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## The Inability of Intellectual Property to Protect the New Fashion Designer: Why the ID3PA Should Be Adopted

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## COMMENT

# THE INABILITY OF INTELLECTUAL PROPERTY TO PROTECT THE NEW FASHION DESIGNER: WHY THE ID3PA SHOULD BE ADOPTED

JESSICA ROSEN\*

### INTRODUCTION

*Piracy can wipe out young careers in a single season. The most severe damage from lack of protection falls upon emerging designers . . . who everyday lose orders and potentially our entire businesses. While salvage designers and large corporations with wide recognized trademarks can better afford to absorb these losses caused by copying, very few small businesses can compete with those who steal their intellectual capital. It makes it harder for young designers to start up their own companies. And isn't that the American Dream?*<sup>1</sup>

In September 2011, fashion blogs blew up in outrage over a pop star's "blatant copy" of a new designer's "Puff Ball" fashion design.<sup>2</sup>

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<sup>1</sup> *Innovative Design Protection and Piracy Prevention Act: Hearing on H.R. 2511 Before the H. Subcommittee on Intellectual Prop., Competition, & the Internet*, 112th Cong. 4-5 (2011) [hereinafter *Hearing on H.R. 2511*] (statement of Lazaro Hernandez, designer and cofounder of Proenza Schouler).

<sup>2</sup> Hayley Phelan, *Adventures in Copyright: Nicki Minaj Wears a Blatant Copy of Young Designer Jessica Rogers' "Puff Ball" Fashion; Rogers Says She Was "in Tears" over It*, FASHIONISTA (Sept. 14, 2011), [www.fashionista.com/2011/09/adventures-in-copyright-nicki-minaj](http://www.fashionista.com/2011/09/adventures-in-copyright-nicki-minaj)

The new designer, 21-year-old Jessica Rogers, saw a blog post about singer Nicki Minaj attending Carolina Herrera's Spring 2012 fashion runway show.<sup>3</sup> As Rogers read the post and studied the accompanying photo, she described herself as "immediately caught off guard" because the dress Minaj wore resembled her own fashion design.<sup>4</sup> She put "time, money, sweat, all of [herself] into [her] work," only to see Minaj in a copy.<sup>5</sup>

Rogers explains that she conceived the "Puff Ball" design three years earlier and worked extremely hard to make it her signature.<sup>6</sup> She "developed contacts all through the industry and [had her] garments waiting to be worn."<sup>7</sup> A year and a half earlier she had been contacted by Minaj's stylists, who requested her garments for future press events.<sup>8</sup> After numerous attempts to reach Minaj's stylists, Rogers decided to send photos of garments from her fashion line.<sup>9</sup> A month later, Rogers saw Minaj wearing her "Puff Ball" design, though she admitted, "The knock off doesn't look that good."<sup>10</sup>

To make matters worse, Minaj was sitting next to none other than Anna Wintour, the Editor-in-Chief of *Vogue* magazine.<sup>11</sup> Rogers was distraught when she saw Minaj sitting next to Wintour wearing a copy of her design, because Wintour is "one of [her] personal icons and someone that [she] admired," someone she hoped "would see [her] garments . . . as a completely original idea."<sup>12</sup> Minaj's "blatant copy" may very well

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wears-a-blatant-rip-off-of-young-designer-jessica-rogers-puff-ball-fashion-rogers-says-she-was-in-tears/; *Nicki Minaj Is Accused [sic] of Copying a Clothing Design by Jessica Rogers During New York Fashion Week*, HUFFINGTON POST (Sept. 15, 2011), [www.huffingtonpost.com/2011/09/15/nicki-minaj-is-accused-o\\_n\\_964804.html](http://www.huffingtonpost.com/2011/09/15/nicki-minaj-is-accused-o_n_964804.html); Ella Brodskaya, *Puff Ball Pitfall for Nicki Minaj*, NEW YORK LAW SCHOOL FOR FASHION LAW (Sept. 23, 2011), [www.caseclothesed.com/puff-ball-pitfall-for-nicki-minaj/](http://www.caseclothesed.com/puff-ball-pitfall-for-nicki-minaj/); Bernice Lee McMillan, *Nicki Minaj Accused of Stealing Budding Designer's Idea*, STYLE BISTRO (Sept. 14, 2011), [www.stylebistro.com/New+York+Fashion+Week/articles/mYrwNz0obsZ/Nicki+Minaj+Accused+Stealing+Budding+Designer](http://www.stylebistro.com/New+York+Fashion+Week/articles/mYrwNz0obsZ/Nicki+Minaj+Accused+Stealing+Budding+Designer); *Young Designer Claims Nicki Minaj Copied Her Designs for That Colorful Top*, GLAMOUR VANITY (Sept. 16, 2011), [www.glamourvanity.com/celebrities/young-designer-claims-nicki-minaj-copied-her-designs-for-that-colorful-top/](http://www.glamourvanity.com/celebrities/young-designer-claims-nicki-minaj-copied-her-designs-for-that-colorful-top/).

<sup>3</sup> Jessica Rogers, *Artistic Plagiarism*, SOME DAY NEW YORKER BLOG (Sept. 13, 2011), [somedaynewyorker.blogspot.com/2011/09/artistic-plagiarism.html](http://somedaynewyorker.blogspot.com/2011/09/artistic-plagiarism.html).

<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

<sup>9</sup> *Id.*

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

<sup>11</sup> *Nicki Minaj Is Accused [sic] of Copying a Clothing Design by Jessica Rogers During New York Fashion Week*, *supra* note 2.

<sup>12</sup> Rogers, *supra* note 3.

have dashed those hopes. She thought, “How could someone copy my work?”<sup>13</sup>

According to legal scholars Kal Raustiala and Christopher Sprigman, the copying of another’s fashion design is only natural in the fashion industry; it is simply how the fashion industry works:

Fashion piracy may be parasitic on original designs, but it is a parasite that does not kill its host: though it may weaken individual designers it also, paradoxically, strengthens the industry and drives its evolution. In an industry that cannot look to continuous improvements in quality to drive demand, piracy substitutes for functional innovation. This is a very important point: piracy is the fashion industry’s equivalent of the new feature on a cell phone. It is a force that encourages a consumer to discard a perfectly serviceable garment and purchase the new, new thing.<sup>14</sup>

For Raustiala and Sprigman, the host in the “parasite” metaphor is not the individual designer, but the fashion industry itself.<sup>15</sup>

While the parasite is not killing its host, it may very well kill new fashion designers, those who “are creating and . . . bringing freshness and newness to middle America. They are inspiring [the] bigger companies to do new things and think of things, and think of our work differently.”<sup>16</sup> New designers who are, in Rogers’s words, putting “time, money, sweat, all of themselves into their work,” find themselves in situations where designs are copied, and there is nothing they can do about it.<sup>17</sup> Moreover, Susan Scafidi, Director of the Fashion Law Institute at Fordham University School of Law, notes that “[i]ndividuals are the industry and it is a loss of human capital and a personal tragedy when designers are driven out of business because they are copied.”<sup>18</sup>

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<sup>13</sup> *Id.*; see Jason Linkins, *Urban Outfitters Continues Their Grand Tradition of Ripping Off Designers*, HUFFINGTON POST, [www.huffingtonpost.com/2011/05/26/urban-outfitters-steal\\_n\\_867604.html](http://www.huffingtonpost.com/2011/05/26/urban-outfitters-steal_n_867604.html) (last updated July 26, 2011).

<sup>14</sup> Kal Raustiala & Christopher Sprigman, *The Piracy Paradox Revisited*, 61 STAN. L. REV. 1201, 1209 (2009) [hereinafter Raustiala & Sprigman, *The Paradox Piracy Revisited*]; see Kal Raustiala and Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687 (2006) [hereinafter Raustiala & Sprigman, *The Piracy Paradox*].

<sup>15</sup> See Raustiala & Sprigman, *The Piracy Paradox*, *supra* note 14.

<sup>16</sup> *Design Law—Are Special Provisions Needed To Protect Unique Industries?: Hearing Before the Subcommittee on Courts, the Internet, & Intellectual Prop.*, 110th Cong. 56 (2011) [hereinafter *Design Law Hearing*] (statement of Narciso Rodriguez, Designer, on behalf of the Council of Fashion Designers of America) (expressing the need for legislation to protect new fashion designers).

<sup>17</sup> Rogers, *supra* note 3.

<sup>18</sup> See *A Bill To Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the H. Subcommittee on Courts, the Internet, & Intellectual Prop.*, 109th Cong. 187 (2006) [hereinafter

As the law stands today, fashion designs are not afforded copyright protection, because clothing is deemed a useful article.<sup>19</sup> Useful articles “are largely unprotected by the Copyright Act, except to the extent that they ‘incorporate[ ] pictorial, graphic, or sculptural features that can be identified *separately from*, and are capable of existing independently of, the utilitarian aspects of the article.’”<sup>20</sup> Under “separate conceptualism,” in which the artistic element is conceptually severable from the useful aspect of the article rather than inextricably interwoven with its utility,<sup>21</sup> it has proven difficult to truly separate the artistic or creative features from the utilitarian function of clothing.<sup>22</sup> One court stated that “separable elements of clothing, *to the extent that they exist*, may be eligible for copyright protection.”<sup>23</sup> However, the Copyright Office “generally refuse[s] to register claims to copyright in three-dimensional aspects of clothing.”<sup>24</sup>

Nevertheless, the fashion world is fighting back. Organizations like the Council of Fashion Designers of America and American Apparel and Footwear Association have lobbied Congress to amend the Copyright Act in order to provide copyright protection to fashion designs.<sup>25</sup> In the 112th Congress, both houses introduced bills to afford copyright protection to fashion designs.<sup>26</sup> On July 13, 2011, Representative Bob Goodlatte reintroduced the Innovative Design Protection and Piracy

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*Hearing on H.R. 5055*] (statement of Susan Scafidi, Visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University).

<sup>19</sup> *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (citing *Fashion Originators Guild of Am., Inc. v. FTC*, 114 F.2d 80, 84 (2d Cir. 1940) (L. Hand, J.), *aff’d*, 321 U.S. 457 (1941)).

<sup>20</sup> *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 548 (S.D.N.Y. 2011) (emphasis added).

<sup>21</sup> *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980).

<sup>22</sup> *Hearing on H.R. 5055, supra* note 18, at 3 (statement of Rep. Howard L. Berman, Member, House Comm. on the Judiciary) (“Current copyright law only provides protection to those design elements of a useful article that are separable and independent of the utilitarian function of the article. Therefore, fashion works have traditionally been denied copyright protection on the ground that they are considered to be useful articles.”); *see also* JOHN W. HAZARD, JR., *COPYRIGHT LAW IN BUSINESS AND PRACTICE* § 2:37 (Rev. ed. 2011) (explaining that “[t]he idea that clothing might be copyrighted—apart from any copyrightable designs that may be placed on it—suffers from the *strict rule* established in such cases as *Whimsicality*, 891 F.2d 452).

<sup>23</sup> *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005) (emphasis added).

<sup>24</sup> *Jovani Fashion*, 808 F. Supp. 2d at 549 (emphasis added) (citing United States Copyright Office Policy Decision: Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,531 (1991)).

<sup>25</sup> *Hearing on H.R. 2511, supra* note 1, at 5 (statement of Lazaro Hernandez, designer and cofounder of Proenza Schouler); *id.* at 91 (statement of Kurt Courtney, Manager, Government Relations, American Apparel & Footwear Association).

<sup>26</sup> Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011); Innovative Design Protection Act of 2012, S. 3523, 112th Congress (2012).

Prevention Act (ID3PA), a virtual copy of the Senate's bill introduced in the 111th Congress.<sup>27</sup> And on September 10, 2012, Senator Charles Schumer introduced the Innovative Design Protection Act of 2012 (IDPA), a bill that followed earlier bills but added limitations in gaining copyright protection—notably the bill would have imposed a notice period as a prerequisite for bringing a cause of action.<sup>28</sup> Although both bills died in the 112th Congress,<sup>29</sup> the lively history and recent focus on expanding copyright protection to cover fashion designers suggest such protection is a realistic possibility in the near future.

The reintroduction of ID3PA and the introduction of IDPA mark the sixth and seventh attempts in the last six years to provide copyright protection for fashion designs. In 2006, members of the House introduced “A Bill To Provide Protection for Fashion Design.”<sup>30</sup> From 2007 to 2009, members of both the Senate and the House introduced three bills known as the Design Piracy Prohibition Act.<sup>31</sup> All of these bills died in committee.<sup>32</sup> Yet, in 2010 the Senate introduced the original ID3PA, which moved further along than the prior bills.<sup>33</sup> The original ID3PA was deemed a “more targeted bill” than its predecessors in protecting original fashion designs while not increasing litigation throughout the fashion industry.<sup>34</sup> The bill was unanimously approved and reported by the Senate Judiciary Committee on December 1, 2010.<sup>35</sup>

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<sup>27</sup> H.R. 2511; Innovative Design Protection and Piracy Prevention Act, S. 3728, 111th Cong. (2010).

<sup>28</sup> S. 3523; S. REP. NO. 112-259, at 2 (2012), available at 2012 WL 6725915 (Westlaw); “Executive Business Meeting”: Hearing on H.R. 2471, S. 3486, S. 1894, S. 3250, S. 3523 Before the Senate Judiciary Committee, Sept. 20, 2012 at 10:00 AM, available at [www.judiciary.senate.gov/hearings/hearing.cfm?id=3fd304c9f884bebd65a28be7fcab7241](http://www.judiciary.senate.gov/hearings/hearing.cfm?id=3fd304c9f884bebd65a28be7fcab7241) [hereinafter *Executive Business Meeting*].

<sup>29</sup> H.R. 2511 (112th): Innovative Design Protection and Piracy Prevention Act, GOVTRACK.US, [www.govtrack.us/congress/bills/112/hr2511](http://www.govtrack.us/congress/bills/112/hr2511) (last visited Mar. 13, 2013) [hereinafter GOVTRACK.US H.R. 2511]; S. 3523 (112th): Innovative Design Protection Act of 2012, GOVTRACK.US, [www.govtrack.us/congress/bills/112/s3523](http://www.govtrack.us/congress/bills/112/s3523) (last visited Mar. 13, 2013) [hereinafter GOVTRACK.US S. 3523].

<sup>30</sup> A Bill To Provide Protection for Fashion Design, H.R. 5055, 109th Cong. (2006).

<sup>31</sup> Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007); S. 1957, 110th Cong. (2007); H.R. 2196, 111th Cong. (2009).

<sup>32</sup> H.R. 2033 (110th): Design Piracy Prohibition Act, GOVTRACK.US, [www.govtrack.us/congress/bills/110/hr2033](http://www.govtrack.us/congress/bills/110/hr2033) (last visited Mar. 13, 2013); S. 1957 (110th): Design Piracy Prohibition Act, GOVTRACK.US, [www.govtrack.us/congress/bills/110/s1957](http://www.govtrack.us/congress/bills/110/s1957) (last visited Mar. 13, 2013); H.R. 2196 (111th): Design Piracy Prohibition Act, GOVTRACK.US, [www.govtrack.us/congress/bills/111/hr2196](http://www.govtrack.us/congress/bills/111/hr2196) (last visited Mar. 13, 2013).

<sup>33</sup> GOVTRACK.US H.R. 2511, *supra* note 29.

<sup>34</sup> *Hearing on H.R. 2511, supra* note 1, at 91 (statement of Kurt Courtney, Manager, Government Relations, American Apparel & Footwear Association).

<sup>35</sup> S. 3728 (111th): Innovative Design Protection and Piracy Prevention Act, GOVTRACK.US, [www.govtrack.us/congress/bill.xpd?bill=s111-3728](http://www.govtrack.us/congress/bill.xpd?bill=s111-3728) (last visited Feb. 11, 2013) [hereinafter GOVTRACK.US S. 3728]; see also Tiffany W. Shimada, *Fashion Design Under the Innovative Design*

However, neither house of Congress voted on the bill before the adjournment of the 111th Congress later that month, resulting in the death of the ID3PA.<sup>36</sup>

The history of prior bills to afford copyright protection to fashion designers, along with the recent introduction of the ID3PA and the IDPA in the 112th Congress, suggest that new fashion designers who face the threat of ruin once their designs are copied may one day receive legal protection for their designs.<sup>37</sup> Being a new designer in the fashion industry generally carries a certain vulnerability, or more appropriately, helplessness.<sup>38</sup> New designers are not necessarily more vulnerable to design-copying than well-known designers; rather, new designers are helpless because they typically lack other intellectual property protections that well-known designers have, such as trademark, trade dress, or design patents.<sup>39</sup> Consequently, a new designer's lack of protection makes her or him considerably more vulnerable to complete ruin when her or his design is copied.<sup>40</sup> Without intellectual property protection, new fashion designers may become dissuaded from participating in the innovation and creation of fashion that can inspire the bigger fashion houses in innovation and creation of new fashion trends.<sup>41</sup> Therefore, a bill to provide copyright protection for the new fashion designer must be adopted because lack of copyright protection impacts the fashion industry as a whole. Without such protection, perhaps the parasite will kill its host after all.<sup>42</sup>

This Comment argues that Congress should adopt legislation that affords copyright protection to new fashion designers. The present state of the intellectual property regime leaves a new designer without any legal protection against blatant copying and can easily result in the designer's business demise. Part I of this Comment provides a brief background of copyright law, as well as other doctrines of intellectual

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*Protection and Piracy Prevention Act*, INTELL. PROP. LITIG. (Spring 2011), available at [www.brinkshofer.com/files/fashion\\_designshimadaaba\\_ip\\_newsletterspring2011.pdf](http://www.brinkshofer.com/files/fashion_designshimadaaba_ip_newsletterspring2011.pdf).

<sup>36</sup> GOVTRACK.US S. 3728, *supra* note 35.

<sup>37</sup> See generally *Hearing on H.R. 2511* *supra* note 1, at 91 (statement of Kurt Courtney, Manager, Government Relations, American Apparel & Footwear Association) (dismissing misconceptions that surrounded prior proposed legislation to afford copyright protection to fashion design).

<sup>38</sup> See *id.* at 4-5 (statement of Lazaro Hernandez, designer and cofounder of Proenza Schouler).

<sup>39</sup> See *id.*

<sup>40</sup> C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1153 (2009).

<sup>41</sup> *Design Law Hearing*, *supra* note 16, at 56 (statement of Narciso Rodriguez, Designer, on behalf of the Council of Fashion Designers of America).

<sup>42</sup> See Raustiala & Sprigman, *The Piracy Paradox Revisited*, *supra* note 14, at 1209.

property law, and the limited protection these doctrines provide for fashion designs. Part I also explains how the limited protections afforded to fashion designs vis-à-vis intellectual property law are rarely, if ever, applicable to the new designer. Part II provides a more thorough history of the predecessor bills discussed above, including the recent ID3PA and IDPA, and explains why the IDPA ignores the needs of the new fashion designer. Part III claims that common arguments by those against the adoption of the ID3PA and future proposed legislation, including increased and frivolous litigation, are unwarranted. Ultimately, the enactment of the ID3PA or similar legislation would ensure a level playing field for new designers and the possibility that they too can realize the American Dream.

#### I. THE LIMITED PROTECTION OF FASHION DESIGN UNDER THE PRESENT INTELLECTUAL PROPERTY REGIME

Utility guides what may or may not be afforded intellectual property protection. Copyright and trademark laws prevent protection to anything “useful,” while patent law endorses utility so long as the thing to be patented is novel and nonobvious. The problem with clothing is that it is useful,<sup>43</sup> yet clothing is rarely seen as novel or nonobvious. We see clothing as a necessity—there are only so many different ways in which a person can design a shirt, a dress, or pair of slacks. While some fashion designers, primarily well-known fashion houses, rely on particular aspects of intellectual property for legal protection, such as trademark and trade dress, and to a certain extent design patents, new designers generally cannot find the same relief.<sup>44</sup>

#### A. COPYRIGHT

The Constitution empowers Congress to establish copyrights in order 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>45</sup> Due to the broad constitutional authorization handed to Congress in establishing copyrights, federal copyright law is “purely statutory,”<sup>46</sup> codified in Title 17 of the United

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<sup>43</sup> *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (citing *Fashion Originators Guild of Am., Inc. v. FTC*, 114 F.2d 80, 84 (2d Cir. 1940) (L. Hand, J.), *aff’d*, 321 U.S. 457 (1941)).

<sup>44</sup> *Hearing on H.R. 2511, supra* note 1, at 4-5 (statement of Lazaro Hernandez, designer and cofounder of Proenza Schouler).

<sup>45</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>46</sup> WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 1:1 (2011).



States Code.<sup>47</sup> Congress enacted the most current version of the Copyright Act in 1976, and it is the main source of copyright law today.<sup>48</sup> The Copyright Act defines “works of authorship” that are protected by copyright as literary works, musical works, dramatic works, pantomimes and choreographic works, pictorial, graphic, and sculptural works, motion pictures and other audiovisual works, sounds recordings, and architectural works.<sup>49</sup> To qualify as a “work of authorship” and therefore warrant copyright protection, a work must fall into one of the foregoing categories.<sup>50</sup> Congress further delineated these categories by explaining that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”<sup>51</sup> Fashion design does not fit neatly into any of the enumerated categories and could arguably be considered an “idea” or a “concept.”<sup>52</sup> Nevertheless, the true threat to fashion design is the Copyright Act’s disapproval of “useful articles.”<sup>53</sup>

In enacting the Copyright Act of 1976, Congress determined that a useful article—for the purposes of this Comment, fashion design and the garment itself—could fall under the category of “pictorial, graphic, and sculptural works”:

“Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall 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

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<sup>47</sup> See 17 U.S.C.A. § 101 et seq. (Westlaw 2012).

<sup>48</sup> Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat 2541 (1976) (codified as amended at 17 U.S.C. § 101 et seq.).

<sup>49</sup> 17 U.S.C.A. § 102(a) (Westlaw 2012).

<sup>50</sup> *Id.*

<sup>51</sup> 17 U.S.C.A. § 102(b) (Westlaw 2012).

<sup>52</sup> See generally *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452 (2d Cir. 1989).

<sup>53</sup> See *id.* at 455.

capable of existing independently of, the utilitarian aspects of the article.<sup>54</sup>

However, relevant case law and recent legal debate on the issue have revealed that it is highly unlikely that the fashion design seeking copyright can truly be identified as conceptually separate from its utilitarian aspects as an article of clothing, and therefore it cannot be afforded copyright protection.<sup>55</sup> Although one court recently stated, “Painting and fashion design stem from related creative stock, and thus share many central features,”<sup>56</sup> ultimately the law is clear regarding clothing: copyright does not protect fashion design. In *Whimsicality, Inc. v. Rubie’s Costume Co.*, the Second Circuit concluded, “Clothes are particularly unlikely to meet [conceptual separability]—the very decorative elements that stand out being *intrinsic* to the decorative function of the clothing.”<sup>57</sup> John W. Hazard, Jr., explains, “The idea that clothing might be copyrighted . . . suffers from the *strict rule* established” under *Whimsicality*.<sup>58</sup>

This does not mean fashion designers have sat idly by prior to the recent introduction of bills to afford copyright protection to fashion design. Raustiala and Sprigman suggest that fashion designers have participated in “the copying free-for-all” the past six decades while making meager proposals for expanded legal protection.<sup>59</sup> However, Louis Altman and Malla Pollack shed light on a history in which fashion designers and manufacturers of apparel played a role in proposing several bills to protect fashion design before Congress, with a few achieving modest success.<sup>60</sup> For example, in 1963 the Senate passed S.

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<sup>54</sup> 17 U.S.C.A. § 101 (Westlaw 2013); see Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified as amended at 17 U.S.C. § 101 et seq.).

<sup>55</sup> LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 4:62 (4th ed. 2011).

<sup>56</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 452 (S.D.N.Y. 2011), *aff’d in part, rev’d in part sub nom. Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012). Though this case dealt with whether a fashion designer registered a valid trademark under the Lanham Act, the court’s comparison of fashion and art nonetheless may apply to an analysis of what “works of authorship” fall under copyright protection.

<sup>57</sup> *Whimsicality*, 891 F.2d at 455 (2d Cir. 1989) (emphasis added) (citing Fashion Originators Guild of Am., Inc. v. FTC, 114 F.2d 80, 84 (2d Cir. 1940) (L. Hand, J.), *aff’d*, 321 U.S. 457 (1941)). For a more detailed discussion of the problem with conceptual separatism and fashion design, see Lisa J. Hedrick, Note, *Tearing Fashion Design Protection Apart at the Seams*, 65 WASH. & LEE L. REV. 215, 229 (2008).

<sup>58</sup> HAZARD, *supra* note 22, at § 2:37.

<sup>59</sup> Raustiala & Sprigman, *The Piracy Paradox*, *supra* note 14, at 1698-99.

<sup>60</sup> ALTMAN & POLLACK, *supra* note 55, at § 4:62, fn. 22; see Emma Yao Xiao, Note, *The New Trend: Protecting American Fashion Designs Through National Copyright Measures*, 28

776, a bill that afforded copyright protection to fashion designs.<sup>61</sup> The bill did not reach a vote in the House and died in the House Judiciary Committee.<sup>62</sup> Also, the proposed Copyright Act of 1976 incorporated a chapter on design protection.<sup>63</sup> However, shortly before final passage, the chapter was excluded prior to the Copyright Act becoming law.<sup>64</sup> That chapter was later reintroduced but did not pass.<sup>65</sup>

Under the Copyright Act, design protection occurs gradually, protecting only specified designs. Congress has either amended the Copyright Act itself to define a particular “useful article” as a “work of authorship,” as in the case of architectural design, or has added chapters to Title 17 to prescribe *sui generis* form of protection for specific industry designs, such as vessel hulls and semiconductor chips.<sup>66</sup> *Sui generis* protection is “absolutely distinct from the rest of the Copyright Act”<sup>67</sup> and defines in detail the protection afforded and remedies available.<sup>68</sup> Notably, when Congress enacted the Vessel Hull Design Protection Act (VHDPA) in 1998, a *sui generis* form of industrial design protection, Congress elected to name the added chapter under Title 17 “Designs Protected.”<sup>69</sup> At the moment, “Designs Protected” covers only vessel hull designs, but recent proposed legislation to afford copyright protection to fashion design sought to amend “Designs Protected” by including fashion design.<sup>70</sup> It is likely Congress will once more

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CARDOZO ARTS & ENT. L.J. 417, 432 (“Since 1914, Congress has considered more than seventy bills that would provide copyright protection to fashion design, but none have been successful.”).

<sup>61</sup> ALTMAN & POLLACK, *supra* note 55, at § 4:62, fn. 22.

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> *Id.*

<sup>66</sup> THE VESSEL HULL DESIGN PROTECTION ACT: OVERVIEW AND ANALYSIS 1 (Nov. 2003) [www.copyright.gov/reports/vhdpa-report.pdf](http://www.copyright.gov/reports/vhdpa-report.pdf); see Raustiala & Sprigman, *The Piracy Paradox*, *supra* note 14, at 1749-54 (discussing the expansion of copyright protection since the enactment of the Copyright Act of 1976 for architectural design, semiconductors and boat hulls); BLACK’S LAW DICTIONARY (9th ed. 2009) defines “*sui generis*” as “[o]f its own kind or class; unique or peculiar,” and says “[t]he term is used in intellectual-property law to describe a regime designed to protect rights that fall outside the traditional patent, trademark, copyright, and trade-secret doctrines. For example, a database may not be protected by copyright law if its content is not original, but it could be protected by a *sui generis* statute designed for that purpose.”

<sup>67</sup> David Nimmer, *Codifying Copyright Comprehensibly*, 51 UCLA L. REV. 1233, 1328 (2004); see also *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1521 (9th Cir. 1992) (discussing the legislative history of the Semiconductor Chip Protection Act, a form of *sui generis* design protection, and explaining that Congress adopted a separate statute in order to afford copyright protection for semiconductor chips rather than amend the Copyright Act, because semiconductor chips are “inherently utilitarian articles” and thus not protected under traditional copyright law).

<sup>68</sup> See 17 U.S.C.A. §§ 1301-1332 (Westlaw 2012).

<sup>69</sup> *Id.*

<sup>70</sup> Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011).

introduce legislation, which again will seek to amend “Designs Protected” in order to extend copyright protection to fashion design.

## B. TRADEMARK & TRADE DRESS

Many well-known fashion designers utilize trademark law in order to directly protect their products and, indirectly, the designs themselves.<sup>71</sup> Federal trademark law is governed by the Lanham Act.<sup>72</sup> The Lanham Act defines subject matter eligible for trademark as “any word, name, symbol, or device, or any combination thereof used by a person.”<sup>73</sup> The purpose of trademark is “to identify and distinguish . . . goods, including a unique product, from those manufactured and sold by others and to indicate the source of the goods, even if that source is unknown.”<sup>74</sup> A limitation, however, is that the purported trademark may not be utilitarian or aesthetically functional.<sup>75</sup>

In fashion, trademark use is generally the placement of a mark that is distinctive, arbitrary, and non-functional on the three-dimensional work itself,<sup>76</sup> such as the popular Louis Vuitton “LV” logo, which is printed consistently on its bags.<sup>77</sup> Recently, the Second Circuit determined a color can be a trademark in the realm of fashion design if the color has acquired secondary meaning and would not be barred by the doctrine of aesthetic functionality.<sup>78</sup> In *Christian Louboutin S.A. v. Yves Saint Laurent American Holdings, Inc.*, the court found the red sole of Louboutin’s shoes acted as a trademark so long as the red sole had acquired secondary meaning, which “occurs when, ‘in the minds of the

<sup>71</sup> Kevin V. Tu, *Counterfeit Fashion: The Interplay Between Copyright and Trademark Law in Original Fashion Designs and Designer Knockoffs*, 18 TEX. INTELL. PROP. L.J. 419, 430-32 (2010).

<sup>72</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 450 (S.D.N.Y. 2011), *aff’d in part, rev’d in part sub nom.* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012).

<sup>73</sup> 15 U.S.C.A. § 1127 (Westlaw 2012).

<sup>74</sup> *Id.*

<sup>75</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 219 (2d Cir. 2012) (“[T]wo forms of the functionality doctrine are relevant to us today: ‘traditional’ or ‘utilitarian’ functionality, and ‘aesthetic’ functionality. Both forms serve as an affirmative defense to a trademark infringement claim.”).

<sup>76</sup> *Id.* at 222 (“On the one hand, where an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs, the aesthetic functionality doctrine denies such protection. But on the other hand, distinctive and arbitrary arrangements of predominantly ornamental features that do *not* hinder potential competitors from entering the same market with differently dressed versions of the product are non-functional, and are hence eligible for trademark protection.” (internal quotation marks, brackets, and citations omitted)).

<sup>77</sup> *See Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108 (2d Cir. 2006).

<sup>78</sup> *See Christian Louboutin*, 696 F.3d at 206.

public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.”<sup>79</sup> The court further found the red sole, in limited use, had no utilitarian function, nor was it aesthetically functional, and was protectable because “the aesthetic design of [the] product is *itself* the mark for which protection is sought,” and providing the mark-holder exclusive use would not “put competitors at a significant non-reputation-related disadvantage.”<sup>80</sup> In *Louboutin*, the court concluded that Louboutin’s registered red sole mark was a valid trademark when placed in contrast to the upper part of the shoe, but when used monochromatically—where the sole and upper part of the shoe are the same color—the court found Louboutin failed to show sufficient secondary meaning.<sup>81</sup>

Another means of intellectual property protection for fashion designers is trade dress, by which the three-dimensional work alone has acquired secondary meaning.<sup>82</sup> Trade dress, as with trademark, does not protect the design itself, but rather protects the overall appearance that functions as a source-indicator in order to prevent consumer confusion.<sup>83</sup> For example, Harvard Law Professor Jeannie Suk explains “the Burberry plaid design is legally protected because it identifies Burberry, while the design of a dress the plaid may adorn is not, no matter how artful or original.”<sup>84</sup> Moreover, purse manufacturers have found protection under trade dress when “the product’s appearance has acquired secondary meaning . . . [such] that purchasers are likely to confuse the imitating goods with the originals.”<sup>85</sup> However, it is unlikely that a new designer entering the fashion industry can overcome secondary meaning when seeking either trademark or trade dress protection since she or he is new to the industry and attempting to make her or his design known.<sup>86</sup>

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<sup>79</sup> *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211 (2000) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)).

<sup>80</sup> *Christian Louboutin*, 696 F.3d at 219-20 (internal quotation marks and citations omitted).

<sup>81</sup> *Id.* at 224-28; see also Theodore C. Max, *Coloring Outside the Lines in the Name of Aesthetic Functionality: Qualitex, Louboutin, and How the Second Circuit Saved Color Marks for Fashion*, 102 TRADEMARK REP. 1081 (2012).

<sup>82</sup> Jeannie Suk, *Little Red (Litigious) Shoes*, N.Y. TIMES, Jan. 22, 2012, at SR14, available at [www.nytimes.com/2012/01/22/opinion/sunday/louboutin-and-the-little-red-litigious-shoes.html?\\_r=1](http://www.nytimes.com/2012/01/22/opinion/sunday/louboutin-and-the-little-red-litigious-shoes.html?_r=1); see *Wal-Mart Stores*, 529 U.S. at 216.

<sup>83</sup> *Wal-Mart Stores*, 529 U.S. at 209-10.

<sup>84</sup> Suk, *supra* note 82.

<sup>85</sup> *Coach Leatherware Co., Inc. v. AnnTaylor, Inc.*, 933 F.2d 162, 168 (2d Cir 1991).

<sup>86</sup> *Hearing on H.R. 2511*, *supra* note 1, at 14 (statement of Jeannie Suk, Professor of Law, Harvard Law School) (“Emerging designers do not have the advantages [of trademark law] . . . Their products are not well enough recognized to qualify for trademark or trade dress protection, nor do they have the money to advertise and reinforce their brand image.”).

Moreover, as in copyright law, fashion designs (or portions of designs) are not protectable under trademark or trade dress because they are generally seen as functional.<sup>87</sup> The Supreme Court in *Qualitex Co. v. Jacobson Products Co.* explained, “If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained.”<sup>88</sup> For this reason, it is doubtful any article of clothing—although it might be known to the common consumer that it comes from a particular fashion designer—would be able to acquire trademark or trade dress protection unless there is something more to the appearance than what is deemed functional.<sup>89</sup>

### C. PATENTS

Patent law, unlike copyright and trademark laws, provides protection for a “useful article” as long as it is novel and nonobvious.<sup>90</sup> Fashion designers may find protection by obtaining either utility patents or design patents.<sup>91</sup> The main distinction between utility and design patents is that utility patents protect new and useful articles, while design patents protect “new, original, and ornamental design for an article of manufacture.”<sup>92</sup> Moreover, the design cannot be “dictated solely by considerations of function.”<sup>93</sup> In order to acquire a valid patent under either category, the fashion designer must show the design is novel and nonobvious.<sup>94</sup> However, overcoming the nonobvious requirement can be extremely difficult, for the new and the well-known fashion designer alike.

In determining nonobviousness for an article of clothing, a court applies a test to determine “whether the design would be obvious to a skilled dressmaker ‘who has, or is chargeable with, knowledge of the

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<sup>87</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011), *aff’d in part, rev’d in part sub nom.* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012).

<sup>88</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65 (1995).

<sup>89</sup> *Christian Louboutin*, 778 F. Supp. 2d 445 (explaining that although the court found the red sole of the Louboutin Shoe to have secondary meaning, ultimately the court could not separate the functionality from the sole itself).

<sup>90</sup> Anne Theodore Briggs, *Hung Out To Dry: Clothing Design Protection Pitfalls in United States Law*, 24 HASTINGS COMM. & ENT. L.J. 169, 171 (2002).

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

<sup>92</sup> *Patents*, USPTO.GOV, [www.uspto.gov/patents/index.jsp](http://www.uspto.gov/patents/index.jsp) (last modified Jan. 26, 2012).

<sup>93</sup> Briggs, *supra* note 90, at 172, 176.

<sup>94</sup> There are different eligibility requirements for utility patents and design patents, but originality, novelty, and nonobviousness apply to both. For the purpose of this Comment, it is unnecessary to go in depth into patents. For a more detailed analysis, see Briggs, *supra* note 90, at 172, 175.

prior art.”<sup>95</sup> If the fashion design is “new and pleasing enough to catch the trade, but [does] not reflect such exceptional talent beyond the skill of the ordinary designer” who is familiar with the prior art, a court will determine that the design does not merit design patent protection.<sup>96</sup> As Anne Theodore Briggs explains, “[T]he nonobviousness standard is so demanding that even new clothing designs that do not incorporate any known design elements can still fail to qualify for design patent protection.”<sup>97</sup>

Nevertheless, assuming a new designer may overcome the demanding requirements of patent eligibility, the process of registering also hinders the fashion designer. Acquiring a valid patent requires time and money, which is arguably a significant barrier in obtaining patent protection for fashion designs.<sup>98</sup> As of December 2012, the patent registration process ranges from 19.6 months for the First Office Action Pendency—from the date of filing an application to the date of first action by the United States Patent and Trademark Office (USPTO)—and the total pendency in registering a patent is an average of 31.7 months.<sup>99</sup> Given the short span of a fashion season, trend, or fad, the designer will not obtain a patent until after the lifespan of the design itself.<sup>100</sup> USPTO’s goal is to reduce these times to an average of twenty months for total pendency by 2015.<sup>101</sup> However, a waiting period of twenty months is still unlikely to benefit fashion designers.<sup>102</sup>

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<sup>95</sup> Briggs, *supra* note 90, at 176 (“The judiciary developed this standard to set a very high bar for new designs.” (citing *Neufeld-Furst & Co. v. Jay-Day Frocks Inc.*, 112 F.2d 715, 716 (2d Cir. 1940) (per curiam))).

<sup>96</sup> *Vanity Fair Mills, Inc. v. Olga Co.*, 510 F.2d 336, 340 (2d Cir. 1975) (internal quotation marks omitted); *see* *Tourneau v. Tishman & Lipp*, 119 F. Supp. 593, 596-97 (S.D.N.Y. 1953) (“It is not sufficient that the design be novel, ornamental, or pleasing to the eye. The conception of the design must require some exceptional talent beyond the range of the ordinary designer familiar with the prior art. An unstartling regrouping of old elements in a design patent which does not rise above the commonplace or demonstrate originality which is born of the inventive faculty may not be called ‘invention’ for the purposes of patent validity.” (internal quotation marks and citations omitted)).

<sup>97</sup> Briggs, *supra* note 90, at 177.

<sup>98</sup> Hedrick, *supra* note 57, at 224.

<sup>99</sup> *Compare Data Visualization Center*, USPTO.GOV, [www.uspto.gov/dashboards/patents/main.dashxml](http://www.uspto.gov/dashboards/patents/main.dashxml) (last visited Jan. 23, 2013), *with* Briggs, *supra* note 90, at 179 (stating that in 1997, the average pendency was 22.2 months).

<sup>100</sup> *See* Hemphill & Suk, *supra* note 40, at 1153 for a discussion of fashion trends and fads. *But see also* Complaint for Patent Infringement, *lululemon athletica can. Inc. v. Calvin Klein, Inc.*, 2012 WL 3292844 (D. Del. Aug. 13, 2012) (alleging Calvin Klein infringed lululemon’s design patents for yoga pants).

<sup>101</sup> *Data Visualization Center*, *supra* note 99.

<sup>102</sup> Briggs, *supra* note 90, at 179 (“With the business lifespan of the average clothing design lasting only one season (a few months to a year at most) design patent protection would come far too late to be of much value.”).

D. THE NEW FASHION DESIGNER UNDER THE CURRENT  
INTELLECTUAL PROPERTY REGIME

New fashion designers have little, if any, intellectual property protection afforded to their fashion designs. While new designers can obtain copyright or trademark protection for some elements of the design, such as copyright protection for the fabric print of the article of clothing or placing a trademark on the design itself, the actual design of the garment may nevertheless be copied by anyone or any entity, and often there is nothing the new designer can do about it.<sup>103</sup> Moreover, with the use of Internet promotion and shops,<sup>104</sup> and online marketplaces, such as Etsy.com, “the homemade marketplace,”<sup>105</sup> new designers who place their designs online can easily fall victim to copying.

An example of copying a new designer from the Internet is the story of Stevie Koerner. In May 2011, the *Huffington Post* reported that Urban Outfitters “ripped off” independent jewelry designer Stevie Koerner’s line of pendants called “A World of Love.”<sup>106</sup> Koerner sold her jewelry on Etsy.com.<sup>107</sup> She explained her “World/United States of Love” line was one of the reasons she could quit her full-time job and become an entrepreneur.<sup>108</sup> She was devastated upon seeing pendants similar to hers at Urban Outfitters: “My heart sank a little bit . . . They even stole the item name as well as some of my copy.”<sup>109</sup> Each pendant resembled a state with a small heart cut out of the pendant.<sup>110</sup> The name of each state pendant is “I Heart [state name].”<sup>111</sup> Urban Outfitters called its

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<sup>103</sup> A new designer can copyright the fabric print, but not the design of the garment; and of course, the new designer may find trademark protection in any “mark” that identifies the designer. See *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841 (9th Cir. 2012); see also *Dolori Fabrics, Inc. v. Limited, Inc.*, 662 F. Supp. 1347 (S.D.N.Y. 1987).

<sup>104</sup> See [www.shopbop.com](http://www.shopbop.com), [www.bluefly.com](http://www.bluefly.com), and [www.revolveclothing.com](http://www.revolveclothing.com), which are just a few online clothing shops that sell a number of well-known and new fashion designers’ garments.

<sup>105</sup> ETSY, [www.etsy.com](http://www.etsy.com) (last visited Nov. 3, 2011). The creators explain in its mission statement: “Etsy is the world’s handmade marketplace. Our mission is to empower people to change the way the global economy works. We see a world in which very-very small businesses have much-much more sway in shaping the economy, local living economies are thriving everywhere, and people value authorship and provenance as much as price and convenience. We are bringing heart to commerce and making the world more fair, more sustainable, and more fun.” *Id.*

<sup>106</sup> Linkins, *supra* note 13.

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

<sup>108</sup> *Id.*; see Laura C. Marshall, Note, *Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act*, 14 J. INTEL. PROP. L. 305, 324 (2007) (discussing why intellectual property is appropriate in safeguarding entrepreneurs).

<sup>109</sup> Linkins, *supra* note 13.

<sup>110</sup> *Id.*

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



jewelry line “I Heart Destination Necklaces.”<sup>112</sup> Urban Outfitters’s advertising copy, “Wear your locale love,” closely resembles Koerner’s copy, “Wear your love.”<sup>113</sup>

The *Huffington Post* report cited other accounts that Urban Outfitters copied jewelry designs from new fashion designers and noted that such accusations began as early as 2006.<sup>114</sup> Nevertheless, Urban Outfitters responded that a search on Etsy.com revealed numerous online shops selling similar “state necklaces” and that they were “not implying Koerner stole her necklace idea from one of these other designers,” but that they were “simply stating the obvious—that the idea is not unique to Koerner and she can in no way claim to be its originator.”<sup>115</sup> Moreover, Urban Outfitters asserted that such negative media coverage threatens “the dozens of independent designers [they] work with on a daily basis.”<sup>116</sup> Whatever the case may be, the fact remains that numerous accusations of “fast fashion” retailers copying independent designs<sup>117</sup> represents “a huge loss to small business.”<sup>118</sup> Silvia Beltrametti explains,

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

<sup>113</sup> *Id.*

<sup>114</sup> *Id.*; Foster Kamer, *Are Brooklyn Fashion Designers Being Ripped Off by Urban Outfitters?*, VILLAGE VOICE BLOGS (May 27, 2010), [blogs.villagevoice.com/runninscared/2010/05/are\\_brooklyn\\_fa.php](http://blogs.villagevoice.com/runninscared/2010/05/are_brooklyn_fa.php).

<sup>115</sup> *Urban Outfitters Responds to False Allegations by Necklace Designer*, URBAN OUTFITTERS (May 28, 2011, 12:03 PM), [blog.urbanoutfitters.com/blog/urban\\_outfitters\\_responds\\_to\\_false\\_allegations\\_by\\_necklace\\_designer](http://blog.urbanoutfitters.com/blog/urban_outfitters_responds_to_false_allegations_by_necklace_designer).

<sup>116</sup> *Id.*

<sup>117</sup> See *Hearing on H.R. 5055*, *supra* note 18, at 78 (statement of Susan Scafidi, visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University). Scafidi gives an example of copying a new designer: “Consider the example of Ananas, a 3-year-old handbag label. Its cofounder is a young wife and mother working from home, actually here in the Washington suburbs, and she has been successful in promoting her handbags, which retail between \$200 and \$400. Earlier this year, however, she received a telephone call from a buyer canceling the wholesale order. When she asked why, she learned that the buyer had found virtually identical bags in a cheaper material at a lower price. Shortly thereafter, the same designer looked on the Internet and discovered a post on a message board from a potential customer who had seen one of her bags in a major department store, thought about buying it, but went home and on the Internet found a cheaper bag, a look-alike in lower-quality materials, which she not only bought but recommended to others.” *Id.*; see also Amy Odell, *Forever 21’s Ability To Copy Designer Clothes Could Be in Jeopardy*, N.Y. MAG. (Apr. 13, 2009, 9:45 AM), [nymag.com/daily/fashion/2009/04/forever\\_21s\\_ability\\_to\\_copy\\_de.html](http://nymag.com/daily/fashion/2009/04/forever_21s_ability_to_copy_de.html). New York Magazine labels fashion line Trovata’s status as “Newcomer.” Trovata sued “fast fashion” retailer Forever 21 for copying Trovata’s clothing. Trovata alleged Forever 21 manufactured garments that were identical, or almost identical to those designed by Trovata. *Id.*

<sup>118</sup> *Hearing on H.R. 5055*, *supra* note 18, at 78 (2006) (statement of Susan Scafidi, visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University).

“Knockoffs devalue designs to the point that wholesale orders are cancelled, and this is threatening for [new] designers especially.”<sup>119</sup>

Another threat to new designers arises when they make efforts to promote their fashion lines, as in the case of Jessica Rogers’s Puff Ball top. Of course, to a new designer, receiving a phone call from a publicist, stylist, or wholesale buyer can be a big deal. It may be the start of getting a new designer’s name and garment out in public. However, if the new designer sends samples, or sells a unit to a publicist, stylist, or wholesale buyer, those persons can easily copy the new designer’s creation.<sup>120</sup> Jessica Rogers claimed she had been contacted by Nicki Minaj’s stylist, who copied her “Puff Ball” design and described her top as a “‘Puff Ball’ top,”<sup>121</sup> giving Rogers no credit.<sup>122</sup> Minaj’s image consultant, on the other hand, asserted that Rogers’s allegation is untrue, and that Minaj never contacted the designer.<sup>123</sup>

These stories illustrate the shortfalls of our intellectual property regime in protecting a new designer’s interests.<sup>124</sup> In both examples, fashion blog wars ignited over whether there was intentional copying. Urban Outfitters claimed that they did not copy Koerner, and that the necklaces merely follow a trend.<sup>125</sup> Minaj claimed there was never any contact between her and Rogers and that Rogers “just wants attention.”<sup>126</sup> Of course, those claims could be true. And of course, the allegedly infringing designers may very well have independently created the contested designs. But with no legal protection, these new designers are left without recourse; they cannot initiate suits to determine the rights of the parties. Instead, they are left with “what ifs” and, perhaps on a

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<sup>119</sup> 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, 163 (2010) (footnote omitted).

<sup>120</sup> See *Hearing on H.R. 2511*, *supra* note 1, at 16 (statement of Jeannie Suk, Professor of Law, Harvard Law School).

<sup>121</sup> *Young Designer Claims Nicki Minaj Copied Her Designs for That Colorful Top*, *supra* note 2.

<sup>122</sup> Phelan, *supra* note 2.

<sup>123</sup> *Nicki Minaj on Copycat Rumors: That Designer Is LYING! I Don’t Even Know Her!*, THEYBF.COM (Sept. 17, 2011), [www.theybf.com/2011/09/17/nicki-minaj-on-copycat-rumors-that-designer-is-lying-i-dont-even-know-her?page=1](http://www.theybf.com/2011/09/17/nicki-minaj-on-copycat-rumors-that-designer-is-lying-i-dont-even-know-her?page=1).

<sup>124</sup> *Hearing on H.R. 5055*, *supra* note 18, at 188 (statement of Rep. Darrell Issa, Member, House Comm. on the Judiciary) (“I would just like to close by saying that in fact we protect individuals, not some industry and we are here today to talk about individuals protected under the Constitution.”).

<sup>125</sup> *Urban Outfitters Responds to False Allegations by Necklace Designer*, *supra* note 115; see also Kamer, *supra* note 114.

<sup>126</sup> *Nicki Minaj Accused of Copying Fashion Designer Styles*, URBAN HOT RADIO (Sept. 23, 2011), [www.urbanhotradio.com/2011/09/23/nicki-minaj-accused-of-copying-fashion-designers-styles/](http://www.urbanhotradio.com/2011/09/23/nicki-minaj-accused-of-copying-fashion-designers-styles/).

positive note, publicity now that their names and garments have received attention, albeit due to allegations of someone copying their designs. Nevertheless, a court is in the best position to determine the legal rights of the parties and what remedies, if any, should be afforded.

## II. HISTORY OF PROPOSED LEGISLATION TO AFFORD COPYRIGHT PROTECTION TO FASHION DESIGN

Congress has introduced seven bills in the last six years proposing to extend copyright protection to fashion design.<sup>127</sup> Although the bills did not pass, the history reveals a steady growth in support among members in Congress and in the fashion industry, as well as lively political debate that has guided the drafters of later bills in accommodating advocates and opponents alike.<sup>128</sup> Accordingly, the recent bills are more focused in protecting fashion designers while minimizing the claimed ramifications of enacting such laws.

### A. H.R. 5055, DESIGN PIRACY PROHIBITION ACTS, AND THE FIRST INNOVATIVE DESIGN PROTECTION AND PIRACY PREVENTION ACT

In proposing the first bill, “A Bill to Provide Protection for Fashion Design,” Representative Goodlatte recognized that existing intellectual property protections fall short of protecting the fashion designer, especially in light of the Internet: “[O]nce a design is made public, pirates can now virtually immediately offer an identical knockoff piece on the Internet for distribution.”<sup>129</sup> This is troublesome for the new fashion designer because much of her or his promotion is through the Internet.<sup>130</sup> The weakness of this bill, however, was that its language was broad, it did not define infringement in the case of fashion, and it required registration in order to obtain protection.<sup>131</sup> The registration

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<sup>127</sup> A Bill To Provide Protection for Fashion Design, H.R. 5055, 109th Cong. (2006); Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007); S. 1957, 110th Cong. (2007); H.R. 2196, 111th Cong. (2009); Innovative Design Protection and Piracy Prevention Act, S. 3728, 111th Cong. (2010); Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011); Innovative Design Protection Act of 2012, S. 3523, 112th Congress (2012).

<sup>128</sup> See *infra* Subparts A, B.

<sup>129</sup> See *Hearing on H.R. 5055, supra* note 18, at 4 (statement of Rep. Bob Goodlatte).

<sup>130</sup> See *supra* Part I.D.

<sup>131</sup> *Hearing on H.R. 5055, supra* note 18, at 2 (statement the Honorable Lamar Smith, Chairman of the Subcommittee on Courts, the Internet, and Intellectual Property) (“Others have expressed concerns that the legislation is too broad and would prohibit the ability of designers and retailers to replicate current trends and styles, something on which the fashion industry thrives.”); *id.* at 87 (prepared statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (“We fear that a primary effect of H.R. 5055 will be extensive and costly litigation

requirement was particularly problematic because the bill would have “require[d] the Register of Copyrights to determine whether or not the application relates to a design which on its face appears to be within the subject matter protected as original designs.”<sup>132</sup> The bill never came to a vote in either house,<sup>133</sup> but its introduction nonetheless started the ongoing debate over whether fashion design should be protected.

The three bills introduced in the following three years were titled the Design Piracy Prohibition Act (DPPA).<sup>134</sup> These bills were virtually identical to the prior bill, with the exception that they defined infringement.<sup>135</sup> Again, the bills were problematic because of their breadth and their requirement of registration.<sup>136</sup> An additional concern was that the DPPA would permit infringement claims for designs that were “substantially similar” to the copyrighted design.<sup>137</sup> Consequently, the bills never made it out of committee. This is partially due to the ongoing legal and political debates over whether fashion design should be afforded copyright protection, and partially due to the fact that fashion industry organizations were themselves divided as to whether the DPPA was the proper path to affording copyright protection to fashion design.<sup>138</sup>

With the introduction of the first ID3PA in 2010, major players within the fashion industry, namely Council of Fashion Designers of America and American Apparel and Footwear Association, who were at odds over the DPPA, came together to support the ID3PA.<sup>139</sup> The ID3PA was considerably different from its predecessors. First, it would

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over what constitutes infringement. As such, H.R. 5055 is a lawyer-employment bill, not a fashion-industry protection bill.”).

<sup>132</sup> CONG. RESEARCH SERV., SUMMARY, H.R. 5055, 109th Cong. (2006), available at [www.thomas.loc.gov/cgi-bin/bdquery/z?d109:HR05055:@@D&summ2=m&](http://www.thomas.loc.gov/cgi-bin/bdquery/z?d109:HR05055:@@D&summ2=m&).

<sup>133</sup> Xiao, *supra* note 60, at 433.

<sup>134</sup> Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007); S. 1957, 110th Cong. (2007); H.R. 2196, 111th Cong. (2009).

<sup>135</sup> *Id.*

<sup>136</sup> Arielle K. Cohen, *Designer Collaborations as a Solution to the Fast-Fashion Copyright Dilemma*, 11 CHI.-KENT. J. INTELL. PROP. 172, 172 (2012) (“A number of versions of the Design Piracy Prohibition Act (DPPA) have entered Congress and none have passed, largely due to some controversial provisions that were contained therein such as the registration requirement which would require designers to register their designs in order to receive protection.”).

<sup>137</sup> See, e.g., Raustiala & Sprigman, *The Piracy Paradox Revisited*, *supra* note 14, at 1217-20.

<sup>138</sup> E.g., *Design Law Hearing*, *supra* note 16, at 61-62; see generally *Hearing on H.R. 5055*, *supra* note 18.

<sup>139</sup> *Hearing on H.R. 2511*, *supra* note 1, at 91 (statement of Kurt Courtney, Manager, Government Relations, American Apparel & Footwear Association) (explaining that the AAFA “fundamentally disagreed with [prior bills to afford copyright to fashion design] overly broad definitions,” but is now working in conjunction with the CFDA in developing a more targeted bill in the ID3PA).

not have required registration to obtain protection; instead, a fashion design would have been protected as soon as it was first made public.<sup>140</sup> Second, the bill defined an infringing article as “substantially identical,”<sup>141</sup> rather than “substantially similar.”<sup>142</sup> The bill also included a home-sewing exception, which would have permitted an individual to produce a single copy of a protected garment for her or his own use or for that of an immediate family member.<sup>143</sup> The ID3PA had more success than its predecessors, advancing to the Senate floor after being passed unanimously by the Senate Judiciary Committee.<sup>144</sup> Again, the bill never came to a vote.<sup>145</sup> Nevertheless, the relative success of the first ID3PA demonstrates the growing strength of the bill and the prospect of success in the future.

B. THE NEW INNOVATIVE DESIGN PROTECTION AND PIRACY PREVENTION ACT AND THE INNOVATIVE DESIGN PROTECTION ACT OF 2012

The 112th Congress proposed two separate bills that would afford copyright protection to fashion design.<sup>146</sup> In 2011, the House of Representatives introduced the ID3PA, a replica of the first ID3PA introduced in the prior term.<sup>147</sup> The Senate introduced the IDPA in 2012, a bill with much of the same language as the ID3PA, but with added limitations on the commencement of an action against an alleged infringer.<sup>148</sup> At the conclusion of the 112th Congress, both bills failed to come to a vote; the ID3PA died in committee, while the IDPA died on the Senate floor, though it was reported favorably and without amendment by the Senate Judiciary Committee within ten days of receiving the bill.<sup>149</sup>

Both the ID3PA and IDPA would have afforded copyright protection for a period of three years once a fashion design was made public.<sup>150</sup> Fashion design would have been defined “as a whole of an

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<sup>140</sup> Innovative Design Protection and Piracy Prevention Act, S. 3728, 111th Cong. § 2(e) (2010).

<sup>141</sup> *See, e.g.*, Design Piracy Prohibition Act, H.R. 2196, 111th Cong. § 2(e) (2009).

<sup>142</sup> S. 3728 § 2(e).

<sup>143</sup> S. 3728 § 2(i).

<sup>144</sup> GOVTRACK.US S. 3728, *supra* note 35.

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

<sup>146</sup> Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011); Innovative Design Protection Act of 2012, S. 3523, 112th Congress (2012).

<sup>147</sup> H.R. 2511.

<sup>148</sup> S. 3523.

<sup>149</sup> GOVTRACK.US H.R. 2511, *supra* note 29; GOVTRACK.US S. 3523, *supra* note 29.

<sup>150</sup> H.R. 2511 § 2(d); S. 3523 § 2(d).

article of apparel, including its ornamentation,”<sup>151</sup> which “includes original elements of the article of apparel or the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel that . . . are the result of a designer’s own creative endeavor”<sup>152</sup> and “provide a unique, distinguishable non-trivial and non-utilitarian variation over prior designs for similar types of articles.”<sup>153</sup> To sue for infringement, a plaintiff would be required to plead with particularity facts showing that the infringing article is “substantially identical in *overall* visual appearance,” and that the article is not the alleged infringer’s “independent creation.”<sup>154</sup>

The IDPA, in contrast to the ID3PA, would provide additional limitations on copyright protections for fashion designers.<sup>155</sup> The purported copyright holder would be required to provide written notification to the alleged infringer at least twenty-one days before commencing legal action.<sup>156</sup> The twenty-one-day notification period, by itself, would not hinder new fashion designers from bringing suit. What would hinder a new fashion designer from vindicating her or his rights is the IDPA’s limitation on damages. The IDPA provides that “[a] person alleged to be undertaking action leading to infringement . . . *shall be held liable only for damages and profits accrued after the date on which the action for infringement is commenced against such person.*”<sup>157</sup> Senator Schumer explained that these limitations were added in response to fashion organizations’ and congressional members’ fear of frivolous litigation.<sup>158</sup> Four members of the Senate Judiciary Committee felt the bill did not do enough to limit litigation, and they proposed to amend the IDPA to include a “loser pays” provision that would require the losing party to pay the prevailing party’s reasonable attorneys’ fees.<sup>159</sup> However, as explained below, a fee-shifting statute is already in place,<sup>160</sup> which will sufficiently deter frivolous litigation. Thus, the IDPA’s added limitations would only hurt new fashion designers who cannot seek relief for the damage already done prior to the notice period. If the alleged infringer ceases her or his conduct, there is no longer a cause of action.

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<sup>151</sup> H.R. 2511 § 2(a)(2)(B); S. 3523 § 2(a)(2)(B).

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

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

<sup>154</sup> *Id.* (emphasis added).

<sup>155</sup> See S. 3523 § 2(e).

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

<sup>157</sup> *Id.* (emphasis added).

<sup>158</sup> *Executive Business Meeting, supra* note 28.

<sup>159</sup> S. REP. NO. 112-259, at 10-11 (2012), available at 2012 WL 6725915 (Westlaw).

<sup>160</sup> 17 U.S.C.A. § 1323(d) (Westlaw 2012).

As Senator Dianne Feinstein put it, the bill protects “couture design.”<sup>161</sup> And while the bill protects one aspect of fashion, it easily ignores the needs of new fashion designers.

### III. THE ID3PA IS BETTER SUITED TO MEET THE NEEDS OF NEW DESIGNERS AND WILL NOT INCREASE LITIGATION DUE TO A FEE-SHIFTING STATUTE

Adopting the ID3PA would remedy the potential threat of loss to the small businesses of new fashion designers, as well as better define new fashion designers’ legal rights. The ID3PA provides legal protection and thus the ability to engage in legal action.<sup>162</sup> For new designers who may lack funds to pursue legal action, Harvard Law Professor Jeanne Suk suggests law firms undertake cases on a contingent-fee basis, because “nothing in the [ID3PA] prohibits contingent fee arrangements.”<sup>163</sup> Chapter 13 of the Copyright Act, “Protection of Original Designs,” also provides reasonable attorneys’ fees in the court’s discretion as a remedy for infringement.<sup>164</sup> At the very least, adopting legislation like the ID3PA would provide new designers some legal recourse because protection exists at the time the fashion design is first made public.<sup>165</sup> Opponents of the ID3PA and proposed legislation affording copyright protection to fashion designs contend that such legislation will result in a flood of litigation.<sup>166</sup> This contention is based on speculation, with no persuasive supporting data.<sup>167</sup>

Opponents argue that enactment would bring more, if not frivolous, litigation “simply because [the United States is] a more litigious society.”<sup>168</sup> When the ID3PA was being considered in the 111th Congress, one congressional member raised concerns that the ID3PA

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<sup>161</sup> *Executive Business Meeting*, *supra* note 28.

<sup>162</sup> See Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011).

<sup>163</sup> *Hearing on H.R. 2511*, *supra* note 1, at 17 (statement of Jeannie Suk, Professor of Law, Harvard Law School).

<sup>164</sup> 17 U.S.C.A. § 1323(d) (Westlaw 2012) (“In an action for infringement under this chapter, the court may award reasonable attorney’s fees to the prevailing party.”).

<sup>165</sup> H.R. 2511 § 2(g)(1).

<sup>166</sup> See *Hearing on H.R. 2511*, *supra* note 1, at 95 (statement of Christopher Sprigman, Professor of Law, University of Virginia). *But see id.* at 17-18 (statement of Jeannie Suk, Professor of Law, Harvard Law School) (stating that the concern that adopting ID3PA may see an increase in litigation is overstated); *id.* at 91 (statement of Kurt Courtney, Manager, Government Relations, American Apparel & Footwear Association) (stating that the ID3PA was written to be “a more targeted bill” that would protect fashion designers while not increasing litigation).

<sup>167</sup> See, e.g., *id.* at 95 (statement of Christopher Sprigman, Professor of Law, University of Virginia).

<sup>168</sup> Raustiala & Sprigman, *The Piracy Paradox*, *supra* note 14, at 1743-44.

could yield “a flood of litigation” due to the absence of registration for copyright protection and possible ambiguity of the ID3PA language, namely the bill’s failure to define “substantially identical.”<sup>169</sup> Professor Suk contends that this concern is overstated because the bill calls for particularized pleading, and “substantially identical” is a high bar to overcome.<sup>170</sup> Furthermore, according to Professor Suk, there is a distinction between one who “close copies” or “line-by-line” copies another’s fashion design, which would constitute “substantially identical,” and one who is influenced by, pays homage to, or simply “remixes” or adapts another’s fashion design to create her or his own design.<sup>171</sup> While the former ultimately harms innovation within the fashion industry, because “there is no reason to reject the standard justification for intellectual property, that permissive copying reduces incentives to create,” the latter may be “valuable to fashion innovation.”<sup>172</sup> Moreover, the threat of awarding the prevailing party attorneys’ fees pursuant to § 1323(d) will halt excessive litigation.

Commentators—proponents and opponents alike—ignore the established remedies for infringement under Chapter 13 of the Copyright Act. Specifically, Chapter 13 permits attorneys’ fees to be awarded, at the court’s discretion, to the prevailing party.<sup>173</sup> This remedy is particularly important because it creates a disincentive from filing suit due to the risk of being ordered to pay costly attorneys’ fees. However, it is unclear what rule of law courts must follow in awarding fees to prevailing parties under Chapter 13, as there is little case law on the issue thus far.

Only one case has considered Chapter 13’s fee-shifting statute, 17 U.S.C. § 1323(d), since its enactment. In *Maverick Boat Co. v. American Marine Holdings, Inc.*, the district court granted attorneys’ fees to the prevailing defendants in a Vessel Hull Design Protection Act action, holding that § 1323(d) “does not require that the Court find the presence of bad faith or that the case is an exceptional one,” but that “the Court may find a party is a prevailing party where said party has been

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<sup>169</sup> *Hearing on H.R. 2511*, *supra* note 1, at 17 (statement of Jeannie Suk, Professor of Law, Harvard Law School).

<sup>170</sup> *Id.*

<sup>171</sup> Hemphill & Suk, *supra* note 40, at 1153 (“Design copying must be distinguished from other forms of relation between two designs, which may go by any number of names including inspiration, adaptation, homage, referencing, or remixing.”); *see also* *Hearing on H.R. 2511*, *supra* note 1, at 17 (statement of Jeannie Suk, Professor of Law, Harvard Law School). In *The Piracy Paradox Revisited*, Raustiala and Sprigman describe “close copying” as “line-by-line copying.” *See* Raustiala & Sprigman, *The Piracy Paradox*, *supra* note 14, at 1217.

<sup>172</sup> Hemphill & Suk, *supra* note 40, at 1153.

<sup>173</sup> 17 U.S.C.A. § 1323(d) (Westlaw 2012).



awarded by the Court relief on the merits of at least some of its claims.”<sup>174</sup> The district court suggested, however, that it had awarded fees based on plaintiff’s “careless conduct surrounding” its registered vessel hull design.<sup>175</sup>

But the district court made no mention of the fee-shifting statute under the Copyright Act, nor did the court cite the *Fogerty* standard, which guides courts in awarding attorneys’ fees under 17 U.S.C. § 505 in a copyright dispute. In *Fogerty v. Fantasy, Inc.*,<sup>176</sup> the United States Supreme Court rejected the dual standard for prevailing plaintiffs and prevailing defendants that applies under the Civil Rights Act of 1963 fee-shifting statute.<sup>177</sup> The *Fogerty* Court held that “[p]revailing plaintiffs and prevailing defendants are to be treated alike” when considering attorneys’ fees.<sup>178</sup> Yet, in *Maverick*, the Eleventh Circuit affirmed the district court’s ruling without considering the Copyright Act or *Fogerty*.<sup>179</sup> While Chapter 13 of the Copyright Act provides *sui generis* protection and is therefore separate from the rest of the Copyright Act, it makes the most sense to conclude that § 1323(d) would follow established case law under § 505.

In evaluating “prevailing party” under the Copyright Act, the Supreme Court in *Fogerty* adopted an even-handed standard: “Prevailing plaintiffs and prevailing defendants are to be treated alike.”<sup>180</sup> The Court rejected the dual standard that applies in civil-rights actions, under which a prevailing plaintiff “should ordinarily recover [attorneys’ fees] unless some special circumstances would render such an award unjust,”<sup>181</sup> while a prevailing defendant is to be awarded attorneys’ fees “upon a finding that the plaintiff’s action was frivolous, unreasonable, or without foundation, even though not brought in subjective bad faith.”<sup>182</sup> The Court noted, “‘There is no precise rule or formula for making these determinations,’ but instead *equitable discretion* should be exercised ‘in light of the considerations we have identified.’”<sup>183</sup> The Court also

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<sup>174</sup> *Maverick Boat Co. v. Am. Marine Holdings, Inc.*, Nos. 02-14102-CIV, 02-14283-CIV, 2004 WL 1093035, at \*16 (S.D. Fla. Feb. 10, 2004), *aff’d*, 418 F.3d 1186 (11th Cir. 2005).

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

<sup>176</sup> *Fogerty v. Fantasy, Inc.* 510 U.S. 517 (1994).

<sup>177</sup> 42 U.S.C.A. § 1988 (Westlaw 2012).

<sup>178</sup> *Fogerty*, 510 U.S. at 534.

<sup>179</sup> *Maverick Boat Co. v. Am. Marine Holdings, Inc.*, 418 F.3d 1186, 1192 (11th Cir. 2005).

<sup>180</sup> *Fogerty*, 510 U.S. at 534.

<sup>181</sup> *Id.* at 522-23 (citing *Newman v. Piggie Park Enters., Inc.*, 390 U.S. 400, 402 (1968) (per curiam)).

<sup>182</sup> *Id.* at 535 (Thomas, J., concurring in judgment) (citing *Christiansburg Garment Co. v. EEOC*, 434 U.S. 412, 417 (1978)).

<sup>183</sup> *Id.* at 534 (majority opinion) (quoting *Hensley v. Eckerhart*, 461 U.S. 424, 436-37 (1983)) (emphasis added).

observed a number of nonexclusive factors a court should use when considering a claim for attorneys' fees.<sup>184</sup> Such factors include "frivolousness, motivation, objective unreasonableness (both in the factual and in the legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence."<sup>185</sup>

Several circuits have refined the *Fogerty* standard, finding presumptive entitlements under certain circumstances. Circuit Judge Posner explained:

If the case was a toss-up and the prevailing party obtained generous damages, or injunctive relief of substantial monetary value, there is no urgent need to add an award of attorneys' fees. But if at the other extreme the claim or defense was frivolous and the prevailing party obtained no relief at all, the case for awarding him attorneys' fees is compelling. As we said with reference to the situation in which the prevailing plaintiff obtains only a small award of damages, "the smaller the damages, provided there is a real, and especially a willful, infringement, the stronger the case for an award of attorneys' fees . . . . [W]e go so far as to suggest, by way of refinement of the *Fogerty* standard, that the prevailing party in a copyright case in which the monetary stakes are small should have a presumptive entitlement to an award of attorneys' fees." When the prevailing party is the defendant, who by definition receives not a small award but no award, the presumption in favor of awarding fees is very strong. For without the prospect of such an award, the party might be forced into a nuisance settlement or deterred altogether from exercising his rights.<sup>186</sup>

Judge Posner further explained the justification behind the attorney fee-shifting statute under the Copyright Act: if "a meritorious claim or defense is not lucrative, an award of attorneys' fees may be necessary to enable the party possessing the meritorious claim or defense to press it to a successful conclusion rather than surrender it because the cost of vindication exceeds the private benefit to the party."<sup>187</sup> Thus, a new designer either has a lot to gain or a lot to lose in bringing suit against an alleged copyright infringer, because if the new designer brings suit and the meritorious defense is successful and the defendant is found to not have infringed, the new designer can be liable for attorneys' fees.

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<sup>184</sup> *Id.* at 534 n.19.

<sup>185</sup> *Id.* (internal quotation marks omitted).

<sup>186</sup> *Assessment Techs. of WI, LLC v. WIREdata, Inc.*, 361 F.3d 434, 436-37 (7th Cir. 2004) (citations omitted).

<sup>187</sup> *Id.* at 437.

Upon a court's determination that attorneys' fees are proper, other considerations concerning the reasonableness of the award come into play. A number of cases in the Second Circuit consider the financial strengths of the parties when deciding whether an award of attorneys' fees is reasonable.<sup>188</sup> For a court to consider denying attorneys' fees under the Copyright Act, the party claiming financial disparity must provide evidence that the party will in fact suffer financial ruin.<sup>189</sup> Hence, a new fashion designer wishing to pursue legal action against a person or entity who has infringed will have the ability to bring a claim even if the defendant has a successful defense.

The objective of the Copyright Act's attorney fee-shifting remedy "is to encourage the production of original literary, artistic, and musical expression for the good of the public."<sup>190</sup> When an imposition of attorneys' fees "would not promote the objectives of the Copyright Act," a court may nevertheless, in its discretion, deny attorneys' fees.<sup>191</sup> Therefore, new fashion designers can assert their legal rights without the fear of attorneys' fees looming overhead.

#### CONCLUSION

Today, a new fashion designer has no recourse when a person or entity blatantly copies the designer's clothing.<sup>192</sup> However, if Congress adopts legislation like the ID3PA to afford copyright protection for fashion designs, new fashion designers will be granted copyright protection over their designs that are "the result of a designer's own creative endeavor; and provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles."<sup>193</sup> By affording new fashion designers copyright protection under Chapter 13 of the Copyright Act, these designers can create their own designs and assist in the innovation process in the fashion industry as a whole. Without it, new designers may rethink their futures in the fashion industry and slowly withdraw from the industry. Although the

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<sup>188</sup> *Contractual Obligation Prods., LLC. v. AMC Networks, Inc.*, 546 F. Supp. 2d 120, 132 (S.D.N.Y. 2008); *Brown v. Perdue*, No. 04 Civ. 7417 (GBD), 2006 WL 2679936, at \*6-7 (S.D.N.Y. Sept. 15, 2006); *Leibovitz v. Paramount Pictures Corp.*, No. 94 Civ. 9144 (LAP), 2000 WL 1010830, at \*5 (S.D.N.Y. July 21, 2000); *Littel v. Twentieth Century-Fox Film Corp.*, No. 89 Civ. 8526 (DLC), 1996 WL 18819, at \*3 (S.D.N.Y. Jan. 18, 1996).

<sup>189</sup> *Brown*, 2006 WL 2679936, at \*6-7.

<sup>190</sup> *Fogerty*, 510 U.S. at 524.

<sup>191</sup> *Brown*, 2006 WL 2679936, at \*7.

<sup>192</sup> *See supra* Part I.D.

<sup>193</sup> Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. § 2(a)(2) (2011).

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fashion industry thrives today, without new designers, the creativity essential to the fashion world could very well decline.

The ID3PA provides ample opportunity for new fashion designers to assert their legal rights, unlike the IDPA, with its notice requirement. With a fee-shifting statute and the possibility of contingent-fee-based representation, new fashion designers can bring suit in order to define their legal rights without the threat of devastating costs. In any event, legislation that affords new fashion designers copyright protection should be adopted in order to keep the new designer in the fashion industry.