

Copyright Protection for Fashion Design: A Legal Analysis of Legislative Proposals

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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. The 111th Congress did not pass legislation that would have provided a three-year term of copyright protection for fashion designs, the Design Piracy Prohibition Act (H.R. 2196) and the Innovative Design Protection and Piracy Prevention Act (S. 3728). This report analyzes these two legislative proposals. The 112th Congress may consider similar legislation regarding fashion design protection.

The bills resembled each other although contained differences. For example, for a fashion design to receive protection under H.R. 2196, the designer must register the design with the U.S. Copyright Office; S. 3728 contained no such registration requirement. Instead, protection arises under S. 3728 upon the design's creation, although the design must be a sufficiently "unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles." This is a more restrictive definition of "fashion design" compared to H.R. 2196.

Both bills offered copyright protection for the appearance of an article of apparel as well as its ornamentation. They broadly defined the term "apparel" to mean the following: clothing (including undergarments, outerwear, gloves, footwear, and headgear), handbags, purses, wallets, tote bags, belts, and eyeglass frames. H.R. 2196 would have denied 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. In contrast, S. 3728 would have denied protection if the design was made public prior to the enactment of the bill or more than three years before the date upon which protection of the design is asserted. H.R. 2196 would have required the Register of Copyrights to establish and maintain an electronically searchable database of protected fashion designs; such database must be made available to the public without a fee or other access charge. S. 3728 contained no similar provision.

Both bills would have prohibited the creation, importation, sale, or distribution of any article whose design 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 have been considered an infringement of the fashion design owner's rights, and the adjudged infringer would have been subject to damages of the greater of: $250,000 or $5 per copy (under H.R. 2196) or $50,000 or $1 per copy (under S. 3728). H.R. 2196 provided 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. S. 3728's limitations on liability were slightly different: (1) if the allegedly infringing article is not "substantially identical" in overall visual appearance to the original elements of a protected design (that is, the article would not likely be mistaken for the protected design because the article contains non-trivial differences in construction or design); (2) if the article is the result of independent creation; or (3) if a person produces a single copy of a protected design for non-commercial personal use. In addition, both bills expressly stated 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.

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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. The 111th Congress did not pass legislation that would have amended Chapter 13 of the Copyright Act to extend design protection to fashion design, the Design Piracy Prohibition Act (H.R. 2196) and the Innovative Design Protection and Piracy Prevention Act (S. 3728). Although the two bills shared similar provisions, they also differed significantly. Legislation concerning fashion design copyright protection was also introduced but not passed by the 110th Congress (H.R. 2033,[1] S. 1957) and the 109th Congress (H.R. 5055)[2]. The 112th Congress may consider similar legislation.

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 (continued...)

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]

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automobiles were not copyrightable because they are useful articles without separable features)).

[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.

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

Legislation in the 111th Congress

The Design Piracy Prohibition Act (H.R. 2196) and the Innovative Design Protection and Piracy Prevention Act (S. 3728) would have amended the Copyright Act to provide a three-year term of copyright protection for fashion designs. H.R. 2196 was referred to the House Committee on the Judiciary but received no further legislative action. S. 3728 was approved by unanimous vote by the Senate Judiciary Committee and reported to the Senate on December 6, 2010; however, the Senate did not vote on the bill before the end of the 111th Congress. The specific provisions of these bills are discussed and analyzed below.

Designs Protected

As noted 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]

Both H.R. 2196 and S. 3728 would have amended 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 statutory definition section, the bills would have added the definitions for "fashion design," "design,"[22] 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,[23] tote bags, belts, and eyeglass frames, rendering these items eligible for protection.[24] However, the bills defined "fashion design" differently; S. 3728 mirrored H.R. 2196's definition but then added several additional qualifications that the design would have to satisfy in order to qualify for protection. H.R. 2196 provided the following definition of "fashion design":

[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, S. 3728, § 2(a)(2)(A).

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

[23] Although S. 3728 as introduced included duffel bags and suitcases within the definition of "apparel," the Senate Judiciary Committee adopted an amendment that removed these items from the bill's definition.

[24] *Id.*

> 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. [25]

To this definition, S. 3728 added two additional requirements. The original elements of the article of apparel or the original arrangement or placement of original or non-original elements must

- be 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.[26]

The additional elements of the statutory definition of "fashion design" contained within S. 3728 suggests that fewer fashion designs would likely have been eligible for protection under S. 3728 than under the broader definition offered by H.R. 2196.

In addition, unique to H.R. 2196 was a definition of the word "trend,"[27] and unique to S. 3728 was a definition of the phrase "substantially identical."[28] These terms were used by the legislation to limit liability for infringement of protected designs, as discussed below.

Term of Protection

The act currently specifies a 10-year term of protection for vessel hulls and decks.[29] Both H.R. 2196 and S. 3728 would have amended the Copyright Act to prescribe a three-year term of protection for fashion designs.[30] The three-year term starts from the earlier of the date of publication of the registration or the date the design is first made public.[31] 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 expensive prices—a time when the designs could be vulnerable to copies sold at substantially lower prices.[32] Because trends arise and fade quickly, the shorter term is considered a sufficient time period for the designer to have exclusive rights.[33] The 10-year protection for vessel hulls and decks would have remained unchanged under the bills.

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[25] H.R. 2196, § 2(a)(2)(B).

[26] S. 3728, § 2(a)(2)(B).

[27] H.R. 2196,§ 2(a)(2)(B) ("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.").

[28] S. 3728, § 2(a)(2)(B) ("In the case of a fashion design, the term 'substantially identical' means an article of apparel which is so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial.").

[29] 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)).

[30] H.R. 2196, S. 3728, at § 2(d), amending 17 U.S.C. § 1305(a).

[31] Under 17 U.S.C. § 1310(b), "[a] design is 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."

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

[33] *Id.* (applauding the proponents of the legislation for seeking a modest term of protection that is appropriate for the (continued...)

Application for Registration

Currently, Section 1310 of the Copyright Act refers only to registration for vessel hull and deck design protection. It 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—if no registration is submitted to the Copyright Office within this time frame, "[p]rotection under this chapter shall be lost."[34]

H.R. 2196 would have added to this section the registration of a fashion design; however, it provided 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.[35] 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."[36] 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.[37] The two-year time frame for vessel hull and deck registration would have remained unchanged under the bill.

H.R. 2196 would have required that an application for registration of a fashion design be made to the Register of Copyrights,[38] as is currently the procedure for registering a vessel hull or deck design.[39] Furthermore, the legislation mandated 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 have established (described in the following section).[40]

Unlike H.R. 2196, S. 3728 did not require that fashion designs be registered with the Copyright Office in order to enjoy protection.[41] Instead, protection arises under S. 3728 upon the design's creation. Some commentators have noted that without a registration requirement, the public (specifically retailers and other designers) would not be put on notice that a particular design is subject to copyright protection.[42]

(...continued)

nature of fashion design).

[34] 17 U.S.C. § 1310(a), (b).

[35] H.R. 2196, § 2(f)(1).

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

[37] *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").

[38] H.R. 2196, §2(f)(3).

[39] 17 U.S.C. § 1310(d).

[40] H.R. 2196, §2(f)(3).

[41] S. 3728, § 2(f)(2) (amending 17 U.S.C. § 1310(a) by adding the sentence: "Registration shall not apply to fashion designs.").

[42] Kal Raustiala and Christopher Sprigman, *Why Imitation is the Sincerest Form of Fashion,* N.Y. TIMES, Aug. 13, 2010, at A23.

Searchable Database for Fashion Designs

H.R. 2196 would have required the Register of Copyrights to establish and maintain a computerized database containing information regarding protected fashion designs.[43] The electronically searchable database would have contained 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 have contained "a substantially complete visual representation of all fashion designs that have been submitted for registration,"[44] including those that are registered, have been denied registration, have been cancelled, or have expired. Finally, the legislation required that such database be made available to the public without a fee or other access charge.

S. 3728 contained no similar provision.

Designs Not Subject to Protection

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

> (1) not original;[45]
>
> (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."[46]

H.R. 2196 would have amended § 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.[47] In contrast, S. 3728 would have made protection unavailable for a fashion design that was made

[43] H.R. 2196, § 2(j)(1).

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

[45] 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.

[46] 17 U.S.C. § 1303.

[47] H.R. 2196, § 2(b)(3).

public before the enactment of the bill or more than three years before the date upon which protection of the design is asserted.[48]

Both bills would have amended § 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."[49]

Infringement

Section 1309 of the Copyright Act details what constitutes infringement of the design of a useful article, namely,

> [I]t shall be infringement of the exclusive rights in a design … for any person, without the consent of the owner of the design, within the United States and during the term of such protection, to—
>
> (1) make, have made, or import, for sale or for use in trade, any infringing article; or
>
> (2) sell or distribute for sale or for use in trade any such infringing article.[50]

In addition to a violation of any of the design owner's exclusive rights, it is also an infringement for a seller or distributor who did not make or import an infringing article, to induce or act in collusion to make or import the article.[51] 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.[52]

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.[53] H.R. 2196 would have narrowed 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.[54] S. 3728 would also have narrowed the exception by specifying that it would constitute infringement if one had either actual knowledge *or* knowledge that can be "reasonably inferred from the totality of the circumstances" that a design was protected and was copied from such protected design.[55] On the other hand, S. 3728 would have broadened the

[48] S. 3728, § 2(b)(3).

[49] H.R. 2196, S. 3728, § 2(c).

[50] 17 U.S.C. § 1309.

[51] *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).

[52] *Id.* § 1309(b)(2).

[53] *Id.* § 1309(c).

[54] H.R. 2196, § 2(e)(1).

[55] S. 3728, § 2(e)(1)(B).

"innocent infringement" exception by including two additional actions with respect to the article embodying a copied design: "offer for sale" and "advertise."[56]

Additionally, both bills added 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."[57] H.R. 2196 would also have amended § 1309 to apply the doctrines of secondary liability to actions for infringement of a design of a useful article.[58] Doing so would codify the doctrines of secondary liability, which are not presently in the Copyright Act but exist in case law.[59] As introduced, S. 3728 contained a similar amendment, but the Senate Judiciary Committee reported the bill with an amendment that eliminated the secondary liability section. According to media reports, this removal was made out of a concern that the bill's secondary liability language might have had unintentional affects on other parts of the Copyright Act.[60]

Finally, H.R. 2196 would have changed 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).[61] S. 3728 would have left the current damage amounts unchanged.

Both bills defined 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.[62] However, the bills expressly excluded 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 provided several limitations on infringement liability:

- if the allegedly infringing article is original and not closely and substantially similar[63] in overall visual appearance to the protected design;
- 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

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[56] *Id.* § 2(e)(1)(A).

[57] H.R. 2196, S. 3728, § 2(e)(2).

[58] H.R. 2196, S. 3728, § 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).

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

[60] Nathan Pollard, *Senate Judiciary Committee Approves Design Piracy Act; Next to Full Senate,* BNA'S PATENT, TRADEMARK & COPYRIGHT LAW DAILY, December 2, 2010.

[61] 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.

[62] H.R. 2196, S. 3728, § 2(e)(2).

[63] The "not closely and substantially similar" language was 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 is the result of independent creation.[64]

S. 3728 would have established slightly different limitations on liability: (1) if the allegedly infringing article is not "substantially identical" in overall visual appearance to the original elements of a protected design (that is, the article would not likely be mistaken for the protected design because the article contains only differences in construction or design that are merely trivial); (2) if the article is the result of independent creation; or (3) if a person produces a single copy of a protected design for non-commercial personal use or for the use of an immediate family member (the "home sewing exception").[65]

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 and S. 3728 would both have increased the penalty amounts for false representation to a range of not less than $5,000 and not more than $10,000.[66]

Registration Prior to Filing An Infringement Lawsuit

Section 1321 of the Copyright Act currently provides that the owner of a design is entitled to institute an action for any infringement of the design, only after issuance of a certificate of registration of the design.[67] H.R. 2196 would leave unchanged the current statutory prerequisite of registering the design prior to filing an infringement suit.

However, in keeping with S. 3728's declaration that "[r]egistration shall not apply to fashion designs,"[68] S. 3728 would have amended Section 1321 to specify that for fashion designs, "the owner of a design is entitled to institute an action for any infringement of the design after the design is made public."[69] S. 3728 would not have changed the registration requirement for vessel hulls.

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

[64] H.R. 2196, § 2(e)(2).

[65] S. 3728, § 2(e)(2).

[66] H.R. 2196, S. 3728,§ 2(h).

[67] 17 U.S.C. § 1321(a).

[68] S. 3728, § 2(f)(2).

[69] *Id.* § 2(g)(1).

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.[70] 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.[71] 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.[72] Supporters of the legislation also point to the protection granted to fashion design in other areas of the world.[73]

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.[74] They claim that such interference into the fashion market would be harmful because of increased litigation over the standard for infringement.[75] As a result, creative production of fashion designs would be stifled, ultimately resulting in less choice for consumers.[76] 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.[77]

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[70] *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").

[71] *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").

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

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

[74] *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.").

[75] *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").

[76] *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).

[77] *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).