

The Trademark Reporter®



The Law Journal of the International Trademark Association

FASHION ISSUE

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**PROTECTING FASHION:
A COMPARATIVE ANALYSIS OF FASHION DESIGN
PROTECTION IN THE UNITED STATES AND THE
EUROPEAN UNION***

*By Francesca Montalvo Witzburg***

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* Adapted by the author from Francesca Montalvo Witzburg, *Protecting Fashion: A Comparative Analysis of Fashion Design Copyright Protection in the U.S. and Europe*, Cardozo Arts & Ent. L.J. Blog (Sept. 19, 2014) (available at <http://www.cardozoelj.com/2016/12/01/protecting-fashion-comparative-analysis-fashion-design-protection-united-states-europe/> (last accessed Dec. 19, 2017)).

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I. INTRODUCTION

In 2016, the United States apparel and footwear industry was valued at \$358.88 billion.¹ Fashion is not just a business—it also has aesthetic, cultural and historical value.² Despite the economic and artistic significance of fashion, the tailoring and structural aspects of a fashion article are generally not protectable under U.S. copyright law. However, certain features exhibited on or components incorporated into a fashion article may be protectable. By example, an unprotectable dress shape or tailoring pattern may feature an intricate textile or bead design that merits protection under U.S. copyright law. Likewise, an unprotectable t-shirt may display a protectable graphic image, art work, or even a trademark. In contrast, the European Union has several legal mechanisms for protecting entire fashion designs and articles under EU and EU Member State laws. This article compares the intellectual property protections available for fashion designs in the United States, including the potential impact of the recent Supreme Court decision addressing conceptual separability under copyright law in the *Star Athletica, L.L.C. v. Varsity Brands, Inc.*³ case, with the intellectual property protections available for fashion designs in the European Union and the EU Member States of France, Italy, and the United Kingdom.

II. FASHION DESIGN PROTECTION IN THE UNITED STATES

A. Limited Fashion Design Protection under U.S. Trademark and Patent Law

In the United States, the three main categories of intellectual property rights available for fashion design protection are copyrights, trademarks (including trade dress), and patents. As discussed below, each right presents an opportunity for the protection of fashion articles, with designers relying heavily on trademark and trade dress protection, design patent protection,

1. Statista.com, *Facts on the apparel market in the U.S.*, <https://www.statista.com/statistics/491214/apparel-and-footwear-united-states-market-value/> (last visited June 25, 2016).

2. Prominent museums have devoted their halls to fashion exhibits, such as the Metropolitan Museum of Art's Alexander McQueen exhibit, "Savage Beauty," and the Met's "Punk: Chaos to Couture" exhibit. Fashion exhibits such as these illustrate the artistic, cultural, and historical significance of fashion. See *Alexander McQueen: Savage Beauty*, The Metropolitan Museum of Art, <http://blog.metmuseum.org/alexandermcqueen/> (last visited June 25, 2017); see also *PUNK: Chaos to Couture*, The Metropolitan Museum of Art, <http://www.metmuseum.org/en/exhibitions/listings/2013/punk> (last visited June 25, 2017).

3. 580 U.S. ____ (2017).

and, to a lesser degree, copyright protection, to gain enforcement rights against marketplace competitors.

Trademark law provides a form of protection for the word marks and logos appearing on a fashion article, if they operate to identify the source of the goods. Thus, designers and fashion houses may protect their goods by adopting a distinctive trademark that allows the consuming public to recognize the fashion article's source.⁴ Designers and brands can also seek trade dress protection in "the overall commercial image (look and feel) of a product that indicates or identifies the source of the product and distinguishes it from those of others."⁵ Trade dress may protect the nonfunctional and distinctive elements of a fashion good, such as size, shape, color and texture, and the overall look and feel.⁶

To function as a trademark, the design itself must identify the source of the fashion article, which may be difficult to prove without sufficient evidence of acquired distinctiveness to demonstrate that consumers have come to recognize the design. Some designers and brands incorporate their logos or marks into the fashionable item in order to distinguish their designs.⁷ However, if a designer obtains protection for the logos incorporated into a fashion design, it needs to consider the possibility that if the underlying design becomes popular, copycats may use the same design on their goods without legal consequence since only the logos are protected and not the design itself. Once others use the design, it may be difficult to prove that the design points to the original creator as the source and functions as a trademark.⁸ This gap is what allows fast-fashion companies, namely, companies that quickly utilize designs from the runway to capture current fashion trends, to exist.

A designer may also be able to apply for a U.S. design patent,⁹ which protects any "new, original and ornamental design for an

4. Christiane Schuman Campbell, *Protecting Fashion Designs Through IP Law*, Duane Morris, https://www.duanemorris.com/articles/protecting_fashion_designs_through_ip_law_5516.html (April 14, 2015) (last visited Dec. 12, 2017).

5. *Trade Dress*, International Trademark Association, Fact Sheets: Types of Protection <http://www.inta.org/TrademarkBasics/FactSheets/Pages/Trade-Dress.aspx>.

6. See Michelle Mancino Marsh & Natasha Sardesai-Grant, *Safe Protection/Safe Inspiration: An Introduction to Intellectual Property Law for Fashion Designs*, 2012 *Emerging Issues* 6821 (Dec. 12, 2012).

7. For example, Burberry incorporates its famous plaid design into its products designs. See also TMEP Section 1202.19 for repeating pattern marks.

8. See Jenna Sauers, *How Forever 21 Keeps Getting Away With Designer Knockoffs*, (July 20, 2011 4:20 P.M.) <http://jezebel.com/5822762/how-forever-21-keeps-getting-away-with-designer-knockoffs>.

9. Some iconic fashion design patents include Bottega Veneta's "Veneta" handbag, U.S. Patent No. D657,952 and Jimmy Choo's "With a Twist," U.S. Patent No. D529,264. See Marsh & Sardesai-Grant, *supra* note 6.

article of manufacture.”¹⁰ A design patent presents an opportunity to protect fashion designs themselves, but with protection limited only to elements of the design that are “novel.” A U.S. design patent is a useful tool to protect aspects of a fashion design that are eligible for such protection.¹¹ Because the United States Patent Office (USPTO) grants only patents for “new” designs or “new” features of designs, mere re-workings of previously existing designs cannot obtain patent protection.¹² And because fashion designs often incorporate pre-existing designs, many do not qualify for design patent protection.¹³

B. Current Copyright Protection

As mentioned above, certain elements of fashion may be protected by U.S. copyright law, which protects “original works of authorship fixed in any tangible medium of expression.”¹⁴ For a work to be original, it need only be “independently created by the author (as opposed to copied from other works), and . . . possess . . . at least some minimal degree of creativity.”¹⁵ In the United States, copyright protection is automatic, but copyright owners can register their copyrights with the U.S. Copyright Office.¹⁶ Registration is a prerequisite for certain remedies, including, in most circuits, the right to sue for copyright infringement.¹⁷ The originality requirement for copyright is a lower hurdle than the “novelty”

10. 35 U.S.C. § 171 (2012). This section lists various types of works considered “works of authorship” for the purpose of this section, and apparel is not listed: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. *Id.*

11. See Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J. Law & Tech. 251 (2011), <http://scholarship.law.unc.edu/cgi/viewcontent.cgi?article=1184&context=ncjolt>; see also Gene Quinn, *Design Patents: The Under Utilized and Overlooked Patent*, Sept. 10, 2016, <http://www.ipwatchdog.com/2016/09/10/design-patents/id=72714/>.

12. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 Va. L. Rev. 1687, 1704 (2006). <http://www.virginialawreview.org/sites/virginialawreview.org/files/1687.pdf>.

13. *Id.*

14. 17 U.S.C.A. § 102 (West 2016).

15. *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345, (1991) (citing 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* §§ 2.01[A], [B] (1990)).

16. 17 U.S. Code § 412.

17. 17 U.S. Code § 412. Garrett M. Johnson, *Court Circuitry Split - Registration or Application Prior to Copyright Infringement Suit*, available at https://www.americanbar.org/groups/entertainment_sports/announce/es-blog/2017/06/court_circuitry_spli.html.

requirement that must be met to obtain a design patent.¹⁸ “Originality requires independent creation plus a modicum of creativity.”¹⁹ “The author’s expression does not need to be novel, and it does not need to be presented in an innovative or surprising way.”²⁰ However, fashion designs are not a protected category of work in their own right under U.S. copyright law, which excludes from protection the particular manner a garment is cut and sewn, by example, in contrast to patent law, which can protect manufacturing processes and product design through utility patents, if legal thresholds are met.²¹

Professor David Nimmer differentiates between two concepts that fall under the term “fashion designs”: (1) “fabric designs” and (2) “dress designs.”²² Fabric designs are the patterns appearing on the fabric that constitutes an article of clothing, such as the floral design repeated on a blouse, and these are copyrightable.²³ However, copyright does not extend to dress designs, for instance, which “graphically set . . . forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment.”²⁴ Clothing historically has been considered a “useful article” as defined in Section 101 of the Copyright Act because it has “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”²⁵ The design of a garment can only acquire copyright protection if it “can be identified separately from, and [is] capable of existing independently of, the utilitarian aspects of the article,” as set out in Section 101 of the Copyright Act.²⁶ Until the recent Supreme Court case *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. ____ (2017), Courts construed this section as the “physical” or

18. Lisa J. Hedrick, *Tearing Fashion Design Protection Apart at the Seams*, 65 Wash. & Lee L. Rev. 215, 226 (2008).

19. *Feist*, 499 U.S. at 346.

20. The Compendium of U.S. Copyright Office Practices: Chapter 300, at 9, citing *id.* at 362, available at <https://www.copyright.gov/comp3/chap300/ch300-copyrightable-authorship.pdf>.

21. Nimmer on Copyright, *supra* note 15, at § 2.08 [H].

22. *Id.*

23. *Id.* (citing *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142 (S.D.N.Y. 1959); *Peter Pan Fabrics, Inc. v. Acadia Co.*, 173 F. Supp. 292 (S.D.N.Y. 1959), *aff'd*, 274 F.2d 487 (2d Cir. 1960); *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F. Supp. 334 (S.D.N.Y. 1960); *Spectravest, Inc. v. Mervyn’s, Inc.*, 673 F. Supp. 1486 (N.D. Cal. 1987)).

24. Nimmer on Copyright, *supra* note 15, at § 2.08[H].

25. 17 U.S.C. § 101 (2012). However, Professor Nimmer believes that not all clothing has an intrinsic utilitarian function, but rather some clothing items may be “intended to portray the appearance of the article” and offers men’s ties as a possible example. Nimmer on Copyright, *supra* note 15, §2.08 [H] (citing Nimmer on Freedom of Speech, § 3.06(E)(3)).

26. *See* 17 U.S.C. § 101.

“conceptual” separability test.²⁷ Physical separability was demonstrated when the decorative elements could “actually be removed from the original item and separately sold, without adversely impacting the article’s functionality.”²⁸ Conceptual separability was demonstrated when the garment “invoke[d] in the viewer a concept separate from that of the [garment’s] ‘clothing’ function,” and the additional function “was not motivated by a desire to enhance the [garment’s] functionality qua clothing.”²⁹ For example, a fabric design—the repeated floral print—is capable of existing separately from the actual skirt, but the dress design—the tailoring and the shape of the skirt—cannot exist separately from the skirt.³⁰ Copyright protection only extends to the portion that is unique and not the functional aspect.³¹

For certain articles of clothing that may appear to serve an additional function other than the typical function of clothing (that being to cover a person’s body)—for example, costumes, prom dresses, or employee uniforms—the actual designs may be copyrightable.³² In 2005, the U.S. Court of Appeals for the Second Circuit in *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005), held that copyright law may protect Halloween costumes if the costume’s design elements can be separated from the overall function of the costume as clothing.

But on the spectrum of articles of clothing with specifically decorative functions, the U.S. Court of Appeals for the Second Circuit denied copyright protection to the design of a prom dress in a 2012 unpublished decision, *Jovani Fashions v. Fiesta Fashions*, 12-598-cv, 2012 WL 4856412 at *1, specifically “the arrangement of decorative sequins and crystals on the dress bodice; horizontal satin

27. See *Jovani Fashions, Ltd. v. Fiesta Fashions*, No. 12-598-cv, 2012 WL 4856412 at *1 (2d Cir. Oct. 15, 2012) (citing *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.* 413 F.3d 324 (2d Cir. 2005) (“We have construed 17 U.S.C. § 101 to afford protection to design elements of clothing only when those elements, individually or together, are separable—‘physically or conceptually’—from the garment itself.”)).

28. *Chosun*, 413 F.3d 324, at 329.

29. *Id.*

30. See Nimmer on Copyright, *supra* note 15, at § 2.08(H).

31. “Copyright never protects the mechanical or utilitarian aspects of an article, whether useful or not. No matter how novel, distinctive, or aesthetically pleasing any clasps, motors, or other functioning parts of an article may be, copyright does not protect them.” Copyright office at <https://www.copyright.gov/fls/fl1103.pdf>.

32. See *Chosun*, 413 F.3d 324 at 326 (stating that costumes may be copyrightable); *But see Jovani Fashions, Ltd. v. Fiesta Fashions*, No. 12-598-cv, 2012 WL 4856412 (2d Cir. Oct. 15, 2012) (explaining that *Jovani* did not have a plausible copyright claim because the aesthetic and functional features of the prom dress are inseparable); see also *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411 (5th Cir. 2005) (“[D]esigns were not copyrightable absent showing that they were marketable independently of their utilitarian function as casino uniforms.”).

ruching at the dress waist; and layers of tulle on the skirt.”³³ The Court noted “that clothing, in addition to covering the body, serves a ‘decorative function,’ so that decorative elements of clothing are generally ‘intrinsic’ to the overall function, rather than separable from it.”³⁴ The U.S. Court of Appeals for the Fifth Circuit, in *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 422 (5th Cir. 2005), similarly denied copyright protection for uniforms of casino workers because the clothing designer could not show that “its designs [were] marketable independently of their utilitarian function as casino uniforms.”³⁵ The Fifth Circuit admitted that “[t]he caselaw on costume design is, to say the least, uneven.”³⁶

The U.S. Supreme Court’s 1954 decision in *Mazer v. Stein*³⁷ held that the original design aspects of otherwise functional articles may be copyrighted, and the holding thereafter became codified as part of the Copyright Act in 1976.³⁸ From 1954 until 2017, U.S. courts struggled to apply the various separability tests that have emerged over the years to determine whether an article of clothing’s design elements are purely utilitarian or are capable of existing separately from the item’s utilitarian purpose.³⁹ Previously, such tests included aspects addressing physical separability, intent, and marketability.⁴⁰ In March 2017, the U.S. Supreme Court issued its decision in the landmark case, *Star Athletica v. Varsity Brands, Inc.*, which established a single test to determine copyrightability of designs incorporated in useful articles.⁴¹

33. *Jovani Fashions*, No. 12-598-cv, 2012 WL 4856412 at *1. Citing *Mazer v. Stein*, the court held that Jovani failed to meet the separability requirements because “Jovani has not alleged, nor could it possibly allege, that the design elements for which it seeks protection could be [physically] removed from the dress in question and separately sold.” *Id.* (citing *Mazer v. Stein*, 347 U.S. 201 (1954)).

34. *Id.*; see also Sheppard Mullin Richter Hampton LLP- Los Angeles Office, *Jovani Fashion, Ltd. v. Fiesta Fashions: Second Circuit Finds Dress Designer’s Copyright Claim Weak at the Seams* (Dec. 3, 2012), http://www.martindale.com/intellectual-property-law/article_Sheppard-Mullin-Richter-Hampton-LLP_1635964.htm (citing *Jovani*).

35. *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 422 (5th Cir. 2005).

36. *Id.* at 420.

37. *Mazer v. Stein*, 347 U.S. 201 (1954).

38. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (Oct. 19, 1976).

39. See generally, Brief of Amicus Curiae New York Intellectual Property Law Association in Support of Neither Party, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 136 S. Ct. 1823 (2016) (No. 15-866), http://www.scotusblog.com/wp-content/uploads/2016/07/15-866_amicus_np_new_york_intellectual_property_law_association.pdf.

40. See Norman J. Leonard, *Applying Copyright Law to Useful Articles - A Dispute Over Cheerleading Uniforms May Result in a New, Unified Test*, <https://www.wardandsmith.com/articles/applying-copyright-law-to-useful-articles>, October 4, 2016.

41. *Id.* See *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 580 U.S. ____ (2017).

C. The Supreme Court Decision in Star Athletica v. Varsity Brands

Varsity Brands Inc. (Varsity) is a \$1.2 billion company owned by the \$3.5 billion private-equity firm Charlesbank Capital Partners; it controls 80 percent of the cheerleading uniform market, according to Slate.com.⁴² Varsity obtained over 200 U.S. copyright registrations for the “two-dimensional” designs incorporated into or otherwise displayed on its cheerleading uniforms. Varsity filed suit against Star Athletica (“Star”) alleging infringement of five of its registered copyrighted designs.⁴³ The U.S. District Court granted summary judgment in favor of Star, finding that Varsity’s designs did not qualify for copyright protection, as they served the utilitarian function of identifying the clothing as “cheerleading uniforms” and could not be separated from such function.⁴⁴ In a split decision, the U.S. Court of Appeals for the Sixth Circuit reversed, holding that the cheerleader uniform design elements were capable of existing independently because they could be applied to other apparel, or even framed as an artwork.⁴⁵ Star petitioned the Supreme Court for a writ of certiorari.⁴⁶

On March 22, 2017, the Supreme Court ruled that copyright law could protect cheerleader uniform designs. The Court set forth a new, two-part test to determine copyright protection for designs incorporated in useful articles:

An artistic feature of the design of a useful article is eligible for copyright protection 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 in some other medium if imagined separately from the useful article.⁴⁷

The Supreme Court affirmed the Sixth Circuit's finding that Varsity’s cheerleading uniform designs satisfy these requirements

42. Leigh Buchanan, *The Battle for the Cheerleading-Uniform Industry Is Surprisingly Cutthroat and Appropriately Glittery*, http://www.slate.com/blogs/moneybox/2016/02/22/rebel_wants_to_disrupt_the_surprisingly_entrenched_cheerleader_uniform_industry.html, Feb. 22, 2016; see also Morgan E. Pietz, Esq. & Trevor Maxim, *Star Athletica, L.L.C. v. Varsity Brands, Inc.* <http://www.gerardfoxlaw.com/news/legal-perspectives/star-athletica-llc-v-varsity-brands-inc/> (last visited Apr. 1, 2017).

43. *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, No. 10-2508, 2014 WL 819422 (W.D. Tenn. Mar. 1, 2014).

44. *Id.*

45. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 799 F.3d 468, 471 (6th Cir. 2015).

46. See *Varsity Brands*, 799 F.3d 468 (6th Cir. 2015), *petition for cert. filed*, 2016 WL 94219 (U.S. Jan. 5, 2016) (15-866), <http://www.scotusblog.com/wp-content/uploads/2016/05/SACP.pdf>.

47. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. ____ (2017).

under the new test promulgated by the Supreme Court. The decision harmonizes all prior circuit court tests, although some believe the decision may raise additional issues.⁴⁸ It remains to be seen if it will clarify interpretation of whether fashion articles are consistently protectable under copyright law.

Under the *Star Athletica* “imagination” test,⁴⁹ if a design not affixed to a useful article can be protected by copyright, then it can be protected even if it is affixed to the useful article. The new test no longer considers the creator's intent, the design's marketability and the design's physical separability. Notably, the Court clarified that copyright protection does not extend to the size, shape and cut of a fashion article.⁵⁰ Even though the Court established a new test, its application may lead to differing conclusions, as illustrated by Justice Breyer's dissent, which applies the Court's new test but reaches a different result, finding that the designs are not protectable.

The *Star Athletica* test raises interesting new possibilities not only for fashion, but also for other industrial designs such as furniture and houseware.⁵¹ The Court acknowledged that some patentable industrial designs could also satisfy the copyright separability test, which may herald an expansion of opportunities to protect designs under more than one statutory regime.⁵² The *Star Athletica* case arguably opens the door for fashion brands to seek greater protection and enforce those rights against others, including fast-fashion companies, such as Zara and H&M, which quickly adapt runway styles and trends for mass market retail sale direct to consumers. Illustratively, in April 2017, Puma filed an action against Forever 21, alleging infringement of design patents, trade dress, and copyright infringement based on alleged copying of a shoe line collaboration with Rihanna.⁵³ Puma cited the *Star Athletica* decision, claiming that the elements of each shoe involved in the case were “separable” enough for protection.⁵⁴ Puma sought a

48. Lee Burgunder, *Does Star Athletica Raise More Questions Than it Answers?* <http://www.ipwatchdog.com/2017/04/13/star-athletica-raise-questions-answers/id=81977/>, Apr. 13, 2017.

49. Jonathan E. Moskin, *C-O-P-Y-R-I-G-H-T: What Does That Spell?* *Star Athletica v. Varsity Brands Reimagines Protection for Useful Articles*, 107 TMR 776 (2017).

50. “In any event, as explained above, our test does not render the shape, cut, and physical dimensions of the cheerleading uniforms eligible for copyright protection.” *Star Athletica*, 580 U.S. ____ (2017) at 17.

51. Jonathan E. Moskin, *C-O-P-Y-R-I-G-H-T: What Does That Spell?* *Star Athletica v. Varsity Brands Reimagines Protection for Useful Articles*, 107 TMR 776, 777 (2017).

52. *Id.* at 778.

53. *Puma SE v. Forever 21, Inc.*, 2:17-cv-02523 (C.D. Cal).

54. *Puma SE*, 2:17-cv-02523 (C.D. Cal). See Loni Morrow, Loni and & Jonathan Hyman, Jonathan, *Puma Treads New Territory Hitting Forever 21 with Copyright Allegations after the Supreme Court's Star Athletica Decision*, Knobbe/Martens: Intellectual Property Law,

temporary restraining order and a preliminary injunction barring Forever 21 from selling the shoes at issue, but the judge refused both. After the refusal of the preliminary injunction, Puma issued a statement that it was “disappointed” and “frustrated” by the decision, specifically commenting that “[i]ntellectual property holders should be able to rely on U.S. courts to enforce their rights immediately when there has been harm and clear infringement,” particularly “in the fashion industry where trends are most valuable in the short term and infringers take advantage of this time frame.”⁵⁵

D. Legislative Initiative to Extend Copyright Protection to Fashion Designs—The IDPA

In an effort to expand copyright protection to fashion articles, a congressional proposal, the Innovative Design Protection Act of 2012 (the “IDPA”), was put forth to amend the Copyright Act’s definition of “useful article” to include apparel.⁵⁶ The IDPA proposed to grant protection to fashion designs for a period of three years and would prohibit a claim that a fashion design was copied from a protected design if it “(1) is not substantially identical in overall visual appearance to and as to the original elements of a protected design, or (2) is the result of independent creation.”⁵⁷

The debate continues as to whether extending copyright protection to fashion designs will help or hurt the U.S. fashion industry. The IDPA “has been heralded by [some of] the heads of the fashion industry as a tool that may finally level the playing field in the counterfeit goods and design infringement cases that have been exploding in recent years due to the ease at which individuals are able to steal designs.”⁵⁸ In contrast to the idea that unauthorized copying reduces innovation, some scholars believe that copying actually benefits the U.S. fashion industry.⁵⁹ According to Kal Raustiala and Christopher Sprigman, “piracy paradoxically benefits

<https://www.knobbe.com/news/2017/04/puma-treads-new-territory-hitting-forever-21-copyright-allegations-after-supreme-court> (last visited Apr. 4, 2017). See also Donahue, Bill Citing High Court, *Puma Sues Forever 21 For Copying Shoes*, <https://www.law360.com/articles/909009>.

55. Donahue, *supra* note 54.

56. See Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012).

57. Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012).

58. Kelly Grochala, *Intellectual Property Law: Failing the Fashion Industry and Why the “Innovative Design Protection Act” Should be Passed*, Seton Hall Law Student Scholarship (2014) (citing Guillermo C. Jimenez, *Fashion Law Editorial: Let’s Pass the New Design Piracy Bill*, Fashion Law Center (Sept. 13, 2012) (<http://fashionlawcenter.com/?tag=design-piracy>)).

59. See Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 Va. L. Rev. 1687 (2006).

designers.”⁶⁰ This “piracy paradox”—the notion that copying “actually promote[s] innovation and benefit[s] originators” in the U.S. fashion industry⁶¹—is why the debate continues in the United States and likely why no action has been taken since the introduction of the IDPA in 2012.⁶² Critics of the IPDA also believe it would increase legal costs for fashion designers as they would need to consult with lawyers to prevent copyright infringement claims.⁶³ There also is concern that it would indirectly increase the cost of apparel for consumers.⁶⁴

III. FASHION DESIGN PROTECTION IN THE EUROPEAN UNION: COPYRIGHT AND DESIGN RIGHTS

Intellectual property protection is at the heart of most European fashion business models. The industry is “driven by fast-paced innovation embodied in the creation of seasonal collections of new fashion designs.”⁶⁵ Europe remains the center of *haute couture*,⁶⁶ and the protection of fashion designs is a core feature of its cultural identity and legal regimes. In contrast to the United States, in the European Union, fashion products—including traditional apparel categories, accessories, and footwear—may be protected under national and EU design laws and national copyright laws.

60. *Id.* at 1722.

61. Eveline van Keymeulen & Louise Nash, *Fashionably Late*, Intellectual Property Magazine, Dec. 2011/Jan. 2012, at 53 (quoting Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 Va. L. Rev. 1687 (2006), <https://www.cov.com/~media/files/corporate/publications/2011/12/fashionably-late.pdf>).

62. Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012).

Coren also represents doctors and health care facilities in a variety of contexts, ranging from medical collections, contract review and negotiation, employment and labor issues, and other generalized litigation and regulatory issues that pertain to medical practitioners. Coren has experience dealing with payment and collection issues, with specific issues presented by out-of-network providers and direct patient reimbursement, and has advised a number of health care providers on best practices with respect to collecting on their outstanding accounts receivable. Coren successfully represented a physician named in a federal civil rights lawsuit, as well as a medical practice identified as a creditor in a bankruptcy proceeding. Michele Woods & Miyuki Monroig, *WIPO Fashion Design and Copyright in the US and EU*, WIPO (2015), available at http://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ipr_ge_15/wipo_ipr_ge_15_t2.pdf.

64. *Id.*

65. Keymeulen & Nash, *supra* note 61, at 53.

66. *Haute Couture*, Cambridge Advanced Learner’s Dictionary & Thesaurus (2016), <http://dictionary.cambridge.org/us/dictionary/british/haute-couture> (*Haute couture* can be defined as “(the business of making) expensive clothes of original design and high quality.”).

A. European Union Design Protection

The European Union implemented a uniform protection approach for design rights that has been embraced by the 28 EU Member States (i.e., the individual countries that comprise the European Union),⁶⁷ by first adopting the EU Designs Protection Directive (98/71/EC) (the “EU Directive”). The EU Directive harmonized national design protection regimes across all EU Member States by requiring them to protect “designs” by registration⁶⁸ and to define design as “the appearance of the whole or a part of a product resulting from the features of . . . the lines, contours, colours, shape, texture . . . or its ornamentation.”⁶⁹ To receive protection, the design must be “novel” and possess “individual character.”⁷⁰ In this context, “novelty” means that there are no identical designs already available to the public. A design has “individual character” if “the overall impression, from an informed user’s point of view, is different from other designs available to the public.”⁷¹

After adopting the EU Directive, which already provided rights for registered designs, the European Union enacted EU Regulation 6/2002, (the “EU Regulation”), which implemented a new, unique design right covering unregistered designs in the EU.⁷² The EU Regulation resulted in two types of EU design rights known as registered Community designs (“RCDs”) and unregistered Community designs (“UCDs”).⁷³ Registered and unregistered Community designs are afforded different rights in the EU. For example, registered designs are protected for a first term of five years from the application filing date and can be renewed in blocks of five years up to a maximum of twenty-five years. In contrast, unregistered Community designs only receive protection for three years from the date on which the design was first made available to

67. For a full list of the EU Member States, see https://europa.eu/european-union/about-eu/countries_en.

68. See Council Directive 98/71, art. 3, 1998 O.J. (L 289) 28, 30 (EC) [hereinafter EU Directive].

69. *Id.*, art. 1, at 30.

70. *Id.*, art. 3, at 30.

71. Note, Emma Yao Xiao, *The New Trend: Protecting American Fashion Designs Through National Copyright Measures*, 23 *Cardozo Arts & Ent. L.J.*, 405, 412 (“This is a heightened standard of infringement because even if a design has not been copied exactly, infringement can occur if it has the same overall impression on an informed user.”).

72. *Id.*

73. J.F. Bretonniere & Frédérique Fontaine, *Europe: Using Community design rights to protect creativity*, Building and enforcing intellectual property value 32 (2010), available at <http://www.iam-media.com/Intelligence/IP-Value/2010/Legal-perspectives-Cross-border/EuropeUsing-Community-design-rights-to-protect-creativity>.

the public⁷⁴ within the European Union, with no possibility of renewal.⁷⁵ Unregistered Community designs are useful in protecting “short-life products (e.g., products within the fashion industry),” because the registration process can be costly.⁷⁶

An application for a registered Community design can be filed directly with the EUIPO office.⁷⁷ An EU design can also be registered by filing an international application under the Hague System and designating the European Union or individual EU Member States to obtain design protection in the respective jurisdictions.⁷⁸ The Hague System is an international design registration system administered via the World Intellectual Property Organization (“WIPO”) that allows a design owner to file a single international application and designate (i.e., extend protection to) over 66 countries that are party to the Hague Agreement.⁷⁹

EU fashion designers have celebrated the decision in *Karen Millen v. Dunnes Stores* regarding unregistered design protection.⁸⁰ In January 2007, the popular British brand Karen Millen filed an action against Dunnes Stores based on an unregistered Community design right in its clothing, and commenced proceedings seeking an injunction and damages in the Irish High Court. Dunnes Stores appealed to the Irish Supreme Court, which stayed the proceedings and referred two questions to the Court of Justice of the European Union (“CJEU”), which ultimately determined that (1) for the purposes of individual character, the overall impression a design produces on a user must be different from that produced by a design or designs taken *individually*, and (2) the right holder does not need to prove the individual character of the unregistered EU design in the infringement action; the right holder need merely indicate the features giving rise to the individual character of the design.⁸¹ The

74. “The act of making available to the public is called ‘disclosure’. Disclosing a design and being able to prove it are key to design protection.” <https://euipo.europa.eu/ohimportal/en/designs-in-the-european-union>.

75. EUIPO, Designs in the European Union, <https://euipo.europa.eu/ohimportal/en/designs-in-the-european-union>.

76. *Id.*

77. <https://euipo.europa.eu/ohimportal/en/web/guest/rcd-apply-now>

78. For more on the international application process under the Hague Agreement, see http://www.wipo.int/edocs/pubdocs/en/designs/911/wipo_pub_911.pdf.

79. <http://www.wipo.int/hague/en/>.

80. *Karen Millen Fashions Ltd v. Dunnes Stores, Dunnes Stores (Limerick) Ltd*, Case C-345/13 (CJEU, June 19, 2014).

81. See Richard Hing & Leighton Cassidy, *Karen Millen Fashions Ltd v. Dunnes Stores, Dunnes Stores (Limerick) Ltd: Clarifying the Assessment of Individual Character in EU Designs*, 105 TMR 1446 (2015); see also Woods & Monroig, *WIPO Fashion Design and Copyright in the US and EU*, WIPO (2015).

decision provides greater certainty for designers that their unique designs qualify for unregistered design protection and reduces the risk of an infringer successfully challenging a design's validity based on the existence of individual elements of prior designs.⁸²

***B. EU National Design and Copyright Protection:
France, Italy, and the United Kingdom***

In addition to the registered and unregistered EU design protection opportunities, each Member State has its own design registration scheme that must comply with the EU Directive.⁸³ EU designers may also be able to rely on national copyright laws to protect designs that meet the conditions under which such protection is conferred, including the required level of originality. Such conditions are determined by each Member State.⁸⁴ Article 17 of the EU Directive requires that a design protected by a design right also be eligible for copyright protection. Therefore, a design protected by a design right in a Member State that also meets that Member State's conditions for copyright protection also must be eligible for copyright protection.⁸⁵ The European Commission's legal review on industrial design protection found that in the 15 EU Member States it examined, which included France, Italy, and the United Kingdom, "cumulative protection under copyright and design law is possible. In order to benefit from cumulative protection, the design needs to satisfy the requirements for copyright protection under copyright law, and the requirements for protection under design law."⁸⁶ While there is generally no such thing as an "international copyright" that will automatically protect creative works throughout the world, copyright owners in the EU may be able to claim protection in the United States or any other country that is a member of the Berne Convention.⁸⁷

82. *The Court of Justice of The European Union Strengthens Unregistered Community Design Rights*, Ladas & Parry, <https://ladas.com/education-center/court-justice-european-union-strengthens-unregistered-community-design-rights/>.

83. For more on why a business may chose national design protection or EU design protection, or vice versa, see https://www.iprhelphdesk.eu/competitive_advantages_achieved_through_design_protection.

84. *Id.* Competitive advantages achieved through design protection https://www.iprhelphdesk.eu/competitive_advantages_achieved_through_design_protection.

85. The European Court of Justice ("ECJ") decision in *Flos SpA v. Semeraro Casa e Famiglia SpA* (C-168/09, January 27, 2011) found that it was required. See <https://www.lexology.com/library/detail.aspx?g=4c6a2c63-398f-4b2b-a616-60ccb2020475>.

86. www.ecar-alliance.eu/wp-content/uploads/ET-04-16-452-EN-N.pdf.

87. International Copyright, U.S. Copyright Office, <https://www.copyright.gov/fls/fl100.html> ("Generally, the works of an author who is a national or domiciliary of a country that is a member of these treaties or works first published in a member country or published within

1. France

France, home of world premier *haute couture* fashion houses, embraces a national copyright system that has historically protected fashion designs.⁸⁸ The French Intellectual Property Code (the “IPC”) protects original works of the mind under Article L.112-1,⁸⁹ including those that “reflect the personality of their author” and expressly lists “the creations of the seasonal industries of dress and articles of fashion” as a protectable work of the mind in Article L.112-2.⁹⁰ The term of protection is the author's lifetime and 70 years thereafter.⁹¹ Design owners face the challenge of showing the original character of their work, because fashion designs usually follow the current trends and therefore may lack originality.⁹² French copyright law grants protection on the date of creation, regardless of registration.⁹³ French courts tend to adhere more strictly to the originality requirement for designs and typically will deny copyright protection for a design that could be considered commonplace.⁹⁴

New fashion designs in France may also be protected not only under national copyright law, but also by either or both a national French design and/or the EU design mechanisms discussed above. The French IPC protects registered designs that are new and have individual character; it does not, however, protect unregistered designs, although such designs are protectable under the EU unregistered design regime.⁹⁵

30 days of first publication in a Berne Convention country can claim protection under the treaties.”).

88. See Xiao, *supra* note 71, at 413; see also Keymeulen & Nash, *supra* note 61, at 54.

89. “The provisions of this Code shall protect the rights of authors in all works of the mind, whatever their kind, form of expression, merit or purpose.” Intellectual Property Code Article L 112-1, (Fr.), available at https://www.legifrance.gouv.fr/content/download/1959/13723/version/3/file/Code_35.pdf.

90. See [Intellectual Property Code] Article L-112-2 (14°) (Fr.); see also Holger Gauss, Boriana Guimberteau, Simon Bennett, Lorenzo Litt, *Red Soles Aren't Made for Walking: A Comparative Study of European Fashion Laws*, 5 *Landslide* 6, available at https://www.americanbar.org/publications/landslide/2012_13/july_august/red_soles_arent_made_walking_comparative_study_european_fashion_laws.html.

91. Intellectual Property Code Article L123-1. The term of copyright protection has been harmonized in the EU. See http://ec.europa.eu/internal_market/copyright/term-protection/index_en.htm.

92. See Gauss et al., *supra* note 90.

93. Xiao, *supra* note 71 (The grant of protection regardless of registration is “unlike different protection schemes given to registered and unregistered designs under the European Union regulations.”).

94. Gauss et al., *supra* note 90.

95. Julien Scicluna, Laurent & Charras, Protecting and enforcing design rights: France. *World Trademark Review*, available at <http://www.worldtrademarkreview.com/Intelligence/Design-Rights/2017/Country-chapters/France>.

2. Italy

Like France, Italy protects fashion designs under its national copyright system. The Italian Copyright Law (the “LDA”) protects “works of the mind having a creative character and belonging to literature, music, figurative arts, architecture, theater or cinematography, whatever their mode or form of expression,” and “[i]n particular, protection shall extend to . . . industrial design works that have creative character or inherent artistic character.”⁹⁶ Copyright registration is not mandatory, “but sometimes it could be recommended, in particular for catalogs of those fashion products like sunglasses and garments that are mostly seasonal and for which the design registration may be too expensive or not cost efficient.”⁹⁷ Under the LDA, a fashion designer of even an unregistered work having creative and artistic value can seek *ex parte* from the Italian courts an interim injunction authorizing the designer to seize any copies of his or her designs that have creative and artistic value and then seek a permanent injunction and damages for unregistered works.⁹⁸ A designer’s copyright endures for the life of the designer plus an additional seventy posthumous years.⁹⁹

Designs also can be protected with an Italian design registration, as the Italian Industrial Property Code protects designs registered with the Italian Patent and Trademark Office.¹⁰⁰ Italian law does not protect unregistered design rights, but unregistered designs can be protected by European unregistered design protection, as discussed above.¹⁰¹

3. The United Kingdom

In the United Kingdom, copyright protection is governed under the Copyright, Designs, and Patents Act of 1988 (“CDPA”). Original “artistic works” obtain automatic copyright protection in the United Kingdom.¹⁰² The CDPA defines an “artistic work” as “a graphic

96. Gauss et al., *supra* note 90 (citing Legge d’autore [LDA] 22 Aprile 1941, n. 633, pt. I, ch. I (It.)).

97. See Gauss et al., *supra* note 90.

98. *Id.*

99. Xiao, *supra* note 71 at 414 (citing Law No. 633 of April 22, 1941, Article 25, <http://www.wipo.int/edocs/lexdocs/laws/en/it/it211en.pdf>).

100. See *Information*, Società Italiana Brevetti, Information/ Italian designs, <http://www.sib.it/en/designs/design-registration-in-italy-and-the-eu/italian-designs/> (last visited Oct. 18, 2016).

101. Casucci, Giovanni Francesco, World Trademark Review, Italy Chapter <http://www.worldtrademarkreview.com/Intelligence/Design-Rights/2015/Country-chapters/Italy>.

102. *Id.*

work, photograph, sculpture, or collage, irrespective of artistic quality, a work of architecture being a building or a model for a building, or works of artistic craftsmanship.”¹⁰³ Fashion designs fall under the category of “works of artistic craftsmanship.” However, case law demonstrates that one must meet a high threshold to show that a work is of artistic craftsmanship, making it difficult to assert fashion design protection under copyright law.¹⁰⁴ Under the CDPA, a work is considered “commonplace in the design field in question at the time of its creation,” if it is not “original” for the purpose of the design right.¹⁰⁵

The United Kingdom also has a national UK registered design regime (“UKRD”) that mirrors the Registered Community Design in all substantive areas including validity and infringement rules. Although the popularity of this regime waned somewhat following the introduction of Registered Community Design protection in 2002, UK companies may need to rely on this right when the United Kingdom ultimately exits the European Union following the “Brexit” plan. UK design law also provides for a UK unregistered design right under the CDPA, but it does not precisely match the Registered Community Design right, which may be of concern post-Brexit.¹⁰⁶

4. Distinguishing Between Design Rights and Copyrights

Copyright protection granted under the national laws of France, Italy, and the United Kingdom are separate and distinct from the unique design rights designated under the EU Regulation and EU Directive. The availability of dual protection (copyright and design protection) over a fashion design may sometimes confuse courts and cause them to confuse the novelty requirement applicable to design protection and the originality requirement for copyrights. For example, the Paris Court of Appeals held that a shoe design was not only original, thus militating in favor of copyright protection, but also novel and possessing of individual character, thus militating in favor of design protection on the grounds that no identical model

103. Copyright, Designs and Patents Act, 1988, c. 48, § 4 (UK), http://www.wipo.int/wipolex/en/text.jsp?file_id=127294.

104. Iona Silverman, *Copyright and Fashion: A UK Perspective*, WIPO Mag., June 2014, available at http://www.wipo.int/wipo_magazine/en/2014/03/article_0007.html. Some think that it could be possible for a one-off piece, but maybe not for mass-products. Woods & Monroig, *supra* note 81.

105. Copyright, Designs and Patents Act, 1988, c. 48, § 213(4) (UK), http://www.wipo.int/wipolex/en/text.jsp?file_id=127294.

106. *Brexit and your designs*, Bird & Bird, June 8, 2017 <https://www.twobirds.com/en/news/articles/2016/uk/brexit-and-design-implications>.

was disclosed to the public and the overall impression imposed upon the consumer was different from that of other models disclosed to the public.¹⁰⁷ But the effort remains to distinguish copyright and design rights. In France, it may be possible for a fashion creation to be denied copyright protection but granted design protection. This was illustrated by a French Supreme Court decision involving a shoe design, in which the court rejected the protection of the shoe on the grounds that it had the same characteristics as a preexisting style, but upheld the design rights because the designs were not identical.¹⁰⁸

Overview of EU Copyright and Design Right Regimes

Country/ Jurisdiction	National Copyright	National Registered Design Protection	National Unregistered Design Protection	Registered Community Design	Unregistered Community Design Rights
EU, including all 28 EU Member States	N/A	N/A	N/A	Available	Available
France	Available	Available	Not available	Available	Available
Italy	Available	Available	Not available	Available	Available
UK	Available	Available	Available (does not precisely match the Registered Community Design right)	Currently available, but not after Brexit takes effect	Currently available, but not after Brexit takes effect

IV. CONCLUSION

Fashion designers and companies must consider the various fashion design intellectual property protection regimes available in the United States and the European Union and be aware of the differences. The European Union and some of its Member States offer broader intellectual property protections for fashion designers, arising out of Europe's reputation as a fashion hub and as a region noted for *haute couture* fashion houses.¹⁰⁹ Designers in the European Union have two main sources of intellectual property

107. SAS Chaussea v. SARL Menport (Court of Appeal of Paris, June 3, 2011).

108. J-M Weston v. Manbow, Cass., 1e civ., Apr. 5, 2012 (Fr.).

109. See Keymeulen & Nash, *supra* note 61 at 53.

protection for fashion designs: national copyright protection and design rights, which can be either under the EU or national design regimes.¹¹⁰ While a designer may choose to protect his or her designs under only one regime, concurrent protection may be available in certain EU Member States where a design is protected by design rights and also meets the Member State's copyright requirements.

In the United States, fashion designs may be afforded minimal protection under trademark and patent law, and currently only certain designs incorporated on fashion articles would be protected under copyright. While *Star Athletica* arguably opened the door for certain design aspects of clothing to be eligible for copyright, the Court made it very clear that the cut, shape, and dimensions of clothing articles are still not protectable. Despite recent proposals in Congress to amend the Copyright Act to include fashion articles as a copyrightable work and the recent Supreme Court decision in *Star Athletica*,¹¹¹ the U.S. fashion industry is a unique business that many believe actually benefits from rapid widespread copying, such that extending copyright protection to fashion articles may be unlikely to occur anytime soon.

110. Gauss et al., *supra* note 90.

111. *See* Innovative Design Protection Act of 2012, S.3523, 112th Cong. (2012).