. Wis. 2004) (applying a test different than *Pivot Point* and deciding the two tests were not incompatible).

<sup>137</sup> *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 418–421 (5th Cir. 2005) ("Acknowledging the comprehensiveness of [the *Pivot Point*] opinion . . . is not tantamount to applying it here. We do not reject the *Pivot Point* test in this circuit, but we decline to apply it to the instant facts. . .").

<sup>138</sup> See *Brandir Int'l*, 834 F.2d at 1145; *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting); *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980).

<sup>139</sup> See, e.g., *Carol Barnhart*, 773 F.2d at 418 (finding the function of mannequin torsos is to assist in the display of clothing); *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970, 973 (6th Cir. 1983) (finding that toy airplanes have no intrinsic utilitarian function other than to portray real airplanes); *Hart v. Dan Chase Taxidermy Supply Co.*, 884 F. Supp. 71, 74 (N.D.N.Y. 1995) (finding the function of taxidermy mounts is to mount animal skins).

<sup>140</sup> See, e.g., *Galiano*, 416 F.3d at 417 (stating only that "[t]here is little doubt that clothing possesses utilitarian and aesthetic value," without further discussion).

<sup>141</sup> *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 327 (2d Cir. 2005).

dicta and does not bar clothing design from copyright registration.<sup>142</sup> This approach is not in line with the Constitutional and Congressional intent of copyright.<sup>143</sup>

Only one court, deciding the copyrightability of *doll* clothes, has given a thorough definition to the function of garments.<sup>144</sup> That court found that the utility of clothing was “to cover embarrassing anatomical aspects or to protect the [wearer] from exterior elements.”<sup>145</sup> If courts were to apply any of the separability tests in this manner, the history of copyright litigation involving fashion designs may have turned out very differently. Courts’ evasive treatment of garments, however, is not limited to the issue of separability.

## 2. *The Originality Determination*

Designers have successfully registered copyrights for garments as derivatives of prior copyrighted works.<sup>146</sup> However, when designers file copyright infringement suits to protect their registered derivatives many courts have overturned the registrations.<sup>147</sup> This decision is often based on a finding that the derivatives are not sufficiently original to garner protection.<sup>148</sup>

This conclusion, however, is frequently the result of the application of an unnecessarily stringent originality test and reliance on prior case rationale, stretched beyond its intended scope.<sup>149</sup> The court’s analysis in *Entertainment Research Group v. Genesis Creative Group* is one example.<sup>150</sup> In *Entertainment Research Group*, the plaintiff, Entertainment Research Group (“ERG”), owned copyrights in seven inflatable costumes.<sup>151</sup> The costumes were used by companies for publicity purposes and were based on copyrighted characters owned by such companies.<sup>152</sup> ERG sued Genesis Creative Group (“GCG”) for copyright infringement when GCG began creating copies of the ERG’s inflatable costumes.<sup>153</sup>

As in all infringement suits, ERG was required to show that it owned a valid copyright registration in the costumes, producing its certificates of registration as

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<sup>142</sup> See *Galiano*, 416 F.3d at 419 n.17.

<sup>143</sup> See U.S. CONST. art. I, § 8, cl.8; *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the [Copyright Clause] is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors . . . in ‘Science and Useful Arts.’ Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”), *superseded by statute*, Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541.

<sup>144</sup> *Boyd’s Collection, Ltd. v. Bearington Collection, Inc.*, 360 F. Supp. 2d 655, 661 (M.D. Pa. 2005).

<sup>145</sup> *Id.*

<sup>146</sup> See, e.g., *Entm’t Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1217–18 (9th Cir. 1997).

<sup>147</sup> See, e.g., *id.* at 1218, 1224.

<sup>148</sup> See, e.g., *id.* at 1224.

<sup>149</sup> See, e.g., *id.* at 1221–24.

<sup>150</sup> *Id.*

<sup>151</sup> *Id.* at 1218.

<sup>152</sup> *Id.* at 1214.

<sup>153</sup> *Id.* at 1215.

proof.<sup>154</sup> The validity of ERG's copyrighted characters was disputed, however, and as a result the court was required to examine the copyrightability of the costumes.<sup>155</sup>

The court in *Entertainment Research Group* first explained that, in the context of derivatives, originality is generally satisfied as long as the author of the derivative does not make an exact copy of the underlying work.<sup>156</sup> The court went on to state the well-established rule that thought and effort alone, such as the conversion of a two-dimensional figure into a three-dimensional work, does not satisfy the originality requirement.<sup>157</sup> ERG then pointed to the fact that its costumes had different facial expressions than the underlying copyrighted works as one artistic, non-trivial, non-functional aspect of its derivative work.<sup>158</sup> The court admitted that there were, in fact, differences in the facial expressions used in each work.<sup>159</sup> In a move that underlines the unpredictability of how courts treat garment design cases, the court held that despite the differences from the originals, the derivatives were unoriginal.<sup>160</sup> To come to this conclusion, the court applied a test similar to the average observer test.<sup>161</sup> The average observer test, however, is used to establish novelty for purposes of patent protection, a much higher standard than that applied to determine the originality of a derivative.<sup>162</sup>

The court concluded that, although the facial features on ERG's costumes were different than the characters on which the costumes were based, "no reasonable trier of fact would see anything but the underlying copyrighted character when looking at ERG's costumes."<sup>163</sup> Citing *Durham Industries, Inc. v. Tomy Corp.*,<sup>164</sup> the court rationalized its decision on the concern that allowing ERG to hold a copyright in the costumes would impinge on the original copyright owner's ability to reproduce the character "in a seemingly limitless variety of forms and media."<sup>165</sup>

The difference in the works at issue in *Durham* and *Entertainment Research Group*, however, exposes the flaw in using *Durham* as rationale. In *Durham*, copyright protection was sought for toy figures that were copied from existing Disney characters *in their entirety, without* a license.<sup>166</sup> Unlike ERG, the creator of the derivative work in *Durham* added no aesthetic differences other than changing their medium.<sup>167</sup> In light of the works being exact copies of Disney characters, the

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<sup>154</sup> *Id.* at 1217.

<sup>155</sup> *Id.* at 1218.

<sup>156</sup> *Id.* at 1221.

<sup>157</sup> *Id.* at 1222 (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 352–56 (1991); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 911 (2d Cir. 1980)).

<sup>158</sup> *Entm't Research Group*, 122 F.3d at 1223.

<sup>159</sup> *Id.*

<sup>160</sup> *Id.*

<sup>161</sup> *Compare id.* at 1223 (holding that the designs at issue were not copyrightable because an ordinary juror would only see the underlying trademarked-design), *with In re Bartlett*, 300 F.2d 942, 943 (C.C.P.A. 1962) ("[T]he degree of difference [from the prior art] required to establish novelty occurs when the average observer takes the new design for a different, and not a modified already-existing, design." (citation omitted) (alteration in original)).

<sup>162</sup> *See In re Bartlett*, 300 F.2d at 943; Raustiala & Sprigman, *supra* note 9, at 1704.

<sup>163</sup> *Entm't Research Group*, 122 F.3d at 1223.

<sup>164</sup> 630 F.2d 905 (2d Cir. 1980).

<sup>165</sup> *Entm't Research Group*, 122 F.3d at 1223 (quoting *Durham*, 630 F.2d at 910).

<sup>166</sup> *Durham*, 630 F.2d at 909.

<sup>167</sup> *Compare Entm't Research Group*, 122 F.3d at 1223 (finding that the alleged derivative work incorporated "one truly 'artistic' difference" and "some differences" in the facial expressions of

*Durham* court was correct in finding that affording derivative copyright protection to the toys would bar Disney from creating toy versions that exactly replicate its copyrighted characters, as a toy replica would infringe on the defendant's copyright.<sup>168</sup> Such a restriction on Disney would, in turn, invade the scope of Disney's own copyright.<sup>169</sup>

ERG, however, did not create a reproduction of a copyrighted character in its entirety.<sup>170</sup> ERG used facial expressions that were not found in the original expressions of the copyrighted characters.<sup>171</sup> By using the *Durham* rationale, the *ERG* court disregarded a fundamental principle of copyright law: that the fixed expression of an idea, (*i.e.*, Toucan Sam's appearance on the cereal box) and not the idea itself, (*i.e.*, Toucan Sam as a parrot capable of any number of facial expressions) is protected.<sup>172</sup> Just as courts tend to do in analyzing garments for separability, the court in *ERG* went out of its way to pay homage to the non-rule that garments are not copyrightable, passing over important considerations along the way.<sup>173</sup>

Even if courts properly identified the utility of garments and properly addressed separability, many garments would not meet the requirements of originality and creativity due to the prevalence of copying. The garments that would most likely qualify are found at the top of the "fashion pyramid."<sup>174</sup> The fashion pyramid is made-up of three design categories: designer, ready-to-wear, and basic.<sup>175</sup> The designer category, which found at the top of the pyramid and produces only a small amount of designs and garments, is characterized as having the greatest amount of "design content."<sup>176</sup> The designs produced by companies in the categories found lower on the pyramid incorporate less and less design content and originality.<sup>177</sup> Due to the fact that the majority of clothing is not produced by companies in the designer

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the characters embodied in the work), *with Durham*, 630 F.2d at 908–909 (finding Disney-character toys not sufficiently original for copyright protection because the "reproduction of the Disney characters in plastic . . . and the toys themselves" reflected "no independent creation, no distinguishable variation from preexisting works, nothing recognizably the author's own contribution" that differentiated the creator's figures "from the prototypical Mickey, Donald, and Pluto, authored by Disney . . .").

<sup>168</sup> *See id.* at 911.

<sup>169</sup> *Id.* After all, the expression of a particular Disney character, using the exact characteristics of the copyrighted character, in an 18-inch toy figure can only be accomplished one way. *See id.*

<sup>170</sup> *Entm't Research Group*, 122 F.3d at 1223.

<sup>171</sup> *Id.*

<sup>172</sup> 17 U.S.C. § 102(b) (2006).

<sup>173</sup> *Compare Entm't Research Group*, 122 F.3d at 1223 (finding that the articles at issue were utilitarian using only the court's judgment), *with Poe v. Missing Persons*, 745 F.2d 1238, 1243 (9th Cir. 1984) (recognizing the importance of considering several pieces of evidence before determining the copyrightability of a garment, including expert testimony regarding the usefulness of the garment, the separability of any apparent functional and artistic elements, evidence of the designer's intent in designing the garment and "testimony concerning the custom and usage within the art world and the clothing trade concerning such objects. . . ." would be helpful in deciding whether it had a utilitarian function (citations omitted)).

<sup>174</sup> Raustiala & Sprigman, *supra* note 9, at 1693–1694.

<sup>175</sup> *Id.* at 1693.

<sup>176</sup> *Id.* at 1694.

<sup>177</sup> *Id.*

category, it is unlikely that protection would result in an increase in litigation, as some opponents argue it would.<sup>178</sup>

It is important to note that there was no significant increase in litigation when vessel hulls, a previously unprotected useful article, received protection. A report on the affect of the VHDPA, five years after its enactment, found that only one lawsuit had been brought under its terms.<sup>179</sup> Four years after the Copyright Office began accepting vessel hull design registrations a manageable 156 designs had been registered.<sup>180</sup> During the same time, eight designs were denied registration.<sup>181</sup> These numbers undermine opponents' argument that intellectual property protection of fashion designs would do more to employ lawyers than protect fashion.<sup>182</sup>

Another opposition argument focuses on the historical success the fashion industry has experienced without intellectual property protection.<sup>183</sup> Prior to the passing of the VHDPA<sup>184</sup> the same could have been said for the ship building industry. There is no reason the fashion industry should be analyzed any differently.

Courts should consider the intent of copyright protection when determining whether intellectual property protection should be extended to garment design.<sup>185</sup> The United States Constitution authorizes Congress "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>186</sup> While some opponents of fashion design protection argue that affording such protection would stunt the growth of garment design industry,<sup>187</sup> evidence gathered in the wake of the codification of the VHDPA suggests just the opposite. Many of the comments submitted to the panel charged with assessing the effectiveness of the VHDPA said that the Act had the effect of encouraging businesses to create new designs for vessel hulls.<sup>188</sup> "The existence of [the VHDPA] clearly pushes our engineers and designers to create innovative and different products, which is evidenced by the designs we have registered, with far more on the drawing board. Were it not for the VHDPA, the incentive for innovation would clearly be diminished."<sup>189</sup>

<sup>178</sup> See *Hearing on H.R. 5055*, *supra* note 36, at 88 (statement of Christopher Sprigman) ("[W]e fear that H.R. 5055 might turn the industry's attention away from innovation and toward litigation.").

<sup>179</sup> U.S. COPYRIGHT OFFICE & U.S. PATENT & TRADEMARK OFFICE, *THE VESSEL HULL DESIGN PROTECTION ACT: OVERVIEW AND ANALYSIS 9* (2003) [hereinafter VHDPA REPORT].

<sup>180</sup> *Id.* at 10.

<sup>181</sup> *Id.*

<sup>182</sup> *Hearing on H.R. 5055*, *supra* note 36, at 88 (statement of Christopher Sprigman).

<sup>183</sup> *Id.* at 87.

<sup>184</sup> 17 U.S.C. §§ 1301–1332 (2006).

<sup>185</sup> See U.S. CONST. art. I, § 8, cl. 8.; see *Mazer v. Stein*, 347 U.S. 201, 219 (1954), *superseded by statute*, Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541.

<sup>186</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>187</sup> Raustiala & Sprigman, *supra* note 9, at 1722. *But see* Coblenz, *supra* note 41 ("The theory that copying actually promotes innovation of designer clothing—because the more common a look becomes, the more the fashion-conscious seek out the next thing—is an insult to common sense as well as to the most elementary decency.").

<sup>188</sup> VHDPA REPORT, *supra* note 179, at 11.

<sup>189</sup> *Id.* at 11–12 (quoting J.J. Marie, President of Zodiac of North America, Inc.).

### III. PROPOSAL

The following section proposes that courts change their analysis of garments and garment design when considering their copyrightability. In order to provide certainty to litigants and the judiciary, courts should give a definition to the utility of garments.<sup>190</sup> Courts should adopt the definition found in *Boyds Collection, Ltd. v. Bearington Collection, Inc.*, that being to cover embarrassing anatomical parts of the body or to protect the wearer from external elements.<sup>191</sup> Additionally, when determining the copyrightability of garment designs, courts should begin to analyze the designs using the separability test and the exception for affording protection to architectural works. An adoption of both the architectural test for separability and the exception that three-dimensional versions of two-dimensional copyrighted works are generally not protected by copyright is supported by public policy considerations.

#### A. *The Utility of Garments Should Be Defined*

Before garments are generically classified as “useful articles,” courts should decide the utility of a garment.<sup>192</sup> The general judicial avoidance of this determination has led to fluid and incongruent holdings which only serve to create uncertainty in litigation.<sup>193</sup>

If courts adopted the decision in *Boyds Collection*,<sup>194</sup> the designing public could be sure of a garment’s utility and shape their legal arguments accordingly.<sup>195</sup> In *Boyds Collection*, the court found that garments were meant to cover embarrassing anatomical parts of the body or to protect the wearer from external elements.<sup>196</sup> This definite description of a garment’s utility would not render a copious amount of garments copyrightable.<sup>197</sup> In *Klieselstein-Cord v. Accessories By Pearl, Inc.*, the court’s analysis of whether a designer’s belt buckles were utilitarian articles took into account the fact that “[t]he primary ornamental aspect of the [belt] buckles is conceptually separable from their subsidiary utilitarian function.”<sup>198</sup>

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<sup>190</sup> See Hetherington, *supra* note 8, at 48–49 (calling the definitions of “useful” provided by the Copyright Office “cryptic” and classifying the decisions as “obtuse hair-splitting.”).

<sup>191</sup> *Boyds Collection, Ltd. v. Bearington Collection, Inc.*, 360 F. Supp. 2d 655, 661 (M.D. Pa. 2005).

<sup>192</sup> *But see* Policy Decision, Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,532 (Nov. 5, 1991) (“Garments are useful articles, and the designs of useful articles are *generally* outside of the copyright law.”) (emphasis added).

<sup>193</sup> *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 420 (5th Cir. 2005) (“The caselaw on costume design is, to say the least, uneven.”); Denicola, *supra* note 78, at 729 n.102 (classifying the existence of competing tests as “hardly an approach calculated to increase certainty and predictability.”).

<sup>194</sup> 360 F. Supp. 2d at 661–62.

<sup>195</sup> *Accord* Denicola, *supra* note 78, at 729 n.102.

<sup>196</sup> *Boyds Collection*, 360 F. Supp. 2d at 661.

<sup>197</sup> See VHDP REPORT, *supra* note 179, at 10 (noting that four years after the Copyright Office began accepting Vessel Hull design registrations, the Copyright office had only registered 156 designs and had rejected only eight).

<sup>198</sup> 632 F.2d 989, 993 (2d Cir. 1980) (noting that many who wore the belt buckles did so for ornamental purposes on parts of the body other than the waist). The court’s language at least

Applying the *Boyd's Collection* definition of a garment's utility to the *Kieselstein-Cord* analysis of separability to garments would provide protection to a small class of garments—those that were clearly designed in a way that considers aesthetics primary to the garment's utility. Garments designed in ignorance of the *Boyd's Collection* function are often seen on the high fashion run-ways of Paris, Milan and New York City, where designers intentionally choose fabrics that display nipples,<sup>199</sup> if not more. These garments, the utilitarian function of which is void, should be considered body ornamentation, as the ornate belt buckles were determined to be in *Kieselstein-Cord*.

Whatever utility the courts decide garments serve, allowing those articles of clothing that do not serve their utilitarian function to be copyrighted would not incite the registration of nightmarish numbers of clothing designs.<sup>200</sup> Most garments would not meet the requirements of originality and creativity,<sup>201</sup> a fact that the Copyright Office would use judiciously. After all, “[t]he Copyright Office continually engages in the drawing of lines between that which may be and that which may not be copyrighted,”<sup>202</sup> a duty that surely would not be discharged solely because the subject matter is somewhat novel.<sup>203</sup>

### *B. Courts and the Copyright Office Should Begin to Apply the Rationale for Copyrightability of Architectural Designs to Fashion Designs*

The unequal treatment by both the Copyright Office and the courts of garment designs depicted on technical flats, despite their similarities with architectural blueprints, must stop. Like blueprints, fashion design patterns may be copyrighted to the extent that they convey information.<sup>204</sup> While the general rule is that transformation from a two-dimensional figure to a three-dimensional form is not sufficient variation for the three-dimensional form to be considered a protected

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suggests that if a garment's utility is subsidiary to its ornamental aspects then the article is copyrightable as applied art. *See id.*

<sup>199</sup> *See* Forfeiture Order, 21 F.C.C.R. 2,760, 2,762 (Mar. 15, 2006) (noting that the first determination, in the test for whether something is indecent, “is whether the material in question depicts or describes sexual or excretory organs or activities,” in coming to the conclusion that Janet Jackson satisfied that first standard).

<sup>200</sup> *See* VHDPA REPORT, *supra* note 179, at 10 (noting that only 156 registrations had been filed in four years).

<sup>201</sup> *See* *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 369 (1991) (“Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works). . . .” (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01[A], [B] (1990))).

<sup>202</sup> *Kieselstein-Cord*, 632 F.2d at 994.

<sup>203</sup> *See Collections of Information Antipiracy Act; Vessel Hull Design Protection Act; Trade Dress Protection Act; and Internet Domain Name Trademark Protection: Hearing on H.R. 2652, H.R. 2696 and H.R. 3163 Before the Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary*, 105th Cong. 22–23 (1997) (statement of Marybeth Peters, Reg. of Copyrights, United States Copyright Office) (illustrating that, regardless of administrative costs adhering to the Copyright Office when new copyright protection is legislatively granted, the Copyright Office still supports such legislative change).

<sup>204</sup> *Beverly Hills Design Studio (N.Y.) Inc. v. Morris*, 126 F.R.D. 33, 38 (S.D.N.Y. 1989).

derivative,<sup>205</sup> this is not the case for architectural structures.<sup>206</sup> Architectural structures based on copyrightable designs, though only a transformation from two dimensions to three, are protected.<sup>207</sup> This exception to the general rule is logical, as architectural copyists do not need the blueprint to copy a structure that is visible from a public place, and thus lack of proof of access to the actual copyrighted blueprint could defeat a valid infringement claim.

This exception, granting protection to an obvious point of access to the copyrighted work, should be applied to garments for the same reason. Unlike physical structures, however, copyists of garments can get an even more intimate understanding of the original by purchasing the garment and studying it inside and out.<sup>208</sup> Whichever pirate has it easier, the result of the copying is the same: inferior product.<sup>209</sup> Materials and methods used in the copies, while appearing similar to the original, are merely cheap substitutes, switched out by the copyists to enable a lower cost to consumers who are not privy of the structural integrity of the original raw materials.<sup>210</sup>

Opponents of granting copyright protection to fashion design argue that copying is good for the fashion industry because it stimulates the fashion cycle.<sup>211</sup> Such an argument is akin to saying “that theft should be encouraged because, by necessity of replacement, it would increase the nation’s industrial output.”<sup>212</sup> To protect consumers selectively, choosing to guard only those who are able to buy homes of architectural significance is clearly against public policy.<sup>213</sup> To further public policy, courts should apply to garments the separability test and the three-dimensional exception as they are used for architectural works.

#### CONCLUSION

Current intellectual property laws are ill-suited to protect fashion design. Regarding the most applicable intellectual property protection, a review of copyright litigation over fashion design infringement reveals the uneven and fluid analyses applied by courts. Litigation, which should serve to clarify and create reliable precedents, has accomplished the opposite.<sup>214</sup> Due to the courts’ failure to supply a

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<sup>205</sup> See *Entm't Research Group v. Genesis Creative Group*, 122 F.3d 1211, 1222 (9th Cir. 1997) (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 352–56 (1991); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 911 (2d Cir. 1980)).

<sup>206</sup> See H. REP. NO. 101-735, at 19 (1990).

<sup>207</sup> *Id.*

<sup>208</sup> Raustiala & Sprigman, *supra* note 9, at 1696.

<sup>209</sup> See Coblenz, *supra* note 41 (“Pirates . . . steal American designs, make low quality copies in foreign factories with cheap labor and import them into the United States to compete with original American fashion.”).

<sup>210</sup> See Hetherington, *supra* note 8, at 66.

<sup>211</sup> Raustiala & Sprigman, *supra* note 9, at 1727 (arguing that copying is more beneficial than harmful to the fashion industry).

<sup>212</sup> Coblenz, *supra* note 41.

<sup>213</sup> See, e.g., S. REP. NO. 1333, at 3 (1946) (expressing that the goal of federal trademark law is “to protect the public so it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and wants to get.”).

<sup>214</sup> *Accord* Denicola, *supra* note 78, at 729 n.102.

definition of garments' functions or a uniform rule to test for separability, the resulting decisions are based on rationale that has no precedent. In addition, the rationale for affording copyright protection to architectural designs is the very same used against the same protection for fashion designs.

When considering the Constitutional intent for protection of intellectual property, it is clear that much progress can be made in the protection of garment designs, without the intervention of legislation, if courts can come to a consensus on both the utility of garments and the test for separability. The application of the architectural test for copyrightability to a fashion design would serve to illustrate the inconsistent treatment of fashion designs, whatever the final outcome of the case. Fashion designs are deserving of intellectual property protection, and litigants in cases involving fashion designs have the right to certainty in litigation.