Fashion design and IPRs

Fashion designs could be protected by...

- Patent
- Design Patent
- Trademark
- Trade dress
- Copyright
- Competition law
- Sui generis protection
US: Fashion designs and IPRs

- Design Patent?
  - Difficult to satisfy the “nonfunctional”, “new” and “nonobvious” criteria.
  - Process too long and expensive for constantly changing fashion trends.

- Trademark or trade dress?
  - Difficult to identify origin of clothing or to obtain “secondary meaning”.

- Copyright??

(By USPTO)
US: Fashion designs and copyright

- Scope of copyright:
  Original works fixed in any tangible medium of expression, including design of a “useful article”.

- Separability requirement for useful article:
  Design of a useful article protected only when it “can be identified separately from, and is capable of existing independently of, the utilitarian aspects of the article”.

US: Separability requirement for useful articles

- Physical separability:

  Design “can actually be removed from the original item and separately sold, without adversely impacting the article’s functionality”.

- Conceptual separability:

  The design “invokes a concept separate from that of the article’s clothing function” and “its addition to the article was not motivated by a desire to enhance the article’s functionality qua clothing”.

WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION
### US: Fashion designs protectable by copyright?

**- No in general**

<table>
<thead>
<tr>
<th>Protected</th>
<th>Not protected</th>
</tr>
</thead>
<tbody>
<tr>
<td>• Fabric designs, patterns</td>
<td>• <strong>3D clothing designs in general</strong></td>
</tr>
<tr>
<td>• Belt buckle</td>
<td></td>
</tr>
<tr>
<td>• Non-useful/non-functional clothing (e.g. clear plastic swimsuit, Lady Gaga’s meat dress)</td>
<td></td>
</tr>
</tbody>
</table>

![Fabric designs](https://via.placeholder.com/150)

![Non-useful clothing example](https://via.placeholder.com/150)

![3D clothing designs](https://via.placeholder.com/150)
## US: Fashion designs protectable by copyright? - How about costume?

<table>
<thead>
<tr>
<th>Protected</th>
<th>Not protected</th>
</tr>
</thead>
<tbody>
<tr>
<td>• Halloween costume’s element (Conceptually separable)</td>
<td>• Prom dress’s element</td>
</tr>
<tr>
<td>![Halloween costume](By Werner Wälfling, via Wikimedia Commons)</td>
<td>![Prom dress](By Sean McGrath from Saint John, via Wikimedia Commons)</td>
</tr>
<tr>
<td>• Rabbit in hat and tigress (Non-useful/non-functionable)</td>
<td>• Uniform of casino workers</td>
</tr>
<tr>
<td>![Rabbit in hat and tigress](By Ian Murphy, via Flickr)</td>
<td>![Uniform of casino workers](By Ian Murphy, via Flickr)</td>
</tr>
</tbody>
</table>
US: “Fashion Bill” attempts

- Constant attempts to protect fashion designs by copyright: FAILED

- The 6th and the most recent attempt: Innovative Design Protection Act, 2012
  ⇒ Extension of copyright protection for 3 years for fashion designs if they;
  - are the result of a designer’s own creative endeavor; and
  - provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles
**US: Debates over “Fashion Bill”**

<table>
<thead>
<tr>
<th>Supporters</th>
<th>Criticisms</th>
</tr>
</thead>
<tbody>
<tr>
<td>• Fashion designs are a form of artistic expression which should be treated equally with other copyright protectable subjects (music, art, literature, etc.).</td>
<td>• Copying is promoting innovation and creation of new fashion designs (“Piracy Paradox”).</td>
</tr>
<tr>
<td>• Designers have alternative motivation to create designs, apart from financial motivation.</td>
<td>• The Bill increases independent fashion designers’ legal costs (e.g. consultation with lawyers to reduce likelihood of infringement claims).</td>
</tr>
<tr>
<td>• Designers are suffering from the loss caused by copycats.</td>
<td>• It indirectly increases the cost of apparel for the consumers.</td>
</tr>
<tr>
<td>• <strong>European countries</strong> protecting fashion designs by copyright are leaders of fashion industry.</td>
<td></td>
</tr>
</tbody>
</table>
EU: Fashion designs and IPRs

Two main sources of IP protection for fashion designs:

- Copyright
- Unregistered Community Design right (UCD)

Cumulative protection

In some countries (e.g. France, Belgium) fashion designs protected by copyright may be also protected by registered/unregistered design rights.
EU: Fashion designs and copyright

- EU Designs Protection Directive (98/71/EC)
  - Cumulative protection: Discretion of Member States
  - "Design": very wide definition
    “The appearance of the whole or a part of a product resulting from the features of the lines, contours, colors, shape, texture or its ornamentation.”

⇒ Fashion articles in general are included.

⇒ In countries where the cumulative protection is admitted, fashion articles can be protected both by design rights and copyright.
EU: Fashion designs and copyright
- Cumulative protection in France

Theory “unité de l’art”:

Works so called “pure arts” (paintings, music, literatures…) are assimilated so much to works so called “applied arts” (designs) that both types of arts should be applied the same legal regime.

The threshold for originality requirement is very low – i.e. simple slype pattern can be protected.

Prodeco SARL v. AS GmbH (OHIM, 2011)

EU registered design right N°1595737-0013 (left) was invalidated by EU Design Office because of the existence of earlier French copyright protected work (right).
EU: Fashion designs and copyright – French case law


YSL brought an action of copyright infringement after seeing RL dress in a French fashion magazine.

Yves Saint Laurent
- Price: 15000 $
- Silk
- No pockets
- Gold buttons
- Lapel narrower

Ralph Laurent
- Price: 1000 $
- Wool
- Pockets
- Black buttons
- Lapel wider

YSL won despite the differences between the garments based on the prior copyright.
**EU: Fashion design and Unregistered Community Design right**

- **EU Regulation on Community Designs (6/2002)**

Comparison between registered and unregistered design rights

<table>
<thead>
<tr>
<th></th>
<th>Registered Community Designs</th>
<th>Unregistered Community Designs</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Formality</strong></td>
<td>Application and registration</td>
<td>Automatic protection</td>
</tr>
<tr>
<td><strong>Cost</strong></td>
<td>Yes</td>
<td>No</td>
</tr>
<tr>
<td><strong>Scope</strong></td>
<td>Protected against the identical and similar designs</td>
<td>Protected only against the “dead copy”</td>
</tr>
<tr>
<td><strong>Border control</strong></td>
<td>Yes</td>
<td>No</td>
</tr>
<tr>
<td><strong>Duration</strong></td>
<td>25 years maximum from the date of application</td>
<td>3 years from the date of publication in the European Union</td>
</tr>
</tbody>
</table>
EU: Fashion design and Unregisterd Community Design right – European case law

A decision largely welcomed by fashion design right holders:
Karen Millen v. Dunnes Stores (CJEU, 19 June 2014)

Claiming the UCD rights on its garments, KM began the proceedings for injunctions and damages in the Irish High Court, which upheld that action. Dunnes brought an appeal before the Irish Supreme Court. The Supreme Court refers two questions to the CJEU.

Premise: In order to be protected, the design should be new and have “individual character”.

<table>
<thead>
<tr>
<th>KM’s articles</th>
<th>Dunnes’ articles</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1" alt="KM's Shirt" /></td>
<td><img src="image2" alt="Dunnes' Shirt" /></td>
</tr>
<tr>
<td><img src="image3" alt="KM's Shirt" /></td>
<td><img src="image4" alt="Dunnes' Shirt" /></td>
</tr>
<tr>
<td><img src="image5" alt="KM's Shirt" /></td>
<td><img src="image6" alt="Dunnes' Shirt" /></td>
</tr>
</tbody>
</table>
Question 1: In order for a design to be considered to have individual character, the overall impression which that design produces must be different from that of:

(a) any individual design which has previously been made available to the public?

or

(b) any combination of known design features from more than one such earlier design?

Answer (a)

It is sufficient for the right holder to compare the contested design only with a body of earlier designs, and it is not necessary to compare with an amalgam of various features of earlier designs.
EU: Fashion design and Unregistered Community Design right – European case law

Question 2: In order for an Unregistered Community Design to be valid, the right holder of that design is required to;

(a) prove that it has individual character?

or

(b) only indicate what constitutes the individual character of that design?

Answer: (b)

It cleared up that the right holder does not need to prove the individual character of his UCD in the infringement procedure.
Other countries – UK

• Closed categories of copyright protectable works.
• Category for fashion designs: ”works of artistic craftsmanship”
  • Difficulty to define “artistic”
  • Case law hesitating to judge if “craftsmanship” meaning handicraft or not.
• Maybe yes for one-off piece, but no for mass-products?
Other countries – UK

The threshold for similarity to qualify infringement seems not very low

John Kaldor UK v. Lee Ann (High Court in England, 2014)

Action for infringement based on both copyright and unregistered design right refused: motifs/patterns are not similar enough to qualify copying.

Cf. The European Design Office judged similar:
Other countries – Japan

“Work means a production in which thoughts or sentiments are creatively expressed and which falls within the literary, academic, artistic or musical domain.”

Case law explicitly excluding mass-products from copyright scope.

Fashion design in general not protected with possible exception of one-off piece.
Other countries – Japan

Protection by unfair competition if:
- It is the “dead copy” of the earlier garment, and;
- It could raise the confusion with the earlier garment among the consumers.

Issey Miyake v. Meitetsu Department Store (Tokyo District Court, 1999)

The Court ordered the infringers to pay damages.
Other countries – Israel

How about Israel?

Israel Copyright Act

CHAPTER 2: Conditions for Subsistence of Copyright

“Copyright shall not subsist in "designs" as defined in the Patents and Designs Ordinance unless the design is not used, nor intended for use in industrial manufacture”.

Similar to US?
Thank you!

COPYRIGHT LAW DIVISION

WWW.WIPO.INT/COPYRIGHT