



Janet Kim Lin  
Seattle, Associate

Direct Dial: 206.521.6437  
Fax: 206.386.5130  
Email Attorney



Sunita Koneru  
San Francisco, Associate

Direct Dial: 415.352.2731  
Fax: 415.352.2701  
Email Attorney



Erica Krikorian  
Seattle, Shareholder

Direct Dial: 206.521.6448  
Fax: 206.386.5130  
Email Attorney

## Alterations to the Design Piracy Prohibition Act: Innovative Design Protection and Piracy Prevention Act ("IDPPPA")

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By Janet Kim Lin, Sunita Koneru, Erica Krikorian

Design piracy has long been considered a problem by some in the fashion industry and a boon by others. Other than trademarked brand logos, fashion design has primarily been in the negative IP space; clothing often considered a "useful article" ineligible for copyright protection or unable to meet design patent requirements. Supporters of protection believe fashion designs should be afforded the same protection that other creative industries, like music and film, are given. For years, many in the fashion industry have been pushing Congress to pass legislation that would give *sui generis* protection to fashion designs. The proposed legislation will leave designs created anywhere prior to enactment in the public domain.

On August 5, 2010, Senator Charles E. Schumer (D. NY) introduced Senate Bill 3728, the Innovative Design Protection and Piracy Prevention Act ("IDPPPA"), to give fashion design short-term protection. Similar to previous versions of the bill, S. 3728 seeks to amend 17 U.S.C. §1301 *et seq.* which currently provides *sui generis* protection to boat vessel hulls.

### "Substantially Identical"

Like its recent predecessors, the IDPPPA proposes a short, three-year term of protection for new and original fashion designs. Protected designs are those with "a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs." Accordingly, designs that are "substantially identical" to protected designs are prohibited. The term "substantially identical" is defined as:

"An article of apparel which is so similar in appearance as to be likely mistaken for the protected design, and contains only those differences in construction or design which are merely trivial."

The challenge will be applying this definition. Specific factors will need to be determined to assess whether a fashion design is so "substantially identical" that it is likely to be mistaken for the original. Thus for protection, is a line for line copy of the design, cut, pattern and other features necessary to show that the copy is nearly indistinguishable from the original? What weight will design differences be given to determine whether they are merely trivial and infringing on the protected design?

Courts may look to other areas of law for guidance, such as trademark law. In determining whether trademarks are sufficiently similar, the marks are compared in terms of appearance, sound, and meaning. While the appearance of trademarks must be considered as a whole, certain features of a mark may be given more or less weight. In comparing fashion designs, will, or should, dominant design elements, or patterns be given greater weight to assess whether they are "substantially identical?"

### **"Non-Trivial"**

Also new under the current Senate bill is that designers must prove their design is a "non-trivial" variation over prior designs. Does this mean a design cannot be inspired by a past design, or be a concept within the public amounting to a trend? Designers like to believe that their creation is completely unique, but most designers pull inspiration from the art, graphics, and patterns of past designers. Interestingly, factors that may not be used in determining the uniqueness of a design are colors and pictorial or graphic elements imprinted on the fabric. If the IDPPPA is enacted, courts will need to guide designers by identifying specific factors to help address whether design variations are unique and non-trivial.

### **Registration Not Required**

The IDPPPA specifically excludes fashion design from §1301's registration requirement. Therefore, there is no initial determination by the U.S. Copyright Office as to whether a design should actually be afforded protection under the required criteria. Unlike boat hull vessel designs which are required to register, a fashion designer would make the initial determination as to whether their designs are "a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs."

A designer would indicate protection by marking designs as set forth under §1306; using the words "Protected Design," the abbreviation "Prot'd Des.," or the letter "D" with a circle, or the symbol \*D\*. Failure to mark a protected design will preclude an action for infringement before providing written notice of design protection.

Unlike boat hull designs, there is no rejection of registration to initially determine whether marking a particular design is inappropriate. While there is a penalty for false marking, a designer could under a good-faith belief continue to mark its designs as protected for the entire duration of the three-year protection period or until the design is successfully challenged in an infringement lawsuit. Where the design notice itself is sufficient deterrent for potential copyists who are unwilling to challenge such designation, there may be an over-inclusion of designs protected by the IDPPPA.

### **"Plead With Particularity"**

Although fashion designs do not need to be registered under the proposed IDPPPA, the designer bears a greater burden at the time of enforcement. The IDPPPA calls for specific pleading requirements for cases of fashion design infringement; requiring specific facts establishing that:

1. the design of the claimant is protected;
2. the design of the defendant infringes upon the protected design; and
3. the protected design or an image thereof was available in such location or

locations, in such a manner, and for such duration that it can be reasonably inferred from the totality of the surrounding facts and circumstances that the defendant saw or otherwise had knowledge of the protected design.

There are only a few types of actions that call for a "plead with particularity" standard, common-law fraud being the most notable. Hence, while designers may make the initial determination of protectability, they will bear a heightened standard of pleading when enforcing rights in their designs.

### **Conclusion**

The IDPPPA proposes some significant changes from previous versions. Currently, two major industry groups support the bill, Council for Fashion Designers of America and most recently, the American Apparel and Footwear Association. If the IDPPPA comes into effect, designers, manufacturers, retailers, and courts will have a new set of rules to consider.