Is That Bag Prada or Prado?:
Protecting Fashion Industry Intellectual Property

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In April 2009, Canadian journalist and blogger Nathalie Atkinson posted a side-by-side comparison of two seemingly identical jackets made by two different designers. *See* National Post Online, *Copycats: A Tale of Two Jackets* (as of Aug. 12, 2009).

From the images alone, it looked like another classic case of copying within the fashion industry. But this story had a twist: Diane von Furstenberg, iconic fashion designer, head of the Council of Fashion Designers of America and driving force behind legislation to protect fashion industry intellectual property, appeared to have copied the work of a more obscure designer.

Atkinson had been looking through the latest issue of Teen Vogue and noticed a Diane von Furstenberg jacket – a jacket that looked very much like a jacket Atkinson already owned. However, the jacket she owned was from the lesser-known Mercy's Spring 2008 collection, not Diane von Furstenberg's Spring 2009 collection. Atkinson found this particularly newsworthy because Diane von Furstenberg was so protective of her own designs, having sued both Forever 21 and Target for copying. Diane von Furstenberg also is one of the main proponents of the Design Piracy Prohibition Act, recently introduced in Congress for the third time, which would provide increased copyright protection for the fashion industry. Ultimately, after Atkinson exposed the similarity between the two jackets, Diane von Furstenberg called Mercy to privately settle the matter. Of course, not every designer is so fortunate as to have Diane von Furstenberg's resources or her sense of moral duty. So, how should designers protect their intellectual property?

Design Patent

Fashion designers may attempt to protect their work through design patents. Some have even successfully done so. For example, Stuart Weitzman obtained a design patent on a buckled ballet

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flat shoe. *See* U.S. Patent No. D545,038 (issued June 26, 2007). This patent served as the basis of an infringement suit filed against J.C. Penney in March 2008.

However, a design patent will not issue if the design is used primarily for a functional or utilitarian purpose. The design may have a useful function, as long as the usefulness is derived from the appearance of the design and its main purpose. *See Rosco Inc. v. Mirror Lite Co.,* 64 USPQ2d 1676 (Fed. Cir. 2002) (Court held design patent for oval-shaped "cross-view" school bus mirror is not invalid for functionality even though claimed mirror exhibited superior field of view and aerodynamics over other mirrors). Thus, design patents are not often available to protect fashion designs – the very nature of clothing suggests a utilitarian function, making it hard for judges to separate the useful elements of the design from the aesthetic ones. *See* Lynsey Blackmon, Comment, The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion, 35 Pepp. L. Rev. 107 (2007). Even less common is a fashion designer who is able to create something that is useful, non-obvious, and novel enough to warrant a utility patent. *But see* U.S. Patent No. 6,704,942 (issued March 16, 2004) (for SPANX pantyhose undergarment).

Trademark and Trade Dress

Trademark and trade dress protection arguably have been the most successful means of protecting fashion industry designs. Trademarks and trade dress protect the source identifying function of a design rather than the actual design itself. Within the fashion industry, trademark registrations have been issued for everything from the ubiquitous Louis Vuitton toile print to Christian Louboutin's red shoe sole.

Despite the fashion industry's success in obtaining trademark registrations for various designs, these statutory rights have still failed to provide sufficient protection from knockoffs in some cases. For example, Louis Vuitton lost its recent trademark infringement suit against Dooney & Bourke over Dooney & Bourke's sale of white purses with a multicolored DB mark that Louis Vuitton alleged was similar to its white purses featuring a multicolored version of their toile. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.,* 79 USPQ2d 1481 (2d Cir. 2006). Also, while Christian Louboutin's red shoe sole has become well-known among the shoe consuming public, this did not stop Steve Madden from producing a shoe that was almost an exact replica – except for the fact that the sole was orange.

Trade dress protection for designs is difficult to obtain since the Supreme court's decision in *Wal-Mart v. Samara Bros*., which required fashion designs to acquire secondary meaning in order to gain trade dress protection. 529 U.S. 205 (2000). As a result, clothing designs are generally not protected as trade dress.

Copyright

A fashion design may be eligible for copyright protection as a pictorial, graphic, or sculptural work if the ornamental aspect of the design can be physically or conceptually separated from its utilitarian function. *See Kieselstein-Cord v. Accessories by Pearl, Inc*., 632 F.2d 989 (2d Cir. 1980) (holding that a belt buckle could be protected via copyright because the buckle was conceptually separate from its functional purpose). The print on a garment also may be protected under traditional copyright protection for pictorial works. Thus, a designer will often use such a copyright as the basis for an infringement suit against a knockoff dress. See *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc*., 169 F. Supp. 142 (S.D.N.Y. 1959) (holding that the pattern on a piece of fabric is copyrightable). Generally, however, fashion designs are not protected under copyright law because they are useful articles.

Currently, the House Judiciary Committee is reviewing the Design Piracy Prohibition Act ("DPPA"), which would amend the Copyright Act to treat fashion designs like other copyrightable works. Some members of the fashion industry, such as Diane von Furstenberg, Narciso Rodriguez, and Tim Gunn, support this amendment. Others, however, argue that limited intellectual property protection for fashion designs actually helped the rapid expansion of the industry.

Overall, intellectual property protection for fashion industry designs is limited, but possible. Regardless of whether or not the DPPA actually passes and provides extended protection to designers, those involved in the fashion industry must remain cognizant of their intellectual property rights.

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