

**Almost Every Useful Art:  
Garment and textile designs and the failure of copyright  
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The Founding Fathers authorized Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>1</sup> For all its lofty goals, however, this section of the Constitution fails to protect a “useful Art” that surrounds us every day. Garment design is an undeniably artistic field, yet these designs are largely unprotected, either because of rulings by the Registrar of Copyrights or through court interpretations of what characteristics are required for protection under the Copyright Act. Although garments may be beautiful, may be carefully constructed, and may be created with as much consideration to their aesthetics as any painting, most courts have failed to recognize that there may be protectable categories of garments; instead all garments have been lumped together, deemed “useful” and therefore held to be unprotectable.<sup>2</sup> (For purposes of this paper, the words “design” and “pattern” refer to the instructions, along with any diagrams, for constructing a garment or accessory. They do not refer to images printed on fabric, which have been held to be protectable.<sup>3</sup>)

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<sup>1</sup> U.S. Const. Art. I, § 8.

<sup>2</sup> 17 U.S.C. § 113 (b) (“This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, ..., in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.”); Copyright Office Circular 40 (“A “useful article” is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. Examples are clothing, furniture, machinery, dinnerware, and lighting fixtures. An article that is normally part of a useful article may itself be a useful article, for example, an ornamental wheel cover on a vehicle... Copyright in a work that portrays a useful article extends only to the artistic expression of the author of the pictorial, graphic, or sculptural work. It does not extend to the design of the article that is portrayed. For example, a drawing or photograph of an automobile or a dress design may be copyrighted, but that does not give the artist or photographer the exclusive right to make automobiles or dresses of the same design.”) <http://www.copyright.gov/circs/circ40.pdf> (accessed Apr. 10, 2010)

<sup>3</sup> See generally *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir 1960); 18 Am. Jur. 2d Copyright and Literary Property § 30; *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996 (2d Cir. 1995); 37

In response to the lack of copyright protection for their works, garment designers have been forced to rely on other, less appropriate intellectual property protection. They have increasingly turned to design patents, which are time-consuming and costly to obtain, and require a substantial novelty in the design of the article.<sup>4</sup> They have also tried to use trademark protection, by printing a logo on the fabric from which the garment or accessory is made, or adding a specific color to an area of the garment to make it distinctive.<sup>5</sup> Both of these protections are inadequate and inappropriate workarounds for a problem that could easily be solved administratively or through legislation. In fact, the Fourth Circuit applies a copyright test that could be extended to protect clothing, and legislation is pending that might resolve the issue – but most garment copyright issues are litigated in the Second Circuit, which has explicitly denied protections to garments, and previous efforts to legislate an answer have repeatedly failed. The better answer is that copyright should protect garment designs; but the question remains, how?

This paper analyzes the failure of statutory and common law to protect garment designs, and suggests that the problem could be remedied by following either the Fourth Circuit’s test for analyzing inseparably functional and aesthetic elements, or by passing appropriate legislation. Section I deals with the failure of copyright to protect garment design; Section II establishes the steps by which a garment is produced in order to give the reader a better understanding of why separating form and function is especially problematic in the field of garment design; Section III discusses the underlying policy rationale for the existing regime and for change; and Section IV

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CFR § 202.10(b) (“The registrability of a work of art is not affected by. . . the fact that it appears on a textile material or textile product.”)

<sup>4</sup> 35 U.S.C. § 171.

<sup>5</sup> See e.g. Trademark No. 3361597 – “a lacquered red sole on footwear” registered to Christian Louboutin. (reg. 1/1/2008).

suggests possible judicial and legislative solutions which would provide copyright protection to garment designs while still allowing future designers to build on the prior art without infringing rights, and bring to the public the greatest possible variety of designs.

## **I. What is Unprotected?**

Completed articles of clothing lack copyright protection under the existing regime. In *Fashion Originators Guild of America v. Federal Trade Commission*,<sup>6</sup> Judge Learned Hand admonished that “until the Copyright Office can be induced to register [clothing] designs as copyrightable under the existing statute, they... fall into the public demesne without reserve.” Although *Fashion Originators Guild* was decided under the Copyright Act of 1919, neither the Copyright Office nor Congress has corrected the situation to date.<sup>7</sup>

Despite the Constitution’s admonition to “protect the ...useful Arts,” copyright law has increasingly been diverted to the protection of nonutilitarian articles only.<sup>8</sup> Courts, with the noted exception of the Fourth Circuit, have repeatedly refused to uphold protection for useful articles, no matter how beautiful they might be or how much thought and artistic purpose went into their creation.<sup>9</sup> Writings or drawings, however, are protected so long as they “display some minimal level of creativity” and the “creative spark” is not “utterly lacking.”<sup>10</sup> The ultimate result of this policy is that the paper pattern from which the garment is made is subject to copyright, but the garment itself is not.<sup>11</sup> It is difficult to say that the protection afforded to

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<sup>6</sup> 114 F.2d 80, 83, (2d Cir. 1940).

<sup>7</sup> *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir.1989); *Fashion Originators Guild of America, Inc. v. FTC*, 114 F.2d 80, 84 (2d Cir.1940), aff'd, 312 U.S. 457 (1941); *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F.Supp. 187, 189 (S.D.N.Y.1934).

<sup>8</sup> U.S. Const. Art. I § 8.

<sup>9</sup> *Barnhart v. Economy Cover Corporation*, 773 F.2d 411 (2d Cir. 1985) (sculpted shape of mannequin torsos more utilitarian than aesthetic).

<sup>10</sup> *Feist Publications, Inc. v. Rural Telephone Service*, 499 U.S. 340 (1991).

<sup>11</sup> *Jack Adelman, Inc. v Sonners & Gordon, Inc.* (1934, DC NY) 112 F Supp 187, (copyright on a pattern gave the copyright holder the exclusive right to make copies or reprints of the drawing only, but not to restrict

patterns is meaningful when the article of clothing they describe may be reverse-engineered with relative ease and is not protected.

In 1994 the Northern District of Texas noted that “As numerous cases have recognized, although they fall within the subject matter of copyright regulation, clothes, as useful articles, are not copyrightable. Although numerous efforts have been made to induce Congress to afford protection to clothing designs, such protection has not been forthcoming and new designs are open to all.”<sup>12</sup> Furthermore, “a State may not, when the article is ...uncopyrighted, prohibit the copying of the article itself or award damages for such copying.”<sup>13</sup> This is not to say that ornamentation of useful articles is not subject to copyright protection, but it must be actually separable from the useful aspects of the article.<sup>14</sup> The separability requirement poses a significant problem for garment designers. The problem, in a nutshell, is that the “useful” aspects of a garment design are generally inseparable from the “ornamental.” That is, the structure of the fabric itself is as much a part of the operation as the aesthetic of the completed garment. This means that as long as inseparability is a bar to copyright, it will be impossible to copyright garments.

Under this analysis, garment designers are left in limbo, with their patterns protected but Congress, courts, and the Copyright Office having declared open season on finished articles of clothing. The freedom to reverse-engineer garments from reference to the finished article undermines copyright in the pattern until it is for most practical purposes meaningless.

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copying of the dress itself; that is, the drawing, not the dress, was the copyrightable work); *Galiano v. Harrah's Operating Co., Inc.* Not Reported in F.Supp.2d, 2004 WL 1057552, E.D.La.,2004 (“[t]wo dimensional artwork for costumes is copyrightable. [However]...the clothing/uniform designs depicted by that artwork in the Collection is not copyrightable.”).

<sup>12</sup> *Aldridge v The Gap*, 866 F Supp 312, 315 (N.D.Tex 1994), citing *Fashion Originators Guild*, 114 F.2d at 80; *Nat Lewis Purses, Inc. v. Carole Bags, Inc.*, 83 F.2d 475, 476 (2nd Cir.1936); *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 281 (2nd Cir.1929), *cert. denied*, 281 U.S. 728 (1930).

<sup>13</sup> *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232 (1964).

<sup>14</sup> *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1146-47 (2d Cir. 1987).

## II. The Process of Garment Design

In order to understand the difficulties in establishing protection for garment and textile design, it is necessary to first understand the process of creating garments. There are a number of ways to do this, the most common being to start with a natural or artificial fiber, make a thread from the fiber, and then either knit or weave the thread into cloth. Garments can also be made of natural or artificial latex or similar materials, which can be molded or extruded in the shape of the finished garment. Each of these techniques produces a distinctive shape and texture, and designers choose among them in order to generate a garment which has the qualities necessary to achieve their desired aesthetic.

### A. Inseparable form and function: woven textiles

Woven fabrics have two aspects: “on the grain” and “bias.”<sup>15</sup> On the grain means that the fabric is arranged in such a way that any strain on the fabric is parallel to either the warp or weft threads in the weave.<sup>16</sup> On bias means that strain is placed on the fabric at an angle (usually 45 degrees) to the warp and weft threads.<sup>17</sup> Woven fabric is very stable on the grain, but tends to stretch on bias.<sup>18</sup> Garment designers have used this to good effect for hundreds of years.<sup>19</sup>

For an example of bias used to good effect, see George Hurrell’s iconic “Old Hollywood” photo of Jean Harlow, circa 1946.<sup>20</sup> Harlow is wearing a clinging white dress with a carefully draped neckline. This is undoubtedly an ornamental touch. Had the dress been cut on the straight grain, it would become essentially a white sack, losing its ability to sway and shift when the wearer moves. The motion of a dress like this is as intrinsic to its aesthetic as the trumpet-like

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<sup>15</sup> Marcy Tilton, *Bias 101*, <http://www.threadsmagazine.com/item/3745/bias-101> (Posted Nov. 6, 2008).

<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> Emrys Eustace, *Sherts, Trewes, & Hose III: Chosen Hosen*, <http://www.greydragon.org/library/underwear3.html> (accessed Apr. 19, 2010).

<sup>20</sup> <http://www.hurrellphotography.com/Hurrell/jeanharlow2.html> (accessed Apr. 17, 2010).

shape achieved by cutting the fabric so that some areas achieve more stretch than others. Under the Second Circuit test from *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co*, however, this is a structural, not an ornamental, decision; or, if it is ornamental, it is inseparable from the structural element and therefore the dress, no matter how beautiful, is not protectable.<sup>21</sup>

#### B. Inseparable form and function: knitting

The problem of inseparable form and function is magnified a thousandfold in patterns which involve making not merely the garment itself, but the fabric from which the garment is made. This is done by starting with a thread and generating a shaped garment by knotting or looping the thread on itself.<sup>22</sup> Because knitting is currently the most popular of these techniques, for the sake of convenience this paper will refer in general to “knitting patterns.” Although only knitting is treated in detail here, the logic is extensible to all other comparable garment creation techniques.<sup>23</sup>

Knitting is the art of “intertwining yarn or thread in a series of connected loops either by hand, with knitting needles, or on a machine.”<sup>24</sup> When a designer creates a knitting pattern, she knows that each stitch (pattern of connected loops) has two qualities: aesthetic and behavioral.<sup>25</sup> Some knit stitches, such as ribbing or moss stitch, are extremely stretchy and will cause the

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<sup>21</sup>834 F.2d at 1146-47.

<sup>22</sup> See generally: knitting. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/knitting> (accessed: Apr. 16, 2010). Textile arts in which fabric is made as the artist shapes the garment also include crochet, naalbinding, sprang, felting, netting, tatting, macramé, and the production of loom-shaped garments. See generally: Donna Kooler, *Donna Kooler's Encyclopedia of Crochet* (Leisure Arts, Inc. 2002); Catherine Amoroso Leslie, *Needlework Through History*, (Greenwood Press 2007); Peter Collingwood, *The Techniques of Sprang*, (Faber & Faber/Watson-Guptill, 1974); Patricia Spark, *Scandinavian-Style Feltmaking: A Three Dimensional Approach to Hats, Boots, Mittens, and Other Beautiful Objects*, (Shuttle Craft Books 1992); Pam Palmer, *Tatting*, (Shire Publications Ltd, 2000).

<sup>23</sup> *Id.*

<sup>24</sup> knitting. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/knitting> (accessed: Apr. 16, 2010).

<sup>25</sup> Barbara G. Walker, *Knitting From the Top*, 20-22 (Charles Scribner's Sons 1972)

finished garment to cling and conform where used.<sup>26</sup> Others are extremely stable and resistant to stretch.<sup>27</sup> Each area of a designed garment, therefore, is worked in a stitch that (a) behaves in an appropriate manner for that area (i.e. shoulders require stable stitches to prevent distortion, but stretchy stitches are preferred at the neckline to enable it to pass over the head and return to its original shape); and (b) is aesthetically pleasing to the designer. The end result of this design process is that the aesthetic elements of the garment are not capable of existing independently from the garment itself. Without separability, these elements may not be protectable.<sup>28</sup> Knit designs which have been found to be protectable are almost invariably intarsia images – images made by changing the color of the yarn to produce a picture on the fabric, not by altering the stitch pattern (the direction and number of loops pulled from a knitting needle).<sup>29</sup> These are more akin to images printed on fabric than structural elements with aesthetic qualities.

#### C. Writings of authors: the pattern for reproducing a designed garment

As discussed above, the paper pattern describing how to reproduce a garment is itself copyrightable, although the garment is not. Why is this important? The pattern generally bears no resemblance whatsoever to the finished product. Patterns for cutting clothing are generally a series of shapes printed on huge sheets of fragile transparent paper, with written directions for how to use those shapes with woven fabric to construct the finished garment. Patterns for knitting or crochet are even more arcane, and often contain such linguistic flights of fancy as “K

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<sup>26</sup> Elizabeth Zimmerman, *Knitting Without Tears: Basic Techniques and Easy-to-Follow Directions for Garments to Fit All Sizes*, 11-14 (Charles Scribner’s Sons 1971).

<sup>27</sup> *Id.*

<sup>28</sup> *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1146-47 (2d Cir. 1987) (“RIBBON” bike rack not protectable because “no artistic element... can be identified as separate and ‘capable of existing independently, of, the utilitarian aspects of the article’”) See also: *Galiano v. Harrah's Operating Co., Inc.* Not Reported in F.Supp.2d, 2004 WL 1057552, E.D.La.,2004. (areas of stitching may constitute “images applied to fabric” and be copyrightable, but ornament that “advance[s] the utilitarian purpose of the garment” is not.).

<sup>29</sup> Debby Robinson, *The Encyclopedia of Knitting Techniques*, (Mermaid Books 1986); *In Design v. Lauren Knitwear Corp.*, 782 F.Supp. 824 (S.D.N.Y.,1991); *In Design v. Lynch Knitting Mills, Inc.*, 689 F.Supp. 176 (S.D.N.Y.,1988).

1, slip 1, K 1, pass slipped st. over K st., K to within 3 sts. of end, K 2 together, K 1.”<sup>30</sup> This obviously bears little resemblance to the portion of the completed garment it describes: the gusset of a man’s sock.<sup>31</sup> Because of the scant resemblance between the pattern and the garment, connecting the two for purposes of demonstrating that infringing copyright on one infringes copyright on the other seems to have been a troubling intellectual exercise for the judiciary.

### III. Balancing the Needs of the Public and the Artist

Copyright is an efficient and not overbroad protection for garment designs. Why, then, is it not afforded to these designs, especially when copyright does inhere in the patterns from which the designs are produced? Congress has been historically inactive in this matter, despite the continuous pleas from courts and critics to do something – anything – on the subject. Without legislative or judicial protection, garment designers are left without recourse if their works are copied. It seems disingenuous to claim that society is best served by affording an entire branch of art no protection, when art of significantly less value to society is protected.<sup>32</sup> The most vulnerable artists, in fact, are the least likely to have a political or litigious voice.

#### A. Why should garment and textile designs be protected?

Textile and garment design are creative arts. Although ultimately each article of clothing is “utilitarian” inasmuch as it protects the wearer to some degree from the elements and covers the body, it is apparent on even a cursory review that most people see clothing as an aesthetic, not a functional, choice.<sup>33</sup> There is a multi-billion-dollar industry based on this principle, and it

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<sup>30</sup> Pattern ca. 1942, *Man’s Sock*, distributed by American Red Cross. Public domain image available at [www.antiquepatternlibrary.org](http://www.antiquepatternlibrary.org) (accessed Apr. 17, 2010)

<sup>31</sup> *Id.*

<sup>32</sup> *Contra*, Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. Rev. 1341 (1987).

<sup>33</sup> The Fug Girls, *Go Fug Yourself*, <http://gofugyourself.celebuzz.com/> (accessed Apr. 19, 2010).

is that industry which has been forced to seek protection for its works in the labyrinth of alternative intellectual property protections.

A strong argument for the anti-copyright faction has historically been the length of the copyright period. While it is true that a span of “the artist’s life plus however long it has been since Walt Disney died”<sup>34</sup> seems long, this should not be the only point of comparison between copyright and the protections in use today. Trademark protections are not time-limited at all, so long as the manufacturer continues to use the mark in commerce or even intends to do so at some point in the future.<sup>35</sup> Patent protection is absolute and strict, in contrast to the traditional copyright defense of independent creation, and while 20 years is shorter than 70 (or 95, or 120),<sup>36</sup> it is still a significant span of time in an industry as fast-moving as the garment design industry. Both trademark and patent protections take significant spans of time to create and maintain, while copyright inheres upon creation of the object.

Under the current state of law and jurisprudence, probably the least protectable patterns are those for knitwear. As discussed above, knit stitches have architectural as well as aesthetic value, which are inseparable aspects. The general trend for small knit designers is to post their pattern for sale on a craft website, such as ravelry.com or etsy.com. This necessarily involves posting a photograph of the finished product. From this photograph, most moderately talented

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<sup>34</sup> Ronald W. Staudt, classroom lecture, *Limitations on Copyright* (Chicago-Kent College of Law, Chicago, Ill. Spring 2009)

<sup>35</sup> 15 U.S.C. § 1058 (2009).

<sup>36</sup> 17 U.S.C. § 302 (“Duration of copyright: Works created on or after January 1, 1978

(a) In General. — Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and 70 years after the author’s death.

(b) Joint Works. — In the case of a joint work prepared by two or more authors who did not work for hire, the copyright endures for a term consisting of the life of the last surviving author and 70 years after such last surviving author’s death.

(c) Anonymous Works, Pseudonymous Works, and Works Made for Hire. — In the case of an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 95 years from the year of its first publication, or a term of 120 years from the year of its creation, whichever expires first.)

knitters can reproduce the article. Obviously, this defeats the purpose of offering the pattern for sale, if the finished garment is not protectable and can be reverse-engineered. Yet these small designers, while most vulnerable, are least likely to litigate.

B. What valid policy reasons underlie the decision to deny protection?

The underlying policy decision behind denying copyright to garment design is that affording copyright protection would limit the public's access to garments.<sup>37</sup> Theoretically, if designers were allowed to copyright a shirt, sweater or scarf, this copyright would cut off future designers from making shirts, sweaters or scarves.<sup>38</sup> What proponents of this school of thought fail to note, however, is that ideas would not somehow gain copyright protection under a regime which permitted copyright in garments. The decision in *Bleistein v. Donaldson Lithographing Company* did not suddenly end the public's ability to view or design circus posters, pictures of circus animals or dancers.<sup>39</sup> Similarly, the ability to copyright a shirt with a particular arrangement of pintucks or a sweater with a particular arrangement of ribs and cables would not mean the end of pintucked shirts or ribbed and cabled sweaters. It would merely mean that others could not reproduce that exact arrangement of design elements.<sup>40</sup>

**IV. Possible ways to extend protection to garment and textile design**

A. The status quo: use another form of intellectual property protection

Copyright protection for garment designs is, as previously established, absent or uncertain. Therefore, designers have turned to a variety of substitute protections in order to

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<sup>37</sup> *Fashion Originators Guild of America v. Federal Trade Commission*, 114 F.2d 80, 83, (2d Cir. 1940).

<sup>38</sup> *Id.*

<sup>39</sup> 188 U.S. 239 (1903).

<sup>40</sup> *Cf. Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1507, C.A.9 (Cal.) 1987 (“even similarity in expression is noninfringing when the nature of the creation makes similarity necessary.”), citing *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 320 (9th Cir.1987); *Frybarger*, 812 F.2d at 530.

preserve their rights in the fruits of their creative labor.<sup>41</sup> The three most commonly used substitute protections are trademarks, design patents, and trade secrets. All of these substitute protections have inherent limitations which make them inferior to copyright.

### 1. Trademarks

Trademarks are an inferior protection for garment design because they protect the association between the product and its source, not the product itself.<sup>42</sup> However, companies such as Coach, Inc. have increasingly turned to trademarks for protection. Coach's strategy provides a prototypical window into this process.

First, Coach attempted to copyright its distinctive "C" design fabric, which is patterned with heavily serified letters rotated to form a pleasing geometric pattern. The application was rejected, in part because "letters" are not copyrightable.<sup>43</sup> This seems a specious piece of reasoning by the Registrar, when one considers the following: 1) images printed on fabric are copyrightable; 2) the "C" logo is not used to communicate, neither as a letter nor a typeface, but is reduced to a simple geometric element; and 3) had the image been described as a rotated "horseshoe" rather than a "C" the entire basis for denying copyright would collapse.<sup>44</sup> Regardless of the merits of the decision, however, the fact remains that Coach could not copyright its printed fabric.

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<sup>41</sup> Not Just Patents LLC, *Examples of Ways to Promote Recognition and Protect Fashion Business Using Intellectual Property*, <http://small-business-ip.com/fashionip.html> (accessed Apr. 16, 2010).

<sup>42</sup> 15 U.S.C. § 1052.

<sup>43</sup> *Eltra Corp. v. Ringer*, 579 F.2d 294 (4<sup>th</sup> Cir. 1978). N.B. - While this paper will not treat the denial of copyright to typefaces, that policy is informed by some of the same reasons as the denial to garments, and should also be reconsidered.

<sup>44</sup> 37 CFR § 202.10(b) ("The registrability of a work of art is not affected by. . . the fact that it appears on a textile material or textile product.")

After denial of copyright protection, Coach turned to trademark protection, arguing that the distinctive fabric designated a source or origin of handbags.<sup>45</sup> Coach has also extended the argument to claim that the arrangement of leatherwork, buckles and hang tags is “trade dress” sufficient to designate the origin of handbags.<sup>46</sup> While the reader will recognize this argument as tenuous at best, Coach has been tremendously successful in using it.<sup>47</sup> This may be because courts recognize that some protection ought to be available, and that under current law and jurisprudence, copyright does not provide that protection.

Trademark protection is available to large companies like Coach; it is unlikely to protect small designers or first-time designers, whose works cannot be said to have gained “secondary meaning” in the minds of consumers. While designer Cookie A’s twisted stitches and evocative gothic arch-like cabling on socks may be as distinctive to a small subset of the population as the distinctive red soles of Christian Louboutin’s high-heeled shoes, few knitwear designers have garnered this level of recognition.<sup>48</sup> Newcomers to the design arena are almost completely without protection from trademark.

## 2. *Design Patents*

Design patents, unlike trademarks, do protect the finished garment or accessory. However, they are significantly more difficult to obtain than a copyright would be, and the patented article must exhibit significant novelty. Under copyright, minimal deviations from prior art constitute copyrightable innovation.<sup>49</sup> The Patent Office, in contrast, takes its novelty

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<sup>45</sup> *Coach Inc et al v. Kmart Corp et al*, U.S. District Court, Southern District of New York, No. 10-01731

<sup>46</sup> *Coach, Inc. v. We Care Trading Co., Inc.*; 67 Fed.Appx. 626, C.A.2 (N.Y.),2002; *Coach Leatherware Co., Inc. v. AnnTaylor, Inc.*, 933 F.2d 162, C.A.2 (N.Y.),1991.

<sup>47</sup> AP, *Coach Sues Target Over Handbag Designs*, <http://www.cbsnews.com/stories/2009/10/06/business/main5367187.shtml> (posted Oct. 6, 2009)

<sup>48</sup> Cookie A., *Sock Innovation: Knitting Techniques & Patterns for One-of-a-Kind Socks* (Interweave Press 2009); <http://www.typepad.com/services/trackback/6a00d83451595d69e200e5502ff3738833>

<sup>49</sup> *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951).

requirements quite seriously.<sup>50</sup> Minor innovations have historically been unsuccessful in obtaining patent protection.

This is hardly surprising; patents are generally less flexible than copyright, and provide a more absolute protection, albeit for a shorter period of time. The fundamental flaws of design patents are apparent on even a superficial level: they are expensive and time-consuming to obtain, and often an application for such patents requires the services of a professional to prepare.<sup>51</sup> Should a design be successful in obtaining a patent, furthermore, the patent is more likely than not to be found invalid at the litigation stage.<sup>52</sup> This renders it useless for its essential purpose.<sup>53</sup> Although some 3,000-5,000 design patents issue annually, their utility in this context is at best limited, especially considering the short turnaround times for garment designs.<sup>54</sup>

Like trademarks, design patents fail to protect small-scale designers, who are unlikely to have the time and resources necessary to obtain a patent, and whose cost-benefit analysis does not favor obtaining the uncertain protection of a design patent. Furthermore, even large designers may find the time lag inherent in obtaining a design patent cumbersome when the garment industry is accustomed to swift turnaround and rapid change.

### 3. *Trade Secrets*

Trade secret law is also used by designers to protect their designs – up until the moment those designs are photographed or put on the runway. Publication destroys trade secrets, so they

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<sup>50</sup> 35 U.S.C. § 171.

<sup>51</sup> Robert A. Gordon and Jane C. Ginsburg, *Copyright*, 222 (7th ed., Foundation Press 2006).

<sup>52</sup> *Id.*, See also: Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. Rev. 1341 (1987).

<sup>53</sup> *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 238, 84 S.Ct. 779, 782, 11 L.Ed.2d 669 (1964) (a design not entitled to a design patent or other federal statutory protection can be copied at will).

<sup>54</sup> Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. Rev. 1341 (1987).

are a limited protection at best,<sup>55</sup> and mainly useful to guard upcoming collections. Certainly once a pattern is published it is no longer subject to any protection under trade secret laws.<sup>56</sup>

Like copyright, trade secret protection adheres without registration – and indeed would be defeated by a registration process – but unlike copyright it is destroyed by exhibition. The owner of the secret must also take affirmative steps to guard it from disclosure, and even accidental exhibition eliminates all protection. Available damages are adequately high to incentivize suit, but in the event that such a suit were to become necessary the damage would have been done.<sup>57</sup>

Ultimately, like design patents and trademarks, trade secret law is not the best avenue for protecting garment designs. It is simply too limited in scope, where the industry it is protecting is dependent on exhibiting the very articles trade secret law demands be kept hidden.

#### B. The Fourth Circuit and the inseparable aspects test

Copyright has many qualities that make it superior to the alternate forms of protection discussed above. It adheres on creation, provides protection even upon display, and prevents the creation of derivative works. Furthermore, it is flexible enough to allow protection for one work while not preventing protection for all similar works. However, there is a significant fly in the copyright ointment: case law regarding the protectability of useful articles “has evolved from the uncertain to the incoherent.”<sup>58</sup>

Utility should not be an absolute bar to copyrightability if the utilitarian article was made with an eye to its aesthetic aspects. The Second Circuit, however, follows the rule from *Brandir* that either pure utility or inseparability of utility and aesthetics operate to bar protection. This is

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<sup>55</sup> 18 U.S.C. § 1832.

<sup>56</sup> *Id.*

<sup>57</sup> *Id.*

<sup>58</sup> Robert A. Gordon and Jane C. Ginsburg, *Copyright*, 221 (7th ed., Foundation Press 2006).

relevant because the vast majority of garment design copyright cases have been and will be litigated in the Second Circuit (which includes New York).<sup>59</sup> The Fourth Circuit, however, reached a better answer when it decided in *Superior Form Builders v. Dan Chase Taxidermy Supply Co.*, that utilitarian articles should not be entirely denied copyright.<sup>60</sup>

In *Superior Form Builders*, the Fourth Circuit introduced a two-part analysis, the first part of which is not unfamiliar in copyright: first, one isolates the utilitarian and nonutilitarian aspects of an object.<sup>61</sup> However, where the Second Circuit would hold that both utilitarian and inseparably utilitarian and aesthetic aspects of the object are uncopyrightable, the Fourth added an additional step.<sup>62</sup> Under *Superior Form Builders*, where the utilitarian and nonutilitarian aspects are inseparable, the court must make a determination as to whether the inseparable portions are included purely for use, or “for the purpose of displaying or portraying the article.”<sup>63</sup> The court used this test to determine that mannequins for mounting taxidermied animals are sculptural, rather than purely structural, because the mannequin sculpture involves aesthetic decisions about pose that, while inseparable from the utilitarian aspect of support, were made for the purpose of displaying that pose.<sup>64</sup>

Unfortunately, the Fourth Circuit continues to stand alone in its decision that articles which are both aesthetic and utilitarian may still be copyrightable even though those aspects are inseparable. The remainder of the circuits, and especially the Second, where most fashion and garment copyright cases are litigated, maintain a firm stance against the copyrightability of

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<sup>59</sup> <http://www.uscourts.gov/images/CircuitMap.pdf> (accessed Apr. 19, 2010).

<sup>60</sup> 74 F.3d 488, 494 (4th Cir. 1996).

<sup>61</sup> *Id.*

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

garment design.<sup>65</sup> The better answer is to apply the Fourth Circuit's reasoning, which yields the result of allowing protection without using a bright-line rule one way or the other on garments.

Under the *Superior Form Builders* test, it is possible to copyright garment designs as embodied in the finished article of clothing without implicating the policy concerns raised by opponents of garment design copyright. Take, for example, this sweater:<sup>66</sup>



Consider the cable (the pattern of stitches that looks like a herringbone or series of loops) running down the outside of the shoulder and arm. This stitch pattern is beautiful, but also functional. The construction of that particular cable is stable and resistant to stretch, which means that the sweater will be resistant to sagging in the shoulders despite repeated wearings. The cable is therefore an inseparably functional and aesthetic element of the sweater. The same can be said of the twisted cable running around the armhole<sup>67</sup> of the sweater.

Under the Second Circuit's analysis, the sweater fails to be copyrightable at this point. Using the Fourth Circuit's test yields a different result, however. Analyzing each inseparable element, a court should reach the conclusion that these elements are included for the primary

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<sup>65</sup> For a discussion of the various circuits and why the Second Circuit is generally followed, see *Pivot Point International v. Charlene Prods., Inc.* 372 F.3d 913 (7th Cir. 2004).

<sup>66</sup> Rue Toland, *One Down*, <http://tinksandfrogs.blogspot.com/2010/01/one-down.html> (accessed Apr. 17, 2010) Photographer: Rue Toland; Model: Jonah Sutton-Morse. Sweater: nameless sweater based on Saddle Shouldered Aran Cardigan (Spun Out #49/ Wool Gathering #63) by Elizabeth Zimmerman.

<sup>67</sup> The line running from the point of the shoulder, down, around the underarm, and back to the point of the shoulder. Jenna Wilson, *Ravellings on the knitted sleeve Part II - Creating a set-in sleeve for a sleeveless body*, <http://www.knitty.com/ISSUEwinter04/FEATwin04TBP.html> (accessed Apr. 19, 2010)

purpose of displaying their aesthetic qualities. After all, there are a myriad of stable stitch configurations that the designer could have used to achieve the same result, so choosing one over the other shows an aesthetic choice and an intent to display that particular configuration. Each element in this sweater may be analyzed the same way, with the ultimate conclusion that the sweater itself may be copyrighted. The copyright would likely be thin, as this sweater is an arrangement of known elements and even small rearrangements could yield a different result, but at least it would protect the designer from actual copying. This is an entirely appropriate result, given the amount of effort and care the designer took in bringing her vision to fruition.

Had the stabilizing stitch been made on the inside of the garment, the primary purpose could be assessed as the stability, that is, the functional purpose, of the stitch. That would mean one more uncopyrightable element in the sweater. Even under the Fourth Circuit test, then, it is possible to have articles of clothing that are not ultimately subject to copyright, which should assuage some of the concerns of garment copyright critics.

C. A possible legislative solution

It is highly unlikely that a garment design case will first reach the Supreme Court and then be analyzed under the Fourth Circuit's approach, which would force the rest of the country to adopt the most sensible test used for this analysis, and even in the Fourth Circuit the *Superior Form Builders* test has not yet been used to successfully support the proposition that garments may be copyrighted. Therefore, garment designers are left to seek a solution at the hands of Congress. Were Congress to make a law providing protection to the garment design industry, courts could take a new look at protecting these designs without struggling with existing jurisprudence. In fact, Congress is not without a history of enacting legislation to close similar gaps in copyright law. Title V of the Digital Millennium Copyright Act protected the design of

boat hulls under the Vessel Hull Design Protection Act (VHDPA), with certain restrictions on the full grant of copyright rights, including a ten-year time limit on protection and a registration requirement.<sup>68</sup> However, another piece of legislation even more closely tracks the policy concerns and history of garment design copyright.

Until relatively recently, copyright law for architectural works operated the way garment design copyright operates today.<sup>69</sup> Building plans were copyrightable; the buildings constructed from these plans were not.<sup>70</sup> Today, buildings are considered an embodiment of architectural drawings.<sup>71</sup> This is because in 1990 copyright protection was explicitly extended to architectural works by act of Congress.<sup>72</sup>

Although the Architectural Works Copyright Protection Act of 1990 (AWCPA) has been subject to a certain amount of criticism,<sup>73</sup> it is not without its merits, and there is no reason why Congress could not use it as a model to devise a Textile Works Act. Such an Act could incorporate the best portions of the AWCPA (its limited scope and limited protection for derivative works) while adding certain new limitations to address the concerns peculiar to the garment design industry.

A Textile Works Act would need to incorporate a time limitation similar to that in the VHDPA in order to allow artists to build on prior art yet still protect that art during the period it is most valuable to its creator.<sup>74</sup> Based on the rate of turnover and production schedule of the

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<sup>68</sup> Gorman and Ginsburg, *Copyright* at 226.

<sup>69</sup> *Id.* at 253.

<sup>70</sup> *Id.*; *Demetriades v. Kaufmann*, 680 F.Supp 658 (S.D.N.Y. 1988).

<sup>71</sup> 17 U.S.C. § 120.

<sup>72</sup> Gorman and Ginsburg, *Copyright* at 254.

<sup>73</sup> Raphael Winick, *Copyright Protection for Architecture after the Architectural Works Copyright Protection Act of 1990* 41 *Duke Law Journal* 6 (Jun., 1992).

<sup>74</sup> As garment patterns are currently subject to the full protections of copyright law, there would not need to be a change in this aspect of protection. Finished garments, however, should have significantly more time-limited protections.

garment industry, most garment designs have reached their point of optimal monetization in the first year of production. Therefore it seems adequate to protect finished garments as embodiments of the pattern from which they are made for a period of one year from the first authorized production of the garment from the final version of the pattern. This limitation would echo the patent doctrine that “testing” does not count as production; likewise, producing samples from a pattern would not trigger the start of the year’s protection.<sup>75</sup> The development of a pattern is somewhat time-intensive, and may include distribution to a select group of tailors or knitters in order to ensure that the directions in the pattern are clear before it is made available to the general public. After the first “commercial” (or authorized, if the pattern is offered for free)<sup>76</sup> production, the year starts to run. By the end of the year, the pattern has most likely reached its maximum monetization; that is, anyone who likes it enough to reverse-engineer it from the finished garment will have bought the pattern, and anyone who cannot reverse-engineer it will buy it anyway. One year, moreover, is a full cycle of seasons in the fashion industry. A one-year limit would enable the Spring 2011 collection to be built on the foundation of the Spring 2010 collection without questions of infringement, yet afford full protection to the Spring 2010 collection for as long as is necessary to reach its full monetary potential.

Like the AWCPA, the TWA would need to limit the protection of derivative works made from the original work.<sup>77</sup> Clothing, like buildings, is often photographed. Any street scene

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<sup>75</sup> *City of Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126 (1878).

<sup>76</sup> It may seem counterintuitive to contemplate copyright in the context of something offered to the public for free, but many patterns are not offered in fee simple absolute. Instead, a limited license to use the pattern is granted, with certain restrictions (usually “do not sell the finished product commercially”) placed on the user. See generally <http://www.knitty.com/legal.php> (accessed Apr. 19, 2010) (note which provisions are enforceable under the current regime and which would be impossible to enforce).

<sup>77</sup> 17 U.S.C. § 120 (a) (“Pictorial Representations Permitted. — The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.”)

photographed will necessarily include a number of articles of clothing. These photographs as a matter of policy should not constitute infringing derivative works. The AWCPA solved this problem legislatively with 17 U.S.C. 120,<sup>78</sup> and the TWA could handle it likewise.

Legislation attempting to protect garment designs has been repeatedly introduced in Congress, but with little success. H.R. 5055 was introduced on March 30, 2006, but died in committee.<sup>79</sup> It would have added “fashion design” to the subject matter of protected designs, and provide three years of protection for these designs.<sup>80</sup> A related bill, the Design Piracy Protection Act, was introduced as H.R. 2033 on April 25, 2007, but also died.<sup>81</sup> As of this writing, the successor bill to H.R. 2033, H.R. 2196, has been referred to the House Committee on the Judiciary. It contains many of the protections discussed above, and makes provision for a searchable database of fashion design.<sup>82</sup> While it would be desirable for both the overall fashion industry and small independent designers to have such a bill pass, there seems little hope at this juncture that H.R. 2196 will fare any better than its predecessors.

## V. Conclusion

The accretion of micro-harms creates a macro harm. That is, when designers are individually prevented from monetizing their patterns, they become less likely to publish. This is not good for the designers, and it does not benefit the public. It is extremely unlikely that the

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<sup>78</sup> 17 USC § 120. Scope of exclusive rights in architectural works

(a) Pictorial Representations Permitted. — The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

(b) Alterations to and Destruction of Buildings. — Notwithstanding the provisions of section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building.

<sup>79</sup> H.R. 5055, 109th Cong. (Mar. 30, 2006).

<sup>80</sup> *Id.*

<sup>81</sup> H.R. 2033, 110<sup>th</sup> Cong. (Apr. 25, 2007).

<sup>82</sup> H.R. 2196, 111th Cong. (Apr. 30, 2009); <http://thomas.loc.gov/cgi-bin/query/z?c111:h2196>:

Supreme Court will grant certiorari on a garment design case and endorse the Fourth Circuit's test for inseparably functional and aesthetic elements. For those reasons, the most sensible solution would be for Congress to pass a Textile Works Act modeled on the Architectural Works Act – limit protections in time and derivative works, but once and for all put a seal of approval on the intuitive understanding that a garment produced from a pattern is an embodiment of that pattern.