

**Design Protection in the Fashion Industry:
Design Patents, Trademarks, Trade Dress, and Copyright**

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I. Introduction

There are few industries for which effective design protection is more critical—and more challenging—than the fashion industry. Prestigious fashion products command premium prices for their designs. Examples abound, from clothing to footwear, sunglasses to handbags, watches to jewelry. Naturally, the prestigious fashion products spawn imitators, and examples of those imitators are just as abundant. Streets, stores, and the Internet are flooded with everything from designer knock-offs to outright counterfeits.

The law provides many tools to allow creators of fashion products to protect and enforce their innovative and valuable designs. In this article, we review the most commonly used tools to protect the design of fashion products under United States law: design patents, trademarks, trade dress, and copyright. As will be seen, each tool has advantages and disadvantages for particular fashion products.

II. Design Patents

A designer may obtain a design patent for “any new, original and ornamental design for an article of manufacture.”³ The designer must file the application no later than one year after the designer, (1) disclosed the design in a printed publication, (2) publicly used or placed the design on sale, or (3) otherwise made the design available to the public.⁴

The design patent application itself is relatively straightforward. Its substance consists of drawings or black and white photographs of the design.⁵ Once obtained, design patents are well-suited to the protection of fashion items. Representative examples of issued design patents for fashion include, a swimsuit patent assigned to Lululemon,⁶

³ 35 U.S.C. § 171(a). (2018).

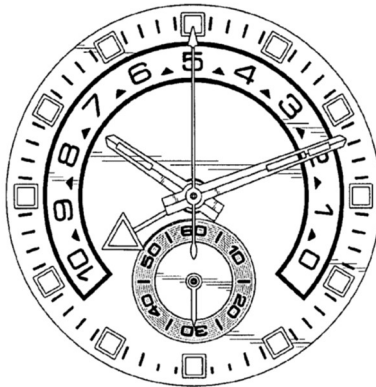
⁴ 35 U.S.C. § 102(a). (2018).

⁵ See 37 C.F.R. § 1.84. (2018).

⁶ U.S. Patent No. D785,905, fig. 1.



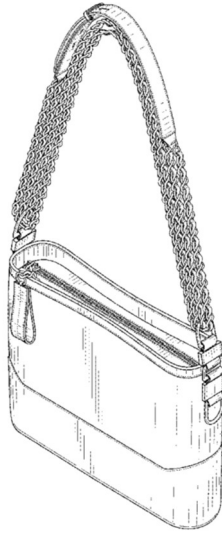
a watch face design assigned to Rolex,⁷



and a handbag design patent issued to Chanel.⁸

⁷ U.S. Patent No. D571,683, fig. 2.

⁸ U.S. Patent No. D847,500, fig. 1.



The examination process for a design patent is more streamlined than for a utility patent. It is common for the United States Patent and Trademark Office to issue a design patent within nine to 12 months from the date of filing. A design patent remains in force for 15 years from the date of issuance (or 14 years, for applications filed before May 13, 2015).⁹

Enforcement of a design patent is also straightforward—at least as compared to enforcement of a utility patent. In order to establish that a utility patent is infringed, a plaintiff must prove that every limitation of a claim is present in an accused device, either literally or under the doctrine of equivalents. In addition, the meaning of the terms of the claims is ordinarily litigated through extensive *Markman* proceedings.¹⁰ In contrast to utility patent cases, claim construction is not required, and is rarely performed, in design patent cases.¹¹

The test for infringement is the “ordinary observer” test. Under this test, as articulated by the Federal Circuit in *Egyptian Goddess, Inc. v. Swisa, Inc.*, a plaintiff can establish infringement if, “an ordinary observer, familiar with the prior art . . . would be deceived into believing the [accused design] is the same as the patented [design.]”¹²

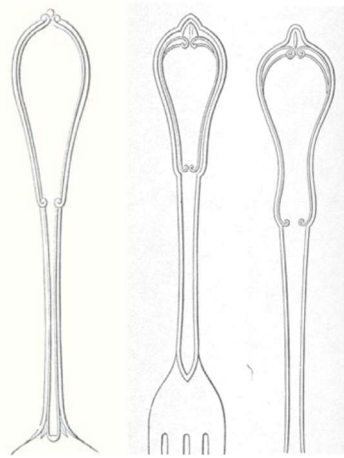
⁹ The duration of a design patent for which an application was filed on or after May 13, 2015 is 15 years from the date of issuance. 35 U.S.C. § 173 (2012). However, a design patent for which the application was filed before May 13, 2015 is 14 years from the date of issuance. MPEP (9th ed. Rev. Jan. 2018). The increase in the design patent’s life was made pursuant to the Patent Law Treaties Implementation Act of 2012, implementing the 1999 Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

¹⁰ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). The *Markman* process frequently requires each party to, among other things, (1) disclose claim terms requiring construction, (2) disclose proposed constructions, (3) participate in claim construction discovery, (4) engage in rounds of claim construction briefing, and (5) participate in a hearing that may include presentation of expert witness testimony. See, e.g., N.D. Cal. Patent L.R.4-1, et seq.

¹¹ See *Egyptian Goddess v. Swisa*, 543 F.3d 665, 679 (Fed. Cir. 2008) (cautioning trial courts against reliance on a detailed verbal description in a design patent infringement case).

¹² *Id.* at 681. In reaching its decision, the Federal Circuit relied on the Supreme Court’s decision in *Gorham Co. v. White*, 81 U.S. 511 (1871), and rejected its prior holding in *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984). In *Litton*, the Federal Circuit held that proof of similarity between designs under the ordinary observer test was not sufficient to establish design patent infringement and, instead, held that the “accused design must also appropriate the novelty of the claimed design in order to be deemed infringing.” *Egyptian Goddess* at 670-71 (citing *Litton Systems* at 1444).

Central to the ordinary observer test is that the designs need not be identical. As the Federal Circuit stated in *Crocs, Inc. v. Int'l Trade Comm'n*, “minor differences between a patented design and an accused article’s design cannot, and shall not, prevent a finding of infringement.”¹³ The ordinary observer test, instead, focuses on the design “in its entirety.”¹⁴ Thus, courts have upheld findings of infringement even where differences are readily observable. In the seminal case *Gorham v. White*,¹⁵ the Supreme Court found infringement of the patented design (below left) by two distinctly different designs (below center and right) under the ordinary observer test.



Similarly, the Federal Circuit in *Crocs* reversed a decision of the International Trade Commission and held that the accused foam sandals infringed the plaintiff’s design patents, even though there was no dispute that the accused sandals were discernably different from the patented designs. As seen in a table from the court’s opinion (reproduced below), differences are apparent.¹⁶ In the patented design (at left), the holes in the sandal’s upper are circular. In the accused design (at right), the holes are rectangular or polygonal.

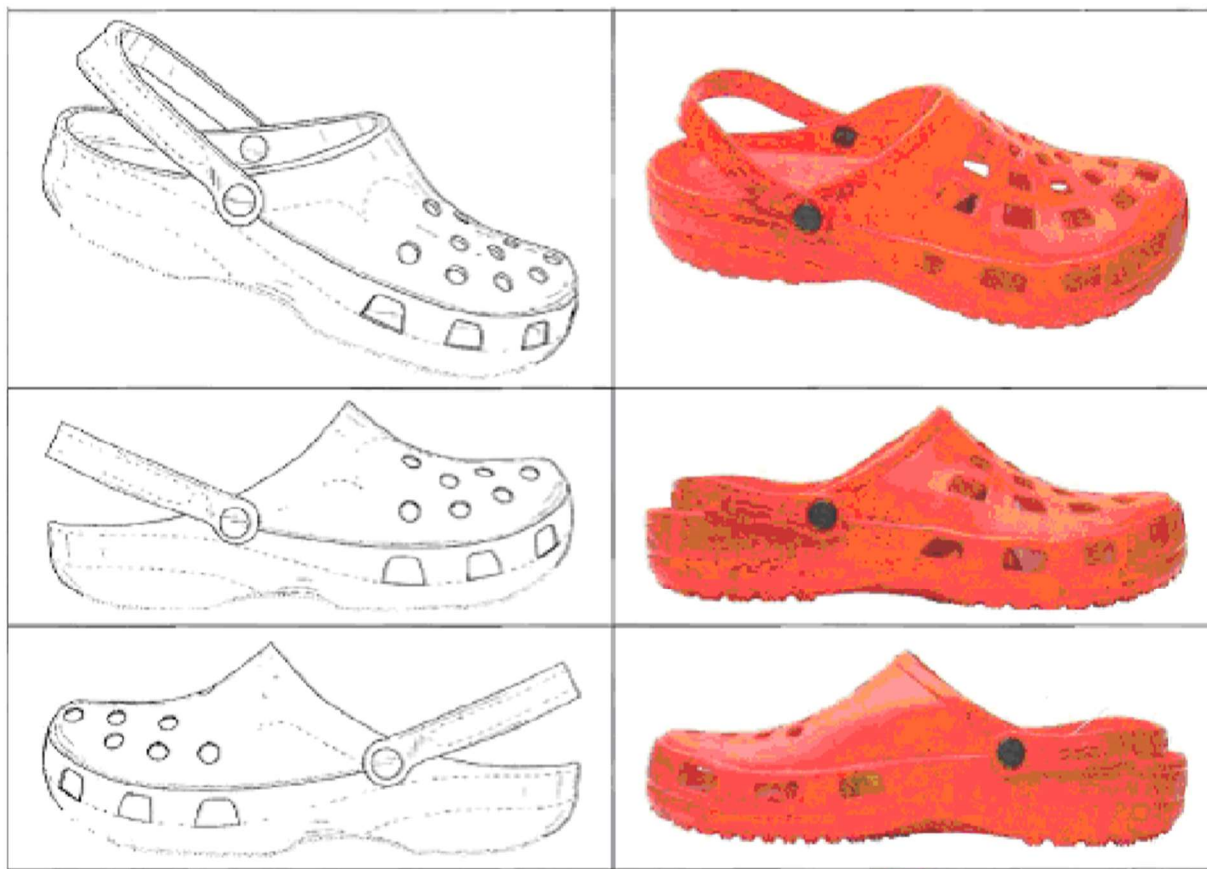
not sufficient to establish design patent infringement and, instead, held that the “accused design must also appropriate the novelty of the claimed design in order to be deemed infringing.” *Egyptian Goddess*, 543 F.3d at 670-71 (citing *Litton Systems*, 723 F.2d at 1444).

¹³ *Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1300 (Fed. Cir. 2010) (quoting *Payless Shoesource*, 998 F.2d 985, 991 (Fed. Cir. 1993) quoting *Lytton Sys.*, 728 F.2d at 1444).

¹⁴ *Id.* at 1300.

¹⁵ *Gorham v. White*, 81 U.S. 511, 731 (1871).

¹⁶ *Crocs, Inc.*, at 1306.



In reversing the ITC, the Federal Circuit stated that the ITC had “placed undue emphasis on particular details” that the ITC had identified, rather than reviewing the designs as a whole.¹⁷ When the designs as a whole were viewed side-by-side, the court held, “an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused products are the same as the patented design.”¹⁸

To emphasize its conclusion, the court stated that the patented designs and the accused designs were so similar that an ordinary observer could not be expected to keep them straight. “If the claimed design and the accused design were arrayed in matching colors and mixed up randomly, this court is not confident that an ordinary observer could properly restore them to their original order without very careful and prolonged effort.”¹⁹

¹⁷ *Id.* at 1303.

¹⁸ *Id.* at 1306.

¹⁹ *Id.*

More types of damages are available for infringement of a design patent than for infringement of a utility patent. As is the case for infringement of a utility patent, available damages include lost profits or a reasonable royalty,²⁰ the potential for the trebling of damages if the infringement is found to have been willful, and attorneys' fees if the case is found to have been "exceptional."²¹

Alternatively, the plaintiff can elect to receive disgorgement of the profits earned by the infringer for its sale of an "article of manufacture" that includes the patented design. The statute, 35 U.S.C. § 289, provides:

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any *article of manufacture* for the purpose of sale, or (2) sells or exposes for sale any *article of manufacture* to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250. . . .²²

In *Apple v. Samsung*,²³ the Supreme Court held that the first step in determining damages under Section 289 is to determine what constitutes the "article of manufacture."²⁴ Apple argued, and the Federal Circuit agreed, that the entire product in the form sold to the consumer is the article of manufacture.²⁵ The Supreme Court rejected that approach and held that the component that embodies the asserted design patent in a multi-component product may be the article of manufacture, but declined to make a finding in the case or articulate a test for identifying the article of manufacture in a multi-component product.²⁶ Thus, some ambiguity remains regarding what constitutes an "article of manufacture" for purposes of determining damages for the infringement of a design in a multi-component product.

Although uncertainty exists regarding how to measure damages under Section 289, design patents are advantageous for protecting fashion products that:

- have been on sale for less than one year (in light of the bar date for filing for a patent application);

²⁰ 35 U.S.C. § 284. (2012).

²¹ 35 U.S.C. § 285. (2018).

²² 35. U.S.C. § 289 (2018) (emphasis added).

²³ *Apple v. Samsung*, 137 S.Ct. 429 (2016).

²⁴ *Id.* at 436.

²⁵ *Id.* at 435-36.

²⁶ *Id.* at 436.

- are expected to be commercially valuable for more than one year (in light of the time from filing until the PTO issues the design patent);
- have not already had sufficient sales, marketing, and publicity such that the consuming public has come to associate the design with the manufacturer (This factor contrasts with trade dress, as will be addressed later in this article.);
- may be discontinued and either permanently retired or reintroduced at some indeterminate point in the future (This factor also contrasts with trade dress, as will be addressed later in this article); and
- Have ornamental designs that cannot be separated and be appreciated in a form separate from the products into which they have been incorporated (This factor contrasts with copyright, as will also be addressed later in this article.).

III. Trademarks

Trademark law allows a designer who owns the trademark to control his or her brand and the good will and reputation of the business. A trademark is any word, name, symbol, or design,²⁷ or any combination thereof, used in commerce to identify and distinguish the goods of one brand from those of another.²⁸

This section addresses protections afforded to conventional trademarks, such as brand names, slogans, and logos (in contrast with trade dress, which may protect the design of the product or its packaging). For many fashion products, the word or logo can be the most critical portion of the product's design (for example, the "swoosh" on a Nike shoe). Accordingly, trademark protection can be an important tool in protecting fashion products.

Type of Mark	Example
Word Mark	BURBERRY for Cosmetics (U.S. Reg. No. 79,087,223); AMAZON for online retailing services (U.S. Reg. No. 2,832,943); NIKE for athletic shoes (U.S. Reg. No. 978,952).
Phrases	JUST DO IT for clothing (U.S. Reg. No. 1,875,307)

²⁷ Including logos, colors, sounds, product configurations, etc.

²⁸ 15 U.S.C. § 1127. (2018).

Symbols	A “‘wing’ design” for sports bags (U.S. Reg. No. 1145473) 
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Trademarks vary in strength of protection. The strength of the mark is measured by its distinctiveness.²⁹ By definition, a trademark must distinguish the source of the good or service.³⁰ A trademark will qualify as distinctive if either (1) it is “inherently distinctive” or (2) it has developed “acquired distinctiveness” of the source of the good or service.³¹ Inherently distinctive marks “almost automatically tell a customer that they refer to a brand,” and “immediately . . . signal a brand or a product ‘source.’”³² Terms that lack distinctiveness, however, may still qualify as a trademark if they have developed “acquired distinctiveness” which is also known as “secondary meaning.” That is, they acquire distinctiveness over time through recognition by consumers after regular use.

Trademark protection entitles owners the right to prevent others from using the same or similar trademark on the same or similar products where the use is likely to cause confusion as to the source, origin, or sponsorship of the products. Unlike patents and copyrights, trademarks do not expire after a set term. Instead, trademark rights originate from, and are perpetuated by, actual “use.”³³ Therefore, in theory, trademark protection can last forever, so long as there is continued use of the mark in commerce, and so long as the owner is policing and enforcing the mark so as to maintain enough exclusivity that the mark is still associated by the consuming public with the owner. Generally speaking, a federal trademark registration is valid for ten years and can be renewed indefinitely for subsequent ten-year periods.

Federal registration is not mandatory to attain trademark protection.³⁴ Trademark protection can also be secured through state registration or the establishment of “common law” rights in a mark—rights based solely use of the mark in commerce.³⁵ However, there are several benefits to federal registration: (1) the mark is presumed to be a valid mark, (2) registration provides a notice to the public of registrant’s ownership of the mark, and (3) the registrant is presumed to have the exclusive right to use the trademark throughout the United States based on

²⁹ The following are categories of marks ranked from strongest to weakest: (1) fanciful marks, (2) arbitrary marks, (3) suggestive marks, and (4) descriptive marks.

³⁰ 15 U.S.C. § 1127.

³¹ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210 (2000).

³² *Qualitex Co. v. Jacobson Prod. Co., Inc.*, 514 U.S. 159, 162-63 (1995) (emphasis in original).

³³ 15 U.S.C. § 1127.

³⁴ United States Patent and Trademark Office, Trademark, Patent, or Copyright? (2016), <https://www.uspto.gov/trademarks-getting-started/trademark-basics/trademark-patent-or-copyright> (last visited on June 28, 2019).

³⁵ *Id.*

the goods or services listed in its registration.³⁶ An application for federal registration with the USPTO must include: (1) a description of the trademark, (2) identification of the products and/or services upon which the mark will be used, and (3) payment of the appropriate fee. While a federal registration is not valid outside of the United States, certain countries recognize a United States registration as a basis for filing an application to register a mark in those countries under international treaties.

Trademark infringement is the unauthorized use of a trademark, or a mark that is confusingly similar to the trademark, on related goods and services.³⁷ In order to succeed on a trademark infringement claim, the plaintiff must show that there is a likelihood of confusion between plaintiff's and defendant's mark. When determining likelihood of confusion, courts perform an analysis focusing on several factors. One prominent example is referred to as "*Polaroid* factors".³⁸

- Strength of the senior user's mark. The stronger or more distinctive the senior user's mark, the more likely the confusion.
- Similarity of the marks. The more similarity between the two marks, the more likely the confusion.
- Similarity of the products or services. The more related the senior and junior user's goods or services, the more likely the confusion.
- The likelihood that the senior user will bridge the gap. If it is probable that the senior user will expand into the junior user's product area, the more likely there will be confusion.
- The junior user's intent in adopting the mark. If the junior user adopted the mark in bad faith, confusion is more likely.
- Evidence of actual confusion. Proof of consumer confusion is not required, but it is important evidence of infringement.
- Sophistication of the buyers. The less sophisticated the purchaser, the more likely the confusion.

³⁶ Additionally, only federally registered trademarks may use the ® symbol.

³⁷ United States Patent and Trademark Office, Trademark, Patent, or Copyright? (2016), <https://www.uspto.gov/trademarks-getting-started/trademark-basics/trademark-patent-or-copyright> (last visited June 28, 2019).

³⁸ See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961). The Ninth Circuit's analysis is similar and is referred to as *Sleekcraft* factors. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

- Quality of the junior user's products or services. In some cases courts have found that there is more harm caused by consumer confusion when the junior user's goods are of low quality.
- Relatedness of the products and services at issue.

If the trademark owner can prove infringement, available remedies may include the following: (1) an injunction (an order requiring the destruction or forfeiture of infringing articles); (2) monetary relief, (which may include defendant's profits, any damages sustained by the plaintiff, and the costs of the action); and (3) in "exceptional cases," attorneys' fees.³⁹

In sum, trademark protection provides advantages for protection of the design of fashion products where:

- the fashion products derive significant value in the marketplace from a word or design mark that is used on the products (for example, the Nike "swoosh" design mark);
- the mark used on the product is well-established and is either distinctive or has acquired secondary meaning;
- the mark used on the product (or class of products) is in continuous use; and
- the owner of the mark is willing and able to continuously police the marketplace and enforce its rights against infringers.

IV. Trade Dress

Trade dress is a subsidiary of trademark law, which generally protects the "total image and overall appearance" of a product. Trade dress generally refers to product configurations, product designs, and product packaging that the consuming public has come to recognize as source identifiers. Features such as the "size, shape, color or color combinations, texture, graphics" can all qualify for trade dress protection.⁴⁰ A product's trade dress may be a collection of elements that are not separately protectable as trademarks, but together, these elements are protectable because of their capacity to identify the source of a product or service.⁴¹ The features must also be "nonfunctional"—not essential to the use or purpose of the product or providing a competitive

³⁹ 15 U.S.C. §§ 1114-1119.

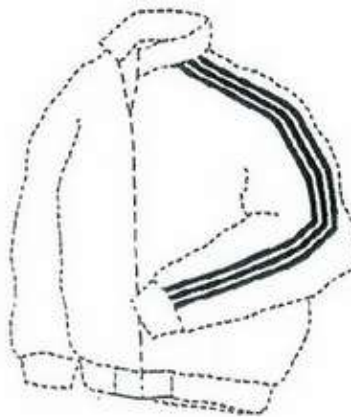
⁴⁰ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992).

⁴¹ See *id.* (finding that the overall decor of the respondent's restaurant was inherently distinctive, and therefore protectable trade dress, even though respondent had not demonstrated that this decor had acquired secondary meaning).

advantage to the product—in order to be afforded trade dress protection.⁴² Examples of issued trade dress protection include Christian Louboutin’s red lacquered sole,⁴³



Adidas’s stripe design,⁴⁴



Hermès’s Birkin handbag design,⁴⁵

⁴² *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.10 (1984) (“a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”); see 15 U.S.C. § 1052(e)(5) (2018) (prohibiting the registration of any mark that “comprises any matter that, as a whole, is functional”).

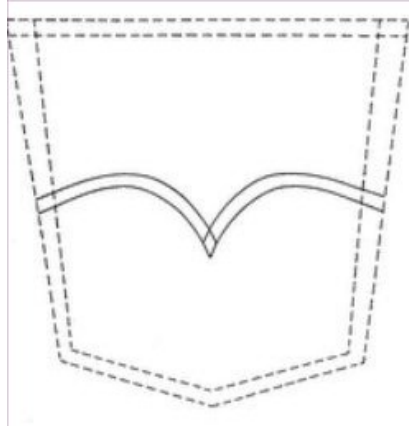
⁴³ U.S. Trademark No. 3,361,597.

⁴⁴ U.S. Trademark No. 78,539,470.

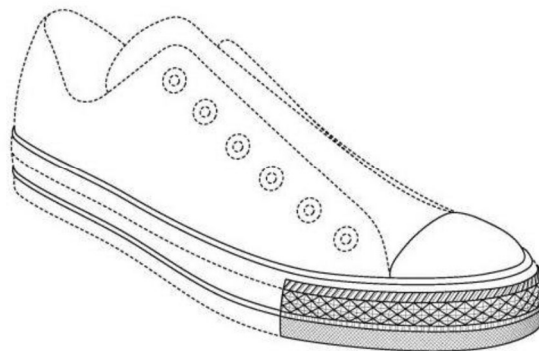
⁴⁵ U.S. Trademark No. 76,700,120.



Levi's pocket stitch design,⁴⁶ and



Converse's athletic shoe design.⁴⁷



⁴⁶ U.S. Trademark No. 11,392,54.

⁴⁷ U.S. Trademark No. 4,398,753.

The trade dress registration must include a description of the trade dress. In the case of the Converse shoe (above), the registration describes the trade dress as follows:

“the mark consists of the design of the two stripes on the midsole of the shoe, the design of the toe cap, the design of the multi-layered toe bumper featuring diamonds and line patterns, and the relative position of these elements to each other.”

To prevail in a trade dress infringement action, a plaintiff must show three elements: (1) distinctiveness, (2) non-functionality, and (3) a likelihood of confusion among consumers between the owner’s mark and the infringer’s mark.⁴⁸

Fashion product designs are never inherently distinctive—able to identify a single source as to a good or service.⁴⁹ Therefore, in order for a product design to qualify for trade dress protection, the owner of the trade dress must prove that the mark has acquired “secondary meaning”—that the product’s design is associated with a particular source in the minds of consumers.⁵⁰ In other words, the relevant consumer must be able to identify the fashion design with the designer. The Federal Circuit established a seven factor test to determine if a trade dress has acquired secondary meaning: “(1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant’s intent in copying the trade dress.”⁵¹

While a showing of secondary meaning can be challenging to achieve in the fashion industry, some designers have been successful in enforcing their trade dress. For example, in *Christian Louboutin v. Yves Saint Laurent*,⁵² the Second Circuit overruled a lower district court and held that Louboutin’s signature red shoe sole was a “distinctive symbol” that had come to represent the brand and deserved trademark protection under certain circumstances.⁵³ The court relied on *Qualitex v. Jacobson Prod.*,⁵⁴ which held that a single color alone can serve as a trademark, as long as that color has acquired secondary meaning and identifies the brand.⁵⁵

⁴⁸ *Two Pesos*, 505 U.S. at 764.

⁴⁹ See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210–11 (2000).

⁵⁰ *Inwood Labs.*, 456 U.S. at 851 (“[S]econdary meaning” is acquired when “in the minds of the public, the primary significance of a product feature ... is to identify the source of the product rather than the product itself”).

⁵¹ *Converse Inc. v. ITC*, 907 F.3d 1361 (Fed. Cir. 2018).

⁵² *Christian Louboutin v. Yves Saint Laurent*, 696 F.3d 206 (2d Cir. 2012).

⁵³ While the holding in that case was that YSL’s monochromatic red shoes did not infringe on Louboutin’s mark (thereby affirming the lower court’s denial of Louboutin’s request for preliminary injunction), the court still found that Louboutin’s lacquered red outsoles had acquired limited secondary meaning only where the sole “pops” and contrasts between the sole and the rest of the shoe (i.e. not red monochromatic shoes). See *Christian Louboutin v. Yves Saint Laurent*, 696 F.3d 206 (2012).

⁵⁴ *Qualitex v. Jacobson Prod.*, 514 U.S. 159 (1995).

⁵⁵ The Court ruled that color is not inherently distinctive and immediately protectable, but that instead, it is only protectable to the

Additionally, in certain cases, a designer may be able to achieve trade dress protection for a specific color. An example of a protected color in the fashion world is Tiffany & Co.'s "robin's egg blue" colored packaging.⁵⁶

Like other trademarks, to prevail in an infringement claim, the plaintiff must show that there is a likelihood of consumer confusion between the trade dress of plaintiff's product and defendant's product. In *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*,⁵⁷ the court applied the likelihood of confusion test in the trade dress context. In that case, Louis Vuitton sought protection for its line of handbags created jointly with artist Takashi Murakami. The handbags had the "LV" monogram combined in a pattern of rows with 33 bright colors, arranged in what is called the "Toile Monogram." Vuitton argued that Dooney & Bourke, which also marketed handbags bearing its initials in an interlocking pattern in a similar color palette termed the "It Bag," copied Vuitton's bags. The district court held that there was no likelihood of confusion between the two bags, relying primarily on a side-by-side comparison. (Images of the bags are reproduced below.)



On appeal, the Second Circuit criticized the district court's side-by-side comparison of the bags, holding that, "to determine whether two products are confusingly similar it is improper to conduct a side-by-side comparison in lieu of focusing on actual market conditions and the type of confusion alleged."⁵⁸

The remedies for trade dress infringement are the same as those for trademark infringement, i.e., injunctions, recovery of damages in the form of the defendant's profits or the plaintiff's actual damages, and/or attorney's fees in "exceptional" cases.⁵⁹

extent that it can be demonstrated to have been used over time on a product to such a degree that it has come to be viewed by consumers as a source indicator. See *Qualitex v. Jacobson Products*, 514 U.S. 159 (1995).

⁵⁶ U.S. Trademark No. 2,359,351.

⁵⁷ 454 F.3d 108 (2d Cir. 2006).

⁵⁸ Compare *Louis Vuitton Malletier S.A. v. Haute Diggity Dog*, 507 F.3d 252 (4th Cir. 2007) (holding that "Chewy Vuiton" was an obvious parody, and applying the factors for likelihood of confusion, the Fourth Circuit affirmed the district court's decision that Haute Diggity's use of "Chewy Vuiton" was not likely to cause confusion.)

⁵⁹ 15 U.S.C. §§ 1114-1119.

In sum, trade dress protection is particularly well-suited to protect the design of fashion products where:

- sales, marketing, and publicity relating to the product are sufficient to establish that the design has acquired secondary meaning among relevant consumers;
- the design is in continuous use; and
- the owner of the mark is willing and able to continuously police the marketplace and enforce its rights against infringers.

IV. Copyright

Copyright protects “original works of authorship” in “pictorial, graphic, and sculptural works.”⁶⁰ The copyright right exists upon the creation of the work. However, the copyright cannot be enforced until the author has obtained a registration for the copyright.⁶¹ Copyright registration is neither complicated nor expensive. It involves little more than the filling out of a form and the payment of a fee ranging between \$35 and \$85.

To prove infringement, a plaintiff must show that the defendant copied the plaintiff’s copyrighted work. Courts recognize, however, that direct evidence of copying is frequently difficult to obtain. Accordingly, a plaintiff can satisfy its burden of proving copying by providing evidence showing, “(1) that the defendant had *access* to the plaintiff’s work and (2) that the two works are *substantially similar*.”⁶² To establish access, “a plaintiff must show a reasonable possibility, not merely a bare possibility, that the alleged infringer had the chance to view the protected work.”⁶³ A plaintiff can meet that burden “using circumstantial evidence of either (1) a ‘chain of events’ linking the plaintiff’s work and the defendant’s access, or (2) ‘widespread dissemination’ of the plaintiff’s work.”⁶⁴

In many instances, copyright protection for fashion products is straightforward. For example, copyright protects the artwork screen-printed on a t-shirt or any other article of clothing. Similarly, the design of a pattern on fabric (e.g. a floral, paisley, or geometric design), the design of an embroidery pattern, or the design of a piece of jewelry may be protected.

⁶⁰ 17 U.S.C. § 102(5). (2018).

⁶¹ *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com LLC*, 139 S.Ct. 881 (2019).

⁶² *Smith v. Jackson*, 84 F.3d 1218 (9th Cir. 1996). (emphasis added).

⁶³ *Art Attacks Inc., LLC v. MGA Entm’t, Inc.*, 581 F.2d 1138, 1143 (9th Cir. 2009).

⁶⁴ *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 482 (9th Cir. 2000).

Two issues frequently arise in the context of fashion products because they are, (1) ordinarily “useful articles,” and (2) contain elements that are not original. Each of these issues is addressed below.

A. Useful Articles

The Copyright 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.”⁶⁵ The Act further states that, “[a]n article that is normally part of a useful article is considered a ‘useful article.’”⁶⁶ Examples of fashion products that are useful articles include clothing, shoes, watches, and handbags.

Copyright protects the design of a useful article only to the extent that its artistic features can be separated from its utilitarian features. The Act states,

“Pictorial, graphic, and sculptural 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 pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.⁶⁷

The Supreme Court recently applied the statute in *Star Athletica, LLC v. Varsity Brands, Inc.*⁶⁸ There, the Court ruled that the designs on a cheerleading uniform were separable from the functional aspects of the uniform, and thus held that the design constituted copyrightable subject matter, even though the uniforms were indisputably “useful articles.” The copyrighted designs consisted of geometric blocks of colors and strips including chevron-like patterns, as shown below.

⁶⁵ 17 U.S.C. § 101. (2010).

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).



The Court stated a two-part “separability test” test for determining whether a design that is part of a useful article is eligible for copyright protection, stating:

a feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.⁶⁹

The Court characterized the first prong as being ordinarily straightforward to satisfy. The Court stated,

The first requirement—separate identification—is not onerous. The decision maker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.⁷⁰

The Court characterized the second prong as constituting a more substantial barrier, stating,

The independent-existence requirement is ordinarily more difficult to satisfy. The decision maker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article. In other words, the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in § 101 once it is imagined apart from the useful article. If the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated

⁶⁹ *Id.* at 1007.

⁷⁰ *Id.* at 1010.

from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.⁷¹

The Court found that the designs of the uniforms met both prongs of its test. First, the geometric designs were “perceivable” separate from the uniforms themselves. Second, when removed from the context of the uniforms, the designs could qualify as pictorial, graphic, or sculptural works in their own right. That is, the designs could be separated from the uniforms as their own two-dimensional works of art that “would not replicate the uniform itself.”⁷²

In *Silvertop Assoc., Inc. v. Kangaroo Mfg., Inc.*, following *Star Athletica*, a district court found that a banana costume, although a (somewhat) useful article, was subject to copyright protection and granted a motion for a preliminary injunction.⁷³ In the images below, the copyrighted design is shown at left, and the accused infringing designs are at center and right.



The court found that the design was protectable by copyright in light of its features that the court held had “a pictorial, graphic, or sculptural quality.” These features included:

- a) the overall length of the costume, b) the overall shape of the design in terms of curvature, c) the length of the shape both above and below the torso of the wearer, d) the shape, size, and jet black color of both ends, e) the location of the head and arm cutouts which dictate how the costume drapes on and protrudes from a wearer

⁷¹ *Id.*

⁷² *Id.* at 1012.

⁷³ *Silvertop Assoc., Inc. v. Kangaroo Mfg., Inc.*, 319 F.Supp. 3d 754 (D.N.J. 2018).

(as opposed to the mere existence of the cutout holes), f) the soft, smooth, almost shiny look and feel of the chosen synthetic fabric, g) the parallel lines which mimic the ridges on a banana in three-dimensional form, and h) the bright shade of a golden yellow and uniform color that appears distinct from the more muted and inconsistent tones of a natural banana.⁷⁴

The court then applied the *Star Athletica* separability test to determine that the banana costume design was protectable, notwithstanding that a costume is a useful object.

The Court finds that, if these features were separated from the costume itself and applied on a painter's canvas, it would qualify as a two-dimensional work of art in a way that would not replicate the costume itself. The Court thus finds, although it uses elements that might in and of themselves not be protectable standing alone, that the design when considered as a whole is separable and eligible for copyright protection. Plaintiff's design is not like the familiar iconic outfit of a cheerleader known to all at issue in *Star Athletica*. Rather, it has unique pictorial, graphic, or sculptural features that did not exist until it was created. To be sure, the Banana Costume is unlikely to end up in the Philadelphia Museum of Art but it represents artistic and stylistic choices. Its unique features reflect an “imaginative spark.”⁷⁵

B. Originality

Copyright protects a particular artistic expression; it does not protect an idea or a concept.⁷⁶ As relevant to fashion products, copyright can protect a particular image on a t-shirt, floral pattern on fabric,⁷⁷ embroidery pattern on a jeans pants pocket, or even a piece of jewelry in the shape of a heart. Copyright, however, does not protect the ideas of t-shirts with graphic prints, fabric with flowers, jeans with embroidered pockets, or heart-shaped jewelry.

Copyright can also protect an original arrangement of unprotectable elements. Thus, an artist can take images of flowers that individually would not be protectable and arrange them in an original way so that the particular arrangement of them could become a protectable design. In *L.A. Printex Indus. v. Aeropostale*,⁷⁸ the Ninth Circuit explained,

[The asserted copyright] is a repeating pattern of bouquets of flowers and three-leaf branches. The idea of a floral pattern depicting bouquets and branches is not

⁷⁴ *Id.* at 764-65.

⁷⁵ *Id.* at 765 (footnotes omitted).

⁷⁶ 17 U.S.C. § 102(b). (1990).

⁷⁷ The tools available to protect fashion have developed significantly since the Second Circuit rejected a designer's claim in *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929). In *Cheney Bros.*, a silk designer sued a competitor for copying a fabric pattern. Because copyright protection was not then available for fabric designs, the plaintiff attempted to sue for product imitation under the common law. The court held that a plaintiff must rely on theory of intellectual property protection provided by statute.

⁷⁸ *L.A. Printex Indus. v. Aeropostale*, 676 F.3d 841 (9th Cir. 2012).

protectable, and [the asserted copyright] has elements that are not protectable, for example the combination of open flowers and closed buds in a single bouquet or the green color of stems and leaves. However, [the plaintiff's] original selection, coordination, and arrangement of such elements is protectable.⁷⁹

If a particular idea (for example, fabric bearing a floral pattern) can be expressed in a large number of ways, then the particular design may enjoy protection. As stated by the Ninth Circuit, there is a wide range of expression for selecting, coordinating, and arranging floral elements in stylized fabric designs. Thus, for floral patterns, “copyright protection is ‘broad’ and a work will infringe if it’s ‘substantially similar’ to the copyrighted work.”⁸⁰

For some ideas, there are fewer possible means of expression, and thus, copyright protection is narrower. The Ninth Circuit has illustrated this distinction by contrasting floral patterns with images of balls and jelly-fish.

“[T]here are gazillions of ways” to combine petals, buds, stems, leaves, and colors in floral designs on fabric, in contrast to the limited number of ways to, for example, “paint a red bouncy ball on a black canvas” or make a lifelike glass-in-glass jellyfish sculpture.⁸¹

Thus, to determine whether the defendant infringed the floral pattern in *L.A. Printex*, the Ninth Circuit looked to the similarities of the protectable elements in the copyrighted design and accused infringing design. The court observed that both patterns included:

two types of small bouquets of flowers, one featuring the largest flower in profile view, the other featuring the largest flower in an open-face view, and both emerging from three buds. Both patterns also depict small, three-leaf branches interspersed between the two types of bouquets. The shape and number of the flower petals and leaves are similar in the two designs. The two types of bouquets are arranged at similar angles in both designs, and the bouquets and branches are coordinated in similar spatial combinations on a grid of similar scale and layout.⁸²

The court noted the “markedly similar” color arrangements, and acknowledged that the designs were not identical. The flowers, stems, and leaves in the defendant’s design were less detailed, and did not use multiple color shades. The court, however, found that those differences were not sufficient to support summary judgment of noninfringement. “[B]ecause we conclude that stylized fabric designs like [the copyrighted design] are properly entitled to broad copyright protection, it is not necessary that Defendants’ design be ‘virtually identical’ to infringe.”⁸³

⁷⁹ *Id.* at 850 (internal citations omitted).

⁸⁰ *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 913-14 (9th Cir. 2010).

⁸¹ *L.A. Printex Indus.* at 850-51 (quoting *Mattel, Inc.* at 913-14) (citing *Satava v. Lowry*, 323 F.3d 805, 812 (9th Cir. 2003)).

⁸² *Id.* at 851 (record citations omitted).

⁸³ *Id.*

Courts have applied similar analysis in the context of jewelry. In *Van Cleef & Arpels Logistics, SA v. Landau Jewelry, et al.*,⁸⁴ a district court considered an alleged copyright for a necklace that included clover-shaped features.



The court found that, although the clover's shape is common, there was sufficient originality in the manner in which the plaintiff had arranged the elements into its jewelry design.

In contrast, in *Todd v. Mont. Silversmiths*,⁸⁵ a district court held that barbed wire jewelry was not copyrightable because the jewelry was not minimally creative nor original enough to distinguish the barbed wire jewelry from actual barbed wire. An example of the barbed wire jewelry is below (left), in contrast to actual barbed wire (right).



C. Damages

Two general forms of damages are available for copyright infringement. First, the copyright owner can obtain its actual damages (such as lost profits) and any additional profits made by the infringer.⁸⁶ Second, in the alternative, the copyright owner may obtain statutory damages. A court may award statutory damages in a sum that is not less than \$750 or more than \$30,000, for each infringed work.⁸⁷ If the copyright owner proves that the defendant willfully

⁸⁴ *Van Cleef & Arpels Logistics, SA v. Landau Jewelry, et al.*, 547 F.Supp. 2d 356 (S.D.N.Y. 2008).

⁸⁵ *Todd v. Mont., Silversmiths*, 379 F.Supp. 2d 1110 (D.Colo. 2005).

⁸⁶ 17 U.S.C. § 504(a). (2018).

⁸⁷ 17 U.S.C. § 504(c)(1).

infringed, the court may increase the award of statutory damages to an amount up to \$150,000.⁸⁸ If the defendant proves that it was not aware and had no reason to believe its acts constituted infringement, the court may reduce the award of statutory damages to an amount not less than \$200.⁸⁹

Copyright is an effective option for protection of fashion product designs where:

- the product design incorporates a pictorial, graphic, or sculptural work that is separable from the useful article; and
- the pictorial, graphic, or sculptural features of the design are sufficiently original to qualify for copyright protection.

V. Conclusion

Although United States law provides tools for protection of fashion designs, no single tool provides the complete answer. Some tools are only available for certain types of products. A design patent cannot be obtained for a product that has been on sale for more than one year. Trade dress protection is unavailable for a product design that has not yet acquired secondary meaning. Copyright will not protect a product design where the original design features are not separable from the useful article into which the features have been incorporated.

At the same time, some product designs can be protected using more than one of these tools. A product's design can initially be protected with a design patent. If secondary meaning later develops, the manufacturer can rely on trade dress. Many fashion products can be protected by design patents or copyrights. In addition, many fashion products contain features that can be protected by all of the intellectual property rights discussed. A single product could incorporate a new feature that can be protected by a design patent; a word or design mark that can be protected as a trademark; older, established design features that can be protected as trade dress; and pictorial, graphic, or sculptural features that can be protected by copyright. Although United States law does not provide a one-size-fits-all tool for protecting fashion designs, United States law does provide a tool box with enough tools, that are versatile enough, that a manufacturer can protect almost any original design.

⁸⁸ 17 U.S.C. § 504(c)(2).

⁸⁹ *Id.*