

Apparel

Technology & Business Insight – From Concept to Consumer

January 8, 2010
(Circ. Online)

Design Protection for Apparel: Know your Options

Mark Schonfeld and Stephen Ball

For years, prominent apparel makers such as Louis Vuitton and Burberry have used various forms of intellectual property to protect their fabric designs. However, apparel designs, which establish the shape, style or cut for converting fabric into clothing, are generally not eligible for protection. Courts view clothing designs as "useful articles" that are not eligible for copyright protection.

Designers have tried to drive legislation aimed at enacting copyright protection for apparel designs and Congress is now considering a proposed law -- the Design Piracy Prohibition Act-- that offers such protection. The bill, however, is opposed by many large chain stores that specialize in copying the latest designs for mass market distribution.

Regardless of how Congress votes on apparel designs, designers have a number of options for protecting fabric designs that provide a purely aesthetic and non-functional purpose.

Design patents are often the first form of intellectual property one considers and they offer a strong form of protection. In addition, trade dress, a form of trademark protection, and copyright protection are also useful for protecting the non-functional aspects of a product's design. Each of these forms of intellectual property offers remedies under federal law, including the power to stop infringing activity as well as monetary compensation for the unauthorized use of protected design features.

To be sure, there is clearly significant copying occurring in the design world since imitators often can duplicate unprotected designs without recourse. Emerging designers also suffer from these "knockoffs," because their designer name becomes associated with the cheaper product. In addition, technology has accelerated the production process and because fashion collections are displayed on the runway many months before they are available to the public, the fashion copycat has plenty of time to get the copies to stores at the same time, if not earlier, than the originals. With imitations of their designs readily available, original designers find themselves at a competitive disadvantage as they are no longer marketing a new product, just a higher quality one.

To capitalize on the significant investment in design and marketing, and to enjoy the goodwill of their original designs, design owners should protect their designs from imitation and knockoffs by using these forms of intellectual property to the fullest extent possible.

Design Patent 101

Patents are considered by many to be the strongest form of protection. An important first step a designer should consider is whether or not to seek a design patent, which protects any new, original, and ornamental design for an article of manufacture. A design patent allows its owner to prevent another from making, using, or selling any product covered by the patent for a period of 14 years.

However, patent protection is unobtainable one year after any offer for sale, public use, or publication of the design. And because protection is limited to aesthetic features, a design patent can be invalidated if the design is dictated by its function. For example, it would be difficult to obtain protection for an apparel design, such as the cut of a new dress, because the cut generally has functional considerations. However, design patents are readily obtainable for fabric designs, shoe designs, and jewelry designs.

Design patent infringement is determined by a test of "substantial similarity" and copying does not have to be exact in order to infringe. In fact, a recent court case strengthened design patent protection by basing the infringement standard in an "ordinary observer" test--essentially whether the accused design "embodies" the appearance of the patented design. Most apparel companies use design patents for critical designs that are important to sales and will have a lengthy duration. Louis Vuitton, for example, has sought design patent protection for dozens of designs, including fabrics, handbags and shoes.

Trademark and Trade Dress Protection

Trademarks serve as short-hand indicators of the origin of products or services, which vendors reinforce through extensive marketing activities. Unlike a patent, a trademark has the potential for an unlimited duration. While trademarks are typically thought of as logos or taglines, a trademark can be almost anything including symbols, sounds, shapes, colors, textures, and scents. The distinctive appearance of product design or packaging can also be protected as "trade dress" when it acts as an indicator of source.

Just like patent protection, trade dress protection extends only to non-functional aspects. To be non-functional, a design element should not affect product cost, quality or a manufacturer's ability to compete in a non-reputational way. Since product design is not considered to be inherently distinctive, it must acquire "secondary meaning," or proof that the design has become distinctive in the eyes of consumers. Five years of exclusive and continuous use of a mark in commerce can be used as evidence of secondary meaning.

Trademark infringement is determined by the "likelihood of confusion" of potential consumers and can be broader than design patent protection since a potential consumer quickly scanning store shelves for a product may find two designs "confusingly similar" while an ordinary observer may not find them "substantially similar."

Trademark protection can also be obtained at any time during the life of the mark, although it must be in continual use in commerce or it may be considered abandoned. In fact, trademark value may increase with successful branding and increased consumer recognition, whereas the value of a patent decreases as its expiration approaches. It is also possible to broaden trademark protection as a company's line of goods or services expands, or as the trademark becomes increasingly recognized.

Coca-Cola serves as an excellent example of how to enhance protection with multiple forms of IP. Coca-Cola obtained a design patent for its soda bottle design in 1915 and registered its bottle design as a trademark in 1960. Today, the design remains protected under trademark law even after the design patent has expired.

Copyright Protection

In legal terms, copyright protection extends to "original works of authorship fixed in any tangible medium of expression" and restricts copying, displaying, selling, or creating derivative works. Under the Copyright Act, "pictorial, graphic and sculptural works" are specifically included, providing an inexpensive form of intellectual property protection for product design. Copyright protection is also limited to aesthetic features, so the artistic expression must have no substantial practical utility, such as a statue, or be separable from the useful article, such as a picture on a coffee mug.

Courts have held that artistic features can be "conceptually," even if not "physically," separable from utilitarian features. As a result, items such as designs for jewelry, fabrics, dinnerware patterns, dolls, Christmas decorations, coin banks, and jewelry boxes have all been found copyrightable.

Like trademark protection, there is nothing preventing copyright registration more than one year after public disclosure. Copyright protection typically has a duration of the author's life plus 70 years. To prove infringement, a copyright owner must show that an infringer copied from the original work. This requires a showing that the infringer not only had access to the copyrighted material, but also that the infringing work incorporates the original material. This puts the burden on the copyright owner since any evidence of access is likely in the defendant's possession. As a consequence, independent creation is often successfully used as a defense.

Choosing The Best Protection

Each of these forms of intellectual property has advantages and disadvantages. While patents provide straightforward protection, they have a limited duration and are unavailable more than a year after any public use. Trademarks are perhaps the broadest form of protection with a liberal infringement test and potential for unlimited duration, although they are generally not available for product designs without evidence of "secondary meaning." Copyrights are inexpensive and can offer effective protection. In the end, the three forms can be used in combination for best effect.

Design patent protection provides a valuable period of exclusivity during which one may achieve the secondary meaning needed for trade dress protection.

In this way, as the limited duration of a design patent nears expiration, designers may shift reliance to the potentially unlimited duration afforded under trademark law. If design patent protection is unavailable, copyright protection may be used instead.

In light of the resources that go into designing and marketing a product, it is prudent to seek IP protection to prevent others from unjustly profiting from your creativity and investment.

Ultimately, it is in the best interest of the designer to work with qualified professionals, including an experienced and knowledgeable IP attorney, before making any decisions.

As a design owner, you have the power to build an interconnected wall of protection to defend against imitation and to preserve market share.

Mark Schonfeld is co-chairman of the Intellectual Property Group at **Burns & Levinson LLP** in Boston; Stephen Ball is an attorney at St. Onge Steward Johnston & Reens LLC, in Stamford, Conn.