



Intellectual Property Alert

Latest developments in patent, trademark, and copyright law

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Legislation to extend copyright protection to fashion designs reintroduced in Congress

By *Gina M. McCreddie*

On April 30, 2009, Representative William Delahunt (D-MA) reintroduced the Design Piracy Prohibition Act (H.R. 2196), which extends copyright protection to fashion designs embodied in clothing and certain accessories, if certain conditions are met. The act has been referred to the House Committee on the Judiciary, where Representative Delahunt and many of the bill's cosponsors sit. This is the third consecutive year in which a version of this act has been introduced in Congress.

If passed, the act would amend 17 U.S.C. §§ 1301, *et seq.*, which governs copyright protection of vessel hull designs, to afford copyright protection to fashion designs embodied in, among other things, clothing, handbags, wallets, belts, footwear, headgear, and eyeglass frames. As currently drafted, a "fashion design" constitutes the appearance of an article of apparel as a whole, including any ornamentation, and specifically protects any original elements or the arrangement or placement of any elements incorporated in the overall appearance of the article of apparel. The presence or absence of any particular color, or of any pictorial or graphic work imprinted on fabric, is not considered when determining the originality of the fashion design or similarity for the purposes of infringement.

The act limits copyright protection for fashion designs to three years from the date of registration or the date on which the fashion design was first made public, whichever date is earlier. In addition, a fashion design is eligible for registration only if the application is made by the owner within six months of the date on which the design was first made public in the United States or a foreign country. The act also increases the statutory penalty for knowingly making a false representation for the purpose of obtaining registration of a design to no less than \$5,000 and no more than \$10,000.

Under the act, it is an infringement to make, have made, import, sell, or distribute any article embodying a fashion design that was: (1) copied from a protected design, or an image of such design, without authorization; and (2) created with knowledge, or with reasonable grounds to know, that such design was protected. An illustration or picture of a protected design in an advertisement, photograph, book, newspaper, broadcast, motion picture, or similar medium does not constitute an infringement. Further, a fashion design is not deemed to have been copied from a protected design if: (1) it is original and not closely and substantially similar in overall visual appearance to the protected design; (2) it merely reflects a trend; or (3) it is the result of independent creation. "Trend"

is defined as “a newly popular concept, idea, or principle expressed in, or as part of, a wide variety of designs of articles of apparel that create an immediate amplified demand for articles of apparel embodying that concept, idea, or principle.” If infringement is established, the court may award—in addition to the copyright owner’s actual damages—enhanced damages of \$250,000 or \$5 per copy, whichever is greater.

The act also expressly applies the doctrines of secondary infringement and liability to fashion designs, and provides that any person who is liable under these doctrines is subject to all of the remedies available to the copyright owner, including any remedies attributable to the underlying infringement. Although these doctrines have long been recognized in case law, this proposed amendment would codify these doctrines in the Copyright Act.

Finally, the act contemplates creation of a searchable electronic database, to be maintained by the U.S. Copyright Office and available to the public without a fee, of all fashion designs submitted for registration. The database will contain, for each design: the name and address of the copyright owner (and designer, if different); the name of the design; a visual representation of the design; the date on which the design was first made public (if any); affirmation that the design has been affixed in an article; and the status of the design’s registration, including whether the registration has been granted, denied, cancelled, or expired. To assist in this process, any application for registration must contain a brief description of the design for purposes of matching the search criteria in this database (which description shall not limit the copyright protection afforded to the design or the subject matter of the registration).

Proponents of this legislation support protection of fashion designs for a limited time, given the time and expense involved in creating the designs and bringing them to market, and the need to afford a meaningful way to combat counterfeiting and piracy in the fashion industry. For example, when a designer debuts a design on the red carpet of an award show, it is usually only a matter of days before “knock-offs” appear on the market at drastically lower prices. Others point to the fact that the United States lags behind Europe, which has long provided copyright protection to fashion designs. Proponents also argue that copyright protection for fashion designs is needed for younger designers, who struggle to make their names in the fashion industry only for others to copy their designs without any concern for recourse.

Critics argue that copyright protection for fashion designs is unnecessary, as it has never existed and the apparel industry in the United States generates more than \$1 billion per year. Others argue that copyright protection will only hinder competition and innovation among designers in the marketplace, as well as harm consumers by offering less apparel choices at different price points. Critics also argue that such legislation will only lead to a flood of copyright litigation, which would have a chilling effect on the industry. Further, designers would be required to clear all new designs with their attorneys, and young designers would be disadvantaged because they are unlikely to have the resources to hire such attorneys.

In the past two Congresses, each version of the Design Piracy Prohibition Act has been referred to committee (or subcommittee), but not reported out for a full vote by the House of Representatives or the Senate, as appropriate. It is too early to tell whether the current version of the act will suffer from the same fate this Congress.

Nixon Peabody will publish additional *Alerts* as new developments in the legislative process unfold.

Intellectual Property Department

Please feel free to call or e-mail any of the Intellectual Property department partners and counsel listed below.

[e-mailname@nixonpeabody.com]

Richard D. Rochford (Department leader)	rrochford	585-263-1533
David Anderson	dlanderson	213-629-6095
Joseph Bach	jbach	650-320-7700
Robert Bernius	rbernius	202-585-8312
Daniel J. Burnham	dburnham	312-425-8513
Jeffrey L. Costellia	jcostellia	202-585-8207
Peter H. Durant	pdurant	585-263-1227
Ronald I. Eisenstein	reisenstein	617-345-1000
Robert P. Fletcher	rfletcher	202-585-8323
Janet M. Garetto	kgaretto	312-425-8514
John C. Gatz	kgatz	312-425-8515
Russell J. Genet	rgenet	312-425-8516
Michael L. Goldman	mgoldman	585-263-1304
Marc S. Kaufman	mkaufman	202-585-8164
Jason C. Kravitz	jkavitz	617-345-1318
Paul R. Kitch	pkitch	312-425-8517
Robert Krebs	rkrebs	650-320-7743
Gunnar G. Leinberg	gleinberg	585-263-1014
Ronald Lopez	rlopez	415-984-8368
David May	dmay	202-585-8220
Edward F. McCormack	emccormack	312-425-8560
Laurin H. Mills	lmills	202-585-8515
Joseph M. Noto	jnoto	585-263-1601
Daniel Offner	doffner	213-629-6094
Nicholas G. Papastavros	npapastavros	617-345-1329
William Pegg	wpegg	312-425-8657
Anne Perrin	aperrin	+33 (0)1 70 72 36 28
David S. Resnick	dresnick	617-345-6057
David Ritchie	dritchie	650-320-7747
Mark D. Robins	mrobins	617-345-6176
Andrew C. Rose	acrose	518-427-2664
Frank W. Ryan	fryan	212-940-3129
John Schaub	jschaub	650-320-7748
Marc Schuler	mschuler	+33 (0)1 70 72 36 40
Khaled Shami	kshami	650-320-7749
Justin D. Swindells	jswindells	312-425-8534
Robert A. Weikert	rweikert	415-984-8385
Jodi Rosen Wine	kwine	312-425-8639
Aaron Winger	awinger	+86 21 6132 3802
Andrew Zappia	azappia	585-263-1214

Visit our website at nixonpeabody.com.

Albany, NY
677 Broadway, 10th Floor
518-427-2650

Boston, MA
100 Summer Street
617-345-1000

Buffalo, NY
40 Fountain Plaza, Suite 500
716-853-8100

Chicago, IL
161 North Clark Street
312-425-3900

London, UK
Hillgate House, 26 Old Bailey
+44 (0)20 7653 9760

Long Island, NY
50 Jericho Quadrangle,
Suite 300
516-832-7500

Los Angeles, CA
555 West Fifth Street, FL 46
213-629-6000

Manchester, NH
900 Elm Street
603-628-4000

New York, NY
437 Madison Avenue
212-940-3000

Palm Beach Gardens, FL
7121 Fairway Drive, Suite 203
561-691-5420

Paris, France
32 rue de Monceau
+33 (0)1 70 72 36 00

Providence, RI
One Citizens Plaza
401-454-1000

Rochester, NY
1100 Clinton Square
585-263-1000

San Francisco, CA
One Embarcadero Center,
Suite 1800
415-984-8200

Shanghai, China
222 Yan An East Road
+86 21 6132 3802

Silicon Valley, CA
200 Page Mill Road, Suite 200
650-320-7700

Washington, DC
401 Ninth Street NW, Suite 900
202-585-8000