



The History and Principles of American Copyright Protection for Fashion Design: On ‘Originality’

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I. INTRODUCTION TO *ON ‘ORIGINALITY’*

As discussed in the previous installment of this five-part series, *A Strange Centennial*, lawyers and non-lawyers alike have often parroted the refrain that U.S. copyright does not apply to articles of fashion design. The American legal system’s actual treatment of fashion articles is far more nuanced. If pressed for an accurate generalization, one might reasonably state that certain components of fashion design are copyright-eligible, but even those elements tend to receive less consistent and robust protection than that accorded to most other types of “artistic” or “expressive” works under the law.

The main objective of *A Strange Centennial* was to shed light on the evolution of popular and judicial thinking about the *conceivability* of copyright protection under U.S. law as an appropriate vehicle for asserting exclusive rights over works of fashion design. An examination of the resulting doctrinal and rhetorical innovations in fashion-related copyright litigation from the late Nineteenth Century to the late Twentieth Century revealed that, after an initial period of “inconceivability,” lasting from the inception of American copyright until the early 1900s,¹ designers pressed increasingly “colorable” claims of copyright infringement concerning their creations.

¹ As discussed in *A Strange Centennial*, when designers brought fashion-related IP lawsuits in the opening years of the twentieth century, the vast majority simply did not question the assumption that copyright was not a conceivable vehicle for asserting exclusive rights. There is a written record of the shifting of this collective assumption in the form of previously mentioned judicial decisions from the 1920s, when American plaintiffs first began to bring claims against “design pirates” grounded in copyright law. Charles E. Colman, *The History and Principles of American*

For a roughly thirty-year period beginning in the 1920s, copyright protection hovered somewhere between being *conceivable* as appropriate for copyright protection and actually *eligible* for it. The Supreme Court's 1954 decision in *Mazer v. Stein*, holding the decorative base of a lamp to be "separable" as a work of art, and thus eligible for copyright protection, resolved the threshold question of "eligibility," writ large, for certain components of applied art.² From that point on, courts were tasked with separating the eligible from the ineligible. One might conceptualize this shift as a change in the judicial understanding of the appropriate inquiry from (1) whether copyright protection was conceivable for works fashion design *as a category of creative output* to (2) *whether certain sub-categories of fashion-related works* were eligible for copyright protection under U.S. law. After an initial "honeymoon" period in which courts applied the Supreme Court's *Mazer* holding to bring several components of fashion design—most notably, fabric patterns and works of jewelry—into the copyright fold, federal courts in the 1970s began to question anew the copyrightability of fashion articles. However, different federal judges went about this in very different ways.

This second installment, *On 'Originality,'* surveys a number of notable fashion design-related judicial decisions from the 1970s to present, in order to parse their treatment of two core principles of copyright law: the "originality" requirement and the "idea-expression" distinction. As we will see, the forty-year period under discussion has been characterized by a smattering of judicial decisions applying these doctrines in ways that have stretched, shoehorned, and transformed copyright protection for works of fashion design in idiosyncratic and sometimes incoherent ways.

While the doctrines mentioned above certainly have important roles to play in U.S. copyright jurisprudence, they have arguably been deployed by courts in fashion-design disputes with the aim and/or result of achieving, often *sub silentio*, the same disfavored treatment of fashion design reflected in the history laid out in *A Strange Centennial*. Indeed, one might best think of these principles as tools used for the judicial implementation of various intuitions arising from the social, cultural, and ontological complexities of fashion design.³ To the extent that one can generalize the manner in which these factors have influenced judicial treatment of fashion design in U.S. copyright law, one might posit the following:

Copyright Protection for Fashion Design: A Strange Centennial, 6 HARV. J. SPORTS & ENT. L. 224 (2015).

² 347 U.S. 201, 214 (1954).

³ See discussion at *A Strange Centennial*; see also Charles E. Colman, *Design and Deviance: Patent as Symbol, Rhetoric as Metric*, 55 JURIMETRICS J. (forthcoming 2015).

Works of fashion design are presumptively ineligible for copyright protection, except for certain components that have been “grandfathered” in by the case law between roughly 1954 and 1980. However, even works of fashion design that *are* potentially copyright-eligible tend to be “constructively derivative,” and are thus entitled to (a) no protection or (b) less robust protection than that awarded to most other copyright-eligible works.

These deep themes are only occasionally made explicit in the “surface discourse” of judicial decisions.⁴ Yet their effect can be observed in the cumulative “on-the-ground” judicial application of major copyright-law principles—not only the “idea-expression” distinction and the “originality” requirement, but also a variety of other doctrines discussed later in this series.

As this installment will show, courts have sometimes invoked the “idea-expression” distinction and/or the “originality” requirement as a way to put a decisive “foot down” on the question of copyrightability for newly contested sub-categories of fashion design;⁵ other courts have *effectively* rejected the prospect of copyright protection for contested articles of fashion design by applying the same doctrines not as all-or-nothing threshold bars to protection, but rather as “filtering” or “thinning” tools. In decisions of the latter variety, courts appear to give works of fashion design a “pass” on the question of copyright eligibility, but dramatically narrow (or even eviscerate) that protection by later excluding large portions of works as irrelevant to the question of infringement. Still other courts have applied the “idea-expression” and “originality” doctrines in decidedly mechanical ways that do not reflect the ontological differences between many works of fashion design and more traditional genres of copyrightable works, like books and musical compositions. The current, heterogeneous doctrinal landscape has resulted in large part from the inconsistency and conceptual incompatibility of these divergent approaches to the adjudication of copyright disputes over works of fashion design.⁶

⁴ See Colman, *Design and Deviance*, *supra* note 3 (arguing that design patents were marginalized in IP jurisprudence due to themes pervading the “deep discourse” of federal courts’ decisions).

⁵ See, e.g., *SCOA Industries, Inc. v. Famolare, Inc.*, No. 75 Civ. 3357, 1976 U.S. Dist. LEXIS 16663, *5-*6 (S.D.N.Y. Feb. 13, 1976) (ruling that “the wavy lines or ridges on the sides of [shoe] soles and . . . the troughs in the bottom of the soles” did exist independently as copyrightable work(s) of art).

⁶ See *Boisson v. Banian, Ltd.*, 273 F.3d 262, 270 (2d Cir. 2001) (“Absent evidence of copying, an author is entitled to copyright protection for an independently produced original work despite its identical nature to a prior work, because it is independent creation, and not novelty that is required.”); compare *Todd v. Montana*

Compounding the problem of this “substantive” doctrinal fracturing is the issue of *procedural* fracturing. When courts treat similar or identical principles as, alternatively, (1) threshold requirements presenting “questions of law,” potentially appropriate for adjudication on a motion to dismiss; (2) “mixed questions of law and fact” dictating the requirements for making out a *prima facie* case on summary judgment; or (3) affirmative defenses, which (by their very nature) place the burden on a defendant to rebut conclusions that would otherwise lead to liability;⁷ the natural outcome is a reduction in the cohesiveness, predictability, and efficiency of copyright doctrine concerning works of fashion design.

In recognition of such obstacles to the coherence of the law, this Article identifies instances in copyright litigation where courts have dealt with works of fashion design inconsistently—for example, by applying one doctrine in name, but drawing on the substance of an entirely different doctrine; by (perhaps inadvertently) fusing doctrines structurally designed to serve different functions; and by introducing procedural variables of (often unrecognized) significance. Illuminating the day-to-day workings of these mechanics is a necessary first step toward bringing conceptual uniformity to this little-understood corner of U.S. copyright law.

Silversmiths, Inc., 379 F. Supp.2d 1110, 1113 (D. Colo. 2005) (“Plaintiff has not ‘recast and arranged’ the public domain elements of her jewelry in an original way. Instead, she has taken the constituent elements of barbed-wire and arranged them in a way that by all objective measures still matches the elemental arrangement of barbed-wire [S]he has failed to show what copyrightable feature(s) she has added to her work to separate it from ordinary public domain barbed-wire.”) *with* Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., Inc., 509 F.2d 64, 65 (2d Cir. 1974) (“The test of copyright infringement is whether the similarity between the products would lead ‘the average lay observer . . . (to) recognize the alleged copy as having been appropriated from the copyrighted work,’ Applying this test here, the district court concluded that the average layman would not find sufficient similarity in the parties’ particular expressions of the idea of a jeweled turtle pin to warrant a finding of infringement. We agree.”).

⁷ For an example of a passage from a judicial decision that conflates a variety of legal and factual inquiries, to the detriment of clarity and guidance to actual or potential litigants, *see* L & L White Metal Casting Corp. v. Joseph, 387 F.Supp. 1349, 1353 (E.D.N.Y. 1975) (“While copyright protection for originality exists if a new element is introduced which is novel or original as compared to the previously known art or material, the introduction of such a new element to the original article will not suffice for infringement protection if the ordinary lay observer would still regard the two articles as substantially similar.”).

II. EXPLORING JUDICIAL INVOCATION OF THE “IDEA-EXPRESSION DISTINCTION” AND THE “ORIGINALITY REQUIREMENT”
(INCLUDING THE “THIN COPYRIGHT” DOCTRINE)

A. *The “Idea-Expression Distinction” and Its Variable Application*

Federal courts in the United States regularly recite that a work’s eligibility for copyright protection hinges on its compliance with three basic requirements. The first is that the subject matter for which copyright protection is sought must constitute “copyrightable expression,” as opposed to an “uncopyrightable idea.” The second is that the subject matter in question must qualify as “original.” The third requirement, which will not be discussed here, is that a work be “fixed in a tangible medium” (because most fashion articles are static, tangible objects, there are seldom disputes as to whether works of fashion design satisfy the “fixation” requirement). This section will explore the idiosyncratic doctrinal landscape concerning the first of these tenets, the “idea-expression distinction,” highlighting loci of overlap, tension, and/or unacknowledged consistency with other principles of U.S. copyright law.

American copyright law has long recognized a distinction between “ideas” and “expression.” Both Congress and the courts have repeatedly recited the mantra that copyright protection exists only for particular *expressions* of an idea, and not for *the ideas contained* therein.⁸ This tenet, however, is much easier to recite than to apply. As the case law reveals, when confronted with disputes over concrete works, it is often challenging to draw principled distinctions between an “idea” and its “expression.” This difficulty was apparent to Judge Learned Hand some fifty years ago, when he wrote the following in a Second Circuit decision concerning fabric designs:

Obviously, no principle can be stated as to when an imitator has gone beyond copying the “idea,” and has borrowed its “expression.” Decisions must therefore inevitably be ad hoc. In the case of designs, which are addressed to the aesthetic sensibilities of an observer, the test is, if possible, even more intangible.⁹

⁸ 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work”).

⁹ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

Judicial techniques for distinguishing copyrightable expression from non-copyrightable ideas have improved only marginally in the decades since Judge Hand made his insightful observation. Courts have struggled, in particular, to apply this doctrine in the context of visual works, including fabric patterns. As will become apparent, the difficulty of distinguishing between the “idea” behind visual material from possible “expressions” of that idea is likely responsible, in part, for designers’ frequent lack of success in obtaining and/or enforcing copyright protection for their creations.

The 1977 district court decision in *Russell v. Trimfit, Inc.*¹⁰ provides an illuminating starting point for a discussion of judicial idiosyncrasies and inconsistencies in this area. The plaintiff in *Russell* claimed to have designed so-called “toe socks” (socks with individual compartments for each toe), alleging that the defendant had infringed its copyright in making competing toe socks. The presiding court could have opted for any number of routes to disposing of the plaintiff’s claim; the most intuitive method would likely have been to rule that plaintiff’s work was a non-copyrightable “useful article,” period.¹¹ Instead, the court dismissed the case on the ground that plaintiff was claiming copyright protection for an “idea” rather than original “expression”—and thus had no viable cause of action under U.S. copyright law—as opposed to U.S. patent law. The presiding judge wrote: “Plaintiff contends that her copyrights prevent others from engaging in the business of manufacturing toe socks. We think that plaintiff has misconstrued the rights afforded under the Patent and Copyright laws [A] copyright does not confer an exclusive right to the idea disclosed, as does a patent.”¹² The court went on to explain that the broad rights asserted by the plaintiff were incompatible with the fact that “[t]he prerequisites for copyright registration are minimal”—and specifically, that “[u]nlike a patented product, [a] copyrighted work need not be novel, nor rise to the level of an ‘invention’; it need only be original, *i.e.*, created without copying.”¹³

The *Russell* decision thus illustrates, as a preliminary matter, the potential interrelatedness of the “idea-expression” distinction, copyright law’s

¹⁰ 428 F. Supp. 91 (E.D. Pa. 1977).

¹¹ The “useful article” bar to copyrightability, along with its exceptions for “physically or conceptually separable” artistic works, will be explored in depth in the next installment of this series, *On ‘Separability.’* (forthcoming).

¹² *Russell*, 428 F. Supp. at 93.

¹³ *Id.* at 93 (“A copyright gives protection from copying only; a person working independently would not infringe a copyright even though his resulting work was substantially identical to a copyrighted work. A patentee, on the other hand, may exclude anyone from the field covered by his patent, even if the latter developed his invention independently.”)

“originality” requirement, and its withholding of protection from “useful articles.” While it would undoubtedly have been useful for the Third Circuit to weigh in on the appropriate treatment of these copyright-law tenets, it affirmed the district court’s decision in a summary manner used for disputes determined to lack “precedential or institutional value.”¹⁴ This lack of sustained engagement by appellate courts appears to be a recurring theme in federal court proceedings over alleged rights in gross concerning the appearance of designed goods.¹⁵

While the idea-expression distinction has thus been used in lieu of the “useful article” bar to copyright protection, it has also been used in a manner reminiscent of copyright’s “originality” requirement. The latter iteration has appeared in several fashion-related disputes where designed articles bear similar visual motifs. In such cases, the idea-expression doctrine has not infrequently served as an adjunct to the conventional originality analysis; in addition to the usual requirements for originality—that material in question (1) have originated with the author and (2) reflect a “modicum of creativity”—the idea-expression distinction steps in to further demand *differentiation from ubiquitous or naturally existing material*.¹⁶

American copyright jurisprudence has traditionally claimed not to care whether a work is in fact *new*, but only whether it is the author’s “independent creation” and whether an alleged infringer copied *that particular author’s version* of the material in question.¹⁷ However, fashion-design disputes,

¹⁴ *Russell v. Trimfit, Inc.*, 568 F.2d 770 (3d Cir. 1978) (explaining that the Third Circuit rules state that « [a]n opinion which appears to have value only to the trial court or the parties is ordinarily not published »).

¹⁵ See generally Colman, *Design and Deviance*, *supra* note 3.

¹⁶ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346 (1990). This iteration of the idea-expression distinction also overlaps significantly with the copyright-law doctrine of “*scènes à faire*,” discussed in some detail below and in greater detail in *On ‘Similarity,’* (forthcoming). For an example of a relatively recent decision treating as conceivable the copyrightability of applied art, but ultimately rejecting the material in question (a collection of artificial corsages) as insufficiently “creative,” non-“original,” and “idea”-based for copyright protection, see *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 783 (S.D.N.Y. 1968) (“[O]riginality is not proved merely because plaintiff may have had the idea to produce artificial corsages made out of a new plastic material. There can be no copyright on an idea.”) (citing *Baker v. Selden*, 101 U.S. 99 (1879); *Uneeda Doll Co. v. P & M Doll Co.*, 353 F.2d 788 (2nd Cir. 1965)).

¹⁷ *Id.* at 345 (“Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some

perhaps more than litigation in any other area of copyright law, reflect a tendency by courts to make this standard more stringent.

In such cases, federal judges' implementation of the idea-expression distinction (along with a ratcheted-up originality requirement) has arguably grafted onto copyright law principles arising in *patent law* that serve to preclude the award of exclusive rights in, *inter alia*, material as it can be found in nature, material already existing in the body of invented objects and process (known as the "prior art"), and material whose development would have been "obvious" to those with the relevant knowledge and background.¹⁸

In such circumstances, a would-be patent owner (or patent-infringement plaintiff) cannot obtain or enforce patent rights over the material in question. This principle is traditionally envisioned as wholly removed from copyright jurisprudence; several fashion design-related cases in the copyright realm, however, suggest otherwise.

The Ninth Circuit's decision in *George S. Chen Corp. v. Cadona Int'l, Inc.*¹⁹ illustrates both (1) the partial importation of patent law's "prior art"

creative spark, 'no matter how crude, humble or obvious' it might be Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.") (internal citations omitted).

¹⁸ See *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S.Ct. 2107, 2116 (2013) (under 35 U.S.C. § 101, "[p]roducts of nature are not created, and 'manifestations . . . of nature [are] free to all men and reserved exclusively to none'") (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980)); *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1342 (Fed. Cir. 2005) (under 35 U.S.C. § 102(b), "[a] patent claim is not valid if 'the invention was patented or described in a printed publication . . . more than one year prior to the date of the application for patent in the United States'"); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415-16 (2007) ("For over a half century, the Court has held that a 'patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men.' This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.") (internal citations omitted). The real-life implementation of these principles remains the subject of substantial uncertainty and controversy; further, their applicability to the subject matter of *design* patents can be idiosyncratic. See *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014) (explaining doctrinal framework for evaluating obviousness of designs).

¹⁹ 266 Fed. App'x. 523 (9th Cir. 2008). This decision might be viewed as a recent iteration of what is arguably the archetypal case on these issues, *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) ("The critical distinction between 'idea' and 'expression' is difficult to draw. As Judge

principle into copyright disputes over certain works of fashion design and (2) the way in which the idea-expression distinction and the originality requirement tend to blur when courts utilize this type of reasoning to dispose of copyright litigation. In *Cadona*, a panel majority affirmed the lower court's grant of summary judgment to a defendant accused of infringing plaintiff's "copyrights on [works consisting of] dolphin, frog, and moon/star wind chime ornaments, and on a stand-alone frog ornament."²⁰ In reaching this result, the panel did not merely use prior art-like reasoning, but stated explicitly: "GSC contends that its moon/star ornament had 'subtle differences' *from the prior art* of such ornaments[.]"²¹ In the panel majority's view, GSC had failed to identify "what those differences may be," making it "impossible to tell whether the differences, if any, are 'more than a "merely trivial" variation [on the 'prior art'], something recognizably "his own.'" "²² The majority went on to explain:

As GSC concedes, its dolphin and frog ornaments are "approximately true to life." It failed to identify any elements of the dolphin or frog that it selected that are not commonplace or dictated *by the idea* of a swimming dolphin or sitting frog sculpture. GSC's concept was to make a "cute"

Hand candidly wrote, 'Obviously, no principle can be stated as to when an imitator has gone beyond copying the "idea," and has borrowed its "expression.'" *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). *At least in close cases, one may suspect, the classification the court selects may simply state the result reached rather than the reason for it.*' (emphasis added). Most courts have been less "candid" than the *Kalpakian* and *Peter Pan* courts in acknowledging the manipulability of the idea-expression distinction, at least in the context of visual works. *But see* Mannion v. Coors Brewing Co., 377 F. Supp. 2d 444, 456, 458-59 (S.D.N.Y. 2005) ("[T]he argument reveals an analytical difficulty in the case law about which more ought to be said . . . The idea/expression distinction arose in the context of literary copyright. . . . In the visual arts, the distinction breaks down. For one thing, it is impossible in most cases to speak of the particular 'idea' captured, embodied, or conveyed by a work of art because every observer will have a different interpretation. Furthermore, *it is not clear that there is any real distinction between the idea in a work of art and its expression.* An artist's idea, among other things, is to depict a particular subject in a particular way. As a demonstration, a number of cases from this Circuit have observed that a photographer's 'conception' of his subject is copyrightable. By 'conception,' the courts must mean originality in the rendition, timing, and creation of the subject - for that is what copyright protects in photography. But the word 'conception' is a cousin of 'concept,' and both are akin to 'idea.' In other words, *those elements of a photograph, or indeed, any work of visual art protected by copyright, could just as easily be labeled 'idea' as 'expression.'*") (emphasis added).

²⁰ *Cadona*. 266 F. App'x at 524.

²¹ *Id.* (emphasis added).

²² *Id.*

dolphin-with an open mouth and an uplifted, twisted tail which made it appear to be swimming — but *these features necessarily follow from the idea of a swimming dolphin*. See *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) (noting that a tyrannosaurus is commonly pictured with its mouth open, and that *no reliance may be put upon similarity in expression resulting from the physiognomy of dinosaurs*). There is no indication that the frog is anything but a stereotypical frog, sitting as a frog would sit in nature.²³

The proposition that the representation of “natural” objects on works of fashion design might preclude copyright protection under the idea-expression distinction has, at times, surfaced in a broader form which has resulted in the defeat of copyright-infringement claims by fashion designers. In *Fashion Victim, Ltd. v. Sunrise Turquoise, Inc.*,²⁴ for example, the plaintiff had created a series of t-shirts bearing cartoon images of skeletons engaging in various sexual acts. After the plaintiff learned that a third party was selling a line of t-shirts showing skeletons in sexual positions, it filed suit for copyright infringement. The court ruled against the plaintiff-designer, applying an iteration of the idea-expression dichotomy that arguably undermined the plaintiff’s rights in “separable” artistic works:

All of the differences (and they are numerous) between the competing designs negate any infringement, while all of the similarities are the natural result of the limitations of the subject matter—the idea itself. To grant Fashion a preliminary injunction under the circumstances here would impermissibly extend the protection of the law to the nonprotectible idea of depicting skeletons as engaged in sexual activity of various kinds.²⁵

The contours of unprotectable “ideas” have proven malleable; not every court wrestling with the question of idea versus expression—even where the depictions in question are of “natural objects”—has ruled against plaintiff-designers. In *Wildlife Express Corp. v. Carol Wright Sales, Inc.*,²⁶ for example, a designer/retailer brought suit to enforce copyright protection in the design of its duffel bags, which featured a stuffed animal head attached to one end and an animal tail attached to the other.²⁷ Finding the duffel bags to be protectable expression rather than an unprotectable idea, the court wrote: “In this case, protection is claimed for the animal heads and tails them-

²³ *Id.* (emphasis added, some internal citations omitted).

²⁴ 785 F.Supp. 1302 (N.D. Ill. 1992).

²⁵ *Id.* at 1307 (emphasis omitted).

²⁶ 18 F.3d 502 (7th Cir. 1994).

²⁷ *Id.* at 505-06.

selves, and for the way they are placed on the duffle bags, but not for the general idea of animal heads on duffle bags.”²⁸

A different district court was similarly inclined to rule in favor of the plaintiff-designer in *Cynthia Designs, Inc. v. Robert Zentall, Inc.*,²⁹ granting a preliminary injunction where the defendant had copied the plaintiff’s design for a pendant in the shape of a t-shirt.³⁰ The court reasoned that “Cynthia has not, in this case, attempted to claim that its copyright extends to all T-shirts, or even to all renditions of T-shirts as articles of jewelry. Cynthia merely claims that its particular expression of the T-shirt as jewelry is protected.”³¹

The ruling in *Cynthia Designs* is arguably difficult to reconcile with the outcome in *Todd v. Montana Silversmiths, Inc.*,³² where the presiding court rejected the possibility of copyright protection in jewelry designed to resemble barbed wire.³³ In *Todd*, the court found that the existence of barbed wire precluded the plaintiff’s claim to any exclusive rights in the jewelry at issue, reasoning: “Any expression contained in Plaintiff’s work is a necessary concomitant of the idea of barbed-wire jewelry. As such, it may not be copyrighted.”³⁴ The cases were decided nearly three decades apart, during which time major doctrinal developments occurred.³⁵ Nevertheless, they highlight the unpredictability of judicial application of the idea-expression distinction in the context of fashion design. Some decisions appear to adhere to a nar-

²⁸ *Id.* at 507.

²⁹ 416 F. Supp. 510 (S.D.N.Y. 1976).

³⁰ *Id.* at 511, 514.

³¹ *Id.* at 512.

³² 379 F. Supp. 2d 1110 (D. Colo. 2005).

³³ *Id.* at 1111.

³⁴ *Id.* at 1114. The court added: “Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all.” *Id.* (quoting *Satava v. Lowry*, 323 F.3d 805, 813 (9th Cir. 2003)).

³⁵ Of potential significance is the Supreme Court’s decisive rejection of the “sweat of the brow” doctrine in *Feist Publ’ns. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 352-55, 359-360 (1991), which, if decided twenty years earlier, might have influenced the reasoning of the 1976 decision in *Cynthia Designs*, given the court’s finding, “on inspection of plaintiff’s pendants, that its renditions of a T-shirt as articles of jewelry required the exercise of ‘artistic craftsmanship . . .’”. 416 F. Supp. at 512. Also of potential significance is the three-decade expansion of objects in what might be called the “aesthetic public domain”—material determined not by the rules governing copyright expiration, but by the degree to which visual material is commonplace. *See id.* (“these pendants contain ‘distinguishable variations’ from ordinary T-shirts in the public domain”).

row understanding of the idea-expression distinction, while others sometimes seize on it as a sort of end-run around the low bar of “originality” set by the Supreme Court. In the process, the originality requirement might appear unchanged “on the books,” but can surface in real-life litigation—by means of idea-expression-based reasoning—as an obstacle whose contours are somewhere in the gray area between copyright “originality” and patent “novelty.”

In addition to conflating the idea-expression distinction with copyright law’s “useful article” and “originality” doctrines, some courts have either intentionally or inadvertently introduced the idea-expression distinction into the *infringement*-oriented “substantial similarity” determination (addressed in detail in the fourth installment of this series, *On ‘Similarity.’*) Consider *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*,³⁶ in which the plaintiff had designed pants bearing dragon figures, and alleged copyright infringement by the defendant which put similar (but not identical) dragon-designs on its own pants.³⁷ In ruling for the defendant, the court stated that “only the particularized expression of the dragon is protectable, not the idea of the dragon itself or even the idea of putting a dragon on pants.”³⁸ In addressing the issue of substantial similarity, the court found the defendant’s dragons to be “dissimilar” from plaintiff’s:

[T]he overwhelming impression [when examining both designs] is of dis[]similarity, and the Court cannot imagine that the dragon images (as distinguished from the mere idea of putting a dragon on pants) came from the same creative source. The Court’s noted differences are merely illustrative of a factual finding which is difficult to explain beyond saying that the dragons are obviously and substantially dissimilar.³⁹

The court’s reference to a “factual finding which is difficult to explain” evokes the oft-recited conventional wisdom in U.S. copyright jurisprudence that the murkiness of the “substantial similarity” inquiry warrants sending such questions to a jury; instead, the court disposed of the case on summary judgment through the idea-expression distinction:

No reasonable factfinder could conclude that the dragons at issue are substantially similar in the relevant respect because virtually all of the similarity is attributable to the fact that the images are all dragons.⁴⁰

³⁶ 292 F. Supp. 2d 535 (S.D.N.Y. 2003).

³⁷ *Id.* at 538-39.

³⁸ *Id.* at 553.

³⁹ *Id.* at 554 (emphasis omitted).

⁴⁰ *Id.* at 553; *cf.* *Angela Adams Licensing, LLC v. Surya Carpet, Inc.*, No. 07-77-P-H, 2008 WL 686868, at *7-*8 (D. Me. Mar. 10, 2008) (“In *Concrete [Mach. Co. v.*

What might give pause to the reader—let alone to the plaintiff in the case—is that the court, in one breath, denies the possibility of substantial similarity, only to concede the existence of (at least some) similarity a moment later. As noted in the contrasting district-court decision excerpted in footnote 39 courts often declare that it is disfavored to grant summary judgment based on a lack of substantial similarity where there are admittedly similar elements in the parties' works. To be sure, it might represent good public policy, to dispose of claims like Maharishi's at the summary-judgment stage (or even earlier) on the basis of claims over unprotectable material. (We will return to this discussion in the fourth installment of this series, *On 'Similarity.'*) But to say that Maharishi could not proceed to a jury trial because of the “fact that the images are all dragons”⁴¹ arguably stretches the idea-expression distinction to its breaking point—and raises questions about tacit judicial assumptions in copyright disputes about the value of plaintiffs' creations.⁴²

In short, courts presiding over copyright-infringement disputes concerning fashion design⁴³ have invoked the “idea-expression” distinction in a

Classic Lawn Ornaments, Inc., 843 F.2d 600, 606 (1st Cir.1988)], the work at issue was a design for a concrete, life-sized deer, and the First Circuit said that “[t]he idea behind this particular expression can be briefly described as a “realistic-looking concrete deer.”” *Id.* at 607. The idea and its expression in that case were close to being the same thing; in the words used by the First Circuit, ‘as idea and expression merge . . . a copyright holder must then prove substantial similarity to those few aspects of the work that are expression not *required* by the idea.’ *Id.* (emphasis in original). . . . However . . . , the Lulu design is closer to an original work embodying only one of an infinite variety of ways of expressing an idea than it is to a concrete, life-sized deer. The shapes in the Lulu design are not geometric shapes; they are irregular shapes [T]he defendant has not established that the Lulu design ‘incorporate[s] unprotected modern ideas.’ Substantial similarity is a fact-based question, making summary judgment unpopular in copyright litigation.”)

⁴¹ *Maharishi*, 292 F. Supp. 2d at 553.

⁴² Federal judges have been under instructions from the U.S. Supreme Court for over a century not to make determinations about the worthiness or value of art in copyright litigation. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“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.”). Yet works of design—and fashion design, in particular—represent an apparent blind spot for the egalitarian aesthetic ethos endorsed in *Bleistein* and many subsequent decisions. See *discussion at A Strange Centennial; accord.* Colman, *Design and Deviance*, *supra* note 3 (detailing and hypothesizing sociocultural reasons for design's long-disfavored treatment by the federal courts).

⁴³ Not all of the dynamics noted here are entirely unique to fashion design. See, e.g., *Satava v. Lowry*, 323 F.3d 805, 810 (9th Cir. 2003) (plaintiff's copyright in

manner resembling the “useful article” bar to copyrightability; as an alternative means of finding a lack of sufficient “originality” for copyright protection, sometimes through a sort-of backdoor introduction of patent-law principles into copyright cases; and even as a dispositive consideration in the “substantial similarity” inquiry. In numerous fashion-related disputes, the idea-expression distinction has shown itself to be an obstacle that can rear its head at virtually any point in a case,⁴⁴ for myriad purposes—to the detriment of coherence and predictability in the law governing the copyrightability of fashion design.

B. The “Originality” Requirement and the Rise of “Thin Copyright”

1. Constitutional Source of “Originality” Requirement and General Application

Assuming that subject matter for which copyright protection is sought qualifies as protectable “expression” under the idea-expression distinction, such expression must further be “original” to receive copyright protection. The Supreme Court most recently articulated the originality requirement in its 1991 decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁴⁵ Because the requirement of originality has no explicit statutory basis, *Feist* (as interpreted by the circuit courts in the intervening quarter-century since it was decided) generally serves as the touchstone for federal courts’ analyses of originality. However, the general and often-abstract dictates of *Feist*, compounded by the difficulty of applying a holding geared toward the specific genre of works in the category of “factual compilations,” have often led courts to apply *Feist* to works of fashion design in idiosyncratic ways—and even to develop alternative frameworks for evaluating originality that are arguably irreconcilable with *Feist*’s decidedly lax requirements.⁴⁶

glass jellyfish sculpture held not infringed, as similarities with defendant’s work stemmed from jellyfish physiology). However, it is potentially significant that the observed twists and tears in the application of the idea-expression doctrine stem from cases decided during the period of federal-court backlash to the post-*Mazer* “honeymoon” period of welcoming many aspects of fashion design into the copyright fold. See discussion at *A Strange Centennial*.

⁴⁴ See discussion at ‘On Similarity.’

⁴⁵ 499 U.S. 340 (1991).

⁴⁶ Consider (1) above-cited examples of judicial invocation of the idea-expression distinction for non-traditional purposes, with the apparent effect of raising the originality bar for fashion-design plaintiffs; (2) the discussion in this section of “thin copyright” and its often-accompanying “striking similarity” standard for infringement; and (3) other doctrinal and pseudo-doctrinal techniques for rendering moot

The *Feist* case arose when one telephone company sued another for copying its phone book; the defendant challenged the source phone book's eligibility for copyright protection, as a threshold matter.⁴⁷ The Supreme Court granted *certiorari* in the case and used Justice O'Connor's majority opinion as something of a massaged "restatement" of the broad principles governing copyright law's "originality" requirement. First, the *Feist* Court resolved the issue at the root of the Court's 1918 "hot news" decision in *INS v. AP*; contrary to the rationale behind the *INS* Court's ruling—and many decisions of lower courts since then—a creator's time and efforts (or "sweat of the brow," as such labor has sometimes been described) does *not* provide a basis for an award of copyright protection.⁴⁸ The proper focus is on the end product, not the process:

The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying. To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence, copyrightable.⁴⁹

portions of fashion design during the traditional "substantial similarity" portion of the infringement analysis, discussed in the fourth installment of this series, *On 'Similarity.'*

⁴⁷ *Feist*, 499 U.S. at 344. There was no dispute about copying, as defendant's phone book contained false directory listings appearing in plaintiff's book, inserted for the specific purpose of detecting copying. *Id.*

⁴⁸ *Id.* at 353 ("The 'sweat of the brow' doctrine had numerous flaws, the most glaring being that it extended copyright protection in a compilation beyond selection and arrangement—the compiler's original contributions—to the facts themselves. Under the doctrine, the only defense to infringement was independent creation. A subsequent compiler was 'not entitled to take one word of information previously published,' but rather had to 'independently wor[k] out the matter for himself, so as to arrive at the same result from the same common sources of information.' . . . 'Sweat of the brow' courts thereby eschewed the most fundamental axiom of copyright law—that no one may copyright facts or ideas.") (internal citation omitted).

⁴⁹ *Id.* at 345-46.

Perhaps surprisingly, the Court declared that this “floor” for copyright protection was not merely a question of good public policy, but rather, that “[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.”⁵⁰

The *Feist* Court recognized that the originality determination presented greater difficulties where a would-be author alleged that its “selection, coordination, or arrangement” of constituent non-original elements (here, the individual phone-book entries) “render[ed] the work as a whole original.”⁵¹ In such scenarios, “originality” does not require “that facts be presented in an innovative or surprising way”; however, “the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.”⁵² Though the “standard of originality is low,” it was not satisfied by the phone book at issue: plaintiff Rural’s final product reflected “insufficient creativity to make it original.”⁵³ While the factual scenario of alphabetical listings in white pages arguably presents little room for judicial infusion of tacit value judgments into adjudication, other contexts—including various genres of visual art, such as copyright-eligible components of fashion design—raise “originality” issues that can be, and have been, much more easily massaged, twisted, and even distorted by the lower courts.

Some of this “massaging” has been driven by the welcome (and overdue) realization by federal judges that “all creative works draw on the common wellspring that is the public domain.”⁵⁴ As one Second Circuit panel noted in a 2014 appeal over the originality of an architectural work: “Every work of art will have some standard elements, which taken in isolation are un-copyrightable, but many works will have original elements—or original arrangements of elements. The challenge in adjudicating copyright cases is not to determine whether a work is a creative work, a derivative work, or a compilation, but to determine what in it originated with the author and what did not.”⁵⁵ In fact, the courts have managed quite well to determine what originated with whom; the thornier issues have stemmed from the lack of a systematic and uniform approach to determine the doctrinal consequences of those findings.

⁵⁰ *Id.* at 363.

⁵¹ *Id.* at 358.

⁵² *Id.* at 362-63.

⁵³ *Id.* at 362-63.

⁵⁴ *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 132 (2d Cir. 2003) (Calabresi, J.).

⁵⁵ *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 104 (2d Cir. 2014).

For example, one Second Circuit panel began its 2003 copyright-infringement analysis of textile designs by parroting the Supreme Court's dictate in *Feist* that independent creative endeavors are the touchstone of "originality," but went on to filter out non-original elements when evaluating similarity.⁵⁶ (Indeed, that panel provided a list of "non-original" components that encompassed a good deal more than material not originating with an author-plaintiff.⁵⁷) Just two years earlier, however, a different panel of the same appellate court insisted, in a case concerning quilt designs, that such filtering (or "dissection") was incompatible with *Feist*, but employed a bit of semantic maneuvering to achieve the same outcome under the purported rubric of "total concept and feel."⁵⁸ Some courts (and/or panels) have

⁵⁶ *Tufenkian Imp./Exp.*, 338 F.3d at 135 ("The appellant charges that, in comparing the two designs' total concept and feel, the district court improperly factored out public domain elements from the Heriz and the Bromley . . . [H]owever, the court was surely correct to factor such elements out. For copying is not unlawful if what was copied from the allegedly infringed work was not protected, for example, if the copied material had itself been taken from the public domain. This principle applies, moreover, whether the copied, unprotected expression at issue is a selection, coordination, or arrangement of elements, or whether it is the exact design itself.").

⁵⁷ *Id.* at 132 ("In this pool are not only elemental 'raw materials,' like colors, letters, descriptive facts, and the catalogue of standard geometric forms, but also earlier works of art that, due to the passage of time or for other reasons, are no longer copyright protected. Thus the public domain includes, for example, both the generic shape of the letter 'L' and all of the elaborately more specific 'L's' from the hundreds of years of font designs that have fallen into the public domain. *See* *Boisson v. Banian, Ltd*, 273 F.3d 262, 269-71 (2d Cir. 2001)] (considering copyright infringement in 'alphabet quilts,' and treating the letters of the alphabet and the spectrum of colors as belonging to the public domain); *cf.* *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 747 (2d Cir. 1998) (refusing to grant copyright protection to 'street locations, landmass, bodies of water and landmarks depicted in a map'); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 763-64 (2d Cir. 1991) (holding that the plaintiff's fabric-design copyright did not encompass a background pattern copied without modification from a public domain textile); *Williams v. Crichton*, 84 F.3d 581, 587 (2d Cir. 1996) (examining substantial similarity between literary works and excluding 'scenes a faire,' *i.e.*, 'sequences of events that "necessarily result from the choice of a setting or situation,"' from the scope of the plaintiff's protectible [*sic*] expression (quoting *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986))).").

⁵⁸ *Boisson v. Banian, Ltd*, 273 F.3d 262, 272 (2d Cir. 2001); *see, e.g., id.* at 270 ("Absent evidence of copying, an author is entitled to copyright protection for an independently produced original work despite its identical nature to a prior work, because it is independent creation, and not novelty that is required.") (citing, *inter alia*, *Feist*, 499 U.S. at 345). The *Boisson* court continued, however, to explain that "a 'more refined [infringement] analysis' is required where a plaintiff's work is not 'wholly original,' but rather incorporates elements from the public domain." *Id.* at

provided guidance on appropriate categorical treatment of certain types of works; others have claimed to reject that approach (even as they might effectively adopt it in practice.)⁵⁹

In sum, the textual-compilation fact pattern of *Feist*, its awkward applicability to many or even most visual material, its apparent irreconcilability with common judicial intuitions about the merit of particular works, and the Supreme Court's choice not to revisit the contours of the "originality" standard since 1991 have all contributed to a fractured doctrinal landscape in which courts can quite easily, and have not infrequently, invoked "originality"—in one form or another—to hold even potentially copyright-eligible (*i.e.*, non-"useful") components of fashion design not protected in the first instance and/or not *unlawfully* copied by defendants.

272. Specifically, "[i]n these instances, '[w]hat must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation.'" *Id.* (internal citations omitted). The *Boisson* court warned against "dissecting" the works at issue "into separate components," noting that "[t]he outcome—affording no copyright protection to an original compilation of unprotectible elements—would be contrary to the Supreme Court's holding in *Feist Publications*." *Id.* However, the court's articulation of the doctrinal significance of the presence of non-original components in a work—that those components might render "the total concept and overall feel created by the two works [not] substantially similar," would appear to be little more than an alternative (and somewhat nonsensical) avenue for finding a lack of originality. *Id.*

⁵⁹ See *Intervest Const., Inc. v. Canterbury Estate Homes, Inc.*, 554 F.3d 914, 919 (11th Cir. 2008) (architectural works, as a class, are best treated as "compilations"); cf. *Zalewski*, 754 F.3d at 103-04 ("While we agree with the outcome in *Intervest*, we disagree with its reasoning. 'Creative,' 'derivative,' and 'compiled' may be useful concepts in some cases, but we reject the idea that works always fall neatly into one of these categories. Every kind of work at some level is a compilation, an arrangement of uncopyrightable 'common elements.' . . . No individual word is copyrightable, but the arrangement of words into a book is. No color is copyrightable, but the arrangement of colors on canvas is. Likewise, doors and walls are not copyrightable, but their arrangement in a building is. Some architectural designs, like that of a single-room log cabin, will consist solely of standard features arranged in standard ways; others, like the Guggenheim, will include standard features, but also present something entirely new. Architecture, in this regard, is like every art form.") (internal citations omitted.). Various Second Circuit decisions suggest that, with regard to certain components of fashion design—and certain other types of works—a genre-based classification for the court's "originality" analysis amounts to something like a *per se* rule. See *infra* Section heading?.

a. Applying “Originality” Requirement to Presumptively Copyright-Eligible Works of Fashion Design

In applying *Feist* and its progeny to potentially copyright-eligible works of fashion design, presiding judges must graft doctrine primarily intended for application to textual works onto the seemingly disparate subject matter of “pictorial, graphic, or sculptural works.”⁶⁰ Of course, this is also true of litigation concerning painting and sculpture. Yet the additional complications of the art-design distinction (previously discussed), compounded by the purportedly “imitative” nature of Western fashion as a medium,⁶¹ have provided at least a veneer of plausibility to courts’ idiosyncratic evaluation of the “originality” of such works—even those that have surmounted the “useful article” bar to copyrightability. Indeed, judicial decisions treating even standalone works of fashion design as mere “selections, coordinations, or arrangements”—with repercussions ranging from unclear to distinctly unfavorable—are not uncommon.⁶² To a much greater degree

⁶⁰ See 17 U.S.C. § 102(a)(5) (2012). See Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright Law*, 125 HARV. L. REV. 683, 684 (2012) (Copyright “starts with the written word as its model, then tries to fit everything else into the literary mode.”) Cf. Charles E. Colman, *Trademark Law and the Prickly Ambivalence of Post-Parodies*, 163 U. PA. L. REV. ONLINE 11, 54 (2014) (“To try to analyze post-parodic works, like those pictured [earlier in the Essay], through trademark law’s one-dimensional parody doctrine is akin to asking whether a personal diary ‘is persuasive,’ to query whether a wholly abstract sculpture ‘supports fiscal reform,’ or to inquire about the ‘credibility’ of a dessert. In each instance, the questioner attempts to make value judgments about objects whose very nature is alien to the analytical framework used.”)

⁶¹ See *H. W. Gossard Co. v. Neatform Co.*, 143 F. Supp. 139, 140 (S.D.N.Y. 1956) (“[I]t has been said that to invent anything in the way of a new dress design, however temporarily attractive such design may be, [is] almost impossible . . .”). For an especially trenchant take on this “conventional wisdom,” see ANNE HOLLANDER, *SEX AND SUITS* 48 (1994) (observing that men have long “been riveted on the feminine scheme of varying the same idea in different ways through time” and that “[t]his has been what is meant by ‘Fashion’ when it is despised as woman’s business”).

⁶² See, e.g., *George S. Chen Corp. v. Codona Int’l*, 266 F. App’x 523, 524 (9th Cir. 2008) (unpublished) (“GSC contends that its moon/star ornament had “subtle differences” from the prior art of such ornaments, but nowhere said what those differences may be. It is thus impossible to tell whether the differences, if any, are “more than a ‘merely trivial’ variation, something recognizably ‘his own.’”). For a discussion of reasons for the potential manipulability of the *Feist* standard, see Elizabeth F. Judge & Daniel Gervais, *Of Silos and Constellations: Comparing Notions of Originality in Copyright Law*, 27 CARDOZO ARTS & ENT. L. J. 375, 408, 402-03 (2009) (“While the policy underpinnings of *Feist* seemed fairly clear, its definition

than in most other factual contexts, judicial analysis of the originality of works of fashion design tends to reflect an assumption that the material in dispute is (to coin a term to which we will return later in this Article) *constructively derivative*.⁶³ With that said, the outcomes of judicial evaluations of “originality” in fashion design have not been uniformly unfavorable; indeed, they have waxed and waned in conjunction with, among other factors, notable judicial decisions, broader cultural trends, and changes in prevailing legal and business practices.⁶⁴ It is possible to identify, at least tentatively, points at which the tide has gently shifted, then shifted again, in the federal courts’ originality determinations concerning fashion design. That is the task to which we will now turn our attention.

b. The “Originality Pendulum”

For the reasons identified in the previous Section, courts’ rulings on the originality of works of fashion design have been inconsistent; nevertheless, examination of the relevant judicial decisions does reveal general trends. In the sixty-plus years since the Supreme Court’s ruling in *Mazer v. Stein*,⁶⁵ judicial treatment of the copyrightability for fashion articles by American federal judges has reflected a gradual oscillation—in something of a *sine* wave—between more stringent and more relaxed approaches to determining the “originality” of fashion-design works. At its lowest ebb, the require-

of originality as being the result of a modicum of creativity posed two problems. One is quantitative in nature: what is a modicum? The other is qualitative: how does one decide what is ‘creative’? . . . [The *Feist* standard turns out to be] difficult to operationalize, especially in borderline cases such as factual or collective works.”)

⁶³ See, e.g., *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109 (2d Cir. 2001) (“The same principles apply to ‘derivative work[s],’ which are ‘based upon one or more preexisting works.’ 17 U.S.C. § 101. Jewelry designs have been viewed as fitting within this latter category.”); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971) (“It seems unrealistic to suppose that defendants could have closed their minds to plaintiff’s highly successful jeweled bee pin as they designed their own.”)

⁶⁴ See generally Colman, *supra* note 60 (containing brief history of Western fashion design since the 1960s, presented with an eye toward ramifications for trademark law). The term “constructively derivative” does not denote an established doctrine in U.S. copyright law; however, I find it to be a useful concept for capturing judicial reasoning that either inadvertently or deliberately imposes unusually stringent bars to eligibility, perhaps inspired by or simply reminiscent of patent-law principles. See discussion *supra* at text accompanying note 18 (discussing “natural phenomena,” prior-art, and obviousness bars to patentability, and judicial implementation thereof in copyright disputes via the “idea-expression” distinction).

⁶⁵ 347 U.S. 201 (1954).

ment of originality has resembled the standard articulated in *Feist*, so that virtually any feature attributable to the judgment of an author-designer would support a finding of originality. At its highest point, multiple federal courts have chafed at the prospect of upholding copyright protection for (even separable components of) many works of fashion design.

The movement of what will be described here as U.S. copyright law's "originality pendulum" suggests a plausible division into four phases⁶⁶: (1) an initial period, beginning with the Supreme Court's 1954 recognition of the potential copyrightability of separable components of useful articles in *Mazer v. Stein*⁶⁷ and continuing until the Second Circuit's 1976 decision in *L. Batlin & Son, Inc. v. Snyder*⁶⁸; (2) a second period lasting from *Batlin* until the Supreme Court's 1991 decision in *Feist*⁶⁹; (3) a third period, beginning with *Feist* and continuing until the early 2000s; and (4) the most recent period, starting from roughly the early 2000s and arguably lasting through the present. The current phase does not closely track a single, landmark court ruling; it might reflect, in part, the popular defense strategy of invoking the "idea-expression" distinction *as part of* the "originality" analysis—an analytical approach that first appeared long before the early 2000s, but has been pressed with increased frequency and vigor in recent years.⁷⁰

⁶⁶ A complex relationship exists between the adjudication of "landmark" cases and sociocultural developments. See generally Colman, *Design and Deviance*, *supra* note 3. However, for present purposes, each period will be demarcated here by precedent rather than through the identification of more diffuse cultural circumstances that likely contributed to the decisions in question. See discussion at *A Strange Centennial*, *supra* note 1 at ____ ("[T]he 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—but rather to examine what that doctrine is.") (internal citations omitted.).

⁶⁷ *Mazer*, 347 U.S. at 211-13 (1954).

⁶⁸ 536 F.2d 486 (2d Cir. 1976).

⁶⁹ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.* 499 U.S. 340 (1991). See Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 132 (2d Cir. 2003) (characterizing *Feist* as the most prominent decision in the "rather lenient caselaw on the originality requirement").

⁷⁰ See, e.g., *Mannion v. Coors Brewing Co.*, 377 F. Supp.2d 444, 458-59 (S.D.N.Y. 2005) (addressing defendant's argument that plaintiff was entitled to little, if any, copyright protection for his photograph because of the idea-expression distinction, and noting the conceptual difficulty of applying the idea-expression distinction to visual, as opposed to literary, works); *Angela Adams Licensing, LLC v. Surya Carpet, Inc.*, No. 07-77-P-H, 2008 WL 686868, at *7-*8 (D. Me. Mar. 10, 2008) (analyzing defendant's argument and proffered case law in support of contention that plaintiff's textile pattern was minimally original and thus merited little, if any, protection).

i. Cases from 1954 to mid-1976

During the initial period of the originality pendulum's movement, the quantum of originality required of even fashion-design works was generally characterized as "very modest"⁷¹; nothing more than a "faint trace of originality" would support copyright protection.⁷² Perhaps notably, however, this very low bar appears to have been set in 1951, *before* the Supreme Court brought works of applied art into the copyright fold. In that case, *Alfred Bell & Co. v. Catalda Fine Arts*, the Second Circuit found both "original" and copyrightable a series of "mezzotints" that were mere reproductions (albeit laborious, time-consuming reproductions) of paintings in the public domain.⁷³ The court explained that while "inventive genius" was required to support the validity of a *patent*, mere "originality"—meaning little or nothing more than "owing its origin to the author"—was sufficient to sustain a copyright.⁷⁴ The Second Circuit highlighted various decisions invali-

⁷¹ *Peter Pan Fabrics v. Dan River Mills*, 295 F. Supp. 1366, 1368 (S.D.N.Y.), *aff'd*, 415 F.2d 1007 (2d Cir. 1969); *see also* *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970) (describing then-prevailing originality standard as "modest at best").

⁷² *Dan Kasoff, Inc. v. Novelty Jewelry Co., Inc.*, 309 F.2d 745, 746 (2d Cir. 1962).

⁷³ *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 104 (2d Cir. 1951) ("Not only does the [Copyright Act of 1909] include 'Reproductions of a work or art', but- while prohibiting a copyright of 'the original text of any work . . . in the public domain' - it explicitly provides for the copyrighting of 'translations, or other versions of works in the public domain'. The mezzotints were such 'versions.' They 'originated' with those who make them, and- on the trial judge's findings well supported by the evidence- amply met the standards imposed by the Constitution and the statute.") (internal citations omitted.).

⁷⁴ *Id.* at 100-02 ("[P]ointing to the Supreme Court's consequent requirement that, to be valid, a patent must disclose a high degree of uniqueness, ingenuity and inventiveness, the defendants assert that the same requirement constitutionally governs copyrights [However, the 1790] legislators peculiarly familiar with the purpose of the Constitutional grant by statute, imposed far less exacting standards in the case of copyrights. They authorized the copyrighting of a mere map which, patently, calls for no considerable uniqueness. They exacted far more from an inventor. And, while they demanded that an official should be satisfied as to the character of an invention before a patent issued, they made no such demand in respect of a copyright Accordingly, the Constitution, as so interpreted, recognizes that the standards for patents and copyrights are [fundamentally] different. The defendants' contention apparently results from the ambiguity of the word 'original'. It may mean startling, novel or unusual, a marked departure from the past. Obviously this is not what is meant when one speaks of 'the original package,' or the 'original bill,' or (in connection with the 'best evidence' rule) an 'original' document; none of those things is highly unusual in creativeness. 'Original' in reference to a copyrighted

dating design-patent protection for works of fashion design, which “neatly illustrated” the higher degree of novelty that the *Bell* copyright-infringement plaintiff need not demonstrate; the court then added, for indeterminate reasons, that designs were not copyrightable (a proposition already clear from the case law.)⁷⁵

After the Supreme Court gave its imprimatur to copyright protection for separable components of industrial design in 1954, however, the “originality” requirement, as articulated in *Alfred Bell*, produced a string of cases during a roughly fifteen-year period in which designer-plaintiffs went largely undefeated on the issues of both copyrightability and originality. Published fashion-related decisions from this period mostly address fabric designs and lace, with an occasional opinion concerning jewelry. *Millworth Converting Corp. v. Slifka* is representative of the rulings from this period.⁷⁶ There, a plaintiff sought copyright protection for two variations on a fabric pattern designed to imitate the appearance of embroidery. The defendant highlighted that the plaintiff’s pattern was derived from a preexisting embroidered pattern, but the Second Circuit deemed this fact irrelevant to the originality determination, ruling for the plaintiff:

Defendants do not dispute that the ‘Schiffli’ embroidered design was a ‘work of art,’ 17 U.S.C. 5(h), *Mazer v. Stein*, [347 U.S. 201 (1954)]. Their principal argument both in the District Court and here was that, despite

work means that the particular work ‘owes its origin’ to the ‘author.’ No large measure of novelty is necessary.” (Internal citations omitted.).

⁷⁵ *Id.* at 104. One might argue either that the court felt compelled to reiterate that designs were not copyright notwithstanding the Copyright Office’s 1949 regulation anticipating (and influencing) the Supreme Court’s 1954 ruling in *Mazer v. Stein* by allowing the registration of certain separable artistic components of industrial design—see discussion at *A Strange Centennial*—and/or that the Second Circuit was further cementing a point that its judges apparently felt could not be made emphatically enough. See, e.g., *White v. Leanore Frocks, Inc.*, 120 F.2d 113, 114-15 (2d Cir. 1941) (*per curiam*) (“We were told at the bar that this appeal has been taken to clear up doubts remaining after the decision of the Supreme Court in *Fashion Originator’s Guild v. Federal Trade Commission*, 312 U.S. 457 . . . ; *it is the latest, and presumably the last, effort of dress designers to get some protection against what they call the ‘piracy’ of their designs.* We fear that their hope will prove illusory; there is little chance that valid design patents can be procured in any such number as to answer their demand. What they need is rather a statute which will protect them against the plagiarism of their designs; a more limited protection and for that reason easier to obtain *if the law recognized copyright in the subject matter at all.* Recourse to the courts, as the law now stands, is not likely to help them. Perhaps, *if their grievance is as great as they say*, Congress may yet be moved to help them; but *short of that, no effective remedy seems open.*”) (emphasis added.).

⁷⁶ 276 F.2d 443 (2d Cir. 1960).

this, plaintiff's copyright was invalid . . . [because] the embroidered design was in the public domain and, as defendants alleged, plaintiff's reproduction contained no element of originality. We think Judge Dawson correctly held defendants' attack on the validity of the copyrights to be foreclosed by the principle enunciated in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, which upheld copyrights on mezzotint reproductions of paintings that were in the public domain . . . Here plaintiff offered substantial evidence that its creation of a three-dimensional effect, giving something of the impression of embroidery on a flat fabric, required effort and skill. Although others may have done the same with respect to other 'Schiffliis,' plaintiff's contribution to its reproduction of this design sufficed to meet the modest requirement made of a copyright proprietor 'that his work contains some substantial, not merely trivial, originality.'⁷⁷

Another Second Circuit decision capturing the tenor of this phase in the oscillation of the originality pendulum is *Peter Pan Fabrics, Inc. v. Dixon Textile Corp.*, where the court decisively rejected a non-originality defense for similar reasons:

The plaintiffs had engaged a Parisian designer to design from rough sketches furnished him a design Byzantine in motif. This design plaintiffs registered as a reproduction of a work of art under 17 U.S.C. § 5(h) The design was printed on goods with the copyright notice repeated on the selvage every 19 inches, and the goods were sold to dress manufacturers. While the basis of the sketches appears to have been suggested by or perhaps taken faithfully from ancient art forms, their incorporation into a combined design by the Parisian designer is clearly sufficiently original to satisfy the originality requirement of the copyright law. See *Alfred Bell & Co., Ltd. v. Catalda Fine Arts Inc.*. Originality, not novelty, is the test. [Citation omitted.] There was no genuine issue as to any facts material to the question of originality.⁷⁸

Similarly, in the 1963 appeal in *H. M. Kolbe Co. v. Armigus Textile Company*, the Second Circuit found originality in a plaintiff's relatively simple textile pattern, notwithstanding its concededly non-original components: "The 'work' or 'reproduction of a work of art' which [plaintiff] sought to copyright was not merely the single rose square from which its textile design was created. It was rather the composite design itself, which depends for its aesthetic effect upon both the rose figure and the manner in which the reproductions of that figure are arranged in relation to each other upon the fabric. We find no error in the determination below that the work, as thus construed, was sufficiently original for copyright protection [W]e find

⁷⁷ *Id.* at 444-45 (citing *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945)).

⁷⁸ 280 F.2d 800, 802 (2d Cir. 1960) (internal citations omitted).

no authority for the proposition that every element of an original work must itself bear the marks of originality.”⁷⁹

After a few years of decisions like *Millworth*, *Dixon*, and *Kolbe*, many defendants in copyright litigation over fashion design no longer found it sufficiently beneficial to raise non-originality arguments, instead advancing defenses based on “technicalities” like the adequacy of plaintiffs’ copyright notices.⁸⁰ But defendants were not the only ones who had become acutely aware of the prevailing originality standard’s utter lack of “bite.” Indeed, in the late 1960s, judges manifestly irked by the prospect of copyright liability for the production of “commonplace” works of applied art took the first tentative steps toward a quasi-systematic ratcheting-up of the originality standard through alternative means. In *Thomas Wilson & Co. v. Irving J. Dorfman*,⁸¹ for example, the court gestured to something like to the notion of “constructively derivative” works:

[B]oth pieces of lace look to the lay observer like rather commonplace pieces of lace, with seemingly commonplace floral designs. Neither design looks like the markings left by intensely creative activity. The plaintiff reports an earlier copyright of its own for an essentially similar ‘style.’ The defendant, upon a full trial, may be able to demonstrate, from the floral designs of others as well as its own, wide usage of such basically comparable patterns. The particular floral arrangement in issue seems to fall within an area—assuming, as the parties do, ‘even the modest originality that the copyright laws require’—where more than ‘substantial similarity’ should be necessary for a finding of infringement.⁸²

⁷⁹ 315 F.2d 70, 72 (2d Cir. 1963).

⁸⁰ See, e.g., *American Fabrics Co. v. Lace Art, Inc.*, 291 F. Supp. 589, 590 (S.D.N.Y. 1968) (defendant relied on purported lack of required copyright notice); accord. *Judscott Handprints, Ltd. v. Washington Wall Paper Co., Inc.*, 377 F. Supp. 1372, 1377 (E.D.N.Y. 1974) (“Defendants attack neither the copyrightability of plaintiff’s design nor the legal sufficiency of its 1969 registration. Instead they argue that the copyright, even if initially valid, was somehow forfeited or abandoned in view of the later sale of improperly noticed infringing Imperial fabric. Defendants assert that the Judscott design entered the public domain when Judscott allowed any Imperial fabric to be sold without a designation of Judscott as the proprietor of the copyright.”). *But see* *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 781, 783 (S.D.N.Y. 1968) (basing judicial finding of non-originality and non-“creativity” primarily on plaintiff’s admission that it had created his artificial corsages based on traditional works, as well as insufficient notice).

⁸¹ 268 F. Supp. 711 (S.D.N.Y. 1967).

⁸² *Id.* at 713 (internal citation omitted; emphasis added). For district-court judges dismayed by the apparently “commonplace” nature of the works before them, some approaches to limiting protection were more viable than others—hinging in part on whether a disgruntled plaintiff appealed to the Second Circuit. See *Condotti Inc. v. Slifka*, 223 F. Supp. 412, 415 (S.D.N.Y. 1963) (“This is not a case

By the early 1970s, a growing number of judges, some of whom had always displayed a certain degree of resistance to the idea of according copyright protection to “garish trinket[s],”⁸³ had begun to express more emphatically their impatience with both esoteric defenses and the seemingly all-embracing *Alfred Bell* originality standard that defendants tried to work around by invoking defenses grounded in “technicalities.”⁸⁴ Some judges were quite explicit in their value judgments; outside the factual context of applied

where the copyists infringed the plaintiff’s ‘expression’ of its ideas, as in *Peter Pan Fabrics, Inc. v. Acadia Company*, [173 F. Supp. 292 (S.D.N.Y. 1959), *aff’d sub nom* Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960)]; *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F. Supp. 334, 336 (S.D.N.Y. 1960.”); *cf* *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 296 F. Supp. 736, 738 (S.D.N.Y. 1969) (“At worst, what defendant has done here is to use an idea of plaintiff’s That the usurping of an idea as compared to the usurping of the expression of that idea is [not infringement] is clear.”), *rev’d*, 409 F.2d 1315, 1316 (2d Cir. 1969) (“The designs . . . , while having some differences, give the same general impression on both samples. While the trial court placed great emphasis on the minor differences between the two patterns, we feel that the very nature of these differences only tends to emphasize the extent to which the defendant has deliberately copied from the plaintiff. . . . In sum, a comparison of the samples strongly suggests that defendant copied plaintiff’s basic design, making only minor changes in an effort to avoid the appearance of infringement. The ultimate test in a copyright infringement case of this sort is whether an average lay observer would find a substantial similarity in the designs, recognizing the copy as an appropriation of the copyrighted work.”). Thus, the Second Circuit in *Concord Fabrics* did not engage with the District Court’s articulation of the idea-expression bar to copyright-infringement liability—an approach that would grow in popularity in the years to come. *See discussion supra* at text accompanying notes 14-23; *cf*. Charles E. Colman, *The History and Principles of American Copyright Protection for Fashion Design: On ‘Seperability’ and ‘Similarity’*, 7 HARV. J. SPORTS & ENT. L. (forthcoming 2016).

⁸³ *Dan Kasoff, Inc. v. Novelty Jewelry Co., Inc.*, 309 F.2d 745, 746 (2d Cir. 1962) (per curiam); *see, e.g., id.* (“Although it might be thought that the invocation of the power of government to protect designs against infringement implied some merit other than a faint trace of ‘originality’, it is now settled beyond question that practically anything novel can be copyrighted. ‘No matter how poor artistically the “author’s” addition, it is enough if it be his own’. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951).”).

⁸⁴ *See, e.g., Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 428 F.2d 551 (2d Cir. 1970) (district court did not abuse its discretion in granting preliminary injunction prohibiting the copying of plaintiff’s jewel-encrusted turtle pin, despite purportedly insufficient copyright notice); *cf* *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co.*, 509 F.2d 64, 65 (2d Cir. 1974) (“The test of copyright infringement is whether the similarity between the products would lead ‘the average lay observer . . . [to] recognize the alleged copy as having been appropriated from the copyrighted work,’ Applying this test here, the district court concluded that the average layman would not find sufficient similarity in the parties’ particular expres-

art—and specifically, fashion design and other “novelties”—one can find few judicial critiques of the “seemingly commonplace” nature of copyright plaintiffs’ works or the supposed lack of “intensely creative activity” required for their creation.⁸⁵

Nevertheless, through the mid-1970s, most federal judges continued to give works of fashion design the benefit of the doubt concerning both originality⁸⁶ and copyrightability more generally.⁸⁷ This would change with the “one-two punch” of a forceful *en banc* decision issued by the Second Circuit in April 1976 and, just a few months later, Congress’s rejection of the proposed inclusion of a designated category of fashion-related works in the newly-enacted Copyright Act of 1976.⁸⁸

ii. Cases from mid-1976 to 1991

In April 1976, the Second Circuit, sitting *en banc*, issued a decision that effectively served to fling the originality pendulum in the opposite direction, toward greater stringency. In *L. Batlin & Son, Inc. v. Snyder*,⁸⁹ a majority of the appellate court reversed a panel’s earlier ruling and held that copyright protection was inappropriate for a plastic novelty bank that reflected only trivial variations from a bank in the public domain. The full court’s majority opinion cited the influential *Nimmer on Copyright* treatise for the proposition that “the mere reproduction of a work of art in a different medium should not constitute the required originality for the reason that no one can claim to have independently evolved any particular medium.”⁹⁰

sions of the idea of a jeweled turtle pin to warrant a finding of infringement. We agree.”).

⁸⁵ *Thomas Wilson & Co.*, 268 F. Supp. at 713; see also *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970) (“While plaintiff’s lace design is not what the phrase ‘work of art’ ordinarily calls to mind, it possesses more than the ‘faint trace’ of originality required.”). Such rhetoric likely reflects, in part, the same anti-fashion/anti-design bias that had contributed to the marginalization of design-patent protection earlier in the century. That inquiry is largely beyond the scope of this article; for a comprehensive discussion of the operative sociocultural and cognitive dynamics, see Colman, *Design and Deviance*, *supra* note 3.

⁸⁶ See, e.g., *Primcot Fabrics, Dep’t of Prismatic Fabrics, Inc. v. Kleinfab Corp.*, 368 F. Supp. 482, 484-85 (S.D.N.Y. 1974).

⁸⁷ See *Cynthia Designs, Inc. v. Robert Zentall, Inc.*, 416 F. Supp. 510, 511-12 (S.D.N.Y. 1976).

⁸⁸ See discussion at *A Strange Centennial* [insert JSEL cite?].

⁸⁹ 536 F.2d 486 (2d Cir. 1976) (*en banc*).

⁹⁰ *Id.* at 491. Note that this passage from *Nimmer* endorses a normative position (“should not constitute”) on originality. For a critique of the federal courts’ frequent and sometimes distortive reliance on copyright treatises—and *Nimmer*, in particular,

Judge Oakes—who had written the dissenting opinion in the panel’s earlier adjudication of *Batlin* but authored the majority decision here—explained that this stemmed from the principle that “one who has slavishly or mechanically copied from others may not claim to be an author.”⁹¹ In a bit of revisionist history, Judge Oakes’ majority opinion declared: “It has been the law of this circuit for at least 30 years that in order to obtain a copyright . . . the work [must] ‘contain some substantial, not merely trivial originality[.]’”⁹² (For this proposition, Judge Oakes cited *Chamberlin v. Uris Sales Corp.*,⁹³ a decision that was indeed three decades old, but had rarely been cited by the court in the interim—and even then, only *in furtherance of* finding the requisite “originality” for copyright protection.⁹⁴)

see Ann Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CIN. L. REV. 581, 591 (2004) (“The Copyright Act is a long and dense body of statutory law. Despite its length and complexity and the wide range of issues it addresses, however, the statute does not answer many questions or create much predictability when disputes about copyrights arise. As a result, judges must either read extensive amounts of copyright case law and distill from it nuanced rules and complicated principles, or they can expediently choose to rely on the formulations that are conveniently and accessibly set out in a treatise, and confidently apply them to the often thorny facts of a particular dispute. The considerable number of citations to the Nimmer copyright treatise suggests it is widespread and commonplace for federal judges to depend on the treatise to articulate and support copyright law decisions.”); *see also id.* at 599 (“Judges who engage in wholesale, unquestioning adoption of any single source of pre-synthesized copyright law, failing to draw on competing theories, will perform ostensibly independent analyses in application of law to fact with hidden and unrecognized but potentially tremendous biases. In the absence of countervailing resources of similar stature, the very existence of a hegemonic treatise potentially prevents the evenly matched battles of policy and doctrine necessary for the emergence of just outcomes.”).

⁹¹ *L. Baitlin & Son*, 536 F.2d at 490. Significantly, Judge Oakes’ dissenting opinion in the first round of appellate review of *Batlin* is used to (1) call into question the wisdom of *Mazer v. Stein*’s extension of copyright protection to certain components of industrial-design works; (2) advocate for anchoring copyright’s originality requirement in language from the Supreme Court’s nearly century-old photography case of *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59-60 (1884), which had stressed the importance of “facts of originality, of intellectual production, of thought, and conception on the part of the author”; and (3) *single out* “some of our fabric design cases” as having “gone far in upholding on an ad hoc basis copyrights of design copies on a ‘minimal quantum of originality. . . .’” *L. Batlin & Son, Inc. v. Snyder*, No. 75-7308, 1975 WL 21412, at *13, *14 (2d Cir. Oct. 24, 1975) (Oakes, J., dissenting) (emphasis added).

⁹² *L. Baitlin & Son*, 536 F.2d at 490.

⁹³ 150 F.2d 512, 513 (2d Cir. 1945).

⁹⁴ *See* *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970). *Uris* had received similar treatment in the Southern District. *See, e.g.,*

Judge Meskill, who had switched places with Judge Oakes from the panel to the *en banc* decisions in *Batlin*, demonstrated that the Second Circuit's recent treatment of the originality requirement differed greatly from the majority's characterization of it.⁹⁵ The dissent cited several decisions, including many discussed earlier in this Section, for the notion that copyright protection required only "a faint trace of originality,"⁹⁶ a "slight addition" to preexisting material,⁹⁷ or mere "effort and skill."⁹⁸ At the end of the day, however, the majority's opinion, as an *en banc* decision from the leading "copyright circuit" in the fashion capital of the United States, set a new tone for the judicial analysis of originality—especially after the Supreme Court denied *certiorari* in the case.⁹⁹

Notably, the post-*Batlin* decisions holding works of fashion design to a more stringent originality requirement were also acting against the backdrop of the recent legislative debate concerning the 1976 Copyright Act, which had at one point expressly included certain fashion-related items in its list of eligible works, but ultimately dropped that language from the statute.¹⁰⁰ Between the apparent legislative endorsement of the general exclusion of non-separable components of applied art from copyright protection, the saga of the *Batlin* decisions—which had at one point had dwelled on works of fashion design as an important example of works on the margins

Concord Fabrics, Inc. v. Generation Mills, Inc., 328 F.Supp. 1030, 1032 (S.D.N.Y. 1971) ("In the well-ploughed field [of the genre of the 'basic fabric design called 'Indian Madras Plaid'"] on which the parties are waging this contest, plaintiff appears to have achieved a sufficiently 'distinguishable variation' . . . to meet the modest requirement made of a copyright proprietor 'that his work contains some substantial, not merely trivial, originality.'") (citing, *inter alia*, *Uris*, 150 F.2d at 513). With that said, the *Generation Mills* court did proceed to rule that plaintiff was not ultimately entitled to relief, based on both the both the "independent creation" bar to infringement liability and an infringement analysis that represents an early implementation of "thin copyright." *Id.* at 1033. ("Thin copyright" is discussed *infra* at text accompanying note 111 *et seq.*; "independent creation" will be addressed in a forthcoming installment, *On 'Similarity.'*)

⁹⁵ *L. Batlin & Son*, 536 F.2d at 493 (Meskill, J., dissenting).

⁹⁶ *Id.* (quoting *Dan Kasoff, Inc. v. Novelty Jewelry Co.*, 309 F.2d 745, 746 (2d Cir.).

⁹⁷ *Id.* (quoting *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 295 F. Supp. 1366, 1368 (S.D.N.Y. 1969)).

⁹⁸ *Id.* (citing *Millworth Converting Corp. v. Slifka*, 276 F.2d 443 (2d Cir. 1960)).

⁹⁹ *Snyder v. L. Batlin & Son, Inc.*, 429 U.S. 857 (Oct. 04, 1976).

¹⁰⁰ See discussion at *A Strange Centennial*. [Does the discussion in *Centennial* include the original language that was eventually dropped?] The Copyright Act of 1976 was enacted fifteen days after the Second Circuit's *en banc* ruling in *Batlin*. See Pub. L. No. 94-553, 90 Stat. 2541 (Oct. 19, 1976).

of “originality”—and the post-*Batlin* opportunity for the venting of judicial frustration with their earlier obligation to accord copyright protection to so-called “commonplace” and “trivial” works of fashion design, it is unsurprising that judicial invalidation of copyright in various fashion-related works became a frequent occurrence by the late 1970s. Indeed, these decisions often went beyond the issue of (non-)originality, holding that the fashion items in dispute were not copyright-eligible at all.

Illustrative examples of such decisions are excerpted below, in bullet-point form:

- *SCOA Industries, Inc. v. Famolare, Inc.*, No. 75 Civ. 3357, 1976 U.S. Dist. LEXIS 16663, at *5-*7 (S.D.N.Y. Feb. 13, 1976) (emphasis added).¹⁰¹

Famolare claims copyright protection for the copied features on the ground that they are “works of art.” 17 U.S.C. § 5(g). What is a “work of art” may require a subjective judgment [though some guidance can be derived from Copyright Office regulations.¹⁰²] . . . 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.

- *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435, 1441-42 (S.D.N.Y. 1986) (emphasis added).

There is nothing at all original, or copyrightable, about seven spikes on a liberty crown. Plaintiff attempts to lay some claim to originality by pointing out that its spikes are uniform in shape and size, unlike the non-uniform spikes of the Statue of Liberty. *This Court declines, however, to find artistic originality in a design feature composed of elemental symmetry* and prompted

¹⁰¹ Note that the *SCOA* decision was issued after the Second Circuit had agreed to rehear the *Batlin* case *en banc*; it may well have been clear to the lower courts that the appellate court planned to ratchet up a lax originality requirement that *Nimmer on Copyright* had identified as responsible for “ludicrous” results. For a discussion of the crucial role of the (decidedly non-neutral) copyright treatise, see Bartow, *supra* note 90.

¹⁰² At this point, the *SCOA* decision states: “Section 202.10, 37 C.F.R. (1975), provides in relevant part:

‘(c) 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. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.’”).

most probably by the promise of convenience in manufacture. . . . Past Pluto's argument that its hat is copyrightable is ultimately reduced to the basic contention that the hat's silhouette window design is sufficiently original to afford plaintiff's hat at least some measure of copyright protection. *{T}his Court declines to find that this design or any of the hat's other features amount to substantial non-trivial originality deserving of protection under the federal copyright laws.*

- ***John Muller & Co., Inc. v. New York Arrows Soccer Team, Inc.***, 802 F.2d 989 (8th Cir. 1986) (emphasis added).

The district court granted partial summary judgment for defendants, finding that plaintiff's logo for the New York Arrows was not copyrightable In order to be copyrightable, a work must show certain minimal levels of creativity and originality If, as here, the creator seeks to register the item as a "work of art" or "pictorial, graphic or sculptural work, *the work must embody some creative authorship in its delineation or form.*" 37 C.F.R. § 202.10(a) (1985); *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 781 (S.D.N.Y. 1968); 1 M. Nimmer, NIMMER ON COPYRIGHT, § 2.08[B][1] (1985). *There is no simple way to draw the line between "some creative authorship" and not enough creative authorship*, and there are no cases involving "works" exactly like this one The [Copyright] Register's decisions are subject to judicial review, but only on an abuse of discretion standard. 17 U.S.C. § 701 (1982); 5 U.S.C. § 706(2)(A) (1982)[.] We conclude that the district court's opinion [finding no abuse of discretion in the Register's denial] is correct and well-reasoned, and we affirm on the basis of that opinion.¹⁰³

- ***Jon Woods Fashions, Inc. v. Curran***, No. 85 Civ. 3203 (MJL), 1988 U.S. Dist. LEXIS 3319, at *1, *7-*8 (S.D.N.Y. Apr. 19, 1988) (emphasis added).¹⁰⁴

¹⁰³ See also *Brandir Int'l v. Cascade Pacific Lumber*, 834 F.2d 1142, 1146 (2d Cir. 1987) (emphasis added) (rejecting copyrightability of artistic bicycle rack due to lack of "conceptual separability," where Copyright Office had denied registration on the grounds (1) that the design at issue contained no physically or conceptually separable components, and, alternatively, (2) that *the design comprised "nothing more than a familiar public domain symbol" and thus lacked the originality required for copyright protection*). *Brandir* is discussed in *A Strange Centennial* and again in the next installment, *On 'Separability'* [forthcoming 2016].

¹⁰⁴ See discussion at *Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482, 485-86 (E.D. Pa. 2002) ("We believe [the approach of giving a Copyright Office denial of registration 'some deference'] strikes the proper balance between a *de novo* review which plaintiff seeks and the heightened abuse of discretion [standard] found in some cases. See *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986).").

Plaintiff Jon Woods Fashions, Inc. (“Jon Woods”) is a converter of fabrics. Prior to April 25, 1984, Jon Woods produced a fabric design which it called “Awning Grids.” The design consists of striped cloth over which is superimposed a grid of 3/16[-inch] squares. . . . [When plaintiff applied for a copyright registration, the Copyright] Register twice found that [his geometric fabric design] did not meet the minimal level of creative authorship necessary for copyright. He explained to Jon Woods that *familiar symbols are not proper subjects for copyright protection even where they are ‘distinctively arranged or printed.’* . . . Such a determination is clearly within the discretion afforded the Register by prevailing statutes and case law Because there is thus no issue of fact as to the propriety of the Register’s denial of copyright to Jon Woods, design, the Register’s motion for summary judgment is granted.

iii. Cases from 1991 to the early 2000s

As noted above, the Supreme Court’s 1991 decision in *Feist* endorsed a lax approach to the “originality” requirement.¹⁰⁵ And indeed, fashion-related decisions issued in the decade or so after 1991 reflect a swing of the “originality pendulum” back toward (in the words of the *Feist* Court) a “modicum of creativity” approach to originality.¹⁰⁶ Some illustrative decisions are provided in bullet-point form below:

- ***Mulberry Thai Silks, Inc. v. K&K Neckwear***, 897 F. Supp. 789, 791-92 (S.D.N.Y. 1995) (emphasis added).

The basis of K & K’s position is the assertion that *Mulberry’s collection simply reflects geometric elements that are common in the trade*. In substance, then, defendant contests the validity of Mulberry’s copyrights.

To be sure, copyright may subsist only in “original works of authorship.” 17 U.S.C. § 102(a). But *Mulberry’s certificates of registration are prima facie evidence of validity and, therefore, of originality. The burden therefore is on the defendant to prove that the plaintiff’s designs were not original. {Citations omitted.} Moreover, “the originality needed to support a copyright merely calls for independent creation, not novelty”* — it requires only that the copyrighted work

¹⁰⁵ See discussion *supra* at text accompanying note 46 *et seq.*

¹⁰⁶ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991). Of course, this did not occur immediately or everywhere. See *Homer Laughlin China Co. v. Oman*, 1991 U.S. Dist. LEXIS 10680, at *3 (“The Supreme Court in [*Feist*] noted that ‘the *sine qua non* of copyright is originality’ [and] ‘to be sure, the requisite level of creativity is extremely low; even a slight amount will suffice.’ However, in determining creativity, such a decision necessarily requires the exercise of informed discretion, and the Register, in part due to having to make such determinations on a daily basis, is generally recognized to possess considerable expertise over such matters. .”) (internal citations omitted).

not have been copied [*citing Nimmer.*] To quote Judge Hand again, “If by some magic a man who had never known it were to compose Keats’ Ode On a Grecian Urn, he would be an ‘author,’ and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats [because his work is now in the public domain].” *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936). . . .

Here the evidence¹⁰⁷ establishes, and *the Court finds, that each of the seven designs copyrighted by Mulberry was an original creation by Mulberry’s in-house design studio. In consequence, Mulberry’s copyrights are valid, and they were infringed by K & K’s designs.*

- ***Prince Group v. MTS Prods.***, 967 F. Supp. 121, 125 (S.D.N.Y. 1997) (emphasis added).

Although the Defendants claim that these polka dots are only a slight variation of a commonplace design, they offer no expert evidence to support that claim. There must be more than the Defendants’ meager claim to support the invalidity of the Plaintiff’s copyright. *In Design [v. Lynch Knitting Mills, Inc.]*, 689 F. Supp. 176, 179 (S.D.N.Y.), *aff’d* 863 F.2d 45 (2d Cir. 1988)] (the court determined the contention of the defendant’s expert witness that the argyle pattern in question was a mere variation of a standard argyle pattern was insufficient to show that the plaintiff’s copyright was invalid). The polka dots in this case are more than average circles. First, they are irregularly shaped, and not the perfect circles of a standard polka dot. They are ‘shaded,’ that is, there is a crescent of white around half of the perimeter of each of the dots which is different from the standard uniformly colored polka dot, and they consist of several different colors. Thus, *the shape and the shading of the dots are sufficiently original to meet the threshold of creativity.*

- ***C&F Enterprises, Inc. v. Barringtons, Inc.***, Civ. Action No. 96-1108-A, 1997 U.S. Dist. LEXIS 14054, at *10-*11 (E.D. Va. May 13, 1997) (emphasis added).

Defendants’ second argument focuses on the creation of the underlying paper artwork for the seven needle-point stockings Courts have said that in the copyright context the standard for originality of a compilation

¹⁰⁷ This “evidence” was not specified in the opinion, nor did the Court expressly rely on the defendant’s failure to rebut the plaintiff’s “presumption of validity” in support of its copyrightability ruling. *See discussion infra.* Indeed, the language employed by the court (“the Court finds, that each of the seven designs copyrighted by Mulberry was an original creation by Mulberry’s in-house design studio [and] [i]n consequence, Mulberry’s copyrights are valid”) suggests that in this case—in stark contrast to many of the other decisions cited in this Article—the court deemed the mere fact of actual authorship (at least, if accompanied by registration) sufficient for a finding of “originality.”

or derivative work is ‘minimal,’ ‘of a low threshold,’ and ‘modest at best.’ This requirement is satisfied if the new material or expression has a ‘faint trace of originality’ and if it provides a ‘distinguishable variation.’ [*M. Kramer Manufacturing Co. v. Andrews*, 783 F.2d 421, 438 (4th Cir. 1986)] (citations omitted). *The court finds that the needlepoint adaptations by Carol Fang, contributing as they did the ‘translation’ into a different medium, satisfy this low standard of originality such that plaintiff’s copyrights in the needlepoint stockings are valid even though plaintiff may not have initially owned copyrights in the underlying artwork for the three works created by Kearney.* [Footnote omitted.] See, e.g., *Millworth Converting Corporation v. Slifka*, 276 F.2d 443, 445 (2d Cir. 1960) (Friendly, J.) (embroidered design that was in the public domain could be photo-graphed and transferred into a printed form on dress fabric and the resulting flat printed design copyrighted in view of the modest requirement made of a copyright proprietor that it possess only some minimal degree of creativity or ‘distinguishable variation’).

iv. Cases from the early 2000s to present

In the past decade, *Feist* notwithstanding, dismissals of copyright plaintiffs’ claims based on the purported non-originality of fashion-related works have once again started to appear with some frequency—particularly (though not exclusively) where the Copyright Office has already rebuffed a plaintiff’s efforts to secure a registration:¹⁰⁸

- *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 498-99 (S.D.N.Y. 2005) (emphasis added).

Having determined that the works were essentially arrangements of the letter “C,” defendant [the Register of Copyrights] noted that letters, mere variations of letters, and familiar symbols cannot be copyrighted. A.R. 1, Ex. 1 at 3-4 (*citing* 37 C.F.R. § 202.1(a) and *Compendium of Copyright Office*

¹⁰⁸ Note that the nature of the originality determination will differ depending on the type of proceeding in which the issue is raised. See *Darden v. Peters*, 488 F.3d 277, 285 (4th Cir. 2007) (“Congress has afforded disappointed copyright applicants two separate methods of seeking redress for the decision of the Copyright Office not to register a copyright claim. First, . . . the applicant may file a review action under the APA against the Register of Copyrights for the sole purpose of having the denial of registration set aside. See 17 U.S.C. §§ 410(a), 701(e) Second, the claimant may seek judicial review of the rejected registration as part of an infringement action against an alleged infringer under section 411(a) of the Copyright Act.”). Alternatively, the unsuccessful applicant may decide not to challenge the Register’s decision directly, but rather proceed to sue infringers and confront the issue at that point. The way that course of events will play out is arguably less predictable. See *id.* at 286 (“[I]t is not a foregone conclusion that courts owe no deference whatsoever to the Register’s decision [regarding lack of originality] in the context of an infringement action under section 411(a). Indeed, courts are split on this issue.”).

Practices, Compendium II, § 503.02(a)). [Footnote omitted.] Defendant cited a number of cases which held that simple arrangements of such items are similarly uncopyrightable[.] [Ed. Most of the cited cases post-date *Batlin* but pre-date *Feist*.] [D]efendant concluded not simply that the letter ‘C’ is not copyrightable, but that “the elements embodied in this work, individually, and in their particular combination and arrangement, simply do not contain a sufficient amount of original and creative authorship to be copyrightable.” [Citation omitted.] [P]LAINTIFFS HAVE FAILED TO OVERCOME THE SUBSTANTIAL DEFERENCE THAT THIS COURT MUST AFFORD DEFENDANT’S DECISION DENYING REGISTRATION OF THE WORKS BECAUSE PLAINTIFFS HAVE NOT SHOWN THAT DEFENDANT ACTED ARBITRARILY AND CAPRICIOUSLY.

- ***Royal Printex, Inc. v. Unicolors, Inc.***, No. CV 07-05395-VBK, 2009 U.S. Dist. LEXIS 60375, at *5-*6, *9-*10 (C.D. Cal. Jul. 8, 2009) (emphasis added).

The design of the flower in . . . the daisy design is of a six-petaled daisy flower, with a center round pistil, a short stem, and a small leaf emanating from that stem. The six petals, the stem, and the small leaf are each shadowed, and the resulting flower in both designs repeats in a manner in which the stems are turned at different angles to each other, and the flowers are relatively equidistant from each other. The background in each of the designs is a generic polka-dot (“polka-dot”) pattern. The predominant part of the overall design of both the daisy design and the flower design consists of the actual flowers depicted in the design, and the placement of the flowers in a repetitive pattern. . . .

[It is true that the] requisite originality for copyright protection can also be found in the combination of unoriginal (and therefore uncopyrightable) elements. *{However, the} daisy design in this case does not possess at least the requisite minimum degree of creativity to qualify as an original design which is copyrightable.* In the daisy design, the actual flowers, and their repetition throughout the design, constitute the predominant design elements. Neither the flowers, nor their repetitive placement, were independently created by Unicolors. *The deletion of the ticking stripe background from the forties flower design, and the insertion of generic polka-dots, does not constitute the requisite originality required for a design to be copyrightable.*

- ***Express, LLC v. Forever 21, Inc.***, No. CV 09-4514 ODW-VBKx, 2010 U.S. Dist. LEXIS 91705, *17-*18, *20, *21 (C.D. Cal. Sep. 2, 2010) (emphasis added).

At best, [plaintiff’s designer Michael] Tower was able to recall that he “colored-up” [earlier] Plaids with certain colors Express selected for its seasonal clothing line. Tower Deposition at 54-56. However, as Tower testified that he has no recollection of the original plaid designs, let alone knowledge of how they were originally colored, Express cannot produce

any evidence at trial of what color substitutions Tower may have made. Thus, the mere fact that Tower claims he “colored-up” the Plaids does nothing to cure the utter lack of evidence upon which a juror could reasonably conclude that any of the Plaids contains content original to Express. . . . [E]ven if Tower could recall that he made particular color substitutions, *mere changes in color are generally not subject to copyright protection*. 37 C.F.R. § 202.1 ([E]xamples of works not subject to copyright [include] mere variations of . . . color’).¹⁰⁹ {E}ven if Express’s copyright registration{s} are entitled to presumptive effect, Defendants have rebutted that presumption by producing Tower’s deposition testimony [and] the Court grants summary judgment in favor of each Defendant with respect to Express’s claims for copyright infringement.¹¹⁰

It is difficult to make predictions with any degree of certainty about where the law of “originality” for fashion-related works might be headed in the coming years. However, the question might be largely academic, as it has become common practice for courts to handle what are essentially originality concerns through alternative doctrinal vehicles like the idea-expression distinction (discussed above), various “filtering” techniques applied during the infringement analysis (discussed in a forthcoming installment, *On ‘Similarity’*), and in particular, an essentially formalized filtering technique that has proven influential—even dispositive—in many copyright-infringement disputes over works of fashion design: the notion of “thin copyright,” to which we now turn our attention.

c. *The Provenance and Contours of “Thin Copyright”*

In the context of fashion articles, in particular, a threshold finding of “originality” often represents little more than a tentative conclusion that the article in question has not been wholly *disqualified* from copyright protection. More than in almost any other corner of copyright jurisprudence, such a ruling provides little guidance regarding the *scope* of protection that a work of fashion design will ultimately enjoy. That fate hinges to a substan-

¹⁰⁹ *But see* Boisson v. Banian Ltd., 273 F.3d 262, 271 (2d Cir. 2001) (“Color by itself is not subject to copyright protection. *See* 37 C.F.R. § 202.1(a). Nevertheless, ‘an original combination or arrangement of colors should be regarded as an artistic creation capable of copyright protection.’ [Nimmer.] . . . [The case law] teach[es] that even though a particular color is not copyrightable, the author’s choice in incorporating color with other elements may be copyrighted. . . . [This] leads us to conclude it was clear error for the district court to find that plaintiffs’ choice of colors in the ‘School Days’ quilts was an unprotectible element.”).

¹¹⁰ For further discussion of the “presumption of validity” accorded to a copyright registrant, *see infra*.

tial degree on whether presiding courts invoke the notion of “thin copyright.”

Most IP practitioners, if asked to define the term “thin copyright,” would likely first jump to the notion that copyright protection in the arrangement and compilation of factual material is protected only from exact, or near-exact, copying. This is indeed one iteration of the “thin copyright” principle, which has been refined in the wake of *Feist* for works that do make the grade when it comes to originality, but only by a hair.¹¹¹ The terminology used appears to have been inspired by the *Feist* Court’s remark that “facts themselves do not become original through association” and “[t]his inevitably means that the copyright in a factual compilation is *thin*.”¹¹²

It is important to note, however, that this approach to the adjudication of “composite” works neither originated in *Feist* nor has been limited to the “protection for the expression of facts” context.¹¹³ Indeed, textiles have often been a key site for the application of “thin copyright.” Consider, for example, the Second Circuit’s 2001 decision in the copyright case of *Boisson v. Banian, Ltd.*,¹¹⁴ which concerned the alleged infringement of quilt designs that contained some elements that were “original” to the author and other elements that were not. The Second Circuit explained:

If a work is not original, then it is unprotectible. Likewise an element within a work may be unprotectible even if other elements, or the work as a whole, warrant protection. Some material is unprotectible because it is in the public domain, which means that it “is free for the taking and cannot be appropriated by a single author even though it is included in a copyrighted work.”¹¹⁵

(For this principle, the Second Circuit cited a 1992 software-related copyright decision,¹¹⁶ which in turn cited various pre-*Feist* decisions applying the doctrine of “*scènes à faire*”¹¹⁷—the principle that no single author can claim

¹¹¹ See *Feist*, 499 U.S. at 350-51 (copyrightability of “the particular selection or arrangement” of facts is limited, and “[i]n no event may copyright extend to the facts themselves”).

¹¹² *Id.* at 349 (emphasis added).

¹¹³ *Id.* at 348.

¹¹⁴ 273 F.3d 262, 269-70 (2d Cir. 2001).

¹¹⁵ *Id.* at 268-69 (quoting *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 710 (2d Cir. 1992)).

¹¹⁶ See *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 710 (2d Cir. 1992).

¹¹⁷ See *id.* (citing, *inter alia*, *Plains Cotton Co-op. Ass’n of Lubbock, Texas v. Goodpasture Computer Service, Inc.*, 807 F.2d 1256, 1262 (5th Cir. 1987)).

exclusive rights over material that is “indispensable, or at least standard, in the treatment of” a subject.¹¹⁸)

There appear to be at least three iterations of the “thin copyright” doctrine: (1) the notion articulated by the Supreme Court in *Feist* that one claiming copyright in a collection or arrangement of facts can assert protection only in the manner of expression of those facts; (2) the notion that only “thin copyright” is accorded to visual works incorporating material *not* original to the author; and (3) the notion that “thin copyright” applies even where an entire work *is* original, but contains elements that (though “originating” with the author in the manner described by the *Feist* Court) are common, imitative of nature, a mere “idea,” or required for/typical of the medium in question.

Courts have differed not only in their choices of which version(s) of “thin copyright” to recognize, but also in their application of the doctrine and the consequences of that application. Nearly across the board, however, judicial invocation of “thin copyright” is associated with the substitution of a more demanding infringement inquiry¹¹⁹ than the conventional “substantial similarity.” Indeed, the doctrine is arguably little more than a “filtering” doctrine¹²⁰ in copyright-eligibility’s clothing. In this respect, the notion of “thin copyright” is reminiscent of many cases on the idea-expression distinction reviewed earlier in this Article. (Indeed, the triggers for the

¹¹⁸ *Id.* at 709 (quoting *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980)).

¹¹⁹ *See e.g.*, *Beaudin v. Ben & Jerry’s Homemade, Inc.*, 95 F.3d 1, 2 (2d Cir. 1996) (reasoning that “where the quantum of originality is slight and the resulting copyright is ‘thin,’ infringement will be established only by very close copying because the majority of work is unprotectable”).

¹²⁰ The issue of “filtering” is, to be sure, not limited to the “thin copyright” context: courts are in disarray concerning the amount of “dissection” or “extraction” that should occur during this type of infringement analysis, even outside of the fashion-design context. *Compare* *DiTocco v. Riordan*, 496 F. App’x 126, 128 (2d Cir. 2012) (emphasis added) (“Where, as here, we are comparing subject matter that contains both protectible and unprotectible elements, we apply the ‘more discerning’ ordinary observer test to determine substantial similarity: ‘we must attempt to extract the unprotectible elements from our consideration and ask whether the protectible elements, standing alone, are substantially similar.’”) (emphasis omitted) (internal citations omitted) *with* *Cameron Indus. v. Mother’s Work, Inc.*, 338 F. App’x 69, 70 (2d Cir. 2009) (“We have declined, however, to ‘dissect [designs] into their separate components[] and compare only those elements which are in themselves copyrightable,’ noting that taking this approach to its logical conclusion could lead to a decision that ‘there can be no originality in a painting because all colors of paint have been used somewhere in the past.’”) (internal citations omitted).

judicial application of “thin copyright” and the idea-expression distinction overlap substantially.)

On rare occasions, appellate courts have chided district courts for having “applied a test that erroneously mingled the standard for sufficient originality and the test for infringement.”¹²¹ But a review of the case law on “thin copyright,” particularly in the realm of fashion design, shows that such “mingling” is not the exception, but the rule.¹²²

The impetus for the recognition of “thin copyright” protection in the fashion-design context can be traced at least as far back as the post-*Mazer v. Stein* wave of 1960s copyright-recognition-for-fashion-design-cases.¹²³ But “thin copyright” in its current iteration is most directly traced to a Second Circuit decision issued in 1991 (just a few months after the Supreme Court handed down its detailed guidance on copyright law’s “originality” requirement in *Feist*, which, on its own, suggested a possible return to the state of affairs in the 1960s, when any and all fashion seemed copyrightable.)

In that case, *Folio Impressions, Inc. v. Byer California*,¹²⁴ a copyright owner had sued over the alleged infringement of, *inter alia*, a design consisting of images of roses “placed in straight lines and turned so that the roses faced in various directions [using a technique] called ‘clip art,’ which consists of a designer cutting out photocopies of the rose, pasting them over the background, and photocopying the result.”¹²⁵ On appeal, the Second Circuit noted that “[t]he pattern thereby made was one of only slight original-

¹²¹ *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 34 (2d Cir. 1982); *see, e.g., id.* at 35 (“To the extent that the district court applied the *Peter Pan Fabrics* test for copyright infringement as the test for determining originality, the district court erred as a matter of law.”), *superseded on unrelated grounds* by 15 U.S.C. § 1125(a) (1988). The offending passage in the lower court’s decision can be found at *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, 526 F. Supp. 1187, 1192 (S.D.N.Y. 1981) (“[Plaintiff’s] changes, however, would not convey to the ordinary observer aesthetic appeal different from that experienced from prior expressions of Paddington Bear. *See Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). [Eden] expressed Paddington Bear essentially unchanged from his prior manifestations.”).

¹²² *See Concord Fabrics, Inc. v. Generation Mills, Inc.*, 328 F. Supp. 1030, 1032 (S.D.N.Y. 1971) (noting that, in general, “the analysis that supports the validity of the copyright moves, in the end, very close to the argument defeating the charge of infringement”).

¹²³ *See, e.g., Kepner-Tregoe, Inc. v. Carabio*, No. 8-71025, 1979 WL 1072, at *9 (E.D. Mich. Apr. 20, 1979) (citing *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 268 F. Supp 711, 713 (S.D.N.Y. 1967) (noting that the amount of protection enjoyed depends upon the amount of protectible originality in the original work)).

¹²⁴ 937 F.2d 759 (2d Cir. 1991).

¹²⁵ *Id.* at 764.

ity,” and declared that this fact warranted a modification of the usual scope of protection:

[T]here was ample evidence to support the finding that [Plaintiff] copied the background of Pattern # 1365 from a public domain document. [A witness] testified that the studio created “documentary designs” from public domain material, and that she believed the source for the background in # 1365 was a document in her studio’s possession [However,] there is no evidence that [Plaintiff] copied the placement of the roses from any source. Consequently, the district court’s finding that the particular arrangement given the Folio Rose in Pattern # 1365 was not original was clearly erroneous. Although the arrangement may have required little creative input, it was still [Plaintiff]’s original work and, as such, copyrightable. [*Feist.*] It must be kept in mind that the scope of copyright protection for Folio’s fabric design found above is narrow, extending only to the work’s particular expression of an idea, not to the idea itself.¹²⁶

As this excerpt suggests, the *Folio* decision contains the second and third potential “triggers” of application of the “thin copyright” doctrine noted above: (1) the incorporation of material from the public domain (the “background” of the fabric pattern at issue); and (2) the character of plaintiff’s original contribution (the rotating “rose” motif), which arguably touched on *all* of the subcategories of less-than-fully-protected material listed earlier. The *Folio* court, though purporting to find the fabric pattern sufficiently “original” for copyright protection, effectively put the pattern through two rounds of “filtering”—first, excluding the background from the “substantial similarity” analysis, and second, requiring near-exact copying of the original material (the roses):

Although the roses in both designs are placed against the background in a similar straight line pattern, the roses themselves are not substantially similar. As the district court correctly pointed out, each of the roses in Pattern # 1365 is identical, while the roses in the Baroque Rose pattern differ from each other in their details and nuances. The Baroque Roses appear to be in soft focus and the Folio Rose has a sharper, clearer image. Moreover, though playwrights and poets from William Shakespeare to Gertrude Stein have extolled the beauty of this five-petaled flower, by the rose’s very nature one artist’s rendering of it will closely resemble another artist’s work. For these reasons, we believe that “an average lay observer would [not] recognize the alleged copy as having been appropriated from the copyrighted work.”¹²⁷

¹²⁶ *Id.* at 764-65.

¹²⁷ *Id.* at 766 (quoting *Novelty Textile Mills v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 (2d Cir. 1977) (quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)).

These excerpts from the *Folio* decision show how easily questions of originality, idea-versus-expression, filtering, and substantial similarity can bleed into each other—and, in the context of fashion design, how they often do. Thus, it might come as little surprise that even after two decades of the quasi-formalization of “thin copyright” for visual works of applied art, important doctrinal questions remain unanswered, and/or have been answered differently by different courts and judges.¹²⁸

To the extent that “thin copyright” imports a patent law-like “novelty” bar into copyright law, what—apart from factual material on the record definitely proving that a portion of the plaintiff’s work is not original—suffices for a judicial finding of what might be called “partial non-novelty”? At times, courts have examined formal evidence on industry practice to evaluate non-novelty in aspects of plaintiffs’ works of fashion design;¹²⁹ in other disputes, courts have taken something resembling judicial notice in rejecting “familiar” images as properly considered for infringement purposes (sometimes in the form of purported factual determinations made “as a matter of law.”).¹³⁰ Reasoning like that found in the final sentence of the second block quote from the *Folio* case—stating, in essence, that material is not “substantially similar” as a matter of law because the material in question is (in the court’s view) commonplace, is replete with problems.

Such problems are only compounded as courts add various criteria to the list of potential triggers for the application of “thin copyright”—many of which overlap and/or form the basis for other copyright-law doctrines: (1) a work’s lack of “novel[ty]” via trade history;¹³¹ (2) a work’s incorporation of material from the (copyright-law) public domain;¹³² (3) a work’s depiction

¹²⁸ See discussion, *infra*.

¹²⁹ See, e.g., *Concord Fabrics, Inc. v. Generation Mills, Inc.*, 328 F. Supp. 1030, 1033 (S.D.N.Y. 1971) (“[B]ecause the concept of alternating squares of solids and plaids is shown not to be novel, the court has necessarily mixed into the emulsion of pertinent ideas the burden upon plaintiff in such a case of proving extremely close copying”).

¹³⁰ See, e.g., *Samara Bros. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 132 (2d. Cir. 1998) (“[C]opyright[ed works] depicting familiar objects, such as the hearts, daisies, and strawberries in Samara’s copyrights, are entitled to narrow protection [as against the] virtually identical copying [found here]”) (citing *Folio Impressions*, 937 F.2d at 765), *abrogated on other grounds by Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000).

¹³¹ *Concord Fabrics*, 328 F. Supp. at 1033.

¹³² *Folio Impressions*, 937 F.2d at 765.

of a real-life object existing in nature;¹³³ (4) a work whose possible range of expression “is constrained by both the subject-matter . . . and the conventions of [commerce]”;¹³⁴ and (5) a situation in which anticompetitive market effects might result from judicial recognition of full-fledged copyright protection for a plaintiff’s work.¹³⁵

Adding to the confusion is the reality that many courts have neglected to observe a strict or systematic division between “thin copyright” and the “idea-expression distinction,”¹³⁶ the “merger” doctrine,¹³⁷ or the doctrine of “*scènes à faire*.”¹³⁸ The following passage from a 2012 district-court opinion illustrates the tendency of courts to gloss over such substantive and procedural nuances:¹³⁹

The Copyright Act protects a plaintiff from competing works that are “substantially similar.” *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 913-14 (9th Cir. 2010). This standard applies when there is a wide range of expression available. *Id.* at 916. For example, there are countless ways to design a doll. If, however, there is only a narrow range of expression available, then plaintiff’s copyright protection is “thin” and the defendant’s work must be “virtually identical” to infringe. *Id.* at 913.

In addition, because copyright protection does not extend to “standard, stock, or common” elements, those generic elements must be excluded from the comparison. *Satava v. Lowry*, 323 F.3d 805, 810-11 (9th Cir. 2003). For example, a designer cannot claim for itself the right to all brightly colored jelly fish designs because many jelly fish are brightly colored. *Id.*; e.g., *Ets-Hokin v. Skeyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) (boldly-colored blue glass vodka bottle shaped like a wine bottle has “thin” protection). The rule prevents one artist from claiming too large of a monopoly on unoriginal, common elements that the public should be

¹³³ *Satava v. Lowry*, 323 F.3d 805, 810-11 (9th Cir. 2003); see also *Celebration Int’l v. Chosun Int’l, Inc.*, 234 F. Supp. 2d 905, 917 (S.D. Ind. 2002) (“On balance, the Court concludes that the tiger [costume found protectable under conceptual separability theory] does have some particularized expression, and will recognize the copyright protection that this creative expression justifies. However, the expressiveness is limited due to the effort to reproduce a real, lifelike tiger. As such, the Celebration tiger will only be afforded limited copyright protection.”).

¹³⁴ *Ets-Hokin v. Skeyy Spirits, Inc.*, 225 F.3d 763, 766 (9th Cir. 2003).

¹³⁵ *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741-42 (9th Cir. 1971).

¹³⁶ See discussion *supra*.

¹³⁷ See discussion at *On ‘Similarity.’*

¹³⁸ See *id.*

¹³⁹ *Brighton Collectibles, Inc. v. RK Texas Leather Mfg.*, No. 10-CV-419-GPC (WVG), 2012 U.S. Dist. LEXIS 177718 (S.D. Cal. Dec. 13, 2012).

allowed to use in fair competition. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741-42 (9th Cir. 1971).¹⁴⁰

It seems largely beyond dispute that, at least in the fashion-design context, judicial formalization and application of the “thin copyright” doctrine—especially as the triggers for the doctrine multiply—have resulted in ratcheting up the threshold of the “originality” test for copyright protection in a manner difficult to reconcile with *Feist*. Perhaps the best way to reconcile these disparate strands of case law is through the same sort of reasoning underlying the canon of statutory construction known as “constitutional avoidance.” Indeed, the Second Circuit arguably opted for such an approach in *Beaudin v. Ben & Jerry’s Homemade, Inc.*¹⁴¹ There, plaintiff sued over the alleged copyright infringement of “hand-painted artwork on cloth caps, in a design that uses the pattern of the black splotches on a white background seen on Holstein cows.”¹⁴² The Second Circuit panel considered it “doubtful whether taking a pattern that appears in nature and rendering it in a variety of minute variations that inevitably result from hand-painting satisfies even the minimal originality requirement of copyright.”¹⁴³ But the panel reasoned that it “need not go so far as to rule that Beaudin has no protectable features in his copyright”¹⁴⁴—potentially a *constitutional* determination, under *Feist*. Instead, the court affirmed the district court’s dismissal by invoking “thin copyright”:

As the District Court ruled . . . whatever aspects of Beaudin’s expression of his idea merit protection have indisputably not been infringed by Ben & Jerry’s. Where the quantum of originality is slight and the resulting copyright is “thin,” infringement will be established only by very close copying because the majority of the work is unprotectable. See I William F. Patry, *Copyright Law and Practice* 607, n. 369 (1994). Such close copying has not occurred here. Applying the “ordinary observer” test in the “more discerning” manner appropriate to such cases, see *Folio Impressions*, 937 F.2d at 766, we agree with Chief Judge Murtha that a reasonable trier could not find substantial similarity between Beaudin’s and Ben & Jerry’s hats. The white background is a minimal feature of Beaudin’s hat, but is an extensive feature of the Ben & Jerry’s versions of the [H]olstein splotch pattern.¹⁴⁵

¹⁴⁰ *Id.* at *21-*22.

¹⁴¹ 95 F.3d 1 (2d Cir. 1996).

¹⁴² *Id.* at 1.

¹⁴³ *Id.* at 2.

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

The *Beaudin* decision places in high relief the premise that “thin copyright” is, at least in certain circumstances, effectively a vehicle for ratcheting up copyright law’s “originality” requirement in particular cases.¹⁴⁶ Given that “thin copyright” appears to be disproportionately invoked and applied in disputes over works of fashion design, relevant stakeholders should consider the precedent in which this doctrine has been applied, every bit as much “the law” as the difficult-to-reconcile Supreme Court ruling in *Feist*—at least until the Court revisits the issue of “originality” in the context of a visual work of applied art.

d. Conclusion of Discussion Concerning “Originality” and “Thin Copyright”

In sum, the threshold requirement of “originality” that potentially copyright-eligible¹⁴⁷ fashion-related works must meet for acts of purported infringement to be potentially actionable has waxed and waned in its stringency since the Supreme Court opened the door to certain components of fashion design in its 1954 decision in *Mazer v. Stein*.¹⁴⁸ It is important to keep track of which way the wind is blowing in this area, as the tenor of the time might be just as decisive a factor in the outcome of a given case as the actual content of a purportedly copyrightable work. Sometimes, the copyright registration alone serves as a “tiebreaker” in difficult cases.¹⁴⁹ On other occasions, courts have disregarded the supposed “presumption of validity” following from a grant of registration based on little more than intuition.¹⁵⁰

Introducing another variable into the area of copyright-for-fashion-design, many courts have effectively circumvented difficult “originality” de-

¹⁴⁶ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) (copyright law’s “originality” requirement stems from the Constitution).

¹⁴⁷ See discussion at *On ‘Separability.’*

¹⁴⁸ See discussion at *A Strange Centennial*.

¹⁴⁹ See, e.g., *Homer Laughlin China Co. v. Oman*, Civ. A. No. 90-3160, 1991 U.S. Dist. LEXIS 10680, at *3–*4 (D.D.C. Jul. 30, 1991) (“The Register is entitled to a significant degree of deference and its decision may be overturned only upon an abuse of discretion This Circuit has concluded that ‘abuse of discretion [is] the appropriate standard to review the [Register’s] denial of a registration. Since the applicant can gain full judicial review of copyrightability in an infringement action, the costs of forcing too fine an analysis and too extensive an explanation of a denial of registration are not worth the benefits - particularly when reviewing a question which has unavoidably subjective aspects such as how much creativity is sufficient to force the Copyright Office to register a proffered work.’”) (internal citations omitted.).

¹⁵⁰ See “The Originality Pendulum,” *supra* at Section B.1.b.

terminations by invoking the doctrine of “thin copyright” (or functional equivalents, as in the “motif” line of cases), with the more stringent infringement test this almost invariably entails. “Thin copyright” might provide a means for a court to avoid making tough calls on “originality,” but arguably does so in a manner that is difficult to reconcile with *Feist*. “Thin copyright” is perhaps even less defensible from a pragmatic perspective, as courts applying the doctrine often achieve little more than pushing back the resolution of difficult questions (to the detriment of many litigants) from the threshold copyrightability determination to the infringement stage of dispute resolution.

This doctrinal morass thus represents one of several areas in which the seemingly fundamental question of which fashion articles are entitled to copyright protection might appear to be settled—but, on a practical level, is not. In the end, it may well be that decisive, transparent, and early-stage calls by judges—whatever their outcome—are of greater utility to the fashion industry at large than is the unpredictable and often-unprincipled invocation of conceptually and procedurally confused notions like “thin copyright.” Whether “rules” are preferable to “standards,” or the other way around, this corner of copyright law cannot currently claim a commitment to either approach.

This underscores a central theme running through this series: that fashion’s unique blend of art, commerce, decoration, and utility makes it an awkward conceptual fit for both copyright protection and legislative/judicial application thereof.¹⁵¹ The awkwardness of that fit has, in turn, yielded

¹⁵¹ While this series focuses exclusively on American law, it is arguably notable that the copyright jurisprudence of other countries frequently reflects similar tensions and inconsistencies in the applied-art context. See *discussion* at PAUL GOLDSTEIN & BERNT HUGENHOLTZ, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 214 (3d ed. 2013) (tentatively identifying three general approaches to copyright protection for works of applied art, but qualifying description with caveat that these “categories are by no means impermeable and are not always internally consistent,” as “national differences within categories will sometimes be as great as the differences between the categories themselves”). Interestingly, Goldstein and Hugenholtz identify as a central “reason for the proliferation of conflicting approaches” the notion “that applied art and industrial design encompass a continuum from mass novelty items, such as earrings and toys, to works of industrial design, such as chairs and lamps, in which art and function intertwine”). *Id.* at 214. But see Jerry Palmer, *Introduction to Part I*, in *DESIGN AND AESTHETICS: A READER* 3, 10 (Jerry Palmer & Mo Dodson, eds., 1996) (“Where do such ‘functions’ come from? They cannot come from the object itself, since objects readily change function as they move through time and space Functions are the purposes to which objects are put, but where do the purposes come from? . . . Nothing is more central to the discussion of how objects relate to people than the notion of need.”) The

idiosyncratic and often inconsistent judicial decisions, in which seemingly well-established doctrines of copyright law become little more than *ad hoc* tools for twisting, reshaping, and fusing as necessary to achieve whatever result appears warranted in a given copyright-infringement case over fashion design. Inconsistency is not, of course, unique to this area of the law. But when even ostensibly straightforward principles like “originality” cannot be relied upon with any degree of certainty by so economically significant an industry as fashion, intervention—whether through judicial and/or legislative clarification of the governing law—is warranted.

next article in this series, *On ‘Separability,’* will explore in depth American copyright law’s premise that there is a meaningful distinction between presumptively copyrightable “pictorial, graphic, and sculptural” works and presumptively non-copyrightable “useful articles,” and will investigate how judges have drawn mapped distinction onto real-life disputes over works of fashion design. There is ample reason to believe that American intellectual property law has often placed fashion design in a double-bind, treating it as sufficiently “useful” to disqualify much of its output from copyright, but lacking sufficient worth to accord even its artistically “separable” components robust copyright protection or, at certain key points in U.S. history, design-patent protection. See generally Colman, *Design and Deviance*, *supra* note 3 (arguing that “ornamental” design, for reasons having to do with socio-cultural developments in the late Nineteenth Century, acquired stigmas that manifested in design-patent doctrine).