

Copyright Protection for Fashion Design: A Legal Analysis of the Design Piracy Prohibition Act (H.R. 2196)

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Summary

Fashion design does not currently receive explicit protection under U.S. copyright law. Limited avenues for protection of certain types of apparel designs can be found through trademark and patent law, though proponents of copyright protection for fashion design argue that these limited means are insufficient. Legislation has been introduced in the 111th Congress, the Design Piracy Prohibition Act (H.R. 2196), that would amend the U.S. Copyright Act to provide a three-year term of protection for fashion designs upon registration with the U.S. Copyright Office. An application for registration of the design must be made within six months after the date on which the design is first made public by the designer in the United States or a foreign country. Similar bills to protect fashion design were introduced in the 110th Congress (H.R. 2033, S. 1957) and the 109th Congress (H.R. 5055), but they were not enacted.

The Design Piracy Prohibition Act would offer copyright protection for the appearance of an article of apparel as well as its ornamentation. The legislation broadly defines the term "apparel" to mean the following: clothing (including undergarments, outerwear, gloves, footwear, and headgear), handbags, purses, wallets, duffel bags, suitcases, tote bags, belts, and eyeglass frames. It would deny protection to fashion design that had been embodied in a useful article that was made public by the designer in the United States or a foreign country more than six months before the date of the application for registration with the U.S. Copyright Office.

H.R. 2196 would prohibit the creation, importation, sale, or distribution of any article the design of which has been copied from a protected fashion design (or from an image of it), without the consent of the registered design owner. Such activity would be considered an infringement of the fashion design owner's rights, and the adjudged infringer would be subject to damages of the greater of $250,000 or $5 per copy. The bill provides several limitations on infringement liability: (1) if the allegedly infringing article is original and not closely and substantially similar in overall visual appearance to the protected design; (2) if the allegedly infringing article reflects a trend (defined by the bill as a newly popular concept or idea expressed in a wide variety of designs of apparel that are in immediate demand); or (3) if the allegedly infringing article is the result of independent creation. In addition, the bill expressly states that an infringing article is *not* an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium.

The bill would require the Register of Copyrights to establish and maintain an electronically searchable database of protected fashion designs. Such database would contain contact information of the owners of the fashion designs, the name of the useful article embodying the design, the date the design was first made public, and other information that the Register may require. The legislation would require that such database be made available to the public without a fee or other access charge.

This report analyzes the amendments that the Design Piracy Prohibition Act would make to the Copyright Act to provide for fashion design protection. It also summarizes arguments both in favor of and against extending such protection.

Contents

Introduction 1
Background 1
Vessel Hull and Deck Design Protection 2
Exclusive Rights of the Design Owner 2
Legal Analysis of the Design Piracy Prohibition Act (H.R. 2196) 3
Designs Protected 3
Term of Protection 3
Application for Registration 4
Searchable Database for Fashion Designs 4
Designs Not Subject to Protection 5
Infringement 5
False Representation Penalties 7
The Protection Debate 7

Contacts

Author Contact Information 8

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Introduction

U.S. copyright law does not protect useful articles, and copyright protection has been denied to fashion designs because clothing garments have traditionally been viewed as useful articles—basic items of necessity having utilitarian value—rather than as artistic creations. However, Chapter 13 of the U.S. Copyright Act does specify protection for the designs of one category of useful articles, the designs of boat hulls. H.R. 2196, the Design Piracy Prohibition Act, was introduced in the 111th Congress by Representative Delahunt on April 30, 2009. The bill would amend Chapter 13 of the Copyright Act to extend design protection to fashion design. Similar legislation was considered but not enacted by the 110th Congress (H.R. 2033,[1] S. 1957) and the 109th Congress (H.R. 5055)[2].

Background

The Copyright Act (the Act) defines a "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."[3] If the function of an article is found to be inherently utilitarian, rather than exclusively aesthetic or informational, then the article cannot be protected under U.S. copyright law. Although useful articles cannot be protected in and of themselves, certain aesthetic or creative aspects of such articles can receive protection. Designs of useful articles can be protected under copyright law "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."[4] Because "pictorial, graphic, and sculptural" works are eligible for copyright protection under § 102 of the Act,[5] protection is permitted for aspects of a utilitarian article that fall into this category and can be physically or conceptually separable from the utilitarian aspects of the article.[6] The U.S. Copyright Office describes this "separability test" as an "extremely limited" means of protecting the designs of useful articles, as courts have excluded most industrial designs from copyright protection.[7]

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[1] A hearing on H.R. 2033 and related matters was held on Feb. 14, 2008, *Design Law: Are Special Provisions Needed to Protect Unique Industries?: Hearing Before the House Subcomm. on Courts, the Internet, and Intellectual Property,* 110th Cong., 2nd Sess. (2008).

[2] A hearing on H.R. 5055 was held on July 27, 2006, *A Bill to Provide Protection for Fashion Design: Hearings Before the House Subcomm. on Courts, the Internet, and Intellectual Property,* 109th Cong., 2nd sess. (2006) [hereinafter Hearings].

[3] 17 U.S.C. § 101.

[4] *Hearings*, *supra* footnote 2 (statement of the U.S. Copyright Office) (citing 17 U.S.C. § 101).

[5] 17 U.S.C. § 102(a)(5).

[6] *See* Chosun, Int'l, Inc. v. Chrisha Creations, Ltd., 413 F.3d 324 (2d Cir. 2005) (holding that it is at least possible that elements of plush sculpted animal Halloween costumes are separable from the overall design of the costume and therefore eligible for copyright protection).

[7] *Hearings*, *supra* footnote 2 (statement of the U.S. Copyright Office) (citing Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987) (holding that a bicycle rack derived from wire sculptures was a product of industrial design and therefore not protectable, because its "[f]orm and function are inextricably intertwined"); Norris Indus. v. International Tel. and Tel. Corp., 696 F.2d 918 (11th Cir. 1983) (holding that wire-spoked wheel covers for automobiles were not copyrightable because they are useful articles without separable features)).

Both the patent and trademark law regimes provide limited means for protecting fashion design.[8] Under the concept of trade dress (part of trademark law), a fashion design can be protected in cases where the product has gained a reputation among consumers as being identifiable with a particular market source.[9] Under patent law, design patents could also be a potential means for protection.[10] However, commentators have noted the potential shortcomings of each of these approaches.[11]

Vessel Hull and Deck Design Protection

The design protection for vessel hulls and decks[12] in the Copyright Act is a unique, specially carved-out area of protection for designs of useful articles. Chapter 13 of the Act provides protection for vessel hull or deck designs for a period of 10 years;[13] such protection is granted if the application for registration of the design is made within two years from the date on which the design is first made public.[14] A design is considered to have been made public "when an existing useful article embodying the design is anywhere publicly exhibited, publicly distributed, or offered for sale or sold to the public by the owner of the design or with the owner's consent."[15]

Exclusive Rights of the Design Owner

Under Section 1308 of the Copyright Act, the owner of a protected design "has the exclusive right to (1) make, have made, or import, for sale or for use in trade, any useful article embodying that design; and (2) sell or distribute for sale or for use in trade any useful article embodying that design."[16]

If design protection under Chapter 13 of the Copyright Act were expanded to include fashion designs, fashion design owners would be granted the exclusive right to place their designs on the marketplace, and to thereby prevent others from creating, importing, selling, or distributing an

[8] For more information, *see* CRS Report RL34559, *Intellectual Property in Industrial Designs: Issues in Innovation and Competition*, by John R. Thomas.

[9] *See* Samara Bros. v. Wal-Mart Stores, 529 U.S. 205 (2000) (holding that a product design, specifically that for children's clothing, could be protected under federal trademark law if it were found to have acquired recognition among consumers as being associated with a particular source).

[10] *See* 35 U.S.C. § 171.

[11] *Hearings, supra* footnote 2 (statement of the U.S. Copyright Office) (noting that "design patents are difficult and expensive to obtain, and entail a lengthy examination process," and that trademark law only protects those product configurations that identify the source of the product, while the other aspects are not protected, and any trademark protection is only against uses of the design that create at least a substantial likelihood of customer confusion).

[12] A "vessel" is defined as "a craft that is designed and capable of independently steering a course on or through water through its own means of propulsion; and that is designed and capable of carrying and transporting one or more passengers." A "hull" is "the exterior frame or body of a vessel, exclusive of the deck, superstructure, masts, sails, yards, rigging, hardware, fixtures, and other attachments." A "deck" is "the horizontal surface of a vessel that covers the hull, including exterior cabin and cockpit surfaces, and exclusive of masts, sails, yards, rigging, hardware, fixtures, and other attachments." 17 U.S.C. § 1301, as amended by the Vessel Hull Design Protection Amendments of 2008, P.L. 110-434.

[13] *Id.* § 1305(a).

[14] *Id.* § 1310(a).

[15] *Id.* § 1310(b).

[16] *Id.* § 1308.

article of apparel the design of which has been copied from a protected design without the authorization of the registered design owner.

Legal Analysis of the Design Piracy Prohibition Act (H.R. 2196)

Designs Protected

As discussed above, Chapter 13 of the Copyright Act, entitled "Protection of Original Designs," is currently limited to vessel hull designs.[17] Section 1301 of the Act grants protection to the designer or other owner of an original design of a "useful article" that makes the article's appearance attractive or distinctive to the buying public.[18] The definition subsection of § 1301 first explains what makes a design original,[19] and then limits the definition of "useful article" to a vessel hull or deck.[20] H.R. 2196 would amend the definition of "useful article" by adding the provision "or an article of apparel," in order to protect the design of apparel under the Act.[21] To the end of the definition section, the bill would add the definitions for "fashion design,"[22] "design,"[23] "trend,"[24] and "apparel." The definition of "apparel" is broad, encompassing articles of men's, women's, and children's clothing, including undergarments, and outerwear, gloves, footwear, and headgear. Additionally, the term covers handbags, purses, wallets, duffel bags, suitcases, tote bags, belts, and eyeglass frames, rendering these items eligible for protection.[25]

Term of Protection

H.R. 2196 would amend the Copyright Act to prescribe a three-year term of protection for fashion designs.[26] The Act currently specifies a 10-year term of protection for vessel hulls and decks.[27] Proponents of legislation to protect fashion design assert that a three-year term is sufficient because its purpose is to protect high end "haute couture" designs when they are first sold at

[17] *Id.* § 1301.

[18] *Id.* § 1301(a)(1).

[19] *Id.* § 1301(b)(1) ("A design is 'original' if it is the result of the designer's creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.").

[20] *Id.* § 1301(b)(2).

[21] H.R. 2196, § 2(a)(2)(A).

[22] *Id.* § 2(a)(2)(B) ("A 'fashion design' – is the appearance as a whole of an article of apparel, including its ornamentation, and 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.").

[23] *Id.* ("The term 'design' includes fashion design, except to the extent expressly limited to the design of a vessel.").

[24] *Id.* ("In the case of a fashion design, the term 'trend' means a newly popular concept, idea, or principle expressed in, or as part of, a wide variety of designs of articles of apparel that create an immediate amplified demand for articles of apparel embodying that concept, idea, or principle.").

[25] *Id.*

[26] *Id.* at § 2(d), amending 17 U.S.C. § 1305(a).

[27] 17 U.S.C. § 1305(a) (The term of protection under copyright law generally, other than for vessel hulls, is the life of the author plus seventy years. *Id.* § 302(a)).

expensive prices—a time when the designs could be vulnerable to copies sold at substantially lower prices.[28] Because trends arise and fade quickly, the shorter term is considered a sufficient time period for the designer to have exclusive rights.[29] The 10-year protection for vessel hulls and decks would remain unchanged under the bill.

Application for Registration

Section 1310 of the Copyright Act mandates a two-year time period after a design has been made public during which an application for registration of the design must be filed.[30] The section refers only to registration for vessel hull and deck design protection. H.R. 2196 would add to this section the registration of a fashion design; however, it provides that such an application for registration must be made within a window of six months after the date on which it is first made public by the designer in the United States or a foreign country.[31] The purpose of including a limited registration period "is to require prompt registration of protected designs, which gives notice to the world that design protection is claimed."[32] Because the entire term of protection for fashion designs is significantly shorter than that for vessel hulls and decks, a shorter window for registration of fashion designs is deemed necessary.[33] The two-year time frame for vessel hull and deck registration would remain unchanged under the bill.

The bill would require that an application for registration of a fashion design be made to the Register of Copyrights,[34] as is currently the procedure for registering a vessel hull or deck design.[35] Furthermore, the legislation would mandate that the Register require a fashion design application to include a brief description of the design for use in the new searchable electronic database that the bill would establish (described in the following section).[36]

Searchable Database for Fashion Designs

H.R. 2196 would require the Register of Copyrights to establish and maintain a computerized database containing information regarding protected fashion designs.[37] The database is to be searchable electronically and contain among other things contact information of the owners of the fashion designs, the name of the useful article embodying the design, the date the design was first made public, and other information that the Register may require. The database also must contain "a substantially complete visual representation of all fashion designs that have been submitted for

[28] *Hearings, supra* footnote 2 (statement of the U.S. Copyright Office).

[29] *Id.* (applauding the proponents of the legislation for seeking a modest term of protection that is appropriate for the nature of fashion design).

[30] 17 U.S.C. § 1310(a), (b).

[31] H.R. 2196, § 2(f)(1).

[32] *Hearings, supra* footnote 2 (statement of the U.S. Copyright Office).

[33] *Hearings, supra* footnote 2 (statement of the U.S. Copyright Office) (describing that "a 2-year window [as vessel hulls receive] to register a fashion design that is entitled to protection for only 3 years and that likely is already starting to go 'out of fashion' after 2 years would make registration a relatively meaningless formality").

[34] H.R. 2196, §2(f)(3).

[35] 17 U.S.C. § 1310(d).

[36] H.R. 2196, §2(f)(3).

[37] *Id.* § 2(j)(1).

registration,"[38] including those that are registered, have been denied registration, have been cancelled, or have expired. Finally, the legislation would require that such database be made available to the public without a fee or other access charge.

Designs Not Subject to Protection

Section 1302 of the Copyright Act denies protection for a design that is

> (1) not original;[39]
>
> (2) staple or commonplace, such as a standard geometric figure, a familiar symbol, an emblem, or a motif, or another shape, pattern, or configuration which has become standard, common, prevalent, or ordinary;
>
> (3) different from a design excluded by paragraph (2) only in insignificant details or in elements which are variants commonly used in the relevant trades;
>
> (4) dictated solely by a utilitarian function of the article that embodies it; or
>
> (5) embodied in a useful article that was made public by the designer or owner in the United States or a foreign country more than 2 years before the date of the application for registration.

However, § 1303 of the Copyright Act offers protection for a design that uses subject matter excluded from protection under § 1302, "if the design is a substantial revision, adaptation, or rearrangement of such subject matter."[40]

H.R. 2196 would amend § 1302 to make protection unavailable for a fashion design that has been embodied in a useful article that was made public by the designer in the United States or a foreign country more than six months before the date of the application for registration.[41] The bill would amend § 1303 to provide that "The presence or absence of a particular color or colors or of a pictorial or graphic work imprinted on fabric shall not be considered in determining the originality of a fashion design under section 1301 or 1302 or this section or the similarity or absence of similarity of fashion designs in determining infringement under section 1309."[42]

Infringement

Section 1309 of the Copyright Act details what constitutes infringement of the design of a useful article.[43] In addition to a violation of any of the design owner's exclusive rights under § 1308, discussed above, it is also an infringement for a seller or distributor who did not make or import

[38] *Id.* § 2(j)(1) (adding new 17 U.S.C. § 1333(b)).

[39] 17 U.S.C. § 1301(b)(1) provides that a design is "original" if it is the result of the designer's creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.

[40] 17 U.S.C. § 1303.

[41] H.R. 2196, § 2(b).

[42] *Id.* § 2(c).

[43] 17 U.S.C. § 1309.

an infringing article, to induce or act in collusion to make or import the article.[44] A seller or distributor can also be liable if a design owner asks where the article came from and the seller/distributor refuses or fails to do disclose its source, and orders or reorders the article with the infringing design after being notified by mail that the design is protected.[45] Section 1309 has an exception to infringement liability for acts without knowledge: it is *not* an infringement to make, have made, import, sell, or distribute any article embodying a copied design that was created without knowledge that the design was protected.[46]

H.R. 2196 would narrow the "innocent infringement" exception by amending the language so that it *would* constitute infringement if one did not have actual knowledge but had *reasonable grounds to know* that design protection is claimed.[47] Additionally, the bill would add protection for images of fashion designs as well as for the designs themselves, stipulating that an article is infringing if its design was copied, without the consent of the design owner, from a protected design itself "or from an image thereof."[48] H.R. 2196 would also amend § 1309 to apply the doctrines of secondary liability to actions for infringement of a design of a useful article.[49] Doing so would codify the doctrines of secondary liability, which are not presently in the Copyright Act but exist in case law.[50] Finally, the bill would change the potential increased damages for infringement that may be imposed "as the court determines to be just" from the current amounts of $50,000 or $1 per copy, to $250,000 or $5 per copy (whichever is greater).[51]

H.R. 2196 would define an "infringing article" to mean any article the design of which has been copied from a protected design, or from an image thereof, without the consent of the owner of the protected design.[52] However, the bill expressly excludes from this definition an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium.

H.R. 2196 provides several limitations on infringement liability:

- if the allegedly infringing article is original and not closely and substantially similar[53] in overall visual appearance to the protected design;

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[44] *Id.* § 1309(b)(1) (explaining that purchasing or giving an order to purchase an infringing article in the ordinary course of business does not of itself constitute inducement or collusion).

[45] *Id.* § 1309(b)(2).

[46] *Id.* § 1309(c).

[47] H.R. 2196, § 2(e)(1).

[48] *Id.* § 2(e)(2).

[49] *Id.* § 2(e)(3). These doctrines include contributory, vicarious, and induced infringement, and refers generally to the imposition of liability upon those who did not directly infringe, but rather encouraged or benefitted from the infringement in certain circumstances. *See* ROGER E. SCHECHTER AND JOHN R. THOMAS, INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS 188 (2003).

[50] *See, e.g.,* Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984).

[51] 17 U.S.C. § 1323(a); H.R. 2196, § 2(g). These values are higher than the maximum statutory damages for copyright infringement, which are between $750 and $30,000 per work and up to $150,000 for willful infringement. 17 U.S.C. § 504.

[52] H.R. 2196,§ 2(e)(2).

[53] The "not closely and substantially similar" language is apparently intended to permit the creation and sale of so-called "inspired-by" designs, as opposed to opportunistic "knockoffs" that are copies or imitations of protected designs. *See* C. Scott Hemphill and Jeannie Suk, *The Squint Test*, Slate.com, May 13, 2009, at http://www.slate.com/id/2218281/.

- if the allegedly infringing article reflects a trend (defined by the bill as a newly popular concept or idea expressed in a wide variety of designs of apparel that are in immediate demand); or
- if the allegedly infringing article is the result of independent creation.[54]

False Representation Penalties

Section 1327 of the Copyright Act currently provides the following:

> Whoever knowingly makes a false representation materially affecting the rights obtainable under this chapter [17 USCS §§ 1301 et seq.] for the purpose of obtaining registration of a design under this chapter [17 USCS §§ 1301 et seq.] shall pay a penalty of not less than $ 500 and not more than $ 1,000, and any rights or privileges that individual may have in the design under this chapter [17 USCS §§ 1301 et seq.] shall be forfeited.

H.R. 2196 would increase the penalty amounts for false representation to a range of not less than $5,000 and not more than $10,000.[55]

The Protection Debate

Law professors, government officials, and design industry professionals have expressed diverse viewpoints on the need for and desirability of legislation granting copyright protection to fashion design. Those in favor of protection assert that the copyright law mistakenly views clothing as purely utilitarian in nature, and ignores the possibility that fashion design may be a form of creative expression deserving of protection.[56] Proponents also highlight the effects of modern technology on the ease and speed of copying fashion designs, pointing to the ability for copiers to easily access images of runway photos posted on the Internet.[57] Additionally, emphasis is placed on the particular vulnerability of young designers whose names and logos are not yet recognizable in the marketplace, and have difficulty promoting their work when it is quickly copied by established competitors.[58] Supporters of the legislation also point to the protection granted to fashion design in other areas of the world.[59]

Those against offering copyright protection for fashion design generally point to the success of the marketplace as it is and note that copying is an integral and accepted part of the fashion industry.[60] They claim that such interference into the fashion market would be harmful because of

[54] H.R. 2196, § 2(e)(2).

[55] *Id.* § 2(h).

[56] *Hearings, supra* footnote 2 (statement of Susan Scafidi, Associate Professor of Law, Southern Methodist University) (arguing that "designers are engaged in the creation of original works").

[57] *Id.* (asserting that "high quality digital photos of a runway look can be uploaded to the Internet and sent to copyists anywhere in the world even before the show is finished").

[58] *Id.* (stating that younger designers "cannot simply rely on reputation or trademark protection to make up for the absence of copyright").

[59] *Id.* (noting that France has strong copyright protection for fashion design).

[60] *See, e.g., Hearings*, *supra* footnote 2 (statement of David Wolfe, Creative Director, Doneger Creative Services) ("The absence of copyright in fashion frees designers to incorporate popular and reemerging styles into their own lines without restricting themselves for fear of infringement, thus facilitating the growth of new trends.").

increased litigation over the standard for infringement.[61] As a result, creative production of fashion designs would be stifled, ultimately resulting in less choice for consumers.[62] Finally, these critics assert that foreign experience with fashion design protection has not had material effect because copying still occurs in nations that have design protection laws—to the same degree it occurs in the U.S. where there is currently no such protection.[63]

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[61] *Hearings, supra* footnote 2 (statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (noting that "[d]rawing the line between inspiration and copying in the area of clothing is very, very difficult and likely to consume substantial judicial resources").

[62] *Id.* ("It is hard to imagine an industry [with design protection] producing the same rich variety of new designs that today's healthy, competitive fashion industry yields."). *But see Hearings*, *supra* footnote 2 (statement of Susan Scafidi) (describing the recent trend of high-end designers designing mass-market clothing lines for stores such as Target and Wal-Mart, reducing the need for consumers to rely on low-priced knock-offs).

[63] *Hearings, supra* footnote 2 (statement of Christopher Sprigman) (asserting that the European Union still faces substantial design copying despite offering substantial protection for apparel designs).