



# **Fashion Design and Copyright in the US and EU**

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# Fashion design and IPRs

Fashion designs could be protected by...

- Patent
- Design Patent
- Trademark
- Trade dress
- Copyright
- Competition law
- Sui generis protection

# US: Fashion designs and IPRs

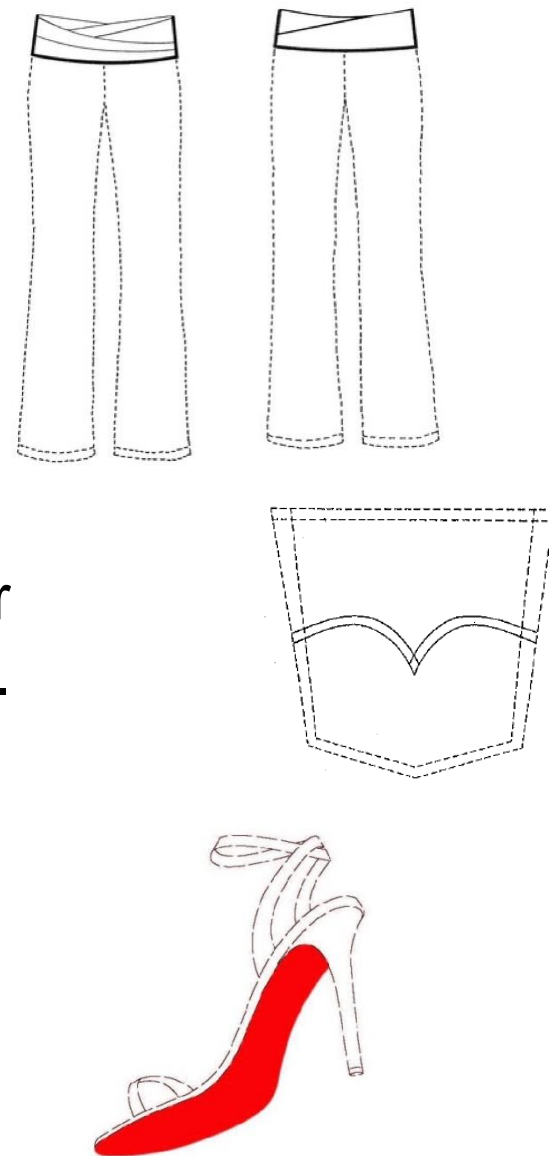
## ■ Design Patent?

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

## ■ Trademark or trade dress?

- Difficult to identify origin of clothing or to obtain “secondary meaning”.

## ■ Copyright??



(BY USPTO)

# US: Fashion designs and copyright

- Scope of copyright:

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

- Separability requirement for useful article:

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

# US: Separability requirement for useful articles

## ■ Physical separability:

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

## ■ Conceptual separability:

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

# US: Fashion designs protectable by copyright?

- No in general

## Protected



- Fabric designs, patterns
- Belt buckle
- Non-useful/non-functional clothing (e.g. clear plastic swimsuit, Lady Gaga's meat dress)



(By w:user:PlaneMad (Photo by w:user:PlaneMad), via Wikimedia Commons)



(By Rahgozarkhab, via Wikimedia Commons)

## Not protected



- 3D clothing designs in general



("KOCIS Lie SangBong Catwalk Fashion Show London 02 (7689309426)" by Korea.net / Korean Culture and Information Service via Wikimedia Commons)

# US: Fashion designs protectable by copyright?

## - How about costume?

### Protected



- Halloween costume's element (Conceptually separable)



(By Werner Wülfing, via Wikimedia Commons)

- Rabbit in hat and tigress (Non-useful/non-functionable)

### Not protected



- Prom dress's element



(By Sean McGrath from Saint John, via Wikimedia Commons)

- Uniform of casino workers



INTELLECTUAL PROPERTY ORGANIZATION  
(By Ian Murphy, via Flickr)



## US: “Fashion Bill” attempts

- Constant attempts to protect fashion designs by copyright: FAILED
- The 6<sup>th</sup> and the most recent attempt: Innovative Design Protection Act, 2012
  - ⇒ Extension of copyright protection for 3 years for fashion designs if they;
    - are the result of a designer’s own creative endeavor; and
    - provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles



# US: Debates over “Fashion Bill”

Supporters	Criticisms
<ul style="list-style-type: none"><li>• Fashion designs are a form of artistic expression which should be treated equally with other copyright protectable subjects (music, art, literature, etc.).</li><li>• Designers have alternative motivation to create designs, apart from financial motivation.</li><li>• Designers are suffering from the loss caused by copycats.</li><li>• <b>European countries</b> protecting fashion designs by copyright are leaders of fashion industry.</li></ul>	<ul style="list-style-type: none"><li>• Copying is promoting innovation and creation of new fashion designs (“Piracy Paradox”).</li><li>• The Bill increases independent fashion designers’ legal costs (e.g. consultation with lawyers to reduce likelihood of infringement claims).</li><li>• It indirectly increases the cost of apparel for the consumers.</li></ul>

# EU: Fashion designs and IPRs

- Two main sources of IP protection for fashion designs:

  - Copyright

  - Unregistered Community Design right (UCD)

- Cumulative protection

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

# EU: Fashion designs and copyright

- EU Designs Protection Directive (98/71/EC)

- Cumulative protection: Discretion of Member States

- “Design”: very wide definition

- “The appearance of the whole or a part of a product resulting from the features of the lines, contours, colors, shape, texture or its ornamentation.”

⇒ Fashion articles in general are included.

⇒ In countries where the cumulative protection is admitted, fashion articles can be protected both by design rights and copyright.

# EU: Fashion designs and copyright

## - Cumulative protection in France

### ■ Theory “unité de l’art”:

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

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

Prodeco SARL v. AS GmbH (OHIM, 2011)



EU registered design right N°1595737-0013 (left) was invalidated by EU Design Office because of the existence of earlier French copyright protected work (right).

# EU: Fashion designs and copyright

## – French case law

### ■ Yves Saint Laurent v. Ralph Laurent (Trib. Comm. Paris, 1994)

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

#### Yves Saint Laurent

- Price: 15000 \$
- Silk
- No pockets
- Gold buttons
- Lapel narrower



#### Ralph Laurent

- Price: 1000 \$
- Wool
- Pockets
- Black buttons
- Lapel wider



(Profils d'hiver; L'Officiel de la Mode, Sept. 1992 at 210 and 211 (left) and Femmes en smoking, supra note 165 and at 133)

■ YSL won despite the differences between the garments based on the prior copyright.

# EU: Fashion design and Unregistered Community Design right

## ■ EU Regulation on Community Designs (6/2002)

Comparison between registered and unregistered design rights

	<b>Registered Community Designs</b>	<b>Unregistered Community Designs</b>
Formality	Application and registration	<u>Automatic protection</u>
Cost	Yes	<u>No</u>
Scope	Protected against the identical and similar designs	Protected only against the “dead copy”
Border control	Yes	No
Duration	25 years maximum from the date of application	<u>3 years</u> from the date of publication in the European Union

■ UCD useful for protecting short-life fashion designs.

# EU: Fashion design and Unregisterd Community Design right – European case law

## ■ A decision largely welcomed by fashion design right holders:

Karen Millen v. Dunnes Stores (CJEU, 19 June 2014)

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

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





# EU: Fashion design and Unregistered Community Design right – European case law

■ Question 1: In order for a design to be considered to have individual character, the overall impression which that design produces must be different from that of;

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

or

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

■ Answer (a)

It is sufficient for the right holder to compare the contested design only with a body of earlier designs, and it is not necessary to compare with an amalgam of various features of earlier designs.

# EU: Fashion design and Unregistered Community Design right – European case law

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

(a) prove that it has individual character?

or

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

■ Answer: (b)

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

## Other countries – UK

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

## Other countries – UK

■ The threshold for similarity to qualify infringement seems not very low

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



VS.



(By High Court in England)

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

Cf. The European Design Office judged similar:



and



## Other countries – Japan

- “Work means a production in which thoughts or sentiments are creatively expressed and which falls within the literary, academic, artistic or musical domain.”
- Case law explicitly excluding mass-products from copyright scope.
- Fashion design in general not protected with possible exception of one-off piece.

## Other countries – Japan

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

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



The Court ordered the infringers to pay damages.

## Other countries – Israel

*How about Israel?*



By <http://www.flickr.com/people/69061470@N05>,  
via Wikimedia Commons)

### Israel Copyright Act

#### CHAPTER 2: Conditions for Subsistence of Copyright

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

Similar to US?



Thank you!

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