

Marketa Trimble

Fashion and U.S. IP Law

University of Milan
March 12, 2013



IT'S ABOUT:
INSPIRATION
CREATIVITY
TALENT
IDEAS
INNOVATION
PASSION
CONFIDENCE
BUSINESS
ORIGINALITY
INTEGRITY
EXPERIENCE
RESPECT
REPUTATION

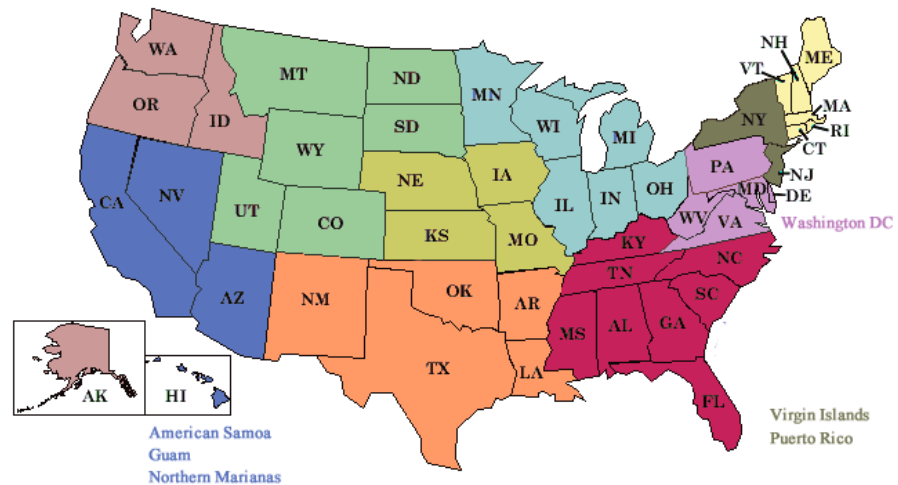
DESIGN.
PROTECT IT.
C.F.D.A.

Developed and distributed by the Council of Fashion Designers of America
to promote design and to discourage copying. www.cdfa.com

Basics of U.S. IP Law

U.S. IP Law

- Patents, designs, copyright, trademarks, trade secrets
- Federal vs. state law
- Preemption
- International treaties
- No protection for fashion *per se*



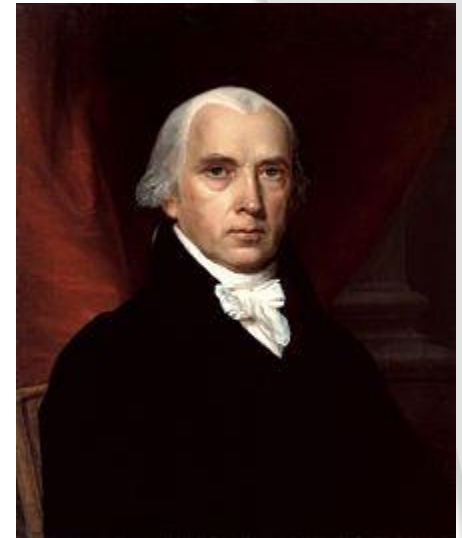


U.S. Constitution Article 1 - The Legislative Branch Section 8 - Powers of Congress

The Congress shall have Power ...
... [t]o 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 ...

James Madison, *The Federalist No. 43*

“The utility of this power will be scarcely questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provision in either of the cases, and most of them have anticipated the decision on this point by laws passed at the instance of Congress.”



Pennock v. Dialogue, 27 U.S. (2 Pet.) 1, 19 (1829)

J. Story:



“While one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was ‘to promote the progress of science and useful arts;’ and this could be done best by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible having a due regard to the rights of the inventor.”

Patents and copyright versus **trademarks**

- Origin in common-law passing off
- Indication of origin of goods and services

*first*VIEW

[collections](#)

[calendar](#)

[shop](#)

[subscribe](#)

[login](#)



Find A Designer

Login

January 30, 2011

[firstVIEW.com/blog](#) ALL
NEW!

New York, London, Milan

*first*VIEW

The world's largest
fashion database
and photo archive
with 3452728





Find A Designer

Login

January 30, 2011

[firstVIEW.com/blog](#) ALL
NEW!

New York, London, Milan

firstVIEW

The world's largest
fashion database
and photo archive
with 3452728

Feraud v. Viewfinder

Copyright

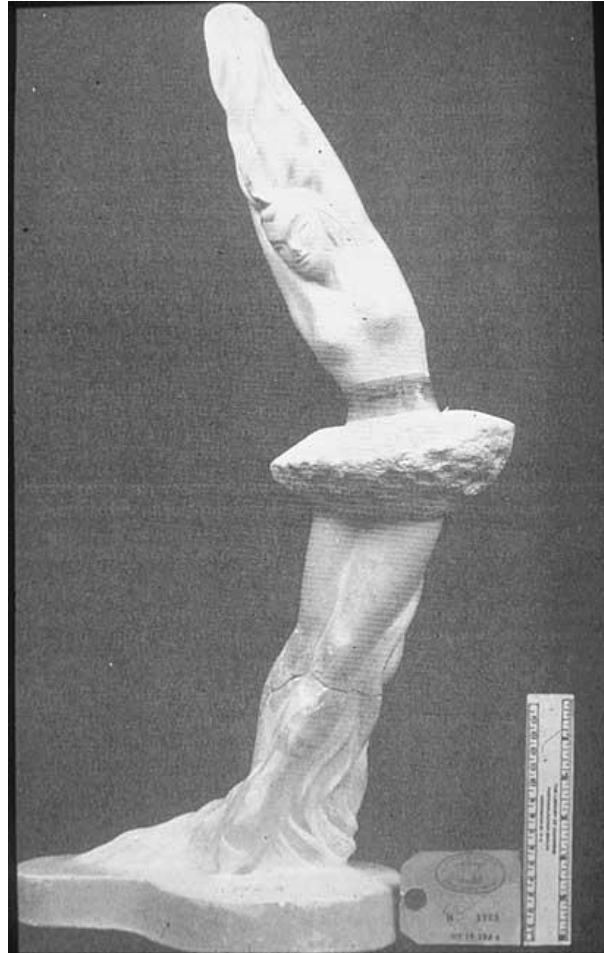
Copyright

- ◉ Original work of authorship fixed in a tangible medium of expression
- ◉ Life of the author plus 70 years
- ◉ No registration needed for protection (the Berne Convention) but a good idea to register with the U.S. Copyright Office
- ◉ No protection for utilitarian objects

Copyright

U.S. Copyright Act, 17 U.S.C. §101

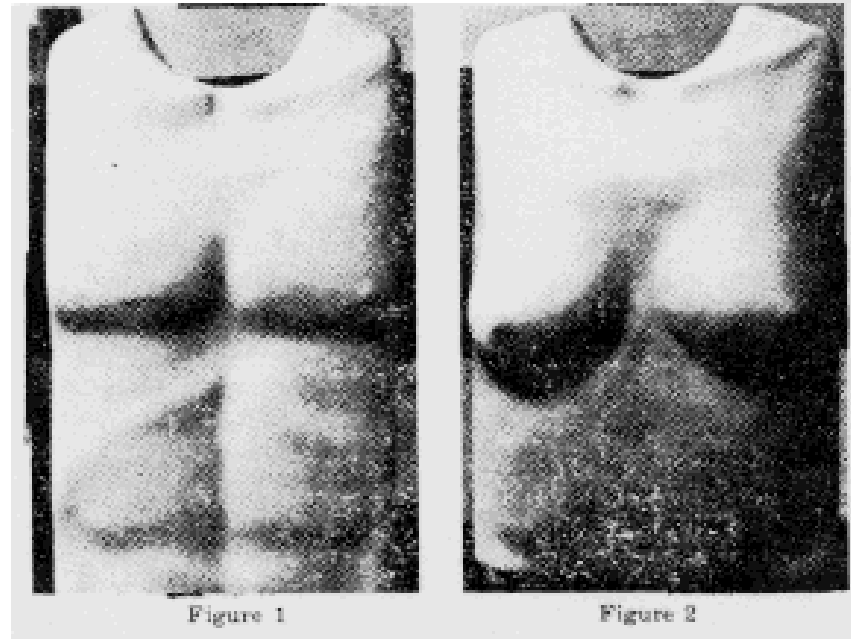
“Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include **works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned**; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only 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.



Mazer v. Stein
(S.Ct. 1953)



Kieselstein-Cord v.
Accessories by Pearl, Inc.
(2d Cir. 1980)



Carol Bernhart Inc. v. Economy
Cover Corp.
(2d Cir. 1985)



Mystique's By The Sea



Mystique's Starry Eyed



Trump's Pia



Trump's Pandora

White Pages

verizon

Montgomery County RESIDENTIAL LISTINGS

32691 © 2004 Verizon Directory Services Inc. All Rights Reserved.

A

Accountant And Attorney Ryan

Lahuti 8729 Georgia Av

Dr Spg 301 585-1000

48 W 301 948-

1806 14th Av Hyattsville 301 434-

515 Birdseye Ct Germantown 301 540-

2129 16th St Silver Spring 301 589-1000

1801 Oliver St 301 680-0459

JF 214 Southampton Dr

Time Spring 301 431-7534

128 Gregorio Dr Silver Spring 301 445-4052

AARON Alan D 1536 Wisconsin Av

Ch 10 301 657-9876

AARON Albert A 12100 Riggs Rd

Hyattsville 301 445-4477

Brian 7501 Maple Av

Tandem Park 301 270-8755

Bogen D L & Carole 1903 Wilmet Rd

AASEN Ronald 2022 Heritage Av

Silver Spring 301 942-6087

AASIM S 7201 Mill Run Dr

Rockville 240 632-0440

AAVATSMARK Paul & Isabella

301 986-1666

AAZAMI Aletha 605 Flourish Blvd

ABANDOR Marygrace

23206 Twinbrook Pkwy Rockville 301 231-9440

ABANGA Shenay 19248 Circle Gate Dr

Germantown 301 515-4326

ABANGAWUAH Bridget

7401 New Hampshire Av

301 942-6087

ABATE-AVERY ; Samrawit

13400 Cemetery Way

Germantown 301 528-8003

Samrawit & Sean 2309 Showfield Rd

Silver Spring 301 949-3108

ABAUTA Yolanda 7547 Laytonia Dr

Bethesda 301 963-6487

ABATE G 2505 Memory Ct

Spring 301 596-1684

Abate 8750 Georgia Av

Land Spring 301 589-0639

Dawit 8308 Electridge Av

Silver Spring 301 562-9152

Redae G 8015 Eastern Av

Silver Spring 301 630-2640

32691 © 2004 Verizon Directory Services Inc. All Rights Reserved.

Silver Spring 301 754-2276

Daniel 5155 King Charles Way

Bethesda 301 564-5969

Edw C 12408 Eastbourne Dr

Silver Spring 301 677-3070

ABA Gabriel Koffi 301 445-6222

Gabriel Koffi 1522 Dilston Rd

Silver Spring 301 445-0779

Gabriel Koffi

7401 New Hampshire Av 301 942-6087

ABATE G 2505 Memory Ct

Spring 301 596-1684

Abate 8750 Georgia Av

Land Spring 301 589-0639

Dawit 8308 Electridge Av

Silver Spring 301 562-9152

Redae G 8015 Eastern Av

Silver Spring 301 630-2640

Feist Publications v. Rural Telephone Service (S.Ct. 1991)

Visual Comparison of Fiesta Fashions Style with Jovani Style



Fiesta Fashions, Style FI50021

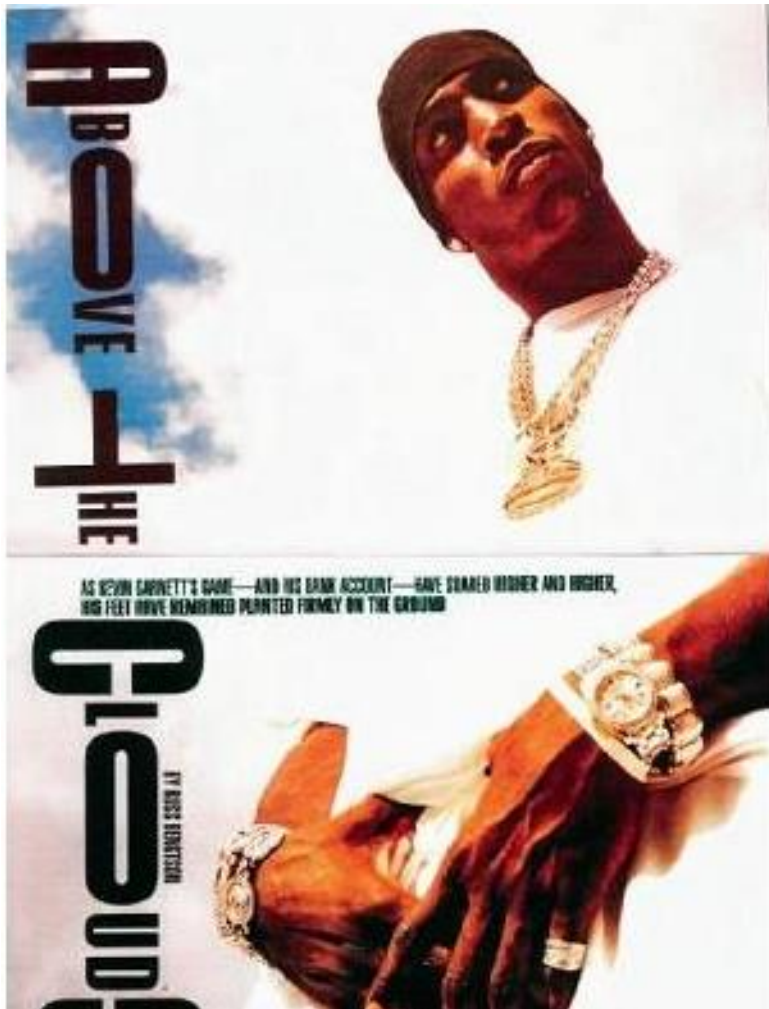


Jovani, Style 154416 (on Jovani website)

Jovani Fashion v. Cindarella
Divine (SDNY 2011)



On Davis v. The Gap (2d Cir. 2001)



Mannion v. Coors (SDNY 2005)

Utility Patent



Patented July 17, 1917.

1,233,714.

fig. 1.

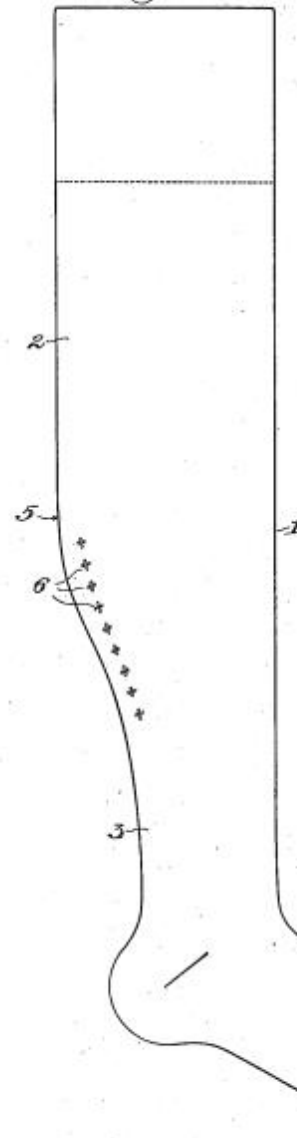


fig. 3.

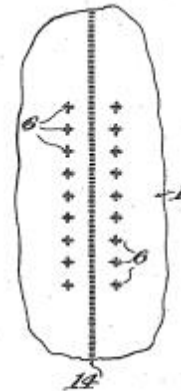
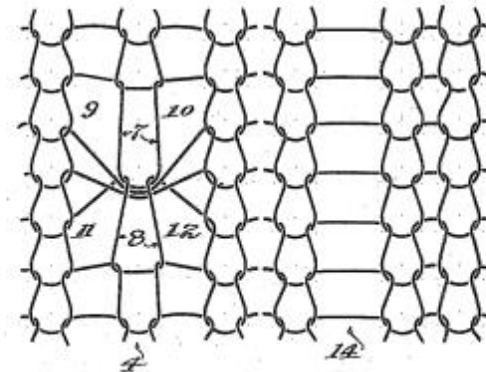


fig. 2.



Inventor:
Robert W. Scott
by Robert Roberts & Cushman
his Attorneys.

Scott & Williams v. Aristo
Hosiery Co.
(2d Cir. 1925)

Utility Patent

- ⦿ Process, machine, article of manufacture, or composition of matter, or any improvement thereof
- ⦿ Novel, non-obvious, useful
- ⦿ Must apply for patent with the USPTO
- ⦿ 20 years from the date of application

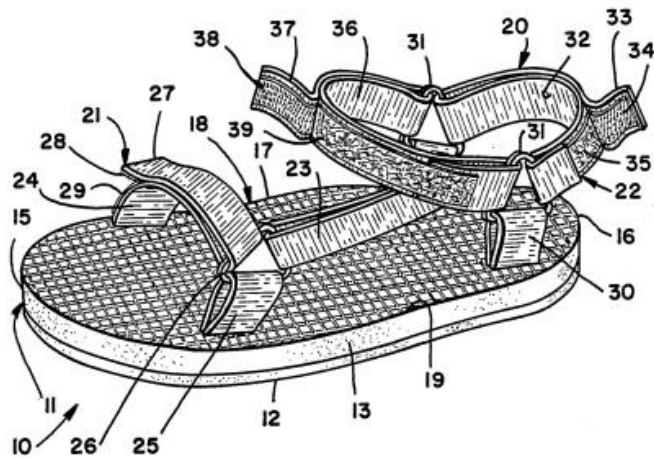


FIG. 1

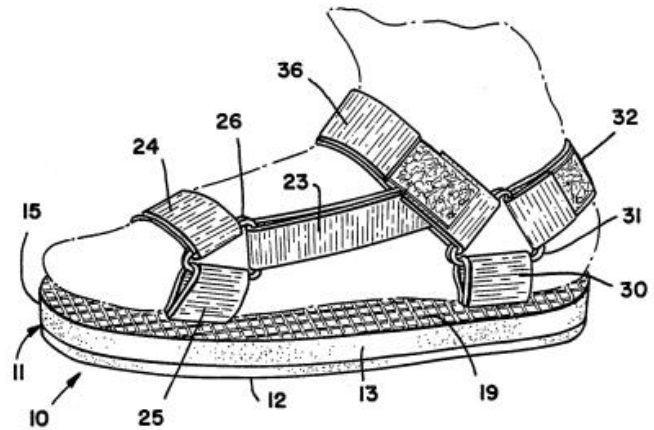


FIG. 2



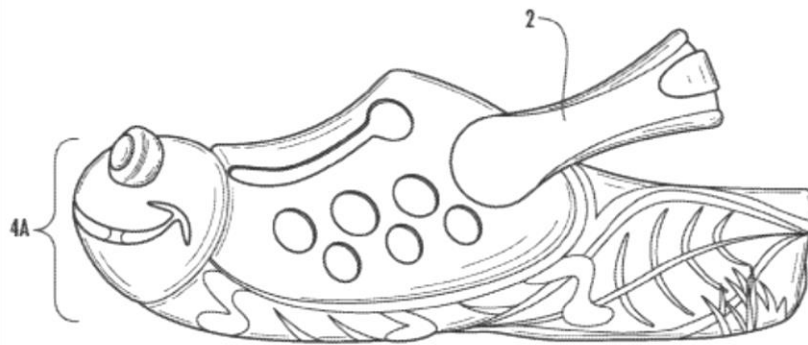


FIG. 1A

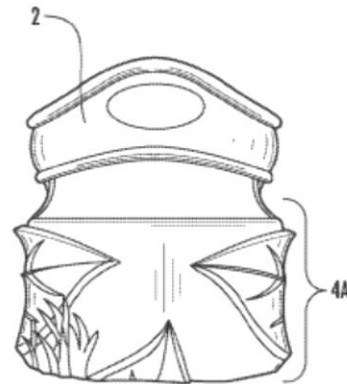


FIG. 1C

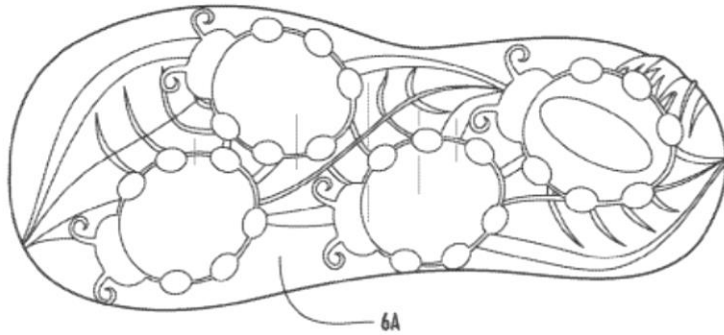
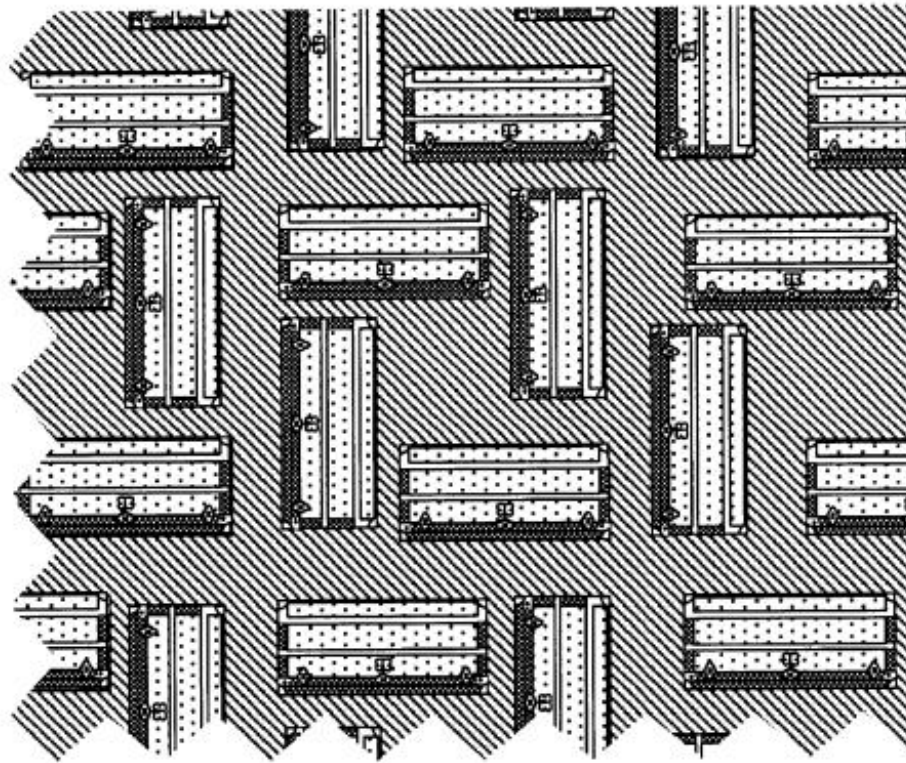


FIG. 1B

10



Design Patent



Design Patent

- ◉ “Visual ornamental characteristics embodied in, or applied to, an article of manufacture”
- ◉ New and original
- ◉ Must register with the USPTO
- ◉ 14 years of protection



Jan. 2, 1940.

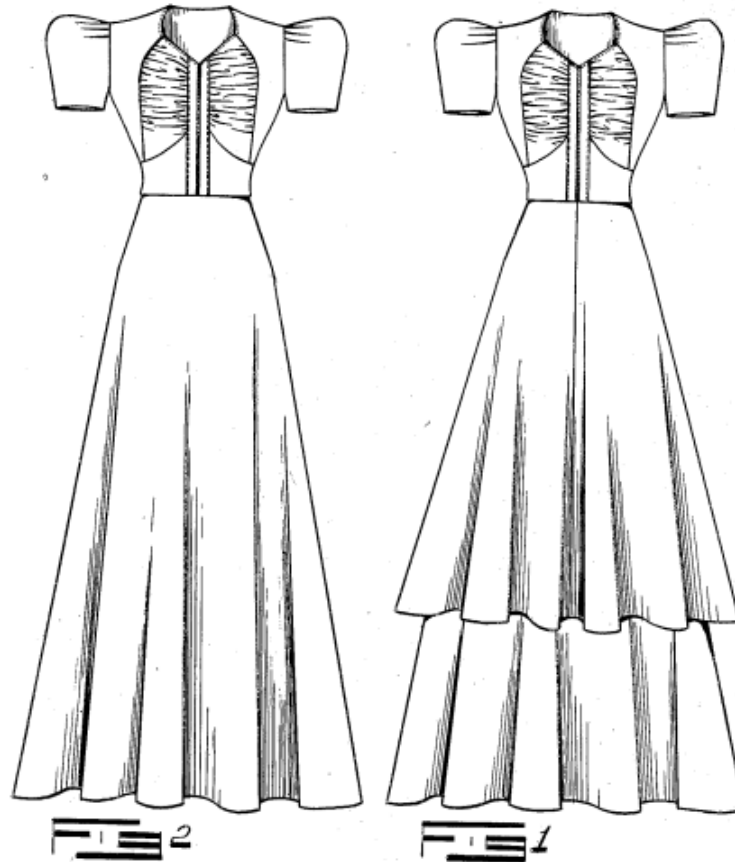
V. SCAPPATICCIO

Des. 118,392

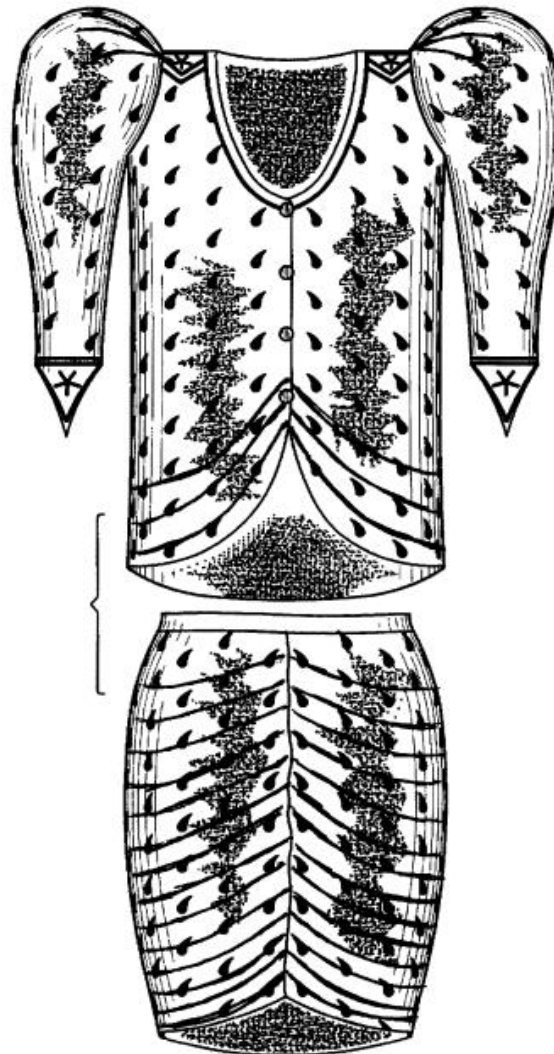
COMBINATION EVENING AND STREET DRESS

Filed Nov. 30, 1939

2 Sheets-Sheet 1



VINCENT SCAPPATICCIO
INVENTOR
By *Louis Casper*
ATTORNEY

FIG. 1

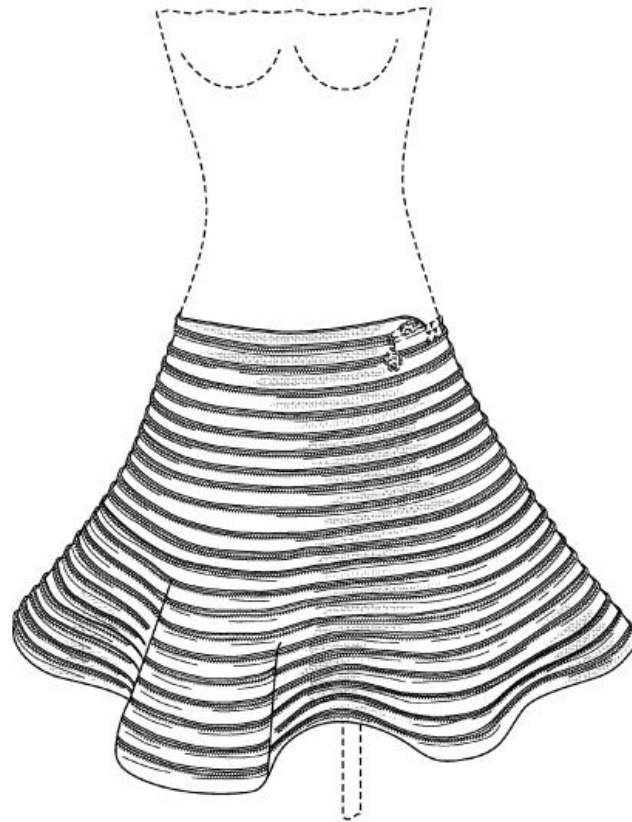


FIG. 1

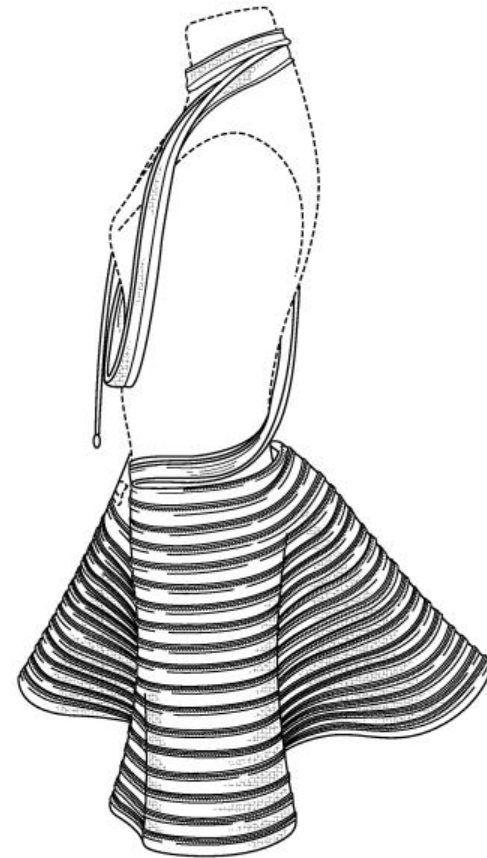


FIG. 7

Trademark and Trade Dress

Trademark and Trade Dress

- ◉ Protection for brand names, logos, symbols, designs
- ◉ Design, packaging or appearance
- ◉ Federal vs. state
- ◉ Registration for certain goods and services
- ◉ Renewable term
- ◉ Distinctive or acquired distinctiveness through use
- ◉ Must use in commerce
- ◉ Must protect against becoming generic

Examples of classes of TM goods and services

- ◉ Wearable garments and clothing, namely shirts
- ◉ Belt buckles [for clothing]
- ◉ Bridesmaid dresses
- ◉ Fashion handbags
- ◉ Eye glasses
- ◉ Dress design services
- ◉ Dressmaking
- ◉ Needlework and dressmaking services
- ◉ Tailoring or dressmaking
- ◉ Entertainment in the nature of fashion shows
- ◉ Fashion design consulting services

A NOTE OF INFORMATION AND ENTREATY
TO FASHION EDITORS, ADVERTISERS,
COPYWRITERS AND OTHER
WELL-INTENTIONED MIS-USERS OF
OUR **CHANEL** NAME.

CHANEL was a designer, an extraordinary woman who made
a timeless contribution to fashion.

CHANEL is a perfume.

CHANEL is modern elegance in couture, ready-to-wear,
accessories, watches and fine jewelry.

CHANEL is our registered trademark for fragrance, cosmetics,
clothing, accessories and other lovely things.

Although our style is justly famous, a jacket is not 'a CHANEL jacket' unless it is
ours, and somebody else's cardigans are not 'CHANEL for now.'

And even if we are flattered by such tributes to our fame as 'Chanel-issime,
Chanel-ed, Chanels and Chanel-ized', PLEASE DON'T. Our lawyers positively
detest them.

We take our trademark seriously.

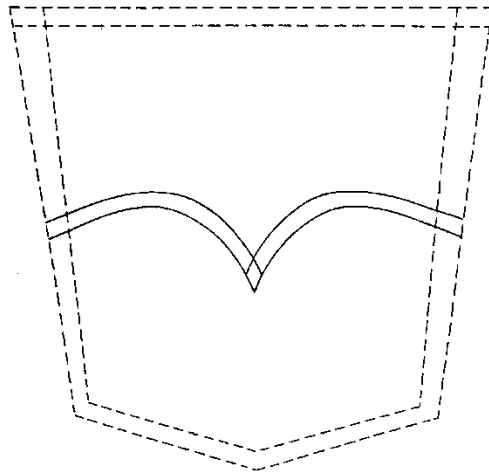
Merci,

CHANEL, Inc.



Wal-Mart v. Samara Brothers (S.Ct. 2000)





U.S. ® 1,139,254



Levi's "Arcuate"



Abercrombie's "Ruehl"

Five of the companies Levi Strauss has sued in the last decade.

Levi Strauss

First trademarked
in 1943



Jelessy

Sued in 2005



Von Dutch

2006



Karen Kane

1996 and 2006



Jones Apparel

2003 and 2006



Fossil

2005



Sources: Thomson West; court documents

The New York Times



Malletier v. Dooney & Bourke
(S.D.N.Y. 2004)





Louboutin v. Yves Saint Laurent (2d Cir. 2012)

Louboutin v. Société Zara France (Cour de cassation 2012)



Omega v. Costco (9th Cir. 2008, S.Ct. 2010)



International exhaustion versus national exhaustion

Other U.S. Laws Protecting Fashion

Testimony of Jeffrey Banks, fashion designer, on behalf of the Council of Fashion Designers of America (U.S. House of Representatives, 2006)

- The adverse impact of piracy on American designers
- Piracy fueled by technology
- The impact of fashion piracy on consumers

Testimony of David Wolfe, creative director, Doneger Creative Services (U.S. House of Representatives, 2006)

- The lack of originality in fashion makes copyright protection a poor fit
- The fashion industry has thrived and continues to thrive in the absence of copyright
- [The new law] would be detrimental to the fashion industry, retailers and consumers
 - Delays from litigation, injunctions and licensing would stunt the fashion industry
 - A fashion copyright would be virtually impossible to enforce fairly because of the lack of originality in fashion
 - A fashion copyright would increase costs for designers and retailers and would decrease choices for consumers

Innovative Design Protection Act of 2012

A “fashion design”

- (A) is the appearance as a whole of an article of apparel, including its ornamentation; and
- (B) includes original elements of the article of apparel of the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel that
 - (i) are the result of a designer’s own creative endeavor; and
 - (ii) provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.

Innovative Design Protection Act of 2012

- Term of protection: 3 years
- An infringing article = “any article the design of which has been copied from a design protected under this chapter, or from an image thereof, without the consent of the owner of the protected design”
- An infringing article is NOT “an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium”

*first*VIEW

[collections](#) [calendar](#) [shop](#) [subscribe](#) [login](#)



Find A Designer

Login

January 30, 2011
firstVIEW.com/blog ALL
NEW!

New York, London, Milan

*first*VIEW

The world's largest
fashion database
and photo archive
with 3452728



Marketa Trimble

Fashion and U.S. IP Law

University of Milan
March 12, 2013