



## The History and Principles of American Copyright Protection for Fashion Design: A Strange Centennial

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### SERIES PREFACE

Between 1914 and 1916, the United States Congress saw the first serious round of lobbying by advocates seeking more robust legal protection of original industrial design and applied art, including fashion design. In the subsequent hundred years, the fashion industry has become a powerful (if fractured) force on the American legislative scene—yet fashion designers and their allies have continually failed to persuade Congress to amend federal statutes to provide greater rights in the appearance of their creations. At the same time, these stakeholders have pressed their cause in the courts, with varying results. This series of articles examines the U.S. federal courts' adjudication of the resulting disputes. In the process, the articles to come will highlight tacit assumptions, unacknowledged inconsistencies, and irreconcilable tensions in the case law. At the same time, this series will seek to shed light on largely unrecognized consistencies, coherent but under-theorized quasi-doctrines, and systematic principles that characterize—and, in many instances, are arguably unique to—U.S. “copyright-for-fashion” jurisprudence.

Before embarking on this journey, it is necessary as an initial matter to dispose of the commonly recited myth that there is “no copyright for fashion” under U.S. law. In fact, certain components of fashion design receive

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substantial—arguably too much—copyright protection under Title 17 of the U.S. Code, while others receive levels of protection that tend to hover somewhere between “nothing at all” and the full “bundle of rights” associated with contemporary American copyright. (Still other aspects of fashion design effectively receive copyright-like protection through trademark law, the recently reinvented vehicle of design-patent law, and/or causes of action under state law—though these sources of rights are generally beyond the scope of this series.) As these articles will show, the current legal landscape is the fractured, but fascinating, outcome of a confluence of historical developments, strategic litigation by stakeholders, innovative and/or counterintuitive application of precedent by federal judges, and other variables.

Of course, this series is by no means the first scholarly examination of fashion design and copyright protection under American law. Indeed, recent years have witnessed a proliferation of commentary by legal academics, practitioners, and others regarding the optimal scope and type of intellectual property protection for fashion design in the United States.<sup>1</sup> Yet much of the existing literature focuses on economic arguments for or against increased protection, other philosophical or policy-based analyses of the wisdom of enhanced rights, or political parsing of the legislative battles that have recurred over the decades. In the process, many have lost sight of the complex and idiosyncratic jurisprudential history, principles, and doctrine of *existing* copyright protection for aspects of fashion design.

The “practical” stakes of having a nuanced understanding of U.S. copyright law’s application to fashion design are hardly trivial. By one measure, “the global apparel market was valued at US\$1.7 trillion in 2012, growing

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<sup>1</sup> See discussion at Eric Wilson, *O.K., Knockoffs, This Is War*, N.Y. TIMES, Mar. 30, 2006, [http://www.nytimes.com/2006/03/30/fashion/thursdaystyles/30copy.html?pagewanted=print&\\_r=0](http://www.nytimes.com/2006/03/30/fashion/thursdaystyles/30copy.html?pagewanted=print&_r=0), [http://perma.cc/6UB4-FART] (“[I]nexpensive copies could be history if the Council of Fashion Designers of America has its way in a new anti-copying campaign in Washington. Designers like Diane Von Furstenberg, Narciso Rodriguez and Zac Posen have been journeying there to lobby for copyright protections like those governing books, music and other creative arts. Mr. Posen was in Washington on Tuesday with Steven Kolb, the executive director of the council, who said a bill could be introduced in Congress as early as today by Representative Bob Goodlatte, a Virginia Republican.”); Eric Wilson, *When Imitation’s Unflattering*, N.Y. TIMES, Mar. 13, 2008, <http://www.nytimes.com/2008/03/13/fashion/13ROW.html> [http://perma.cc/B876-D754] (“Steven Kolb, the executive director of the designers’ council, said his group would continue to push for the legislation but that it would be more difficult.”).

by 5.8% over the year.”<sup>2</sup> While the percentage of this amount consisting of American fashion is open to debate,<sup>3</sup> one can safely say that the economic importance of the industry is significant.<sup>4</sup> Yet non-partisan, sustained engagement with the contours and overarching principles of existing U.S. copyright protection for fashion has been decidedly sparse.<sup>5</sup>

This series of articles will provide an analysis—sometimes granular and doctrinal, sometimes sweeping and theoretical—of the American federal courts’ surprisingly voluminous, sometimes difficult-to-reconcile decisions concerning copyright protection for fashion design. Far from the mythic unanimity imagined by those who would declare that there is simply “no copyright protection for fashion design in the United States,” the case law in fact reflects a range of approaches to determining the rights available

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<sup>2</sup> Ashma Kunda, “New Apparel Research: Part 1 - A Focus on Geographies,” EUROMONITOR INTERNATIONAL (Mar. 11, 2013), <http://blog.euromonitor.com/2013/03/new-apparel-research-part-1-a-focus-on-geographies.html> (citing Euromonitor International, *Passport Apparel Global* (Feb. 2013), available at <http://www.euromonitor.com/passport-apparel-global/passport-subscription> (subscription required)).

<sup>3</sup> See C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1147 (2009) (“Fashion is one of the world’s most important creative industries. It is the major output of a global business with annual U.S. sales of more than \$200 billion[.]”); but see *Protecting Design*, COUNCIL OF FASHION DESIGNERS OF AMERICA, <http://cfda.com/programs/protecting-intellectual-property> [<http://perma.cc/7XHJ-2Y5N>] (last visited Dec. 30, 2014) (“Accounting for more than four million U.S. workers and \$350 billion in annual retail sales, the U.S. fashion industry represents one of the nation’s largest drivers of economic growth.”).

<sup>4</sup> Far less clear is whether economic vibrancy of the industry would be enhanced or damaged by the codification of additional U.S. intellectual-property protection for fashion design. See *discussion* at Hemphill & Suk, *supra* note 3, at 1180 (“In an influential article, Kal Raustiala and Chris Sprigman . . . have advanced the counterintuitive argument that in the fashion industry, ‘piracy paradoxically benefits designers.’ Some observers have found their argument persuasive. Here we explain why we disagree with their argument.”) (Internal citations omitted.) Raustiala and Sprigman subsequently co-authored a book making similar arguments. See *THE KNOCKOFF ECONOMY: HOW IMITATION SPARKS INNOVATION* (2012).

<sup>5</sup> See *FASHION LAW: A GUIDE FOR DESIGNERS, FASHION EXECUTIVES, AND ATTORNEYS* xv (Kolsun & Jimenez rev. ed. 2014) (“Despite the economic and cultural importance of the fashion sector, the legal profession [has been] slow to develop specific tools and treatises to serve its fashion clientele.”) (alteration in original); Hemphill & Suk, *supra* note 3, at 1147 (noting that annual U.S. retail sales of fashion are “larger than those of books, movies, and music combined”). For critical commentary on the curious disconnect between the cultural importance of fashion and the lack of attention it receives from legal scholars, see Charles E. Colman, *Trademark Law and the Prickly Ambivalence of Post-Parodies*, 163 U. PA. L. REV. ONLINE 11, 27 (2014).

therein, along with often-idiosyncratic doctrinal vehicles for adjudicating claims for the alleged infringement of those rights.

Before proceeding, it is necessary to define the scope of this inquiry into U.S. copyright protection for elements of “fashion design.” The term “fashion” is generally used throughout this series to refer to *the design (i.e., shape, color, material, and overall appearance) of items, not exclusively utilitarian in nature, that are created primarily to be worn or carried on the human body.*<sup>6</sup> Fashion’s distinctive relationship with the body immediately differentiates it<sup>7</sup> from most other material potentially eligible for copyright law—a distinction addressed later in this series. (Indeed, the importance of fashion design’s relationship with the body and the identity of the wearer has been widely studied and hotly debated<sup>8</sup>—albeit largely outside of the legal academy.)

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<sup>6</sup> This definition is necessarily artificial; it does not accord with either theoretical and practical perspectives. See EUGENIA PAULICELLI, WRITING FASHION IN MODERN ITALY 6 (2014) (“The doublesidedness of fashion is what makes it difficult to find a clearcut definition of the term’s ontological and epistemol[ogical] boundaries. Clothing can be different styles of dress, the empirical, personal and multisensorial realms that define the perception of the wearers, viewers and makers; fashion can be understood beyond clothing as part of wider cultural, economic and political systems including manners, behavior, way of life and taste.”). Certain practices regularly grouped with “fashion,” like the styling of hair, the use of makeup, and the application of tattoos, are largely excluded from this text—owing less to abstract difficulties than to the near-total absence of relevant U.S. legal decisions. I should note that “*any* definition of ‘design’ is likely to be controversial and partial . . . for reasons intrinsic to the subject: in a nutshell, the boundary between ‘art’ and ‘design’ is always necessarily fluid insofar as all artefacts can be said to have elements of both in them, whether the artefacts in question are conventionally classified as ‘art objects’ or ‘design objects.’” Jerry Palmer, *Introduction to Part I*, JERRY PALMER & MO DODSON, EDS., DESIGN AND AESTHETICS: A READER 3, 3 (Jerry Palmer & Mo Dodson, eds., 1996) (emphasis added).

<sup>7</sup> See ELIZABETH WILSON, ADORNED IN DREAMS: FASHION AND MODERNITY vii (I.B. Tauris 2013) (“Clothes are among the most fraught objects in the material world of things, since they are so closely involved with the human body and the human life cycle. They are objects, but they are also images. They communicate more subtly than most objects and commodities, precisely because of that intimate relationship to our bodies and our selves.”).

<sup>8</sup> See, e.g., Francesca Stavrakopoulou, *Female academics: don’t power dress, forget heels – and no flowing hair allowed*, THE GUARDIAN, Oct. 26, 2014, <http://www.theguardian.com/higher-education-network/blog/2014/oct/26/-sp-female-academics-dont-power-dress-forget-heels-and-no-flowing-hair-allowed> [http://perma.cc/8HCP-NDT5] (“The [sartorial conventions of academia suggest] that dressing in a more conventionally feminine way is somehow more frivolous, and can undermine perceptions of a woman’s intellectual and professional skills. Dressing in order to be taken seriously indicates that the spectre of older, more explicit forms of sexism still

More often discussed within IP jurisprudence and scholarship is a different aspect of fashion, the conceptually thorny “art/design” distinction, which has sometimes presented obstacles to the consistent application of certain well-established tenets of American copyright law. Media scholar Jerry Palmer explains the fraught nature of the imagined art-design dichotomy:

It is clear that there is a tension here between the thrust of aesthetic judgment, at least according to traditional theories where it is always conceived as universalizing; and design judgment, which must articulate the functions of artefacts, where such functions are ultimately historically and sociologically determined . . . . [Yet a]ll objects have a function of some sort by virtue of occupying some place in human society . . . and all objects have to be created according to some imaginative process where the creator imagines them in their completed state before the completions occurs in actuality. This points to ambiguities in the definition of the terms ‘design’ and ‘art.’<sup>9</sup>

Some would likely identify, not unreasonably, the puzzles identified by Palmer as central to the fractured landscape of copyright protection for fashion design in the United States.

Some might highlight related structural reasons for fashion design’s idiosyncratic posture in U.S. copyright law, noting that even purely decorative aspects of utilitarian articles were not “supposed” to be covered by copyright protection in the first place. As a strictly historical matter, it is true that the ornamental components of fashion design were initially allocated to the branch of American intellectual property law known as *design-patent law*.

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hovers over us: a woman who adopts a more feminine style is too preoccupied with pretty things to be a serious academic, because a woman can’t be both attractive and intelligent – if indeed she can be intelligent at all.”); Tracey M. Lewis-Giggetts, *The Campus Style Police: “Your Look is a Bit Wild.”*, CHRONICLE VITAE, Dec. 5, 2014, <https://chroniclevitae.com/news/826-the-campus-style-police-your-look-is-a-bit-wild> [http://perma.cc/Z5H5-CTPP] (“assumptions made about a person of color based on superficial and prejudiced views of ‘appropriate’ hair, dress, and clothing—particularly if held by those with administrative and hiring power—can affect critical decisions, including promotions and committee appointments”); Grayson Perry, *The Straight, White, Middle-Class Man Needs to Be Dethroned*, NEW REPUBLIC, Oct. 10, 2014, <http://www.newrepublic.com/article/119799/straight-white-middle-class-default-man-needs-be-dethroned> (“In people’s minds, what do professors look like? What do judges look like? What do leaders look like? The very aesthetic of seriousness has been monopolized by Default Man. Practically every person on the globe who wants to be taken seriously in politics, business, and the media dresses up in some way like a Default Man, in a grey, western, two-piece business suit. Not for nothing is it referred to as ‘power dressing.’”).

<sup>9</sup> Palmer, *supra* note 6, at 3.

It is perhaps instructive that the picture of copyright protection for fashion was relatively uncomplicated until design patents were judicially marginalized in the early years of the Twentieth Century.<sup>10</sup> As design patents lost their viability in federal-court litigation, designers wishing to assert exclusive rights in works of fashion, interior decoration, and other works channeled their efforts into both legislative lobbying and litigation that increasingly drew on alternative types of IP—not only copyright,<sup>11</sup> but trademark (specifically, “trade dress”) law as well.<sup>12</sup> An examination of the developments in these areas of IP law quickly reveals some of the same sociocultural dynamics that led to the multi-decade period of design patents’ near-complete irrelevance in litigation.<sup>13</sup> It seems very probable indeed that these cultural dynamics have played, and continue to play, at least as prominent a role in shaping the contours of copyright protection for fashion design as strictly “doctrinal” concerns.<sup>14</sup>

Still other features of American fashion have arguably contributed to the development of the doctrine in this area, including fashion’s “bad repu-

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<sup>10</sup> See discussion at Charles E. Colman, *Design and Deviance: Patent as Symbol, Rhetoric as Metric*, 55 JURIMETRICS J. (forthcoming 2015). For an alternative account of this marginalization, see Jason Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZAGA L. REV. 531 (2010).

<sup>11</sup> See David Goldenberg, *The Long and Winding Road: A History of the Fight over Industrial Design Protection in the United States*, 45 J. COPYRIGHT SOC’Y U.S.A. 21, 27 (1997) (noting that “after the adoption of the Copyright Act of 1909, design protection strategy [in Congress] fundamentally shifted,” as “[a]ttempts to amend the design patent statute were abandoned” in favor of legislation that would provide for “a copyright-like, registration only regime (without a search of prior art”).

<sup>12</sup> See Gerard N. Magliocca, *Ornamental Design and Incremental Innovation*, 86 MARQUETTE L. REV. 846, 858 (2003) (“Taking advantage of the dual nature of trade dress, designers often try to obtain protection for their work by claiming that it performs an identifying function for consumers.”) (Internal footnote omitted, due in part to this author’s disagreement with much of Magliocca’s historical and policy analysis.).

<sup>13</sup> See Sarah Burstein, *GUEST POST: “What makes a fashion design ‘obvious?’”* by Sarah Burstein (Associate Professor, U. of Oklahoma College of Law), LAW OF FASHION, Feb. 13, 2013, <http://lawoffashion.com/blog/story/02/13/2013/176> [<http://perma.cc/67YS-Z8MJ>] (noting that after decades of irrelevance, “[d]esign patents are the intellectual-property regime *du jour* for fashion designs”).

<sup>14</sup> See Charles Colman, *A ‘Female Thing’: Fashion, Sexism, and the United States Federal Judiciary*, 4 VESTOJ 53, 53 (2013) (“As ‘fashion’ was, from the creation of the United States until, arguably, the late 1960s, associated primarily with the female sex, while judges during this time period were almost exclusively male, one naturally wonders whether the power dynamics of gender shaped the development of the law pertaining to fashion. There is good reason to believe that this has indeed been the case.”).

tation” as a vehicle for “conspicuous consumption” and class stratification,<sup>15</sup> the oft-recited (but highly questionable<sup>16</sup>) notion that there is “nothing new in fashion,”<sup>17</sup> and the purportedly “ephemeral” popularity of any particular item or style.<sup>18</sup> These issues, each less straightforward than is likely apparent at first glance,<sup>19</sup> share some of the responsibility for the strange doctrinal twists and turns of American copyright for fashion design.

With that said, the primary purpose of this series is not to map the complex array of social, cultural, and cognitive factors that have shaped current intellectual-property doctrine pertaining to fashion design—I have tackled such questions more directly and thoroughly in other scholarship<sup>20</sup>—but rather to examine what that doctrine *is*. The focus of this series is on the principles, past and present, guiding the application of copyright protection to components of fashion design under U.S. law—and how those

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<sup>15</sup> See Colman, *supra* note 5, at 27 *et seq.* (explaining continuing, though misguided, influence of Thorstein Veblen’s 1899 theory of “conspicuous consumption” in contemporary legal discussion of fashion design).

<sup>16</sup> Cf. CHRISTOPHER BREWARD, FASHION 71-83 (2003) (noting three examples of fashion designers whose creations were indisputably novel, whether because of innovative construction, unique perspective, or the “ability to develop a historical quotation into something uncompromisingly contemporary”).

<sup>17</sup> See *discussion* at Hemphill & Suk, *supra* note 3, at 109-115.

<sup>18</sup> For a representative example, see Magliocca, *supra* note 12, at 847-48 (asserting that because “their life span is so short,” the “optimal term” of IP protection for “[ae]sthetic designs and other marginal improvements” is “only a matter of months”).

<sup>19</sup> One common characteristic of much scholarly discourse on intellectual property is that while it purports to engage in objective policy analysis (of the optimal scope and duration of rights, if any, in “aesthetic designs”), it often serves to reify culturally contingent—and often dispositive—value judgments and social norms that operate on the level of what might be called “deep discourse.” See *discussion* at Colman, *supra* note 10. Operative terms, like “originality,” “innovation,” and “authorship” (to name just a few) tend to be inadequately scrutinized for the premises on which they rest. For further discussion, see LAWRENCE ROSEN, LAW AS CULTURE: AN INVITATION 7-8 (2006) (“It is no mystery that law is part of culture, but it is not uncommon for those who, by profession or context, are deeply involved in a given legal system to act as if ‘The Law’ is quite separable from other elements of cultural life . . . . But context is crucial: When we hear a court speak of ‘the conscience of the community,’ ‘the reasonable man,’ or ‘the clear meaning of the statute,’ when we . . . listen to counsel debate whether surrogate motherhood or a frozen embryo should be thought of in terms of ‘ownership,’ we know that the meaning of these concepts will come not just from the experience of legal officials or some inner propulsion of the law but from those broader assumptions, reinforced across numerous domains, that characterize the culture of which law is a part.”).

<sup>20</sup> See generally Colman, *supra* notes 5, 10, 14.

principles manifest in consistent and inconsistent, defensible and indefensible, ways.

This series of five articles will begin with a broad overview of historical developments in American fashion design and copyright law—and the intersection of the two—taking note of certain foundational aspects of English law in the early 1700s and jumping forward to notable developments, through late 1980s, by which point the basic doctrinal framework of U.S. copyright-for-fashion had coalesced. The second installment in this series, *On ‘Originality,’* will examine ways in which certain core tenets of copyright law, including “originality” and the interrelated notion of the “idea-expression” distinction, have been judicially implemented in cases concerning fashion design. The third installment, *On ‘Separability,’* will scrutinize the theoretical basis for, and “on-the-ground” application of, U.S. law’s asserted distinction between the non-copyrightable “useful articles” of fashion and design elements deemed copyrightable as “physically or conceptually separable” from such articles. The third installment will proceed to identify lines of judicial decisions applying copyright doctrines, in often-unexpected ways, to disputes over the major categories of “separable” design components, including fabric patterns, superimposed images, embroidery, lace, jewelry, and aspects of fanciful costumes. The fourth installment in the series, *On ‘Similarity,’* will parse the often-opaque mechanics of copyright infringement as they have operated in the context of fashion design. Here again, judicial application of supposedly one-size-fits-all standards reveals unexpectedly systematic and nuanced treatment of certain types of fashion works, even as other decisions reflect irreconcilable tensions in the doctrine. The fifth and final series installment, *The Politics of ‘Piracy,’* will resume the historical narrative where the first installment left off, in 1987, with an account of notable lobbying efforts and legislative activity concerning copyright(-like) protection for fashion design over the past thirty years. That final article will identify the key players, recurring rhetorical strategies, and successes and failures of important stakeholders in the debates surrounding American IP legislation tailored to fashion design.

The articles in this series should not be considered a comprehensive survey of—and certainly not the last word on—the subject of U.S. copyright protection for fashion design.<sup>21</sup> This series does not (nor could it)

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<sup>21</sup> Further, copyright protection plays a major role in fashion outside the realm of “design”: a recent news story provides just one illustrative example. See Doreen Carvajal, *Koons Again Accused of Copyright Infringement*, N.Y. TIMES ARTSBEAT, Dec. 19, 2014, 2:26 P.M., <http://artsbeat.blogs.nytimes.com/2014/12/19/koons-again-ac-cused-of-copyright-infringement/> [<http://perma.cc/F77S-F3ZL>] (“Franck Davidovici, creator of a 1985 ad campaign for the French clothing retailer Naf Naf featur-



address every rule, exception, statutory provision and judicial decision concerning intellectual-property protection for fashion in the U.S.—let alone similar or alternative protection available under the laws of other countries.<sup>22</sup> As noted above, the primary focus here is on overarching themes, consistencies, and inconsistencies within the body of case law that has emerged concerning U.S. copyright protection for fashion design. Though many specific judicial decisions are used in furtherance of this goal, this series is not and should not be considered a treatise or any sort of “reference guide,” in the traditional sense. Indeed, as will quickly become apparent, even as this series attempts to answer certain questions about U.S. copyright protection for fashion design, it will pose many *new* questions that do not lend themselves to easy answers—to the extent there are correct “answers” at all.

## I. INTRODUCTION TO “A STRANGE CENTENNIAL”

Lawyers and non-lawyers alike often parrot the notion that “[U.S.] copyright protection does not cover apparel.”<sup>23</sup> It is true that the United States

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ing a similar figure and pig, is pressing a legal complaint” against appropriation artist Jeff Koons over two works, both entitled “Fait d’hiver,” in which “mannequins share the same tousled dark hair [in the original ad and the Koons variation], and are sprawled in what appears to be snow, post-avalanche [but] the Koons woman is wearing sunglasses and the pig is wreathed in red flowers alongside some penguins.”).

<sup>22</sup> The laws of other countries, and potentially relevant international treaties and agreements, are mentioned only in passing throughout this series; such discussion will be limited and primarily in the service of illuminating the subject of copyright protection for fashion design in the United States. In general, the existence of such laws and/or agreements does not impact the doctrinal landscape of copyright protection for fashion design until/unless Congress implements changes via statutory amendment, so addressing the latter will generally be sufficient for the purposes of this series. This is so because intellectual property protection, including copyright law, is generally “territorial” in nature. (Even if one owned a valid copyright in a design under French law, that copyright—as opposed, notably, to a French court’s judgment for infringement of that copyright, in certain instances—cannot be directly enforced in the United States.) While the principle of territoriality has recently been tested by both industrial realities (like the ever-more complex global supply chain on which the fashion industry is dependent) and doctrinal developments (like the U.S. federal courts’ heightened sensitivity to issues concerning choice of law, foreign affiliates, etc.), “territoriality” nevertheless remains a fundamental principle of copyright law in the United States.

<sup>23</sup> See, e.g., Kristi Ellis, *Design Piracy Bill Reintroduced in Congress*, WOMEN’S WEAR DAILY, Sep. 10, 2012, available at <http://www.wwd.com/business-news/government-trade/design-piracy-bill-reintroduced-in-senate-6261424> (subscription re-

Code contains a bar on copyright protection for “useful articles”—a category into which many items comprising “fashion,” do indeed fall (and likely the basis for the above-noted tendency to overgeneralize). Importantly, however, this “useful article” bar to copyright protection is *itself* subject to exceptions ranging from the very narrow to the surprisingly broad. The only way to appreciate the contours of copyright protection for fashion design in the United States, whether “on the books” or in practice, is to survey the often-idiosyncratic judicial decisions of the federal courts.<sup>24</sup> Reliance on

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quired) (“Copyright protection does not cover apparel, because articles of clothing are currently considered ‘useful articles’ as opposed to works of art.”); Marie-Andrée Weiss, *Puss In (Infringed?) Boots*, THE IPKAT (Sep. 17, 2014, 6:54 PM), <http://ipkitten.blogspot.com/2014/09/puss-in-infringed-boots.html> [http://perma.cc/J8L7-APQL] (“As a reminder, U.S. copyright law does not allow for the protection of useful items, which has left fashion designers with the options of protecting their work either with a design patent, or by claiming that a particular design is a trade dress, as it has acquired secondary meaning and can thus protected by trademark law.”).

<sup>24</sup> There is a colorable argument that there exists “common-law copyright protection” for (at least unpublished) works of fashion design. *See* Capitol Records v. Naxos of America, 4 N.Y.3d 540, 552-53 (2005) (“To insure that the 1909 Act would not be interpreted to deny any existing common-law protection, Congress explicitly stated that the Act ‘shall [not] be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.’”). The contours of this common-law protection remain uncertain, even in far more fleshed-out contexts than that of fashion design. *See, e.g.,* Flo & Eddie, Inc. v. Sirius XM Radio Inc., No. 13 Civ. 5784(CM), 2015 WL 585641, at \*1, \*2 (S.D.N.Y. Feb. 10, 2015) (certifying interlocutory appeal under 28 U.S.C. § 1292(b) based on “substantial ground for difference of opinion” concerning District Court’s earlier ruling “that under New York law the right to publicly perform sound recordings is part of the bundle of rights associated with common law copyrights in those recordings”). Some courts have acknowledged the possibility of the existence of common-law copyright in unpublished works of fashion design. *See* Fashion Originators Guild of America v. Federal Trade Commission, 114 F.2d 80, 83, 84 (“[W]e have been unable to discover any case which squarely presented the situation— that is, in which ‘intellectual property’ not covered by the copyright act then in existence, was challenged because of its ‘publication’— there are plenty of general expressions in the books that the ‘common-law property’ does not survive . . . . We conclude therefore that, regardless of whether the Guild’s designs could be registered or not, ‘publication’ of them was a surrender of all its ‘common-law property’ in them. To embody a design in a dress or a fabric, and offer the dress for general sale was such a ‘publication’; nothing more could be done to bring it into the public demesne. It may be unfortunate— it may indeed be unjust—that the law should not thereafter distinguish between ‘originals’ and copies; but until the Copyright Office can be induced to register such designs as copyrightable under the existing statute, they both fall into the

“rules of thumb,” while potentially risky in any area of law, is especially problematic in the context of American copyright protection for works of fashion design.

As this series will recount, the past century has witnessed repeated bursts of lobbying efforts for legislation creating (more) robust copyright—or copyright-like—protection for works of fashion design. Such efforts gained newfound momentum in the second half of the first decade of the 2000s.<sup>25</sup> While much of this momentum has been lost as of this writing,<sup>26</sup> it remains important to monitor legislative developments in this area. Until a legislative overhaul does occur (which history suggests is a long shot—though not an impossibility, particularly given the long-term trend toward international harmonization of copyright regimes), it remains crucial to understand the scattered and often difficult-to-reconcile decisions of the U.S. federal courts, which—as reflected in the focus of this series—have long provided the bulk of the relevant law in this area.

Before delving into a detailed discussion of the history of American copyright protection for fashion design, it is prudent to pose a fundamental question: what is “copyright,” under U.S. law, more generally? American copyright is a form of quasi-property, authorized by what some call the “Intellectual Property Clause”<sup>27</sup> of the Constitution, located at Article I,

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public demesne without reserve.”) (citing *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929)); compare *A. J. Sandy, Inc. v. Junior City, Inc.*, 17 A.D.2d 407, 409 (N.Y. App. Div. 1962) (“The first and second causes of action link inseparably dress design, artwork, photographs and literary material under the broad heading ‘copyrightable materials’. In the absence of copyright to design patent, dress designs clearly are not protected by so-called common law copyright for design copyrights do not exist at common law.”). Non-copyright causes of action might be available to the aggrieved designer in certain instances. See *Quadrille Wallpapers & Fabric, Inc. v. Pucci*, 1:10-CV-1394 (LEK/DRH), 2011 U.S. Dist. LEXIS 95457 (N.D.N.Y. Aug. 24, 2011) (discussing circumstances in which theft of uncopyrightable designs may nevertheless give rise to a non-preempted cause of action). However, the viability and mechanics of such theories are largely beyond the scope of this five-article series.

<sup>25</sup> See Eric Wilson, *O.K., Knockoffs, This Is War*, N.Y. TIMES, Mar. 30, 2006, <http://www.nytimes.com/2006/03/30/fashion/thursdaystyles/30copy.html>.

<sup>26</sup> See Kristi Ellis, *CFDA, AAFA Taking New Tack on Design Piracy*, WOMEN’S WEAR DAILY, Mar. 20, 2012, available at <http://www.wwd.com/business-news/government-trade/cfda-aafa-taking-new-tack-on-design-piracy-5812260> (subscription required) (reporting on fashion-industry trade groups’ decision to put lobbying effort on backburner in favor of devoting resources to alternative approaches to combating unauthorized copying).

<sup>27</sup> The term “intellectual property” was unknown in the eighteenth century. Edward C. Walterscheid, *To Promote the Progress of Science and the Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*,

Section 8: “The Congress shall have power to . . . promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries[.]”<sup>28</sup>

As the constitutional language reveals, the Framers generally viewed copyright protection as a “reward to the author or artist serves to induce release to the public of the products of his creative genius”<sup>29</sup>—a rationale that is still invoked, if increasingly scrutinized,<sup>30</sup> today. But even if we assume that copyright is necessary to encourage the production and distribution of certain works, which “products of creative genius” should receive protection—and what should the scope and term of an author’s rights be?

The Constitution refers only to “writings” as being eligible for copyright, but “Congress has always construed this term broadly, and in doing so has been uniformly supported by judicial decision . . . for instance, interpret[ing the language] as authorizing subject-matter so remote from its popular [meaning] as photographs, paintings, statuary, and dramas, even if unwritten.”<sup>31</sup> Such judicial decisions include, for example, the Supreme

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2 J. INTELL. PROP. L. 1 n.1 (1994). I will nevertheless use the term “Intellectual Property Clause” (or “IP Clause,” for short) to refer to this constitutional provision addressing copyrights and patents.

<sup>28</sup> Taking the words of the IP Clause at contemporary face value would be misleading, for “the colonial usage of the term ‘useful arts’ referred to scientific inventions that were to be protected by patent laws requiring proof of novelty, [while] the word ‘science’ was taken to mean an organized system of knowledge that was the product of authorship and was to be protected by copyright laws.” ALINA NG, COPYRIGHT LAW AND THE PROGRESS OF SCIENCE AND THE USEFUL ARTS 24-25 (2011).

<sup>29</sup> *Eldred v. Ashcroft*, 537 U.S. 186, 227 n.4 (2003) (Stevens J., dissenting) (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 158 (1945)).

<sup>30</sup> See, e.g., Greg Lastowka, *Innovative Copyright*, 109 MICH. L. REV. 1011, 1013 (2011) (“Of course, while the theory provides that IP contributes to innovation and creativity, everyone knows that IP rights are not absolutely necessary to produce art and inventions . . . . [T]he question is really how much of an IP right produces the optimal social benefits.”). This skepticism can be observed even outside the academy. See, e.g., Mike Masnick, *Yet Another Example Of Creativity Exploding Without Copyright Law: Football Plays*, TECHDIRT (Oct. 1, 2010, 8:24 AM), <http://www.techdirt.com/articles/20100926/21424511172/yet-another-example-of-creativity-exploding-without-copyright-law-football-plays.shtml> [<https://perma.cc/D2YT-CSRJ>].

<sup>31</sup> S. REP. NO. 59-6187, at 4 (1907). The 1907 Senate Report continued: “As thus interpreted, the word ‘writings’ would to-day [*sic*] in popular parlance be more nearly represented by the word ‘works’ . . . including ‘all forms of record in which the thought of an author may be recorded and from which it may be read or reproduced.” But while the term “writings” may be underinclusive of the subject matter eligible for copyright protection, the word “works” is decidedly overinclusive, for reasons explained later in this chapter.

Court's 1884 decision in *Burrow-Giles Lithographic Co. v. Sarony*, declaring appropriate for copyright protection "all forms of writing, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression."<sup>32</sup>

Once the threshold question of eligible subject matter is resolved, one reaches the question of the specific rights held by the copyright owner. The Supreme Court has said, of 17 U.S.C. § 106, the operative provision under contemporary U.S. copyright law, that

[T]he Copyright Act confers a bundle of exclusive rights to the owner of the copyright. Under the Copyright Act, these rights – to publish, copy, and distribute the author's work [among other rights] – vest in the author of an original work from the time of its creation. § 106. In practice, the author commonly sells his rights to publishers who offer royalties in exchange for their services in producing and marketing the author's work.<sup>33</sup>

In contrast to the oft-repeated rationale for creating and awarding copyright protection in the United States—"motivat[ing] the creative activity of authors . . . by the provision of a special reward, and to allow the public access to the products of their genius"<sup>34</sup>—continental European copyright law has been said to rest on "radically different foundations," such as "preserving the dignity and personhood of creators."<sup>35</sup> Whether or not this conventional wisdom is correct,<sup>36</sup> it is helpful to keep such rhetoric—as well as the culturally contingent status of the "fashion designer"—in mind when studying the highly delineated rights in the appearance of fashion designs under U.S. law.

## II. THE HISTORY OF COPYRIGHT PROTECTION (OR LACK THEREOF) FOR FASHION DESIGNS IN THE UNITED STATES

While contemporary copyright protection resembles a private property right,<sup>37</sup> copyright's early life, was, perhaps surprisingly, most closely

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<sup>32</sup> 111 U.S. 53, 58 (1884) (rejecting argument that Congress could not constitutionally codify copyright protection for at least some forms of photography).

<sup>33</sup> *Harper & Row, Publrs. v. Nation Enters.*, 471 U.S. 539, 546-47 (1985).

<sup>34</sup> *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

<sup>35</sup> See Brian Angelo Lee, *Making Sense of "Moral Rights" in Intellectual Property*, 84 *TEMPLE L. REV.* 71, 73 (2011).

<sup>36</sup> *Id.* at 76.

<sup>37</sup> See, e.g., *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) ("[T]he limited grant [of exclusive rights, in the form of copyright] is a means by which an important public purpose may be achieved. It is intended to

intertwined with royal censorship. The so-called “right of copy,” defined as “the exclusive right to print and sell copies of a book or other literary work,” was initially regulated in the United Kingdom by royal “Letters Patent.”<sup>38</sup> In sixteenth-century England, the right to print and sell a book could only be obtained through a grant, in the form of a “patent,” from the Crown, and was unavailable to those who would challenge royal prerogatives.<sup>39</sup> A 1557 charter, issued by Queen Mary Tudor to a London printers’ guild, granted the “Stationers’ Company” the essentially exclusive right to print approved books, providing the guild with a strong economic incentive to destroy any unapproved books published by would-be competitors.<sup>40</sup> British Parliament wrested power from the Crown in 1641, only to adopt a series of licensing acts that effectively preserved the Company’s monopoly.<sup>41</sup>

In 1695, after a clash between the upper and lower houses of British Parliament, the Licensing Act of 1662 expired without renewal.<sup>42</sup> Little legislative action was taken over the next fifteen years, while “it remained uncertain just how far the common law was adequate to deal with an emerging and increasingly unruly press.”<sup>43</sup> At the same time, “it was becoming evident that the control and censorship of the book trade, if it was required at all, could be effectively addressed as an issue, separately from any need to provide for the property in such books.”<sup>44</sup>

A complex array of factors<sup>45</sup> led to the passage, in 1710, of the so-called “Statute of Anne,” which forever changed the trajectory of “the right of copy” in common-law countries.<sup>46</sup> Whereas the previous legislative regime had arranged for the Stationers’ Company to purchase manuscripts from au-

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motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.”).

<sup>38</sup> Howard B. Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29 WAYNE L. REV. 1119, 1135 (1983).

<sup>39</sup> *Id.*

<sup>40</sup> *Id.* at 1136.

<sup>41</sup> *Id.* at 1137.

<sup>42</sup> RONAN DEAZLEY, ON THE ORIGIN OF THE RIGHT TO COPY: CHARTING THE MOVEMENT OF COPYRIGHT LAW IN EIGHTEENTH CENTURY BRITAIN (1695-1775) 1 (2004)

<sup>43</sup> *Id.* at 6.

<sup>44</sup> *Id.* at 29.

<sup>45</sup> See *id.* at 221-22 (examining contradictory accounts of the decisive social, political, and cultural factors driving the enactment of the Statute of Anne, and arguing that a nuanced examination of historical evidence “exposes the fiction of the larger, unified and coherent form” often grafted onto the history of copyright).

<sup>46</sup> Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent and Copyright Clause*, 84 J. PAT. & TRADEMARK OFF. SOC’Y 909, 914 (2002).

thors,<sup>47</sup> essentially making the distribution of works contingent on both the acceptability of their content and on authors' transfer of any applicable legal interest apart from the right to receive certain royalties, the Statute of Anne proclaimed that "the Author of any Book . . . shall have the sole Right and Liberty of printing such Book."<sup>48</sup> The Statute went on to provide that regardless of any subsequent purchase of an author's copyright, "after the expiration of the [initial] term of fourteen years, the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years."<sup>49</sup> The statute did not explicitly address subject matter other than books. The United Kingdom would enact legislation covering certain works of fashion design at a surprisingly early date, in 1787<sup>50</sup>—but this, of course, took place after the American Revolution and did not exert any immediate influence on IP policy in the United States, due in part to the very different cultural politics and economic agendas prevalent in the two countries.<sup>51</sup>

With that said, "the early years of copyright in the United States paralleled the development of copyright in England in [certain] respects," including the passage of "a copyright act modeled after the Statute of Anne."<sup>52</sup> Indeed, shortly after the ratification of the Constitution, the first federal<sup>53</sup> copyright law in the United States was enacted by Congress, titled

<sup>47</sup> Abrams, *supra* note 38, at 1171.

<sup>48</sup> An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, During the Times therein mentioned, 1710, 8 Anne, c. 19 (1710).

<sup>49</sup> *Id.*

<sup>50</sup> An Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Callicoes, and Muslins, by vesting the Properties thereof, in the Designers, Printers and Proprietors, for a limited time, 1787, 27 Geo.III, c.38 (1787) (hereinafter "Calico Printers' Act") (conferred exclusive rights lasting two months on those first printing "new and original" patterns on linens, cottons, calicoes and muslins). See Ronan Deazley, *Commentary on the Calico Printers' Act 1787*, in L. BENTLY & M. KRETSCHMER, EDS., PRIMARY SOURCES ON COPYRIGHT (1450-1900) (2008), [http://www.copyrighthistory.org/cam/commentary/uk\\_1787/uk\\_1787\\_com\\_1072007131417.html](http://www.copyrighthistory.org/cam/commentary/uk_1787/uk_1787_com_1072007131417.html) <http://perma.cc/GAX2-U23Y>].

<sup>51</sup> See generally Kate Haulman, *Fashion and the Culture Wars of Revolutionary Philadelphia*, 62 WILLIAM AND MARY QUARTERLY 621 (2005); Ruthann Robson, *Beyond Sumptuary: Constitutionalism, Clothes, and Bodies in Anglo-American Law, 1215-1789*, 2 BR. J. AM. LEG. STUDIES 477, 502-509 (2013); cf. Mary Lynn Stewart, *Copying and Copyrighting Haute Couture: Democratizing Fashion, 1900-1930s*, 28 FRENCH HISTORICAL STUDIES 103 (2005).

<sup>52</sup> PAUL GOLDSTEIN, COPYRIGHT'S HIGHWAY: THE LAW AND LORE OF COPYRIGHT FROM GUTENBERG TO THE CELESTIAL JUKEBOX 51 (1st ed. 1994).

<sup>53</sup> State copyright laws preceded the passage of the federal act in all but one of the original states. *Id.*

(much like its English precursor) as “An Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.”<sup>54</sup> Like the Statute of Anne, the 1790 Act provided for an initial term of protection of fourteen years for new works, followed by a renewal term of 14 years if the author survived the first term. Among important questions not answered by the text of the U.S. Copyright Act of 1790, however, was whether authors of works other than “maps, charts, and books” enjoyed any enforceable copyright, and if so, under what law(s). The question would not arise in the fashion-design context for many years to come.<sup>55</sup>

To be sure, the U.S. Congress, with occasional nudges—or pushes—from the federal judiciary, has amended the copyright laws many times over the years to bring a variety of new categories of works within the ambit of copyright protection. (Congress has also repeatedly extended the term of protection for such works; for most works, the duration of copyright now stands at the life of the author, plus seventy years.<sup>56</sup>) But despite these expansions, and despite many advocates’ dogged attempts in the legislature and the courts to obtain robust copyright protection for fashion designs, such works are still left substantially—though, as noted above and discussed in depth below, not entirely—unprotected under U.S. copyright law.

The gradual expansion of federal copyright protection, and the current fragmented doctrinal landscape concerning protection for works of fashion design, can be understood through a survey of major legislative and judicial developments. In 1802, decades before the concept of individual “authorship” in fashion had been meaningfully recognized in mainstream American culture,<sup>57</sup> Congress extended copyright’s embrace around “any historical or other print or prints [that the author had] designed and engraved, etched, or worked.”<sup>58</sup> In 1831, Congress further expanded copyright protection

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<sup>54</sup> Act of May 31, 1790, ch. 15, 1 Stat. 124. The Statute of Anne had begun as follows: “An act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers of such copies, during the times therein mentioned.” 8 Anne, c. 19 (1710).

<sup>55</sup> The most influential factors contributing to the passage of Britain’s 1787 Calico Printers’ Act, though applicable in some other European countries, were largely inapplicable in the new United States. See *discussion supra* at text accompanying notes 50 and 51; see especially Robson, *supra* note 51, at 502-509 (surveying salient political and economic landscape concerning fashion in the U.S. of the late 1700s).

<sup>56</sup> See generally Eldred v. Ashcroft, 537 U.S. 186 (2003).

<sup>57</sup> See *discussion* at BREWARD, *supra* note 16, at 25-47; accord. BLUM, *infra* note 88 (illustrating the evolution of rhetoric concerning designers in *Harper’s Bazaar* between 1867 and 1898).

<sup>58</sup> Act of Apr. 29, 1802, 2 Stat 171.



through the first major overhaul of the copyright laws since the original Copyright Act, in a law titled “[A]ct to amend the several acts respecting copyright, musical compositions, and cuts, in connection with prints and engravings.”<sup>59</sup> While this codification of IP rights for “prints and engravings” took place long after the passage of similarly targeted legislation in the UK,<sup>60</sup> it is emblematic of the first real—albeit embryonic—flourishing of the arts in the U.S.

In 1842, the United States Congress, apparently prompted in part by recent British legislation regularizing intellectual-property protection for works of industrial design<sup>61</sup> codified an entirely new domestic regime for the grant of “design patents.” This new type of IP protection was not heavily

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<sup>59</sup> Act of Feb. 3, 1831, 4 Stat. 436.

<sup>60</sup> Engravers’ Copyright Act, 1735, 8 Geo.II, c.13. See discussion at Deasley, *supra* at note 45, text accompanying note 3 (“[In 1735, the British House of Commons had received a petition from a group of artists and engravers complaining that when they had] ‘finish’d a Design, which has taken them up Time, and Pains, and Thought in the Execution, and procured at a considerable Expence Engravings, or any other Sort of Prints from their Designs,’ their original designs were reproduced by ‘Copyers’ who were ‘no better than the Lowest of Robbers.’) (quoting *The Case of Designers, Engravers, Etchers, &c., Stated in a Letter to a Member of Parliament*, Lincoln’s Inn Library, M.P.102, Fol.125 (1735)).

<sup>61</sup> See “Report from the Select Committee on Copyright of Designs; together with the Minutes of Evidence Taken Before Them,” in HOUSE OF COMMONS PAPERS, REPORTS FROM COMMITTEES, Vol. VI, Session Jan. 16-Aug. 11, 1840 442 (1840) (discussing design laws passed to date: 27th Geo. III, c. 38 [Designing and Printing of Linens, etc. Act 1787 c. 38]; 29th Geo. III, c. 19 [Designing and Printing of Linens, etc. Act 1789 c. 19]; 34th Geo. III, c. 23 [Linens, etc. Act 1794 c. 23]; 2d Vict. c. 13 [Copyright of Designs Act 1839 c. 13]; 2d Vict. c 17 [Copyright of Designs Act 1839 c. 17]). See also U.K. Intellectual Property Office, “History of designs,” <http://www.ipo.gov.uk/types/design/d-about/d-what-is/d-history.htm> (last visited Feb. 27, 2013) (“The first Act dealing with copyright in industrial designs was the Designing & Printing of Linen Act in 1787. This gave a very limited copyright protection to those who engaged in the ‘arts of designing and printing linens, cottons, calicos and muslin’. It gave proprietors the sole right of printing and reprinting for 2 months from the date of first publication, provided the name of the proprietor was marked on each piece. In 1794 the period of protection was extended to 3 months. From 1839 a series of laws were passed, gradually extending the boundaries of design protection. The Copyright and Design Act 1839 considerably increased the protection given to fabrics by extending the law to fabrics composed of wool, silk or hair and to mixed fabrics. The same Act extended protection far beyond the textile trade and gave us the foundations of modern design law. It gave protection to every new or original design including textiles. It also allowed protection for the ornamentation and for the shape and configuration of any article of manufacture.”).

used during its first two decades.<sup>62</sup> However, one of the first recorded judicial opinions concerning design-patent law—an 1847 district-court decision finding that a defendant had infringed a patentee’s rights in the appearance of fashionable silk buttons<sup>63</sup>—arguably suggests that design patents could have provided a potential remedy that countless future fashion designers would claim to be necessary—had the doctrine in that new area of intellectual-property protection law not strayed so dramatically off-course.<sup>64</sup>

Throughout the mid-Nineteenth Century, Congress made a series of largely administrative amendments to both the patent and copyright laws. While some of these statutory revisions tinkered with the design-patent laws, the relevant legislative activity does not evince a clear policy imperative: the statutory language specifically mentioning “new and original design[s] for the printing of woolen, silk, cotton or other fabrics,” for example, was removed in 1861—without any immediately apparent objective or effect<sup>65</sup>—only to be reinstated in 1870.<sup>66</sup>

Meanwhile, Congress was busy making substantive revisions to the copyright laws; in 1870, the copyright statutes were amended to provide, for the first time, exclusive rights to authors of “paintings, drawings, chromolithographs, statues and statuaries, and ‘models or designs intended to be perfected as works of fine art.’”<sup>67</sup> Again, there was no mention of fashion, and (as discussed below), it seems beyond reasonable dispute that industrial design and applied art—to use contemporary terminology—were assumed to be outside the purview of the statutory language.

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<sup>62</sup> See WILLIAM LEONARD SYMONS, *THE LAW OF PATENTS FOR DESIGNS* 5 (1914).

<sup>63</sup> *Booth v. Garrelly*, 3 F. Cas. 883, 884 (C.C.S.D.N.Y. 1847).

<sup>64</sup> For a culturally grounded “critical history” of design patents’ decline as a viable form of IP protection for fashion design, see generally Colman, *supra* note 10. For a primarily doctrinal account of the decline, arguing that an unduly stringent “nonobviousness requirement was . . . forced on design patents through an odd series of administrative, legislative, and judicial mishaps,” see Jason Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZAGA L. REV. 531, 535 (2010).

<sup>65</sup> See Du Mont, *supra* note 64, at 547 n.99.

<sup>66</sup> See *id.* at 564 n.198.

<sup>67</sup> Act of July 8, 1870, §§ 85-111, 41st Cong., 2d Sess., 16 Stat. 198 (describing protectable subject matter as any “map, chart, musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts”). See GOLDSTEIN, *supra* note 52, at 56 (arguing that 1870 Act’s “extension of copyright to prohibit unauthorized new uses of literary works reflected a sensitivity to the burgeoning variety of American culture”).

Among its other changes, the 1870 Act centralized responsibility for the administration of copyright matters in the Library of Congress, which soon resulted in a dramatic increase in the number of works received by the executive branch.<sup>68</sup> Indeed, the Librarian of Congress suddenly found himself overwhelmed with submissions, many of which consisted solely of commercial labels for industrial goods. In his 1872 annual report, the Librarian—perhaps motivated more by practical considerations than by legal analysis—asserted that without pictorial embellishment, such labels were not “writings of authors” within the meaning of the Constitution.<sup>69</sup> “Mere printed labels,” the Librarian insisted, should instead be protected by the Patent Office, as “trademarks” or “designs for labels.”<sup>70</sup> Congress promptly obliged, passing an 1874 amendment purporting to limit copyright for writings and engravings to “pictorial illustrations or works connected with the fine arts, and no[t] prints or labels designed to be used for any other articles of manufacture.”<sup>71</sup> The Library of Congress’s marginalization of “industrial” and “commercial” goods (and related paraphernalia) can also be observed some thirty years later, in another annual report stating that industrial articles “are nowhere found thus designated [as protectable in

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<sup>68</sup> WILLIAM F. PATRY, *COPYRIGHT LAW AND PRACTICE* 43-44 (ed. 2000) (hereinafter “PATRY, *COPYRIGHT LAW AND PRACTICE*”).

<sup>69</sup> *Id.* at 46 (quoting 1872 Annual Report of the Librarian of Congress at 4-5).

<sup>70</sup> *Id.*

<sup>71</sup> Act of June 18, 1874, 43d Cong., 1st Sess., 18 Stat. 78 (hereinafter “1874 Act”). See *discussion* at *Higgins v. Keuffel*, 11 S. Ct. 731, 733 (1891) (“The act of June 18, 1874, (18 St. c. 301, p. 78,) changes the previous law in some respects. It allows, in place of the statement of entry in the office of the librarian, the simple use of the word ‘copyright,’ with the addition of the year it was entered, and the name of the party by whom it was taken out. It also declares that the words ‘engraving,’ ‘cut,’ and ‘print,’ shall be applied only to pictorial illustrations or works connected with the fine arts; and also that no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent-office[.]”). This provision remained in effect, in substance if not always in identical language, until 1939, when Congress amended the Copyright Act to include “[p]rints and pictorial illustrations including prints or labels used for articles of merchandise.” See *discussion* at *Forstmann Woolen Co. v. J. W. Mays, Inc.*, 89 F.Supp. 964, 971 (E.D.N.Y. 1950) (“since *Higgins v. Keuffel*, the Copyright Act has been amended so as to include § 5, subdivision (K), prints and pictorial illustrations including prints or labels used for articles of merchandise’ by the amendment of 1939 to the copyright statute, Act of July 31, 1939, c. 396, 53 Stat. 1142, 17 U.S.C.A. § 5(K).”); accord. *Mazer v. Stein*, 347 U.S. 201, 209 n.14 (1954). The intervening period witnessed a strange quirk of IP history: a period during which the Patent Office took over registration responsibilities for labels of manufacture, but issued *copyrights* for such works. See PATRY, *COPYRIGHT LAW AND PRACTICE*, at 47.

the Copyright Act], while they would seem to be included in the provisions of section 4929 of the patent law.”<sup>72</sup>

Yet in certain respects, the federal courts of the *fin de siècle* took a decidedly liberal approach to copyrightability. In *Burrow-Giles Lithographic Co. v. Sarony*, for example, the U.S. Supreme Court was confronted with an appeal posing the question of whether it was proper, under the Constitution’s Intellectual Property Clause, for Congress to allow for the grant of copyright in works of photography.<sup>73</sup> The Court’s 1884 decision answered in the affirmative, explaining that “[b]y writings in [the Constitution’s operative language] is meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writing, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression.”<sup>74</sup>

However, late Nineteenth-Century federal courts did not take the same creator-friendly approach reflected in *Sarony* to the copyrightability of what might be described (again, using contemporary terminology) as “applied art.” While the *Sarony* Court had stated that copyright was “the exclusive right secured to the author . . . of a writing or drawing which may be multiplied by the arts of printing in any of its branches,”<sup>75</sup> *fabric* prints would not be judicially adopted into these privileged categories for another ninety years.<sup>76</sup> Further, in striking contrast to the Court’s generous approach to a variety of borderline works in the copyright arena between the 1880s and the 1910s,<sup>77</sup> the federal courts of the time period took a decidedly skeptical, narrow, and/or dismissive view of purportedly exclusive rights—whether claimed via utility or design patent law—of the components forming the very heart of the craft of fashion design.<sup>78</sup>

The very same year the *Sarony* Court opted for an expansive construction of the copyright law, for instance, the Court in *Smith v. Nichols* invalidated as insufficiently novel to warrant patent protection a new textile of

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<sup>72</sup> 1902-1903 Annual Report of the Register of Copyrights at 445.

<sup>73</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884). The Court continued: “The only reason why photographs were not included in the extended list in the act of 1802 is probably that they did not exist[.]”

<sup>74</sup> *Id.* at 58.

<sup>75</sup> *Id.* at 56.

<sup>76</sup> See *discussion at Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 762-63 (2d Cir. 1991).

<sup>77</sup> See GOLDSTEIN, *supra* note 52, at 243 (providing citations to four majority decisions authored by (Chief) Justice Holmes issued between 1903 and 1917, each expanding the scope of copyrightable subject matter).

<sup>78</sup> See *discussion at Colman*, *supra* note 10.

“corded fabric.”<sup>79</sup> At a time when the critical rhetoric and negative social connotations concerning fashion design were on the rise in mainstream American culture,<sup>80</sup> the Court decided that there existed a dispositive distinction between a patentable *improvement* and an unpatentable *adaptation*—specifically, of “form, proportions, or degree.”<sup>81</sup> (Such modifications naturally comprise some of the most important means of innovation for the typical fashion designer.<sup>82</sup>)

Despite discouraging decisions like *Nichols*, patent law—and specifically, design-patent law, appeared, for at least a couple decades more, to be the most promising (and perhaps *only* conceivable) avenue for asserting exclusive rights in the appearance of fashion articles. Indeed, some case law of the time period appears to indicate that copyright protection for textile prints was widely assumed to be a non-starter.

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<sup>79</sup> 88 U.S. 112, 115 (1874) (describing purported invention at issue as a textile “in which the cords are elastic and held between the upper and under weft threads, and separated from each other by the interweaving of the upper and under weft threads with the warp threads in the spaces between the cords”).

<sup>80</sup> See discussion at Colman, *supra* note 10 (quoting, *inter alia*, Jno. Stainback Wilson, M.D., *Health Department*, GODEY’S LADY’S BOOK, Nov. 1861, *full text available at* <http://www.accessible-archives.com/2011/11/the-dangers-of-bare-arms-in-godeys-ladys-book/#ixzz3NxpGgXtH> (“We have before warned our readers against the ‘most pernicious practice,’ the dire effects of which are so forcibly presented in the above extract; but so prevalent is this evil, and such is the bending power of fashion, that the subject cannot be too often or too strongly urged upon the attention of mothers. The above remarks are as applicable to every part of our [American] country as to the city of Paris, for from Paris we receive our fashions, and with Paris we must suffer the dreadful consequences of following the senseless requisitions of vanity and folly in preference to the plain dictates of reason, physiology, and common sense. Mothers can never expect health for themselves and their children until they make the laws of health their guide, instead of the decrees of fashion; until they study physiology and hygiene more, and French fashion-plates less.”); cf. GOLDSTEIN, *supra* note 52, at 115 (“At the heart of most cases that reach the Supreme Court is a single question and a single answer that can spell success or failure for a party’s claim. The question rarely turns on strict legal theory. Usually it goes to plain, practical circumstances, to the lives sometimes even of Supreme Court Justices.”).

<sup>81</sup> 88 U.S. at 115. See also *id.* at 118-19 (“[A] mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.”).

<sup>82</sup> See discussion at BREWARD, *supra* note 16, at 25-47.

One of the first published fashion-related copyright decisions emerged from the 1862 case of *Drury v. Ewing*,<sup>83</sup> at a time when it was common practice for American women to purchase patterns in order to recreate popular styles of clothing for themselves and their children.<sup>84</sup> The plaintiff in *Drury* sued over the alleged infringement of a large chart containing patterns and instructions for cutting apparel; the defendant sought to avoid liability by arguing that “the copyright of Mrs. Drury is a nullity as not being a legitimate subject of a copyright within the scope and intention of the act of congress”—specifically, that the plaintiff’s pattern was not a “book” within the meaning of the copyright laws.<sup>85</sup> The presiding court rather casually disposed of the proffered defense.<sup>86</sup>

But *Drury* was no lasting victory for fashion; indeed, the decision was soon thereafter cited for the principle that fashion designs themselves were *not* eligible for copyright protection. The Supreme Court’s discussion of *Drury* in its 1879 decision in *Baker v. Selden*<sup>87</sup> suggests that fashion’s ineligibility for copyright was self-evident:

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<sup>83</sup> 7 F. Cas. 1113 (C.C.S.D. Oh. 1862).

<sup>84</sup> See BREWARD, *supra* note 16, at 53-55.

<sup>85</sup> 7 F. Cas. at 1114-15 (“The point made by the defendants’ counsel is, that the chart copyrighted to Mrs. Drury is neither a ‘book,’ nor a ‘chart,’ nor a ‘print,’ within the terms of the act of congress, and therefore not within its protection. Upon this point, no American authorities have been referred to, nor am I aware that it has been decided in this country. In the English courts I know of but one case in which it has been fully considered. This will be presently referred to as having a direct bearing on the question adverted to.”).

<sup>86</sup> *Id.* at 1115-16 (“[In the only published decision on the relevant issue, a British judge is] reported to have said: ‘I do not see at present why a composition printed on a single sheet of paper should not be entitled to the privileges of the statute.’ . . . No case has been referred to, and I am not aware there is any in which the doctrine then settled has been reconsidered or overruled by the English courts. And the construction of the statute of Anne, on the point under consideration, may be regarded as law in England. And I can not perceive on what ground the principle can be impugned as against good sense and reason. I am, therefore, inclined to adopt the liberal construction given by the English courts to their statute, and to hold that Mrs. Drury’s chart is within the protection of our statute.”).

<sup>87</sup> 101 U.S. 99, 104 (1879) (“Now, whilst no one has a right to print or publish [any material part of the plaintiff’s] book, [which] explained and described a peculiar system of book-keeping, and illustrated his method by means of ruled lines and blank columns . . . any person may practise [*sic*] and use the art itself which he has described and illustrated therein.”) *Baker* is often described as the Supreme Court’s first articulation of “a principle fundamental to copyright law: a copyright does not protect an idea, but only the expression of an idea.” *Kregos v. Associated Press*, 3 F.3d 656, 663 (2d Cir. 1993). See further discussion of the so-called “idea-expression distinction” in *Macrodoctrines* (the second installment in this series).

[The appellant relies on *Drury v. Ewing*, in which] a copyright was [successfully] claimed in a chart of patterns for cutting dresses and basques for ladies, and coats, jackets, &c., for boys. It is obvious that such designs could only be printed and published for information, and not for use in themselves. Their practical use could only be exemplified in cloth on the tailor's board and under his shears; in other words, by the application of a mechanical operation to the cutting of cloth in certain patterns and forms. Surely the exclusive right to this practical use was not reserved to the publisher by his copyright of the chart.<sup>88</sup>

One interesting, if roundabout, example of the judicial rejection of the notion that textile patterns might be copyrightable can be found in a New York federal district-court decision in *Rosenbach v. Dreyfuss*,<sup>89</sup> issued just a year after *Baker*. In *Rosenbach*, a defendant faced the charge that he had violated federal law by placing a copyright notice, without having complied with relevant requirements,<sup>90</sup> on “prints of small balloons [and] prints of hanging baskets, [each] with printing for embroidery and cutting lines.”<sup>91</sup>

The defendant in *Rosenbach* argued, cleverly, that a penalty could only be imposed under the relevant statute where the spurious copyright notice had been placed on material that was potentially copyrightable *in the first place*. The court somehow agreed, ruling that in light of the operative statutory language, examined in conjunction with the provision's predecessor and public-policy considerations, “the statute is to be construed as imposing the penalty only in case of copyrightable articles.”<sup>92</sup> The court could not (improbably) find any “apparent object or obvious reason of public policy in imposing a penalty for using this notice on any article not subject to copyright.”<sup>93</sup>

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<sup>88</sup> *Baker*, 101 U.S. at 107.

<sup>89</sup> 2 F. 217 (C.C.S.D.N.Y. 1880).

<sup>90</sup> Under the copyright law of the Nineteenth Century, failure to comply with certain formalities, including (initially) a deposit of a copy of the work with a federal district court or (later on) deposit of two copies of a work the Library of Congress, resulted in a forfeiture of one's copyright. See GOLDSTEIN, *supra* note 52, at 55, 60. The repercussions for an author's non-compliance would gradually be softened, but—even after 1989 treaty-implementing legislation often described as abolishing the formalities serving as a hindrance to obtaining enforceable copyright protection in eligible works—not completely eliminated, to date. See *id.*

<sup>91</sup> *Rosenbach*, 2 F. at 217-18.

<sup>92</sup> *Id.* at 219.

<sup>93</sup> *Id.* at 220. If the purpose of the false notice provision is to inform the public and competitors of what can and cannot be lawfully copied, then of course the court's statement is true only if everyone knows exactly what material is and is not potentially eligible for copyright protection. This proposition was (and continues to be) doubtful, not only on the basis of common sense, but also in light of the

This meant that the outcome of *Rosenbach* ultimately hinged on a single question: what did the word “print” mean, as used in copyright law? The court answered:

The word ‘print,’ in [the copyright statute] is used in connection with ‘engraving, cut and photograph.’ It means, apparently, a picture, something complete in itself, similar in kind to an engraving, cut or photograph. It clearly does not mean something printed on paper, that is not intended for use as a picture, but is itself to be cut up and embroidered, and thus made into an entirely different article, as a balloon or a hanging basket.<sup>94</sup>

A print, unless “complete in itself”—*i.e.*, where it might be “fine art” rather than what we now call applied art or industrial design—was deemed not to be the sort of material appropriate for copyright protection.<sup>95</sup>

It is important to observe that at the time of the *Baker* Court’s reference to *Drury* and the district court’s opinion in *Rosenbach*, the notion of “authorship” in fashion design was not yet widely recognized in mainstream American culture.<sup>96</sup> Tellingly, America’s leading high-end fashion magazine of the late Nineteenth Century, *Harper’s Bazar*, did not consistently attribute new apparel designs to specific individuals or fashion houses until the 1890s.<sup>97</sup> Further, while individual designers—just a handful of French celebrity couturiers—were sometimes credited for their creation of a new dress “design,” the magazine in the 1870s and 1880s far more often referred to dresses by their salient features or geographical provenance. Until the 1890s, far more common were *Bazar*’s mentions of American retailers—

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*Rosenbach* court’s own non-committal assertion that “[p]rints’ may or may not be the subject of copyright.” *Id.* at 224.

<sup>94</sup> *Id.* at 221.

<sup>95</sup> Whether summarized accurately or not, *Rosenbach* was later cited in one of the first federal-court decisions tackling the question of fashion design, itself, was copyrightable. *See Kemp & Beatley v. Hirsch*, 34 F.2d 291, 292 n.1 (E.D.N.Y. 1929) (“Under the authority of *Rosenbach v. Dreyfuss* (D.C.) 2 F. 217, it would seem, too, that articles such as dress patterns do not present copyrightable subject-matter”).

<sup>96</sup> *See* BREWARD, *supra* note 16, at 25-47.

<sup>97</sup> *See* STELLA BLUM, ED., VICTORIAN FASHIONS AND COSTUMES FROM HARPER’S BAZAR, 1868-1898 (1974) (comparing infrequency of attribution in first half of selected magazine excerpts with final decade). Even then, the attributions rarely accompanied illustrations of any items apart from dresses and, on rare occasions, high-end jewelry. *See generally id.*; *see id.* at 7 (noting that 1868 jewelry designs were “from Messrs. Tiffany & Co. and Browne & Spaulding, New York”). This by no means bespeaks a lack of importance for other types of accessories, however. *See, e.g.*, Susan J. Vincent, *Gloves in the Early Twentieth Century: An Accessory After the Fact*, 25 JOURNAL OF DESIGN HISTORY 190 (2012).



specifically, in the magazine's expressions of gratitude for the "furnishing" of the dress "models" depicted in its pages.<sup>98</sup>

Nor, apparently, was there a significant stigma associated with presenting and purchasing copies of the latest French designs. The caption accompanying a December 1874 cover describes the featured design as a "[Charles Frederick] Worth Basque and Full-Trained Trimmed Skirt," then goes on to thank American retailer Lord & Taylor for their "kindness" in providing the model that had been "*copied* from a stylish toilette made by the celebrated Paris dress-maker, Worth."<sup>99</sup> Over the next two decades, retailers' names—and mentions of "copies"—were eclipsed by mentions of "creations" and "designs" by French and sometimes English individuals who received the increasingly effusive praise of the magazine.<sup>100</sup> By the early 1890s, fashion designs selected for the cover of *Bazar* were increasingly described as the "exquisite" creations of the "creative brains" of "artists."<sup>101</sup>

Yet this emerging notion of "artistry" did not translate to favorable legislative or judicial treatment of fashion design under United States design-patent or copyright law.<sup>102</sup> Turn-of-the-century courts' skeptical and/or hostile treatment of fashion design in intellectual property disputes<sup>103</sup> stood in stark contrast with its decisions concerning other material whose claim to IP protection was arguably more precarious. In 1903, for example, the Supreme Court took a generous approach to the scope of copyright protection for a heavily commercial work in a case that hinged on the meaning and force of a 1874 congressional amendment purporting to limit copyright for writings and engravings to "pictorial illustrations or works connected with the fine arts, and no[t] prints or labels designed to be used for any other articles of manufacture."<sup>104</sup>

Justice Oliver Wendell Holmes' now-famous majority decision in *Bleistein v. Donaldson Lithographing Co.* dramatically expanded the reach of

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<sup>98</sup> See BLUM, *supra* note 94, at 75 (emphasis added). It is possible that the propriety of exalting a self-avowed copy of a Worth design followed from the practical impossibility of obtaining an original—for only the rich and famous could secure an appointment with the increasingly dictatorial couturier.

<sup>99</sup> *Id.* at 75.

<sup>100</sup> See STELLA BLUM, ED., VICTORIAN FASHIONS AND COSTUMES FROM HARPER'S BAZAR, 1868-1898 (1974) (compare infrequency of attribution in first half of selected magazine excerpts with final decade).

<sup>101</sup> See *id.* at 232, 238, 248.

<sup>102</sup> The picture is actually quite complicated, for the newly-dubbed "artists" of fashion were mostly French, and yet the French could not, as a practical matter, take advantage of American IP protection—no matter how they might be considered.

<sup>103</sup> See Colman, *supra* note 10.

<sup>104</sup> 1874 Act.

copyright protection in holding that the operative statutory language did not preclude the availability of copyright protection for illustrated “chromolithographs prepared . . . for advertisements of a circus.”<sup>105</sup> He explained: “Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use — if use means to increase trade and to help to make money.”<sup>106</sup> Holmes went on to write one of the most recognized passages in U.S. copyright law: “It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”<sup>107</sup> The Supreme Court thus eviscerated the “fine arts” language of the copyright laws, notably absent from the Copyright Act of 1909, passed just a few years later.<sup>108</sup>

The 1909 Act (still applicable today in disputes over works pre-dating January 1, 1977), contained a long list of categories into which copyrighted works might fall: “(a) Books, including composite and cyclopædic works, directories, gazetteers, and other compilations; (b) Periodicals, including newspapers; (c) Lectures, sermons, addresses, prepared for oral delivery; (d) Dramatic or dramatico-musical compositions; (e) Musical compositions; (f) Maps; (g) Works of art; models or designs for works of art; (h) Reproductions of a work of art; (i) Drawings or plastic works of a scientific or technical character; (j) Photographs; [and] (k) Prints and pictorial illustrations.”<sup>109</sup>

The Copyright Act of 1909’s broadly worded provision on copyrightable subject matter<sup>110</sup> thus did not explicitly exclude fashion prints from consideration. But the regulations promulgated by the Copyright Office to administer the 1909 Copyright Act were more restrictive, declaring generally that “[p]roductions of the industrial arts utilitarian in purpose and character, are not subject to copyright registration, even if artistically made or ornamented,” and stating more specifically that “[n]o copyright exists in

<sup>105</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 248 (1903).

<sup>106</sup> *Id.* at 251. Justice Holmes continued: “A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement.” *Id.*

<sup>107</sup> *Id.*

<sup>108</sup> Copyright Act of 1909, Pub. L. No. 60-349, 35 Stat. 1075 (Mar. 4, 1909; repealed Jan. 1, 1978).

<sup>109</sup> *Id.* at § 5.

<sup>110</sup> *See* Copyright Act of 1909, at § 4 (“[T]he works for which copyright may be secured under this Act shall include all the writings of an author.”); § 5 (“[T]he application for registration shall specify to which of the following classes the work in which copyright is claimed belongs [including ‘(g) Works of art; models or designs for works of art’] . . . [but this list shall] not be held to limit the subject-matter of copyright as defined in section four of this Act[.]”).

toys, games, dolls, advertising novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics or any similar articles.”<sup>111</sup>

Yet the Copyright Office softened the above-quoted regulation via a 1917 revision, after which it read: “The protection of productions of the industrial arts utilitarian in purpose and character even if artistically made or ornamented depends upon action under the patent law; but registration in the Copyright Office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.”<sup>112</sup> Further complicating the picture, the Office apparently accepted for registration, as early as 1912, “works of art possessing utilitarian aspects”—though the practice, which appears to have been more *ad hoc* than systematic, came to light only decades later.<sup>113</sup> (Such works tended to be at least loosely classifiable as “sculpture”—“statuettes, book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays”<sup>114</sup>—rather than apparel or “soft” home goods.)

Meanwhile, even as fashion had been mentioned in passing in copyright cases before the 1910s, it seems that no party had been so bold as to claim in court that a *fashion design itself*—as distinguished from a printed work containing images of fashion designs—was entitled to copyright protection. To bring a suit on this basis would require (1) affixing a notice of copyright protection on an article of clothing—a perilous proposition for works not clearly protectable, since use of any “fraudulent notice” was punishable by a fine—and (2) persuading the responsible government agent to accept a “deposit” of a copy (or photograph) of the work.<sup>115</sup> Importantly,

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<sup>111</sup> Rules and Regulations for the Registration of Claims to Copyright, Copyright Office Bull. No. 15, § 12(g), at 8-9 (1917), *full text of then-applicable regulations available at* ARTHUR WILLIAM WEIL, AMERICAN COPYRIGHT LAW, WITH ESPECIAL REFERENCE TO THE PRESENT UNITED STATES COPYRIGHT ACT, WITH APPENDICES CONTAINING FORMS FROM ADJUDICATED CASES, AND THE COPYRIGHT LAWS OF ENGLAND, CANADA, AUSTRALIA, GERMANY, AND FRANCE 624 (1917) (hereinafter, “WEIL, AMERICAN COPYRIGHT LAW”).

<sup>112</sup> 37 C.F.R. § 201.4(7) (1939).

<sup>113</sup> See *discussion* at Mazer v. Stein, 347 U.S. 201, 212 (1954).

<sup>114</sup> See *id.* at 212; *id.* at 221 (Douglas, J., concurring).

<sup>115</sup> WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 37-38, 46 (1994).

there appears to be no record of a reported judicial decision<sup>116</sup> concerning the governmental refusal to register a work until 1898.<sup>117</sup>

To the extent fashion design was not considered a “fine art,”<sup>118</sup> as was required for copyrightability during the period of many of the decisions discussed,<sup>119</sup> it was—at least in theory—barred from copyright protection as a threshold matter. Only in Justice Holmes’ 1903 majority opinion in *Bleistein* would many (but certainly not all) visual works not qualifying as “fine art” be rescued from their copyright no-man’s land.<sup>120</sup> Even after *Bleistein*, however, litigants would sometimes try to evade liability for copying fashion-related material by invoking either the “common” status of the materials, or the nature of fashion’s output as the mere “productions of the industrial arts,” or both.

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<sup>116</sup> It is possible that unreported decisions and/or summary orders—and, during an earlier period, casual rejections in district courts of attempted deposits of material deemed non-copyrightable—did not surface during the research conducted for this series of articles.

<sup>117</sup> See *id.* at 52 n. 167 (“In the first decision regarding the Librarian’s refusal to register a work, *United States v. Everson*, 26 Wash. L. Rep. 546 (Sup. Ct. D.C. 1898), the court rejected an effort to compel, by mandamus, registration for a completely blank book. The court indicated at the same time, however, that ‘the act is mandatory. . . The Librarian has no discretion in relation to the matter of recording.’”).

<sup>118</sup> The uniformly male judges on the Nineteenth-Century federal bench would almost certainly have deemed fashion design not to be a “fine art.” The decision in *Drury v. Ewing* is illustrative. There, the presiding judge included something resembling praise in his opinion finding for the pattern-designer plaintiff: “I can not perceive why her rights as an authoress or inventress should be prejudiced by this form of publication. If the chart, as the court is bound, for reasons before intimated, to presume, is original with her—the product of thought and mental toil—her claim is by no means destitute of merit, and she is justly entitled to all the benefits which the law confers.” 7 F. Cas. at 1116. The judge then stated: “It is clearly no objection to the validity of her copyright, that *her production does not claim a standing as a work of great literary merit*. The statute does not make this a necessary element of a legal copyright; and it is well known there are *works of great practical utility, having no pretension to literary merit*, which are yet within, not only the words, but the scope and design of the statute.” *Id.* (emphasis added). It is worth noting that even this level of highly qualified praise, including the court’s description of the pattern-maker as “an authoress or inventress,” would become increasingly difficult to locate in judicial decisions concerning fashion over the next thirty years. See generally Colman, *supra* note 10.

<sup>119</sup> See discussion at GOLDSTEIN, *supra* note 52. This is all the more expected in light of the then-recent statutory marginalization of “articles of manufacture,” discussed above.

<sup>120</sup> See discussion *supra* at text accompanying notes 105-07.

Such arguments were advanced, for instance, by the defendant in the 1911 case of *National Cloak & Suit Co. v. Kaufman*, which concerned the unauthorized reproduction of a book entitled “New York Fashions, Vol. 14, No. 4.”<sup>121</sup> The work at issue was described by the presiding court as comprising illustrations of “original conceptions and creations relating to wearing apparel, of great interest to a large proportion of the public on account of the originality and exercise of trained aesthetic faculties displayed in said illustrations. . . .”<sup>122</sup> Despite the defendant’s arguments, the court saw “no reason why copyright should be withheld from the complainant’s pictures of ladies showing to advantage wearing apparel of the latest styles and its manufacture,” as *the “complainant {did} not claim to monopolize the manufacture and sale of the wearing apparel depicted by reason of its copyright.”*<sup>123</sup>

In other words, like the Supreme Court in *Baker*, the presiding judge in *Kaufman* appeared to have no doubt about the non-copyrightability of *the fashion designs themselves*: “Of course, the complainant cannot monopolize the right to picture these. ‘Others are free to copy the original. They are not free to copy the copy.’”<sup>124</sup> The *Kaufman* court recited an important distinction that substantially persists today:<sup>125</sup>

The fallacy in [defendant’s] argument that the complainant cannot copyright ‘productions of the industrial arts’ lies in the confusion of the pictures with the things they depict in a particular way; that is, the wearing apparel which appears in the illustration as part of the pictures. As said by Mr. Justice Bradley in *Baker v. Selden*, *supra*: ‘There is a clear distinction between the book as such and the article which it is intended to illustrate. The object of the one is illustration; of the other it is the use thereof. The former may be secured by copyright, the latter [to the extent protectable at all under federal intellectual property law] by patent.’<sup>126</sup>

Further, the Copyright Office’s regulations contributed to perpetuating a “fine arts” requirement that had an adverse impact on fashion design.

As discussed above, some participants in the fashion industry had, in the latter half of the Nineteenth Century, attempted to assert rights in their creations through the vehicle of design patents.<sup>127</sup> This might have been in

<sup>121</sup> 189 F. 215, 216 (C.C.M.D. Pa. 1911).

<sup>122</sup> *Id.*

<sup>123</sup> *Id.* at 219 (emphasis added).

<sup>124</sup> *Id.* at 218 (citations to earlier cases, none involving apparel, omitted).

<sup>125</sup> See discussion at *On ‘Originality’* (second article in this five-article series).

<sup>126</sup> *Kaufman*, 189 F. at 219.

<sup>127</sup> To be sure, apparel companies relied on *utility* patents at the same time, though such efforts also often failed to prevent perceived “piracy.” See, e.g., *Rheubottom v. Loomer*, 26 F. 698, 699 (C.C.D. Conn. 1886) (dismissing infringement

part because of the assumption, reflected in judicial decisions of the period, that fashion-related materials simply were not the proper subject matter of copyright protection. In the 1889 case of *Untermeyer v. Freund*, for example, a New York federal district judge had explained: “The policy which protects a design [under the “design” branch of patent law] is akin to that which protects the works of an artist, a sculptor or a photographer by copyright.”<sup>128</sup> (The court ruled that the defendant had infringed the plaintiff’s design patent in decorative watch cases.)<sup>129</sup>

But while design patentees in the jewelry and accessory realms had enjoyed occasional success in the courts,<sup>130</sup> patentees of textile (and textile-related) designs and numerous other decorative components of fashion found that design patents provided a gradually more perilous avenue of potential recourse.<sup>131</sup> With increasing frequency, the federal courts—especially in the influential Second Circuit, whose word on design patents was akin to gospel after the Supreme Court stopped granted *certiorari* in design-patent cases after the 1890s—tended to rejected potential liability for the copying of patented fashion designs.<sup>132</sup>

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suit based on evidence that method of improving hoop skirts had been used by third parties several years before plaintiff obtained a utility patent in same).

<sup>128</sup> 37 F. 342, 344 (C.C.S.D.N.Y. 1889).

<sup>129</sup> *Id.* at 345.

<sup>130</sup> *See, e.g.*, *Dreyfus v. Schneider*, 25 F. 481, 481 (C.C.S.D.N.Y. 1885) (ruling for patentee of design consisting of “a ring made of chenille, or other analogous fabric, suspended from a tuft, and a ball suspended in like manner in the center of the ring; the thickness of the ring increasing from the bottom of the tuft to a point diametrically opposite”).

<sup>131</sup> *But see* *Untermeyer v. Freund*, 37 F. 342, 344, 345 (C.C.S.D.N.Y. 1889) (decision for plaintiff/patentee in watch-case design patent lawsuit, in which the court states that “if [a design] proves to be pleasing, attractive, and popular, if it creates a demand for the goods of its originator, even though it be simple, and does not show a wide departure from other designs, its use will be protected” and considers it “impossible to read the literature upon this subject without being convinced that the courts, though applying the same rules, have looked with greater leniency upon design patents than patents for other inventions.”).

<sup>132</sup> *See, e.g.*, *Post v. T.C. Richards Hardware Co.*, 26 F. 618, 619 (C.C.D. Conn. 1886) (“It is not clear that the substitution of any metallic loop for a silk or woolen loop is a ‘design’ of the character which the statute contemplates; but, without deciding that question, it is clear that if such a change can properly be called a design, it is not a patentable design. The mere substitution of one material for another, in the construction of or for the purposes of an ornament, the ornament to be of any approved form, cannot properly be patentable. There is nothing which the law deems ‘new’ in a mere change of that sort.”).

While the full range of reasons for this doctrinal development is open to debate,<sup>133</sup> it is clear that many designers had lost their taste for design patents by the first decade of the Twentieth Century.<sup>134</sup> Oft-cited disadvantages of this form of IP protection included the cost and trouble of procuring a design patent, the relatively short duration of any protection ultimately obtained,<sup>135</sup> and the uncertainty about whether such patents could actually be enforced in court, notwithstanding the imprimatur of the Patent Office.<sup>136</sup>

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<sup>133</sup> In *Patents and Perverts* (work-in-progress), I argue that complex social dynamics surrounding gender and sexuality were partially responsible for this doctrinal marginalization of design patents. This is not to deny, however, that some judges had “legitimate” jurisprudential objections to the claims asserted by design patentees. See, e.g., *Jennings v. Dolan*, 24 F. 697, 698 (C.C.S.D.N.Y. 1885) (opining that “[t]here are so many of these things [lace designs with fringe] that the differences are necessarily small, and small differences make different designs” and declaring that in the court’s view, “as fringed fabrics the designs as to the fringes appear to be different”). Regardless of the presiding judges’ motivations, however, design patentees were vulnerable to both the district and appellate courts’ tendency to take rather casual judicial notice of the novelty—or lack of novelty—of the subject matter of their patents, even after the U.S. Supreme Court’s decision in *New York Belting and Packing Co. v. New Jersey Car Spring and Rubber Co.*, 137 U.S. 445, 450 (1890) (“Whether or not the design is new is a question of fact, which, whatever our impressions may be, we do not think it proper to determine by taking judicial notice of the various designs which may have come under our observation.”). This, of course, made such protection less appealing.

<sup>134</sup> Some designers continued to rely on design patent protection, and still make frequent use of it today. See discussion at *The Politics of ‘Piracy’* (fifth installment in five-article series). See, e.g., *Kraus*, 34 F. 39 (ruling that defendant’s product infringed plaintiff’s design patent in particular type of corset). Note, however, that the plaintiff in *Kraus* appears to have only barely made out his case. See *id.* (“Most of the special features of this design are to be found, separately, in prior things, but they are nowhere combined so as to make such an effect as a whole; and that is what is to be looked at.”).

<sup>135</sup> See, e.g., *Kraus v. Fitzpatrick*, 34 F. 39, 39 (C.C.S.D.N.Y. 1888) (“This suit is brought upon design patent No. 13,620, dated February 13, 1883, and granted to Frank Welton, assignor to the orators, to run seven years, for a corset.”).

<sup>136</sup> See, e.g., *Streat v. White*, 35 F. 426, 427 (C.C.S.D.N.Y. 1888) (dismissing infringement suit based on design patent granted for print simulation of seersucker fabric, as he had merely “imitate[ed] an old woven fabric,” precluding a finding of novelty required for a valid patent); accord. *Streat v. Simpson*, 53 F. 358, 359 (C.C.S.D.N.Y. 1891) (“[T]he defendants’ pattern is not more like the plaintiff’s than like the photograph of seersucker, which all would have a right to work into any pattern not a copy of a patented one.”).

As a result, even as the opening years of the new century witnessed significant strides in “American design,”<sup>137</sup> there appeared to be no realistic, viable option for most fashion designers to take legal action against the purveyors of rising numbers of “knockoffs.”<sup>138</sup> (As the Register of Copyrights later observed: “That [design] patents have proved inadequate as a practical form of protection for designs is something on which most people will agree.”<sup>139</sup>) This “failure of the patent law as a method to combat [‘design piracy’] led to a variety of alternative efforts to protect original designs.”<sup>140</sup>

One such effort was the concerted lobbying of Congress, beginning in the 1910s, by designers seeking the codification of a more viable form of IP protection.<sup>141</sup> As David Goldenberg has recounted, advocates of design protection made their first serious attempt to persuade lawmakers to establish “a copyright-like, registration only regime (without a search of prior art)” between 1914 and 1916:

The first hearings were held in 1914, with longer hearings held on substantially the same bill in 1916. These bills are collectively referred to as the Oldfield Bills. The bills provided for the registration with the United States Patent Office of “any design, new and original, as embodied in or applied to any manufactured product of an art or trade . . . . The bill was drafted by the Design Registration League, an organized group of companies which believed that they “were unable to obtain satisfactory protection for their original design work” under the then present statutes.<sup>142</sup>

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<sup>137</sup> See, e.g., WILLIAM LEACH, *LAND OF DESIRE* 166 (1993) (recounting, *inter alia*, *Women’s Wear Daily* editor and American Museum of Natural History curator Morris D’Camp Crawford’s influential “Designed in America” campaign, carried out in the years immediately following World War I).

<sup>138</sup> See Maurice A. Weikart, *Design Piracy*, 19 *IND. L.J.* 235, 239 (1944) (describing the growth and impact of design piracy).

U.S. Library of Congress, *Draft of Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, Chapter VII*, at 4 (1975) (hereinafter “Register of Copyrights, 1975 Draft of Second Supplementary Report”).

<sup>139</sup> *Id.*

<sup>140</sup> *Id.*

<sup>141</sup> H.R. Rep. No. 11321, 63d Cong., 2nd Sess. (1914). See Weikart, *supra* note 139, at 236 (“The 1914 attempt to get legislative relief represented the first stirring of the movement to secure complete design protection covering [fashion] designs beyond the copyright and design patent law [and was] introduced just about the time when the ready-made apparel industry of the United States was beginning its development into the million-dollar proportions it possesses today”).

<sup>142</sup> Goldenberg, *supra* note 11, at 27-28 (internal citations omitted).



As Goldenberg explains, the designers' rhetoric ranged from rights-based arguments to economic rationales; they also argued "that protection would create [a more robust] American design industry, and that lack of protection would further the then current practice of importing all quality designs and designers from abroad."<sup>143</sup> The fashion industry, specifically, "raised the question of originality in its fundamental sense, with one speaker stating: 'We cannot help copying [but that is perhaps beside the point, as] infringement depends on how you define a new style.'"<sup>144</sup> Despite several efforts to rework the bills to address the vehement objections of opponents, and the House Committee's general support of the legislation, the bills resulted in no new laws.<sup>145</sup>

(It is probably safe to say that these advocates of more robust copyright protection for fashion designs did not anticipate how long and fruitless their struggle would be. Between 1914 and 1976, roughly seventy fashion-specific design protection bills were introduced in Congress, none of which became law;<sup>146</sup> from 1976 to 2012, additional bills on the subject were introduced, but none made it through the House and the Senate.<sup>147</sup>)

Designers' lack of success in the legislative realm appears to have fueled newly aggressive efforts to seek protection in the courts, through litigation premised on various legal theories. One strategy was to invoke the tort of "unfair competition," a common-law cause of action protecting against certain types of misrepresentation and other misconduct.<sup>148</sup> This approach sometimes proved effective, as in the 1918 New York appellate court deci-

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<sup>143</sup> *Id.* at 28 (internal citations omitted).

<sup>144</sup> *Id.* at 29-30 (internal citations omitted).

<sup>145</sup> *Id.* at 31.

<sup>146</sup> *See Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 n.12 (D.C. Cir. 1978).

<sup>147</sup> *See generally* Goldenberg, *supra* note 11.

<sup>148</sup> *See Notes: Self-Protection of Design Creation in the Millinery Industry*, 49 YALE L.J. 1290, 1292 (1940) (hereinafter "*The Millinery Industry*") ("In the absence of legislation, the courts have permitted appropriation of another's design so long as the copyist could not be accused of such unfair competition[.]"). While the student author of the cited piece surely cannot be considered an authority on the fashion industry, it is notable that he felt comfortable adding this commentary to his summary of the law: "Since manufacturers rarely insert trade names in their hats, there is scant chance for their product to become known in the public mind and, therefore, no basis for a claim of 'palming-off.' It is difficult to imagine protection for the style creator from the law of unfair competition." *Id.* at note 15. In fact, manufacturers had begun to insert brand-identifying labels onto their products by the 1930s, and unfair competition—broader than a tort of mere 'palming off'—had sometimes been, and would continue to be, at least in certain circumstances, a viable cause of action for fashion designers confronted with objectionable business activities. *See discussion* at *Lewis v. Vendome Bags*, 108 F.2d 16 (2d Cir. 1939).

sion in *Montegut v. Hickson, Inc.*<sup>149</sup> In *Montegut*, the New York outpost of a French company enjoying “the most exclusive clientele [and] an international and enviable reputation for the creation of exclusive models and styles” of dress prevailed, on an unfair competition theory, against a competitor that had used a mole to purchase gowns that were subsequently stripped of their labels and sold to defendant’s customers.

The difficulties with unfair competition as a reliable tool for designers was apparent from the opinion of the dissenting judge in *Montegut*, who noted that “[t]he question of patent or copyright [was] not involved in this case, as the plaintiffs’ models [were] neither copy-righted nor patented.”<sup>150</sup> Indeed, even the majority opinion “agree[d] that the defendant has a legal right to copy and to sell as its own creations the exclusive models designed by the plaintiffs if the models or an inspection of the models are procured by fair means,” but found the defendant’s conduct actionable because it had “obtain[ed] plaintiffs’ trade by resort[ing] to fraud and deception[.]”<sup>151</sup> Thus, it seemed that the savvy knockoff artist could avoid liability for unfair competition simply by, for example, standing outside a store and sketching the designs presented in the window, for later reproduction.

By the 1920s, some designers had grown bolder in their attempted use of copyright protection to stop unauthorized copies of their creations.<sup>152</sup> One New York federal district-court decision, *Kemp & Beatley, Inc. v. Hirsch*, analyzed the issue of copyright protection for fashion design in a way that the plaintiff had likely hoped to avoid—and which would be cited repeatedly in the years to come.<sup>153</sup> In *Kemp*, a plaintiff sued for copyright infringe-

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Regardless, the Note author’s apparent perception that most women’s high-fashion hats remained “unbranded” as late as 1940 is worthy of mention.

<sup>149</sup> 164 N.Y.S. 858, 860 (N.Y. App. Div. 1918).

<sup>150</sup> *Id.* at 98, 861 (Davis, J., dissenting).

<sup>151</sup> *Id.* at 97, 860.

<sup>152</sup> See *Kemp & Beatley, Inc. v. Hirsch*, 34 F.2d 291 (S.D.N.Y. 1929). Fashion designers had already begun to look to copyright law for more limited objectives, with mixed results. See *Royal Sales Co. v. Gaynor*, 164 F. 207, 208-09 (C.C.S.D.N.Y. 1908) (“I think the monogram [graphic design at issue in this case] is not a subject within the copyright law. If it were, any one could get, by means of a copyright, what would be substantially a patent for a design for a longer term and upon payment of less fees than [federal law] prescribes in the case of design patents.”).

<sup>153</sup> Note: *Protecting the Artistic Aspects of Articles of Utility: Copyright or Design Patent?*, 66 HARV. L. REV. 877, 880 (1953) (“The value of the *Kemp* holding as precedent [would seem] to have been reduced in 1948 when the Copyright Office finally eliminated the ‘fine arts’ restriction and adopted the position that works of ‘artistic craftsmanship’ may be protected as ‘works of art’ regardless of their practical use. Yet a recent textile design case in continuing to cite *Kemp* as authority indicates that

ment over the copying of dress designs contained in a copyright application that it had successfully submitted for registration under the category of “Work of Art (Painting, Drawing or Sculpture), or for Model or Design for a Work of Art.”<sup>154</sup> The presiding judge was immediately skeptical:

The question [presented in this case] is whether a design for dress goods stamped on paper, or on the goods themselves, is a proper subject for copyright protection. One is aided towards reaching a conclusion by inquiry as to what monopoly right the plaintiff really sought to obtain. It would seem that the aim of the plaintiff was to secure a monopoly right of the manufacture and sale of dress patterns which embodied the designs sought to be copyrighted.<sup>155</sup>

The court proceeded to engage in statutory construction of the copyright laws’ language concerning “works of art,” finding that the relevant provision contemplated only “paintings, drawing, and sculptures,” and models for those specific types of media.<sup>156</sup> The plaintiff here, however, had (at least, in the court’s view) conceded “that its design [was not] for a painting, drawing, or sculpture.”<sup>157</sup>

The *Kemp* court then put the nail in the coffin of the designer plaintiff’s case through reliance on a regulation promulgated by the Librarian of Congress, stating: “The protection of productions of the industrial arts utilitarian in purpose and character, even if artistically made or ornamented depends upon action under the patent law.”<sup>158</sup> Works of this sort, which

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the change in the regulations has not had a significant impact on the established judicial position.”) (citations omitted).

<sup>154</sup> *Kemp & Beatley*, 34 F.2d at 291-92.

<sup>155</sup> *Id.*

<sup>156</sup> *See id.* at 292 (“Is the copyright statute intended to afford such protection? The form of application requires an applicant to state whether that which is sought to be copyrighted is a work of art, or a model or design for a work of art. The plaintiff answered that inquiry by stating that its matter constituted a design for a work of art. What does the phrase ‘work of art’ mean, as used in the application? The application itself indicated with convincing clearness exactly what is meant, for after ‘Work of Art’ the words ‘Painting, Drawing, or Sculpture’ are used in parenthesis, and that language is followed immediately by the following: ‘Or for Model or Design for a Work of Art.’ Does it not follow, therefore, that the design for a work of art contemplated by this application is a design for a ‘painting, drawing, or sculpture?’”).

<sup>157</sup> *Id.* (“But there is no contention by the plaintiff that its design is for a painting, drawing, or sculpture; on the contrary, its design is for a pattern, the best edition of which was the pattern stamped on dress goods.”).

<sup>158</sup> *Id.* (quoting Rule 12(g) of “Rules and Regulations for the Registration of Claims to Copyright”).

included “[t]oys, games, dolls, advertising novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics, or similar articles,” were deemed outside the bounds of copyright by the government entity with the primary responsibility for administering copyright—confirming the court’s original intuition.<sup>159</sup>

At roughly the same time as the *Kemp* litigation, patterned-silk designer Cheney Bros., tried its hand at anti-knockoff litigation, taking an alternative approach that sought to navigate the obstacles of both traditional unfair competition law and formal copyright protection.<sup>160</sup> Cheney Bros.’ legal theory was premised on the Supreme Court’s 1918 ruling in *International News Service v. Associated Press*, which had addressed the practice of a defendant (“INS”) taking news released by the Associated Press (“AP”), rewording it somewhat, and selling it to consumers—before the AP’s coverage even reached many of those consumers.<sup>161</sup> The twist in *INS* was that the defendant could not be held liable for copyright infringement, as it had made use only of unprotectable “facts”<sup>162</sup> contained within the AP’s coverage, and had used only material that the AP made available to the consuming public—seemingly avoiding the pitfalls of both copyright infringement and unfair competition law.<sup>163</sup> Nevertheless, the *INS* Court used its then-

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<sup>159</sup> The court added a footnote with some decidedly unhelpful advice: “Parenthetically it may be observed that, if the plaintiff’s designs were novel and the result of invention, complete protection could have been had by the plaintiff by obtaining design letters patent. Revised Statutes, Secs. 4929 and 4933 (35 USCA § 73), were particularly enacted to provide such protection.” *Id.* at n.2.

<sup>160</sup> It is worth noting that the plaintiff in *Kemp* had also invoked the tort of unfair competition, but was rebuffed by the court due to a lack of diversity of citizenship between the parties. *Id.* at n.3. Whether this bespeaks a growing skepticism of the federal courts’ authority in the realm of “federal common law”—addressed by Judge Learned Hand in the Cheney Bros. case, is open to question (but certainly possible).

<sup>161</sup> 248 U.S. 215, 232 (1918).

<sup>162</sup> See *Int’l News Serv. v. AP*, 248 U.S. 215, 246 (1918) (Holmes, J., concurring) (“When an uncopyrighted combination of words is published there is no general right to forbid other people repeating them – in other words there is no property in the combination or in the thoughts or facts that the words express. Property, a creation of law, does not arise from value, although exchangeable – a matter of fact. Many exchangeable values may be destroyed intentionally without compensation.”).

<sup>163</sup> *Id.* at 241 (“It is [argued by defendant] that the elements of unfair competition are lacking because there is no attempt by defendant to palm off its goods as those of the complainant, characteristic of the most familiar, if not the most typical, cases of unfair competition.”).

existing “federal common-law” powers<sup>164</sup> to rule that because “both parties are seeking to make profits at the same time and in the same field . . . as between them, [the AP’s news] must be regarded as *quasi* property, irrespective of the rights of either [party] as against the public.”<sup>165</sup>

The general rationale for the Court’s 1918 *INS v. AP* ruling<sup>166</sup>—that regardless of what copyright law might have to say on the matter, a company should not be permitted to free-ride on “the cost of enterprise, organization, skill, labor, and money” of a competitor by selling a knockoff version of the original product—arguably fit like a glove (so to speak) in the context of fashion piracy—or so argued Cheney Bros. in the late 1920s.<sup>167</sup> Like many designers, Cheney Bros. created and released many new patterns each season, only a fraction of which became popular with the public—and each only for a short time, perhaps nine months at most.<sup>168</sup> Defendant Doris Silk had developed a business model whereby it waited to see which of Cheney’s (and presumably others companies’) patterns struck the public’s fancy, and

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<sup>164</sup> The Supreme Court’s *INS* ruling pre-dated by two decades the Court’s decision in *Erie Railroad Co. v. Tompkins*, 304 U.S. 64 (1938), which established definitively that a federal court sitting in diversity and presiding over a common-law “unfair competition” case—as distinguished from, for example, present-day litigation for unfair competition brought under the federal Lanham Act of 1946—is bound by relevant state law. *See Fashion Originators’ Guild of America v. FTC*, 312 U.S. 457, 468 (1941) (“[W]hether or not given conduct is tortious is a question of state law, under our decision in *Erie R. Co. v. Tompkins* . . .”). However, even where state law might purport to render actionable various types of “misappropriation,” such causes of action will often be held preempted by the U.S. Copyright Act. *See Laws v. Sony Music Ent.*, 448 F.3d 1134, 1137-38 (9th Cir. 2006) (“We have adopted a two-part test to determine whether a state law claim is preempted by the Act. We must first determine whether the ‘subject matter’ of the state law claim falls within the subject matter of copyright as described in 17 U.S.C. §§ 102 and 103. Second, assuming that it does, we must determine whether the rights asserted under state law are equivalent to the rights contained in 17 U.S.C. § 106, which articulates the exclusive rights of copyright holders.”) (Internal citations and footnotes omitted.) One curiosity of contemporary IP law is that, through the power of *stare decisis*, the *INS v. AP* “hot news” doctrine has managed to survive the demise of “federal common law” and still exists, in emaciated form, today. *See, e.g., NBA v. Motorola*, 105 F.3d 841, 843 (2d Cir. 1997).

<sup>165</sup> *Id.* at 236 (emphasis in original).

<sup>166</sup> Though this terminology was not used in the 1918 Supreme Court decision, the doctrine is now known as “hot news misappropriation.” *See, e.g., NBA*, 105 F.3d at 843.

<sup>167</sup> *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 280 (2d Cir. 1929) (citing *Int’l News Service v. Associated Press*, 248 U.S. 215 (1918)).

<sup>168</sup> *Id.* *See also* Weikart, *supra* note 139, at 239 (discussing the “wait-and-see” approach).

copied only those, undercutting the price of the original manufacturer. Cheney Bros. sought recourse through an *INS v. AP* “misappropriation” theory—and lost.<sup>169</sup>

The preeminent Judge Learned Hand, writing for a unanimous Second Circuit panel in 1929, expressed sympathy for designers whose “ingenuity and expense” had gone into the copied designs; he even opined that “it would seem as though the plaintiff had suffered a grievance for which there should be a remedy.”<sup>170</sup> But Judge Hand nevertheless wrote that the plaintiff had no cause of action against copyists under federal law in the absence of patent protection (which he acknowledged would be impractical and burdensome to obtain, given the rapidity of the fashion cycle and most fashion articles’ lack of the requisite novelty) or copyright protection (which Judge Hand wrote was “impossible to [obtain for fashion designs] under the Copyright Act . . . , or at least so the authorities of the Copyright Office hold.”).<sup>171</sup>

At the plaintiff’s urging, Judge Hand’s decision reflected on unfair competition cases like *Montegut v. Hickson, Inc.*, but he found that they merely created an exception to the rule that, absent patent or copyright protection, “a man’s property is limited to the chattels which embody his invention [and others] may imitate [such property] at their pleasure.”<sup>172</sup> Patent and copyright protection were both creatures of statute, upon which Congress had “imposed . . . conditions . . . upon the creation of the right,” and Judge Hand would not use the judiciary’s “limited power to amend the law” to circumvent these statutory limitations.<sup>173</sup> Judge Hand further explained: “To exclude others from the enjoyment of a chattel is one thing; to prevent any imitation of it, to set up a monopoly in the plan of its structure, gives the author a power which the Constitution allows only Congress to create.”<sup>174</sup> In short, the plaintiff was out of luck.

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<sup>169</sup> Cheney Bros., 35 F.2d 279 (2d Cir. 1929).

<sup>170</sup> *Id.* at 281.

<sup>171</sup> *Id.* at 279. The accuracy of the latter statement was and is open to question, as explained below.

<sup>172</sup> *Id.* at 280.

<sup>173</sup> As the silk patterns in question were copied *after* sale, Judge Hand did not address Section 2 of the 1909 Copyright Act, which provided that “nothing in this Act shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.” Rights existing only in *unpublished* works are discussed in *On ‘Similarity’* (fourth installment in this series).

<sup>174</sup> Judge Hand did not expressly accuse the U.S. Supreme Court of overreaching in creating a federal “misappropriation” cause of action for “hot news” in *INS v.*

Thus, whereas the Supreme Court in *INS v. AP* had been persuaded to make new law to right the wrong before it,<sup>175</sup> Judge Hand felt constrained from doing so. In his view, this was a matter for the legislature, and “Congress might see its way to create some sort of temporary right, or it might not.”<sup>176</sup> Either way, the legislature’s “decision would certainly be preceded by some examination of the result upon the other interests affected.”<sup>177</sup> (As noted below, the relevant legislative activity in the late 1920s and early 1930s was indeed among the most contentious, and the most promising, for designers.)

Technically, the *Cheney Bros.* court’s proclamations about the non-copyrightability of fashion designs were *dicta*, for the plaintiff had brought no copyright claim. Further, the Copyright Act of 1909’s provision on copyrightable subject matter was broadly worded<sup>178</sup> and did not explicitly exclude fashion prints from consideration. But again, the regulations promulgated by the Copyright Office to administer the 1909 Copyright Act were more restrictive, stating in part that “[n]o copyright exists in toys, games, dolls, advertising novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics or any similar article.”<sup>179</sup>

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A.P., 248 U.S. 215, but it seemed clear that he disapproved of the Court’s doctrinal innovation. Judge Hand thus unequivocally limited the reach of that case to “news and perhaps market quotations.” *Cheney Bros.*, 35 F.2d at 281. Again, while the “hot news” doctrine managed to survive the demise of “federal common law” in *Erie R.R. Co. v. Tompkins*, 304 U.S. 64 (1938), it survives only in emaciated form today. See *On ‘Similarity’* (fourth installment in this series).

<sup>175</sup> *INS*, 248 U.S. at 236 (“The rule that a court of equity concerns itself only in the protection of property rights treats any civil right of a pecuniary nature as a property right (In re Sawyer, 124 U.S. 200, 210; In re Debs, 158 U.S. 564, 593); and the right to acquire property by honest labor or the conduct of a lawful business is as much entitled to protection as the right to guard property already acquired.”).

<sup>176</sup> *Cheney Bros.*, 35 F.2d at 281.

<sup>177</sup> *Id.*

<sup>178</sup> See U.S. Copyright Act of 1909, § 4 (“the works for which copyright may be secured under this Act shall include all the writings of an author”); § 5 (“the application for registration shall specify to which of the following classes the work in which copyright is claimed belongs [including ‘(g) Works of art; models or designs for works of art’] . . . [but this list shall] not be held to limit the subject-matter of copyright as defined in section four of this Act”).

<sup>179</sup> Rules and Regulations for the Registration of Claims to Copyright § 12(g), Copyright Office Bull. No. 15, § 12(g), at 8-9 (1917), *full text of then-applicable regulations available at* WEIL, AMERICAN COPYRIGHT LAW, at 624. However, the reader should also recall that that the Copyright Office had made a somewhat liberal amendment to this regulation, in 1917, to provide that “[t]he protection of productions of the industrial arts utilitarian in purpose and character even if artistically made or ornamented depends upon action under the patent law; but registration in

It is far from clear that the Copyright Office had the power to narrow the category of copyrightable “artistic works” in this manner.<sup>180</sup> But *Cheney Bros.* was not an administrative law case,<sup>181</sup> and the broad strokes of the Second Circuit’s decision seemed clear: fashion had no place in copyright law. *Cheney Bros.* further established, or at least distilled, many of the major points in the “copyright-for-fashion” debate that still apply today.<sup>182</sup> (It is important to note that despite *Cheney Bros.*, the courts—especially the New York state court—continued to adjudicate unfair competition cases involving fashion copyists for decades,<sup>183</sup> and still do so today,<sup>184</sup> though such cases are now often dismissed on federal preemption grounds.<sup>185</sup>)

The outcome of the *Cheney Bros.* case likely created additional momentum for lobbying by designers seeking meaningful copyright protection in their creations, who did manage to get a design-protection bill passed by the House of Representatives in 1930.<sup>186</sup> Yet as their lobbying efforts contin-

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the Copyright Office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.” 37 C.F.R. § 201.4(7) (1939).

<sup>180</sup> One leading commentator wrote in 1917 that the Copyright Office’s narrow view of copyrightable artistic works “appears to take an unduly restricted view of the Act and appears unsupported either by statute or decision.” WEIL, AMERICAN COPYRIGHT LAW, at 214.

<sup>181</sup> Eleven years later, Judge Hand wrote for a Second Circuit panel that *did* preside over an administrative law case involving fashion copyists—but the proceeding, *Fashion Originators Guild v. FTC*, 114 F.2d 80 (2d Cir. 1940), concerned an agency other than the Copyright Office: the Federal Trade Commission. In any event, Judge Hand adhered to his previous position that “until the copyright law is changed, *or until the Copyright Office can be induced to register such designs as copyrightable under the existing statute*, [‘published’ fashion designs] fall into the public demesne without reserve.” *Id.* at 84 (citing *Cheney Bros.*, 35 F.2d 279) (emphasis added).

<sup>182</sup> See generally L.J. Jackson, *Some Designers Say Their Work Deserves Copyright Protection; Others Say It Would Harm the Industry*, ABA JOURNAL, (July 2011), [http://www.abajournal.com/magazine/article/the\\_genuine\\_article/](http://www.abajournal.com/magazine/article/the_genuine_article/).

<sup>183</sup> See, e.g., *Dior v. Milton*, 155 N.Y.S.2d 443 (N.Y. Sup. Ct. 1956); *Richard J. Cole, Inc. v. Manhattan Modes Co.*, 157 N.Y.S.2d 259 (N.Y. App. Div. 1956).

<sup>184</sup> See, e.g., *Spicy Clothing Co. v. Say What Inc.*, No. 103456/08, 2008 NY slip op 31192U; 2008 N.Y. Misc. LEXIS 8065 (N.Y. Sup. Ct. Apr. 24, 2008).

<sup>185</sup> See *The Politics of ‘Piracy’* (fifth installment in this series).

<sup>186</sup> See Goldenberg, *supra* note 11, at 37 (discussing, *inter alia*, 1930 “Vestal bill” that was passed by a majority in the House of Representatives, but not the Senate, and noting that it “was at this time that the interests of the silk manufacturers [like *Cheney Bros.*] became dominant in the design debate”).



ued throughout the decade,<sup>187</sup> and the aid of administrative agencies was sought in vain,<sup>188</sup> even as copyright infringement lawsuits continued to be brought by designers without success,<sup>189</sup> key players in the U.S. fashion industry opted to develop their own techniques for dealing with what was increasingly being described—not just by the designer community, but by a growing segment of the general public—as “design piracy.”<sup>190</sup>

The most visible industry self-help effort was the creation of the so-called “Fashion Originators Guild of America,” which a 1936 *TIME* magazine article explained was “founded three years ago [in 1933] to stamp out style piracy and [is] the principal prop of highgrade dressmaking.”<sup>191</sup> FOGA’s members implemented an extralegal system intended to make it financially impractical for retailers to sell or otherwise deal in “pirated” copies of popular women’s dress designs.<sup>192</sup> The perceived root of the problem, as later paraphrased by the Supreme Court, was that “[a]fter [original]

<sup>187</sup> See *The Millinery Industry*, 49 *YALE L.J.* 1290, 1292 (1940) (citing Hearings Before Senate Committee on Patents on H. R. 11852 71st Cong., 3d Sess., 117 (1931)).

<sup>188</sup> See *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 189 (S.D.N.Y. 1934) (“In August, 1933, in response to a written inquiry from a designer of dresses, the Register of Patents replied as follows: ‘There are no provisions in the Copyright Law for protecting fashions for dresses. The right to make and sell an artistically designed garment may under proper circumstances be obtained by a design patent issued from the Patent Office but not by copyright.’”); See, e.g., *Nat Lewis Purses, Inc. v. Carole Bags, Inc.*, 83 F.2d 475, 476 (2d Cir. 1936) (“[T]he piracy of designs, especially in wearing apparel, has been often denounced as a serious evil and perhaps it is; perhaps new designs ought to be entitled to a limited copyright. Efforts have been made to induce Congress to change the law so as to give some such protection, without success so far.”).

<sup>189</sup> *Adelman*, 112 F. Supp. at 189-90 (“A dress is not copyrightable [even though a] picture of a dress is . . . . To give an author or designer an exclusive right to manufacture the art described in the certificate of copyright registration, when no official examination of its novelty has every been made, would unjustly create a monopoly and moreover would usurp the functions of letters-patent.”). See also *id.* at 188 (“The dress itself could hardly be classed as work of art and filed in the Register’s office.”).

<sup>190</sup> While Judge Hand had not employed the term “piracy” in the 1929 *Cheney Bros.* decision, the word appeared throughout his 1940 opinion in *Fashion Originators Guild v. FTC*, 114 F.2d 80 (2d Cir. 1940); the term also appears in secondary sources of the time. See generally *The Millinery Industry*, 49 *YALE L.J.* 1290 (1940).

<sup>191</sup> *Business & Finance: Dress War*, *TIME*, Mar. 23, 1936, at 88.

<sup>192</sup> As discussed in detail in *The Millinery Industry*, 49 *YALE L.J.* 1290 (1940), a similar system was devised by a guild of women’s hat designers and manufacturers. This initiative, like FOGA’s, provoked action by the FTC, in *In re Millinery Quality Guild, Inc.*, 24 F.T.C. 1136 (1937). The trajectory and outcome were essentially the same for both organizations. See *id.*; *Millinery Creators’ Guild, Inc. v. FTC*, 109

designs enter the channels of trade, other manufacturers systematically make and sell copies of them, the copies usually selling at prices lower than the garments copied.”<sup>193</sup>

While FOGA’s system was not foolproof,<sup>194</sup> it appears to have been reasonably effective during its brief existence, as the system drew (unsuccessful) legal challenges by private parties,<sup>195</sup> and then a (successful) challenge by the Federal Trade Commission, which initiated antitrust proceedings against FOGA in the late 1930s based on the Clayton, Sherman, and FTC Acts.<sup>196</sup> The FTC ruled against FOGA on a largely stipulated record; the Guild then appealed to the Second Circuit<sup>197</sup> and ultimately to the Supreme Court, which agreed, for reasons explained below, that FOGA’s practices constituted an unlawful restraint of trade.<sup>198</sup>

At the center of the challenged system, the Supreme Court explained, was a boycott by “one hundred and seventy-six manufacturers of women’s garments who are members of the Guild [and notably] occupy a commanding position in their line of business” of any entity found to deal in or sell knockoff fashion items.<sup>199</sup> Knockoff determinations were made based on a private system, intended to serve as substitute for absent IP protection under federal law. Bypassing the U.S. Copyright and Patent Offices, “[t]he Guild maintain[ed] a Design Registration Bureau for garments, and the Textile Federation maintain[ed] a similar Bureau for textiles.”<sup>200</sup> Registered designs, instead of a copyright notice or a patent number, carried a special FOGA label, two examples of which are pictured in *Figure 1*, below.

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F.2d 175 (2d Cir. 1940); *Millinery Creators’ Guild, Inc. v. FTC*, 312 U.S. 469, 471 (1941) (“present[ing] virtually the same issues as” the *FOGA* dispute).

<sup>193</sup> *Fashion Originators’ Guild of America v. FTC*, 312 U.S. 457, 461 (1941).

<sup>194</sup> *Id.* at 466 (“[I]t [is not] determinative in considering the policy of the Sherman Act that petitioners may not yet have achieved a complete monopoly [as it is] the object of the Federal Trade Commission Act to reach [attempted monopolies and other undesirable restraints of trade] not merely in their fruition but also in their incipency combinations which could lead to these and other trade restraints and practices deemed undesirable.”).

<sup>195</sup> *See Filene’s Sons Co. v. Fashion Originators’ Guild of America, Inc.*, 90 F.2d 556, 559 (1st Cir. 1937). This dispute is covered in the *TIME* article cited *supra* at note 184. *See also* *Wolfenstein v. Fashion Originators’ Guild of America, Inc.*, 280 N.Y.S. 361 (N.Y. App. Div. 1935).

<sup>196</sup> *In re Fashion Originators’ Guild of America, Inc.*, 28 F.T.C. 430 (Feb. 8, 1939).

<sup>197</sup> *Fashion Originators’ Guild of America v. FTC*, 114 F.2d 80 (2d Cir. 1940).

<sup>198</sup> *Fashion Originators’ Guild of America v. FTC*, 312 U.S. 457 (1941).

<sup>199</sup> *Id.* at 462-63.

<sup>200</sup> *Id.* at 462.



FIGURE 1: Sample labels indicating authorized, FOGA-registered fashion designs.

“red-carding” (*i.e.*, blacklisting) process, which entailed “employ[ing] ‘shoppers’ to visit the stores of both cooperating and non-cooperating retailers, ‘for the purpose of examining their stocks, to determine and report as to whether they contain . . . copies of registered designs . . .’” Offenders were brought before “[a]n elaborate system of trial and appellate tribunals [operated by FOGA] for the determination of whether a given garment is in fact a copy of a Guild member’s design.”<sup>201</sup>

Further—and significantly, from the Supreme Court’s perspective—FOGA’s anti-piracy initiative was not limited to its red-carding. As the Court recounted, FOGA not only prescribed rules directly targeting “competition by so-called style copyists, [but also] prohibit[ed] its members from participating in retail advertising; regulate[d] the discount they may allow; prohibit[ed] their selling at retail; cooperate[d] with local guilds in regulating days upon which special sales shall be held; prohibit[ed] its members from selling women’s garments to persons who conduct businesses in residences, residential quarters, hotels or apartment houses; and denie[d] the benefits of membership to retailers who participate with dress manufacturers in promoting fashion shows unless the merchandise used is actually purchased and delivered.”<sup>202</sup>

The Supreme Court, in a ruling consistent with the weight of then-applicable precedent,<sup>203</sup> found FOGA’s practices to be unlawful under the

<sup>201</sup> *Id.* at 463.

<sup>202</sup> *Id.* at 462-63; *see also id.* at 465-66 (“the combination is in reality an extra-governmental agency, which prescribes rules for the regulation and restraint of interstate commerce, and provides extra-judicial tribunals for determination and punishment of violations, and thus ‘trenches upon the power of the national legislature and violates the statute’”) (quoting *Addyston Pipe & Steel Co. v. United States*, 175 U.S. 211, 242 (1899)).

<sup>203</sup> *See* W. Wallace Kirkpatrick, *Commercial Boycotts as Per Se Violations of the Sherman Act*, 10 GEO. WASH. L. REV. 302, 311 (1941) (hereinafter “Kirkpatrick, *Commercial Boycotts*”) (“[R]ecent Supreme Court decisions, although not analyzing the problems presented by a boycott in a very full way and although not deciding whether any boycott is per se a violation of the Sherman Act, do lend considerable

Clayton, Sherman, and FTC Acts.<sup>204</sup> While some have criticized the Supreme Court's reasoning as opaque,<sup>205</sup> the Court minced no words in rejecting FOGA's primary argument that its system was "reasonable and necessary to protect the manufacturer, laborer, retailer and consumer against the devastating evils growing from the pirating of original designs."<sup>206</sup> Justice Black, for a unanimous Court, wrote:

[T]he aim of petitioners' combination was the intentional destruction of one type of manufacture and sale which competed with Guild members. The purpose and object of this combination, its potential power, its tendency to monopoly, the coercion it could and did practice upon a rival method of competition, all brought it within the policy of the prohibition declared by the Sherman and Clayton Acts . . . . [T]he reasonableness of the methods pursued by the combination to accomplish its unlawful object is no more material than would be the reasonableness of the prices fixed by unlawful combination.<sup>207</sup>

In response to the more specific argument that FOGA's system was lawful because it sought only to snuff out tortious conduct, the Court explained:

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weight to the view that a concerted refusal to deal is illegal regardless of the circumstances."). *But see* Allen C. Horsley, *Comment: Per Se Illegality and Concerted Refusals to Deal*, 13 B.C. IND. COMM. L. REV. 484 (1972) ("The Supreme Court has always treated concerted refusals to deal and group boycotts as being per se illegal."). In any event, antitrust law has evolved considerably since the 1940s—especially beginning in the 1970s. *See* George L. Priesent, *The Abiding Influence of The Antitrust Paradox: An Essay in Honor of Robert H. Bork*, 31 HARV. J. L. & PUB. POL'Y 455, 456 (2008). In light of changes to antitrust law's perceived rationale, executive and judicial policy objectives, and revised doctrine, it would be imprudent to consider the Supreme Court's *FOGA* and *Millinery Creators' Guild* decisions anything other than interesting historical artifacts.

<sup>204</sup> *FOGA*, 312 U.S. at 464 ("[T]he Commission, upon adequate and unchallenged findings, correctly concluded that th[ese] practice[s] constituted an unfair method of competition.").

<sup>205</sup> *See* Kirkpatrick, *Commercial Boycotts*, at 322 ("The Supreme Court decided that the course of conduct in each case was unlawful and, therefore, the Court said, the unreasonableness of the practices followed was immaterial. This can be true, however, only if the case is one where the restraint is unreasonable in and of itself. Unfortunately the Court was not at all clear as to its grounds for holding that the plans were unlawful.").

<sup>206</sup> *Id.* at 467.

<sup>207</sup> *Id.* at 467-68. *Cf.* *Millinery Creators' Guild v. FTC*, 109 F.2d 175, 176 (2d Cir. 1940) ("In certain Cases group action may permissibly have broad objectives, and a trading exchange may fix rules for trading and forbid dealing with non-members, provided again that there is no perceptible effect on legitimate methods of competition.").

[T]he unlawful [conduct of the Guild cannot] be justified upon the argument that systematic copying of dress designs is itself tortious, or should now be declared so by [the Court]. In the first place, whether or not given conduct is tortious is a question of state law, under our decision in *Erie R. Co. v. Tompkins*, 304 U.S. 64 [(1938)]. In the second place, even if copying were an acknowledged tort under the law of every state, that situation would not justify petitioners in combining together to regulate and restrain interstate commerce in violation of federal law. And for these same reasons, the principles declared in *International News Service v. Associated Press*, 248 U.S. 215 [(1918)], cannot serve to legalize petitioners' [activities].<sup>208</sup>

Thus, the Supreme Court brought an end to FOGA's short life;<sup>209</sup> the same fate befell the so-called Millinery Creators' Guild in another short decision authored by Justice Black and issued the same day.<sup>210</sup> Interestingly, in neither opinion did the Supreme Court meaningfully address the subject of intellectual property (or lack thereof) for fashion design. The Second Circuit's decision in the *Millinery Creators' Guild* case, by contrast, had at least dipped a toe in the water of the copyright-for-fashion issue, declaring that "while we maintain the competitive system, a monopoly in an idea, not recognized by positive law, must be jealously scrutinized lest the few are

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<sup>208</sup> *Id.* at 468.

<sup>209</sup> *But see* *Fabrex Corp. v. Scarves by Vera, Inc.*, 61 Civ. 539, 1961 U.S. Dist. LEXIS 3959, \*8-\*9 (S.D.N.Y. Apr. 14, 1961) ("17. In further defense of its adoption of its accused Butterfly design, Fabrex alleges that it takes every practical precaution to assure itself that the designs and patterns it uses in its printed fabrics are original. One such precaution is taken in the form of submission of finished patterns or designs to the Design Registration Bureau of The Textile Distributors Institute for search, clearance and registration. It is alleged that the function of this Design Registration Bureau is to ascertain whether a submitted design or pattern conflicts with any other pattern or design used by another firm. 18. The Design Registration Bureau appears to be a division of the General Arbitration Council and the National Federation of Textiles. There is, however, no showing that said Bureau has any statutory powers, duties or functions whatsoever. There is no showing that it has been authorized and empowered by the Congress to register designs and determine questions of copyright infringement. Nor is there any showing of how the Bureau could possibly determine such questions in relation to copyrighted designs which have not been registered with the Bureau, as in the case at bar. It is clear that the Bureau cannot stand as a shield between a copyright owner and a copyright infringer and it cannot be permitted to preempt the jurisdiction, powers and functions of this Court.").

<sup>210</sup> *Millinery Creator's Guild v. FTC*, 312 U.S. 469, 472 (1941) ("The respects in which the plan of the Millinery [Creators'] Guild differs from that of the Fashion Originators' Guild are not material[.]").

protected at the expense of the many.”<sup>211</sup> In another passage, even more prescient of the current debate concerning additional IP protection for fashion designs,<sup>212</sup> the Second Circuit reminded the public that what might strike some as “a distasteful ‘evil’” to be eliminated, “the law [might] nevertheless recognize[ ] to be a socially desirable form of competition.”<sup>213</sup>

It is probably safe to say that the issue of “design piracy” took a backseat to other, more pressing national concerns in the troubled years that followed the 1941 Guild decisions.<sup>214</sup> By the late 1940s, however, designers were again quite preoccupied with the problem of copyists. One 1949 judicial opinion attempted to sum up the then-current state of the law on copyright-for-fashion (before a 1954 Supreme Court decision, discussed below, would throw the state of IP protection for industrial design into disarray.)

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<sup>211</sup> *Millinery Creators' Guild v. FTC*, 109 F.2d 175, 178 (2d Cir. 1940). One wonders if either the Second Circuit or the Supreme Court's rulings in the *FOGA* and *Millinery Creators' Guild* cases might have differed if the entities had set up inspection and boycott systems to “red-card” only *copyright-* or *patent-*infringing vendors. (Of course, if the majority of the knockoffs at issue violated federal copyright or patent law, the Guild would probably never have been created in the first place, as the federal courts would have provided a forum for aggrieved designers to seek recourse.) Because copyright was out of the picture in the fashion design realm, FOGA was forced to argue that the boycotted competitors' conduct ran afoul of state law. As the last-quoted passage of the Supreme Court's opinion indicates, state-law rules (including state IP protection) are subordinate to federal law by virtue of the Constitution's Supremacy Clause. But considering that infringement under the Copyright Act, like Sherman and Clayton Act violations, exists at the federal level, one wonders if the Supreme Court might have condoned a non-governmental, FOGA-like copyright enforcement regime designed primarily as a more economical and effective alternative to the use of the federal courts. *See also* U.S. Copyright Office, *Remedies for Copyright Small Claims*, <http://www.copyright.gov/docs/smallclaims/> (last visited Feb. 1, 2013) (“[W]hile a copyright owner may want to stop an infringement that has caused a relatively small amount of economic damage, that owner may be dissuaded from filing a lawsuit because the prospect of a modest recovery may not justify the potentially large expense of litigation [and, as such,] Congress has asked the Copyright Office to study the challenges of the current system for resolving small copyright claim disputes, as well as possible alternative systems.”).

<sup>212</sup> *See The Politics of 'Piracy'* (fifth article in five-article series).

<sup>213</sup> *Millinery Creators' Guild*, 109 F.2d at 178.

<sup>214</sup> However, lawsuits against copyists did not stop completely, even during the War. *See, e.g., Belding Heminway Co. v. Future Fashions, Inc.*, 143 F.2d 216, 218 (2d Cir. 1944) (vacating district court's preliminary injunction in design-patent case over stylized floral print, and noting “[a]pparently what the makers of women's dresses really need is that copyright protection, which Congress has hitherto denied them.”).

In the case of *Verney Corp. v. Rose Fabric Converters Corp.*,<sup>215</sup> plaintiff designer sued several parties involved in the process of unabashedly replicating plaintiff's "curly chrysanthemum" fabric pattern—for which plaintiff had, it so happened, obtained a registration certificate from the Copyright Office.<sup>216</sup> Registration notwithstanding, the court rejected the idea that the design could give rise to copyright-infringement liability:

While the design may have been properly registered as a print for an article of merchandise, plaintiff, by printing it on the fabric from which the dresses are manufactured, uses the design as a part of the article of merchandise itself. It is obviously not used in connection with a sale or an advertisement of either the fabric or the dresses, but is an attempt by plaintiff to obtain a monopoly of the design in the manufacture of dress fabrics and dresses, to which it is not entitled.<sup>217</sup>

In any event, the court held, "even if there were doubt as to the invalidity of the copyrighted design when so used on fabrics and dresses, which I do not entertain, still plaintiff's copyright on the design has been lost by failure to publish on the fabric and the dresses, in connection with the design, the proper copyright notice."<sup>218</sup> Once again, a fashion designer found himself out of luck. Other intellectual-property enforcement strategies for fashion were attempted, unsuccessfully.<sup>219</sup>

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<sup>215</sup> 87 F. Supp. 802 (S.D.N.Y. 1949).

<sup>216</sup> *Id.* at 803.

<sup>217</sup> *Id.* at 804. In support of its conclusion, the court cited some of the more significant episodes in the troubled recent history of designers' attempts to obtain copyright protection for their creations: "In *Kemp & Beatley v. Hirsch*, [34 F.2d 291, 292 (E.D.N.Y. 1929)], it was held that dress patterns were not copyrightable under the Act. *Cf. Millinery Creators' Guild v. Federal Trade Commission*, [109 F.2d 175, 177 (2d Cir. 1940)] (affirmed without discussion of the point in [312 U.S. 469 (1941)]), where the court said that 'What passes in the trade for an original design of a hat or a dress cannot be patented or copyrighted.' The lack of statutory copyright protection for dress designers has been repeatedly pointed out by the Court of Appeals in this Circuit. *Nat Lewis Purses v. Carole Bags*, [83 F.2d 475, 476 (2d Cir. 1936)]; *White v. Leanore Frocks*, [120 F.2d 113, 114-115 (2d Cir. 1941)]; *Belding Heminway Co. v. Future Fashions*, [143 F.2d 216, 218 (2d Cir. 1944)]." *Id.* at 803-804.

<sup>218</sup> *Id.* at 804.

<sup>219</sup> *See, e.g., Forstmann Woolen Co. v. J. W. Mays, Inc.*, 89 F. Supp. 964, 971 (E.D.N.Y. 1950) ("Nevertheless Exhibits 11 and 12 ['ladies' coats'] do bear such labels [containing notice of copyright]. Some one put them there. I am forced to conclude that they were on the garments when Miss Whiteside and Pfeifer purchased them. Such a use of the registration label was a violation of the copyright registration, if the copyright registration was valid. There is some question about such validity . . . . [T]here certainly is nothing artistic about the way in which the

The picture was about to change, however—not in a way that thoroughly remedied fashion designers’ concerns about “piracy,” but in a way that certainly complicated the legal landscape. In 1954, “[a] radical change in the legal status of original designs in the United States occurred [when] the United States Supreme Court, by a seven-to-two majority in *Mazer v. Stein*, 347 U.S. 201 (1954), upheld the copyrightability of ‘works of art’ that had been incorporated as the designs of useful articles,” notwithstanding their potential eligibility for design patent protection.<sup>220</sup> The complicated doctrinal landscape of copyright-for-fashion that exists today, laid out in the next three articles in this series, can arguably be traced back most directly to the decision in *Mazer v. Stein*—the effects of which the presiding Justices (especially during a court term that featured much higher-profile cases<sup>221</sup>) likely did not foresee.

At issue in the *Mazer* case was a lamp with a statuette base in the form of the human body, pictured in *Figure 2*, below. The sculptural portion of the lamp had been created using the traditional clay-model technique, from which a production mold for casting copies was made.<sup>222</sup> The mass-produced statuettes “were sold throughout the country both as lamp bases and as statuettes.”<sup>223</sup> During the appropriate timeframe, the “statuettes, without any lamp components added, were submitted by the [plaintiff] to the Copyright Office for registration as ‘works of art’ or reproductions thereof under . . . the copyright law, and certificates of registration issued.”<sup>224</sup>

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plaintiff’s name, nor the legend ‘100% Virgin Wool’, appears on the copyright label. That leaves the representation of the fleurs de lis. Surely and certainly in the form in which the fleurs de lis are shown, no originality is displayed. . . . I must conclude, therefore, that there is no infringement of the copyright registrations, because those registrations are not valid under the copyright statute.”)

<sup>220</sup> *Mazer v. Stein*, 347 U.S. 201, 223 (1954).

<sup>221</sup> *See, e.g.*, *Brown v. Board of Education*, 347 U.S. 483 (1954).

<sup>222</sup> *Mazer*, 347 U.S. at 202.

<sup>223</sup> *Id.* at 203.

<sup>224</sup> *Id.* at 202-203. The Court stated in a footnote that “[e]rrors of classification [in copyright applications] are immaterial.” *Id.* at 203 n.1.





**FIGURE 2:** Decorative lamp base at issue in *Mazer v. Stein*, 347 U.S. 201 (1954).

The defendants in the *Mazer* case, “[w]ithout authorization . . . copied the statuettes, embodied them in lamps and sold them.”<sup>225</sup> The original designer and manufacturer sued for copyright infringement; the defendants argued that the plaintiffs’ “publication [of the object] as a lamp and registration as a statue to gain a monopoly in manufacture that they assert is such a misuse of copyright as to make the registration invalid.”<sup>226</sup> The district court sided with the defendant; the Fourth Circuit reversed. The alleged infringer appealed to the Supreme Court, which granted *certiorari* because of conflicting lower-court decisions on the issue presented.<sup>227</sup>

As Justice Reed, writing for seven Justices, recounted, the Seventh Circuit,<sup>228</sup> among other courts, had rejected the proposition that an artistic object repurposed for a “useful” function was copyrightable, while the

<sup>225</sup> *Id.* at 203.

<sup>226</sup> *Id.* at 206.

<sup>227</sup> *Id.* at 203.

<sup>228</sup> See *Stein v. Expert Lamp Co.*, 188 F.2d 611, 612 (7th Cir. 1951) (“[While] the Copyright Act protects ‘Works of art; models or designs for works of art,’ [it] does not refer to articles of manufacture having a utilitarian purpose. . . . We have examined and considered all the cases cited but are not persuaded that a design of an electric lamp may be protected as a monopoly by means of a copyright registration, registered without an examination [of the sort conducted in the patent context] as to originality, novelty or inventiveness.”).

Fourth<sup>229</sup> and Ninth<sup>230</sup> Circuits, at least, had taken the opposite position. Justice Reed's opinion embarked on an elaborate examination of the legislative and administrative vicissitudes of copyright law over the previous 150 years, and ultimately found that any "[v]erbal distinctions between purely aesthetic articles and useful works of art [had] ended insofar as the statutory copyright language is concerned."<sup>231</sup> Justice Reed concluded (albeit based on seemingly non-dispositive portions of the available legislative history) that "[i]t is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts."<sup>232</sup> Giving considerable deference<sup>233</sup> to the Copyright Office's recently promulgated, more lenient

<sup>229</sup> Stein v. Mazer, 204 F.2d 472 (4th Cir. 1953).

<sup>230</sup> Rosenthal v. Stein, 205 F.2d 633 (9th Cir. 1953).

<sup>231</sup> Mazer, 347 U.S. at 211.

<sup>232</sup> *Id.* at 213.

<sup>233</sup> It was and remains unclear whether this deference was appropriate, though its role in the outcome of *Mazer* has been subsequently acknowledged. See *discussion* at *Eltra Corp. v. Ringer*, 579 F.2d 294, 298-99 (4th Cir. 1978) ("While the principal argument of the appellant is directed to the claim that its work was entitled to registration by the Copyright Office as a 'work of art' under § 5(g), it raises the point that the Register of Copyrights is a legislative office and as such may not exercise any executive powers or authority, in particular any power to issue rules and regulations, though there is specific legislative authorization for such exercise of power. Pursuing this line of reasoning, it argues that the Register can legally exercise no power to deny registration to any 'writing' or design submitted; that his power is very strictly limited to the receipt, deposit and issuance of a registration certificate. It must be conceded that this contention [pertaining to the 1976 Copyright Act] represents in effect a belated challenge to the 1909 revision of the Copyright Act and an attempt to confine the Register to the narrow range of duties exercised by him prior to the 1909 Act. In the roughly three-quarters of a century that the 1909 revision has been in effect, however, its constitutional validity has been generally assumed, including the power of the Register to issue rules and regulations. *Indeed, the leading case of Mazer v. Stein . . . proceeded on the assumption that the Register had such power and the decision in that case relied in its result to a substantial extent on the application of a rule issued by the Register under the authorization given him by the 1909 Act.*") (emphasis added) (citation omitted); *but see* *United States v. Brooks*, 945 F. Supp. 830, 833-34 (E.D. Pa. 1996) ("[T]he government cites to one Fourth Circuit opinion in which the court held that the Copyright Office acts as an executive agency. *Eltra Corp. v. Ringer*, 579 F.2d 294, 301 (4th Cir. 1978). This case is directly contradicted by a Second Circuit case cited by the defendant, in which the court stated that the Copyright Office is a part of the legislative branch. See *Harry Fox Agency, Inc. v. Mills Music, Inc.*, 720 F.2d 733, 736 (2d Cir. 1983), *rev'd on other grounds sub nom.*, *Mills Music v. Snyder*, 469 U.S. 153 (1985)[.] [Footnote 6: The correct characterization of] the Copyright Office was not a decisive issue for either [the Second Circuit or the Supreme Court in *Mills*], though Justice White, in dissent, noted that 'the Copyright Act is unusual

regulations concerning copyrightable subject matter,<sup>234</sup> Justice Reed announced:

The successive acts, the legislative history of the 1909 Act and the practice of the Copyright Office unite to show that ‘works of art’ and ‘reproductions of works of art’ are terms that were intended by Congress to include the authority to copyright these statuettes. Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. *As a standard we can hardly do better than the words of the present {Copyright Office} Regulation . . . naming the things that appertain to the arts {including “works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture.” 37 C.F.R. § 202.8 (1949)}* They must be original, that is, the author’s tangible expression of his ideas. [If that condition is met, *such original} expression, whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color, is copyrightable.*<sup>235</sup>

Although this passage is of major importance for the development of modern copyright law, one need not concern oneself with its exact wording; *Mazer’s* pronouncements about copyright-eligible subject matter have been superseded by the 1976 Copyright Act, as explained below.

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in that much of it, including the derivative-works exception, was drafted by the Copyright Office, which is itself an arm of Congress.’ *Mills Music*, 469 U.S. at 182 n.6 (1985). [End of footnote.] [In this court’s view, it] is the Copyright Act, not the Administrative Procedure Act, that dictates the policies and procedures of the Copyright Office. The mere fact that the Copyright Office is required to perform ‘administrative functions and duties’ (17 U.S.C. § 701(a)) under the Copyright Act is not enough to make the Copyright Office a component of the executive branch. Acting similarly to an executive agency is not the same as being part of the executive branch. The Copyright Office is a division of the Library of Congress, which is a part of the legislative branch, and thus the Copyright Office is part of the legislative branch.”).

<sup>234</sup> 37 C.F.R. § 202.8 (1949) (“Works of art (Class G) — (a) In General. This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. . . .”) See *Prestige Floral v. Cal. Artificial Flower Co.*, 201 F. Supp. 287, 291 (S.D.N.Y. 1962) (“[I]n 1949 section 202.8 of the Regulations was changed so as to make registrable the artistic features of jewelry, enamel, glassware, tapestries, and other similar materials. Such registration was to cover only the artistic aspects, as distinguished from ‘the mechanical or utilitarian’ aspects.”).

<sup>235</sup> *Mazer*, 347 U.S. at 213-14 (emphasis added) (citation omitted).

After Justice Reed resolved the question of the statuette's eligibility for protection under the Copyright Act, in isolation, he turned to the defendant's argument that "congressional enactment of the design patent laws should be interpreted as denying protection to artistic articles embodied or reproduced in manufactured articles."<sup>236</sup> In the defendant's view, "overlapping of patent and copyright legislation so as to give an author or inventor a choice between patents and copyrights should not be permitted."<sup>237</sup> Justice Reed acknowledged that some case law did indicate that the award of a *utility* patent for an object precluded copyright protection, but pointed out that, since at least 1910, multiple federal courts had found *design* patents and copyright protection to be perfectly compatible.<sup>238</sup> The Supreme Court gave its imprimatur to the latter class of decisions, holding that "the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art [as neither] the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted."<sup>239</sup> Justice Reed further explained that copyright's limitations, and its distinct objective from that of design patent law, would prevent the adverse effects that the defendant argued would follow from permitting overlapping protection:

The copyright protects originality rather than novelty or invention—conferring only 'the sole right of multiplying copies.' Absent copying there can be no infringement of copyright. [By contrast, 'independent creation' is *not* a defense to the infringement of a patent—a form of property that carries with it a so-called 'right to exclude.'<sup>240</sup>] Thus, respondents may not exclude others from using statuettes of human figures in table lamps; they may only prevent use of copies of their statuettes as such or as incorporated in some other article. [Copyright Office regulations make] clear that artistic articles are protected in 'form but not their mechanical or utilitarian aspects.' . . . *The dichotomy of protection for the aesthetic is*

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<sup>236</sup> *Id.* at 215-16.

<sup>237</sup> *Id.* at 216.

<sup>238</sup> *Id.* at 215 n.33 (citing *Louis De Jonge & Co. v. Breuker & Kessler Co.*, 182 F. 150, 155 (C.C.S.D. Pa. 1910), *aff'd on other grounds*, 191 F. 35 (3d Cir. 1911), and 235 U.S. 33 (1914)).

<sup>239</sup> *Id.* at 217.

<sup>240</sup> See *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 895 F.2d 1403, 1406 (Fed. Cir. 1990) ("[I]n patent law, the fact of infringement establishes the fact of damage because the patentee's right to exclude has been violated.") (citing 5 D. Chisum, *PATENTS* § 20.03[3] at 20-142 (1986)); *but see* *Apple, Inc. v. Motorola, Inc.*, 869 F. Supp. 2d 901, 909-10 (N.D. Ill. 2012) (Posner, J., sitting by designation) ("A reasonable royalty is a form of damages when awarded in the damages phase of an infringement litigation, though it usually is a form of equitable relief, as we'll see, when it is imposed, in lieu of an injunction, to prevent future harm to the patentee.").

*not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents. We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration.*<sup>241</sup>

The *Mazer* decision was unquestionably a major step forward for advocates of IP rights in industrial design, resulting in an overhaul of the Copyright Office's regulations on registrable works<sup>242</sup> and a revolution in the case law on copyright for many aspects of fashion design (among other types of "applied art.")<sup>243</sup> Yet the ruling also raised myriad questions, many eventually answered by courts and policymakers in a less cogent manner than one might have hoped. While this view is not uniformly held, one leading casebook laments that between the pre-*Mazer* period and the present, "the availability of copyright protection for the design of useful objects [like apparel] has evolved from the uncertain to the incoherent."<sup>244</sup>

The current state of affairs, described in a systematic manner in this series, is at least partly the result of zealous litigants pressing copyright

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<sup>241</sup> *Mazer*, 347 U.S. at 218 (emphasis added) (citations omitted). Compare *Oroamerica, Inc. v. D & W Jewelry Co.*, 10 F. App'x. 516, 517 (9th Cir. 2001) (non-precedential) ("Oroamerica, Inc. alleges that D & W Jewelry, Inc.'s sale of certain jewelry chains infringes upon Oroamerica's copyright in two jewelry chain designs. Oroamerica requested, and the district court denied, a preliminary injunction . . . . We are aware of no authority to support Oroamerica's contention that the district court was not entitled to consider the issuance of a design patent covering D & W Jewelry's gold chain as a relevant factor in evaluating whether to grant preliminary injunctive relief.").

<sup>242</sup> See *Prestige Floral v. Cal. Artificial Flower Co.*, 201 F. Supp. 287, 291 (S.D.N.Y. 1962) ("In August, 1956, the Copyright Office issued regulations which, in greater detail than ever before, explicitly describe what can be registered. These regulations do not talk in terms of 'writings' but do require that any object offered for registration meet at least minimal standards of originality and creativity, as well as fall within one of the classes enumerated in section 5 of the copyright statute." (quoting Subcommittee on Patents, Trademarks, and Copyrights, Senate Committee on the Judiciary, 86th Cong., 1st Sess., *Study No. 3, The Meaning of 'Writings' in the Copyright Clause of the Constitution*, at 100 (Comm. Print 1960) (hereinafter "*Study No. 3*").

<sup>243</sup> See *id.* at 291 ("The courts in recent years, particularly since *Mazer v. Stein*, are beginning to realize the validity of the copyright approach and are gradually overcoming their hesitation to hold, expressly or impliedly, that a three-dimensional object is a 'writing.'") (quoting *Study No. 3*, at 101).

<sup>244</sup> Robert A. Gorman & Jane C. Ginsburg, COPYRIGHT: CASES AND MATERIALS 221 (7th ed. 2006).

claims (some decidedly marginal<sup>245</sup>) in the courts. After all, designers and manufacturers of not only fashion, but other artistic “useful articles,” have tended to favor copyright protection over design patent protection wherever the former is at least conceivably available (and sometimes, even when it seems quite clear that it is not.) As one appellate court later observed, “where copyright is available, it is more popular than the design patent largely because copyrights are far easier and less expensive to obtain than design patents.”<sup>246</sup> But this tells only part of the story: with no examination of “novelty” by a government agency,<sup>247</sup> most formalities once required for copyright protection tempered and/or abolished by the Copyright Act of 1976 and the Berne Convention Implementation Act of 1988,<sup>248</sup> and a far

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<sup>245</sup> The author takes no view on the propriety of bringing suit cases, only noting that as an objective matter, some of the cases cited herein lay at the very outer edge—some might say the “razor’s edge”—of the law.

<sup>246</sup> *Schnadig Corp. v. Gaines Mfg. Co.*, 620 F.2d 1166, 1168 n.2 (6th Cir. 1980).

<sup>247</sup> *See Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 824 (11th Cir. 1982) (“Although the originality concept defies exact definition, courts generally agree that ‘originality’ for copyright purposes is something less than the novelty or uniqueness necessary for patent protection.”) (citing, *inter alia*, *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980)).

<sup>248</sup> *See* Copyright Act of 1976, 90 Stat. 2541; Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853, §§ 7-9 (1988). *See also Original Appalachian Artworks*, 684 F.2d at 826-27, 827 n.7 (“Prior to [January 1, 1978, the effective date of the 1976 Copyright Act,] detachable notices were defective and constituted improper notice under the 1909 copyright law. *See* 37 C.F.R. § 202.2(b) (9) (1981) (copyright notice on detachable tag does not meet requirements of proper notice for a work published before January 1, 1978). [Footnote omitted.] Under the new Act, however, publication of copies of a work with defective notice does not necessarily impair an author’s copyright protection . . . . The 1976 Copyright Act apparently liberalized certain of the requirements of notice from the 1909 Act by providing that ‘the notice shall be affixed to the copies in such manner and location as to give reasonable notice of the claim of copyright.’”) (citing Latman, *THE COPYRIGHT LAW* 147 (5th ed. 1979)); *Langman Fabrics v. Graff Californiawear, Inc.*, 160 F.3d 106, 114 (2d Cir. 1998) (“The defendants argue that even if Langman Fabrics was the author of the design under the work-for-hire doctrine, it invalidated its copyright when it failed to comply with the requirement in 17 U.S.C. § 401(b)(2) that a copyright notice include the year of first publication. [Footnote 6:] Section 401 does not apply to works first published after [the effective date of the Berne Convention Implementation Act,] March 1, 1989. *See Innovative Networks, Inc. v. Satellite Airlines Ticketing Centers, Inc.*, 871 F. Supp. 709, 720 (S.D.N.Y. 1995). The work in this case was published in 1984 and is therefore subject to section 401.”).

longer term of protection than that accorded to design patents,<sup>249</sup> it is no wonder that the tool of copyright has been ripe for use and abuse—even by those who, like a “pirated” designer trying to make a living, might have only noble intentions.

One should not overstate matters: the *Mazer v. Stein* decision did not revolutionize copyright law for all (or perhaps even most) aspects of fashion design.<sup>250</sup> But the lower federal courts certainly took notice of the Supreme Court’s declarations in the case. As recounted by Judge Clark, dissenting in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, “in response to [*Mazer v. Stein*] we have affirmed the copyright of ornamental jewelry, such as pins, bracelets, earrings, and the like, *Boucher v. Du Boyes, Inc.*, [253 F.2d 948 (2d Cir. 1958), *cert. denied*, *Du Boyes, Inc. v. Boucher*, 357 U.S. 936 (1958)]; and the district court has supported the copyright of a necklace, *Trifari, Krussman & Fishel, Inc. v. Charel Co.*, [134 F.Supp. 551 (S.D.N.Y. 1955)].”<sup>251</sup> For example, in one post-*Mazer* copyright infringement dispute over a decorative life-size “Santa Claus bag [designed to be

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<sup>249</sup> The term of U.S. design-patent protection has never exceeded fifteen years, while the term of U.S. copyright protection for most works has gradually climbed to the life of the author plus seventh years.

<sup>250</sup> See, e.g., *SCOA Industries, Inc. v. Famolare, Inc.*, 192 U.S.P.Q. 216, No. 75 Civ. 3357, 1976 U.S. Dist. LEXIS 16663 (S.D.N.Y. Feb. 13, 1976) (court agreed with Copyright Office “troughs, waves, and lines” on shoe sole did not exist independently as copyrightable work of art).

<sup>251</sup> *Vacheron & Constantin-Le Coultre Watches*, 260 F.2d at 644 (Clark, J., dissenting). Judge Clark, unlike the majority of the presiding panel, would have reached the issue of copyrightability, and would have ruled that the “highly ornamented watches [at issue in the case] were equally entitled to copyright with the ornamental lamp bases in *Mazer v. Stein*.” *Id.* Judge Clark further explained why the validity of the design patent at issue in the suit was too doubtful to justify the majority’s remand for a determination of novelty, and why *copyright* was a preferable source of protection for certain aspects of fashion design—at least, post-*Mazer*:

The prevailing view to date appears to be that we should rest upon infringement of a design patent, a view which presents pitfalls and has limitations, as I shall endeavor to point out. To me the more workable, though possibly more novel, course is that of copyright infringement . . . .

Just as our standard for mechanical patents which combine known elements is high, see, e.g., *Jungersen v. Baden*, [166 F.2d 807 (2d Cir. 1948), *aff’d*, 335 U.S. 560 (1949)], so in terms of the protection afforded, it should be no less high in the case of a design patent. *Knickerbocker Plastic Co. v. Allied Molding Corp.*, 2 Cir., 184 F.2d 652, 654 [(2d Cir. 1950)]. Doubtless it is because of these quite obvious difficulties that, to my knowledge, our court has never sustained a design patent challenged for lack of novelty. If this patent eventually survives, it will indeed mark the case as novel.

stuffed with newspaper and] cut from an appropriate pattern so that it defines the arms, legs and torso of a human form,” the defendant attacked “the validity of plaintiffs’ copyright [on the basis] that plaintiffs’ product is not a work of art at all, but rather a garment.”<sup>252</sup> Though not convinced that the work was, in fact, a garment,<sup>253</sup> the court explained: “[E]ven if plaintiffs’ Santa could be used as a garment, the copyright would not thereby be invalidated. For, in *Mazer v. Stein* . . . the Supreme Court put to rest all previous doubts on the subject by holding that the actual or intended use in industry of an article eligible for copyright does not bar or invalidate its registration[.]”<sup>254</sup>

Further, in the first major cluster of fabric design-related copyright infringement cases that followed *Mazer*, each brought by a company called “Peter Pan Fabrics, Inc.,” original Byzantine-inspired textile patterns were decisively held copyrightable by judges in the Second Circuit, undoubtedly the leading “fashion circuit”—an outcome that surely delighted fashion’s “anti-piracy” advocates. The 1959 disputes in the *Peter Pan Fabrics* cases<sup>255</sup>

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But for my part I do not see how this patent can possibly prevail against the prior art; there is literally nothing in it which can be considered even new. This, I think, is almost, if not quite, admitted with commendable candor in the opinion herewith, which calls the roll of some of the pertinent prior patents and shows the lack of novelty in the prior art of ‘sticks’ and ‘floaters’ in various combinations for clock or watch dials. The three patents cited in the opinion, those of Gardner, Dupertuis, and Jaeger, are particularly striking and — when seen in illustration more vivid than cold description — really leave nothing more to be imagined. It is urged that the use of jewels to catch the light and sparkle can be relied on as a dependable element of novelty. But this is surely incorrect. For this element appears in previous patents, indeed as early as the Blumstein Design Patent 96,642 of 1935 for a ‘watch dial’ which used only four numerals, instead of twelve, and provided ‘indications’ for the intermediate hours, ‘the indications being provided with baguette precious stones and the numerals being studded with precious stones.’ . . .

On the other hand, the copyright concept affords a different emphasis, one much more directly in point in a case such as this than the patent concept of novelty or new invention . . . .”

*Id.* at 642-44.

<sup>252</sup> *Doran v. Sunset House Distributing Corp.*, 197 F. Supp. 940, 942, 945 (S.D. Cal. 1960), *aff’d*, 304 F.2d 251 (9th Cir. 1962).

<sup>253</sup> *Id.* (“Plaintiffs’ Santa is not a ‘garment’ because it was neither designed nor intended to be worn by anyone as an article of clothing.”).

<sup>254</sup> *Id.*

<sup>255</sup> See *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142 (S.D.N.Y.1959); *Peter Pan Fabrics, Inc. v. Acadia Company, Inc.*, 173 F.Supp. 292 (S.D.N.Y.1959); *Peter Pan Fabrics, Inc. v. Dixon Textile Corporation*, 280 F.2d



involved virtually identical subject matter and legal issues as the above-mentioned 1949 case of *Verney Corp. v. Rose Fabric Converters Corp.*,<sup>256</sup> yet the later litigation went quite differently. And one need not wonder about *Mazer*'s impact on the outcomes of the later cases, for the presiding judges made plain the influence of the intervening Supreme Court ruling in each of the *Peter Pan Fabrics* opinions.

In the late 1950s, the company Peter Pan Fabrics found that it had a hit on its hands with a textile consisting of "a solid design made up of motifs suggestive of the Near East: arches reminiscent of Arabic architecture, figures much like those in Oriental rugs, tablets covered with palpable imitations of Arabic script and other unidentifiable but similar decorations."<sup>257</sup> The design proved so popular that it inspired a number of knock-offs, over which plaintiff sued in several differently captioned cases. The issue of the pattern's copyrightability was first squarely addressed in Judge Dimock's landmark 1959 opinion in *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*:<sup>258</sup>

The problem to be decided is whether a design printed upon dress fabric is a proper subject of copyright . . . . In *Mazer v. Stein*, 347 U.S. 201 [(1954)], Mr. Justice Reed said in the opinion of the court:

'It is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts. Herbert Putnam, Esq., then Librarian of Congress and active in the movement to amend the copyright laws, told the joint meeting of the House and Senate Committees:

"The term 'works of art' is deliberately intended as a broader specification than 'works of the fine arts' in the present statute with the idea that there is subject-matter (for instance, of applied design, not yet within the province of design patents), which may properly be entitled to protection under the copyright law."

*In Dr. Putnam's statement before the joint meeting we have an authoritative construction of the term 'works of art' in the Copyright Act as including 'applied design'. No better description of the subject matter of this litigation could be devised.*

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800 (2d Cir. 1960); *Peter Pan Fabrics, Inc. v. Dixon Textile Corp.*, 188 F. Supp. 235 (S.D.N.Y. 1960). See roundup of aforementioned cases at *Peter Pan Fabrics, Inc. v. Puritan Dress Co.*, 207 F. Supp. 563, 565 (S.D.N.Y. 1962).

<sup>256</sup> 87 F. Supp. 802 (S.D.N.Y. 1949).

<sup>257</sup> *Peter Pan Fabrics*, 169 F. Supp. at 144 (S.D.N.Y. 1959).

<sup>258</sup> *Id.* at 142.

*I therefore find that plaintiffs' design is a proper subject of copyright both as a work of art and as a print.*<sup>259</sup>

History, however, seems to have a better recollection of the related proceeding before Judge Herlands in *Peter Pan Fabrics, Inc. v. Acadia Co.*,<sup>260</sup> whose result in favor of the plaintiff was appealed and affirmed in the oft-cited *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*<sup>261</sup> In his decision for the plaintiff, Judge Herlands took note of “[t]he well-known history of the struggle between ‘copyists,’ ‘pirates,’ ‘freebooters,’ and the design ‘originators’ in the textile and allied industries.<sup>262</sup> After Judge Dimock’s decision in *Brenda Fabrics*, it seemed that questioning the pattern’s fundamental copyrightability was off the table. Thus, the defendants shifted their focus to *originality*. Here, again, the copyist lost. As Judge Herlands wrote: “The copyrighted designs are highly intricate and detailed both in over-all pattern and particular features. There is nothing in the record to impeach plaintiffs’ representations that the two designs, Byzantium and Grecian Glory, are ‘original’ expressions of characteristic Byzantine and Greek motifs and artifacts. Where, as here, the designs reflect creative originality and a substantial degree of skill, labor and independent judgment, they are proper subjects for copyright. See *Mazer v. Stein*, [347 U.S. 201, 214, 217-218 (1954).]”<sup>263</sup> It should be noted that the defendants in *Acadia* raised many other defenses to the plaintiff’s copyright infringement claims were raised, none successful.<sup>264</sup>

<sup>259</sup> *Id.* at 143 (emphasis added).

<sup>260</sup> 173 F. Supp. 292 (S.D.N.Y.).

<sup>261</sup> 274 F.2d 487 (2d Cir. 1960) (Hand, J.).

<sup>262</sup> *Acadia*, 173 F. Supp. at 296.

<sup>263</sup> *Id.* at 299. The court added, for good measure: “The ‘originality’ requirement for copyrightability is not onerous.” *Id.* This passage was undoubtedly music to the ears of previously defeated design-patent plaintiffs in fashion houses everywhere.

<sup>264</sup> See *Peter Pan Fabrics, Inc. v. Acadia Co.*, 173 F. Supp. 292, 295-96 (S.D.N.Y. 1959) (“Other infringement actions have been instituted against other defendants by the plaintiffs in this District to protect the copyrighted Byzantium design. In an action against Dixon Textile Corporation (Civil Action 140-109), District Judge Bryan, without opinion, granted plaintiffs’ motion for a preliminary injunction. Subsequently, in an action against Brenda Fabrics, Inc. (Civil Action 140-267), District Judge Dimock also granted plaintiffs preliminary injunctive relief. *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, D.C.S.D.N.Y.1959, 169 F.Supp. 142.’) [Nevertheless,] Defendant Weiner [now] argues: (1) that neither plaintiff has the requisite standing to bring a copyright infringement action; (2) that the defendant’s accused design is not an infringing copy of the plaintiffs’ copyrighted design; (3) that the dress made of plaintiffs’ fabrics which defendant allegedly copied bore no copyright notice; (4) that the plaintiffs’ copyright is invalid because the plaintiffs’

The appeal from Judge Herlands' ruling in *Acadia*, contrary to popular belief, did not directly address the question of the fabric pattern's copyrightability. As Judge Hand stated in the resulting opinion in *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, the appeal actually addressed only two questions concerning the fabrics shown in *Figure 3*: "(1) whether the defendant has in fact copied so much of the registered design as to infringe the copyright; and (2) whether the design was dedicated to the public, because it was sold without adequate notice of copyright as required by § 10 of the [Copyright Act]."<sup>265</sup> The Second Circuit panel ruled for the plaintiff on both issues.

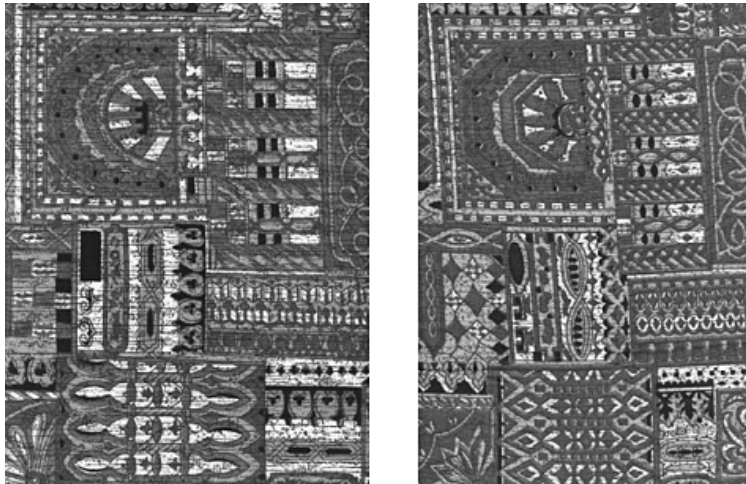


FIGURE 3: Fabric patterns at issue in *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960) (Hand, J.).

And although Judge Hand's decision in *Peter Pan Fabrics* in fact contained no holding on the copyrightability of fabric patterns, it is often remembered that way<sup>266</sup>—which may ultimately have mattered more. Such

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design was published with insufficient copyright notice; (5) that the wrong defendant has been sued; and (6) that the alleged infringement ceased promptly upon notice given by plaintiffs. [Further,] Defendant *Acadia* argues: (1) that the copyrights should not have been granted to plaintiffs because the designs were lacking in originality; (2) that, if arguendo the copyrights are valid, the plaintiffs' failure to provide proper notice of copyright on the ultimate products (i.e., dresses) that embody the plaintiffs' copyrighted fabric designs results in a loss of the copyrights; and (3) that the plaintiffs have failed to establish a proper basis for the issuance of a preliminary injunction.”)

<sup>265</sup> 274 F.2d 487, 489 (2d Cir. 1960) (Hand, J.).

<sup>266</sup> See, e.g., *Primcot Fabrics, Dep't of Prismatic Fabrics, Inc. v. Kleinfab Corp.*, 368 F. Supp. 482, 484 (S.D.N.Y. 1974) (“In *Peter Pan Fabrics, Inc. v. Martin*

details aside, the *Peter Pan Fabrics* cluster of cases made it clear that the Supreme Court's *Mazer* decision (though not actually cited in Judge Hand's opinion) would have the practical effect of immediately bringing most fabric patterns into the copyright fold.

How much further did the Supreme Court's *Mazer* decision (and derivative case law) reach, for the purposes of the copyrightability of "applied art" like fashion design? Quite a bit further. As recounted in 1962 the district-court case of *Prestige Floral v. Cal. Artificial Flower Co.*<sup>267</sup>

In *Mazer v. Stein*, 347 U.S. 201 (1954), the question raised was whether statuettes used as bases for electric lamps were protected by the copyright of the original models. The statuettes were of Balinese dancers. The Supreme Court held that use in industry would not bar or invalidate the copyrights.

One of the studies upon which the Report of the Register of Copyrights, [Copyright Law Revision, House Comm. on the Judiciary, 87th Cong., 1st Sess. (Comm. Print 1961)], was based pointed out the following on *the recent trend in copyrighting three-dimensional objects*:

*"The courts in recent years, particularly since Mazer v. Stein, are beginning to realize the validity of the copyright approach and are gradually overcoming their hesitation to hold, expressly or impliedly, that a three-dimensional object is a 'writing.' Perhaps the Copyright Office anticipated this development by changing its regulation with regard to the definition of the term 'work of art.' Prior to 1949 three-dimensional objects, intended primarily for commercial use, were not ordinarily granted registration. On the contrary, applicants were advised that 'protection of productions of the industrial arts, utilitarian in purpose and character, even if artistically made or ornamented, depends upon action under the patent law.' However, in 1949 section 202.8 of the Regulations was changed so as to make registrable the artistic features of jewelry, enamel, glassware, tapestries, and other similar materials. Such registration was to cover only the artistic aspects, as distinguished from 'the mechanical or utilitarian' aspects. When the validity of this regulation was challenged in Mazer v. Stein, the Register of Copyrights, as amicus curiae, took the position that the new regulation actually reflected the previous practice of the Office. The brief said in this regard — that the Copyright Office has consistently since 1909 — and even before then — registered works like the one in this case following the clearly stated mandate of Congress.*

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Weiner Corp., 274 F.2d 487 (2d Cir. 1960), the Court of Appeals held that ornamental designs on cloth were the proper subject of copyright under that section.").

<sup>267</sup> 201 F. Supp. 287, 290-91 (S.D.N.Y. 1962) (holding artificial lilac copyrightable, in part because of *Peter Pan Fabrics*).

*'In August, 1956, the Copyright Office issued regulations which, in greater detail than ever before, explicitly describe what can be registered. These regulations do not talk in terms of 'writings' but do require that any object offered for registration meet at least minimal standards of originality and creativity, as well as fall within one of the classes enumerated in section 5 of the copyright statute.'*"<sup>268</sup>

Taking a cue from the Copyright Office's views of, and regulatory response to, *Mazer v. Stein* (discussed in the above-excerpted passage), the lower federal courts pressed on in the general vein of the *Prestige Floral* court, displaying a strong tendency to favor industrial design copyright plaintiffs throughout the 1960s. Indeed, until the late 1970s, one finds a surprisingly small volume of reported decisions in which asserted copyright protection—at least, for works of applied art that were already the subject of copyright registrations—was not upheld in court. Thus, one 1966 case, *Ted Arnold Ltd. v. Silvercraft Co.*,<sup>269</sup> hinged on the copyrightability of “a simulation of an antique telephone [used] as a casing for a pencil sharpener.” Defendant had contended “that this copyrighted article is not a work of art because it is utilitarian” and that “the casing cannot be considered apart from the pencil sharpener.”<sup>270</sup> The court disagreed, relying on *Mazer v. Stein*: “Even without the crank, the telephone casing could still exist independently as a work of art . . . . Defendant is no more persuasive than the *Mazer* defendants in picturing the artistic features as nothing in them-selves and merely necessary parts of the product as a whole. An antique telephone is no more necessary to encase a pencil sharpener than a statuette is to support a lamp.”<sup>271</sup> In a passage whose relevance to fashion can hardly be ignored—and yet, has been, in many ways<sup>272</sup>—the court observed: “Customers are paying fifteen dollars for [the object at issue], not because it sharpens pencils uncommonly well, but because it is also a decorative conversation piece.”<sup>273</sup> Of course, the same is often true of “designer” fashion: a premium can be charged for *aesthetic* reasons. (Just as often, however, consumers are willing to pay a premium for the perceived “exclusivity” associated with particular products or fashion houses.<sup>274</sup>)

<sup>268</sup> *Id.* at 290-91.

<sup>269</sup> 259 F. Supp. 733 (S.D.N.Y. 1966).

<sup>270</sup> *Id.* at 734.

<sup>271</sup> *Id.* at 735.

<sup>272</sup> *But see* National Theme Prods., Inc. v. Jerry B. Beck, Inc., 696 F. Supp. 1348, 1350 (S.D. Cal. 1988) (“The final expression of these costumes is no more determined by their function than the pencil sharpener shaped like a telephone in *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966).”).

<sup>273</sup> *Ted Arnold, Ltd.*, 259 F. Supp. at 736.

<sup>274</sup> *See generally* Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769 (2012).

It was not until the late 1970s that the federal appellate courts, by and large, resumed the practice of subjecting the claims of textile pattern (or other fashion-related) copyright infringement plaintiffs to close scrutiny. Perhaps one of the first signs of the turning tide is the 1976 decision in *SCOA Industries, Inc. v. Famolare, Inc.*,<sup>275</sup> in which a district-court judge agreed with Copyright Office that sides of shoe soles featuring designs consisting of “troughs, waves, and lines” did not exist independently as work(s) of art. The court justified its ruling thus:

There can be no valid copyright in troughs in the sole or wavy lines on the sides. These have no existence as works of art and if they did have, lack even the minimum originality needed for copyright. . . . A shoe sole is an object whose intrinsic function is utilitarian. There are, of course, works of art which also serve a utilitarian function. The classic example is a statue used as a lamp base. *Mazer v. Stein*, 347 U.S. 201, 100 USPQ 325 (1953). It is clear that a statue can be identified as a work of art independent of its utilitarian aspects. It is concluded, in agreement with the Copyright Office, that the troughs, waves, and lines which appear on the shoe sole cannot be identified and do not exist independently as works of art. This being the case, Famolare has no claim of valid copyright as to the features of the shoe sole which Scoa has allegedly copied.<sup>276</sup>

Some members of the appellate bench appear to have been growing uncomfortable with the “bleed” of industrial design copyright, especially for textile patterns. Perhaps the first major “let’s wait just a minute here” moment at the appellate level occurred in 1977’s *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*,<sup>277</sup> in which a Second Circuit panel majority—contrary to the ruling of the district court judge—found substantial similarity sufficient to justify the issuance of a preliminary injunction.

Judge Mansfield, concurring and dissenting, was not so sure, writing in a separate opinion: “At a distance of 15 feet or more the similarity between Novelty’s 253, on the one hand, and the two infringing Joan plaids, on the other, was substantial, not solely because of the shading, spacing, composition, and juxtaposition of the diamonds and stripes, but *principally because of the identical color scheme* which lent the same overall effect to the designs . . . . *However, a closer comparison of the fabrics (at a distance of two to five feet) reveals several marked differences*, which were noted by Judge Werker [below] . . . .”<sup>278</sup> Judge Mansfield concluded: “In my view the color scheme should be treated as one of the elements of the copyrighted

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<sup>275</sup> 192 U.S.P.Q. 216 (S.D.N.Y. Feb. 13, 1976).

<sup>276</sup> *Id.* at \*5-\*7.

<sup>277</sup> 558 F.2d 1090 (2d Cir. 1977).

<sup>278</sup> *Id.* at 1095.

design and, since we are in as good a position as the district court to resolve the infringement issue, we should hold that Novelty's Style 253 is not infringed by any of the alleged infringing fabrics produced by Joan other than its 'Fleetwood Spice' and 'Sand.'"<sup>279</sup>

During the same fifteen-year "honeymoon" period in the courts for copyright-for-fashion that followed the *Peter Pan Fabrics* cases, there had been much activity in the legislative arena. According to those with influence, it had become clear that a number of difficult issues in copyright law—including the issue of protection for industrial design, post-*Mazer*—could only be satisfactorily resolved only through legislation. For this and other reasons, beginning in the mid-1960s a variety of parties took the first steps toward a major overhaul of the copyright law, the likes of which the U.S. had not seen since the passage of the 1909 Copyright Act. While the eventual result, the Copyright Act of 1976, made many admirable strides forward, the law arguably did little to bring coherency to the thorny area of copyright protection for works of industrial design and applied art. At the very least, it failed to definitively resolve many of the difficult questions raised and left unanswered by the Supreme Court in *Mazer v. Stein*.

It will come as no surprise that when efforts to overhaul the copyright laws finally came to a head in the early 1970s, advocates of robust copyright protection for fashion designs—notwithstanding their recent success in the courts—pressed their cause yet again. Indeed, perhaps because of the positive judicial momentum, these advocates made significant progress toward codification of copyright-for-fashion-design.

One draft section of what eventually became the 1976 Copyright Act, known as the "Design Protection Act of 1975" (a/k/a "Title II")<sup>280</sup> sought to "create a new limited form"<sup>281</sup> of copyright protection for 'original' designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself."<sup>282</sup> While Title II was passed in the Senate as part of the "Copyright Revision

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<sup>279</sup> *Id.*

<sup>280</sup> S. 22, 94th Cong., 2d Sess., "Title II—Protection of Ornamental Designs of Useful Articles."

<sup>281</sup> See 1-2 NIMMER ON COPYRIGHT § 2.08[B][3], \_\_\_ at note 116.1 ("Note that even Title II excluded from the scope of its protection 'three-dimensional features of shape and surface with respect to men's, women's, and children's apparel, including undergarments and outerwear.' § 202(e).").

<sup>282</sup> See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800-01 (D.C. Cir. 1978) (quoting H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50 (1976), U.S. Code Cong. & Admin. News 1976, at 5659, 5663 (hereinafter "1976 Act House Committee Report")).

Bill,” it was deleted from the final Copyright Act in the House.<sup>283</sup> The House Committee Report explains that the section was removed “in part because the new form of design protection provided by Title II could not truly be considered copyright protection and [was thus not] appropriately within the scope of copyright revision.”<sup>284</sup>

The House Report further stated that the new Copyright Act sought to track the Supreme Court’s *Mazer* decision in distinguishing between “copyrightable works of applied art [versus] uncopyrighted works of industrial design.”<sup>285</sup> The Report deemed “ladies’ dress[es]” as belonging in the second category, absent some copyrightable component that could be identified as “physically or conceptually . . . separable” from the utilitarian aspects of such articles:

The [House] Committee [on the Judiciary] has added language to the definition of “pictorial, graphic, and sculptural works” [in the new Copyright Act] in an effort to make clearer the distinction between works of applied art protectable under the bill and industrial design not subject to copyright protection . . . . In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. *Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.*<sup>286</sup>

The end result of the legislative process, for purposes of applied art like fashion design, was summarized in the Second Circuit’s later decision in *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*:<sup>287</sup>

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<sup>283</sup> See 1-2 NIMMER ON COPYRIGHT § 2.08[B][3], \_\_\_ at note 116.1 (“This design legislation, passed by the Senate as a part of the Copyright Revision Bill, was deleted from the final Act by the House of Representatives. See Conf. Rep., p. 82.”).

<sup>284</sup> 1976 Act House Committee Report, at 5663.

<sup>285</sup> *Id.* at 5668.

<sup>286</sup> *Id.* at 5667-68 (emphasis added).

<sup>287</sup> 834 F.2d 1142 (2d Cir. 1987).



Against the history of copyright protection well set out in the majority opinion in *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 415-18 (2d Cir. 1985), and in Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 709-17 (1983), Congress adopted the Copyright Act of 1976. The “works of art” classification of the Copyright Act of 1909 was omitted and replaced by reference to “pictorial, graphic, and sculptural works,” 17 U.S.C. § 102(a)(5). According to the House Report, the new category was intended to supply “as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.” H.R. Rep. No. 1476, at 55. The statutory definition of “pictorial, graphic, and sculptural works” states that “the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U.S.C. § 101 . . . .

As courts and commentators [later came] to realize, however, the line Congress attempted to draw between copyrightable art and noncopyrightable design “was neither clear nor new.” Denicola, *supra*, 67 Minn. L. Rev. at 720. One aspect of the distinction that has drawn considerable attention is the reference in the House Report to “physically or conceptually” (emphasis added) separable elements.<sup>288</sup>

Indeed, as the *Brandir* court explains, while Congress (or at least the House Judiciary Committee speaking for the bill) had “attempted to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection,”<sup>289</sup> the final statutory language ultimately proved inadequate for the resolution of many actual disputes over the copyrightability of utilitarian works.<sup>290</sup>

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<sup>288</sup> *Id.* at 1143-44.

<sup>289</sup> H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50 (1976), U.S. Code Cong. & Admin. News 1976, at 5667.

<sup>290</sup> See Michael A. Solomon, *The Copyright of Useful Articles: “Conceptual” Retreat in the Second Circuit*, 52 BROOK. L. REV. 713, 714 n.4 (1986) (“Once protection is granted, the useful article by definition becomes a work of applied art. If protection is denied, it is ‘merely’ an industrial design.”); see also Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 721-22 (1983) (at some point “applied art” and “industrial design” meet). The Denicola article later proved influential in shaping the “separability” doctrine that arose from the courts’ application of the statutory “useful article” language. See, e.g., *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1143-44 (2d Cir. 1987).

Shortly after the 1976 Copyright Act took effect on January 1, 1978,<sup>291</sup> the D.C. Circuit in *Esquire, Inc. v. Ringer* addressed the Copyright Office's broad interpretation of its own regulation on useful articles, which had been applied to deny petitioner a copyright registration in the appearance of its decorative lighting fixture.<sup>292</sup> The regulation in question (no longer in effect in identical form) provided, *inter alia*: "If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art."<sup>293</sup> The applicant for the registration argued that the Registrar had misinterpreted and misapplied its regulation. The District Court had agreed, citing *Bleistein* for the principle that "[t]here cannot be and there should not be any national standard of what constitutes art and the pleasing forms of the Esquire fixtures [which 'serve both to decorate and to illuminate'] are entitled to the same recognition afforded more traditional sculpture."<sup>294</sup>

The D.C. Circuit reversed, siding with the Copyright Office.<sup>295</sup> The appellate court found the Copyright Registrar's interpretation of § 202.10(c), and its application to deny the petitioner his requested copyright registration, to be "reasonable and well-supported," and in harmony with the then-recent 1976 Copyright Act:

The Register's interpretation of § 202.10(c) derives from the principle that industrial designs are not eligible for copyright. Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products. Most recently, Congress deleted a proposed section ["Title II"] from the Copyright Act of 1976 that would have "create(d) a new limited form of copyright protection for 'original' designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself." In rejecting proposed Title II, Congress noted the administration's concern that to make such designs eligible for copyright would be to create a "new monopoly" having obvious and significant anticompetitive effects. The is-

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<sup>291</sup> For additional information on legislative activity pre-dating the 1976 Copyright Act, see generally Goldenberg, *supra* note 11; Rocky Schmidt, *Designer Law: Fashioning a Remedy for Design Piracy*, 30 UCLA L. REV. 861, 865 n.30 (1983).

<sup>292</sup> 591 F.2d 796 (D.C. Cir. 1978). Note that although this appeal was decided after the 1976 Copyright Act went into effect, it concerned a work pre-dating 1978, which was governed by the 1909 Copyright Act. Further, even as a matter of statutory construction of the 1909 Act, the continuing import of *Esquire* is open to question—as discussed below.

<sup>293</sup> 37 C.F.R. § 202.10(c) (1976).

<sup>294</sup> *Esquire, Inc. v. Ringer*, 414 F. Supp. 939, 941 (D.D.C. 1976).

<sup>295</sup> *Esquire*, 591 F.2d at 800.

sues raised by Title II were left for further consideration in “more complete hearings” to follow the enactment of the 1976 Act.<sup>296</sup>

The *Esquire* court found especially persuasive a portion of the Registrar’s brief arguing that (1) “consumer preference sometimes demands uniformity of shape for certain utilitarian articles [and] to give one manufacturer the monopoly on such a shape would also be anticompe[ti]tive;” and (2) “insofar as geometric shapes are concerned, there are only a limited amount of basic shapes, such as circles, squares, rectangles and ellipses [and] it would be unfair to grant a monopoly on the use of any particular such shape, no matter how aesthetically well it was integrated into a utilitarian article.”<sup>297</sup> (These public policy-based arguments are still made in substantially similar form today, not only in the continuing debate about copyright—or copyright-like—protection for apparel, but also in the increasingly important arena of “trade dress” lawsuits premised on the configuration and/or appearance of fashion goods.<sup>298</sup>)

Yet *Esquire* would not be the last word on the subject of copyright protection for works of applied art and industrial design. Just two years later, advocates of copyright protection for such works achieved a major victory in the case of *Kieselstein-Cord, Inc. v. Accessories by Pearl, Inc.*<sup>299</sup> At issue in this Second Circuit appeal were belt buckles comprising “solid sculptured designs . . . with rounded corners, a sculpted surface, a rectangular cut-out at one end for the belt attachment [and] several surface levels.”<sup>300</sup> (Photos of the two buckles at issue are shown in *Figure 4*, below.) The presiding panel split two to one, ruling in favor of the buckles’ copyrightability.

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<sup>296</sup> *Id.* at 800-01 (citations omitted).

<sup>297</sup> *Id.* at 801 n.15.

<sup>298</sup> See discussion at *The Politics of ‘Piracy’* (fifth installment in this series).

<sup>299</sup> 632 F.2d 989 (2d Cir. 1980).

<sup>300</sup> *Id.* at 990.

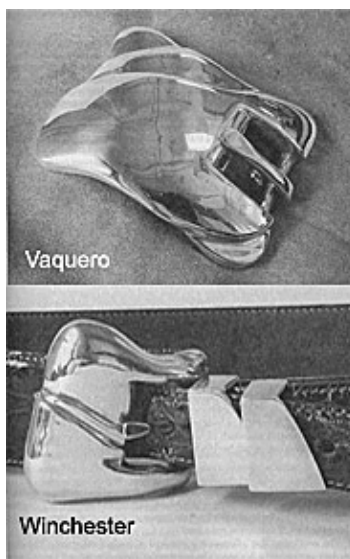


FIGURE 4: Belt buckles at issue in *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989 (2d Cir. 1980).

The *Kieselstein-Cord* majority began its opinion by asserting that the dispute lay “on a razor’s edge of copyright law.”<sup>301</sup> This description may have been a self-fulfilling prophecy, for the panel proceeded to engage in an in-depth analysis of the notion of copyright protection for “conceptually separable” components of industrial design and applied art in a dispute that involved only *physically* separable belt buckles—objects rather analogous to the sculptural lamp base deemed copyrightable by the Supreme Court, some thirty-six years earlier, in *Mazer v. Stein*.<sup>302</sup> The panel, apparently not tempted by the low-hanging fruit of “physical separability,” wrote: “We see in appellant’s belt buckles conceptually separable sculptural elements, as apparently have the buckles’ wearers who have used them as ornamentation for parts of the body other than the waist. The primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function.”<sup>303</sup> The key to copyrightability, in other words, lay in the buckle’s independent appeal as a work of art. The buckle was thus similar to one of the few categories of fashion-related goods well-established as copyright-eligible: “Pieces of applied art, these buckles may

<sup>301</sup> *Id.*

<sup>302</sup> See 17 U.S.C. § 101 (1976) (addressing copyrightability of separable components of “useful articles”).

<sup>303</sup> *Kieselstein-Cord*, 632 F.2d at 993.

be considered jewelry, the form of which is subject to copyright protection.”<sup>304</sup>

The well-known District Court Judge Jack Weinstein, sitting on the presiding panel by designation, objected in his dissenting opinion that while the works at issue were “admirable aesthetically pleasing examples of modern design, [they were] indubitably belt buckles and nothing else; their innovations of form are inseparable from the important function they serve—helping to keep the tops of trousers at waist level.”<sup>305</sup> In his view, no copyright protection was available here precisely *because* of the designer’s “success in completely integrating the artistic designs and the functional aspects of the buckles.”<sup>306</sup> He reminded the majority that just two years earlier, the D.C. Circuit in *Esquire v. Ringer* (a case whose majority opinion was barely addressed by the *Kieselstein-Cord* majority) had, in Judge Weinstein’s words, “denied copyright protection to the overall shape of a lighting fixture because of its integration of the functional aspects of the entire lighting assembly.”<sup>307</sup> Weinstein then quoted what he considered the most relevant passage from *Esquire*, the D.C. Circuit panel’s declaration that the “overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright.”<sup>308</sup>

The Second Circuit’s *Kieselstein-Cord* ruling—at least, in modified form—ultimately won out over the D.C. Circuit’s view expressed in *Esquire*.<sup>309</sup> In one of the first fashion-related cases to be decided after *Kieselstein-Cord*, *Transworld Mfg. Corp. v. Al Nyman & Sons, Inc.*,<sup>310</sup> a district court cited the 1980 Second Circuit decision in support of its holding that there was a possibility of “separability” sufficient to support the copyrightability of eyeglass display cases, and thus denied the defendant’s motion for summary judgment on that basis. Advocates of copyright-for-fashion—perhaps seeking to capitalize on the momentum of victories like those in *Kieselstein-Cord* and *Transworld Mfg.*, perhaps still bitter over fashion’s treatment in the

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<sup>304</sup> *Id.*

<sup>305</sup> *Id.* at 994 (Weinstein, J., dissenting).

<sup>306</sup> *Id.*

<sup>307</sup> *Id.* at 995.

<sup>308</sup> *Id.* (citing *Esquire v. Ringer*, 591 F.2d 796, 804 (D.C. Cir. 1978)).

<sup>309</sup> See *Pivot Point Int’l v. Charlene Prods.*, 372 F.3d 913, 922 n.8 (7th Cir. 2004) (“[Despite the skepticism of some] that the statutory language encompassed both physical and conceptual separability, circuits have been almost unanimous in interpreting the language of § 101 to include both types of separability. . . . Only one appellate court [the D.C. Circuit in *Esquire, Inc. v. Ringer*, discussed above] has rejected the idea of conceptual separability.”).

<sup>310</sup> 95 F.R.D. 95 (D. Del. 1982).

days leading up to the passage of the 1976 Copyright Act—launched another round of lobbying efforts in 1983, pushing a bill similar to the fallen “Title II”/“The Design Protection Act of 1975.”<sup>311</sup> These efforts, like those that came before it, proved unsuccessful.

Meanwhile, many (including the Copyright Office<sup>312</sup> and some judges) were questioning the precise meaning—including, most importantly, the limiting principles—of the *Kieselstein-Cord* decision. In 1985, a different Second Circuit panel revisited *Kieselstein-Cord* and tried to answer such questions, in a rather far-fetched dispute about the copyrightability of “four human torso forms . . . each of which is life-size, without neck, arms, or a back, and made of expandable white styrene.”<sup>313</sup> (Photos of two such forms are shown in *Figure 5*, below.) The panel majority in *Carol Barnhart Inc. v. Economy Cover Corp.*, gently backpedaled on the *Kieselstein-Cord* decision, but notably declined to overrule it. Instead, the *Carol Barnhart* panel majority held that torso forms at issue were not entitled to the same copyright protection that the *Kieselstein-Cord* belt buckles had received, because unlike the decorative components in the earlier case, which “were not in any respect required by their utilitarian functions,” the features claimed to be aesthetic or artistic in the [torso] forms were “inextricably intertwined with the utilitarian feature, the display of clothes.”<sup>314</sup> (Judge Newman, dissenting, would have applied a different test—whether the disputed “design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously”<sup>315</sup>—and would have reached the opposite result.<sup>316</sup>)

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<sup>311</sup> See H.R. 2985, 97th Cong. 1st Sess. (1983), *reprinted in* 2 COPYRIGHT L. REP. (CCH) 20,228 (1983).

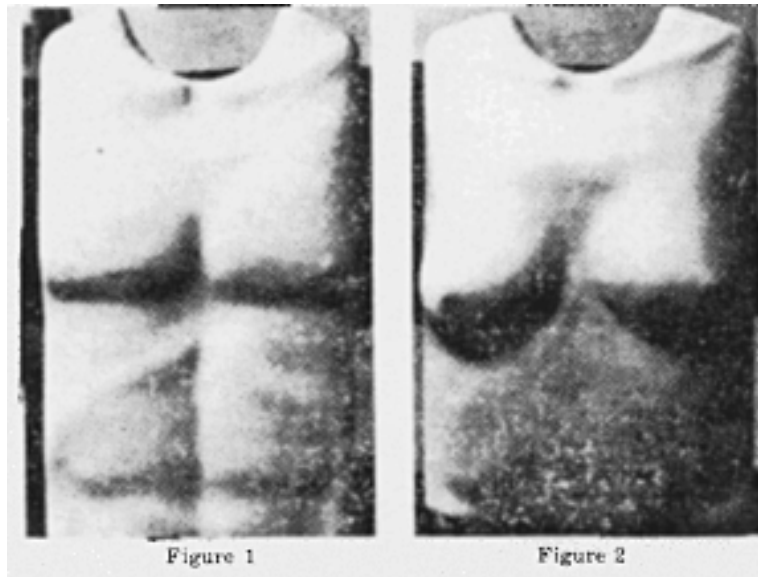
<sup>312</sup> See U.S. Copyright Office, Compendium II of Copyright Office Practices § 505.03 (1984) (recognizing that a “carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for [copyright] registration” on the basis of separability).

<sup>313</sup> 773 F.2d 411, 412 (2d Cir. 1985).

<sup>314</sup> *Id.* at 419.

<sup>315</sup> *Id.* at 422.

<sup>316</sup> *Id.* at 424 (“The initial concept in the observer’s mind, I believe, would be of an art object, an entirely understandable mental impression based on previous viewing of unclad torsos displayed as artistic sculptures. Even after learning that these two forms are used to display clothing in retail stores, the only reasonable conclusion that an ordinary viewer would reach is that the forms have both a utilitarian function and an entirely separate function of serving as a work of art. I am confident that the ordinary observer could reasonably conclude only that these two forms are not simply mannequins that happen to have sufficient aesthetic appeal to qualify as works of art, but that the conception in the mind is that of a work of art in addition



**FIGURE 5:** Torso forms at issue in *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985).

Two years later, in *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co.*,<sup>317</sup> a different Second Circuit panel set out to bring clarity to the parameters of copyright law's "conceptual separability" doctrine. The *Brandir* appeal turned, in part, on the alleged copyrightability of an aesthetically unusual "bicycle rack made of bent tubing that is said to have originated from a wire sculpture."<sup>318</sup> The panel's majority opinion began with the observation that "[i]n passing the Copyright Act of 1976 Congress attempted to distinguish between protectable 'works of applied art' and 'industrial designs not subject to copyright protection,'"<sup>319</sup> but conceded that the courts had experienced "difficulty framing tests by which the fine line establishing what is and what is not copyrightable can be drawn."<sup>320</sup>

The *Brandir* majority reviewed the *Kieselstein-Cord* and *Carol Barnhart* decisions and concluded that "conceptual separability [was] alive and well, at least in this circuit"; the difficulty lay in "determining exactly what it is

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to and capable of being entertained separately from the concept of a mannequin, if the latter concept is entertained at all.").

<sup>317</sup> 834 F.2d 1142 (2d Cir. 1987).

<sup>318</sup> *Id.*

<sup>319</sup> *Id.* (citing H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54, reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5667).

<sup>320</sup> *Id.*

and how it is to be applied.”<sup>321</sup> The majority surveyed various proposals for the exact parameters of the doctrine,<sup>322</sup> and found most appealing the commentary of Professor Robert C. Denicola, who had written in a 1983 article that “although the Copyright Act of 1976 was an effort “to draw as clear a line as possible,” in truth ‘there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.’”<sup>323</sup> In the following passage, the panel alternately quoted and paraphrased Denicola’s proposal:

“Copyrightability [of artistic elements of ‘useful articles’] should turn on the relationship between the proffered work and the process of industrial design.” [Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983).] [Denicola] suggests that “the dominant characteristic of industrial design is the influence of nonaesthetic, utilitarian concerns” and hence concludes that copyrightability “ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations.” [Footnote omitted.] *Id.* To state the Denicola test in the language of conceptual separability, *if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.*<sup>324</sup>

The panel majority then formally adopted the Denicola approach to conceptual separability, explaining that it represented the best available test because (1) it could be reconciled with the court’s precedent, (2) it would alleviate discrimination against non-representational art, and (3) it would “not be too difficult to administer in practice.”<sup>325</sup> When applied to the bicycle rack at issue in *Brandir*, the test yielded a finding of non-copyrightability, as “the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements.”<sup>326</sup> In the majority’s view, “while the rack may have been derived in part from one or more

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<sup>321</sup> *Id.* at 1144.

<sup>322</sup> *Id.* A more comprehensive exploration of these various proposals can be found in Judge Newman’s *Carol Barnhart* dissent. See *discussion* at 773 F.2d at 419 *et seq.*

<sup>323</sup> *Id.* at 1145 (quoting Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983)).

<sup>324</sup> *Id.* (emphasis added).

<sup>325</sup> *Id.*

<sup>326</sup> *Id.* at 1147.



‘works of art,’ it is in its final form essentially a product of industrial design,” which “the designer ha[d] clearly adapted . . . to accommodate and further a utilitarian purpose.”<sup>327</sup>

Judge Winter, dissenting in relevant part,<sup>328</sup> received no support from the other members of the panel for his view—informed largely by Judge Newman’s dissenting opinion in *Carol Barnhart*—that “the relevant question [should be] whether the design of a useful article, however intertwined with the article’s utilitarian aspects, causes an ordinary reasonable observer to perceive an aesthetic concept not related to the article’s use,” and that “[t]he answer to this question is clear in the instant case because any reasonable observer would easily view the Ribbon Rack as an ornamental sculpture.”<sup>329</sup> In Judge Winter’s view, the majority’s “adaptation of Professor Denicola’s test diminishes the statutory concept of ‘conceptual separability’ to the vanishing point” and the majority’s “focus on the process or sequence followed by the particular designer makes copyright protection depend upon largely fortuitous circumstances concerning the creation of the design in issue.”<sup>330</sup> (Subsequent decisions on conceptual separability suggest that Judge Winter’s critiques were not entirely unfounded.<sup>331</sup>)

To be sure, the *Brandir* decision did not bring an end to the conceptual difficulties or the debate surrounding the separability tests.<sup>332</sup> But with the trio of *Kieselstein-Cord*, *Carol Barnhart*, and (most importantly) *Brandir* on the books, the predominant analytical framework of copyright protection for articles of industrial design and applied art—and thus, *the general parameters that would henceforth govern the copyrightability of most works of fashion design*—had been established, at least in the most crucial “fashion

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<sup>327</sup> *Id.*

<sup>328</sup> Judge Winter concurred with the panel majority’s discussion and disposition of the plaintiff’s trademark and unfair competition claims, which are not relevant for present purposes. *Id.* at 1152.

<sup>329</sup> *Id.* at 1151-52.

<sup>330</sup> *Id.* at 1151.

<sup>331</sup> See discussion at *On ‘Originality’* (second installment in this series).

<sup>332</sup> See discussion at *Pivot Point Int’l v. Charlene Prods.* 372 F.3d 913, 921 (7th Cir. 2004) (“Although the Congressional goal was evident, application of [the 1976 Copyright Act’s ‘separability’] language has presented the courts with significant difficulty. Indeed, one scholar has noted: ‘Of the many fine lines that run through the Copyright Act, none is more troublesome than the line between protectible pictorial, graphic and sculptural works and unprotectible utilitarian elements of industrial design.’ PAUL GOLDSTEIN, 1 COPYRIGHT § 2.5.3, at 2:56 (2d ed. 2004).”).

circuit.”<sup>333</sup> Of course, myriad questions about the doctrine’s application to specific types of works would have to be resolved through case-by-case adjudication (even as lobbying efforts continued in the legislative realm.<sup>334</sup>) That application of the conceptual separability doctrine in apparel and accessories-related disputes forms part, though certainly not all, of the broader contemporary doctrinal landscape of copyright protection for fashion design under U.S. law, addressed in great detail later in this article series.

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<sup>333</sup> *But see* *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 548 (S.D.N.Y. 2010) (Koeltl, J.) (“None of the Second Circuit cases has purported to establish an exclusive test for determining conceptual separability. Indeed, the most recent entry in the field, *Chosun*, appears to endorse both the ‘separate concept’ test and the ‘judgment exercised independently of functional influences’ test. *See Chosun [Int’l, Inc. v. Chrisba Creations, Ltd.]*, 413 F.3d 324, 329 (2d Cir. 2005). It is therefore unclear what test should be applied in a case such as this, involving design elements on dresses.”) Whether or not Judge Koeltl’s statement of the law *circa* 2010 was correct, the *Brandir* test continues to provide the foundation for conceptual separability analysis in the Second Circuit (and in several other jurisdictions), even if the test has been tweaked and appears to have lost its teeth, as discussed in *Macrodoctrines* (second installment in five-article series).

<sup>334</sup> *See, e.g.,* Lee B. Burgunder, *Product Design Protection After Bonito Boats: Where It Belongs and How It Should Get There*, 28 AM. BUS. L.J. 1, 3 (1990) (“Currently, Congress is debating a bill that would establish a separate system of protection for product designs. [H.R. 902, 101st Cong., 1st Sess. (1989).]”).