

## INTELLECTUAL PROPERTY & LIFE SCIENCES

### Copyright Law Protection For Fashion Designs

By Craig S. Hilliard

Copyright law protects many different types of original works of authorship, such as books, paintings, sculptures and even the source code of computer programs. The core elements of a claim for copyright infringement seem simple enough. The person claiming infringement need prove only two things: ownership of a valid copyright and unauthorized copying of original elements of the work. Yet, the fashion world has never quite embraced the protections available under copyright law (or any other law) for even admittedly original clothing designs. In what is known in the industry as the “piracy paradox,” a considerable number of the industry’s members argue forcefully that “knockoffs” of designs are good because they force manufacturers to create new designs quickly, which satisfies the consumer’s constant demand for the “latest” trends. They also contend that copying allows clothing to be accessible to consumers who cannot afford the high-priced designer label. But an equally

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forceful voice in the industry rails against the piracy, arguing that the copycats destroy the incentive of manufacturers to invest in creative new designs. They argue that copying is not the only way to bring affordable clothing to consumers.

The arguments have mounted on both sides for many years. In 2009, legislation known as the Design Piracy Prohibition Act (H.R. 2196) was reintroduced in the U.S. Congress, and has galvanized the fashion industry once again in a spirited debate. If enacted, the legislation would broaden the protection for fashion designs. Historically, courts have been reluctant to recognize any sweeping protections because of the functional and utilitarian aspects of clothing designs. Although ultimately a legislative solution may enhance or otherwise change the protections given to clothing designs under the law, some limited protection does exist today under copyright law. In *Mon Cheri Bridals, Inc. v. Wen Wu*, 2010 WL 2222497 (June 4, 2010), the U.S. Court of Appeals for the Third Circuit recently affirmed a jury verdict of copyright infringement in favor of a manufacturer of social occasion dresses against an importer of “copycat” garments. The manufacturer, Mon Cheri Bridals, paid a leading designer to create

original lace and beading designs which appeared on the company’s best-selling dresses. Mon Cheri secured copyright registrations not on the dresses themselves, but on the particular embroidery and beading designs. Mon Cheri argued that the designs were “works of art” conceptually separable from the dresses themselves, and were entitled to protection under copyright law.

The Third Circuit agreed, holding that the designs were “sufficiently original” to support a claim for infringement. This was not new law. Lace and fabric designs incorporated into dresses “are considered ‘writings’ for purposes of copyright law and are accordingly protectible”. See *Eve of Milady v. Impression Bridal, Inc.*, 957 F.Supp. 484, 489 (S.D.N.Y. 1997). Moreover, the necessary level of originality and creativity in fabric designs is minimal. Only an “unmistakable dash of originality need be demonstrated, high standards of uniqueness in creativity are dispensed with.” *Folio Impressions*, 937 F.2d at 765. Under the Copyright Act, “original” means only that the work was independently created by the author (rather than copied from other works), and that it possesses at least some minimal degree of creativity.

In *Folio Impressions*, a fabric designer cut out photocopies of roses, arranged them in a pattern and then photocopied that pattern against a background. That design was then registered with the U.S. Copyright Office as “Pattern # 1365.” The Court in *Folio Impressions* rejected the

defendant's attack on originality:

The arrangement of the roses over the background portion of Pattern # 1365, while perhaps elementally symmetrical, does not appear to be designed to ease manufacture since, once the decision as to how to place the item against the background was made and executed, the whole piece was copied mechanically. Thus, it did not matter for manufacturing purposes of what the original design consisted. Rather, [the designer's] decision to place the roses in straight rows was an artistic decision. Further, there is no evidence that [the designer] copied the placement of the roses from any source. Consequently, the district court's finding that the particular arrangement given the Folio Rose in Pattern # 1365 was not original was clearly erroneous. Although the arrangement may have required little creative input, it was still [the designer's] original work and, as such, copyrightable.

In *Mon Cheri Bridals*, the designer sketched her beading and embroidery designs sometimes using common elements in the public domain. Even though these common elements had been used before in clothing designs, Mon Cheri argued that the designer nevertheless created original designs by her particular combination of the elements. The Third Circuit agreed, concluding that the designer's use of "inspiration" from common elements such as floral and leaf patterns did not fatally undermine originality, because the designer "rearranged" the elements, changing their size, color and frequency across the dress to create embroidery and beading patterns which made up an "original" work.

The Supreme Court has stated that

"[a]s a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection." See *Andrien v. Southern Ocean County Chamber of Commerce*, 927 F.2d 132 (3d Cir. 1991). Of course, the mere mechanical transposition of an author's expressions does not entitle the transposer to the right of authorship. On the other hand, the author does not lose copyright protection simply because she does not actually fix the work into its final expression. This was the reasoning of the Third Circuit in *Andrien*:

Poets, essayists, novelists, and the like may have copyrights even if they do not run the printing presses or process the photographic plates necessary to fix the writings into book form. These writers are entitled to copyright protection even if they do not perform with their own hands the mechanical tasks of putting the material into the form distributed to the public.

In *Mon Cheri Bridals*, the designer gave detailed instructions to the factories in China to make dresses in accordance with her designs. The factories did not have discretion to change her designs. The Third Circuit concluded that sufficient evidence was presented to the jury that Mon Cheri's designer was the author of each of the embroidery and beading patterns covered by the copyright registrations, even though the factories actually made the dresses.

An author need only show unauthorized copying of original elements of the author's work to sustain the infringement claim. *Parker v. Google, Inc.*, 242 Fed. Appx. 833 (3d Cir. 2007) (quoting *Costar Group, Inc. v. LoopNet, Inc.*, 373 F.3d 544, 551 (4th Cir. 2004)); *Kay Berry Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 203 (3d Cir. 2005); see *Dolori Fabrics, Inc. v. Limited, Inc.*, 662 F.Supp. 1347, 1354 (S.D.N.Y. 1987) (infringement of textile

converter's copyright on textile pattern by manufacturer of clothing was intentional, where manufacturer received samples of converter's pattern directly from converter, and samples were notice of converter's copyright, and instead of purchasing fabric from converter, manufacturer gave samples to rival textile converter who printed original converter's design on cheaper cloth and then sold it to clothing maker). Typically, the author proves copying by demonstrating that the alleged infringer had access to her work, and that "substantial similarity" exists between the protected work and the alleged copies. Proof of the actual copying of original elements of fabric designs is generally a question for the jury, because only the fact-finder can make the comparison between designs to determine whether there is substantial similarity. *Eve of Milady*, 957 F.Supp. at 489-90 ("An inspection of advertisements portraying plaintiffs' bridal dresses alongside defendants' bridal dresses provides additional indirect evidence regarding the extent of the similarity between the protectible elements of plaintiffs' and defendants' dresses. Although the idea of using a lace design is not entitled to copyright protection, a particular expression of the idea of using a lace design is copyrightable"). See also *BUC Int'l Corp. v. International Yacht Council Ltd.*, 489 F.3d 1129 (11th Cir. 2007) (issue of whether organization, selection, and arrangement of data in vessel listings included by publisher in factual compilation of information about yachts listed for sale was sufficiently creative to be original work of authorship is for jury).

The Third Circuit's recent decision in *Mon Cheri Bridals* did not announce new law, but reaffirmed the existence of limited protection under copyright law for original designs which appear on dresses and other garments. The garment itself and the shape and overall appearance of clothing cannot in fact be protected (at least under current law); however, copyright law remains a significant weapon in the arsenal of those in the fashion industry who create and manufacture original clothing designs. ■