Intellectual Property Alert: Will Fashion Designs Finally be Clothed in "Copyright" Protection?

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After many attempts, it appears that clothing designs may finally gain protection in the United States.

On Monday, September 10th, Senator Charles Schumer re-introduced a new version of what is now called the Innovative Design Protection Act (IDPA) to provide quasi-copyright protection to "*fashion designs*." S.3523 is Senator Schumer's sixth attempt to protect clothing designs. The last version was introduced in 2010 and was the first time that such a bill had made it out of committee. A version of the bill had also been introduced in the House on July 13, 2011 by Representative Goodlatte with bipartisan co-sponsorship. With only a few months remaining in the current legislative session and the intervening congressional elections fast approaching, it is unlikely that there will be any movement on S.3523 until sometime after the 113th Congress takes office next January. In the interim, however, S.3523 has garnered the same type of bipartisan support as the previous version received, for example from the American Apparel and Footwear Association and the Council of Fashion Designers of America. Many European countries already recognize property rights in fashion design, and this bill would bring the United States closer to providing the same type of protection.

Scope and Protection

S.3523 provides quasi-copyright protection to "fashion designs" for a non-renewable three-year term. "**Fashion design**" is defined as "*the appearance as a whole of an article of apparel, including its ornamentation*" and "**Apparel**" is defined as an "*article of men's, women's, or children's clothing, including undergarments, outerwear, gloves, footwear, and headgear; handbags, purses, wallets, tote bags, and belts; and eyeglass frames*."

The design must include "*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*," and must be the "*result of a designer's own creative endeavor*." The design must also provide a "unique, distinguishable,

non-trivial and non-utilitarian *variation over prior designs for similar types of articles*."

Currently, U.S. copyright law protects some design elements that are separable from the functional or utilitarian aspects of the article (for example, fabric designs and artwork on clothing can be protected). But IDPA's standards of originality are more stringent and it will probably be more difficult to protect fashion designs against infringement than works currently covered under copyright law. If passed, the IDPA will not provide retroactive protection; thus any fashion designs previously introduced to the public will not be covered. Finally, there is no provision to register a fashion design and protection under this bill would begin the day a design is first made public.

Infringement

An "**infringing article**" must be "*substantially identical in overall visual appearance to and as to the original elements of a protected design*." This is a much higher standard than under traditional copyright law, which states that an infringement may occur if the work is "*substantially similar*." Note that if any article is created independently (in other words, the designer had no access to the other designer's work and did not see it), it is not an infringing article. "**Substantially identical**" is defined as "an article of apparel which is so similar in appearance as *likely to be mistaken* for the protected design, and contains only those *differences in construction or design which are merely trivial*." By requiring a likelihood of mistake, this definition injects the perspective of the customer into the analysis, much like in a trademark infringement. Making one copy of a fashion design for personal or family member use is **exempted** so long as the article is not offered for sale.

While we do not know how the facts of individual cases might be interpreted if this bill passes, we can predict that the IDPA will change the landscape for designers and those who copy their designs.

Written Notice Before Liability Accrues

S.3523 adds a provision requiring the fashion designer to provide 21 days written notice to an alleged infringer before suit can be brought. Damages and profits will only accrue after the suit has been filed. This provision addresses the concern that alleged infringers would be bullied by fashion designers into ceasing sales of clothing that does not violate S.3523.

Highlights of the IDPA

If the IDPA is enacted into law:

- Fashion designs will have non-renewable protection for three years; no registration is provided.
- Protection extends to:
  - articles of men's, women's, or children's clothing (like undergarments, outerwear, gloves, footwear, and headgear);
  - handbags, purses, wallets, tote bags, and belts; and
  - eyeglass frames.

- Designs must be:
  - the result of a designer's own creative endeavor; and
  - unique, distinguishable, non-trivial and non-utilitarian.
- All prior designs remain in the public domain.
- Accused designs must be "substantially identical" to protected designs to be found infringing.
- Fashion designers must give infringers 21 days written notice before bringing suit. Damages accrue only after a suit is filed.
- Individuals who make one copy of protected designs for their personal use will be exempted.
- Claims must be pled with particularity and must establish:
  - The infringed design is protected by this act;
  - The defendant's design infringes the protected design; and
  - The protected design was publicized in such a way that it is reasonable to infer the defendant knew of its existence.