IT’S ABOUT:
INSPIRATION
CREATIVITY
TALENT
IDEAS
INNOVATION
PASSION
CONFIDENCE
BUSINESS
ORIGINALITY
INTEGRITY
 EXPERIENCE
RESPECT
REPUTATION
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*
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 ...
“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.”

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
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)
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
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
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
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, Chanel's 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)
Five of the companies Levi Strauss has sued in the last decade.

<table>
<thead>
<tr>
<th>Company</th>
<th>First Trademarked</th>
<th>Sued Years</th>
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<tbody>
<tr>
<td>Levi Strauss</td>
<td>1943</td>
<td>2005</td>
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<td>Jelessy</td>
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<td>Von Dutch</td>
<td>2006</td>
<td>1996 and 2006</td>
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<tr>
<td>Karen Kane</td>
<td>2006</td>
<td></td>
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<tr>
<td>Jones Apparel</td>
<td>2003 and 2006</td>
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<td>Fossil</td>
<td>2005</td>
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</tbody>
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Levi’s “Arcuate”  Abercrombie’s “Ruehl”

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
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”
Marketa Trimble

Fashion and U.S. IP Law

University of Milan
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