

Intellectual Property

Knobbe Martens

Design Protection in the Fashion Industry

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There are few industries for which effective design protection is more critical—and more challenging—than fashion. Prestigious fashion products command premium prices for their designs. Naturally, these products spawn imitators, and streets, stores, and the Internet are flooded with everything from designer knock-offs to outright counterfeits.

The law provides many tools to allow creators of fashion products to protect and enforce their innovative and valuable designs. Each tool has advantages and disadvantages for particular fashion products.

Design Patents

A designer may obtain a design patent for “any new, original and ornamental design for an article of manufacture.” The designer must file the application no later than one year after the designer publicly disclosed it, used or offered it for sale.

The design patent application is straightforward. Its substance consists of images of the design. A design patent remains in force for 14 (if filed before May 13, 2015) or 15 years (if filed on or after May 13, 2015) once issued.

Enforcement of a design patent is also straightforward. The test for infringement is the “ordinary observer” test. Under this test, a product infringes if, “an ordinary observer,” familiar with older designs would be deceived into believing the accused infringer’s design is the same as the patented design. The designs need not be identical, and minor differences between them will not prevent a finding of infringement.

A designer can seek lost profits or a reasonable royalty, the potential to increase damages three-fold if the infringement was willful, and an injunction against further infringement. Alternatively, the plaintiff can elect to receive disgorgement of the profits earned by the infringer for its sale of the “article of manufacture” containing the design. (There is ongoing uncertainty as to how to determine these profits in the context of a multi-component product, as the Supreme Court has not yet articulated a test for making that determination.)

Design patents provide clear advantages for protection of fashion products that:

- have been on sale for less than one year;
- have not already had sufficient sales, marketing, and publicity to cause the consuming public to associate the design with the designer (a requirement for trade dress as discussed below);
- have ornamental features that cannot be separated from the products into which they have been incorporated.

Trade Dress

Trade dress generally refers to product configurations, designs, and packaging that the public recognizes as source identifiers. Features such as the “size, shape, color or color combinations, texture, and graphics” can all qualify. A trade dress which the public recognizes as a source identifier is said to have acquired “secondary meaning.” The features must also be “nonfunctional”—not essential to the use or purpose of the product or add a competitive advantage to the product. To determine if a trade dress has acquired secondary meaning, courts typically look to evidence including the length and manner of use of the trade dress, the volume of sales, the amount and manner of advertising, the nature of use of the trade dress in media, consumer-survey evidence. To maintain this secondary meaning, a designer must enforce its trade dress against infringers. To prevail in an infringement action, a plaintiff must prove a likelihood of confusion among consumers between the mark owner’s trade dress and the infringer’s. Designs often rely on surveys and evidence of actual confusion.

A designer can seek lost profits, a reasonable royalty, disgorgement of the infringer’s profits, punitive damages, an injunction, and attorneys’ fees.

Trade dress protection is particularly well-suited to protect the design of fashion products where:

- sales, marketing, and publicity relating to the product are sufficient to establish that the design has acquired secondary meaning;
- the design is in continuous use; and

- the owner of the mark is willing to continuously police the marketplace and enforce its rights against infringers.

Copyright

For purposes of fashion products, copyright protects original “pictorial, graphic, and sculptural works.” The copyright right exists upon the creation of the work. However, the copyright cannot be enforced until the designer has obtained a registration for the copyright.

To prove infringement, a plaintiff must prove that the defendant copied the plaintiff’s copyrighted work. Courts recognize, however, that direct evidence of copying is frequently difficult to obtain. Accordingly, a plaintiff can satisfy its burden of proving copying by providing evidence showing that the defendant had access to the plaintiff’s work and that the two works are substantially similar.

Where the design is part of a useful article, copyright protects the design only if the design is separable from the useful article and can still be conceived as a copyrightable work, either by itself or incorporated into a different useful article. Artwork imprinted on a t-shirt easily meets that test, as would the design of an embroidery pattern on a pair of jeans. A figurine that is part of the base of a lamp also qualifies. The overall design of a watch likely would not qualify, although portions of the watch, such as an artistic design on the face, bracelet, or back might meet this test.

Copyright protects a particular artistic expression; it does not protect an idea. Although copyright can protect a particular floral pattern on fabric, it does not protect the idea of fabric with flowers. Copyright can also protect an original arrangement of unprotectable elements. Thus, an artist can take images of flowers that individually would not be protectable and arrange them in an original way so that the particular arrangement could become a protectable design.

A copyright owner can seek actual damages or the profits of the infringer. The copyright owner can alternatively seek statutory damages, which can range from \$200 to \$150,000 per infringed work.

Copyright is an effective option for protection of fashion product designs where:

- the product design incorporates a pictorial, graphic, or sculptural work that is separable from the useful article; and
- the pictorial, graphic, or sculptural features of the design are sufficiently original to qualify for copyright protection.

Although U.S. law provides tools for protection of fashion designs, no single tool provides the complete answer for protecting fashion products. Although there is no one-size-fits-all tool for protecting fashion designs, the law does provide a tool box with enough tools that are versatile enough that a manufacturer can protect almost any original design.

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