

S. 3523: Louboutin, Lululemon, and Fashion Design: Finally Getting Some Respect?

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A few weeks ago, the Second Circuit's ruling in the [Louboutin decision](#) made clear that color as a trademark can be protected in the fashion industry. Recently, [Lululemon has sued Calvin Klein](#) for design patent infringement over the design of yoga pants. And just before [Fashion Week](#) in New York City, New York Sen. Chuck Schumer introduced [Senate Bill 3523 entitled the "Innovative Design Protection Act of 2012"](#) seeking to amend the US Copyright Act to extend protection to fashion design. Coincidence? Perhaps, but the fashion industry has been waiting a long time for this type of protection.

The stumbling block that the fashion industry has faced in the US has been the "functionality doctrine." Under historic US jurisprudence, articles of clothing have generally been considered utilitarian and unprotected since the form and shape of the clothing were considered functional to its purpose regardless of the design. Nevertheless, some design patents for various features on articles of clothing, including shoes, have been issued over the years. And the Second Circuit in its [Louboutin decision](#) reversed the District Court's finding that color is functional in the fashion industry and cannot be protected as a trademark. Copyright protection has never extended to articles of clothing, with the possible exception of costumes, but only to individual design elements that can be "separated" from the overall design. S.B. 3523, like its [predecessors](#) before it, seeks to change that.

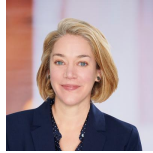
The Bill seeks to amend Chapter 13 of the Copyright Act which covers "Protection of Original Designs" to add "fashion design" as a specific type of protected design. Currently, the statute generally protects "an original design of the useful article which makes the article attracted more distinctive in appearance to the purchasing or using public" and specifically protects the design of "vessel features." "Fashion design" is defined in the Bill as "the appearance as a whole of an article of apparel, including its ornamentation; and includes original elements of the article of apparel or the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel that are the result of the designer's own creative endeavor and provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles." The word "apparel" includes men's, women's, or children's clothing (including undergarments outerwear gloves footwear and headgear), handbags, purses, wallets, tote bags, belts and eyeglass frames. Protection would exist for three years upon the earlier of the date of publication of the registration under the statute or the date the design is first made public as defined in the statute.

One design would not infringe another if it was "not substantially identical in overall visual appearance to and as to the original elements of the protected design; or is the result of independent creation;" or falls within the "home sewing" exception. To be "substantially identical" the apparel must be "so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial." Infringing articles would include unauthorized designs copied from a protected design or image thereof, but would not include an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium.

A design owner may maintain an action for infringement after the design is made public and it has complied with the 21 notice requirement proscribed in the Bill. Liability will be limited only to damages and profits accrued after the date on which the infringement action is commenced. Limited liability for sellers, importers, and distributors of infringing articles is added, while ISPs and search tools are exempted from liability.

Previous efforts to protect fashion through the Copyright Act have failed. It remains to be seen whether this Bill will become law.

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