

# Fashion Law: Protecting Brands and Designs

By David M. Adler

Charles Caleb Colton was a 19th century English pundit and the author of the famous aphorism “Imitation is the sincerest (form) of flattery.” This has never been more apt than in the fast-paced world of fashion, where celebrated and aspiring fashion designers alike constantly draw on prior art for inspiration in the never-ending effort to stay fresh, relevant, and marketable. As Tim Gunn (mentor to would-be fashion designers on the television show *Project Runway*) often says, “Make it work.” In other words, find inspiration in themes and styles but find your own voice, or “brand,” and, more importantly, protect what makes you distinctive.

As an intellectual property lawyer, I am often asked about “fashion law,” and asked to provide advice on intellectual property and commercial matters to fashion designers, manufacturers, distributors, modeling agencies, retailers, and photographers. Relevant issues involve everything from branding; protection and enforcement of intellectual property and personality/publicity rights; and the more obvious commercial side of the business, such as licensing, manufacturing, and distribution contracts, and agency and franchising agreements.

While each fashion designer brings a unique perspective and fashion sense to his or her craft, starting a fashion or design company is really no different than starting any other business that derives value from creative content. For many designers, the questions most often asked are “How do I protect my brand?” “How do I protect my designs?” and “What do I do if other people copy me?”

To answer the first two questions, it is useful to approach each situation with three basic concepts in mind. A fashion designer needs to protect his or her *ideas*, *relationships*, and *talent*. This article looks at this first task, protecting the fashion designer’s ideas. Broadly speaking, this usually means copyrights and trademarks although it can include patents and trade secrets. The latter two usually are not that relevant to a clothing company unless you have created some new manufacturing process or method. Some may be familiar with Lululemon and its patent on women’s yoga pants waistbands.

There is no simple answer to the last question, what to do when one is being copied. Each circumstance is unique and highly dependent on the facts. Whether and to what extent any design or brand may be protected will require an analysis of those facts and the relevant areas of law. This article aims to give fashion designers and their lawyers better insight into the two most relevant sections of law.

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Thinking about protecting fashion design ideas typically involves two separate but related concepts: (1) the designer’s “brand” or identity; and (2) the embodiment of the designer’s ideas, the designs themselves. To answer the question, “How do I protect my brand?” one typically begins with application of trademark law. To answer the question, “How do I protect my designs?” one generally looks to copyright law.

## Trademark Law

It is important for designers and other creative professionals to market intelligently and effectively. Money spent on marketing must generate revenue and set the stage for future growth. In fashion, image and reputation are highly important; therefore, marketing must focus on conveying a relevant and distinguishable message. However, as important as image is, timing is everything. I cannot stress enough the importance of an early consultation with an intellectual property lawyer to determine whether a brand is available and to take the steps necessary to protect it.

## What Is a Brand?

According to the *Oxford American Dictionary*, a “brand” is a composite of attributes, both tangible and intangible, symbolized by a trademark, which if managed properly, creates value and influence.<sup>1</sup> “Value” has different interpretations: from a marketing or consumer perspective, it is the promise and delivery of an experience; from a business perspective, it is the security of future earnings; from a legal perspective, it is a separate piece of intellectual property.

A brand identifies a business’s products or services by creating an association in the customer’s mind, and solidifying preference and loyalty. Brands simplify decision making, represent an assurance of quality, and offer a relevant and credible choice among competing offerings. From both a legal and business perspective, brands are *assets*, the value of which is enormous. Brands derive value from the fact that loyal customers come back again and again.

Consumers and even some marketing professionals often confuse a “brand” with other marketing techniques that are not brands. For example, an advertising campaign, a slogan, or a logo is not a “brand.” Standing alone, none of those necessarily convey source or attributes. A brand is not solely created for the customer. Rather, a brand resonates with many people: employees, shareholders, customers, partners, and end users.

## Trademarks and Trademark Rights

As noted above, a trademark symbolizes a “brand.” A trademark is any word, name, symbol (including sound), or device, or any combination, used, or intended to be used, in commerce to identify and distinguish the goods of one manufacturer or seller from others,

and to indicate the source of the goods.<sup>2</sup> Although sometimes confused, a service mark identifies and distinguishes services. For purposes of identification, use, and protection, trademarks and service marks are legally indistinguishable.

Trademarks are important because registration is not required to establish rights in a mark, nor is it required to begin use of a mark. However, federal registration can secure benefits beyond the rights acquired by merely using a mark. For example, the owner of a federal registration is presumed to be the owner of the mark for the goods and services specified in the registration, and to be entitled to use the mark nationwide.

Because the United States Patent and Trademark Office's (USPTO's) authority is limited to determining the right to register,<sup>3</sup> only a court may render a decision about the right to use, such as issuing an injunction or awarding damages for infringement. It should be noted that a federal registration can provide significant advantages to a party involved in a court proceeding. For example, because the owner of a registered mark is presumed to be the exclusive owner for the associated goods or services, this shifts the burden to the alleged infringer to prove that its use is noninfringing.

Trademark rights arise from either actual use of the mark or the filing of a proper application to register a mark with the USPTO, stating that the applicant has a bona fide intention to use the mark in commerce regulated by the U.S. Congress. It is worth noting that several recent Trademark Trial and Appeal Board cases have heightened the evidentiary requirement for proving bona fide intent. Acceptable evidence of such intent may include market studies, focus groups, marketing plans, and similar documented efforts to identify and promote a brand.

Two related but distinct types of rights exist in a mark: the right to register and the right to use. Generally, the first party who either uses a mark in commerce or files an application with the USPTO has the ultimate right to register that mark. Unlike copyrights or patents, trademark rights can last indefinitely if the owner continues to use the mark to identify its goods or services. The term of a federal trademark registration is 10 years, with 10-year renewal terms. However, between the fifth and sixth year after the date of initial registration, the registrant must file an affidavit setting forth certain information to keep the registration alive. If no affidavit is filed, the registration is canceled.

Anyone who claims rights in a mark may use the TM (trademark) or SM (service mark) designation with the mark to alert the public to the claim. It is not necessary to have a registration, or even a pending application, to use these designations. The claim may or may not be valid. The registration symbol ® may only be used when the mark is registered with the USPTO. It is improper to use the symbol at any point before the registration issues.

From the perspective of the fashion designer, or "fashion lawyer," one need look no further than the recent decision in *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, to see the importance of trademarks in fashion.<sup>4</sup> At issue in this Second Circuit case was whether, in the fashion industry, the color red merits trademark protection. Specifically, Louboutin sought to enforce its federal trademark registration for a lacquered red sole on footwear. The case arose because Yves Saint Laurent (YSL) launched a line of monochromatic shoes,

including a shoe with a lacquered red sole. Not surprisingly, the district court held that Louboutin's trademark registration was inherently functional and thus likely invalid, and it denied Louboutin's motion to enjoin YSL's sales of the monochromatic shoe.

The district court decision was reversed on appeal. The Second Circuit held that Louboutin's red sole mark was valid and enforceable, and that a single color can serve as a trademark. However, the court limited the single-color mark in the fashion industry to those circumstances where, as here, the mark has achieved secondary meaning in the public eye. Specifically, the court found that the mark's secondary meaning was limited to shoes in which the red sole contrasts with a differently colored upper. The decision has both sides claiming victory because the court found that YSL's monochromatic shoe was not within the scope of Louboutin's trademark protection.

### Copyright Law

Just as trademark law allows the fashion designer to protect his or her brand, copyright law may provide a way to protect his or her designs. First, creative works of authorship fixed in a tangible medium of expression are protected by copyright.<sup>5</sup> Unfortunately, copyright protection also requires a certain amount of "originality." Because so much of fashion is derivative of what has come before, it can be difficult to create a design that is sufficiently original to prevent others from creating one that is strikingly similar.

Another hurdle for protection of fashion designs is the tension with § 102(a)(5) of the Copyright Act.<sup>6</sup> That section protects "pictorial, graphic, and sculptural works," including "two-dimensional and three-dimensional works [of artistic craftsmanship] of fine, graphic, and applied art . . . if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."<sup>7</sup>

Courts have viewed this requirement as requiring either "physical separability" or "conceptual separability," a test that they have struggled to pin down. However, courts that have addressed the issue in the case of designs of clothing containing arm and neck holes, ruffles, beads, etc., as opposed to artwork on the surface of clothing, have routinely viewed clothing garments as utilitarian because they "cover the wearer's body and protect the wearer from the elements."<sup>8</sup> "Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself."<sup>9</sup>

To illustrate, consider the (in)famous "meat dress" worn by Lady Gaga. In this example, the "concept" of a garment composed of meat is separable from the function, covering the body. Put another way, "meat" had no function as a garment until someone came up with the idea of making it into the form of a dress.

Contrast that with, say, shoes that have a bright red sole. The color of the sole of the shoe is irrelevant to its function. However, the concept of the sole of the shoe is not. In other words, regardless of the color, the sole of a shoe serves a primarily utilitarian purpose. Merely changing the color does not physically alter its function.

The second method by which a designer may be able to protect his or her ideas is somewhat novel and as yet

nonexistent. I am referring to the not-yet-enacted “Fashion Bill,” the Innovative Design Protection Act of 2012 (S. 3523) proposed by Senator Charles Schumer. The bill is a follow-up to the failed Innovative Design Protection and Piracy Prevention Act (H.R. 2511). The bill would amend the Copyright Act to extend certain protections to fashion designs.

If enacted, the law would be the extension of design protection to fashion designs, by amending § 1301(a) of the Copyright Act to provide that “[a] fashion design is subject to protection under this chapter” and by amending § 1302(b) to include “an article of apparel” in the definition of “useful articles” subject to protection. The bill would make clear that for purposes of protection, a fashion design is the appearance as a whole of an article of apparel, including its ornamentation. The bill elaborates on what would constitute apparel: “(A) an article of men’s, women’s, or children’s clothing, including undergarments, outerwear, gloves, footwear, and headgear; (B) handbags, purses, wallets, tote bags, and belts; and (C) eyeglass frames.” Notably, the duration for such protection would be considerably less than customary copyright protections. The term of protection for fashion designs would be only three years.

Proponents of the legislation have explained that the purpose of the legislation is to protect designs of haute couture during the period of time in which such high-end clothing is sold at premium prices of thousands of dollars and to prevent others from marketing clothing with those designs at substantially lower prices during that initial period, thereby undercutting the market for a hot new fashion design. Because the peak demand for such designs is

relatively short-lived, a three-year term is considered adequate to satisfy the designer’s reasonable expectation of exclusivity.

Fashion design occupies a unique position in the world of creative endeavors. On the one hand, tastes, styles, and market conditions change, putting a premium on innovative ideas and creative expression. Intellectual property was designed to incentivize such creativity by granting creators protection from unfair competition and theft of original ideas. On the other hand, so much of fashion design is derivative and can be driven by the overwhelmingly functional considerations. Intellectual property law must balance incentives with the needs of the marketplace and freedom to express one’s creative ideas without being unduly constrained by what has come before.

So what’s a designer to do? As the esteemed Mr. Gunn says, “Make it work.” ■

## Endnotes

1. OXFORD AMERICAN DICTIONARY (Oxford University Press, 1980).
2. 15 U.S.C. § 1127.
3. 37 C.F.R. § 2.11.
4. No. 11-3303-cv (2d Cir. Sept. 5, 2012).
5. 17 U.S.C. § 102(a).
6. *Id.* § 102(a)(5).
7. *Id.* § 101.
8. *Celebration Int’l, Inc. v. Chosun Int’l, Inc.*, 234 F. Supp. 2d 905, 912 (S.D. Ind. 2002).
9. *Mazer v. Stein*, 347 U.S. 201, 217 (1954).