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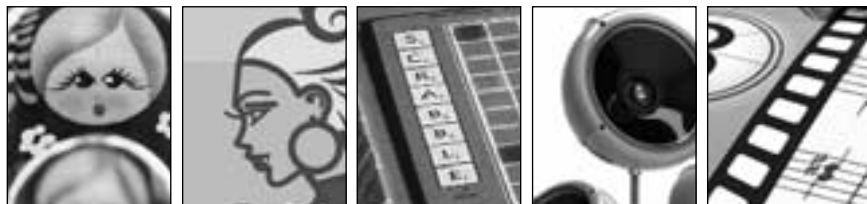
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IN SUMMARY

- In the US, fabric designs are considered to be a proper subject of copyright law for the pictorial and graphic elements of the fabric and as works of art, unlike clothing designs which are considered primarily as having a utility function and are not covered by copyright law
- To qualify for copyright protection, fabric designs must have some elements of originality, where this does not exist designers may choose other avenues for protection, such as trademark
- Over the past few years, there has been a surge of legal activity with designers proactively targeting some of the most prolific copycat merchants
- This article looks at how fabric design protection has been used by copyright holders in the past and how today's designers are pursuing "knock-off" infringers

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From fashion catwalks to the courts



 *Copyright protection for fabric designs*

Prints and patterns are everywhere this season, but their popularity could be more than just a passing trend given the strength of fabric design copyright to protect against copycats, say Lisa Pearson, Laura Miller and Lauren T Estrin of Kilpatrick Stockton

Bold patterns and prints are hot. Florals, geometric patterns, polka dots and retro designs have been gracing magazine pages and runways for the past year. *Women's Wear Daily* recently reported that "proper pricing and a heavy helping of prints [are] the keys to a successful season."¹ This fashion trend has moved from the runways to shopping malls, and now to the courts. Copyright infringement suits over fabric designs appear to be the next fashion industry trend.

Copyright protection for fashion design has long been elusive in the United States. But the recent spate of infringement litigation over fabric designs confirms that copyright protection for the pictorial and graphic elements of the fabric from which those fashions are made can provide a remedy against copycats.

Fabric designs are a proper subject of copyright

Fabric designs have long been recognized as a proper subject of copyright in the United States. In earlier cases applying the Copyright Act of 1909, courts held that fabric designs were protectible both as a "work of art" and as a "print."² These designs are also protectible under the current Copyright Act as a "pictorial" or "graphic" work.³ The U.S. Copyright Act grants the copyright owner the exclusive right to reproduce, distribute, adapt and display the copyrighted work publicly. For works created after January 1, 1978, a copyright exists for 70 years after the creator's death, or in the case of works made for hire (typically by an employee within the scope of employment), the shorter of 95 years from the date of publication or 120 years from creation.

“**Quirky prints and vivid colors were key runway trends on both sides of the Atlantic**
– **Women’s Wear Daily**

Delicate, museum-worthy prints are in full bloom
– **Cosmopolitan**

Buyers write immediate orders for print dresses
– **Women’s Wear Daily**

”

In contrast to fabric designs, clothing designs are generally considered “useful articles” that are not the proper subject matter for copyright protection.⁴ This is because U.S. copyright protection does not extend to “article[s] having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁵ As one court explained in a case involving alleged copyright infringement of uniform and costume designs, “designs, which graphically set forth the shape, style, cut and dimensions for converting fabric into a finished dress or other clothing garment, typically, do not qualify for copyright protection.”⁶

Repeated attempts have been made to bring clothing within the ambit of U.S. copyright coverage, including most recently the re-introduction of a bill in the U.S. Congress to extend limited copyright

protection to fashion designs.⁷ However, copyright experts think the most recent iteration of the bill is unlikely to be enacted into law for many of the same reasons its predecessors failed.⁸

Fashion designers may nevertheless claim copyright in original prints and pictorial designs “imprinted onto a fabric or that appear repeatedly throughout the dress fabric” as well as certain designs created by such creative endeavors as embroidery, appliqué, and weaving.⁹ As two-dimensional paintings or graphic works, prints and designs do not lose their copyrightability simply because they appear on a utilitarian article such as fabric, wallpaper, wrapping paper, or floor covering. For example, a U.S. court recently sent a strong warning to the “knock-off” community by awarding significant statutory damages and fees in a case where the defendant infringed the

plaintiffs’ wallpaper designs, which consisted of alternating light and dark elongated diamonds.¹⁰ U.S. copyright law therefore clearly protects the original artwork adorning a Pucci print dress or Hermes scarf, despite the fact that they appear on useful articles.

Creativity is required, but how much?

Despite the availability of protection, obtaining copyright protection for fabric designs is not without its roadblocks. Originality is not only the *sine qua non* for great art and design; it is also the “*sine qua non of copyright*.”¹¹ In the copyright context, the threshold of originality is low. Works must owe their origin to the creator and display “at least some minimal degree of creativity.”¹²

Some fabric designs are just too commonplace to be protectible. The Copyright Office has said that copyright protection afforded a fabric design will not extend to “familiar symbols or designs,” such as a fleur-de-lys, geometric shapes, stripes, a five-pointed star or a cross.¹³ For example, the Copyright Office refused to issue a registration for Coach’s “Signature CC Fabric Design”, on the ground that it is “essentially arrangements of the letter ‘C,’” and therefore not sufficiently creative to warrant copyright protection.¹⁴

The Copyright Office stated that “mere variations of letters and familiar symbols cannot be copyrighted.”¹⁵

Despite the unavailability of protection for commonplace design elements, the combination of these “unoriginal” elements may embody sufficient creativity to warrant at least “thin” copyright protection, protecting the particular arrangement of those elements. For example, in *Folio Impressions, Inc. v. Byer California*, the court found that although it required “little creative input,” the designer’s placement of roses in a straight row was sufficiently original to warrant “narrow” copyright protection.¹⁶ Similarly, in *Sunham Home Fashions, LLC v. Pem-America, Inc.*, the court found that the plaintiff held a valid copyright in a quilt design because the selection and arrangement of print and floral fabrics evidenced the requisite minimal spark of creativity.¹⁷ And in *Knitwaves, Inc. v. Lollytogs Ltd.*, the court found that by selecting and arranging leaves and squirrels as dominant images, with a “fall” color palette and shadowed lines as a background, the designer created an original, copyrightable pattern.¹⁸

“Designers interested in protecting their original fabric designs would be well-advised to secure copyright registrations for individual patterns, or for a fabric collection, as appropriate. Although not required for protection, acquiring a copyright registration from the U.S. Copyright Office is a relatively straightforward process”

Even if the fabric design in question transcends familiar symbols, questions may arise as to its originality where, as is often the case, the designer drew inspiration from others in the field or materials in the public domain. For example, in a suit against an alleged infringer, North Coast Industries first had to establish that its design, evidently inspired by painter Piet Mondrian as reinterpreted by designer Yves St. Laurent, was sufficiently original to warrant copyright protection.¹⁹ There must be creative differences between a work and its inspiration to achieve the requisite level of originality required for protection.

Fabric designers also risk infringing the copyrights of others when they adapt existing works. There is nothing unlawful in adapting a work that is already in the public domain, but the lines are not always clear-cut. For example, in *Tufenkian Import/Export Venture v. Einstein Moomjy*, two carpet companies clashed in court over an historical oriental rug pattern.²⁰ While both rugs drew on sources in the public domain and were essentially simplifications of these designs, the defendant’s designer, in the course of designing his rug, viewed the plaintiff’s rug. Although the defendant’s designer made changes to the design, the court found that the defendant’s rug was substantially similar to the protectible original expression contained in the plaintiff’s design and did not merely incorporate elements from the public domain.

The court considered the “total-concept-and-feel” of the designs and concluded that the “number of motifs present (or absent) in the Bromley field which mirror those the Heriz selected (or deleted) in any original way from the [public domain source] is overwhelming.”²¹

Although looking to “the common well spring that is the public domain” may be standard practice,²² fabric designers must take care to ensure that their sources of inspiration are in fact in the public domain, and, if they wish to obtain copyright in their own designs, to add sufficient original new matter to qualify for protection.

Who owns the copyright?

Only copyright owners and exclusive rights holders have standing to sue for infringement.²³ The “author” and initial copyright owner of a copyrightable fabric design is its individual creator or, in the case of a design created by an employee in the course of his or her employment, the employer. Accordingly, fashion designers who hire independent contractors to create fabric designs or buy finished fabric from outside vendors may wish to consider obtaining an exclusive license or copyright assignment from the copyright owner in order to take advantage of this pocket of copyright protection. (Only rarely will fabric designs created by independent contractors qualify as works made for hire; if they do, a work for hire agreement with a back-up assignment should be secured, ideally before creation of the work.)

When has the copying become too much?

To establish copyright infringement, a plaintiff must prove, first, ownership of a valid copyright, and second, copying of the plaintiff’s protectible expression. Copying is proven by showing not only that the alleged infringer had access to a copyrighted work, but also that there are substantial similarities between the two works.

Although the precise application of the substantially similarity test varies, courts have used the “ordinary observer test” where the plaintiff’s design consists solely of copyrightable elements and a “more discerning ordinary observer test” where the presence of unprotectible elements in the plaintiff’s design requires the court “to eliminate the unprotectible elements from its consideration and to ask whether the protectible elements, standing alone, are substantially similar.”²⁴

Regardless of the label, the factfinder ultimately engages in a visual comparison of the competing works as shown by the court’s analysis of floral fabric designs in *Lauratex Textile Corp. v. Allton Knitting Mills*.²⁵

“[W]e find that [the designs’] overall effect is identical, and that an ordinary observer of garments made out of fabric printed with those designs who was not searching for their differences would conclude that they are the same design. Both designs are floral prints on a white background bordered by a narrower strip containing another design. Both use precisely the same color combinations in the same balance of colors. In both, the flowers are the same size and are clustered in the same manner. There are more flowers in deeper colors near the border and in both the flowers “trickle” out into a lower concentration and in lighter colors as they move away from the border...”²⁶

Registering the designs

Designers interested in protecting their original fabric designs would be well-advised to secure copyright registrations for individual patterns, or for a fabric collection, as appropriate. Although not required for protection, acquiring a copyright registration from the U.S. Copyright Office is a relatively straightforward process, which involves filing a relatively short application, submitting a copy of the work with the Copyright Office, and paying a nominal fee.²⁷ Registration is necessary to maintain an infringement suit and a copyright owner can obtain significant additional legal rights and remedies by prompt registration.²⁸

Can trademark protection help?

Given the unavailability of copyright protection for many fashion and fabric designs, well-known designers have sought trademark protection for their source-identifying patterns. For example, Coach owns trademark registrations for the same interlocking “C” pattern that was found by the Copyright Office to lack sufficient originality for copyright protection. Burberry has obtained a trademark registration for its signature “check,” which covers, *inter alia*, suitcases, handbags, and clothing.

Similarly, Louis Vuitton holds several trademark registrations for its “Monogram” and related patterns, which adorn its handbags, luggage, and clothing.

Trademark and unfair competition law can be a powerful weapon to enforce rights in source identifying designs, but it may well be harder to win a trademark case than a copyright case. To prevail in a trademark infringement suit, for example, the trademark owner must prove that the public is likely to be confused as to the source of the goods, an element that is absent in the substantial similarity test for copyright infringement. Moreover, trademark protection will only be available for those designs used as a source identifier as opposed to mere ornamentation.

Copyright infringement suits – as popular as the prints themselves

Legendary fashion designer Coco Chanel once said that “being copied is the ransom of success.” Coco Chanel, however, did not create her iconic designs in a world of lightning fast communication, technology and “fast fashion” retailers. Today, the copycats can even beat the originals to market at a significantly lower price point.

Litigation over fabric designs is nothing new. For example, some 50 years ago, in the leading case of *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, which involved fabric designs for women’s dresses, Judge Learned Hand held that the plaintiff’s montage of individual squares based on Turkish designs was sufficiently original for copyright protection and was infringed by the defendant, who slightly altered the plaintiff’s design in creating its copy.²⁹

In the past two years, though, U.S. courts have seen an influx of cases by fashion designers alleging copyright infringement of fabric designs. The current wave of litigation is likely driven by the popularity of prints and patterns in designer’s collections and the designer’s frustration with the lack of copyright protection for the garments themselves. Among the most notorious defendants is Forever 21, a “fast-fashion” merchandiser with store locations primarily in shopping malls. Forever 21’s business model of copying high-end designers has made it the target of more than 20 lawsuits by well-known designers in the past two years.³⁰

Diane von Furstenberg was one of the first designers to take a proactive approach against companies knocking off her fabric

designs. In March 2007, she sued Forever 21 for copyright infringement.

The two dresses were virtually indistinguishable, but due to the unavailability of protection for the garment, von Furstenberg relied on two copyright registrations covering the fabric designs.³¹

Recently, von Furstenberg sued Target, the well-known discount department store chain, for copying her “Spotted Frog” print.³² Again, Target allegedly infringed the copyright covering the fabric design, not the design of the dress itself.

Designer Anna Sui has also taken aim at Forever 21. In April 2007, Sui filed her own complaint against Forever 21, accusing Forever 21 of “blatant and intentional” copying of the Sui collection.³³ In her complaint, Sui claimed that the alleged Forever 21 knock-offs beat the Sui collection to market.

To date, none of the Forever 21 cases has reached a final judgment. Several have been settled.

Conclusion

Pending legislation to amend the U.S. Copyright Act to cover fashion design has evidently opened the industry’s eyes to available pockets of legal protection. Copyright protection for fabric design is among the most promising ways to protect designs in this industry. As long as prints remain in vogue, fashion designers may finally have some recourse against the copiers. ☛

Notes

1. Beth Wilson, *Points of Emphasis*, Women’s Wear Daily, Feb. 12, 2008, at 12.
2. *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142 (S.D.N.Y. 1959) (design printed on a dress is protectible both as a work of art under § 5(g) and as a print under § 5(k) of the Copyright Act of 1909).
3. See 17 U.S.C. § 102(5).
4. See e.g., *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995); *Aldridge v. The Gap, Inc.*, 866 F. Supp. 312, 315 (N.D. Tex. 1994).
5. 17 U.S.C. § 101.
6. *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005).
7. “The Design Piracy Prohibition Act,” H.R. 2033 and S. 1957, 110th Cong. (2007).
8. See, generally, Lisa Pearson, Lauren Estrin, and Ling Zhong, *In Vogue: IP Protection for Fashion Design*, *Copyright World*, Apr. 2007, at 21.
9. *Galiano*, 416 F.3d at 419; see, e.g., *Knitwaves*, 71 F.3d at 1002 (holding that fabric design, such as artwork on plaintiff’s sweaters was subject to protection); *Spectravest, Inc. v. Mervyn’s Inc.*, 673 F. Supp. 1486, 1491 (N.D. Cal. 1987) (patterns of flattened teddy bears with their arms outstretched, silkscreened on sweatshirts, was protectible).
10. *The Design Tex Group Inc. v. U.S. Vinyl Mfg Corp.*, 2005 WL 1020436 (S.D.N.Y. 2005).
11. *Feist Publ’ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).
12. See *id.* (requiring “a minimal degree of creativity”).
13. “Copyright Registration for Works of the Visual Arts,” U.S. Copyright Office Circular 40, revised July 2006, available at <http://www.copyright.gov/circs/circ40.html>.
14. *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495 (S.D.N.Y. 2005).
15. *Id.* at 498.
16. 937 F.2d 759 (2d Cir. 1991).
17. 2002 WL 31834477 (S.D.N.Y. 2002) (“[A]lthough the idea of a plaid or floral pattern may not of its own be original, the patterns’ sizes, shapes, arrangements and colors taken together are original and copyrightable.”)
18. 71 F.3d 996, 1002 (2d Cir. 1995).
19. *North Coast Ind. v. Jason Maxwell, Inc.*, 972 F.2d 1031 (9th Cir. 1992).
20. 338 F.3d 127 (2d Cir. 2003).
21. *Id.* at 136.
22. *Id.* at 132.
23. 17 U.S.C. 501(b).
24. *Knitwaves*, 71 F.3d at 1003.
25. 517 F. Supp. 900 (D.C.N.Y. 1981).
26. *Id.* at 902-03.
27. For more information and directions on filing a copyright application, see www.loc.gov/copyright.
28. 17 U.S.C. §§ 410-12. If made within five years of publication, registration will be prima facie evidence in court of the validity of the copyright and of the facts stated in the certificate. If registration is made within three months after publication of the work or before an infringement, statutory damages and attorneys’ fees will be available to the copyright owner.
29. 274 F.2d 487 (2d Cir. 1960).
30. See Liza Casabona, *Retailer Forever 21 Facing A Slew of Design Lawsuits*, *Women’s Wear Daily* at 12 (July 23, 2007);
31. *Diane von Furstenberg Studio, LP v. Forever 21, Inc.*, 07-CV-2413 (S.D.N.Y., filed Mar. 23, 2007).
32. *Diane von Furstenberg Studio, LP v. Target Brands, Inc.*, 08-CV-00866 (S.D.N.Y., filed January 24, 2008).
33. *Anna Sui Corp. v. Forever 21, Inc.*, 07-CV-3235 (S.D.N.Y., filed Apr. 23, 2007).