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Article

**COUNTERFEIT FASHION: THE INTERPLAY BETWEEN COPYRIGHT AND TRADEMARK LAW IN ORIGINAL FASHION DESIGNS AND DESIGNER KNOCKOFFS**

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\*420 The fashion and apparel industry is big business in both the United States and abroad. With the growth of the fashion industry and the role of the media in disseminating fashion commentary, public awareness about prominent fashion

designers, and the creations of such designers is at an all-time high. The popularity and status attached to certain designers and their trademark designs, therefore, has led to the rise of “style piracy.” A style pirate will copy a designer’s original creative work to capitalize on the popularity or desirability of the product. The copying can occur in varying degrees, including attempts to pass off counterfeit copies as the original or the creation of “designer-inspired” products that seek to profit by giving the impression of relatedness to the original. Despite the potential loss of substantial revenue and exclusive control over the use of original designs facing designers, few legal rights exist to protect these valuable creative and economic interests from misuse by style pirates. Specifically, United States laws extend spotty legal protections, at best, against counterfeit and knockoff designs. The Copyright Act fails to provide adequate protection because its protection is generally limited to non-utilitarian designs. Thus, the inherent usefulness of apparel traditionally exists as a barrier to protection through copyright law. Given the shortcomings of copyright law, many designers have turned to trademark law and secondary meaning in trademarks as a means of circumventing the requirements of copyright law in order to defend against style pirates and achieve some modest level of design protection. Although trademark law has been extended to utilitarian items in some cases, only a small portion of designs will ever reach the level of recognition and notoriety required for this type of protection. The interplay of both copyright and trademark law in this area highlights (1) the fact that neither copyright law nor trademark law affords sufficient protection for the original designs of fashion designers and (2) the need for a more comprehensive plan for protecting creative but utilitarian works \*421 such as fashion designs. Based on the shortcomings of the copyright and trademark laws to provide adequate rights and remedies for fashion designers, this article argues that the copyright eligibility requirements should be extended to encompass the original and creative elements of fashion designs, such that the framework of copyright law, and not trademark law, becomes the primary method of design protection.

## I. Introduction

The apparel manufacturing industry generates hundreds of billions of dollars annually.<sup>1</sup> In 2007, Americans alone spent \$195.6 billion on apparel.<sup>2</sup> In 1999, sales of clothing and apparel were estimated at \$784.5 billion internationally.<sup>3</sup> The growth of the fashion industry has spawned an increased public awareness for fashionable “designer products.”<sup>4</sup> In light of the popularity of certain designers or specific designs, style piracy has increased exponentially.<sup>5</sup> Style piracy is “the copying of a designer’s original designs, ‘thereby securing, without expense, the benefit of his artistic work.’”<sup>6</sup> A common example of such activity is the counterfeiting of high-end fashion bags such as those produced by Louis Vuitton, Kate Spade, or Coach.<sup>7</sup> Although not exact copies, designer-inspired products also contribute to style piracy by giving the impression of relatedness to the designer product.<sup>8</sup> For example, Louis Vuitton filed separate lawsuits against Burlington Coat Factory and \*422 Dooney & Bourke for producing similar monogrammed handbags.<sup>9</sup> Admittedly, style piracy is not new,<sup>10</sup> but where it once took several years for a fashion to descend the price line to low-priced production, this progression is now nearly immediate.<sup>11</sup> Technological advances have made it possible for style pirates to obtain another person’s designs and manufacture duplicates overnight.<sup>12</sup> Because of the pervasiveness of style piracy, copying is now considered commonplace in the fashion industry.<sup>13</sup> Accordingly, the original designers of iconic fashion pieces stand to lose substantial amounts of revenue after expending capital to create the item.<sup>14</sup> Despite the lost revenue and the loss of exclusive control over the use of original fashion designs, little exists under current laws to protect the creative and economic interests of these original designers.

\*423 At best, the protection extended to fashion designs under United States law provides a spotty defense against counterfeit and knockoff designs. Under the Copyright Act, sufficiently original and non-utilitarian designs may qualify for protection.<sup>15</sup> The inherent usefulness of apparel, however, traditionally exists as a barrier to protection through copyright law.<sup>16</sup> Given the lack of protection available under copyright law, many designers have turned to trademark law and secondary meaning in trademarks as a means of circumventing the requirements of copyright law to receive some form of legal protection.<sup>17</sup> Trademark law has been extended to the point that, at least in some circumstances, it protects utilitarian items of an arguably minimal original nature because of the recognizable nature of the item.<sup>18</sup> Under these circumstances, trademark law functions to protect designs that would otherwise be in the public domain under copyright law.<sup>19</sup> Even where protection is granted on the basis of secondary meaning, the lofty requirements of attaining such status result in protection for only a small portion of fashion designs.<sup>20</sup> In light of this limited scheme of protection, both copyright’s primary function to “promote the [p]rogress of [s]cience and useful [a]rts”<sup>21</sup> and trademark’s goal of protecting against unfair competition<sup>22</sup> accentuate the need for a more comprehensive plan of protecting fashion and apparel designs.

Accordingly, Part II of this article sets forth the current legal environment of statutes and legislative proposals that apply to the protection of fashion designs from counterfeiting and knockoffs. Part III analyzes the use of trademark law, as an

alternative to copyright law, to protect certain designs that would otherwise be **\*424** ineligible works. Finally, Part IV discusses the need for an extension of copyright eligibility to encompass the original elements of fashion designs so that copyright law becomes the primary method of design protection.

## II. The Current Environment of U.S. Law Applicable to Fashion Design Protection

### A. Fashion Designs Receive Little Protection Under Copyright Law

The Statute of Anne, an early law that protected against unauthorized copying, never contemplated the protection of fashion designs. Instead, the Statute of Anne covered only the “vesting [of] the copies of printed books in the authors or purchasers of such copies.”<sup>23</sup> Likewise, early United States copyright statutes wholly precluded fashion designs from protection. The first copyright statute extended protection only to maps, charts, and books.<sup>24</sup> Subsequent amendments enumerated additional types of works that qualified for protection. In 1802, historical prints and other engraved or etched prints were added.<sup>25</sup> Musical compositions were included by 1831,<sup>26</sup> and photographs and their negatives were incorporated in 1865.<sup>27</sup> Finally, the addition of paintings, drawings, chromos, statues, statuaries, and models or designs “intended to be . . . works of the fine arts” completed the list of copyrightable items in 1870.<sup>28</sup> Fashion designs were never specifically added as copyrightable items. In fact, they were precluded from protection under the “design” category because of the requirement that the design be intended to be a work of fine art. Thus, by operation of this early statute, fashion designs were generally excluded by virtue of their useful nature.

The Copyright Act of 1909 replaced the previous statutory scheme and provided that protection encompassed “all the writings of an author.”<sup>29</sup> The meaning of writings was not literal, but more appropriately described as some form of expression. **\*425**<sup>30</sup> Therefore, in § 5, the 1909 Act set forth a list of copyright-eligible classes.<sup>31</sup> Perhaps most relevant to fashion designs, § 5(g) conferred copyright eligibility on “works of art” and “models or designs for works of art.”<sup>32</sup> Facially, the removal of the fine arts requirement appeared to permit the registration of fashion designs. However, the Copyright Office clarified that “works of art” included only “works belonging fairly to the so-called fine arts” excluding “[p]roductions of industrial arts utilitarian in purpose and character . . . even if artistically made or ornamented.”<sup>33</sup> In fact, “garments, laces, woven fabrics, or any similar articles” were generally barred from eligibility for copyright,<sup>34</sup> as both the Copyright Office and the courts adopted the position that the dominant function of fashion was utilitarian, and therefore such items were not eligible for copyright under the 1909 Act.<sup>35</sup>

Today, fashion designs receive little protection under copyright laws because of the inherently utilitarian nature of clothing items. Pursuant to § 102(a) of the Copyright Act of 1976, copyright protection “subsists . . . in original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated.”<sup>36</sup> Section 102 further enumerates a nonexhaustive list of categories that constitute original works of authorship, including literary works, musical works, dramatic works, and pictorial, graphic, and sculptural works.<sup>37</sup> While fashion designs do not facially fall into any one of § 102(a)’s categories of “original works of authorship,” some courts have extended protection to garments in very limited circumstances. For example, copyright protection has been granted to masquerade costumes as applied art.<sup>38</sup> Also, **\*426** one court held that summary judgment was improper against a plaintiff’s claim that a nonfunctional swimsuit intended for display was a work of art and not a useful item of clothing.<sup>39</sup>

The legislative history of the 1976 Act suggests that regardless of artistic or aesthetic considerations, copyright protection extends only to those elements that are capable of separation from utility. Accordingly, artistic elements inextricably linked with either the function or usefulness of the article are precluded from protection under copyright law. The House Report to the 1976 Act notes that:

[A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the . . . intention is not to offer it copyright protection . . . [u]nless the shape of [the] . . . ladies’ dress . . . or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article . . . . The test of separability and independence from “the utilitarian aspects of the article” does not depend upon the nature of the design—that is, even if the appearance of an article is determined by esthetic [sic] (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article . . . are copyrightable.<sup>40</sup>

In adopting this test of separability, courts have extended protection to utilitarian items such as jewelry boxes,<sup>41</sup> artistic jewelry,<sup>42</sup> and even to a Christmas decoration.<sup>43</sup> The Copyright Office has also been progressive in accepting registration of useful articles, such as bookends, candlesticks, chandeliers, and fishbowls as works of art.<sup>44</sup>

In essence, it is now well-established that a useful article may be copyrightable insofar as its form exists independently of its useful function such that it may stand separately as a work of art.<sup>45</sup> For example, courts have embraced fabric patterns \*427 as copyrightable as both a work of art and a print.<sup>46</sup> Nonetheless, copyright protection is largely unavailable for fashion designs because articles of clothing fall neatly within the statutory definition of useful items, as their function is not “merely to portray the appearance of the article or to convey information.”<sup>47</sup> As a useful article, copyrights in fashion designs may only be claimed to the extent that they satisfy 17 U.S.C. § 101, which limits the protection of useful articles. In relevant part, § 101 clarifies that pictorial, graphic, and sculptural works include “works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects.”<sup>48</sup> Therefore, fashion designs must have an original aspect capable of being separated from the function of covering the human body.

With clothing and apparel, it is difficult to locate an artistic work that can stand on its own, wholly independent from the useful aspect of a garment’s form. Unlike fabric designs or patterns that have pictorial depictions that exist apart from the fabric itself, fashion designs are not so easily separated from their utilitarian function.<sup>49</sup> While fashion designs might contain patterns, embroidery, or illustrations that may be easily separated from the utilitarian function of the garment, the shape and form of the garment suffers because of the difficulty in establishing it as an artistic creation independent of its useful purpose of covering the human form. To demonstrate the difficulty of separability as applied to apparel, consider the question of whether a shirt sleeve is necessary and useful. Assuming an answer in the affirmative, at what point does a sleeve with a full, flowing cut and additional fringe extend past the utilitarian aspect and step into the artistic or original creation sphere sufficient to support a copyright? Given the difficulty in separating a garment’s utilitarian function from its artistic creation, it is not surprising that courts hesitate to extend copyright protection where it is inherently difficult to draw a logical line between use and art in fashion designs.

Even where a design itself can obtain a copyright, the likelihood of robust protection is unlikely. A thin copyright is likely for two reasons. First, the basic underlying design for apparel is well established and available to the public. Therefore, the analogy can be made that basic fashion designs are akin to the basic plots or characters in a play because both involve a limited number of basic or stock plots or designs, and both are subject to the common availability of basic or stock plots \*428 or designs in public domain.<sup>50</sup> Accordingly, copyright arguably exists in fashion designs only to the extent that truly original texture is added to the basic design. Second, fashion designs can be analogized to compilations of facts such as telephone directories.<sup>51</sup> Just as facts, such as phone numbers, are in the public domain and thus ineligible for copyright, the component parts of clothing such as zippers, pockets, buttons, and basic patterns of an item of clothing are likewise widely available. Accordingly, the extent of copyright protection available in fashion designs could be construed as similar to the level of copyright protection applicable to phonebooks. Under such a framework, copyright protection would extend only to the original selection and organization of component pieces.

As an additional impediment to protection for fashion designs, copyright law generally protects against the duplication of another’s designs when used as an instructional sheet for an unauthorized designer, but it will not grant that same protection when sought against the embodying of the design in competitive garments.<sup>52</sup> Therefore, even when garments clear the initial hurdle of eligibility for copyright protection, the scope of the protection likely to be granted to fashion designs appears thin.

In sum, the extension of protection to original fashion designs is extremely limited because of the generally useful nature of clothing and apparel. As a result, a number of legislative attempts have been made to provide more comprehensive protection to fashion designs in an effort to promote new designs and to protect the economic investment of the original designers.

#### **\*429 B. Attempts to Extend Specific Copyright Protection to Fashion Designs Have Failed to Achieve Additional Safeguards**

Because of the limited scope and inconsistent protection of useful designs under current copyright law, numerous legislative attempts have been made to either extend current protection or create special schemes to protect designs. Since 1914, Congress has introduced approximately seventy bills intended to either protect designs through copyright law or to create a unique design-specific protection system.<sup>53</sup> Despite these attempts, no bill has been passed to increase protections for useful designs in general or fashion designs in particular.<sup>54</sup> In addition to consistently rejecting proposed bills to protect industrial designs, Congress explicitly deleted the proposed Title II from the Copyright Act of 1976.<sup>55</sup> Title II provided for the creation

of “a new limited form of copyright protection for ‘original’ designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself.”<sup>56</sup> Congress chose to reject this proposed extension of copyright because, as one court stated, Congress recognized the “concern that to make such designs eligible for copyright would be to create a ‘new monopoly’ having obvious and significant anticompetitive effects.”<sup>57</sup> The Register of Copyrights explained three potential anti-competitive effects of extending copyright to utilitarian objects in *Esquire, Inc. v. Ringer*:

First, in the case of some utilitarian objects, like scissors or paper clips, shape is mandated by function. If one manufacturer were given the copyright to the design of such an article, it could completely prevent others from producing the same article. Second, consumer preference sometimes demands uniformity of shape for certain utilitarian articles, like stoves for instance. People simply expect and desire certain everyday useful articles to look the same particular way. Thus, to give one manufacturer the monopoly on such a shape would also be anticompetitive [sic]. Third, insofar as geometric shapes are concerned, there are only a limited amount of basic shapes, such as circles, squares, rectangles and ellipses. These shapes are obviously in the public domain and accordingly it would be unfair to grant a monopoly on the use of any particular \*430 such shape, no matter how aesthetically well it was integrated into a utilitarian article.<sup>58</sup>

Therefore, utilitarian-infused designs, such as clothing and apparel, remain largely unprotected under federal copyright law in spite of efforts to extend protection.

### **C. The Application of Trademark and Trade Dress Law to Fashion Designs May Provide a Modicum of Additional Protection**

When style pirates make copies of fashion designs and use a famous brand name or a substantially similar mark in “passing off” counterfeits, designers are generally eligible for protection under the Lanham Act for trademark infringement and trademark dilution.<sup>59</sup> Even where style pirates use the “heart” of a design only as inspiration for a knockoff, designers may find redress in trade dress and secondary meaning pursuant to § 43(a) of the Lanham Act.<sup>60</sup> The primary purpose of the Act is to protect “a merchant’s good will and business reputation by granting the merchant exclusive rights in the mark under which he or she sells products and services.”<sup>61</sup> Federal trademark law also seeks to protect consumers from misleading labels and confusion as to the source of goods.<sup>62</sup> In general, a trademark is an individual feature, symbol, name, or small group of features on a product, while trade dress refers to the overall look and feel of a product.<sup>63</sup> Despite both trademark and trade dress as avenues for protection, only a limited number of designers will find successful redress under trademark law, primarily because of the requirements of distinctiveness and likelihood of confusion as to the source of goods.

Fashion designers generally face the best odds of successfully protecting designs when they have a well-established trademark<sup>64</sup> that has been purloined by a subsequent party. To establish a prima facie case for trademark infringement, the \*431 plaintiff must prove (1) that a distinctive mark has been used in commerce; (2) legal or equitable ownership of the mark; and (3) that the use of a similar mark is likely to cause confusion among consumers as to its source.<sup>65</sup> Distinctiveness is the ability of a mark to distinguish and identify the source of goods and services.<sup>66</sup> The Supreme Court has recognized that marks may be classified in five categories of increasingly distinct marks:<sup>67</sup> (1) generic, (2) descriptive, (3) suggestive,<sup>68</sup> (4) arbitrary,<sup>69</sup> or (5) fanciful.<sup>70</sup> Suggestive marks, arbitrary marks, and fanciful marks are entitled to immediate trademark protection because they are inherently distinctive.<sup>71</sup> Descriptive marks may acquire distinctiveness through secondary meaning in the marketplace by establishing that the public has come to associate the mark with a specific source.<sup>72</sup> Even marks initially excluded from registration, such as personal names or surnames, may obtain secondary meaning in the marketplace, thereby securing distinctiveness.<sup>73</sup> Following a finding of distinctiveness, the test for infringement is whether the use of the disputed mark creates a likelihood of confusion among the consuming public.<sup>74</sup>

\*432 In light of the protection granted to trademarks, a fashion designer that incorporates a registered trademark into a fashion design may obtain indirect protection of the design itself from those who misappropriate the mark for use on counterfeit goods. Protection would be available because the owner of a registered mark generally retains the exclusive right to use that mark in commerce.<sup>75</sup> Pursuant to the Lanham Act, the owner of a famous mark is also entitled to remedies when another uses the famous mark (after it has become famous) and causes dilution of the distinctive quality of the mark.<sup>76</sup> This protection not only includes indirect protection of fashion designs in suits against counterfeiters, but may also include protection against non-literal copies or unrelated goods where the use of the famous mark causes dilution.<sup>77</sup> Courts have

unequivocally accepted the application of famous mark dilution to clothing and apparel, thereby providing an avenue for designers to indirectly protect garment designs by way of protecting the famous mark.<sup>78</sup> Where **\*433** infringement is established, a registrant may recover monetary damages and attorneys' fees.<sup>79</sup> Injunctive relief, destruction of infringing material,<sup>80</sup> and declaratory relief<sup>81</sup> may also be granted. However, courts will refuse to grant protection where there is no evidence of actual harm or reduced capacity of the famous mark to identify and distinguish the goods sold.<sup>82</sup>

While fashion designs may qualify for trademark protection in limited circumstances involving sufficient distinctiveness and likelihood of confusion, protection will extend only to the original designer's famous mark.<sup>83</sup> Therefore, the protection of a valid trademark indirectly encompasses a limited number of designs by virtue of the mark's attachment to a counterfeit item. Absent a registered mark, an owner may not sue for trademark infringement.<sup>84</sup> Infringement of unregistered marks must then be pursued as trade dress infringement claims under 15 U.S.C. § 1125(a).<sup>85</sup> This section provides a civil cause of action against "[a]ny person who, on or in connection with any goods . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof," which is likely to cause confusion as to the origin, sponsorship, or approval of the goods by another person.<sup>86</sup> The fundamental policy concerns underlying unfair competition law are (1) protecting the public from confusion about the source of goods, and (2) preventing a subsequent party from utilizing the reputation and goodwill of the original creator for **\*434** economic benefit in competitive markets.<sup>87</sup> The term "trade dress" has been defined generally as the total image and overall appearance of a product,<sup>88</sup> including "features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques."<sup>89</sup> In essence, trade dress includes the totality of elements in which a product is presented.<sup>90</sup> Therefore, where the overall appearance of a counterfeit or knockoff design is so similar to an original design that it causes confusion as to the origin of the counterfeit or knock-off, a claim for trade dress infringement under 15 U.S.C. § 1125(a) may be available to the original designer.

To prevail on a trade dress infringement claim, a plaintiff must establish the existence of secondary meaning such that in the consumer's mind, the product is associated with a single source.<sup>91</sup> Actual knowledge of the source is irrelevant.<sup>92</sup> Factors considered by courts in determining whether secondary meaning has attached to trade dress include (1) sales success and amounts of receipts, (2) extent of unsolicited media coverage of the product, (3) intentional copying by third parties, (4) amount and extent of advertising expenses, (5) proper focus of advertising upon the trade dress, (6) statistical evidence from consumer recognition surveys and unsolicited consumer testimonials, (7) length and exclusivity of use, and (8) direct evidence of consumer association via testimony, affidavits, and depositions.<sup>93</sup> As there is no requirement of either actual sale of infringing goods or actual consumer confusion, a plaintiff must only show the "mere possibility of . . . [a]n injury" to obtain injunctive relief.<sup>94</sup> In weighing these factors, courts have extended trade **\*435** dress protection to the overall look and feel of apparel and related products.<sup>95</sup> However, high-end and brand name fashion designs are not guaranteed trade dress protection because difficulties in setting forth sufficient evidence of secondary meaning consistently bar protection.<sup>96</sup>

The high evidentiary burden of establishing secondary meaning in trade dress limits the application of trademark protection to prevent unauthorized copying of fashion designs and results in perhaps inconsistent protection. For example, Levi Strauss was able to obtain protection for a jean pocket tab, but not for its shirt pocket tab.<sup>97</sup> Given the nature of trade dress law, only the most recognizable of brand-name designs will warrant consideration for protection. Even then, only a handful of those brand-name or recognizable wearable apparel designers will qualify for protection, because of the difficulty of proving secondary meaning.

**\*436** Assuming proof of a strong mark or trade dress, some courts have nonetheless justified rejection of protection on the grounds that substantial confusion was unlikely because of different consumer markets or sophisticated buyers were unlikely to be fooled. For example, Louis Vuitton failed in an action against Burlington Coat Factory, despite judicial recognition of a strong mark, in part because the customer base of the \$29.98 knockoff handbag was completely different than that of the upscale designer bag and because of the significant differences apparent when visually comparing the bags.<sup>98</sup> In another recent case, Louis Vuitton failed to enjoin Dooney & Bourke from producing similar monogrammed bags because the absence of geometric shapes on the defendant's bags reduced the likelihood of consumer confusion and therefore, Louis Vuitton could not prove dilution.<sup>99</sup> Accordingly, the main purpose of trademark and trade dress law, to avoid misappropriation of reputation and consumer confusion, appears to be generally inconsistent with protecting the copying of fashion designs as a whole. Even where there is an acknowledged consumer association between the design and a source, protection varies widely.

In sum, trade dress law extends protection further than trademark law, which focuses on a designer's mark, but trade dress protection is not comprehensive and fails to cover the design configuration in whole.

### **III. Trade Dress May Be Used to Defeat The Exacting Requirements of Copyright In Extending Protection to The Most Popular And Recognizable Goods**

As evidenced by the prevalence of brand-name or high fashion designers seeking redress under trade dress law and often successfully obtaining injunctive relief or other remedies, secondary meaning provides a means for otherwise uncopyrightable utilitarian works to be protected against unauthorized use.<sup>100</sup> If a useful item can establish secondary meaning in the marketplace such that it is attributable to a particular source, trade dress law appears to offer a means of protection if a copy of the item could cause substantial confusion to the public.<sup>101</sup> Accordingly, where brand names or popular goods are involved, trade dress law may \*437 provide an indirect way around the requirements of copyright law, such that useful designs otherwise subject to the public domain under copyright laws may be restricted from misuse by style pirates. Admittedly, the emphasis of trade dress law on widespread recognition tends to doom attempts by any but the most famous fashion designers to receive protection.

#### **A. Some Utilitarian Designs Incapable of Copyright Protection May Attain Secondary Meaning in Trademark Restricting Material Otherwise Subject to the Public Domain Creating De Facto Copyright Protection of Some Useful Goods.**

In extending trade dress to include not only product packaging but also to encompass the design of a product,<sup>102</sup> United States jurisprudence has arguably created a narrow regime of protection for certain qualifying utilitarian goods such as clothing, handbags, and luggage. Absent such judicially created protection, these items, by virtue of their inherent usefulness, would fail to qualify for copyright protection and would likely reside in the public domain for unhindered use. While most utilitarian items are unlikely to qualify for trade dress, this limited exception for trade dress may allow some protection where copyright law does not.

Courts have been increasingly willing to extend trade dress protection to apparel designs. In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, the Supreme Court recognized that unregistered trade dress extends to clothing designs.<sup>103</sup> There, the Court considered product-design trade dress in the context of an allegedly infringed-upon line of designer children's clothing.<sup>104</sup> The Court ruled that product designs could be protected as distinctive trade dress so long as secondary meaning has been attained in the minds of the public.<sup>105</sup> This ruling implies that where the public comes to identify any combination of design features or the fashion design itself with a unitary source, protection via trade dress is available to designers.

Hermès International, a maker of luxury goods, also seized upon trade dress law to file an action against retailer Steven Stolman for selling the so-called "Jelly \*438 Kelly," a knockoff of Hermès' Birkin bag.<sup>106</sup> Mr. Stolman's knockoffs were very similar to the \$5,000 Hermes bag but were created from transparent rubber.<sup>107</sup> The Jelly Kelly bags differed in other ways from the Birkin in that the keyhole cutouts on the flaps of the Jelly Kelly were larger than those on the Birkin, the straps were longer, and the classic locket dangling from the Birkin's horizontal strap was absent.<sup>108</sup> Additionally, the flaps on the Jelly Kelly bags were glued, not hand-stitched.<sup>109</sup> Hermès obtained a permanent injunction against the sale of these bags, along with an undisclosed settlement.<sup>110</sup>

The children's clothing line and the handbag discussed in *Wal-Mart Stores* and *Hermes*, respectively, constitute useful goods, rendering them incapable of coverage under copyright law. Admittedly, analytic dissection of both cases might produce separable elements that could qualify for copyright protection. However, in extending trade dress protection, the whole design concept itself may attain secondary meaning, thereby granting exclusive rights to the owner. Therefore, the prohibition against the protection of useful items under copyright law is contravened in the limited circumstances where (1) useful items incapable of copyright protection attain secondary meaning, and (2) a style pirate utilizes a substantially similar design capable of market confusion. In such circumstances, trade dress law operates in limited situations to protect otherwise public domain goods under copyright law.

Although considered on a motion for summary judgment, *Adidas-Salomon AG v. Target Corp.* presents an example of how trade dress may be applied to a useful clothing design in whole.<sup>111</sup> There, the defendant argued that the plaintiff could not establish its trade dress either as nonfunctional or distinctive, and that there was no likelihood of confusion between the trade dress of the shoes.<sup>112</sup> The \*439 trade dress in controversy comprised the following design elements: "(1) three stripes on the side of the shoe parallel to equidistant small holes; (2) a rubber 'shell toe;' (3) a particularly flat sole; and (4) a colored portion on the outer back heel section."<sup>113</sup> After weighing the evidence as applied to a host of factors, the magistrate denied summary judgment for the defendant on the grounds that Adidas had presented sufficient evidence of a trade dress that had

acquired secondary meaning, and that the defendant's substantially similar shoe design posed a likely risk of confusion.<sup>114</sup>

While the magistrate in *Adidas* only considered grant of summary judgment, an application of the legal reasoning to a fashion design serves to fully illustrate how trade dress and secondary meaning operate to bypass copyright protection in certain circumstances. Consider the example of Burberry's arguably distinctive and recognizable tan and red plaid fabric pattern used to construct a handbag in combination with other functional and non-functional design elements. Burberry would possess a trademark in its logo and labels. However, Burberry also would have a strong argument for trade dress in the compilation of the following elements: (1) any registered trademark, logo, or label; (2) the plaid fabric; (3) the black accent detailing; (4) the hardware such as clasps or zippers; and perhaps (5) the shape of the bag. Applying the *Adidas* reasoning, Burberry would probably gain trade dress protection against exact copies, as well as those inspired by the original so long as a substantial likelihood of confusion exists. Initially, Burberry would not be foreclosed from redress by trade dress merely because of the inclusion of some functional design elements.<sup>115</sup> That is, "trade dress protection focuses on the plaintiff's entire selling image, rather than the narrower single facet of trademark."<sup>116</sup> Because trade dress considers the entire visual tapestry, a "defendant cannot avoid liability . . . simply by segregating out the various aspects of the plaintiff's product . . . and claiming that no one of these is protectable in and of itself."<sup>117</sup> As such, **\*440** the functional elements of an item that may be incapable of legal protection standing alone may, therefore, find some level of protection as part of the item as a whole under trade dress law.<sup>118</sup> Thus, the entire composition of the Burberry handbag, from shape to accoutrements, may constitute trade dress. However, the scope of trade dress does not extend so far as to preclude all use of the individual components of the trade dress by competitors, but rather, only grants the right to "prevent competitors from using the items in a way that, viewed as a whole, is likely to confuse customers."<sup>119</sup>

*Adidas*' balancing of the factors for establishing secondary meaning also bodes well for the fashion designer. Of particular relevance is the recognition that a registered trademark may be considered as part of establishing the secondary meaning.<sup>120</sup> Therefore, a strongly branded and recognizable trademark such as Burberry's labels or perhaps even the plaid pattern itself must be considered in the whole of trade dress. Secondary meaning is then much more likely where a famous mark may be considered in conjunction with other design elements. Additionally, secondary meaning may still be established absent trade dress-focused advertising.<sup>121</sup> While trade dress-focused advertising is a potential factor, courts have found that such advertising is not a requisite element.<sup>122</sup> For example, widely recognized trade dress such as an hourglass-shaped Coca-Cola bottle may still qualify for secondary meaning absent a marketing campaign touting or promoting consumer awareness in the trade dress.<sup>123</sup> Therefore, where trade dress or consumer awareness of the entirety of the Burberry design rises to a significant level, the design may be protected. This is often the case with apparel that gains pop-culture status as the new "it-fashion" or when celebrities are often seen wearing the apparel. Lastly, *Adidas* recognizes that exact copying is not required to establish a presumption of secondary meaning where a "cursory look . . . indicates that the trade dress of the defendant's product incorporates significantly more similarities to, than differences from, the [o]riginal."<sup>124</sup> Therefore, items "inspired" by the **\*441** original Burberry fashion design may be required to surpass this presumptive barrier.

Finally, *Adidas*' finding of a likelihood of confusion in a substantially similar fashion design supports the position that functional garment designs are increasingly likely to receive protection. The Ninth Circuit found that the likelihood of confusion, not intent to confuse or actual confusion, is all that is required.<sup>125</sup> "Likelihood of confusion will be found whenever consumers are likely to assume that a mark is associated with another source or sponsor because of similarities between the two marks."<sup>126</sup> Confusion may also be established via initial interest confusion<sup>127</sup> or post-sale confusion.<sup>128</sup> Ostensibly, a substantially similar design could cause both initial interest confusion by attracting the interest of a potential customer at the point of sale because of its similarity to another item, and post-sale confusion by confusing post-sale observers as to the source of the item. Moreover, the use of a source-indicating label on a substantially similar design may not be sufficient to avoid initial interest confusion, and it wholly fails to address post-sale confusion.<sup>129</sup> Post-sale observers may be unaware that two confusingly similar items are sold in different stores or at different prices, yet the observer's confusion may be detrimental to the original designer if they perceive the inferior-quality product as related to the original, thus damaging the original's reputation and image.<sup>130</sup> Therefore, the entirety of the Burberry handbag would be protected against aesthetically similar bags that seize the heart of the design even when clearly marked with another source indicator.

In sum, trade dress may operate to protect some product designs as a whole, where copyright protection of the same item would either be limited to a separable **\*442** artistic element or wholly barred because the design is functional. As noted in the Burberry handbag hypothetical above, an extension of trade dress protection would cover the entirety of the product design assuming secondary meaning. The combination of design elements, including purely functional elements of the trade dress such as a specific handle, clasp, or zipper, would be protected along with nonfunctional elements such as the trademark itself and other aesthetic additions. In contrast, copyright protection would extend only to the fabric design of the Burberry

handbag<sup>131</sup> but little else without artistic elements separable from the bag's function.<sup>132</sup> While there are many hurdles for a functional fashion design, trade dress law offers an alternative form of protection for certain non-copyrightable useful designs. Upon qualification for trade dress, the owner attains the exclusive rights to use that trade dress and the opportunity to receive relief for infringement.<sup>133</sup> Accordingly, otherwise public domain designs are essentially granted de facto copyright protection through the extension of trade dress law to protect the look and feel of a useful item as a whole.

## **B. Protecting Utilitarian Designs Under Trademark Law Promotes Further Inconsistency in Granting Exclusive Rights as to Fashion Designs**

While secondary meaning in trade dress operates to protect certain useful, and therefore uncopyrightable, works, this loophole is indicative of a patchwork scheme of protection that supports the need for clear standards of protection over utilitarian items such as fashion designs. As noted above, copyright laws operate to protect wearable apparel and garments in whole only to the extent that they are non-functional.<sup>134</sup> Garments, such as "soft-sculpture" swimsuits<sup>135</sup> and costumes,<sup>136</sup> that have been given judicial protection by some courts accentuate the exceedingly \*443 limited scope of copyright protection as applied to the entirety of the useful fashion design. Without this limited copyright protection of fashion designs in whole as artistic works, only the creative elements physically or conceptually separable from the product's function may be protected under copyright laws.<sup>137</sup> Where separable illustrations or designs are utilized as a trademark or acquire secondary meaning, the laws of unfair competition may offer double coverage. Moreover, secondary meaning in trade dress provides protection for designs in total, including utilitarian elements, where copyright wholly denies protection. Because of the contextual approach and fact-specific inquiry into distinctiveness, secondary meaning, and confusion, courts vary widely in their application of trade dress to fashion designs.<sup>138</sup> This further compounds the current inconsistency of the scheme available to protect fashion designs from unauthorized copying.

In sum, the interplay of copyright and trademark law results in an unpredictable environment where original fashion designers are uncertain of the possibility of legal protections and the extent that such protections would extend to their works. This lack of certainty supports the need for a fashion design-specific system or at least a more uniform interpretation and application of the current copyright and trademark laws to prevent inconsistency and uncertainty.

## **IV. The Protection of Fashion Designs Is Necessary to Protect Business Investment In Original Apparel Designs And to Promote Continued Innovation By Fashion Designers**

Because of the useful nature of fashion designs, copyright generally precludes their protection. Therefore the creativity and originality of designers is stymied in favor of essentially unrestricted public use. As a result, the purpose of copyright law--balancing exclusive rights to the originator and public use--is skewed in favor of public use, which in turn reduces the incentives for designers to continue innovation. Moreover, trademark law fails to provide protection for even some famous designers because the difficulty in establishing that consumer confusion occurs and that cheap imitations dilute the strength of their mark. Trademark law similarly fails to adequately protect the business investment and reputation of fashion designers just as copyright fails to comprehensively protect the creative aspects of fashion designs. While the public benefits from the instantaneous copying and production of cheap replicas, the speed at which this copying occurs largely precludes \*444 the original designer from enjoying exclusive production of an item for any meaningful time.

In light of the advances in design pirating, a new scheme of protection should be enacted that considers both copyrights creativity interests and trademarks business concerns in fashion designs. Otherwise, not only original designers, but also style pirates themselves may soon be out of a job as progressive fashion designers find little incentive to risk the expense of creating an original design where the promise of either exclusive control or economic benefit is nil.

## **A. The Purpose of Copyright Law Supports the Need to Protect Original Fashion Designs Despite Inherently Functional Nature**

In granting exclusive rights, copyright seeks the threshold question of originality.<sup>139</sup> Copyright protection arises only to the extent of the "original intellectual conceptions" of their authors, not necessarily the entirety of the work.<sup>140</sup> For example, in *Burrow-Giles Lithographic Co. v. Sarony*, the Supreme Court extended copyright in a photograph narrowly to the artistic elements such as angles, lighting, posing, and accoutrements utilized by the photographer.<sup>141</sup> More recently, in *Feist Publications, Inc., v. Rural Telephone Services Co.*, the Court determined that the original work of authorship in a telephone

book could be copyrightable to the extent of its original manner of compiling or organizing factual information.<sup>142</sup> While copyright protection extends only as far as the original work of the author, this requirement of originality has been recognized as minimal. Copyright “carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic quality.”<sup>143</sup> Accordingly, Justice Holmes noted that “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”<sup>144</sup>

In applying these principles to fashion designs, it cannot be said that fashion designs lack sufficient originality for copyright protection where designers use artistic \*445 vision to create garment concepts and designs. As noted in *Bleistein v. Donaldson Lithographing Co.*, even the “least pretentious picture has more originality in [it] than directories and the like, which may be copyrighted.”<sup>145</sup> Similarly, even the least original fashion design likely has more original artistic contribution in it than a factual compilation. Furthermore, in *Bleistein*, the Court reasoned that “there is no reason to doubt that these prints in their ensemble and in all their details, in their design and particular combinations of figures, lines and colors, are the original work of the plaintiff’s designer.”<sup>146</sup> Likewise, the original work of a fashion designer in creating a garment is found in the ensemble of all the details and design elements incorporated. Some might argue that there is very little originality in clothing designs because of well-established basic designs or even because of the regurgitation of styles from past generations, but this should not bar the applicability of copyright. Rather, copyright law must protect whatever originality the author has produced. The extent or “thinness” of the copyright protection, however, would ultimately turn upon the amount of originality involved. Fashion designers often succeed by being different and bringing a new style to the forefront. Accordingly, progressive fashion designers would likely receive more protection in their designs than those that only involve minimal originality. In sum, the fact that fashion designs possess the requisite originality for copyright is accentuated by the fact that aesthetic considerations have increased in value and the appearance of garments have come to the forefront. Moreover, it is not the place of judges to make determinations of aesthetic valuation where purely factual compilations possessing lesser originality may qualify for copyright. Thus, the originality found in fashion designs deserves to be protected. If not for a garment’s inherent functional nature, the garment’s design would presumably qualify for protection. The notion that a garment cannot be protected because of its inherent functional nature should be re-evaluated. Fashion designs are no longer solely valued for a functional purpose. For example, the functional aspect of a Louis Vuitton handbag is not the reason customers pay in excess of \$1,000 where a bag that will perform the same function can be purchased for far less. Rather, it is increasingly the combination of aesthetically appealing original design elements that increases the value of the particular fashion design.

Therefore, copyright must adapt to protect this form of original authorship. Copyright law seeks to promote the useful arts by way of securing exclusive rights \*446 for the authors of these works for a limited time.<sup>147</sup> In doing so, copyright law attempts to strike a balance between granting exclusive rights as an incentive to originators and allowing free public use to promote additional progress.<sup>148</sup> In spite of this stated purpose, the balance is skewed in favor of public use where fashion designs are concerned because of their useful nature. Therefore, copyright law is not striking the balance that it seeks with fashion designs.

While the commercial nature of fashion tends to push many into arguing that fashion lies outside the realm of copyright, copyright law itself recognizes the importance of the commercial use and licensing of protected items.<sup>149</sup> It is precisely the grant of exclusive rights and ability to license protected items to others for use, thereby securing commercial gain, that underlies copyright as an incentive to continue creating. Absent copyright protection, the ability to control and license products essentially evaporates. Except in very limited circumstances, the fashion industry and designers must cope with exactly that state of affairs, lacking control and increasingly losing commercial value. Therefore, the incentives to create new fashion designs diminish immensely.

Designers take great risk and cost in creating a fashion line, and absent protection, style pirates may ride on the coattails of the designers’ work and success, costing designers potentially huge sums of revenue. For example, manufacturer Jack Mulqueen grossed over \$200 million in 1981 by copying and selling the original creations of other designers.<sup>150</sup> To prevent such losses by the original designer of a garment, copyright protection should extend to situations where others take the essence or heart of a fashion design and create a work that evokes substantially the same look and feel as the original.<sup>151</sup> While an amendment to the Copyright Act for works of fashion is not likely to be passed anytime soon because “legislators and courts have a great deal of trouble seeing past the utilitarian function of a piece \*447 of clothing,”<sup>152</sup> this position is especially perplexing where copyright protection has been extended to useful items such as fashion accessories, works of architecture, and computer chip designs.<sup>153</sup> In light of the more than sufficient originality found in fashion designs and copyright’s goal of promoting the useful arts, the law must look past the difficulty in separating the creative elements of a fashion design from its functional elements and instead protect the sufficiently original creations of a fashion designer as a

whole.

## **B. Copyright Law Exists as an Appropriate Medium to Protect Fashion Designs Because of the Focus on Promoting Arts and a Secondary Goal of Securing Exclusive Rights and Commercial Value to Originators.**

While trademark law appropriately supports the copyright incentive scheme by explicitly granting protection to the business aspect of recognizable goods, copyright law is the appropriate medium to provide the primary protection over the original and artistic aspects of all fashion designs, not just the most popular. Trademark and trade dress law exist to protect business goodwill and to provide redress for customer confusion. As a result, trademark and trade dress laws do not focus on safeguarding the original artistic elements of a design itself, which is more traditionally the province of copyright law.<sup>154</sup> Therefore, trademark law primarily seeks to protect the consumer from confusion about the source of the goods, not the designer from unauthorized use or copying of artistic design elements.<sup>155</sup>

Nonetheless, trademark and trade dress laws currently fill part of the void left by copyright and provide some minimum incentives for continued artistic creation via secondary meaning. Because trademark law's focus is on the business aspects of product sales, it appropriately protects designs of high commercial value and recognizability in the consumer marketplace. Accordingly, it is copyright law, and not trademark law, that must be extended to serve as the medium of protection for the original aspects of all fashion designs, not just those that are the most commercially valuable and recognizable. Admittedly, this protection should not extend to a \*448 veritable grant of monopoly over a basic T-shirt design, but rather only to the unique artistic compilation of elements, added texture, and detail of any particular fashion design. Moreover, others are free to license the design from the original author to make copies or derivative works, and where not commercially viable, the design will likely fall into the public domain for free use.

However, clothing and fashion designs would require a different duration of protection. Clothing is seasonal, and trends and artistic originality tend to move in and out of the consumer consciousness rapidly. Therefore, a grant of exclusive rights for the 1976 Act's duration of life of the author plus 70 years,<sup>156</sup> or 120 years from creation for anonymous works or works for hire,<sup>157</sup> would be a de facto monopoly. Academics have pushed for a shorter duration of protection for fashion designs, thereby securing protection and incentive without inordinately sacrificing use.<sup>158</sup> In any event, copyright law appears to be the appropriate medium of protection of original fashion designs, with trademark serving as a supplement to address unfair business competition as applied to fashion designs.

## **V. Conclusion**

In its current state, intellectual property law, including copyright law and trademark law, inconsistently and perhaps arbitrarily grants exclusive rights in certain fashion designs while wholly excluding many other designs. Where copyright law has failed to protect fashion designs, designers sought to use trademark and trade dress law to protect their creations. Even so, trademark law served to protect only registered marks used by the designer and not the design as a whole. In addition, the extension of trade dress generally protected only the most recognizable of designs and was often inconsistently applied to even the most famous of brand names. Therefore, fashion designers have few legal rights to protect their original creations under the current laws.

While copyright law and trademark law protect very few qualifying designs, the near-wholesale exclusion of most other designs used to be justifiable based on the fact that designers generally enjoyed the benefits of being the first providers of the garment. In the past, the amount of time required for a competitor to copy and offer a counterfeit or knockoff effectively secured sufficient commercial benefits \*449 for the original designer as the sole provider of the garment until competing items could be designed and manufactured. This limited period of exclusivity promoted continued innovation in fashion design by incentivizing designers with the promise of obtaining the benefit of their work and creativity. However, technology has evolved to the extent that designs can now be purloined and placed in competition with the original almost instantaneously. As such, designers no longer have the promise of a limited period of time as the exclusive provider of a particular fashion design.

Accordingly, copyright law should be extended to include protection for fashion designs. In doing so, the original artistic creations of a fashion designer are adequately protected, thus securing the continued ability of the designer to control and reap the benefit of the design prior to use by others in derivative works. Trademark and trade dress law reiterates the

importance of securing the commercial benefits of goodwill and reputation for a designer. Absent this incentive, fashion designers may fail to continue providing new apparel designs, thereby contravening the purpose of copyright law to encourage the useful arts. Copyright law requires a minimum of originality, and this requisite is ostensibly met by even the least creative of designers who assemble existing elements in a new manner. The fact that fashion designers satisfy the originality requirement is evident in the consumer valuation of garment designs, which now focuses primarily upon appearance, style, and image as opposed to function. The only bar would then be copyright's general prohibition against inherently useful items.

As it stands, copyright law fails to protect fashion designs as a form of original authorship. Instead, copyright law allows fashion designs to fall into the abyss of the public sphere without any semblance of safeguards for the original creative expression of designers. Since fashion designs have both aesthetic and functional purposes, copyright should extend protection to the design elements both functional and aesthetic in combination, so that others cannot piggyback upon the popularity of a designer and deprive the originator of the benefits of creating the garment.

#### Footnotes

- <sup>a1</sup> Attorney, Davis Wright Tremaine LLP, Seattle, Washington. This article reflects the views of the author and not necessarily of Davis Wright Tremaine LLP, its partners or its clients. The author would like to thank Professor Kate O'Neill, University of Washington School of Law, for her assistance during the infancy of this article. The author would also like to thank his wife, Carly Tu, for her unending love and support.
- <sup>1</sup> Randall C. Harris, *A Beginner's Guide to Apparel Manufacturing: The Apparel Industry Today* 1 (2001) (on file with author).
- <sup>2</sup> Press Release, The NPD Group, Inc., *The U.S. Apparel Market 2007 Dresses Up...Way Up* (Mar. 18, 2008), [http://www.npd.com/press/releases/press\\_080318.html](http://www.npd.com/press/releases/press_080318.html).
- <sup>3</sup> Safia A. Nurbhai, *Style Piracy Revisited*, 10 *J.L. & Pol'y* 489, 489 (2002).
- <sup>4</sup> Rocky Schmidt, *Designer Law: Fashioning a Remedy for Design Piracy*, 30 *UCLA L. Rev.* 861, 861 (1983).
- <sup>5</sup> *Id.* at 868 n.49.
- <sup>6</sup> Nurbhai, *supra* note 3, at 489-90 (citing *Wolfenstein v. Fashion Originators' Guild of Am., Inc.*, 280 N.Y.S. 361, 364 (N.Y. App. Div. 1935)).
- <sup>7</sup> See Alex Barbieri, *Getting Real About Fake Designer Goods*, *Spt.* 29, 2004, <http://www.bankrate.com/brm/news/advice/scams/20040929a1.asp> (noting that imitations sell at a fraction of the cost and can be found on over 5,000 sites on the Internet, at in-home sales parties akin to Tupperware gatherings of old, and at counterfeit bazaars on Canal Street in Chinatown in New York City).
- <sup>8</sup> See, e.g., *Id.* (noting that Louis Vuitton's famous monogram bag has inspired look-alikes with similar patterns such as a bag covered with monogrammed "XOs" rather than "LVs").
- <sup>9</sup> See *Despite Strong Vuitton Mark, Facts Lacking to Enjoin Accused Knock-off Handbags*, 68 *Pat. Trademark & Copyright J.* (BNA) No. 1674, at 114 (June 5, 1980) (noting the attempt to enjoin production of beaded "NY" monogrammed bags inspired by the Louis Vuitton "LV" handbag in *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, No. 04 Civ. 2644, 2004 WL 1161167, at \*5 (S.D.N.Y. May 24, 2004)); *Multicolored Mark Doesn't Infringe Louis Vuitton's Marks, Despite Similarities*, 68 *Pat. Trademark & Copyright J.* (BNA) No. 1687, at 552 (Sept. 17, 2004) (noting another Louis Vuitton suit against a manufacturer of monogrammed bag with different initials and lacking certain geometric shapes found on the original Louis Vuitton bag in *Louis Vuitton Malletier v. Dooney & Bourke Inc.*, 340 F. Supp. 2d 415, 420 (S.D.N.Y. 2004)).

- <sup>10</sup> Style piracy of fashion designs has been a point of contention in the courts since at least the 1930s. See, e.g., Wolfenstein, 280 N.Y.S. at 362 (involving an agreement between associations composed of manufacturers and retailers of ladies' dresses, prohibiting style piracy); *Wm. Filene's Sons Co. v. Fashion Originators' Guild of Am.*, 90 F.2d 556, 557-58 (1st Cir. 1937) (involving the copying of original dress designs of women's ready-to-wear fashion); *Fashion Originators' Guild of Am. v. Fed. Trade Comm'n*, 312 U.S. 457 (1941) (concerning the systematic copying of original dress and fabric designs); *Nat Lewis Purses, Inc. v. Carole Bags, Inc.*, 83 F.2d 475, 475-76 (2d Cir. 1936) (discussing potential patent infringement of a woman's purse); *Johnny Carson Apparel, Inc. v. Zeeman Mfg. Co.*, 203 U.S.P.Q. (BNA) 585, 589 (N.D. Ga. 1978) (noting that the copying of garments is an old practice in the clothing industry).
- <sup>11</sup> Harris, *supra* note 1, at 4; see also Teri Agins, Copy Shops: Fashion Knockoffs Hit Stores before Originals as Designers Seethe Photos, Fax, Fedex and Spies Make Imitation Pervasive and All but Instantaneous--An Expensive Suit for Lauren, Wall St. J., Aug. 8, 1994, at A1.
- <sup>12</sup> See Nurbhai, *supra* note 3, at 490 (noting that design pirates can sneak into a fashion show and have duplicates available the next day or, alternatively, purchase the garment and return it after having it copied).
- <sup>13</sup> Harris, *supra* note 1, at 4.
- <sup>14</sup> Schmidt, *supra* note 4, at 861-62; see also Mingxia Xu, Canal St. Shoppers Have Designs on Counterfeit Bags, The Villager, Oct. 6-12, 2004, at 2, available at [http://www.thevillager.com/villager\\_75/canalstshoppers.html](http://www.thevillager.com/villager_75/canalstshoppers.html) (noting that the popularity of counterfeit designer handbags even provokes customers to return the high-priced originals).
- <sup>15</sup> See *infra* Part III.A.
- <sup>16</sup> See *infra* Part III.A.
- <sup>17</sup> See *infra* Part IV.
- <sup>18</sup> See *infra* Part IV.
- <sup>19</sup> See *infra* Part IV.
- <sup>20</sup> See *infra* Part IV.
- <sup>21</sup> U.S. Const., art. 1, § 8, cl. 8; see also Jeff Toole, *Campbell v. Acuff-Rose Music, Inc.: The Rap on Remedies*, 29 Ind. L. Rev. 467, 468-70 (1995) (discussing the careful balance required in copyright law of protecting original designers to promote continued creativity and the corollary need to prevent monopoly and to allow public use to spawn additional original works).
- <sup>22</sup> See *Minneapolis Co. v. Normandin*, 338 N.W. 2d 18, 22 (Minn. 1983) ("The purpose of trademark law is to protect the public from confusion regarding the sources of goods or services and protect business from diversion of trade through misrepresentation or appropriation of another's goodwill.").
- <sup>23</sup> Statute of Anne, 1710, 8 Anne, c. 19.
- <sup>24</sup> Act of May 31, 1790, ch. 15, 1 Stat. 124.

25 Act of Apr. 29, 1802, ch. 36, 2 Stat. 171.

26 Act of Feb. 3, 1831, ch. 16, 4 Stat. 436.

27 Act of Mar. 3, 1865, ch. 126, 13 Stat. 540.

28 Act of July 8, 1870, ch. 230, 16 Stat. 198.

29 Copyright Act of 1909, § 4, 35 Stat. 1075.

30 See generally *Burrow-Giles Lithographic Co., v. Sarony*, 111 U.S. 53, 58 (1884) (clarifying that the Constitution's grant to Congress of securing exclusive rights to authors of writings as not literal but rather inclusive of all forms of expression as evidenced by the legislature's continued additions to the coverage of the statute).

31 Copyright Act of 1909, § 5, 35 Stat. 1075.

32 Copyright Act of 1909, § 5(g), 35 Stat. 1075.

33 *Nurbhai*, supra note 3, at 495 (citation omitted).

34 *Nurbhai*, supra note 3, at 495 (citation omitted).

35 *Nurbhai*, supra note 3, at 495-97.

36 Copyright Act of 1976, 17 U.S.C. § 102(a) (2006).

37 See Copyright Act of 1909, § 102(a)(1)-(8), 35 Stat. 1075.

38 See 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.08 [H][3], at 2-145 to -146 (2004) (citing several instances of protecting masquerade costumes as applied art in the Ninth Circuit and several district courts).

39 See *Poe v. Missing Persons*, 745 F.2d 1238, 1240-43 (9th Cir. 1984).

40 See H.R. Rep. No. 94-1476, at 9 (1976), reprinted in 1976 U.S.S.C.A.N. 5659, 5668.

41 *Dan Kasoff, Inc. v. Gresco Jewelry Co.*, 204 F. Supp. 694, 694 (S.D. N.Y. 1962), *aff'd*, 308 F.2d 806, 806 (2d Cir. 1962).

42 *Boucher v. DuBoyes, Inc.*, 253 F.2d 948, 949 (2d Cir. 1958).

43 *Sunset House Distrib. Corp. v. Doran*, 304 F.2d 251, 251-52 (9th Cir. 1962).

44 Nimmer & Nimmer, supra note 38, § 2.08 [B][3], at 2-91.

45 See Nimmer & Nimmer, supra note 38, § 2.08[B][3], at 2-90 to -91.

46 See *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142, 142-43 (S.D.N.Y. 1959).

47 Nimmer & Nimmer, supra note 38, § 2.08[D][2][a], at 2-145.

48 17 U.S.C. § 101 (2006) (defining “pictorial, graphic, and sculptural works”).

49 See generally Nimmer & Nimmer, supra note 38, § 2.08, at 2-144 to - 149.

50 See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121-22 (2d Cir. 1930) (refusing to extend copyright protection to basic background plots and stock characters absent original development because there are only a limited number of basic characters and plots); *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54-57 (2d Cir. 1936) (extending copyright protection to the additional texture and detail of expression placed atop the general patterns available in the public domain).

51 See *Feist Publ’ns, Inc., v. Rural Tel. Ser. Co.*, 499 U.S. 340, 340-41 (1991) (clarifying that compilation of facts available in the public domain, such as a telephone directory, may receive copyright protection for original selection and organization but not for the facts themselves).

52 Nimmer & Nimmer, supra note 38, § 2.08[H][3], at 2-145 (citing *Beaudin v. Ben & Jerry’s Homemade, Inc.*, 95 F.3d 1, 2 (2d Cir. 1996); *Russell v. Trimfit, Inc.*, 428 F. Supp. 91, 94 (E.D. Pa. 1977), *aff’d*, 568 F.2d 770 (3d Cir. 1978); *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 188 (S.D.N.Y. 1934)).

53 *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 n.12 (D.C. Cir. 1978).

54 Nurbhai, supra note 3, at 501.

55 Nurbhai, supra note 3, at 501.

56 See H.R. Rep. No. 94-1476, at 50 (1976), reprinted in 1976 U.S.C.C.A.N. 5659.

57 See *Esquire*, 591 F.2d at 801 (citation omitted).

58 *Id.* at 801 n.15.

59 Trademark (Lanham) Act of 1946 § 43(a), 15 U.S.C. § 1125 (a), (c) (2006).

60 15 U.S.C. § 1125(a).

61 M. Elaine Buccieri, Cause of Action for Trademark Infringement Under the Lanham Act, in 10 Causes of Action 2d 501, at § 2 (2009).

62 Id. (citing as an example *Star Fin. Servs., Inc. v. AASTAR Mortgage Corp.*, 89 F.3d 5 (1st Cir. 1996)).

63 See *Sports Design & Dev., Inc. v. Schoneboom*, 871 F. Supp. 1158, 1160 n.2 (N.D. Iowa 1995).

64 A trademark is a symbol, word, or name which identifies a particular product as coming from a distinct source. See 15 U.S.C. § 1127; see also *Fila U.S.A., Inc. v. Kim*, 884 F. Supp. 491, 493 (S.D. Fla. 1995) (providing judicial recognition of the definition of trademark).

65 Buccieri, supra note 61, § 1.

66 Buccieri, supra note 61, § 5.

67 *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

68 Suggestive marks do not describe the product directly, but rather require the consumer to utilize imagination to understand the description. *Sprinklets Water Ctr., Inc. v. McKesson Corp.*, 806 F. Supp. 656, 661 (E.D. Mich. 1992). A common example of suggestive marks is team names in professional athletics. See, e.g., *Harlem Wizards Entm't Basketball, Inc. v. NBA Props., Inc.*, 952 F. Supp. 1084, 1093 (D. N.J. 1997) (noting that the team name “Wizards” is suggestive, as the consumer must imagine the connection to basketball).

69 An arbitrary mark possesses a dictionary meaning but that common meaning does not accurately describe the product. Buccieri, supra note 61, § 14.

70 See Buccieri, supra note 61, § 14 (“A fanciful mark is a made up term or combination of letters or other symbols used to describe a product or service. The term has no separate significance or meaning apart from the product or service to which it is affixed.” (internal citation omitted)). One such fanciful mark is KODAK.

71 *Two Pesos*, 505 U.S. at 768.

72 Buccieri, supra note 61, § 16.

73 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 13:2 (4th ed. 2009); see 15 U.S.C. 1052(e)-(f) (2006).

74 Restatement (Third) of Unfair Competition § 21, cmt. a (1995). Confusion is established through the following factors: “(1) strength of the mark, (2) similarity of the marks, (3) relation of the goods ... (4) similarity of marketing channels, (5) sophistication of the intended purchaser, (6) evidence of actual confusion, (7) intent of the defendant, (8) likelihood of expansion, and (9) discrepancies in quality between the products.” Buccieri, supra note 61, § 43. Generally, a plaintiff’s showing of likely confusion may be rebutted by a showing of one of the following: “(1) the marks are not confusingly similar, (2) the goods ... are non-competitive and unrelated, and (3) the goods ... of the defendant are sold in a remote trade territory, yielding no direct competition.” Buccieri, supra note 61, § 28.

75 See 15 U.S.C. §§ 1114(1), 1115(a).

- 76 See 15 U.S.C. § 1125; see also Marjorie A. Shields, What Constitutes “Famous Mark” for Purposes of Federal Trademark Dilution Act, 15 U.S.C.A. §1125(c), which Provides Remedies for Dilution of Famous Marks, 165 A.L.R. Fed. 625 § 2 (2000) (discussing how a court, when determining whether a mark is distinctive and famous, may consider facts including but not limited to (1) degree of distinctiveness inherent or acquired; (2) duration and extent of use in connection with goods; (3) duration and extent of advertising or publicity targeted at the mark; (4) geographical trading area in which the mark is used; (5) channels of trade for the goods; (6) the degree of recognition of the mark; (7) nature and extent of use of the same or similar marks by third parties; and (8) whether the mark was federally registered).
- 77 See Shields, *supra* note 76, § 9[a].
- 78 See, e.g., Nike Inc. v. Variety Wholesalers, Inc., 274 F. Supp. 2d 1352 (S.D. Ga. 2003) (finding Variety infringed Nike’s trademarks by selling counterfeit Nike socks, T-shirts, and fleece items bearing designs similar to Nike’s trademarks); Levi Strauss & Co. v. Amer. Pub. Co. Mktg., Inc., No. C-97-00681 DLJ, 1997 WL 337549 at \*23 (N.D. Cal. May 27, 1997) (permanently enjoining alleged infringer from directly or indirectly manufacturing, distributing, or producing apparel bearing Levi’s or a substantially similar, distinctive pocket stitching and tab device); Louis Vuitton Malletier & Oakley, Inc. v. Veit, 211 F. Supp. 2d 567, 577-78 (E.D. Pa. 2002) (finding dilution of the distinctive quality of “Louis Vuitton” and “Oakley” registered trademarks in use of louisvuitton-replicas.com domain name to sell products that the purchasing public was likely to attribute to the infringer’s use a source of origin, authorization, or sponsorship to the detriment of the trademark holder); Victoria’s Secret Stores v. Artco Equip. Co., Inc., 194 F. Supp. 2d 704, 704 (S.D. Ohio 2002) (finding bad-faith use of the trademark “Victoria’s Secret” in websites to divert consumers to an adult novelty store selling items such as lingerie).
- 79 15 U.S.C. § 1117(a) (2006).
- 80 15 U.S.C. §§ 1116, 1118.
- 81 See 28 U.S.C. § 2201(a).
- 82 See, e.g., Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 418 (2003) (denying trademark protection absent evidence that use resulted in actual injury to the economic value of the famous mark); Tommy Hilfiger Licensing, Inc. v. Nature Lab, LLC, 221 F. Supp. 2d 410, 416-17 (S.D.N.Y. 2002) (finding that the broadness of the joking use of Tommy Holedigger pet perfume did not pose a risk of negative associations to the famous mark).
- 83 See 15 U.S.C. § 1127 (defining trademark); see also Buccieri, *supra* note 61, § 2 (“[T]he Lanham Act protects a merchant’s good will and business reputation by granting the merchant exclusive rights in the mark under which he or she sells products and services.”).
- 84 Buccieri, *supra* note 61, § 21.
- 85 Buccieri, *supra* note 61, § 21.
- 86 15 U.S.C. § 1125(a) (2006).
- 87 James E. Clevenger, Proof of Trade Dress Infringement, in 55 Am. Jur. 3d Proof of Facts 383, at § 1 (2000).
- 88 Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253, 1256 (5th Cir. 1989).
- 89 Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 764 n.1 (1992) (quoting John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1981)).

- 90 1 McCarthy, *supra* note 73, § 8.1.
- 91 See David E. Rigney, *Application of Secondary Meaning Test in Action for Trade Dress Infringement Under § 43(a) of Lanham Act* (15 U.S.C.A. §1125(a)), 87 A.L.R. Fed. 15, § 2[a] (2005); see also *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 635 (6th Cir. 2002).
- 92 Rigney, *supra* note 91, § 2[a].
- 93 Rigney, *supra* note 91, § 2[a].
- 94 See *Vuitton Et Fils, S. A. v. Crown Handbags*, 492 F. Supp. 1071, 1077 (S.D.N.Y. 1979) (quoting *Monsanto Chem. Co. v. Perfect Fit Prods. Mfg. Co.*, 349 F.2d 389, 392 (2d Cir. 1965).
- 95 See, e.g., *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71 (2d Cir. 1985) (finding secondary meaning established and enjoining defendant from marketing lightweight luggage and bags that contained confusingly similar dress, in part because of substantial advertising, unsolicited media coverage, and high sales volume); *Scholl, Inc. v. Tops E.H.R. Corp.*, 185 U.S.P.Q. (BNA) 754, at \*2-3, \*12 (E.D.N.Y. 1975) (finding secondary meaning established in distinctive blue and yellow color combination, in part because of properly focused, extensive advertising); *Le Sportsac, Inc. v. Dockside Research, Inc.*, 478 F. Supp. 602, 608-09 (S.D.N.Y. 1979) (finding substantial evidence of secondary meaning in line of travel bags and accessories, in part because of properly focused, extensive advertising, unsolicited media coverage, and increased sales); *Stormy Clime, Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 972, 974 (2d Cir. 1987) (finding secondary meaning in trade dress of a rain jacket because of substantial advertising expenditures, increased sales, and the exclusive sale of the jacket under registered trademark); *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 821 (9th Cir. 1980) (finding established secondary meaning in a pocket tab used on jeans based on widespread advertising directed to the mark and high revenue of sales).
- 96 See, e.g., *Coach Leatherware Co. v. Ann Taylor, Inc.*, 933 F.2d 162 (2d Cir. 1991) (finding no secondary meaning in part because of the consumer awareness survey's inability to establish that the overall design of the manufacturer's handbag has attained requisite association in the minds of the public); *Calvin Klein Co. v. Farah Mfg. Co.*, 229 U.S.P.Q. (BNA) 795, at \*23-24, \*26 (S.D.N.Y. 1985) (finding no secondary meaning in the back-pocket design stitching of jeans because of insufficient evidence of consumer association absent advertising that suggested the design as an identifying mark); *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 860-61 (11th Cir. 1983) (finding no secondary meaning in shoe company's "V" design because of insufficient evidence of consumer association absent proper consumer recognition surveys and minimal advertising focus on the design); *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985) (finding no secondary meaning in a shirt pocket tab because the survey conducted did not support secondary meaning, there was no evidence of sales, and there was little evidence of advertising or promoting the shirt tab).
- 97 See *Levi Strauss*, 632 F.2d 817 at 821; *Levi Strauss*, 778 F.2d at 1358.
- 98 Despite Strong Vuitton Mark, Facts Lacking to Enjoin Accused Knock-off Handbags, *supra* note 9, at 1475, and accompanying text.
- 99 Multicolored Mark Doesn't Infringe Louis Vuitton's Marks, Despite Similarities, *supra* note 9, at 553, and accompanying text.
- 100 See *infra* Part III.a.
- 101 See *supra* Part II.c.

102 See Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 209 (2000).

103 See id. at 207.

104 Id. at 207-08.

105 See id. at 216.

106 Hermès Int'l v. Steven Stolman, Ltd., No. CV 033722, 2003 WL 23883672, at \*1 (E.D.N.Y. July 30, 2003).

107 Ginia Bellafante, A Satire of a Classic Fails to Amuse the August House of Hermès, N.Y. Times, Aug. 12, 2003, at B8.

108 Id.

109 Id.

110 See Bag the Knockoffs, Newsday, Aug. 14, 2003, available at <http://www.kirkland.com/sitecontent.cfm?contentID=230&itemId=7391>.

111 Adidas-Salomon AG v. Target Corp., No. CV-01-1582-ST, 2002 WL 31971831, at \*7-8 (D. Or. July 31, 2002).

112 Id. at \*5.

113 Id. at \*2.

114 Id. at \*12, \*17- 18.

115 See id., at \*6.

116 1 McCarthy, supra note 73, § 8:2 (quoting Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 613 (9th Cir. 1989)); see also Clicks Billiards, Inc. v. Sixshooters, Inc., 251 F.3d 1252, 1259 (9th Cir. 2001) (“Trade dress is the composite tapestry of visual effects ... [and] must be examined as a whole, not by individual constituent parts.”); Fuddruckers, Inc. v. Doc’s B.R. Others, Inc., 826 F.2d 837, 842 (9th Cir. 1987) (“[F]unctional elements that are separately unprotectable can be protected together as part of trade dress.”) (quoting LeSportsac, Inc. v. Kmart Corp., 754 F.2d 71, 76 (2d Cir. 1985).

117 See Adidas-Salomon, 2002 WL 31971831 at \*7 (D. Or. July 31, 2002).

118 Id.

119 Id. (citing Fuddruckers, 826 F.2d at 843 n.7).

120 Id. at \*11.

121 See id. at \*2.

122 See id.

123 See *Adidas-Salomon AG v. Target Corp.*, No. CV-01-1582-ST, 2002 WL 31971831, at \*12 (D. Or. July 31, 2002).

124 See id. at \*13.

125 See *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1256 n.16 (9th Cir. 1982); *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1050 (9th Cir. 1999).

126 *Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991).

127 Initial interest confusion occurs where similarities are used “to capture initial consumer attention even though no actual sale is finally completed as a result of the confusion.” *Adidas-Salomon*, 2002 WL 31971831, at \*16 (quoting *Dr. Seuss Enters. L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997)).

128 Post-sale confusion occurs where “consumers view a product outside the context in which it is originally distributed and confuse it with another, similar product” and can establish the requisite likelihood of confusion. *Id.* (quoting *Acad. of Motion Pictures Arts & Scis.*, 944 F.2d at 1455).

129 *Payless Shoesource, Inc. v. Reebok Int'l Ltd.*, 998 F.2d 985, 989-90 (Fed. Cir. 1993).

130 See id.

131 Fabric designs have been deemed generally capable of copyright protection. See *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142, 143 (S.D.N.Y. 1959).

132 Since the typical Burberry handbag design does not include ornamental or sculptural accoutrements like a large sculpted belt buckle, there would likely be judicial hesitancy to grant protection. Cf. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 990, 992 (2d Cir. 1980) (unlike an unornamented handbag, the sculptural shape of a belt buckle was found to be separate from its intrinsic function and eligible for copyright).

133 Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2006); see also *Kendall-Jackson Winery, Ltd., v. E. & J. Gallo Winery*, 150 F.3d 1042, 1046 (9th Cir. 1998) (making actionable use of marks).

134 See supra note 40 and accompanying text.

135 *Poe v. Missing Persons*, 745 F.2d 1238, 1240-43 (9th Cir. 1984).

136 See supra note 38 and accompanying text.

137 See supra notes 40-48 and accompanying text.

138 See supra notes 96-111, 122-124, and accompanying text.

139 See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991) (“The sine qua non of copyright is originality.”).

140 Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884).

141 See id. at 53.

142 See Feist, 499 U.S. at 345-46.

143 See H.R. Rep. No. 94-1476, at 54, reprinted in 1976 U.S.S.C.A.N. 5659, 5667.

144 Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903).

145 Id. at 250.

146 Id. (emphasis added).

147 See Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 56 (1884) (citing U.S. Const., art. 1 § 8, cl. 8).

148 See U.S. Const., art. 1 § 8; see also Jeff Toole, Campbell v. Acuff-Rose Music, Inc.: The Rap on Remedies, 29 Ind. L. Rev. 467, 468-70 (1995) (discussing the careful balance required in copyright law of protecting original designers to promote continued creativity and the corollary need to prevent monopoly and to allow public use to spawn additional original works).

149 See Schmidt, supra note 4, at 861-62.

150 Schmidt, supra note 4, at 863.

151 See generally Steinberg v. Columbia Pictures Indus., Inc., 663 F. Supp. 706, 709, 711-13 (1987) (protecting substantial similarity in visual works).

152 See Schmidt, supra note 4, at 861-62.

153 See Christine Magdo, Protecting Works of Fashion from Design Piracy, Harvard Legal Electronic Document Archive, 2000 <http://leda.law.harvard.edu/leda/data/36/MAGDO.pdf>. Industrial designs continue to be the subject of many bills, but Congress has explicitly excluded fashion works from these bills; for example, the Industrial Design Anti-Piracy Act of 1989. Industrial Design Anti-Piracy Act of 1989, H.R. 3017, 101st Cong. (1989).

154 See supra note 61 and accompanying text.

155 See supra note 61 and accompanying text.

<sup>156</sup> See 17 U.S.C. § 302(a)-(b) (2006).

<sup>157</sup> See 17 U.S.C. § 302(c).

<sup>158</sup> See, e.g., Nurbhai, *supra* note 3, at 517 (advocating a one-year term of protection); Schmidt, *supra* note 4, at 877 (advocating a one-year term for apparel design protection).