
FROM THE RUNWAY TO THE COURTROOM: HOW SUBSTANTIAL SIMILARITY IS UNFIT FOR FASHION

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INTRODUCTION

“if one is going to shop at main stream retailers in the lower priced market, forever 21 is not the place to do so. all of their product is knocked off, most of which is done so prior to the originals hitting stores. try [H&M]. at least they staff designers.”¹

In the summer of 2008, one of the “season’s hottest trends” was the romper.² Stella McCartney’s black “All-in-one romper suit” version has long sleeves and a collar, epaulettes³ on the shoulder, logo detail buttons through the center, and two large button trim patch pockets on the front. It is made of 100% cotton. During the same season, Paul & Joe Sister offered a similar garment called the “Kenya silk playsuit.” Their garment is made of silk with an elastic dropped waistline and attached

* Notes Editor, *Cardozo Law Review*; J.D. Candidate (June 2009), Benjamin N. Cardozo School of Law; B.A., Columbia University (2004). I would like to dedicate this note to my grandmother, Leeza Elman, who passed along to me her love of clothing and her habit of hoarding it. I would like to thank my parents, Michael and Larisa Elman, my brother, Michael Elman, Jr., and my two best friends, George Wong and Field Marshal Bernard Montgomery, for their everlasting patience, support, and encouragement. Lastly, I would like to thank Carrie Maylor for her insightful feedback and Brian Lederman for his assistance in the editing of this Note.

¹ This anonymous thread post in response to a Forever 21 knockoff of a Marc Jacobs dress subtly points to some of the tensions that will be considered in this Note. See Fashionista—Fashion Designers, Models, Shopping, Style—Adventures in Copyrights: In the Ruf, http://fashionista.com/2008/02/adventures_in_copyrights_in_th.php#comments (last visited Feb. 23, 2008).

² A romper may also be referred to as a jumpsuit, playsuit, or onesie. See Andrea DeSimone, *Summer Style for a Steal*, PEOPLE, July 16, 2007, http://www.people.com/people/package/gallery/0,,20045075_20045739_1,00.html; Tamara Abraham, *Celebs Come Out to Play in New Season Jumpsuits*, MAIL ONLINE, May 24, 2008, <http://www.dailymail.co.uk/femail/article-1021442/Celebs-come-play-new-season-jumpsuits.html>.

³ Colloquially, this word has come to refer to some types of shoulder strap. Historically, epaulettes were used in the French army to indicate rank. See *Epaulette*, WIKIPEDIA—THE FREE ENCYCLOPEDIA, <http://en.wikipedia.org/wiki/Epaulette>.

button fastening belt, three-quarter length sleeves, a zip through front, two patch pockets, and cuffed shorts and sleeves.⁴ While it is possible that one designer influenced the other, it is also possible that both designers were influenced by other designers' rompers from this and previous seasons. It is likely that one or both designers were inspired by vintage rompers. It is impossible to imagine that the designers created their designs entirely independent of trends in the fashion world.

Consider Marc Jacobs' "Flocked Dot Dress," a black cotton dress that falls just above the knees with a side zip and a ruffle front, neckline, and hem. Forever 21 simultaneously sold a nearly exact replica called the "Ruffled Swiss Dot Dress."⁵ The two dresses are indistinguishable. It is nearly impossible to think that one designer did not appropriate the exact design from the other.

Since the beginning of 2006, more than twenty fashion companies have filed copyright or trademark infringement suits against Forever 21⁶—perhaps the most reviled "knockoff"⁷ company in the fashion industry.⁸ The Council of Fashion Designers of America,⁹ led by

⁴ The two garments can be compared at Abraham, *supra* note 2.

⁵ See *Adventures in Copyrights: In the Ruff*, FASHIONISTA, http://fashionista.com/2008/02/adventures_in_copyrights_in_th.php (last visited June 28, 2008).

⁶ See Forever 21, <http://www.forever21.com/forever/history.asp> (last visited Jan. 4, 2008) (describing that Forever 21 began as a 900 square foot shop in Los Angeles in 1984 and by 2005 there were over 355 locations nationwide). Retail analysts estimate sales have grown to more than \$1 billion. Ruth La Ferla, *Faster Fashion, Cheaper Chic*, N.Y. TIMES, May 10, 2007, at G1, available at <http://www.nytimes.com/2007/05/10/fashion/10FOREVER.html>.

⁷ This Note will use the term "knockoff" to refer to the copying of design. Other authors use the term more rigidly to refer only to the copying of protected trademarks. See Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Designs*, 92 VA. L. REV. 1687, 1692 (2006). Counterfeiting refers to the field of trademark, not copyright. The Lanham Act defines a counterfeit mark as "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark." Lanham Act, 15 U.S.C. § 1127 (2000).

⁸ Plaintiffs include (in separate actions): Cover Design Inc., Unicolors Inc., Exact-Science Productions LLC, Anna Sui Corp., Bebe Stores Inc., Coast To Coast Fabrics Inc., Harajuku Lovers LLC, Diane von Furstenberg Studios LP, Sweet People Apparel Inc., M.M.P. Inc., and Soho Fashion Ltd. Diane von Furstenberg, famous for her wrap dress of the 1970s, is at the forefront of the attack on Forever 21, Congress, and even journalists who comment on the dangers of copyright protection for fashion designs. Angered by a Los Angeles Times editorial entitled "Fashion Copyright Cuts Creativity," von Furstenberg fought back with her own opinion piece, both critiquing the editorial and fervently standing in support of the Design Piracy Prohibition Act. See Editorial, *Copyright Hems and Haws: Trying to Protect Fashion Designs from Knockoffs Would Be Too Difficult and Would Smother Innovation*, L.A. TIMES, Aug. 15, 2007, at 18, available at <http://www.latimes.com/news/opinion/editorials/la-ed-fashion15aug15,0,5421470.story?coll=la-news-comment-editorials> (arguing that three fundamental flaws with the proposed legislation are "[f]irst, it would enable designers to claim copyrights over styles and features they didn't invent. There are only so many ways to design a T-shirt or a strapless dress, and chances are good that they've all been done already. Second, lawsuits would more likely target U.S. apparel makers than manufacturers in distant or undeveloped low-wage countries. Meanwhile, judges would become the arbiters of fashion innovations, deciding whether garments were sufficiently unique or excessively similar."). See Diane von Furstenberg, Opinion, *Fashion Deserves Copyright Protection*, L.A. TIMES, Aug. 24,

designer Diane von Furstenberg, has fought since 2006 for legislation that would provide copyright protection for fashion designs.

The major provisions of the Design Piracy Prohibition Act (DPPA), currently under consideration by the 110th Congress,¹⁰ would amend Chapter 13 of the Copyright Act to add protection for fashion designs¹¹ for a term of three years so long as the registration is filed with the Copyright Office within three months of the date that the design is first made public.¹² The bill would amend the infringement section of title 17, which currently provides a narrow exception to liability for acts without knowledge, so that one who has “reasonable grounds to know that protection for the design is claimed” will be held liable for infringement.¹³ The bill would increase recovery for

2007, available at <http://www.latimes.com/news/opinion/la-oev-furstenberg24aug24,0,1109807.story?coll=la-promo-opinion> (countering the Editorial by arguing, in part, that “[i]n legal terms, fashion designers are the poor relations of the creative world. Starving artists, struggling writers and independent filmmakers all at least own the rights to their work. Emerging designers, however, remain vulnerable to knockoff artists who can steal ideas straight off the runway and produce copies before the originals even reach stores. This can effectively put young designers out of business before they even have a chance.”).

⁹ See Council of Fashion Designers of America—About the CFDA, http://www.cfda.com/index.php?option=com_cfda_content&task=about_the_cfda_display (follow “About” hyperlink) (last visited Jan. 4, 2008) (“The Council of Fashion Designers of America, Inc. (CFDA) is a not-for-profit trade association of over 300 of America’s foremost fashion and accessory designers. Founded in 1962, the CFDA continues to advance the status of fashion design as a branch of American art and culture; to raise its artistic and professional standards; to define a code of ethical practices of mutual benefit in public and trade relations; and, to promote appreciation of the fashion arts through leadership in quality and aesthetic discernment. . . . [T]he organization is committed to nurturing the development of the American fashion industry’s future designers.”).

¹⁰ The House bill, H.R. 2033, is a reincarnation of a bill that was considered in the last House Session, formerly H.R. 5055. H.R. 2033 was introduced on April 25, 2007, by William Delahunt and co-sponsored by Mary Bono, Robert Goodlatte, Carolyn Maloney, Darrell Issa, and Diane Watson. This bill is currently in the first step of the legislative process and has yet to be scheduled for debate. On May 4, 2007, the bill was referred to the Subcommittee on Courts, the Internet, and Intellectual Property. See Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007), available at <http://www.govtrack.us/congress/bill.xpd?bill=h110-2033> (last visited Jan. 4, 2008). The Senate bill, S. 1957, was introduced on August 2, 2007, by Charles Schumer and co-sponsored by Hillary Clinton, Dianne Feinstein, Lindsey Graham, Orrin Hatch, Kay Hutchinson, Herbert Kohl, Olympia Snowe, and Sheldon Whitehouse. The Senate bill is also in the first step of the legislative process and has yet to be scheduled for debate. It has been read twice and referred to the Committee on the Judiciary. The two versions of the DPPA are almost in sync. The Senate bill, however, has added some extra language in (d), which relates to infringement. See Design Piracy Prohibition Act, S. 1957, 110th Cong. (2007), available at <http://www.govtrack.us/congress/bill.xpd?bill=s110-1957> (last visited Jan. 4, 2008).

¹¹ A fashion design refers to elements including the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment. See DAVID NIMMER, 1-2 NIMMER ON COPYRIGHT § 2.08 (2007).

¹² H.R. 2033.

¹³ *Id.* at § 2(d)(1). Secondary infringement and secondary liability would be actionable under the bill whereby a party could be held liable for infringement committed by another person’s infringing activity. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 419 (1984) (stating that the absence of express language in the Copyright Act rendering a person liable for infringement committed by another does not preclude the imposition of liability for copyright

infringement from “\$50,000 or \$1 per copy” to “\$250,000 or \$5 per copy.”¹⁴

Between press coverage of the suits against Forever 21¹⁵ and the DPPA,¹⁶ copyright protection for fashion designs has never been so hotly debated. The DPPA, if passed in its current form, would protect Marc Jacobs’ “Flocked Dot Dress” from the near exact replica by Forever 21. Because of copyright law’s broad view of what constitutes similarity in two works, the legislation threatens also to protect designs like the romper (whichever the original may be) despite the many differences in design including button and pocket placement as well as fabric. This result is problematic not only for companies such as Zara and H & M,¹⁷ which engage in loose design “referencing” by borrowing high fashion ideas and interpreting them for the masses, but also for high-end companies which have themselves engaged in design referencing for centuries.¹⁸

Critics of the proposed legislation are rightly skeptical of the potential effects of the DPPA. They argue, first, that the bill could

infringements on certain parties who have not themselves engaged in the infringing activity); *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005) (describing doctrines of secondary liability, which emerged from common law principles and are well established in the law, whereby one infringes contributorily by intentionally inducing or encouraging direct infringement and one infringes vicariously by profiting from direct infringement while declining to exercise a right to stop or limit it).

¹⁴ H.R. 2033 at § 2(g).

¹⁵ See Jen Carlson, *Forever 21’s New Unfashionable Suit*, GOTHAMIST, Oct. 2, 2007, http://gothamist.com/2007/10/02/forever_21.php (last visited Jan. 4, 2008); Liza Casabona, *Anthropologie Sues Forever 21*, WOMEN’S WEAR DAILY, Sept. 12, 2007, at 2; Liza Casabona, *Diane von Furstenberg Sues Forever 21 Over Copyright*, WOMEN’S WEAR DAILY, Mar. 28, 2007, at 3; Danica Lo, *Designer Sues ‘Evil’ Twin—Von Furious at ‘Copycat’*, N.Y. POST, Mar. 29, 2007, at 3; Lynn Yaeger, *Sui Generis?: Anna Sui, Others Sue Forever 21: How Original Are You?*, VILLAGE VOICE, Sept. 25, 2007, at 20, available at <http://www.villagevoice.com/nyclife/0739,yaeger,77905,15.html>.

¹⁶ See Serena French, *Knock it Off! Fashion Fights Back at Year of the Copycat; Counterfeit Counterattack*, N.Y. POST, May 1, 2007, at 41; Julian Sanchez, *Thou Shalt Not Knock Off*, THE AMERICAN, Sept. 14, 2007, available at <http://www.american.com/archive/2007/september-0907/thou-shalt-not-knock-off>; James Surowiecki, *The Piracy Paradox*, NEW YORKER, Sept. 24, 2007, at 90, available at http://www.newyorker.com/talk/financial/2007/09/24/070924ta_talk_surowiecki; Eric Wilson, *Before Models Can Turn Around, Knockoffs Fly*, N.Y. TIMES, Sept. 4, 2007, at 1 [hereinafter Wilson, *Turn Around*]; Eric Wilson, *Senate Joins Knockoff Battle*, N.Y. TIMES, Aug. 9, 2007, at 4.

¹⁷ See Lisa Marsh, *Don’t Call Them Knockoffs: Designer Looks, Low Prices*, MSN LIFESTYLE, <http://lifestyle.msn.com/BeautyandFashion/PersonalStyle/Article.aspx?cp-documentid=254945> (last visited Feb. 23, 2008) (interviewing Lisa Sandberg, director of communications and H&M who says “[i]t happens the same way at H&M that it does at the high fashion design houses Our team travels and analyzes trends around the world They go to exhibitions, different cultures, street fashion, history, trade fairs H&M’s team consists of 100 designers and 100 buyers who ensure the more than 1,100 stores in twenty-two countries have the right items, in the right colors and sizes for each market”).

¹⁸ See *infra* Part II.A.1 for a discussion on how deeply entrenched design referencing is in the fashion industry by both high-end and low-end companies.

potentially lead to a frenzy of litigation against alleged copyists, forcing defendants and courts to struggle with the unwieldy task of evaluating the “originality”¹⁹ of designs and, second, that copyright protection for designs will lead to a chilling effect in the industry, restraining companies such as H&M from borrowing design ideas in fear of litigation.²⁰ A chilling effect on the industry is a particularly harmful result since a primary purpose behind copyright law is to encourage innovation. This Note grapples with these two major problems presented by the proposed legislation and suggests that copyright legislation can be enacted in a way that avoids these problematic effects on the industry.

This Note argues that in order for copyright protection for fashion designs to be effective, courts must narrow the substantial similarity standard²¹ to fit the needs and peculiarities of the industry.²² Such an approach would address critics’ concerns about a chilling effect on the industry because only a much narrower category of defendants, those whose garments are more or less blatant copies, would be burdened with the task of researching the originality of fashion designs.

Part I of this Note will examine the purpose of copyright law, why fashion designs have historically been unprotected by copyright law, and why now is an appropriate time to reconsider the issue of copyright protection for fashion designs. The argument for a narrower standard would be moot without sufficient evidence that *some* form of copyright protection for fashion designs is necessary. Part II will demonstrate that

¹⁹ See *infra* Part I.A.2 for a detailed discussion of what constitutes originality in copyright law. For the purposes of this portion of the Note, it is only necessary to understand that in a copyright infringement action, a work is not protectable unless it meets a requisite standard of independent effort and creativity. A plaintiff will of course want to prove that his work is protectable whereas a defendant will try to prove that this design is in the public domain. In order to analyze the originality of a particular fashion design, it is necessary to research what, if any, works a particular garment is based on—an arduous task considering fashion’s long history and the repetition and recycling of fashion concepts.

²⁰ See *Legislative Hearing on H.R. 5055: “To amend title 17, United States Code, to provide protection for fashion design”*: *Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. (2006) [hereinafter *DPPA Hearings*] (statement of David Wolfe, Creative Director, Doneger Group), available at <http://www.publicknowledge.org/pdf/wolfe-testimony-20060727.pdf>.

²¹ The substantial similarity standard is the prevailing standard in copyright law. Before assessing whether two works are “substantially similar” as referred to throughout this Note, a court will initially look to whether the defendant copied plaintiff’s work, an analytical process which considers access to plaintiff’s work and similarity between the works. In the case that copying is found, the second question inquires whether that copying went so far as to constitute an improper appropriation. See *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946); 4-13 NIMMER, *supra* note 11, § 13.03; see also *infra* Part II.B.2.

²² This Note, on one hand, agrees with critics in the sense that the DPPA could produce the results that critics fear with a broad substantial similarity standard. On the other hand, the argument presented here is meant to respond to critics’ fears by suggesting that a “compromise” is available whereby designers are only protected from the most blatant knockoffs, avoiding the potentially harmful effects of copyright protection.

determining originality of a fashion design is a heavy burden to place on a defendant and leads critics to believe that the proposed legislation is impractical. Additionally, this section will describe how the substantial similarity standard, if applied to fashion, has the potential to create a chilling effect in the fashion industry which would decrease innovation—the reverse of what copyright protection should aim toward. Part III will examine how a narrower standard, similar to the consumer confusion standard in trademark law,²³ would eliminate the problems created by applying the substantial similarity standard to fashion designs and also impose a burden on the defendant only in cases where it seems reasonable for him to have to show that a plaintiff's work is not original (cases where his piece is essentially a replica of another designer's work).

I. TENSION BETWEEN THE NEED FOR AND THE PROBLEMS CREATED BY
COPYRIGHT PROTECTION FOR FASHION DESIGNS

A. *Why Fashion Designs Are not Copyrightable*

Article I, Section 8, Clause 8 of the U.S. Constitution, known as the Copyright Clause, empowers Congress “to promote the Progress of Sciences and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”²⁴ In deciding whether to enact copyright law, Congress must consider two issues: first, how much the legislation will stimulate the producer and benefit the public and, second, how much the monopoly granted will be detrimental to the public.²⁵ The 1976 Copyright Act protects “original works of authorship fixed in any tangible medium of expression.”²⁶ The statute goes on to list the eight categories of works of authorship: literary works; musical works;

²³ Courts consider a number of factors in determining whether a plaintiff has proven consumer confusion. Among the factors are the defendant's intent and actual confusion by consumers. See *Lyons P'ship v. Morris Costumes, Inc.*, 243 F.3d 789, 802 (4th Cir. 2001).

²⁴ U.S. CONST. art. I, § 8, cl. 8. All works protected under copyright law are considered “Writings” under the Constitution. Patent law protects “Discoveries.”

²⁵ ROBERT A. GORMAN & JANE C. GINSBURG, *COPYRIGHT: CASES AND MATERIALS* 14 (7th ed. 2006) (“Although the primary purpose of copyright law is to foster the creation and dissemination of intellectual works for the public welfare, it also has an important secondary purpose: To give authors the reward for their contribution to society. These two purposes are closely related. Many authors could not devote themselves to create work without the prospect of remuneration. By giving authors a means of securing the economic reward afforded by the market, copyright stimulates their creation and dissemination of intellectual works.” (quoting STAFF OF H. COMM. ON THE JUDICIARY, 84TH CONG., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 3-6 (1961))).

²⁶ 17 U.S.C. § 102(a) (2006).

dramatic works; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and audiovisual works; sound recordings; and architectural works.²⁷ Because fashion designs do not fall into any of these categories, they are not copyrightable. The DPPA would change this by extending “pictorial, graphical, and sculptural works” to include fashion designs.

1. The “Useful Articles” Doctrine

The “useful articles” doctrine, historically considered an obstacle in providing copyright protection for fashion designs,²⁸ is not a substantial barrier that will cause problematic effects in enacting copyright legislation. Fashion designs currently do not fall under the category of pictorial, graphic, or sculptural works because of the “useful articles” doctrine. A “useful article” is an article that has an intrinsic utilitarian function.²⁹ The Copyright Act states that the design of a useful article is only considered a “pictorial, graphic, [or] sculptural work[.]” insofar as the design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspect of the article.³⁰ The “useful articles” doctrine expresses Congress’ desire to limit the ability of manufacturers to monopolize designs dictated solely by the article’s function.³¹ While clothing is valued for its aesthetic, decorative function, it serves a utilitarian function as well.

Courts that have applied this standard have consistently focused on whether an element, physically or conceptually, can be identified as separable from the functional purpose that it serves in determining whether an item may be copyrighted.³² As the Seventh Circuit noted in

²⁷ *Id.*

²⁸ See Jennifer Mencken, *A Design for the Copyright of Fashion*, 1997 B.C. INTELL. PROP. & TECH. F. 121201, ¶ 2.

²⁹ 17 U.S.C. § 101 (2006) (defining a “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally part of a useful article is considered a ‘useful article.’”).

³⁰ *Id.* (“[W]orks of artistic craftsmanship *insofar as their form but not their mechanical or utilitarian aspects are concerned*; the design of a useful article . . . 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.*” (emphasis added)).

³¹ Anne Theodore Briggs, *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, 24 HASTINGS COMM. & ENT. L.J. 169, 181 (2002).

³² GORMAN & GINSBURG, *supra* note 25, at 230 (“Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrightable under the bill.” (quoting H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* U.S.C.C.A.N. 5659, 5668)).

2004, the language used by Congress is not the language of a bright-line rule; rather, it provides only general policy guidance to be implemented on a case-by-case basis by the courts.³³ As a result, circuits vary in the tests used to determine conceptual separability.³⁴ Certain features of fashion design such as belt buckles,³⁵ lace accenting,³⁶ and sweater embroidery and artwork³⁷ have passed the separability test.

The courts have been reluctant to take steps toward allowing fashion designs to meet the conceptual separability test, which is why it is necessary for the legislature to step in.³⁸ Susan Scafidi, Visiting Professor at Fordham Law School and supporter of the legislation, argues that modern attitudes toward fashion design have changed dramatically.³⁹ She points out the distinction between “clothing,” a term for “articles of dress that cover the body,” and “fashion,” a form of creative expression.⁴⁰ If fashion were driven by utility, she says, people would simply wear clothes until they fell apart or no longer fit.⁴¹ The range of designs each season and, ironically, the production of copies of

³³ See *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 921 (7th Cir. 2004) (holding that a mannequin, designed to imitate the “hungry look” of high-fashion, runway models, was meant to be seen and admired and, because it was the product of a creative process unfettered by functional concerns, its sculptural features “can be identified separately from, and are capable of existing independently of” its utilitarian aspects, meeting the conceptual separability test).

³⁴ *Pivot Point* sets out the variety of tests that the Second Circuit has adopted in the past. In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, the court first grappled with the issue and settled on a primary/subsidiary test. Under this test, if the ornamental, aesthetic elements of a work are primary and the functional elements are subsidiary, then the work is copyrightable. 632 F.2d 989, 993 (2d Cir. 1980). Next, in *Carol Barnhart v. Economy Cover Corp.*, the court looked to whether the aesthetically pleasing features can be conceptualized as existing independently of their utilitarian function. 773 F.2d 411, 418 (2d Cir. 1985). Finally, in *Brandir Int'l, Inc. v. Cascade Pacific Lumber Corp.*, the Second Circuit again addresses the issue and adopts a test put forth by Professor Denicola in a law review article. This test looks to the extent to which the work reflects artistic expression uninhabited by functional considerations. 834 F.2d 1142, 1145 (2d Cir. 1987) (“[W]here design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”).

³⁵ See *Kieselstein-Cord*, 632 F.2d 989 (holding that the belt buckles in question were conceptually separable sculptural elements and are worn as ornamentation for parts of the body other than the waist).

³⁶ See *Eve of Milady v. Impression Bridal*, 957 F. Supp. 484 (S.D.N.Y. 1997); *Express, LLC v. Fetish Group, Inc.*, 424 F. Supp. 2d 1211 (C.D. Cal. 2006).

³⁷ See *Segrets, Inc. v. Gillman Knitwear Co.*, 207 F.3d 56, 60 (1st Cir. 2000) (failing to dispute district court’s finding that sweater embroidery is entitled to copyright protection); *Knitwaves v. Lollytogs, Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995) (holding that fabric design, such as the artwork on plaintiff’s sweaters, is copyrightable).

³⁸ *DPPA Hearings*, *supra* note 20 (statement of Susan Scafidi, Professor, Fordham Law School).

³⁹ *Id.* (stating that “[i]nstitutions from the Smithsonian to Sotheby’s take fashion seriously, and organizations like the National Arts Club and the Cooper-Hewitt National Design Museum have recently added fashion designers to their annual categories of honorees. . . . It is inconsistent with this cultural shift for copyright law to deny fashion’s role as an artistic form”).

⁴⁰ *Id.*

⁴¹ *Id.*

those designs, demonstrate that designers are engaged in more than utility. They are producing creative works.⁴²

Congress has illustrated the malleability of the rule by altering it to provide design protection for architecture⁴³ which, like apparel, embodies original designs and yet performs a utilitarian function.⁴⁴ In addition, Congress has provided copyright-like protection outside the Copyright Act for useful articles in the cases of vessel hulls and semiconductor chips.⁴⁵ The DPPA is an effort to extend this same copyright-like protection to fashion designs.⁴⁶ While the useful articles

⁴² *Id.*

⁴³ See Raustiala & Sprigman, *supra* note 7, at 1751. In 1990, Congress amended the Copyright Act to extend protection to architectural works by enacting the Architectural Works Copyright Protection Act (“AWCPA”). Raustiala and Sprigman argue that in the case of architectural works, Congress has erased the traditional presumptions of the useful articles doctrine as it applies to a building’s design. The same move applied to fashion would result in broad copyright protection for original designs. *Id.* However, it is important to recognize that in enacting AWCPA, Congress was attempting to abide by the terms of an international convention of which it was a member. In the 1980s, the United States became a member of the Berne Convention for the Protection of Literary and Artistic Works, which forced a reassessment of the conception of architecture as a utilitarian work under U.S. copyright law. To comply with the Berne Convention, copyright law would have to be amended to recognize the artistic value of architecture by extending copyright protection to architectural works. See Raphael Winick, *Copyright Protection for Architecture after the Architectural Works Copyright Protection Act of 1990*, 41 DUKE L.J. 1598, 1602-03 (1992).

⁴⁴ Raustiala & Sprigman, *supra* note 7, at 1750.

⁴⁵ *Id.* at 1751.

⁴⁶ During the Hearings before the Subcommittee on Courts and Intellectual Property with regard to the Vessel Hull Design Protection Act, the issue of similar protection being extended to fashion designs was discussed by House Representative Howard Coble, Donald Cramer, Corporate Counsel for Bayliner Marine Corporation, and J.J. Marie, President of Zodiac of North America, supplier of boats and related safety equipment:

Mr. CANNON: . . . Could you spend a few minutes trying to distinguish your industry for me from any other industry that needs—that might want this kind of protection, but doesn’t need it the way your industry does?

Mr. CRAMER: This is Don Cramer. I think our industry is a little unique in one sense, that we’re making very large-ticket items, and there is innovation in our industry, and these boats are all unique. We can tell what are the copies. We’re also unique in the very low investment cost to get into copying our product. And so it’s kind of a funny set of facts, but it is so easy, so inexpensive, to get into this business. If you’re going to invent a new bicycle, perhaps you have a higher startup cost. You have large investments. Whereas, in the boat business, copying is so common that it’s done every day.

Mr. CANNON: The other industry that comes to mind, when you think of copying, of course, is fashion design. Wouldn’t you suggest that we include something like fashion design, or are you sufficiently different from that that we shouldn’t?

Mr. CRAMER: I think we’d be substantially different than that, but perhaps there would be situations where fashion designers would come in with new, unique, visually-recognizable designs that perhaps they should be entitled to some protection also.

. . . .

MR. MARIE: May I—if I could make one comment—for example, comparing us to the fashion industry. I think one major difference is safety. My wife may not agree with that, but safety is a very big factor, which of course wouldn’t apply to other industries. I would also mention, speaking for most of us, we certainly have no

doctrine seems like a restraint in obtaining copyright protection for fashion designs, Congress would certainly not be overstepping its bounds by providing protection for useful articles as it has done before, especially given the strong arguments suggesting that fashion is just as much art as it is utility.⁴⁷ The fact that fashion designs are useful articles, moreover, would not pose any practical problems or challenges if copyright legislation were enacted.

2. Originality and Derivative Works

The concept of originality in fashion, unlike the useful articles doctrine, has the potential to create significant practical problems for courts and the fashion industry if designs are protected by copyright legislation. The originality requirement⁴⁸ in copyright does not demand that an author produce a work of recognized artistic merit; it is enough for the author to refrain from copying prior works and contribute more than a minimal amount of creativity.⁴⁹ The work created must be independently created by the author and not copied from other works.⁵⁰ Therefore, a work is original and may command copyright protection even if it is completely identical to a prior work, as long as it was not copied from that work but is, rather, a product of the independent efforts.⁵¹

A “derivative work” is a work that substantially copies a prior work but, at the same time, modifies or adds to the prior work in some way.⁵² In order for a derivative work to receive its own copyright protection, the copyright owner of the prior work must grant permission to the creator of the derivative work.⁵³ This new derivative work must satisfy an originality requirement that is more stringent than the

objections to other industries getting the protection. Obviously, we represent our industry and can't speak for what others may not want.

Copyright Protection for Vessel Hulls: Hearing Before the Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary, 105th Cong. (1997).

⁴⁷ *DPPA Hearings*, *supra* note 20 (statement of Susan Scafidi, Professor, Fordham Law School).

⁴⁸ 17 U.S.C. § 102(a) (2006) (“Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression.”).

⁴⁹ See GORMAN & GINSBURG, *supra* note 25, at 39.

⁵⁰ See 1-2 NIMMER, *supra* note 11, § 2.01 (Nimmer points to a quotation from Justice Holmes, who succinctly states that “if by some magic a man who had never known it were to compose anew Keats’ Ode On a Grecian Urn, he would be an ‘author,’ and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats.” (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936)).

⁵¹ *Id.*

⁵² See 1-3 NIMMER, *supra* note 11, §3.01.

⁵³ 17 U.S.C. § 103(a) (2006). If the work has already fallen into the public domain, no permission is necessary to create a derivative work.

requirement for a work that is not a derivative. In transforming the prior work, a substantial variation from the prior work is required.⁵⁴ The derivative work can be protected only to the extent that new material is added to the prior work.⁵⁵

One concern regarding the DPPA as it stands is that the lack of originality in fashion makes copyright protection a poor fit⁵⁶ and that drawing the line between inspiration and copying will lead to an increase in litigation.⁵⁷ Originality in fashion, critics say, is questionable since designers are explicitly influenced by so many sources and it is difficult to determine what is “original” about a particular fashion design.⁵⁸ While advocates of the copyright legislation argue that originality in fashion does exist,⁵⁹ they have not addressed the practical difficulty that companies, attorneys, and courts would face in assessing the originality requirement.

B. *The Current Climate: Why Reevaluate Copyright Protection Now?*

1. Unrest in the Fashion Community Despite Limited IP Protection

Trademark protection does not extend in scope to fashion designs.⁶⁰ “Trade dress,” a subsection of trademark law, can protect the

⁵⁴ *Sherry Mfg. Co. v. Towel King of Fla., Inc.*, 753 F.2d 1565, 1568 (11th Cir. 1985) (“It is well settled that in order to qualify for a separate copyright, the derivative work must contain some substantial, and not merely trivial, originality.” (citing *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 34 (2d Cir. 1982))).

⁵⁵ 17 U.S.C. § 103(b) (2006) (“The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the pre-existing material employed in the work, and does not imply any exclusive right in the pre-existing material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the pre-existing material.”).

⁵⁶ See *DPPA Hearings*, *supra* note 20 (statement of David Wolfe, Creative Director, Doneger Group).

⁵⁷ See *id.* (statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law).

⁵⁸ See Yaeger, *supra* note 15.

⁵⁹ See *DPPA Hearings*, *supra* note 20 (statement of Susan Scafidi, Professor, Fordham Law School).

⁶⁰ With copyright protection in fashion being very limited, trademark protection is perhaps the most significant form of IP protection utilized in fashion. The Lanham Act of 1946 defines a trademark as “any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.” Lanham Act § 45 (codified at 15 U.S.C. § 1127 (2006)). One example of a protected trademark, and one of the most frequently imitated, is Louis Vuitton’s “Toile Monogram,” which consists of “entwined LV initials with three motifs—a curved diamond with a four-point star inset, its negative, and a circle with a four-leafed flower inset.” See *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415, 424 (S.D.N.Y. 2004); Sarah J. Kaufman, *Trend Forecast: Imitation Is a Legal Form of Flattery—Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 23 CARDOZO ARTS & ENT. L.J. 531 (2005) (discussing

design of a product.⁶¹ However, in *Wal-Mart v. Samara*,⁶² the Supreme Court considered trade dress in the context of a children's seersucker outfit, essentially foreclosing the possibility of trade dress protection extending to fashion designs.⁶³ The court held that, to gain protection, one must establish "secondary meaning,"⁶⁴ whereby the public is able to determine the source of the product by looking at the design. However, this is a near impossible feat because of the rapid nature of the fashion cycle and the unlikelihood that designers are able to associate a particular design with a particular designer.⁶⁵ As a result, trademark protection fails to provide sufficient protection for fashion designs.

Despite a designer's limited copyright protection over the print design of fabric,⁶⁶ designers have mobilized to display dissatisfaction

tensions and nuances between trademark infringement and acceptable knockoffs). This form of trademark law, while providing effective protection for those products that do feature symbols, does not protect the design of a fashion work.

⁶¹ See *Two Pesos v. Taco Cabana*, 505 U.S. 763, 764 n.1 (1992) ("[Trade dress] 'involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.'" (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983))); Lanham Act § 43(a) (codified at 15 U.S.C. § 1125(a)(1) (2006) (providing that "[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact [shall be liable]")). Protection under the Lanham Act is provided in a trade dress infringement claim when the trade dress is not functional, a likelihood of confusion exists as to the source of the competing products, and the trade dress is distinctive. See *Two Pesos*, 505 U.S. 763.

⁶² See 529 U.S. 205, 216 (2000) (holding that "in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product's design is distinctive, and therefore protectable, only upon a showing of secondary meaning").

⁶³ See Briggs, *supra* note 31, at 200 (assessing the applicability of trademark law to the protection of fashion designs and arguing that "[t]he Supreme Court's *Wal-Mart* decision puts trade dress for clothing in a highly suspect position").

⁶⁴ See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 ("To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.>").

⁶⁵ See Briggs, *supra* note 31, at 199 (explaining that "[t]he short-lived nature of most clothing designs make a showing of secondary meaning nearly impossible and thus most clothing designs will fail to qualify for trade dress protection. Consumers are very unlikely to be able to attribute a particular clothing design to a particular clothing designer, without the aid of trademarks, labels or a substantial advertising campaign").

⁶⁶ A print design, such as a rose petal, may appear repeatedly throughout the dress fabric or only once on a given garment. See *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960) (upholding preliminary injunction forbidding the alleged infringer to copy and ornamental design printed upon cloth); *Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484, 489 (S.D.N.Y. 1997) (stating that fabric designs "are considered 'writings' for purposes of copyright law and are accordingly protectable" (quoting *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d, 996, 1002 (2d Cir. 1995))). Under an earlier view, fabric designs were not regarded as copyrightable. See *Kemp & Beatley, Inc. v. Hirsch*, 34 F.2d 291, 292 (E.D.N.Y. 1929) ("The protection of productions of the industrial arts utilitarian in purpose and character, even if artistically made or ornamented depends upon action under the patent law Toys, games, dolls . . . embroideries, garments, laces, woven fabrics, or similar articles are examples. The exclusive right to make and sell such articles should not be sought by copyright registration."). However, under doctrines of physical and conceptual separability, such designs are copyrightable

with the current state of copyright protection in the fashion industry like never before. The recent onslaught of copyright litigation pertains to the print design of garments. On April 12, 2007, Diane von Furstenberg (DVF) filed a copyright infringement suit against Forever 21 over three garments that consisted of a total of four registered print designs exclusively owned by DVF.⁶⁷ DVF registered each of these print designs with the U.S. Copyright Office, an act which provides prima facie evidence of copyrightability. Although the case settled in September 2007, it is unclear how the case would have turned out at trial.⁶⁸ What is clear, however, is that DVF had an actionable claim for infringement of her print design even without copyright protection for her designs under the DPPA. Proving access to the garments would be fairly straightforward as would substantial similarity between the garments, as Forever 21 created nearly indistinguishable knockoffs immediately after DVF's garments hit the market.⁶⁹ The burden would be on Forever 21 to rebut the presumption that the design patterns were original.

DVF and Anna Sui,⁷⁰ another fashion designer, despite having actionable suits against alleged infringers, are seemingly dissatisfied with the state of the law because it only offers protection for the very

under current law. See discussion of useful articles, *supra* Part I.A.1; see also 1-2 NIMMER, *supra* note 11, § 2.08.

⁶⁷ The allegedly copied designs were the "Cerisier" dress which consists of the "Small Dentelle" and the "Flower Lace Border" designs; the "Aubrey" dress which bears a print design called "Mimosa"; and the "Edith" blouse which bears a print design by DVF called "Scattered Stones." The suit also included actions for unfair competition and false designation of origin in violation of 15 U.S.C. § 1125(a) (2006), unlawful and deceptive acts and practices in violation of N.Y. GEN. BUS. LAW § 349 (McKinney 2008), and unfair competition under New York state law. Complaint at 5-9, *Diane von Furstenberg Studio, LP v. Forever 21, Inc.*, No. 07-cv-2413 (S.D.N.Y. Mar. 23, 2007), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2007cv02413/302881/1/0.html>. These actions are beyond the scope of this Note and will not be discussed.

⁶⁸ Letter from Scott Gelin & Peter S. Sloane to Judge Victor Marrero, *Diane von Furstenberg Studios, LP v. Forever 21, Inc.*, No. 07-cv-2413 (S.D.N.Y. Oct. 5, 2007), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2007cv02413/302881/22/>. Anna Sui likewise filed suit against Forever 21 on June 26, 2007, for copyright infringement of at least seventeen of Sui's print designs. This case is still pending; and it will be interesting to see whether the parties make it to trial. Like von Furstenberg, Sui's print designs are registered and there is law that protects her in this situation. The complaint mentions that "Defendants' intention to infringe is beyond question. Even in the instance of less copyrightable designs, Defendants have sought out Sui designs to reproduce for their stores." Complaint at 11, *Anna Sui Corp. v. Forever 21, Inc.*, No. 07-cv-3235 (S.D.N.Y. Apr. 23, 2007).

⁶⁹ See *Diane von Fostenburg Sues Forever 21*, NITRO-LICIOUS, <http://www.nitrolicious.com/blog/2007/03/28/diane-von-furstenberg-sues-forever-21/> (last visited Sept. 12, 2008) for images of the "Cerisier" and "Aubrey" dresses.

⁷⁰ Sui moved to New York in the 1970s to attend Parsons School of Design. After two years at Parsons, Anna styled with friend Steven Meisel and designed for several sportswear companies before launching her first collection in 1980. Today, Anna Sui has 32 boutiques in five countries, and her collection is sold in 300 stores in over 30 countries. See *Anna Sui Biography*, <http://www.annasui.com/bio/> (last visited Jan. 4, 2008).

limited number of garments that contain print designs. They have not been shy over the past year, with DVF responding by publishing responses to articles criticizing the legislation,⁷¹ and Sui distributing gift bags at her Spring '08 fashion show with T-shirts depicting Forever 21 owners on a Wild West-style poster describing them as "Forever Wanted" and carrying the phrase "Thou Shalt Not Steal."⁷² While both cases were filed in 2007, some of the print designs that are the source of litigation were shown publicly by the designers as early as 2004.⁷³ Since a previous version of the DPPA was considered in the last Congressional term, a slew of others in the fashion world have joined their cause in support of the legislation.⁷⁴ This is at the very least evidence that frustration within the field exists, possibly now more than ever before.

2. Fashion Cycle Undercut by Copies: The Limited Scope of Induced Obsolescence

In an environment where copyists are undercutting sales of designers who produce original work, copyright protection for designers is necessary to stimulate designers to produce without fear that their hard work will go unrewarded. While well-known designers such as DVF and Sui are perhaps best able to grab media attention and mobilize support for the legislation, copying has an effect on the "little guys" as well.⁷⁵ Supporters of the DPPA argue that the Internet era calls for new

⁷¹ See *supra* notes 10-18 and accompanying text. Von Furstenberg also responded to James Surowiecki's September 24, 2007, article in the *New Yorker*.

⁷² Yaeger, *supra* note 15.

⁷³ DVF first showed the "Aubrey" dress, bearing the print design called "Mimosa," in September 2005 at its Spring 2006 show and began selling the dress in Winter 2006. Complaint at 5-6, *Diane von Furstenberg Studio, LP v. Forever 21, Inc.*, No. 07-cv-2413 (S.D.N.Y. Mar. 23, 2007). Sui's "Battenburg Embroidery" print design was created in 2004. Complaint at 10, *Anna Sui Corp. v. Forever 21, Inc.*, No. 07-cv-3235 (S.D.N.Y. Apr. 23, 2007).

⁷⁴ Supporters of the legislation include DVF, Sui, Zac Posen, Tim Gunn, Narciso Rodriguez, Marc Bouwer, and Nicole Miller. For a more extensive list, see Press Release, Council of Fashion Designers of Am., *CFDA Applauds Introduction of Design Piracy Prohibition Act to U.S. Senate* (Aug. 8, 2007), available at http://www.cfda.com/index.php?option=com_cfda_content&task=news_display_all.

⁷⁵ Susan Scafidi responds to the question of how smaller designers are negatively affected by design copying in a question and answer session:

Felix Salmon: . . . But which designers, exactly, suffer from being copied? If an emerging designer with a tiny showroom gets copied by a massive High Street chain like Forever 21, does that really mean the designer will sell fewer original designs? Are you quite sure that Narciso Rodriguez would have sold more than 45 wedding dresses were it not for the fact that his design had been copied? And if internet time is of the essence in such cases, how would a slow and lumbering copyright-infringement lawsuit help anybody? By the time it was decided, would it not be too late for all concerned?

. . . .

strategies to protect creativity.⁷⁶ Because high-quality images from fashion shows are online within a day, copyists no longer have to smuggle sketch artists into fashion shows.⁷⁷ This convenient access allows knockoffs to appear in stores months before the designer version whereas years ago the copyist's production time would have at least slowed down this process.

Critics of the legislation emphasize that the traditional fashion cycle has allowed copyists' products to reach stores around the same

Susan Scafidi: . . . The designers who suffer from copying are the little guys—those whose designs are copied, while their trademarks are not. Consider the accessories designer who received an order for a belt from a large department store—only to have the store place its larger reorder with a cheaper manufacturer. Or how about the jeweler whose work was admired by a buyer at a trade show and hoped for a sale, only to open the large company's catalog months later and see an exact copy of her design? Maybe the dress designer who saw her dress praised in an online forum, only to have the next post recommend buying an exact knockoff elsewhere—followed by thanks for the “tip”? Perhaps you'd be convinced by the handbag designer who actually received a wholesale order, only to have it canceled a few days later because the buyer found an exact copy of her original design elsewhere at a lower price? The stories are common ones, but these are not hypothetical examples. These are real people, some of whom prefer not to be named. They have invested time, money, and talent—R&D to any other industry—in realizing their visions, only to have their work stolen, often by huge companies. You would recognize many of the names of the corporate copyists; I doubt that most readers would ever have heard of the startup designers.

. . . .
The benefit of the Design Piracy Prohibition Act is not just that it would give Narciso and many lesser-known designers a cause of action. It's that it would change the behavior of the large companies who stalk the runway and the red carpet, waiting to copy everyone's favorite look

Felix Salmon, *Market Movers: Susan Scafidi on Copyrighting Fashion*, CONDE NAST PORTFOLIO, Sept. 19, 2007, available at <http://www.portfolio.com/views/blogs/market-movers/2007/09/19/susan-scafidi-on-copyrighting-fashion> (last visited Feb. 20, 2008).

⁷⁶ See *DPPA Hearings*, *supra* note 20 (statement of Susan Scafidi, Professor, Fordham Law School)

⁷⁷ *Id.* In the 1940s and 1950s, sketch artists were oftentimes banned from fashion shows of rival designers. Seema Anand's company, Simonia Fashions, makes less expensive clothes inspired by other designers' runway looks. Wilson, *Turn Around*, *supra* note 16, at A1. In describing her process, Anand says that once she sees something on Style.com, all she has to do is e-mail the picture to her factory and say that she wants something “similar” or a silhouette made “just like this” and the factory in Jaipur, India, can deliver a knockoff to stores months before the designer version is available to shoppers. *Id.* Anand's factory is one of many that can deliver versions of runway styles as soon as a month after an order is placed. See William Echikson, *The Fashion Cycle Hits High Gear*, BUSINESSWEEK, Sept. 18, 2000, at 66, available at http://www.businessweek.com/2000/00_38/b3699071.htm (describing how Zara has turned the traditional fashion cycle on its head by moving a new design from pattern to store in two weeks rather than six months: “A store manager sends in a new idea to La Coruna headquarters. The 200-plus designers decide if it's appealing, then come up with specs. The design is scanned into a computer and zapped to production computers in manufacturing, which cut the material needed to be assembled into clothes by outside workshops. The manufacturing plant is futuristic, too, stuffed with huge clothes-cutting machines that are run by a handful of technicians in a laboratory-style computer-control center.”).

time as the original runway designs for many years.⁷⁸ Because of the traditional four to six month lag between fashion shows and distribution to retailers, critics argue that despite any increases in production speed over the past twenty-five years, copyists have always benefitted from this lag.⁷⁹ Two scholars, Karl Raustiala and Christopher Sprigman,⁸⁰ are skeptical of the argument that the advent of nearly instantaneous copying has a negative effect on designers.⁸¹ They say that the empirical difficulty with this argument is that by the mid-1980s, when fax machines became widely available, the original creator had already lost the ability to make a profit before the copyist could produce copies.⁸² They also argue that since legislation has been proposed and has failed since well before the internet or the fax, there is no necessary connection between technological enhancements and efforts at legislative change.⁸³ Lastly, the critics see a conceptual problem—that copyists have an incentive to delay copying to see which designs resonate with the fashion elite and copy only the popular designs.⁸⁴

Raustiala and Sprigman make a convincing point—that certain copyists are incentivized to wait and see which looks will be popular

⁷⁸ The high-fashion industry observes the traditional calendar of two seasons a year—Spring/Summer and Fall/Winter. SUE JENKYN JONES, *FASHION DESIGN* 29 (2002). Milan, London, Paris, and New York each have about a week of runway shows (“Fashion Week”) during these two seasons. Two popular websites that feature fashion shows from each major city in addition to criticism and commentary of many of the lines are <http://www.style.com/fashionshows> and <http://nymag.com/fashion/fashionshows/>. The Spring/Summer collections usually start showing during fashion week in the second week of September and this line is delivered to stores the following January. The Fall/Winter collection shows in March and is delivered to stores in early September just as the following Spring/Season shows begin. See *id.* at 30 for the fashion calendar.

⁷⁹ Raustiala & Sprigman, *supra* note 7, at 1759-60 (“For the last quarter-century (at a minimum) the copying of fashion designs has been easy and fast. The use of ordinary photos and sketches and transcontinental air travel allows copyists to begin work on a design copy within days of photographing or sketching the original. The advent of fax machines made the process even faster. An increasingly nimble global manufacturing and shipping capacity, which allows products to move swiftly from manufacturing site to market, coupled with the rise of the Internet and digital design platforms, may have reduced any remaining gap between originators and copyists to near zero.”).

⁸⁰ Raustiala and Sprigman’s article has received much attention from the press since its publication in December 2006. Many non-academics in the press seem to agree with their criticisms of the DPPA; however, no criticism of the legislation is quite as in-depth, academic, or persuasive as Raustiala and Sprigman’s and, for this reason, this Note refers to their analysis a great deal. Their main argument in *The Piracy Paradox* is that copying fails to deter innovation in the fashion industry because, counter-intuitively, copying is not very harmful to originators. They use the phrase “piracy paradox” to describe how copying promotes innovation and benefits originators. See *id.* at 1691.

⁸¹ See *id.*

⁸² See *id.* at 1759 (describing “First-Mover Advantage” as the advantage that an originator of fashion designs can achieve if he is able to sell many units, gain a large share of revenues for his designs and make back investment plus profit before copyists produce copies).

⁸³ *Id.*

⁸⁴ *Id.* at 1761-62.

before knocking them off. This is likely true of designers such as Allen Schwartz of A.B.S., a label that copies red carpet gowns as seen on celebrities.⁸⁵ While Schwartz may be the most infamous, he is not the only one.⁸⁶ According to NDP Group, a market research group which tracks apparel sales, red-carpet knockoff dresses are holding steady in sales at around \$300 million per year.⁸⁷ These knockoff companies wait for the “reliable hit-makers,” such as Jennifer Aniston, Nicole Kidman, and Lindsay Lohan, to wear a dress before creating their own significantly cheaper version.

The existence of this type of knockoff, the type that waits for the original to be available first, is a requisite for Raustiala and Sprigman’s model of induced obsolescence. To summarize, this model suggests that design copying results in the pricing-in of consumers who would not be able to consume the original design.⁸⁸ As a particular style becomes popular to the masses, the original design becomes less attractive to fashion forward, early adopters of the trend.⁸⁹ Designers must respond to those fashion forward consumers who are quickly, as soon as the design has spread to the masses, ready for something new—essentially speeding up the fashion cycle and encouraging consumerism.⁹⁰ An example that Raustiala and Springman provide, to show the quick ascent and descent of a fashion item, is the Ugg boot, which became popular in 2003 but by August 2004 was described by commentators as a “human rights violation.”⁹¹ While the basic

⁸⁵ Ironically, a Google search of “A.B.S. by Allen Schwartz” produces the website www.absstyle.com with the following description: “Original fashionable clothes for sophisticated young woman [sic].” (emphasis added). Sheila Marikar, *Designers Fight Knockoffs*, ABCNEWS, Sept. 15, 2006, <http://abcnews.go.com/Business/Story?id=2442802&page=1> (quoting Schwartz as saying, “[I]f i [sic] have a ruffled dress like the one that Debra Messing wore and I have it for \$300 why shouldn’t I show that? People love that . . . There’s no such thing as an original idea, and [designers are] just looking for a forum to get together and have cocktails.”); see Lynn Yaeger, *Post-Oscars, the Knock-Off Crowd Gets Busy, and the Debate over Copies Crops Up Again*, VILLAGE VOICE, Mar. 8, 2008, at 12, available at <http://www.villagevoice.com/news/0810,351213,351213,2.html>.

⁸⁶ Others include Edressme.com, created by Joanna Stoner, and Dresses.com by Tor Sweeney. Ruth La Ferla, *Night of a Thousand Knockoffs*, N.Y. TIMES, Mar. 9, 2006, at G11, available at <http://www.nytimes.com/2006/03/09/fashion/thursdaystyles/09KNOCKOFFS.html?ex=1299560400&en=0d831b94ef00b6fe&ei=5088&partner=rssnyt&emc=rss>. Marshal Cohen, chief retail analyst for NDP, said in 2006, “Three years ago I would be lucky if I could find a dozen manufacturers doing this. Now it is well over a hundred.” *Id.*

⁸⁷ *Id.*

⁸⁸ Raustiala & Sprigman, *supra* note 7, at 1722-24.

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.* at 1721-22. The fleece-lined Ugg has been around for 30 or so years. By the end of 2003, celebrities including Oprah Winfrey, Kate Hudson, Sarah Jessica Parker, Cameron Diaz, and Sandra Bullock were all fans of the boot. Retailers were sold out of the boot before the start of the holiday shopping season in late 2003. As one article reported, “Celebrity-driven trends often take off fast, leaving retailers scrambling to exploit them, but about the only place you’ll

principles of this model are convincing, it does not account for those knockoffs that are not based off the successful red carpet looks.

Raustiala and Sprigman do not give enough credit to copyists or the designers they copy. The authors assert that if copyists do not wait to see what sells in the market, they are forced to guess which garment they ought to copy.⁹² However, companies such as Forever 21 have proven that they are, in fact, willing to take this risk. This second category of copyist is able to sell the knockoffs before the originals are available.⁹³ In doing so, they prevent the cycle of induced obsolescence from occurring because, by the time the knockoffs are worn by the masses, the design has lost its appeal to the elite who would otherwise have purchased the original design. Thus, while some knockoffs, those described by Raustiala and Sprigman's model, do not necessarily cause harm to creators of the original high-end designs, other designers, whose sales are completely undercut by copyists such as Forever 21, have a convincing argument that copyists cause them a great deal of harm. The challenge is to find a way to protect designers from this harm through copyright legislation, all the while preventing the negative consequences of an abundance of litigation and a chilling effect on the industry.

II. PROBLEMS CREATED BY APPLYING THE SUBSTANTIAL SIMILARITY STANDARD TO FASHION

A. *Struggling with Originality in Fashion Design*

David Wolfe of the Doneger Group,⁹⁴ one of the four experts to testify during the legislative hearings on H.R. 5055, argues that finding and defining originality in fashion is an extremely difficult if not impossible task since all designers feed off the same information and

find these \$90-to-\$185 boots is the gotta-have-it last resort: eBay (though bids for the popular pink have approached \$400 in some cases).” Retailers, the article reported, would not be able to get their hands on more Uggs until February at the earliest and as late as June for the most popular styles and colors. Lorrie Grant, *UGG Boots a Fashion Kick*, USA TODAY, Dec. 11, 2003, at 03B, available at http://www.usatoday.com/money/industries/retail/2003-12-10-ugg_x.htm; see Fashionista, <http://fashionista.com/cgi-bin/mt/mt-search.cgi?IncludeBlogs=6&search=Ugg> (last visited Jan. 4, 2008) (“Let’s face it, if it’s after noon and you’re wearing Uggs in public, you should either be in middle school, pregnant, or walking in the snow. But on a day like today, when it’s cold but not frosty, there’s really no excuse. Maybe we should look at some alternatives.”).

⁹² Raustiala & Sprigman, *supra* note 7, at 1761-62.

⁹³ See Wilson, *Turn Around*, *supra* note 16.

⁹⁴ See The Doneger Group, <http://www.doneger.com/web/231.htm> (last visited Jan. 4, 2008) (describing The Doneger Group as “the leading source of global market trends and merchandising strategies to the retail and fashion industry”).

inspiration and, hopefully, interpret it in their own unique way.⁹⁵ It is difficult to see how fashion differs in this respect from other fields protected by copyright, such as art and music, which also feed off of the same cultural and political references.⁹⁶

The music and art industries do differ from fashion in that near-exact replicas of past designs are permissibly recycled in fashion. One blog posted two dresses, side by side, challenging the readers to identify which dress was real and which was the knockoff.⁹⁷ The designer dress by Kate Moss for TopShop sold at Barney's for \$150, whereas the Forever 21 version of the dress retailed for \$24.80.⁹⁸ Wendy B., a blog reader, commented, "[B]ut the Kate Moss Dress is a knockoff of Versace . . . so exactly how are the situations different?"⁹⁹ In fact, the TopShop dress is nearly indistinguishable from a Versace dress that Kate Moss wore in the 1990s and was her inspiration for the dress that she re-created for Top Shop. As this example illustrates, certainly not *all* fashion designs are original.¹⁰⁰

⁹⁵ See *DPPA Hearings*, *supra* note 20 (statement of David Wolfe, Creative Director, Doneger Group).

⁹⁶ The term "pop art," for example, first appeared in Britain during the 1950s and referred to the interest of a number of artists in the images of mass media, advertising, comics and consumer products:

Influenced by the art seen in Eduardo Paolozzi's 1953 exhibition *Parallel between Art and Life* at the Institute for Contemporary Arts, and by American artists such as Jasper Johns and Robert Rauschenberg, British artists such as Richard Hamilton and the Independent Group aimed at broadening taste into more popular, less academic art. Hamilton helped organize the 'Man, Machine, and Motion' exhibition in 1955, and 'This is Tomorrow' with its landmark image *Just What is it that makes today's home so different, so appealing?* (1956). Pop Art therefore coincided with the youth and pop music phenomenon of the 1950s and '60s, and became very much a part of the image of fashionable, 'swinging' London. Peter Blake, for example, designed album covers for Elvis Presley and the Beatles and placed film stars such as Brigitte Bardot in his pictures in the same way that Warhol was immortalizing Marilyn Monroe in the USA. Pop art came in a number of waves, but all its adherents—Joe Trilson, Richard Smith, Peter Phillips, David Hockney and R.B. Kitaj—shared some interest in the urban, consumer, modern experience.

THE BULFINCH GUIDE TO ART HISTORY: A COMPREHENSIVE SURVEY AND DICTIONARY OF WESTERN ART AND ARCHITECTURE 516 (Shearer West ed., 1996).

⁹⁷ See http://www.fashionista.com/2007/08/adventures_in_copyrights_dupli_1.php#comments (last visited Jan. 4, 2008). Fashionista,

⁹⁸ See *id.*

⁹⁹ *Id.*

¹⁰⁰ One article highlights this mainstream criticism of originality in fashion:

Still, when it comes to fashion, who can claim to be original?

I took a spin recently around Sui's Soho store to see if this could be a case of a very chic pot calling a fashion-forward kettle basic black. And here is what I found: many garments that appeared to be line-for-line copies of clothes from the '70s that were clearly purchased from flea markets; a newspaper print that is startlingly similar to one touted by John Galliano a few seasons back; a ribbon-trimmed badge pinned to a sweater exactly like the ones employed by the Fake London brand on its sweaters.

But let's be fair: Galliano wasn't the first guy to do a newspaper print either, and

1. What Constitutes Original Fashion Design?

In determining what constitutes original fashion design, it might be easier to describe what would *not* constitute original fashion design under the DPPA. Commonplace designs that are already in the public domain, such as t-shirts, jeans, bubble skirts, and wrap dresses would generally not be considered original. Something less common, such as Celine's double-wrap belt with metal on the outside would not be considered original since it is an exact replica of a vintage belt from What Comes Around Goes Around, a vintage clothing store in New York City.¹⁰¹ What undoubtedly would qualify as original design is a dress (and perhaps most garments) from Hussein Chalayan's¹⁰² Fall 2007 ready-to-wear collection, which through the use of LED technology lit up and played its own movie, "a colorful pixelated grid inspired by a cityscape, as seen from space via Google Earth."¹⁰³ While

lots of designers spend Sundays at the flea market. (They are, in fact, notorious for sweeping through the Manhattan Vintage Clothing Show—the next one is October 12—and buying like wild animals.)"

Yaeger, *supra* note 15.

¹⁰¹ See DAVID BOLLIER & LAURIE RACINE, READY TO SHARE: CREATIVITY IN FASHION AND DIGITAL CULTURE 17 (2005), available at <http://www.learcenter.org/pdf/RTSBollierRacine.pdf>. Cameron Silver, the owner of Decades, Inc., a vintage clothing chain in Los Angeles and London, said that 60 percent of his business comes from designers. In New York City, designers constantly trek to Gallagher Paper Collectibles, a small East Village grotto that owns a rich archive of vintage fashion magazines. Proprietor Michael Gallagher told a reporter that all the big name designers shop at his store including Hedi Slimane, Karl Lagerfeld, Marc Jacobs, John Varvatos, Narciso Rodriguez, the Calvin assistants, the Gucci assistants, Dolce & Gabbana, Anna Sui—you name it. He says that they all come for what they call "inspiration." *Id.*

¹⁰² Hussein Chalayan was born in Cyprus and educated in Cyprus and England. He graduated from Central Saint Martins with a degree in fashion. He is a highly conceptual fashion designer who constructs clean, architectural garments. Cathy Horyn, describing Chalayan's Fall 2006 collection, wrote:

The runway . . . was a crystal-pebbled moonscape, and for the finale, Mr. Chalayan created a series of dresses that changed shape when each model came to a halt. Mr. Chalayan said later that microchips were inserted in the corset or hat of each outfit and programmed to magically erase hems or lapels. The ribbon slats of one dress retracted like a Venetian blind and then dropped, transformed into mirrors. It took about seven seconds for a silk chemise to disappear into the rim of a picture hat, leaving the model naked. When the transformation was complete, a puff of steam rose from the crown of her hat.

"I've always been interested in the future," Mr. Chalayan said. "But the challenge was to do something less predictable than Robocop that could be realized in fashion."

He made believers of his audience.

Cathy Horyn, *Shape-Shifters With Microchips Walk the Runway*, N.Y. TIMES, Oct. 7, 2006, at B8, available at <http://www.nytimes.com/2006/10/07/fashion/shows/07FASHION.html?n=Top/Reference/Times%20Topics/People/C/Chalayan,%20Hussein>.

¹⁰³ A photograph of the dress as well as a runway review of the collection is available at Sara Mower, *Hussein Chalayan Review*, STYLE.COM, Feb. 28, 2007, <http://www.style.com/fashionshows/collections/F2007RTW/review/HCHALAYA> (last visited

these are the two extremes, most current fashion works fall into the category of derivative works.¹⁰⁴ For example, J.P. Tod developed the “Gommino” shoe in the late 1970s, a leather moccasin with a rubber sole consisting of 133 pebbles for extra grip.¹⁰⁵ At the beginning of the twenty first century, dozens of shoe designers began marketing their own versions, derivative works, of Tod’s driving shoe.¹⁰⁶

2. The Problem of Distinguishing Original from Imitation

The true problem with originality is not that it doesn’t exist in fashion; the problem is that the burden placed on alleged infringers under the DPPA, who would have to show that a plaintiff’s work is not original (and hence does not warrant copyright protection), is unreasonably high.¹⁰⁷ Not all garments are so unique and innovative, as is Chalayan’s LED dress, such that one can assume nothing like it has been created in the past. Consider Theory’s lightweight shirtdress with bust darts, pleating, an inset waistband, and three-quarter length sleeves with banded cuffs.¹⁰⁸ It would be conceivable for two designers, Theory and, say, J. Crew, to create similar versions of this garment, during the same season, where neither influenced the other but both were consciously or perhaps subconsciously¹⁰⁹ influenced by designs from the past, now in the public domain. Suppose Theory were to sue J. Crew for copyright infringement. J. Crew’s attorneys would be forced

Jan. 4, 2008).

¹⁰⁴ See *supra* Part I.A.2.

¹⁰⁵ See Tom Stubbs, *Talking Trousers: Shorts and the City*, SUNDAY TIMES (London), May 7, 2006, at 29, available at http://women.timesonline.co.uk/tol/life_and_style/women/style/article711120.ece.

¹⁰⁶ See Raustiala & Sprigman, *supra* note 7, at 1713 for images of these derivative driving shoes by Bacco Bucci, Minnetonka, Ecco, E.T. Wright, and Ralph Lauren. Under the DPPA, Tod’s “Gommino” shoe would be considered a public domain work and all derivative works would be copyrightable only to the extent that they differed from the “Gommino” shoe.

¹⁰⁷ See *DPPA Hearings*, *supra* note 20 (statement of David Wolfe, Creative Director, Doneger Group):

Because defining and determining originality is difficult enough for those who work in and study the fashion industry; it would be just as difficult for a court. If a court cannot determine the originality of a design, then how could it fairly determine whether one design infringes upon another or whether a design is substantially similar or whether a design is sufficiently original to qualify for copyright protection? Would a court be forced to measure the width of the lapels on a tuxedo jacket, the width of spaghetti straps on a cocktail dress, the similarity of pastels of a suit? Or the originality in the length of a skirt, the cut of a men’s button-down dress shirt, or in the number of straps on a pair of gladiator-style sandals?

¹⁰⁸ Available to interested shoppers at <http://shop.nordstrom.com/S/2954445/0~2376776~2374327~2374331~6008991?mediumthumbnail=Y&origin=category&searchtype=&pbo=6008991&P=1> (last visited Sept. 12, 2008).

¹⁰⁹ See Carissa Alden, Note, *A Proposal to Replace the Subconscious Copying Doctrine*, 29 CARDOZO L. REV. 1729 (2008).

to undertake the job of art historians, digging to find the past designs upon which their own work and/or Theory's work were based in an effort to show that Theory's dress is not original and, hence, cannot be protected by copyright.¹¹⁰ There is no central database of fashion designs where an attorney could turn. Perhaps fashion historians could be of use in the process but it would certainly be a tedious endeavor to locate original works, even for an expert in the field. It is possible that J. Crew's attorneys would find a garment in the public domain in order to protect themselves from liability but, regardless, they would have to expend a great deal of time and effort to shield themselves from liability.

This hypothetical is meant to show that, under a broad substantial similarity standard, a non-infringing party may be forced to research fashion history in order to shield itself from liability. This Note argues that an alleged infringer should not have to face this great burden unless the garments are so similar (not just substantially similar) that copying must have occurred.

B. *Substantial Similarity Standard*

1. Copyright Infringement Analysis

In order to assert copyright infringement, a plaintiff must establish ownership of a valid copyright and copying of constituent elements of the work that are original.¹¹¹ Two separate elements essential for the plaintiff to prove are: 1) that his work was actually copied by defendant and 2) that the copying amounts to improper appropriation.¹¹² The evidence pertaining to actual copying, the first prong, may consist of either the defendant's admission that he copied or circumstantial evidence—evidence of access—from which the trier of facts may reasonably infer copying.¹¹³ Only after copying is proven will a court inquire as to whether the copying constitutes improper appropriation—whether the defendant has taken enough original material to constitute infringement.¹¹⁴ Even where copying is conceded in the first prong, a defendant will not be liable for copyright infringement unless the

¹¹⁰ The court would have to determine whether plaintiff's work is a new work or a derivative work, since this distinction determines the standard of originality required for a copyright. *See supra* Part I.A.2.

¹¹¹ *See* *Feist Publ'ns., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

¹¹² *See* *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

¹¹³ 4-13 NIMMER, *supra* note 11, § 13.01.

¹¹⁴ *Feist*, 499 U.S. at 348 ("The mere fact that a work is copyrighted does not mean that every element of the work may be protected.").

defendant's copy is substantially similar to the plaintiff's works.¹¹⁵ The substantial similarity standard is distinct from the more rigid customer confusion standard in trademark law.¹¹⁶ Critics of copyright protection for fashion designs argue that the substantial similarity standard as applied to designs will lead to an influx of litigation, resulting in a chilling effect on fashion companies' design production.¹¹⁷

2. What is "Substantial Similarity"?

Somewhere between no similarity and complete and literal

¹¹⁵ 4-13 NIMMER, *supra* note 11, § 13.03; *see* *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004). The term "substantial similarity" is confusingly used in both prongs. Similarity between plaintiff and defendant's work is required for indirect proof of copying under the access prong of the analysis. This type of similarity has been called "probative similarity" to avoid confusing it with "substantial similarity" which is assessed in determining whether the copying amounts to improper appropriation. 4-13 NIMMER, *supra* note 11, § 13.01. This explanation of the confusion is helpful:

We have now reached the source of the confusion—the borrowing from one requirement for use in another. "Substantial similarity," while said to be required for indirect proof of copying, is actually required only after copying has been established to show that *enough* copying has taken place. A similarity, which may or may not be substantial, is probative of copying if, by definition, it is one that under all the circumstances justifies an inference of copying. In order to emphasize the function of such similarity and avoid the confusion of double usage, this Article suggests use of the term "probative similarity" in place of "substantial similarity" in this context.

Alan Latman, "Probative Similarity" as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1187, 1189-90 (1990) (emphasis added).

The probative similarity analysis is such that "if there are no similarities, no amount of evidence of access will suffice to prove copying. If there is evidence of access and similarities exist, then the trier of the facts must determine whether the similarities are sufficient to prove copying. . . . If evidence of access is absent, the similarities must be so striking as to preclude the possibility that plaintiff and defendant independently arrived at the same result." *See Arnstein*, 154 F.2d at 468. Only then does the analysis move on to the second prong, where substantial similarity is assessed. *Id.*

¹¹⁶ Despite this disparity in standards, it is not uncommon for courts to describe works as "confusingly similar" in copyright infringement analysis. *See Mulberry Thai Silks, Inc. v. K & K Neckwear, Inc.*, 897 F. Supp. 789, 791 (S.D.N.Y. 1995) ("A tie buyer who had seen one of Mulberry's Ziggurat collection ties and wished subsequently to buy the same tie would be likely, upon seeing K & K's copy, to buy it in the mistaken belief that the buyer was purchasing the same tie that the buyer had seen previously."); 4-13 NIMMER, *supra* note 11, § 13.03 n.2.1; *see also infra* Part III.C.

¹¹⁷ Raustalia & Sprigman, *supra* note 7, at 1049 n.118. The authors note that:

In practice, the courts' implementations of the test have resulted in a low threshold for finding infringement. More important for our purposes than courts' differing articulations of the standard of liability is one overarching verity. . . . If the useful articles rules were modified to extend copyright to apparel designs, the current substantial similarity doctrine would expose many designs to challenge under the copyright laws.

. . . This change would create substantial disruption for the industry. Because fashion designers are immersed in their competitors' products once they leave work, there is no such thing in fashion as a clean room [where designers are without access to competitors' products].

Id. at 1751.

similarity lies “substantial similarity.”¹¹⁸ It is an “ad hoc” determination, resting on the facts of an individual case, in which a court must decide whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.¹¹⁹ During the subcommittee hearing for H.R. 5055 in 2006, two similar polka-dot dresses were displayed and a discussion as to whether they were “substantially similar” ensued.¹²⁰ Christopher Sprigman argued that the two, under the DPPA, would be considered substantially similar given the way that the doctrine has developed in the courts.¹²¹ Jeffrey Banks, a fashion designer in support of the bill, disagreed, arguing that one dress had spaghetti straps while the other has a capped sleeve.¹²² This example reveals the divide between what designers wish the substantial similarity standard were and the broader way in which courts would arguably interpret it. Adopting a narrower standard for infringement of copyright designs is more likely to fit designers’ perception of what is substantially similar (which is not synonymous with how the law views the standard).

¹¹⁸ 4-13 NIMMER, *supra* note 11, § 13.03.

¹¹⁹ See *Arnstein v. Broad. Music Co.*, 137 F.2d 410 (2d Cir. 1943); see also *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 492 (2d Cir. 1960); *L & L White Metal Casting Corp. v. Joseph*, 387 F. Supp. 1349, 1352-1353 (E.D.N.Y. 1975) (“An examination of the dolls reveals that, while similarities exist as to standard doll features such as the full faces; pert, upturned noses; bow lips; large, widely spaced eyes; and slim figures, distinct differences exist with respect to the neck structures and hair styles” (quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966))). In *Peter Pan Fabrics*, the court describes the vagueness of the substantial similarity standard:

The test for infringement of a copyright is of necessity vague In the case of designs, which are addressed to the aesthetic sensibilities of an observer, the test is, if possible, even more intangible. No one disputes that the copyright extends beyond a photographic reproduction of the design, but one cannot say how far an imitator must depart from an undeviating reproduction to escape infringement. In deciding that question one should consider the uses for which the design is intended, especially the scrutiny that observers will give to it as used. In the case at bar we must try to estimate how far its overall appearance will determine its aesthetic appeal when the cloth is made into a garment. Both designs have the same general color, and the arches, scrolls, rows of symbols, etc. on one resemble those on the other though they are not identical. Moreover, the patterns in which these figures are distributed to make up the design as a whole are not identical. However, the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same. That is enough; and indeed, it is all that can be said, unless protection against infringement is to be denied because of variants irrelevant to the purpose for which the design is intended.

Peter Pan Fabrics, 274 F.2d at 489.

¹²⁰ See Sarah Zenewicz, *Copyright Unfit for Fashion*, PUBLIC KNOWLEDGE, <http://www.publicknowledge.org/node/570> (last visited Jan. 4, 2008) for more details of the debate and to see images of the two dresses in question.

¹²¹ *Id.*

¹²² *Id.*

3. Purpose of Substantial Similarity Standard: Not a Fit for Fashion

The idea behind the substantial similarity standard was articulated by Judge Learned Hand when he said that a narrower standard would allow a copyist to escape liability by “immaterial variations.”¹²³ In most fields protected under copyright, it is easy to see why artists should be entitled to protection broader than literal replication. Without this, an author could change a few character names or a songwriter could change a few lyrics in order to avoid liability for infringing. In fashion, however, there are convincing reasons as to why comparable, minor variations should be acceptable in the industry and, in fact, are a benefit to designers.¹²⁴

For one thing, fashion celebrates the appropriation and modification of other people’s creative designs; these practices are an indispensable part of the process of creating fashion designs.¹²⁵ Even fashion designers who support the DPPA believe that the truly troublesome knockoffs are the near-exact replicas of high-end designs.¹²⁶ Designer Carmen Marc Valvo, who came face to face with a

¹²³ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (“It is of course essential to any protection of literary property . . . that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations.”).

¹²⁴ The arguments as to why the substantial similarity standard is unsuitable in the fashion industry, by reason of it being too broad a standard, will obviously be similar to arguments that oppose any form of copyright protection for fashion designs. The difference is one of degree—while critics of the legislation argue that no copying should create liability, the argument set forth in this Note is that copyright protection could create an extremely minimal amount of protection against blatant copies. Since Congress is to consider the effect that copyright legislation will have on the public, it is worth mentioning that different infringement standards would have different effects on the public. A narrower standard would be most beneficial for consumers who naturally want designs to resemble high fashion. See discussion of induced obsolescence *supra* Part I.B.2. On the other hand, with so many high fashion designers creating cost-friendly designs (e.g., Vera Wang for Kohls, Isaac Mizrahi for Target, Karl Lagerfeld for H & M, Thakoon for Gap), the public, arguably, has access to high fashion styles without the need for knockoffs. See Eric Wilson, *The Big Brand Theory*, N.Y. TIMES, Sept. 9, 2007, at 74, available at http://www.nytimes.com/2007/09/09/magazine/09Style-designers-t.html?_r=3&ref&oref=slogin&oref=slogin. Despite the existence of these affordable fashions from high-fashion designers, it still seems that a consumer would want choice above all things—to either purchase knockoffs or to buy Vera Wang garments from Kohls.

¹²⁵ *Bollier & Racine*, *supra* note 101, at 6 (“[T]here is a long history in fashion of ‘knocking off’ haute couture garments and selling them from the most unlikely places—Polynesian Islands, urban street corners, stock-car races, bowling alleys—and transformed into new trends. In fashion, nearly every design element is available to anyone for the taking. Any fashion design, one might say, is ‘ready to share.’”). It seems that the historical lack of copyright protection for fashion designs is what has allowed designers to depend so heavily on design “referencing” or knocking off.

¹²⁶ Zac Posen believes there is “a very fine line of what is a copy and what is inspiration.” Michelle Nichols, *High Fashion Battles Knockoffs*, REUTERS, Sept. 6, 2007, available at <http://www.reuters.com/article/domesticNews/idUSN0639743920070906>. Tim Gunn, who recently joined the creative department at Liz Claiborne, accompanied the CFDA on a lobbying trip for copyright protection. “I’m not in favor of piracy, of course But I want to say to any

copy of one of his dresses a few years ago, says that the proposed legislation might not help the industry because of the difficulty and expense of enforcement and that it might not be worth it unless the target was a blatant copy.¹²⁷ Since designers are so accustomed to referencing others' designs, it makes sense that they would want some degree of flexibility to continue to do so.¹²⁸ The challenge is whether copyright protection can be implemented in such a way that designers are allowed to freely reference other designs, an inherent part of the flow and progression of fashion,¹²⁹ but are not permitted to create stitch-by-stitch copies.

III. A NARROWER STANDARD IS CONSISTENT WITH COPYRIGHT DOCTRINE

A. *Unwarranted Fear of Straying From the Substantial Similarity Standard*

Straying from the substantial similarity standard generally employed by courts in copyright infringement cases may cause unwarranted concern because it seems like a drastic departure from a rudimentary and effective element of copyright doctrine. However, a narrower standard would actually be a less drastic departure from the industry's current lack of copyright protection for fashion designs. A system in which the scope of permissible copying is maintained at some level that allows copying while disallowing very close point-by-point copies would replace a low-IP¹³⁰ regime not with the usual high-IP regime found in the music or film industries but, rather, with a moderate-IP regime.¹³¹ This regime would be calibrated to the particular creative environment of the fashion industry, with its historically greater tolerance of design appropriation.¹³²

The concept of tailoring the substantial similarity standard is not farfetched. As Nimmer describes, the measure of how substantial

fashion designer, it's not as though you're creating fire or inventing the wheel. These things already exist. . . . I celebrate H&M and Zara, and I think they're great. I love what they do. But I draw the line at something that, if you squint your eyes, you really can't discern it from the original." French, *supra* note 16. Nicole Miller thinks that "[w]ith this legislation, people will be deterred from making everything too literal. . . . It's the line-for-line copies that bother me." *Id.*

¹²⁷ Nichols, *supra* note 126.

¹²⁸ See Bollier & Racine, *supra* note 101, at 13.

¹²⁹ For a discussion on "The Durability of Homage," see *id.* at 13-15.

¹³⁰ Raustiala and Sprigman use this phrase to describe the low level of protection afforded to fashion designs across the three core forms of protection—copyright, trademark, and patent law. Raustiala & Sprigman, *supra* note 7, at 1699.

¹³¹ *Id.* at 1749 n.118.

¹³² *Id.*

“substantial similarity” must be varied according to circumstances.¹³³ Some copyrights represent significant creative effort whereas others reflect only scant creativity—the latter copyright protection is labeled “thin” by the Supreme Court.¹³⁴ Courts have held that compilations require a narrower standard.¹³⁵ A factual compilation such as the white and yellow pages of a telephone book, for example, warrants thin protection because the range of protectable and unauthorized expression is narrow.¹³⁶ While the names, phone numbers, and addresses listed are not protected, the selection and arrangement *may* be protectable provided they are original.¹³⁷ Typically, there is scant creativity utilized in the selection and arrangement of facts. When the range of protectable and unauthorized expression is narrow, courts have referred

¹³³ 4-13 NIMMER, *supra* note 11, § 13.01.

¹³⁴ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (“No matter how original the format, however, the facts themselves do not become original through association. . . . This inevitably means that the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another’s publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.”).

¹³⁵ “A ‘compilation’ is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101 (2006); *see* *BUC Int’l Corp. v. Int’l Yacht Council Ltd.*, 489 F.3d 1129, 1148 (11th Cir. 2007) (“The nuances of the ‘substantial similarity’ test vary, however, depending on the nature of the copyrighted work at issue.”).

¹³⁶ *See Feist*, 499 U.S. at 361 (holding that Rural’s white pages, which contained only factual information, i.e. phone numbers, addresses, and names listed in alphabetical order, lacked the requisite originality because Rural had not selected, coordinated, or arranged the uncopyrightable facts in any original way); *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 204 (9th Cir. 1989) (“Plaintiffs claimed the [defendant’s country music] show infringed its copyright as to the manner of presentation of the songs and dances. The district court ruled in favor of the defendants because it found that the various parts of the shows (costumes, hay bales, American flags), when dissected, were not copyrightable. The Fifth Circuit reversed, with the direction that the show might still be copyrightable as a compilation, even if the individual elements could not be protected. We agree” (quoting *Apple Barrel Prods. v. Beard*, 730 F.2d 384, 387-88 (5th Cir. 1984)); *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 573 (9th Cir. 1987) (“[F]acts, like ideas, are never protected by copyright law. . . . Because authors . . . in factual works are usually confined to a ‘narrow range of expression . . . similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed.’ . . . Fictional works, in contrast, which may be expressed with infinite variations, enjoy a broader protection; a verbatim copy . . . is not a necessary element to establish infringement.” (quoting *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir. 1984)); *Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 492 (9th Cir. 1985).

¹³⁷ *See Feist*, 499 U.S. at 348 (“Factual compilations . . . may possess the requisite originality. The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws. Thus, even a directory that contains absolutely no protectable written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement.”).

to the appropriate standard for illicit copying as “virtual identity.”¹³⁸ This Note argues that a narrower standard should likewise be applied to fashion designs.

B. *Fashion Designs Compared to Compilations: Justifying a Narrower Standard*

The “total concept and feel” test in assessing substantial similarity originated in *Roth Greeting Cards v. United Card Co.*, where the majority looked at the various parts of a greeting card as a whole to find that the defendant’s card was substantially similar to the plaintiff’s.¹³⁹ The dissenting judge, on the other hand, reasoned that the whole cannot possibly amount to greater than the sum of its parts.¹⁴⁰ He advocated examining and comparing each copyrightable element of the work to determine infringement rather than looking at the work as a whole.¹⁴¹ A criticism of looking at the entire work as a whole is that two works may be substantially similar based solely on the copying of uncopyrightable elements, which should not lead to a finding of infringement.

“Filtration,”¹⁴² which was initially used to determine substantial similarity in computer programs, has become another dominant test.¹⁴³ Under this approach, a court breaks down the allegedly infringed program into its constituent parts, examines these parts for things such as ideas and elements taken from the public domain, and sifts through

¹³⁸ See *Apple Computer v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994).

¹³⁹ See *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970) (“It appears to us that in total concept and feel the cards of United are the same as the copyrighted cards of Roth. With the possible exception of one United card (exhibit 6), the characters depicted in the art work, the mood they portrayed, the combination of art work conveying a particular mood with a particular message, and the arrangement of the words on the greeting card are substantially the same as in Roth’s cards. In several instances the lettering is also very similar.”).

¹⁴⁰ See *id.* at 1111 (Kilkenny, J., dissenting). In Judge Kilkenny’s dissent, he noted:

I cannot . . . follow the logic of the majority in holding that the uncopyrightable words and the imitated, but not copied art work, constitutes such total composition as to be subject to protection under the copyright laws. The majority concludes that in the overall arrangement of the text, the art work and the association of the art work to the text, the cards were copyrightable and the copyright infringed. This conclusion, as I view it, results in the whole becoming substantially greater than the sum total of its parts. With this conclusion, of course, I cannot agree.

Id.

¹⁴¹ *Id.*

¹⁴² I refer to the test as one of “filtration,” but the same idea goes by other names such as “the extrinsic test” or “analytic dissection” whereby the court filters and isolates each of the constituent elements of the copyrighted works to the exclusion of other elements. See *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1174 (9th Cir. 2003); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir. 1997); *Reece v. Island Treasures Art Gallery, Inc.*, 468 F. Supp. 2d 1197, 1204-05 (D. Haw. 2006).

¹⁴³ *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 707 (2d Cir. 1992).

all non-protectable material. Left with some kernels of creative expression, the court then determines whether the protectable elements of the programs at issue are substantially similar.¹⁴⁴

Applying a filtration approach to fashion designs, most if not all of the individual elements that make up the design are often unprotectable since they come from the public domain or are arguably ideas not protected under copyright.¹⁴⁵ As a result, the copyright protection for the whole design should be as thin as possible, so as not to prevent uninhibited use of unprotectable elements of the design. Filtration, however, does not seem like the correct lens through which to analyze fashion designs since, after eliminating all of the unprotectable elements, it appears that in many cases no protectable elements are left to assess.

Courts have fittingly compared compilations of fact to the “total concept and feel” of pattern designs in fashion. In *Knitwaves v. Lollytogs*, a case involving copyright infringement of a sweater design pattern, the court pointed out that a work may be copyrightable even though it is entirely a compilation of unprotected elements.¹⁴⁶ A fashion

¹⁴⁴ *Id.* at 706.

¹⁴⁵ Applying the filtration test to works of art, one court has said:

Among the unprotectable elements which the court must filter out are: ideas, as distinguished from expression; elements borrowed from another artists [sic] or from the public domain; instances in which a particular expression “merges” with the idea being expressed; and the degree to which the form of the expression is so standard in the treatment of a given idea that it constitutes a *scenes a faire*, or a “scene which must be done.”

Reece, 468 F. Supp. 2d at 1205 (emphasis added). The “idea-expression dichotomy,” while not a central focus of this Note, requires further explanation. Section 102(b) of the Copyright Act provides that “[i]n no case does copyright protection . . . extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery” 17 U.S.C. § 102(b) (2006). This has often been restated by academics to mean that copyright protects the expression of an idea rather than the idea itself.

¹⁴⁶ 71 F.3d 996, 1003-04 (2d Cir. 1995).

What is protectable then is “the author’s original contributions,”—the original way in which the author has “selected, coordinated, and arranged” the elements of his or her work. In this case, *Knitwaves*’ “original contribution” consists not merely—as *Lollytogs* would have it—in arranging leaves or squirrels in a specific pattern, but in (1) selecting leaves and squirrels as its dominant design elements; (2) coordinating these design elements with a “fall” palette of colors and with a “shadow-striped” (for the Leaf Sweater) or a four-paneled (for the Squirrel Cardigan) background; and (3) arranging all the design elements and colors into an original pattern for each sweater. Viewed in this way, it is clear to us that *Lollytogs*’ Leaf and Squirrel sweaters are substantially similar to *Knitwaves*’. *Lollytogs* has chosen to feature the same two fall symbols that *Knitwaves* used, leaves and squirrels. Not only do *Lollytogs*’ renderings of these symbols substantially resemble *Knitwaves*’ renderings, but *Lollytogs* has employed them in virtually the same manner as *Knitwaves* has (as felt appliques stitched to the sweaters’ surface); on strikingly similar backgrounds (“shadow-striped” for the Leaf Sweater, and four-paneled for the Squirrel Cardigan); and in virtually the same color scheme. An observer viewing the sweaters side by side cannot help but perceive them as coming from one creative source.

design, as defined in the DPPA, is “the appearance *as a whole* of an article of apparel”¹⁴⁷ Similar to how facts in a compilation are not protectable, the individual elements in a design such as its cut, color, shape, and material are not protectable. In the case of a factual compilation, the facts are not protectable because facts are discovered rather than created.¹⁴⁸ Once facts are exposed, they become part of the public domain.¹⁴⁹

Fashion designs, in many cases, do not involve a high level of creativity since each individual element of the design is likely a part of the public domain. In the same way that facts are discovered and retold freely in different narratives, aspects of fashion designs already in the public domain such as cowl necks, pleats on pants, and cuff link holes should be free for use by designers. It is the whole of the fashion design that should be protected. The substantial similarity standard, if applied broadly, threatens designers’ use of these individual elements already in the public domain. Thus, while fashion designs are not compilations in a technical sense, the goal of wanting to keep unprotectable design elements in the public domain is similar to the need for facts to remain uncopyrightable. As a result, the narrowest form of copyright protection should be available for fashion designs which can be achieved by interpreting substantial similarity more strictly.

C. *What Should the Narrower Standard Be in Practice?*

Implementing a standard narrower than the substantial similarity standard to fashion designs would require only a minimal departure from the copyright infringement analysis that courts currently apply.¹⁵⁰ The standard should keep in mind the purpose of copyright law, which is to prevent the introduction of an alleged copy into the market from adversely affecting the demand for the protected work.¹⁵¹ A reasonable test to apply would borrow from aspects of the consumer confusion standard in trademark law, which several courts have already gravitated toward in adjudicating copyright infringement.¹⁵²

¹⁴⁷ Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007) (emphasis added).

¹⁴⁸ See *Nash v. CBS, Inc.*, 899 F.2d 1537, 1540 (7th Cir. 1990).

¹⁴⁹ *Id.* at 1541-42.

¹⁵⁰ See *supra* note 119. As described previously, the standard is vague as it is, and interpreting it more narrowly would require a slight tweaking.

¹⁵¹ See *Lyons P’ship v. Morris Costumes, Inc.*, 243 F.3d 789, 802 (4th Cir. 2001) (“[T]he relevant question that courts must ask in determining whether a work has been copied is . . . whether the works are so similar that the introduction of the alleged copy into the market will have an adverse effect on the demand for the protected work. Put more directly, copyright law is concerned with those “knock-offs” that could actually diminish a copyright owner’s profits.”).

¹⁵² See *supra* note 116 and accompanying text.

Trademark law requires that a plaintiff prove that the defendant infringes its mark by creating confusion, or a likelihood thereof, by causing mistake, or by deceiving as to the attributes of its mark.¹⁵³ Courts look at a variety of factors in assessing whether the defendant infringes by creating confusion, the paramount factor being actual confusion.¹⁵⁴ Because *actual* confusion is such a difficult factor to prove, courts consider survey evidence under the prong of “actual confusion.”¹⁵⁵ Plaintiffs commonly use consumer surveys; while surveys do not measure the degree of *actual* confusion by real consumers, they create an experimental environment from which useful data can be acquired to make informed inferences about the likelihood of actual confusion in the future.¹⁵⁶ *Actual* confusion would, as in trademark law, be difficult to prove if applied as a new standard for copyright infringement of fashion designs. A plaintiff could not prove *actual* confusion without his own design and the copied design being available in stores for a substantial amount of time. However, in some cases, a plaintiff may want to bring suit even before his own design reaches stores.¹⁵⁷ Indirect evidence, such as surveys and comparisons being drawn by the media, could be used as a means to assess consumer confusion in these instances.

In *Lyons v. Morris*, the defendant company rented and sold costumes to adults. One was named Duffy the Dragon, whose overall appearance was alleged by plaintiff to infringe on its Barney the

¹⁵³ 15 U.S.C. § 1114 (2006); see *Lyons P’ship*, 243 F.3d at 804.

¹⁵⁴ See *Lyons P’ship*, 243 F.3d at 804 for a list of the factors considered when a plaintiff attempts to prove a likelihood of confusion:

(1) the strength or distinctiveness of the plaintiff’s mark, (2) the similarity of the two parties’ marks, (3) the similarity of the goods and services the marks identify, (4) the similarity of the facilities the two parties use in their businesses, (5) the similarity of advertising used by the two parties, (6) the defendant’s intent, and (7) actual confusion.

The importance and relevance of each factor will, of course, vary from case to case. Nevertheless, we have indicated that the seventh factor—actual confusion—is often paramount.

¹⁵⁵ See *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (“Of course, it is black letter law that actual confusion need not be shown to prevail under the Lanham Act, since actual confusion is very difficult to prove”); see *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415, 433 n.83 (S.D.N.Y. 2004) (“Although survey evidence is not direct evidence of actual confusion, it is nonetheless routinely categorized under the heading ‘actual confusion.’”).

¹⁵⁶ See *Louis Vuitton Malletier*, 340 F. Supp. 2d at 433.

¹⁵⁷ See *infra* Part I.B.II for a discussion about cases where copies of designs end up in stores even before the runway design that was copied. In this context, it would be difficult to prove *actual* confusion before both garments have been available in stores. However, in trademark law, the fact that a product is not in stores long enough to judge actual confusion among consumers does not stand as a bar to proving consumer confusion. See *Lois Sportswear*, 799 F.2d at 875 (“[Survey evidence] is still somewhat probative of actual confusion in the post-sale context [T]he record indicates that sales of appellants’ jeans have been minimal in the United States thus far and there has been little chance for actual confusion as yet. It would be unfair to penalize appellee for acting to protect its trademark rights before serious damage has occurred.”).

Dinosaur costume.¹⁵⁸ In considering whether plaintiff's costume was substantially similar to defendant's, the court looked to evidence of actual confusion among children.¹⁵⁹ This was proven through testimony whereby a school administrator dressed in a Duffy costume entered a room of 500 children who chanted "Barney. Barney. Barney." In addition, over thirty newspaper clippings around the country photographed people wearing the Duffy costume and reported them as "Barney" costumes.¹⁶⁰ This test, if applied to fashion designs, would look to whether average consumers would confuse one garment for another by looking at the complete exterior look.¹⁶¹ The internet would be a useful tool in assessing consumer confusion, since comparing designer and knock off garments has become a common practice of fashion bloggers.¹⁶²

D. *How a Narrower Standard Will Affect the Industry*

Implementing copyright protection for fashion designs with a standard narrower than the substantial similarity standard would afford designers the protection they deserve while preventing a chilling effect in the industry from an onslaught of lawsuits. Forever 21 could continue to provide designer-inspired fashions to consumers as long as their designs are not so similar to DVF's designs that they confuse consumers in their appearance. While substantial similarity is a vague standard,¹⁶³ implementing a narrower standard that incorporates consumer confusion would allow designers to more easily predict when their designs might infringe upon another designer's copyright. Designers would, as a result, be incentivized to make changes to their designs substantial enough to differentiate their garments from those that they "reference."

Those designers who create near-exact replicas of other garments

¹⁵⁸ *Lyons P'ship*, 243 F.3d at 790.

¹⁵⁹ In this case, the relevant evidence showed that the target for both the Barney and Duffy characters was an audience consisting of young children. Because copyright law is intended to protect the creator's economic market, the relevant question in this case, according to the court, was whether the children, not the parents, were confused. *Id.* at 802.

¹⁶⁰ *Id.* at 796.

¹⁶¹ In the case of two polka dot dresses, one with spaghetti straps and the other with capped sleeves, whereas a court may find infringement under the substantial similarity standard, a court applying this consumer confusion standard would not mistake one dress for another despite both having some similarities. See *supra* note 120 for a link to the image. Of course, under this standard, the consumer would not be inspecting the garment for indicators of source such as interior tags.

¹⁶² See Fashionista, http://www.fashionista.com/shopping/adventures_in_copyrights/ (last visited Jan. 4, 2008).

¹⁶³ See *supra* note 120 and accompanying text.

and are sued would still face the difficult task of arguing that the plaintiff's garment is not original and, hence, cannot be protected under copyright law (assuming that both prongs of infringement—access and the heightened similarity standard—are proven). However, under such a narrow standard of copyright infringement, this high burden no longer seems unjust. When it is so clear that he has copied plaintiff's work and the works are indistinguishable to an average consumer, the defendant ought to face the high burden of proving that the plaintiff's piece itself is not original. It is clear that he has produced nearly a stitch-by-stitch copy of plaintiff's work. Unless he can show that plaintiff himself copied a previous work (making plaintiff's piece unoriginal) or that he copied a different work, the defendant should be liable for essentially stealing plaintiff's design.

CONCLUSION

Despite the convincing evidence in support of copyright protection for fashion designs, the DPPA has the potential to create a chilling effect by restraining the high level of innovation that currently exists in fashion and to cause an influx of litigation whereby defendants are faced with an unreasonable burden of researching the originality of garments—an arduous and endless task. While some scholars and commentators have pointed to these same reasons in arguing that the legislation is hopeless, there is another alternative. A narrower standard of copyright infringement would achieve the goal of protecting designers, all the while avoiding the problems created by the legislation. If the DPPA does pass, this narrower standard should be employed by the courts as a way to avoid turmoil in the fashion industry.