

THE FEDERAL GOVERNMENT'S HAND-ME-DOWNS: THE POSSIBILITY OF PROTECTING FASHION AT THE STATE LEVEL

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For decades, American fashion designers have been fighting, to no avail, for a federal law that protects their designs. In light of this inaction at the federal level, this Note explores the possibility of making use of the states' traditional role as "laboratories of democracy" and passing a state law protecting works of fashion, specifically garment designs. However, this state law would need to overcome the hurdle of the federal copyright-preemption test. After examining the relevant provisions of the federal copyright statute and the preemption test in relation to garment designs, this Note concludes that a state law protecting garment designs could avoid copyright preemption and suggests that New York adopt such a law.

INTRODUCTION

At a flea market in Chelsea, Dana Foley met her future design partner, Anna Corinna, while selling garments Foley made in her kitchen.¹ At the time, Foley, the mother of two children, was an aspiring playwright living on the Lower East Side, and Corinna was working as a receptionist at Trump Tower and selling vintage clothes at a flea market to make ends meet.² "We both really loved each other's aesthetics and had really great followings at the flea market," Corinna said of their collaboration.³ "One day, Dana said we should open a store and we did!"⁴ The fashion world quickly took notice. In 2008, the pair, who had formed the label Foley + Corinna, was invited to join the prestigious Council of Fashion Designers of America.⁵ Now the brand is sold in stores such as Saks Fifth Avenue, Neiman Marcus, Bloomingdale's, and Nordstrom.⁶ Yet despite its success in a competitive industry, Foley + Corinna does not have the

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1. Eric Wilson, *Simply Irresistible*, N.Y. Times (May 21, 2008), <http://www.nytimes.com/2008/05/21/business/smallbusiness/21look.html> [hereinafter Wilson, *Simply Irresistible*] (on file with the *Columbia Law Review*).

2. *Id.*

3. Rachel Bernstein, *Foley + Corinna's Anna Corinna Dishes on Brand Evolution and Vintage Prowess*, Daily Front Row (Mar. 18, 2013), <http://fashionweekdaily.com/foley-corinnas-anna-corinna-dishes-on-brand-evolution-and-vintage-prowess/> (on file with the *Columbia Law Review*).

4. *Id.*

5. About F+C, *Foley + Corinna*, <http://www.foleyandcorinna.com/index.php/aboutfc> (on file with the *Columbia Law Review*) (last visited Oct. 13, 2014).

6. *Id.*

name recognition, high-profile editorials, or runway shows of American designers such as Michael Kors, Marc Jacobs, or Ralph Lauren.⁷ People without knowledge of the industry may not have even heard of Foley + Corinna.

Foley's and Corinna's eye for style and under-the-radar status make them an ideal target for style piracy. Susan Scafidi, an expert on fashion law, explained this conundrum: "This is the downside of being successful but relatively unknown If you bite a well-known brand, you get caught very easily. If you bite a couple of sweet girls on the Lower East Side, how many people will notice?"⁸ A few years ago, a woman spent over \$1,200 on silk dresses for her bridesmaids at a Foley + Corinna store. Corinna received a phone call from one of her employees when the dresses were returned. The woman had seen a polyester knockoff of the dress, which was selling for almost a tenth of the price, in the window of a fast-fashion clothing chain.⁹ When looking at a picture of the knockoff and her original design, even Corinna could not immediately tell which was which.¹⁰ "When one of our designs gets knocked off," Corinna said of the incident, "the dress is cheapened—customers won't touch it."¹¹

While it is common to think knockoffs and fashion piracy only harm large, faceless fashion brands—the Guccis, Chanel's, and Prada's of the world—this simply is not the case, as the Foley + Corinna episode demonstrates. The fashion industry has been fighting for protection of its designs for decades to no avail.¹² Thus far, advocates of protection largely have fallen into two camps: those who believe existing federal intellectual-property regimes can be used to protect works of fashion¹³

7. See Wilson, *Simply Irresistible*, *supra* note 1 (stating Foley + Corinna has "never been prominently profiled in *Vogue* or *Elle*, nor have they sought the Bryant Park runways").

8. *Id.*

9. Maggie Overfelt, *When Piracy Is Legal*, CNNMoney (Apr. 28, 2008, 9:20 AM), http://money.cnn.com/2008/04/23/smbusiness/whos_stealing_piracy_legal.fsb/ (on file with the *Columbia Law Review*).

10. Ruth La Ferla, *Faster Fashion, Cheaper Chic*, *N.Y. Times* (May 10, 2007), <http://www.nytimes.com/2007/05/10/fashion/10FOREVER.html> (on file with the *Columbia Law Review*).

11. Overfelt, *supra* note 9.

12. See, e.g., *Fashion Originators' Guild of Am., Inc. v. FTC*, 312 U.S. 457, 464–65 (1941) (finding fashion designers' agreement among themselves to refuse to sell designs to knockoff-selling retailers constituted unfair method of competition).

13. For arguments promoting the use of currently existing intellectual-property regimes (i.e., trademark or trade dress, patent, or copyright) to protect works of fashion, see, e.g., Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & Tech. 251, 277–98 (2011) (supporting greater utilization of design patents to protect works of fashion); S. Priya Bharathi, *Comment, There Is More than One Way to Skin a Copycat: The Emergence of Trade Dress to Combat Design Piracy of Fashion Works*, 27 *Tex. Tech L. Rev.* 1667, 1691–94 (1996) (arguing trade dress is superior to copyright for protecting works of fashion); Peter K. Schalestock, *Comment, Forms of Redress for Design Piracy: How Victims Can Use*

and those who think the best method would be for Congress to take action on the issue.¹⁴ While a federal statute that explicitly protects fashion would be a worthy solution, attempts to get such legislation through Congress have failed time after time.¹⁵

The possibility of protecting works of fashion, specifically garment designs, at the state level has not been widely considered, presumably because advocates of protection assume such a state law would be preempted by federal copyright law.¹⁶ This Note argues against this assumption and contends that a state law extending protection to garment designs would not necessarily run afoul of federal copyright. Part I

Existing Copyright Law, 21 *Seattle U. L. Rev.* 113, 128–29 (1997) (examining how copyright's separability doctrine can be interpreted to allow protection for works of fashion); Sunila Sreepada, Comment, *The New Black: Trademark Protection for Color Marks in the Fashion Industry*, 19 *Fordham Intell. Prop. Media & Ent. L.J.* 1131, 1159–68 (2009) (supporting use of trademark to protect color marks in fashion industry).

14. For discussions on the need for Congress to pass legislation providing for the protection of works of fashion, see, e.g., C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 *Stan. L. Rev.* 1147, 1184–90 (2009) (proposing protection for original designs, but only from close copies); Anne Theodore Briggs, Comment, *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, 24 *Hastings Comm. & Ent. L.J.* 169, 201–13 (2002) (discussing shortcomings of extant intellectual-property regimes and arguing for legislation to protect garment design); Laura C. Marshall, Note, *Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act*, 14 *J. Intell. Prop. L.* 305, 327–31 (2007) (arguing for adoption of modified version of previously proposed fashion legislation); Safia A. Nurbhai, Note, *Style Piracy Revisited*, 10 *J.L. & Pol'y* 489, 515–23 (2002) (suggesting Congress add section for fashion-design protection to Title 17 of U.S. Code); Megan Williams, Comment, *Fashioning a New Idea: How the Design Piracy Prohibition Act Is a Reasonable Solution to the Fashion Design Problem*, 10 *Tul. J. Tech & Intell. Prop.* 303, 311–18 (2007) (arguing for enactment of previously proposed fashion law).

15. See Casey E. Callahan, Note, *Fashion Frustrated: Why the Innovative Design Protection Act Is a Necessary Step in the Right Direction, but Not Quite Enough*, 7 *Brook. J. Corp. Fin. & Com. L.* 195, 203–04 (2012) (“The Design Piracy Prohibition Act (DPPA) was introduced to Congress three times, once in 2006 and 2007, and again in 2009. The bill never made it further than the House Committee on the Judiciary . . .”); Jessica Rosen, Comment, *The Inability of Intellectual Property to Protect the New Fashion Designer: Why the ID3PA Should Be Adopted*, 43 *Golden Gate U. L. Rev.* 327, 346–47 (2013) (discussing failure of ID3PA and IDPA, two bills that would protect fashion); Press Release, Office of Commc’ns & Pub. Affairs, Columbia Law Sch., *A Lost Story of Fashion Week* (Aug. 26, 2013), http://www.law.columbia.edu/media_inquiries/news_events/2013/august2013/hemphill-foga (on file with the *Columbia Law Review*) (“U.S. Senator Charles E. Schumer (D-NY) introduced the Innovative Design Protection Act in 2012. The bill was passed out of the Senate Judiciary Committee but never enacted and has yet to be introduced in the 113th Congress.”).

16. On the other hand, a leading treatise on copyright law seems open to the possibility that a state law protecting works of fashion could avoid preemption. See 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 1.01(B)(2)(e) (Matthew Bender rev. ed. 2014) [hereinafter *Nimmer on Copyright*] (“If such typeface designs are . . . outside the realm of copyright protection, it may follow that federal pre-emption does not extend to state laws extending comparable protection. In like manner, one can analyze state-law protection touching on other borders of copyright protection (such as dress designs).”).

provides a general overview of the relevant provisions of the federal copyright statute and how they apply to garment designs. Part II addresses the copyright-preemption test and discusses whether one can consider garment designs copyrightable subject matter and whether a state law would extend a right comparable to one provided by federal copyright. Part III concludes by considering what a state law protecting garment designs would look like and suggests that New York implement such legislation. Though the arguments of this Note could be expanded to include all works of fashion (e.g., designs for garments, bags, shoes, and other accessories), this Note focuses on protection for garment designs. Additionally, this Note emphasizes statutory preemption under the federal copyright statute, as opposed to preemption under the Supremacy Clause¹⁷ of the Constitution.¹⁸

I. UNDERPINNINGS

In order to promote national uniformity in copyright,¹⁹ section 301 of the Copyright Act provides for the preemption of state laws and causes of action that (1) speak to works that fall under the federal umbrella of copyrightable subject matter *and also* (2) extend a right equivalent to those provided exclusively by federal copyright.²⁰ Therefore, in order for a state law regulating garments to be preempted, garments must be copyrightable subject matter *and* the law must provide a right comparable to those available under federal copyright. If only one (or neither) of these criteria is met, the law avoids preemption.²¹

A. *Sections 102 and 103: What Is Copyrightable Subject Matter?*

Section 301 of the Copyright Act explicitly disclaims preemption of state laws addressing works that do not “come within the subject matter

17. See U.S. Const. art. VI, cl. 2 (stating Constitution and federal laws “shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding”).

18. For a brief discussion of preemption under the Supremacy Clause, see *infra* notes 231–233 and accompanying text.

19. See H.R. Rep. No. 94-1476, at 129 (1976) (“By substituting a single Federal system for the present anachronistic, uncertain, impractical, and highly complicated dual system, the bill . . . would be much more effective in carrying out the basic constitutional aims of uniformity and the promotion of writing and scholarship.”).

20. See 17 U.S.C. § 301(a) (2012) (preempting “all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright”).

21. Cf. H.R. Rep. No. 94-1476, at 132 (“Section 301 is not intended to preempt common law protection in cases involving activities such as false labeling, fraudulent representation, and passing off even where the subject matter involved comes within the scope of the copyright statute.”).

of copyright as specified by sections 102 and 103.”²² Section 102 provides the baseline requirements of copyright protection: originality and fixation.²³ Section 102 also sets out eight categories of copyrightable subject matter: (1) literary works; (2) musical works; (3) dramatic works; (4) pantomime and choreographic works; (5) pictorial, graphic, and sculptural works; (6) audiovisual works; (7) sound recordings; and (8) architectural works.²⁴ This list was not meant to be exhaustive.²⁵ Section 103 makes clear that compilations²⁶ and derivative works²⁷ are also copyrightable subject matter.²⁸ Of the enumerated categories in section 102, only one appears to be relevant to garments: pictorial, graphic, and sculptural (PGS) works.

1. *PGS Works*. — The category of PGS works encompasses “two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproduction, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.”²⁹ In this definition, garments would most likely qualify as “applied art,” a term which refers to PGS works that are also useful articles,³⁰ regardless of whether they have been mass produced or marketed for commercial

22. 17 U.S.C. § 301(b)(1).

23. See *id.* § 102(a) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later-developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”). The originality requirement merely demands 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.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). The fixation requirement ensures that the work is “sufficiently permanent or stable to permit it to be perceived, reproduced, otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101.

24. 17 U.S.C. § 102(a).

25. See *id.* § 102(a) (stating “[w]orks of authorship *include* the following categories” (emphasis added)); see also *id.* § 101 (making clear “terms ‘including’ and ‘such as’ are illustrative and not limitative”); H.R. Rep. No. 94-1476, at 53 (“The use of the word ‘include,’ as defined in section 101, makes clear that the listing is ‘illustrative and not limitative,’ and that the seven categories do not necessarily exhaust the scope of ‘original works of authorship’ that the bill is intended to protect.”).

26. A compilation is a “work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101.

27. A derivative work is a “work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.” *Id.*

28. See *id.* § 103(a) (“The subject matter of copyright as specified by section 102 includes compilations and derivative works.”).

29. *Id.* § 101.

30. See *infra* Part I.A.2 (discussing useful articles).

purposes, or whether they may be eligible for design-patent protection.³¹ Another way to fit garment designs into the PGS framework is to try to pass them off as “soft sculptures,”³² though this subcategory generally refers more to objects like plush toys and dolls.³³

2. *Useful Articles.* — The definition of PGS works contains an important caveat: If the work qualifies as a useful article, its mechanical and utilitarian aspects are not protectable.³⁴ A useful article is an “article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”³⁵ This language is fairly opaque. One court found that this meant a toy airplane was copyrightable because its whole purpose was to portray the appearance of a real airplane and, apart from this, it had no intrinsic utilitarian function.³⁶ Another court determined that Legos were functional, and

31. H.R. Rep. No. 94-1476, at 54 (1976); see also *Mazer v. Stein*, 347 U.S. 201, 217–18 (1954) (“Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration.”). The Copyright Act of 1976 was meant to codify *Mazer*. See H.R. Rep. No. 94-1476, at 54 (“In accordance with [*Mazer*] works of ‘applied art’ encompass all original pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection.”).

32. See *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 455–56 (2d Cir. 1989) (“Whimsicality chose to classify its [costumes] as soft sculptures with no useful function Unfortunately for Whimsicality here, the evidence demonstrates not only that the costumes were not soft sculpture, but that Whimsicality knew full well that no reasonable observer could believe that the costumes were soft sculpture.”); *Nat’l Theme Prods., Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1351 (S.D. Cal. 1988) (claiming costume portraying dog is copyrightable as “soft sculpture”).

33. See *Ty, Inc. v. Publ’ns Int’l Ltd.*, 292 F.3d 512, 523 (7th Cir. 2002) (mentioning Ty’s Beanie Babies are copyrighted as soft sculptures); *Kamar Int’l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1061 (9th Cir. 1981) (holding copyright for stuffed animals as soft sculptures was valid); *Ty, Inc. v. GMA Accessories, Inc.*, 959 F. Supp. 936, 938 (N.D. Ill. 1997) (“Ty manufactures ‘Squealer the Pig’ . . . and ‘Daisy the Cow’ . . . , soft-sculptured ‘bean bags’ which Ty sells as part of its ‘The Beanie Babies Collection’ Ty is the owner of registered copyrights for both of those bean bags.”); *Original Appalachian Artworks, Inc. v. Yuil Int’l Trading Corp.*, 105 F.R.D. 113, 114 (S.D.N.Y. 1985) (“Plaintiff Original Appalachian Artworks (‘OAA’) is the owner of the copyright to the enormously popular ‘Cabbage Patch Kids’ line of soft-sculpture dolls.”).

34. See 17 U.S.C. § 101 (“[PGS works] shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned.”).

35. *Id.*

36. *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 973 (6th Cir. 1983). The overruled district court had passionately taken the opposite stance:

The airplanes are toys. Toys are useful. A plane is a thing to play with. Play is an integral part of growing up. Children need toys. A toy airplane is useful and possesses utilitarian and functional characteristics in that it permits a child to dream and to let his or her imagination soar The basic elements employed in the overall design of the defendant’s toy airplane are functional and utilitarian since they are

therefore not copyrightable, because a child could attach pieces to each other and, “[w]hile moving and attaching are not the only functions of a toy, they can be seen as utilitarian in a way that the capacity to inspire play is not.”³⁷ As evident from these examples, what constitutes a useful article is still a gray area, likely due to the lack of clarity in the statutory language.³⁸

Garments clearly have both utilitarian and aesthetic features; clothes cover the body and protect the wearer from the elements, but they are also valued for their aesthetic appeal and used to express one’s individuality.³⁹ Garments thus appear to qualify as useful articles, albeit ones with strong artistic overtones. But this does not automatically disqualify garments from copyright protection. A useful article can gain copyright protection if it passes the “separability test”: If some feature of a useful article is separable from its utilitarian aspects, then that feature is

mandated by the overall shape required to simulate a real airplane. Clearly, without question, the defendant’s toy airplane is both useful and utilitarian.

Gay Toys, Inc. v. Buddy L Corp., 522 F. Supp. 622, 625 (E.D. Mich. 1981), vacated, 703 F.2d 970 (6th Cir. 1983).

37. *Lego A/S v. Best-Lock Constr. Toys, Inc.*, 874 F. Supp. 2d 75, 98–99 (D. Conn. 2012).

38. See *infra* Part II.A.2 (discussing difficulty in applying definition of “useful article” in context of garment designs).

39. See Jenna Marotta, Q&A: Simon Doonan on Why Stars Should Buy Their Gowns for Awards Shows, N.Y. Mag.: The Cut (Jan. 14, 2014, 3:05 PM), <http://nymag.com/thecut/2014/01/simon-doonan-on-why-stars-should-buy-their-gowns.html> (on file with the *Columbia Law Review*) (“I think clothes and style are self-expression: If that’s what someone’s wearing, they’re expressing themselves, and that’s who they are—you don’t rush over and make them look different by cutting off their mullet.”). On the other hand, in early 2014, the media caught wind of a new “trend” called “normcore”—a “self-aware, stylized blandness” that is “a general attitude: embracing sameness deliberately as a new way of being cool, rather than striving for ‘difference’ or ‘authenticity.’ In fashion, though, this manifests itself in ardently ordinary clothes. Mall clothes. Blank clothes. The kind of dad-brand non-style you might have once associated with Jerry Seinfeld . . .” Fiona Duncan, Normcore: Fashion for Those Who Realize They’re One in 7 Billion, N.Y. Mag.: The Cut (Feb. 26, 2014, 8:00 AM), <http://nymag.com/thecut/2014/02/normcore-fashion-trend.html> (on file with the *Columbia Law Review*); see also Graham Slaughter, Are You Normcore—or Merely Unfashionable?, Toronto Star (Mar. 1, 2014), http://www.thestar.com/life/fashion_style/2014/03/01/are_you_normcore_or_merely_unfashionable.html (on file with the *Columbia Law Review*) (describing normcore as “[s]artorial tofu, tasteless on purpose”); Simon Doonan, Beware of Normcore: The Bogus-Sounding New Fashion Trend Is All Too Real, Slate (Apr. 7, 2014, 11:45 PM), http://www.slate.com/articles/life/doonan/2014/04/normcore_the_new_fashion_trend_and_its_perils.html (on file with the *Columbia Law Review*) (describing normcore as “dressing like . . . a bewildered Icelandic exchange student circa 1984”). However, this is likely just “a rewind of the early 1990s, when stonewashed jeans, big white sneakers, ill-fitting baseball caps, turtlenecks and fleece jackets were the rage, and the socks-with-sandals look rocked . . . [F]ashion trends typically resurface in a 20-year cycle, making normcore’s arrival right on track.” Eun Kyung Kim, Normcore: ‘Seinfeld’ Look Turns Bland into Fashion Trend, TODAY (Mar. 5, 2014, 9:59 AM), <http://www.today.com/style/normcore-seinfeld-look-turns-bland-fashion-trend-2D79317923> (on file with the *Columbia Law Review*).

protectable as a PGS work.⁴⁰ The statutory language relating to the separability test is even more enigmatic than the definition of “useful article”: A useful article is a PGS work, and thus eligible for copyright protection, “if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”⁴¹ If such a separable feature exists, only that feature is protected and not the entire article.⁴²

It is common to distinguish between conceptual separability (“can be identified separately from”) and physical separability (“capable of existing independently of”).⁴³ The plain language of the statute seems to imply that both conceptual and physical separability are required since “and” is used instead of “or.” However, House Report 1476 suggests the presence of either conceptual or physical separability would suffice: “Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, *physically or conceptually*, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.”⁴⁴ This makes sense, since physical separability—which exists “when a component of a useful article can actually be removed from the original item and separately sold, without adversely impacting the article’s functionality”⁴⁵—may be relatively straightforward when applied to three-dimensional works but may not translate as well to two-dimensional works.⁴⁶ Since the language was “intended to apply to two-dimensional material, it is clear that a physical separability test cannot be the exclusive test for determining copyrightability.”⁴⁷

40. See *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005) (“[I]f a useful article incorporates a design element that is physically or conceptually separable from the underlying product, the element is eligible for copyright protection.”).

41. 17 U.S.C. § 101 (2012).

42. H.R. Rep. No. 94-1476, at 55 (1976) (“[E]ven if the three-dimensional design contains some such [separable] element . . . copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian design as such.”).

43. 17 U.S.C. § 101; see also *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 932–33 (7th Cir. 2004) (Kanne, J., dissenting) (distinguishing between two types of separability and identifying basic qualifications for each).

44. H.R. Rep. No. 94-1476, at 55 (emphasis added).

45. *Chosun Int’l*, 413 F.3d at 329.

46. See *Pivot Point*, 372 F.3d at 922 (“When a three-dimensional article is the focus of the inquiry, reliance on physical separability can no doubt be a helpful tool . . . [but] such an approach really is not of much use when the item in question is two-dimensional.”).

47. *Id.* Though the Seventh Circuit is perhaps correct that physical separability is more difficult to grasp in the context of two-dimensional works, it seems possible for two-dimensional works to pass this test. For example, a stamp could be physically separated from an envelope and displayed as a work of art in a museum. However, the Seventh Circuit’s assertion that physical separability is not the sole test has been widely accepted. See *Leicester v. Warner Bros.*, 232 F.3d 1212, 1219 n.3 (9th Cir. 2000) (noting general

Physical separability may be an easier notion to grasp than conceptual separability. For instance, a poodle pin attached to a skirt is physically separable, because it can exist independently of the skirt and the functionality of the skirt is not compromised by its absence.⁴⁸ However, physical separability would probably not be the avenue for protection for the majority of garments. After all, what could someone physically separate from a pair of pants while maintaining its functionality and integrity as a pair of pants? For the vast majority of garments, the only viable way to gain copyright protection is through the conceptual-separability analysis. The many iterations of conceptual separability and their concomitant capacity to perplex judges is discussed in further detail in Part II.A.3.

B. *Section 106: What Is an Equivalent Right?*

A state law may also avoid preemption if it addresses “activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.”⁴⁹ Under section 106, the owner of a copyright is guaranteed five exclusive rights: reproduction, preparation of derivative works (or adaptation), distribution, performance, and display.⁵⁰ A state law reaching copyrightable subject matter would be preempted if it provided any of these five rights, or their equivalents.

The exclusive right that seems most relevant to the fashion industry is the right “to reproduce the copyrighted work in copies.”⁵¹ The copyrighted work is infringed if the work is reproduced “in whole or in any substantial part, and by duplicating it exactly or by imitation or simulation.”⁵² If a garment managed to acquire copyright protection, it would be directly protected from knockoffs by the right of reproduction. There-

recognition of two kinds of separability, physical and conceptual); *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1143–44 (2d Cir. 1987) (noting scholarly discussion regarding conceptual and physical separability before concluding “[c]onceptual separability’ is thus alive and well, at least in this circuit”); *Lego A/S v. Best-Lock Constr. Toys*, 874 F. Supp. 2d 75, 95 (D. Conn. 2012) (“Because Lego does not assert physical separability in support of the claim that its figurines contain copyrightable elements, the case turns upon conceptual separability.”); *Eliya, Inc. v. Kohl’s Dep’t Stores*, No. 06 Civ 195(GEL), 2006 WL 2645196, at *11 (S.D.N.Y. Sept. 13, 2006) (“Separability comes in two flavors—physical separability and conceptual separability.”).

48. Look 8 of Isaac Mizrahi Fall 2011 Ready-to-Wear Collection, Style.com, <http://www.style.com/slideshows/fashion-shows/fall-2011-ready-to-wear/isaac-mizrahi/collection/8> (on file with the *Columbia Law Review*) (last visited Oct. 13, 2014) (depicting skirt with poodle pin attached).

49. 17 U.S.C. § 301(b)(3) (2012).

50. *Id.* § 106; see also H.R. Rep. No. 94-1476, at 61 (1976) (“The five fundamental rights that the bill gives to copyright owners—the exclusive rights of reproduction, adaptation, publication, performance, and display—are generally stated in section 106.”).

51. 17 U.S.C. § 106(1).

52. H.R. Rep. No. 94-1476, at 61.

fore, if garments qualified as copyrightable subject matter, a state statute extending a right to designers equivalent to federal copyright's right of reproduction would be preempted by section 301.

II. SKIRTING COPYRIGHT PREEMPTION

A state law will be preempted only if it addresses subject matter that falls within the scope of federal copyright *and* extends a right comparable to those provided by federal copyright.⁵³ Part II.A discusses the first prong of the preemption test as it relates to garment designs—namely, whether garments qualify as copyrightable subject matter. Part II.B then discusses whether a state law that protects garment designs would provide a right resembling one of those provided by federal copyright.

A. *The Subject-Matter Requirement*

Section 301 preempts state laws that address works that “come within the subject matter of copyright.”⁵⁴ Conversely, subject matter that does not fall under the umbrella of copyrightable subject matter is fair game for the states.⁵⁵ Part II.A.1 discusses the fundamental question of whether garments can fit into the category of PGS works and examines the various ways fashion designers have represented their creations in the hopes of gaining copyright protection. Part II.A.2 then addresses whether garments are useful articles, and Part II.A.3 determines whether they would survive the separability test. As part of this analysis, this section examines the various separability tests enunciated by courts and determines how garment designs would fare under each.

1. *Are Garments PGS Works?* — It is undisputed that a *sketch* of a garment design is eligible for copyright protection, but the copyright only extends to the sketch itself and not the garment embodied in the sketch.⁵⁶ Similarly, fabric designs qualify as copyrightable subject matter.⁵⁷ The design of a garment itself, however, has generally failed to meet the requirements of copyrightability.⁵⁸ A work of authorship must first fall

53. See 17 U.S.C. § 301(a) (detailing scope of federal preemption); see also *supra* Part I (discussing preemption test).

54. 17 U.S.C. § 301(b)(1).

55. See *id.* (leaving to states “subject matter that does not come within the subject matter of copyright”).

56. See, e.g., *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 189–90 (S.D.N.Y. 1934) (holding valid copyright of drawing of garment does not give copyright owner right to prevent others from manufacturing garment in drawing).

57. See *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142, 143 (S.D.N.Y. 1959) (determining fabric design is copyrightable subject matter both as work of art and as print).

58. See, e.g., *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (“We have long held that clothes, as useful articles, are not copyrightable.”); *Fashion Originators Guild of Am. v. FTC*, 114 F.2d 80, 84 (2d Cir. 1940) (“It may be unfortunate—it may indeed be unjust—that the law should not thereafter distinguish

into a category of copyrightable subject matter,⁵⁹ and the best contender for works of fashion is the category of pictorial, graphic, and sculptural (PGS) works. In their attempts to make the copyright regime a fit for protecting their garments, designers have attempted to express their designs in the PGS language.⁶⁰

Designers often attempt to claim their garments are “soft sculptures.”⁶¹ A soft sculpture would qualify as a PGS work; however, whether *garments* are actually soft sculptures is another matter. In *Whimsicality, Inc. v. Rubie’s Costume Co.*, faced with a designer trying to pass his costumes off as soft sculptures, the Second Circuit observed that the “word sculpture implies a relatively firm form representing a particular concept” and declined to expand the term to the costumes at issue.⁶² The designer had managed to register the costumes with the Copyright Office as soft sculptures, but the court considered this approach disingenuous.⁶³ The designer’s attorney was asked at trial what would have happened if *Whimsicality* had been upfront about attempting to register a child’s pumpkin *costume*, instead of claiming to register a *soft sculpture*, in the application. The attorney admitted the application likely would have been rejected.⁶⁴ The Second Circuit thus invalidated the copyrights due to misrepresentation.⁶⁵ In a similar case, a designer attempted to charac-

between ‘originals’ and copies; but until the Copyright Office can be induced to register such designs as copyrightable under the existing statute, they both fall into the public demesne without reserve.”), *aff’d*, 312 U.S. 457 (1941); *Boyd’s Collection v. Bearington Collection, Inc.*, 360 F. Supp. 2d 655, 661 (M.D. Pa. 2005) (“[The concept of useful articles] has been universally interpreted to include all clothing, regardless of differences in design, that may be worn by an individual to cover and protect his or her body.”); *Jack Adelman*, 112 F. Supp. at 189 (quoting Register of Patents as saying “[t]here are no provisions in the Copyright Law for protecting fashions for dresses” (internal quotation mark omitted)). But see *Aldridge v. Gap, Inc.*, 866 F. Supp. 312, 314–15 (N.D. Tex. 1994) (“[A]lthough they fall within the subject matter of copyright regulation, clothes, as useful articles are not copyrightable.”).

59. See 17 U.S.C. § 102 (listing requirements for copyrightable subject matter and listing eight qualifying categories); see also *supra* Part I.A (discussing subject-matter requirement).

60. See *supra* Part I.A.1 (discussing PGS works).

61. See *supra* notes 32–33 and accompanying text (discussing designers’ attempts to pass garments off as “soft sculptures” in order to gain protection as PGS works).

62. 891 F.2d at 456.

63. See *id.* at 454–55 (“The explanation for this deception [(i.e., referring to the costumes as “soft sculptures” in the application)] is not a mystery; the Copyright Office considers costumes to be wearing apparel and consistently rejects applications to register them.”).

64. *Id.* at 454.

65. *Id.* at 456 (“*Whimsicality*, because of its misrepresentation, does not have valid copyrights capable of enforcement.”). However, on remand, the district court determined, based on newly discovered evidence, that there was no misrepresentation. *Whimsicality, Inc. v. Rubie’s Costume Co.*, 836 F. Supp. 112, 120 (E.D.N.Y. 1993). An order clarifying this decision granted the defendant’s motion to dismiss the copyright-infringement claim based on the rationale of the original district-court decision. *Whimsicality, Inc. v. Rubie’s*

terize his costumes as “wearable toys”⁶⁶ and “soft sculptures,” arguing that one of the costumes in question could be “stuffed and independently displayed as a fanciful soft sculpture portraying a spotted puppy dog.”⁶⁷ In that case, the court was more sympathetic to the approach, since the costumes were not “designed to optimize their function as clothing.”⁶⁸ The court pointed to the fact that some of the costumes required garments to be worn underneath to avoid “risk[ing] indecent exposure,” and other costumes did not allow the wearer to “move freely or sit easily.”⁶⁹

The Ninth Circuit, in *Poe v. Missing Persons*,⁷⁰ also responded more favorably to the “soft sculpture” approach, but not in a way that bodes well for the majority of garment designs. Gregory Poe, an artist and fashion designer, had created Aquatint No. 5, which he described variously as “an artwork in the medium of soft sculpture,”⁷¹ “visual art,”⁷² “an artists [sic] impression or rendering of an article of clothing,”⁷³ “a work of conceptual art,”⁷⁴ and “a three dimensional work of art in primarily flexible clear-vinyl and covered rock media.”⁷⁵ The defendants maintained that it was simply a swimsuit.⁷⁶ Poe had lent Aquatint No. 5 to a photographer for use in her portfolio, but it instead appeared on an album cover without Poe’s consent.⁷⁷ The district court granted the defendants’ motion for summary judgment “because the functional aspects of the swimsuit [were] not independent of the alleged

Costume Co., No. 89-CV-1720 (RJD), 1993 WL 661161, at *1 (E.D.N.Y. Dec. 6, 1993). The original district-court decision had determined that the costumes were useful articles and failed to pass the separability test, and were therefore not copyrightable. Whimsicality, Inc. v. Rubie’s Costume Co., 721 F. Supp. 1566, 1575–76 (E.D.N.Y.), *aff’d in part, vacated in part*, 891 F.2d 452 (2d Cir. 1989).

66. *Nat’l Theme Prods., Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1350 (S.D. Cal. 1988) (“The Rabbit In Hat costume was designed and is marketed by NTP as a novelty item intended exclusively as a wearable toy for masquerade purposes to portray the magic trick of a rabbit being drawn out of a hat.”). For a discussion of whether toys, wearable or not, are useful articles, see *supra* notes 36–37 and accompanying text.

67. *Nat’l Theme Prods.*, 696 F. Supp. at 1351.

68. *Id.* at 1353.

69. *Id.*

70. 745 F.2d 1238 (9th Cir. 1984).

71. *Id.* at 1239.

72. *Id.*

73. *Id.* at 1240.

74. *Id.*

75. *Id.* (quoting plaintiff’s copyright application) (internal quotation marks omitted).

76. See *id.* at 1239 (“Appellees moved for a summary judgment claiming that ‘the critical facts in this case are not in dispute. There is no dispute that plaintiff designed the swimsuit.’”).

77. *Id.* at 1240.

sculptural/artistic aspects of the suit,” thus rendering the work in question uncopyrightable.⁷⁸

The Ninth Circuit reversed the order of summary judgment, finding there was a disputed issue of material fact regarding whether the work was a useful article. The Ninth Circuit was at a loss to determine this question as a matter of law:

Nothing in our legal training qualifies us to determine as a matter of law whether Aquatint No. 5 can be worn as an article of clothing for swimming or any other utilitarian purpose. We are also unable to determine merely by looking at Poe's creation whether a person wearing this object can move, walk, swim, sit, stand, or lie down without unwelcome or unintended exposure.⁷⁹

The Ninth Circuit seemed to imply that the ability to perform activities typically associated with swimsuits without risk of indecent exposure while wearing the work would disqualify it from protection. The court also noted that it appeared that Poe just wanted to “create a work of art which portrayed an article of clothing,” but it was an open question whether he also “created an article of clothing which can *function* as a swimsuit.”⁸⁰ According to the Ninth Circuit, it seems as though copyright protection might come at the cost of sacrificing wearability. For example, while this may allow protection for an Alexander McQueen gown made entirely of razor-clam shells and displayed at the Metropolitan Museum of Art,⁸¹ it would not allow protection for an actually salable and wearable Diane von Furstenberg shift dress, of which Forever 21 made an identical copy and sold for a tenth of the price.⁸² Under this approach, the garments that are least likely to be copied would be protectable, but

78. Id. at 1241.

79. Id. at 1242.

80. Id.

81. Dress, VOSS, Spring/Summer 2001, Metro. Museum of Art, <http://blog.metmuseum.org/alexandermcqueen/dress-voss-2/> (on file with the *Columbia Law Review*) (last visited Oct. 13, 2014) (depicting dress made of razor shells designed by Alexander McQueen displayed as part of “Savage Beauty” exhibition at Metropolitan Museum of Art).

82. A few years ago, Forever 21 released a knockoff (called the “Sabrina” dress) of the “Cerisier” dress by Diane von Furstenberg. See Susan Scafidi, *Seeing Double?*, *Counterfeit Chic* (Mar. 29, 2007, 12:52 PM), http://www.counterfeitichic.com/2007/03/seeing_double.php (on file with the *Columbia Law Review*) (depicting Diane von Furstenberg “Cerisier” dress and indistinguishable Forever 21 knockoff “Sabrina” dress). While the Diane von Furstenberg original was priced at \$325, the knockoff sold for \$32. Danica Lo, *Designer Sues*, *N.Y. Post* (Mar. 29, 2007, 9:00 AM), <http://nypost.com/2007/03/29/designer-sues/> (on file with the *Columbia Law Review*). This drastic discrepancy in price “likely has to do with the premium put on a designer name, product development on the part of von Furstenberg, the manufacturing conditions and the quality of the material.” Id.

those that are most likely to be copied would not.⁸³ This would be counterintuitive and rather ineffective, since copyright ideally should be aimed at protecting works that are actually vulnerable to copying.

All of this reveals that the statutory language defining PGS works does not easily apply to garments. Garments could potentially qualify as soft sculptures, works of three-dimensional art, or works of applied art, but, as *Poe* demonstrated, there is another barrier that the designer must overcome: the useful-articles doctrine.

2. *Are Garments Useful Articles?* — Copyright preemption does not apply to state statutes that address useful articles,⁸⁴ which do not qualify for copyright protection. Therefore, if garments are useful articles, a state law that protects them would avoid preemption, even if the law extends a right equivalent to one of those provided by federal copyright. At least one court has rejected preemption arguments with regard to several state-law claims (such as unjust-enrichment and unfair-competition claims) involving garments, finding the swimwear in question was a useful article and thus beyond the reach of copyright preemption.⁸⁵

A useful article is “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁸⁶ Importantly, the definition reaches articles “having an intrinsic utilitarian function,” not just articles having a *solely* intrinsic utilitarian function.⁸⁷ Courts have addressed what exactly is the intrinsic utilitarian function of human clothing in cases that deal with the copyrightability of dolls’ clothing. In *Mattel, Inc. v. MGA Entertainment, Inc.*, the Ninth Circuit addressed this issue in a dispute between the creator of

83. An exception to this is a relatively unsalable and unwearable Alexander McQueen look. See Look 45 of Alexander McQueen Spring 2010 Ready-to-Wear Collection, Style.com, <http://www.style.com/slideshows/fashion-shows/spring-2010-ready-to-wear/alexander-mcqueen/collection/45> (on file with the *Columbia Law Review*) (last visited Oct. 11, 2014). A near replica was made and modeled by Yara Sofia, a drag queen and contestant on the reality-TV competition *RuPaul’s Drag Race*. See *RuPaul’s Drag Race: Queens in Space*, at 23:41 (LOGO television broadcast Jan. 31, 2011) (depicting Yara Sofia modeling her “best futurama glamorama,” which bears striking resemblance to Alexander McQueen look, on main stage of *RuPaul’s Drag Race*).

84. See, e.g., *H2O Swimwear, Ltd. v. Lomas*, 560 N.Y.S.2d 19, 21 (App. Div. 1990) (“The preemption provision does not, however, apply to ‘useful articles.’”).

85. *Id.* at 20–21 (“[I]t was error for the IAS Part to have granted defendants’ motions to dismiss several causes of action on grounds of Copyright Act preemption and these claims are, accordingly, reinstated.”).

86. 17 U.S.C. § 101 (2012); see also *supra* Part I.A.2 (discussing useful articles).

87. See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 804 (D.C. Cir. 1978) (“Congress may have concluded that literal application of the phrase ‘sole intrinsic function’ would create an unworkable standard. For as one commentator has observed, ‘[t]here are no two-dimensional works and few three-dimensional objects whose design is absolutely dictated by utilitarian considerations.’” (alteration in original) (quoting Comment, Copyright Protection for Mass-Produced, Commercial Products: A Review of the Developments Following *Mazer v. Stein*, 38 U. Chi. L. Rev. 807, 812 (1971))).

the Barbie doll and the creator of the Bratz doll.⁸⁸ The court determined that doll clothing, unlike actual clothing, could be copyrighted: “Human clothing is considered utilitarian and unprotectable. However, articles that are intended only to portray the appearance of clothing are protectable. Dolls don’t feel cold or worry about modesty. The fashions they wear have no utilitarian function.”⁸⁹ Similarly, in a case that discussed clothing worn by teddy bears, a district court distinguished between human clothes and dolls’ clothes:

The clothing on a teddy bear obviously has no utilitarian function. It is not intended to cover embarrassing anatomical aspects or to protect the bear from exterior elements. Rather, it is intended and serves only to modify the appearance of the bear, to give the doll a different “look and feel” from others. Clothing on a bear replicates the form but not the function of clothing on a person. It does not constitute a “useful article” excluded from copyright protection.⁹⁰

From these cases, it can be concluded that two of the “intrinsic utilitarian functions” of human clothing are to protect the wearer from the elements and to “cover embarrassing anatomical aspects.”⁹¹ The court in *Whimsicality* also mentioned the “decorative function” of clothing.⁹² With these intrinsic utilitarian functions, it is highly unlikely that a garment could qualify as anything but a useful article. Most garments that are vulnerable to design piracy—meaning they are salable—at a minimum will take into account basic modesty concerns and will protect the wearer from the elements to some degree. Furthermore, if the decorative function of clothing counts as an intrinsic utilitarian function, even the most over-the-top avant garde looks that are far closer to the “art” side of the spectrum than the “utility” side would be useful articles.⁹³

3. *Do Garments Pass the Separability Test?* — Even as a useful article, an individual garment could still qualify for copyright protection if elements of the design pass the separability test: “[T]he design of a useful arti-

88. See 616 F.3d 904, 907 (9th Cir. 2010) (“2001 saw the introduction of Bratz, ‘The Girls With a Passion for Fashion!’ Unlike the relatively demure Barbie, the urban, multi-ethnic and trendy Bratz dolls have attitude. This spunk struck a chord, and Bratz became an overnight success. Mattel, which produces Barbie, didn’t relish the competition.”).

89. *Id.* at 916 n.12 (citations omitted).

90. *Boys Collection, Ltd. v. Bearington Collection, Inc.*, 360 F. Supp. 2d 655, 661 (M.D. Pa. 2005) (footnote omitted).

91. *Id.*

92. See *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (“While the pictorial, graphic and sculptural aspects of useful articles may be copyrightable if they are separable from the article . . . clothes are particularly unlikely to meet that test—the very decorative elements that stand out being intrinsic to the decorative function of the clothing.”).

93. If the *Whimsicality* court is really serious about clothing’s “decorative function,” one could argue that art traditionally conceived would also serve a “decorative function” and would thus be a useful article.

cle . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features *that can be identified separately from, and are capable of existing independently of, the utilitarian aspects* of the article.”⁹⁴ This language is notoriously difficult to apply.⁹⁵ This section examines how various courts have grappled with the statutory language of separability and how garment designs would fare under each version of the separability test.

a. *The Second Circuit.*

i. *The Kieselstein-Cord Test.* — The Second Circuit first addressed the separability issue in *Kieselstein-Cord v. Accessories by Pearl, Inc.*⁹⁶ The case involved belt buckles that were “sculptured designs cast in precious metals—decorative in nature and used as jewelry is, principally for ornamentation.”⁹⁷ The designs in question—the Winchester and the Vaquero⁹⁸—had been registered with the Copyright Office as sculptures and had sold quite successfully.⁹⁹ The designer was even inducted into the Council of Fashion Designers of America, and the buckles were accepted into the permanent collection of the Metropolitan Museum of Art.¹⁰⁰ The defendant admitted to copying the designs but claimed they were not copyrightable as they were useful articles.¹⁰¹ The Second Circuit therefore had to determine whether any element of the buckles was conceptually or physically separable from its utilitarian aspects.¹⁰² The court asserted that conceptual separability existed and that the buckles were therefore eligible for copyright protection: “We see in appellant’s belt buckles conceptually separable sculptural elements, as apparently have the buckles’ wearers who have used them as ornamentation for parts of the body other than the waist. The primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function.”¹⁰³ If a test can be gleaned from this rather conclusory statement, it would likely involve a determination of whether the utilitarian function of the article is secondary to and

94. 17 U.S.C. § 101 (2012) (emphasis added).

95. See *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 670 (3d Cir. 1990) (“Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article’s utilitarian function.”).

96. 632 F.2d 989 (2d Cir. 1980).

97. *Id.* at 990.

98. No Copyright Love for Fashion?, Haute-Law.com (Feb. 24, 2012), <http://haute-law.com/2012/02/24/no-copyright-love-for-fashion/> (on file with the *Columbia Law Review*) (depicting belt buckles in question).

99. *Kieselstein-Cord*, 632 F.2d at 990–91.

100. *Id.* at 991.

101. *Id.* at 991–92.

102. *Id.* at 993.

103. *Id.*

separate from the primary ornamental purpose of the article. The court provided little guidance on how to make this determination.

Since the *Kieselstein-Cord* court did not lay out the rationale behind its test, it is not clear how it would work in the context of garment designs. How can one tell, first, if the ornamental aspects of a garment supersede the utilitarian aspects and, second, if the ornamental aspects are separate from the utilitarian aspects? At the very least, it seems that an avant garde garment that is more at home in a museum than on the streets would be primarily ornamental, and a plain white T-shirt would be primarily utilitarian. But this does not aid in the analysis, since the vast majority of clothing that designers would want to protect lies somewhere between these two extremes. The *Kieselstein-Cord* court did not provide any guidance as to where exactly the line falls.

ii. *The Carol Barnhart Test*. — Luckily, the Second Circuit addressed the separability issue again just a few years later in *Carol Barnhart Inc. v. Economy Cover Corp.*,¹⁰⁴ which considered the copyrightability of mannequins. The mannequins in question were “life-like and anatomically accurate” partial male and female torsos with “hollow backs designed to hold excess fabric when the garment is fitted onto the form.”¹⁰⁵ After a lengthy discussion of the relevant legislative history, the court concluded that the mannequins failed to satisfy the separability test and were not copyrightable.¹⁰⁶ As in *Kieselstein-Cord*, the Second Circuit declined to provide an explicit test, but the *Carol Barnhart* court elaborated on how one would conduct this analysis while distinguishing the facts from those in *Kieselstein-Cord*. The court emphasized that the ornamental features of the belt buckles in *Kieselstein-Cord* “were not in any respect required by their utilitarian functions; the artistic and aesthetic features could thus be conceived of as having been added to, or superimposed upon, an otherwise utilitarian article. The unique artistic design was wholly unnecessary to performance of the utilitarian function.”¹⁰⁷ With the mannequins, however, the features that were allegedly ornamental were “inextricably intertwined with the utilitarian feature, the display of clothes.”¹⁰⁸

The *Carol Barnhart* test appears to involve a determination of whether and to what extent the ornamental aspects of an article are required by its utilitarian function. Again, it is unclear how this would work in the context of fashion. A garment could definitely contain aesthetic features that are “wholly unnecessary” to its utilitarian function.

104. 773 F.2d 411 (2d Cir. 1985).

105. *Id.* at 412.

106. See *id.* at 418 (“[W]e are persuaded that since the aesthetic and artistic features of the Barnhart forms are inseparable from the forms’ use as utilitarian articles the forms are not copyrightable.”).

107. *Id.* at 419.

108. *Id.*

For example, the fringe on a skirt¹⁰⁹ could be seen as a purely aesthetic feature “superimposed upon[] an otherwise utilitarian article.”¹¹⁰ But is the fringe “inextricably intertwined” with the utilitarian function of the skirt, i.e., covering the body and protecting against the elements?¹¹¹ Though it may do so in an aesthetically pleasing manner, the fringe on the skirt, at the very least, still serves the intrinsic utilitarian function of covering “embarrassing anatomical aspects.”¹¹²

iii. *The Carol Barnhart Dissent.* — In his *Carol Barnhart* dissent, Judge Newman quickly addressed and disposed of four possible tests¹¹³ before proposing a new one: In order to be conceptually separable, “the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”¹¹⁴ This test is performed from the perspective of the ordinary observer.¹¹⁵ Though the majority claimed this test “uses as its yardstick a standard so ethereal as to amount to a ‘non-test’ that would be extremely difficult, if not impossible, to administer or apply,”¹¹⁶ Judge Newman at least attempted to give some guidance for how his test would operate. He began by defining “separateness” to mean that the “design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously.”¹¹⁷ Therefore, an article is conceptually separable when a person can displace from her mind the idea of the utilitarian function of the object and focus exclusively on the nonutilitarian aspects of the object, usually by conceiving of it as a work of art.¹¹⁸

109. See Look 10 of Michael Kors Fall 2014 Ready-to-Wear Collection, Style.com, <http://www.style.com/slideshows/fashion-shows/fall-2014-ready-to-wear/michael-kors/collection/10> (on file with the *Columbia Law Review*) (last visited Oct. 11, 2014) (depicting fringe skirt).

110. *Carol Barnhart*, 773 F.2d at 419.

111. And this does not even get into the *Whimsicality* court’s proposed “decorative function,” which would likely eviscerate any chance this skirt had at copyright protection. *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989); see supra notes 92–93 (discussing *Whimsicality* court’s inexplicable reference to “decorative function” of clothing).

112. *Boyd’s Collection, Ltd. v. Bearington Collection, Inc.*, 360 F. Supp. 2d 655, 661 (M.D. Pa. 2005); see supra text accompanying note 90 (discussing intrinsic utilitarian functions of clothing in context of clothing for teddy bears).

113. See *Carol Barnhart*, 773 F.2d at 421–22 (Newman, J., dissenting) (discussing four iterations of conceptual-separability test and rejecting each).

114. *Id.* at 422.

115. See *id.* (“I think the relevant beholder must be that most useful legal personage—the ordinary, reasonable observer. This is the same person the law enlists to decide other conceptual issues in copyright law, such as whether an allegedly infringing work bears a substantial similarity to a copyrighted work.”).

116. *Id.* at 419 n.5 (majority opinion).

117. *Id.* at 422 (Newman, J., dissenting).

118. See *id.* at 422–23 (“[Conceptual separability] also occur[s] even when the utilitarian function is perceived by observation, . . . if the concept of the utilitarian function can be displaced in the observer’s mind while he entertains the separate concept of

This version of the separability test seems to operate somewhat like an optical illusion. To take the example of the famous goblet optical illusion,¹¹⁹ a person can look at the picture and see only a goblet. With a slight change in focus, she will see the profiles of two faces in the exact same picture. Thus, when looking at the exact same thing, she is capable of conceiving of two different things separately and exclusively in her mind: a goblet and a pair of faces. Judge Newman also provided several considerations to weigh when performing this test: “the fact that an object has been displayed or used apart from its utilitarian function, the extent of such display or use, and whether such display or use resulted from purchases,” along with the use of expert opinion and survey results.¹²⁰

It would likely be incredibly difficult for a garment to pass Judge Newman’s version of the separability test. The ordinary observer would need to be able to view the garment and conceive of it in her mind as a work of art without at the same time conceiving of it as a functional garment. Even if she perceives it as a work of art, if this conception is “engendered in the observer’s mind simultaneously with the concept of the article’s utilitarian function, the requisite ‘separateness’ does not exist.”¹²¹ Though someone may view an eccentrically structured dress made entirely out of duck feathers at the Metropolitan Museum of Art as a work of art,¹²² it is still difficult to conceive of it as anything but a highly artistic, outré dress. Even if a garment like this could pass Judge Newman’s version of the conceptual-separability test, the vast majority of garments, and particularly the ones that are most vulnerable to being knocked off, would still be ineligible for protection as useful articles.

iv. *The Brandir Test*. — The Second Circuit’s discussion of conceptual separability culminated in a third decision: *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, which addressed the copyrightability of the RIBBON Rack, a bicycle rack that was adapted from a sculpture.¹²³ In *Brandir*, the court adopted Professor Denicola’s test for conceptual separability:¹²⁴ “[I]f design elements reflect a merger of aesthetic and func-

some non-utilitarian function. The separate concept will normally be that of a work of art.”).

119. Eric W. Weisstein, Goblet Illusion, Wolfram MathWorld, <http://mathworld.wolfram.com/GobletIllusion.html> (on file with the *Columbia Law Review*) (last visited Oct. 11, 2014) (depicting illusion).

120. *Carol Barnhart*, 773 F.2d at 423.

121. *Id.* at 422.

122. See *Dress, The Horn of Plenty*, Autumn/Winter 2009–10, Metro. Museum of Art, <http://blog.metmuseum.org/alexandermcqueen/dress-horn-of-plenty/> (on file with the *Columbia Law Review*) (last visited Oct. 13, 2014) (showing duck-feather dress designed by Alexander McQueen that was part of “Savage Beauty” exhibition at Metropolitan Museum of Art).

123. 834 F.2d 1142, 1143 (2d Cir. 1987).

124. See Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 *Minn. L. Rev.* 707, 741 (1983) (“[C]opyright-

tional considerations, the artistic aspects of a work cannot be said to be conceptually separable Conversely, where the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists."¹²⁵ Therefore, whether an article is copyrightable turns on the extent to which aesthetic elements are "significantly influenced" by functional concerns.¹²⁶

The Second Circuit favored this version of the test for multiple reasons. First, the test could be reconciled with the court's previous decisions in *Kieselstein-Cord* and *Carol Barnhart*.¹²⁷ According to the court, the ornamental elements of the belt buckles in *Kieselstein-Cord* "reflected purely aesthetic choices, independent of the buckles' function," yet the distinctive elements of the mannequins in *Carol Barnhart* "showed clearly the influence of functional concerns."¹²⁸ Second, the court appreciated how the test emphasized the emergence of utilitarian concerns during the design process, proof of which would require information regarding how the article was designed.¹²⁹ Third, the court believed this test would be relatively straightforward to apply.¹³⁰

Indeed, the *Brandir* test is much easier to grasp and administer than the two previous tests articulated by the Second Circuit, but garment designs would still likely fail this test. For most garments, aesthetic concerns are merged with utilitarian concerns. For example, designers incorporate zippers and buttons to help the wearer get in and out of the garment, straps to hold it up, lining to make it more comfortable or less transparent, elasticity in the fabric to make it more wearable, or seaming to make it more flattering to the body.¹³¹ Very few garments reflect the "designer's artistic judgment exercised independently of functional influences,"¹³² and, again, the ones that do reflect the designer's pure artistic judgment are not the garments that are likely to be copied by design pirates.

ability ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations.").

125. *Brandir*, 834 F.2d at 1145.

126. *Id.* at 1145–46.

127. *Id.* at 1145.

128. *Id.*

129. See *id.* ("[T]he test's emphasis on the influence of utilitarian concerns in the design process may help, as Denicola notes, to 'alleviate the de facto discrimination against non-representational art that has regrettably influenced much of the current analysis.'" (quoting Denicola, *supra* note 124, at 745)).

130. See *id.* ("[W]e think Denicola's test will not be too difficult to administer in practice.").

131. Cf. *id.* at 1146–47 (describing functional concerns that went into design process of RIBBON Rack).

132. *Id.* at 1145.

b. *The Seventh Circuit: Pivot Point.* — *Pivot Point International, Inc. v. Charlene Products, Inc.*, a Seventh Circuit case, also addressed the copyrightability of mannequins.¹³³ This time the subject was “Mara,” a mannequin of a human head that was used by hairstylists and imitated the “hungry look” of runway models.¹³⁴ Leo Passage, a celebrated hair designer, enlisted the help of a German artist, Horst Heerlein, to create the original Mara sculpture.¹³⁵ The mold of this sculpture was then sent to Hong Kong, where it was used to create polyvinyl chloride replicas.¹³⁶ Following the commercial success of plaintiff’s Mara mannequin, the defendant began marketing “Liza,” a mannequin head that bore a striking resemblance to Mara.¹³⁷

The Seventh Circuit looked to the Second Circuit’s analysis of the separability issue for guidance¹³⁸ before ultimately determining that Mara was copyrightable.¹³⁹ The Seventh Circuit noted with approval the Second Circuit’s increased focus on the design process of the article in its separability analysis¹⁴⁰ and purported to use this approach to conclude the Mara face was copyrightable: “Applying this test to the Mara mannequin, we must conclude that the Mara face is subject to copyright protection. It certainly is not difficult to conceptualize a human face, independent of Mara’s specific facial features . . . that would serve the utilitarian functions of a hair stand”¹⁴¹ This approach is somewhat perplexing. If the test is whether it is possible to conceive of a different design that would serve the same utilitarian functions, it seems as though nearly every useful article would be copyrightable, as it is almost always possible to conceive of a different design that serves the same purposes. As the *Pivot Point* dissent noted, “If copyright provided protection for functional items simply because of their aesthetic qualities, Congress’s policy choice that gives less protection in patent than copyright would be undermined.”¹⁴²

133. 372 F.3d 913, 915 (7th Cir. 2004).

134. *Id.*

135. *Id.*

136. *Id.*

137. *Id.* at 915–16.

138. See *id.* at 924–30 (discussing, among others, Second Circuit opinions in *Kieselstein-Cord*, *Carol Barnhart*, and *Brandir*).

139. See *id.* at 932 (“Thus, because Mara was the product of a creative process unfettered by functional concerns, its sculptural features ‘can be identified separately from, and are capable of existing independently of,’ its utilitarian aspects. It therefore meets the requirements for conceptual separability and is subject to copyright protection.”).

140. See *id.* at 930 (“This process-oriented approach for conceptual separability—focusing on the process of creating the object to determine whether it is entitled to copyright protection—is more fully articulated in *Brandir* and indeed reconciles the earlier case law pertaining to conceptual separability.”).

141. *Id.* at 931.

142. *Id.* at 932 (Kanne, J., dissenting).

The *Pivot Point* dissent believed Mara was clearly a useful article that failed to meet the separability test, since her facial features were essential to her function as a teaching device at beauty schools.¹⁴³ Furthermore, the dissent did not think the emphasis on the design process had any basis in the statutory language, which “looks to the useful article as it exists, not to how it was created.”¹⁴⁴ Even if one were to take into account the design process, *Pivot Point*, the dissent pointed out, intended for Mara to be used for a *functional* purpose from the beginning and enlisted Heerlein to create her for that functional purpose.¹⁴⁵

The upshot of *Pivot Point* for works of fashion is unclear. If the court meant merely to adopt the Second Circuit’s analysis, then garment designs will likely fail to satisfy the separability test.¹⁴⁶ If the test is whether it is possible to conceive of a different design that would serve the same utilitarian concerns, nearly all garment designs would qualify as conceptually separable. However, *Pivot Point* still makes clear that the design process is important to the analysis.¹⁴⁷ Since fashion designers typically have in mind a combination of aesthetic and functional concerns when they are designing garments, garment designs would likely still fail to meet the *Pivot Point* articulation of the test. It would be a rare situation where a designer was completely unhampered by functional considerations, as the court believed Heerlein to have been.¹⁴⁸

c. *The Fifth Circuit: Harrah’s*. — In *Galiano v. Harrah’s Operating Co.*, the Fifth Circuit addressed the issue of conceptual separability in the context of garment designs, specifically casino uniforms.¹⁴⁹ Jane Galiano entered into an agreement with Harrah’s to design uniforms for its casino employees.¹⁵⁰ Nearly a year later, negotiations to extend the contract fell through, but Harrah’s continued to order from the manufacturers the uniforms Galiano had designed.¹⁵¹ Galiano then sued, claiming

143. See *id.* at 933 (“[S]tudents style her hair and apply makeup as realistic training for such pursuits on live subjects. A mannequin head without a neck, or with different eyes and musculature, would not serve the utilitarian purpose of applying makeup or teaching the art of matching hair styles to facial features.”).

144. *Id.* at 934.

145. *Id.* (“Even if we . . . look at the ‘process’ that led to the creation of Mara, it is undeniable that, from the beginning, *Pivot Point* intended Mara to serve a functional purpose and commissioned her creation to fulfill that purpose (not to create a work of art for aesthetic beauty).”).

146. See *supra* text accompanying notes 131–132 (discussing how garment designs would fare under *Brandir* test).

147. *Pivot Point*, 372 F.3d at 931–32 (discussing design process of Mara).

148. See *id.* at 931–32 (“[T]here is no evidence that Heerlein’s artistic judgment was constrained by functional considerations.”).

149. See 416 F.3d 411, 413, 416 (5th Cir. 2005) (discussing statutory test for separability as applied to “uniforms for employees of various Harrah’s casinos”).

150. *Id.* at 413.

151. *Id.*

Harrah's had infringed her copyright on the garments¹⁵² by continuing to use and order the garments.¹⁵³

The Fifth Circuit first considered the *Pivot Point* test and made clear that it was not outright rejecting the test, but declined to apply it to the facts at hand.¹⁵⁴ The court then turned to two cases that had addressed the copyrightability of works of fashion: *Poe v. Missing Persons*¹⁵⁵ and *Kieselstein-Cord*.¹⁵⁶ The Fifth Circuit believed both of these decisions showed that a "willingness to recognize the copyrightability of a useful article seems, at some elemental level, to turn on the capacity of the item to moonlight as a piece of marketable artwork."¹⁵⁷ After declaring that "a sub-optimal prophylactic rule" is occasionally better than a "theoretically superior but hopelessly subjective one,"¹⁵⁸ the Fifth Circuit adopted what it referred to both as the "Nimmer/*Poe*" standard and the "likelihood-of-marketability standard," but only for garment designs.¹⁵⁹ Since Galiano had not shown that her designs were marketable apart from their utilitarian purpose of casino uniforms, the garments were not copyrightable.¹⁶⁰

Since the Fifth Circuit's test was tailor-made, as it were, for garment designs, it is much more straightforward to apply to garments. But this does not mean garment designs fare any better under this test. In order to be eligible for protection, a garment must be marketable apart from its utilitarian functions. This would mean, under the Fifth Circuit's test, that a significant number of people would be willing to purchase it purely for its aesthetic aspects, even if it had no utilitarian purpose. Since the vast

152. A few years after she designed them, Galiano received copyright protection for sketches she made of the garments. *Id.*

153. *Id.* at 414.

154. *Id.* at 418 ("Acknowledging the comprehensiveness of [*Pivot Point*], however, is not tantamount to applying it here. We do not reject the *Pivot Point* test in this circuit but we decline to apply it to the instant facts . . .").

155. 745 F.2d 1238 (9th Cir. 1984). For a discussion of *Poe*, see *supra* notes 70–83 and accompanying text.

156. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980). For a discussion of *Kieselstein-Cord*, see *supra* notes 96–103 and accompanying text.

157. *Harrah's*, 416 F.3d at 420; see also *Poe*, 745 F.2d at 1243 (listing, as one of four possible considerations for district court on remand, "admissibility of evidence as to Aquatint No. 5's marketability as a work of art"); *Kieselstein-Cord*, 632 F.2d at 991 (noting commercial success of belt buckles and their acceptance into permanent collection of Metropolitan Museum of Art). The Fifth Circuit also drew some inspiration from the Nimmer test: whether "there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities." *Harrah's*, 416 F.3d at 419 (quoting 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.08(B)(3) (2005)).

158. *Harrah's*, 416 F.3d at 421.

159. See *id.* ("We therefore adopt the likelihood-of-marketability standard *for garment designs only*, because it appears firmly rooted as the implicit standard courts have been using for quite some time." (footnote omitted)).

160. *Id.* at 422 ("Gianna makes no showing that its designs are marketable independently of their utilitarian function as casino uniforms.").

majority of people purchase clothes based on both aesthetic and functional considerations, this would likely render most garments ineligible for protection.

Though courts are clearly divided on just how the conceptual-separability analysis should function, it seems as if no court has proposed an iteration of the test that would allow for protection of garments that are both artistic and functional. It appears clear that this places garments outside the realm of copyrightable subject matter. Since garments are useful articles that fail the conceptual-separability test, they avoid copyright preemption and could be the subject of state legislation.

B. *The Equivalency Requirement*

Even though garments are not copyrightable subject matter, which fact alone is enough to preclude preemption,¹⁶¹ it is nonetheless worthwhile to consider whether a state law that addresses copyrightability of garments would extend a right equivalent to those provided by federal copyright as an alternate ground for avoiding preemption. Again, section 301 makes clear that it does not preempt “any rights or remedies under the common law or statutes of any State with respect to . . . activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright.”¹⁶² However, if a state-level right contains an “extra element” that goes beyond those involved in a copyright-infringement claim, this is generally enough to preclude preemption by placing the right outside the realm of federal copyright.¹⁶³ An example of this is the “hot news” misappropriation claim, which protects “property rights in time-sensitive information so that the information will be made available to the public,” because, without protection, “no one would have an incentive to collect ‘hot news’” and the “newspaper-reading public would suffer.”¹⁶⁴ A “hot news” claim avoids preemption through the extra elements of “time-sensitive factual information, free-riding by the defendant, and a threat to the very existence of the plaintiff’s product,”¹⁶⁵ which make the claim distinctly different from that of copyright infringement. This section looks at

161. See *supra* Part I (discussing how state law is preempted only if it meets both prongs of preemption test).

162. 17 U.S.C. § 301(b) (2012).

163. *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 716 (2d Cir. 1992) (“[I]f an ‘extra element’ is ‘required instead of or in addition to the acts of reproduction, performance, distribution or display, in order to constitute a state-created cause of action, then the right does not lie ‘within the general scope of copyright,’ and there is no preemption.” (quoting 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 1.01(B) (1991))).

164. *NBA v. Motorola, Inc.*, 105 F.3d 841, 853 (2d Cir. 1997).

165. *Forest Park Pictures v. Universal Television Network, Inc.*, 683 F.3d 424, 430–31 (2d Cir. 2012).

examples of extra elements and examines the “hot news” misappropriation claim in greater detail as a possible model for fashion protection.

1. *Extra Elements.* — Courts in a variety of causes of action have found “extra elements” that are sufficient to save the claim from preemption. For example, trade-secret¹⁶⁶ claims at times contain the requisite extra element, which is often phrased as either “breach of trust or confidence”¹⁶⁷ or merely “secrecy.”¹⁶⁸ House Report 1476 also makes clear that copyright preemption was not meant to reach trade-secret claims.¹⁶⁹ Likewise, a breach-of-contract claim typically does not run into preemption problems because it contains the extra element of a promise¹⁷⁰ or the existence of the contract itself.¹⁷¹ Congress also made clear that nothing in section 301 “derogates from the rights of parties to contract with each other and to sue for breaches of contract.”¹⁷² Similarly, a *Desny* claim—the “implied contract right to compensation when a writer submits material to a producer with the understanding that the writer will be paid if the producer uses the concept”¹⁷³—will normally avoid

166. A “trade secret” refers to information that meets three criteria: “(1) [I]t must confer a competitive advantage when kept secret; (2) it must be secret in fact; and (3) in many states, it must be protected by reasonable secrecy safeguards.” Robert G. Bone, *A New Look at Trade Secret Law: Doctrine in Search of Justification*, 86 *Calif. L. Rev.* 241, 248 (1998).

167. See *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 847–48 (10th Cir. 1993) (stating “breach of a duty of trust or confidence” is extra element for trade-secret claims); *Brainard v. Vassar*, 561 F. Supp. 2d 922, 931 (M.D. Tenn. 2008) (“The plaintiffs have correctly noted that misappropriation of trade secrets claims often defeat preemption because trade secrets claims require the extra element of a ‘breach of duty of trust and confidentiality.’”).

168. See *AtPac, Inc. v. Aptitude Solutions, Inc.*, 787 F. Supp. 2d 1108, 1115 (E.D. Cal. 2011) (noting “CRiis and the surrounding ideas and processes qualify as trade secrets” and this extra element made “claim qualitatively different from a copyright infringement action”); *Firoozye v. Earthlink Network*, 153 F. Supp. 2d 1115, 1131 (N.D. Cal. 2001) (noting qualification as trade secret under applicable state statute was extra element that differentiated trade-secrets claim from copyright-infringement claim).

169. See H.R. Rep. No. 94-1476, at 132 (1976) (“The evolving common law right[] of . . . trade secrets . . . would remain unaffected as long as the causes of action contain elements, such as . . . breach of trust or confidentiality, that are different in kind from copyright infringement.”).

170. See *Dorsey v. Money Mack Music, Inc.*, 304 F. Supp. 2d 858, 865 (E.D. La. 2003) (“The existence of a promise or fiduciary duty renders plaintiff’s claims qualitatively different from a copyright infringement claim, and thus cannot be preempted.”); *Brignoli v. Balch Hardy & Scheinman, Inc.*, 645 F. Supp. 1201, 1205 (S.D.N.Y. 1986) (“Claims One, Two, Four, and Five are essentially breach of contract claims that involve an element beyond unauthorized reproduction and use—a promise to pay plaintiff for use of his product.”).

171. See *Huckshold v. HSSL, L.L.C.*, 344 F. Supp. 2d 1203, 1208 (E.D. Mo. 2004) (“[I]n addition to having to prove the extra element of HSSL permitting Miller to copy the Software, Plaintiff must also prove the extra element of the contract itself.”).

172. H.R. Rep. No. 94-1476, at 132.

173. *Montz v. Pilgrim Films & Television, Inc.*, 649 F.3d 975, 976 (9th Cir. 2011) (citing *Desny v. Wilder*, 299 P.2d 257 (Cal. 1956)).

preemption because it includes the extra element of an implied promise to pay.¹⁷⁴ Fraud claims may also survive preemption, due to the extra element of misrepresentation.¹⁷⁵ Additionally, unfair-competition claims may avoid preemption through various extra elements, such as intentional deception,¹⁷⁶ consumer confusion,¹⁷⁷ and “passing off.”¹⁷⁸ House Report 1476 buttresses this: “Section 301 is not intended to preempt common law protection in cases involving activities such as false labeling, fraudulent representation, and passing off even where the subject matter involved comes within the scope of the copyright statute.”¹⁷⁹ Conversion claims may also survive copyright preemption due to the element of wrongful possession of or interference with the plaintiff’s property.¹⁸⁰

A state statute that extends protection to garment designs would most likely resemble the federal copyright’s exclusive right to “reproduce the copyrighted work in copies.”¹⁸¹ Though the fact that garments do not qualify as copyrightable subject matter should be enough to prevent preemption, a state law could still take its cues from these “extra elements” in order to err on the side of safety. Adding in an element of secrecy—such as requiring the garment designs to be kept under lock and key—

174. *Id.* at 981 (affirming “implied contractual claim to compensation for use of a submitted idea” avoids preemption); *Grosso v. Miramax Film Corp.*, 383 F.3d 965, 968 (9th Cir. 2004) (noting prior cases support “treating the implied promise to pay required by *Desny* as an ‘extra element’ for preemption purposes”).

175. See *Bean v. McDougal Littell*, 538 F. Supp. 2d 1196, 1200 (D. Ariz. 2008) (“McDougal’s alleged misrepresentation during the dealing for the licenses provides an extra element which distinguishes the nature of Bean’s fraud action from a copyright claim.”); *Brignoli*, 645 F. Supp. at 1205–06 (stating fraud claim includes extra element of misrepresentation and finding no preemption).

176. See *Samara Bros. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 131 (2d Cir. 1998) (“We agree that ‘intentional deception’ constitutes an extra element not required in a copyright infringement claim.”), *rev’d on other grounds*, 529 U.S. 205 (2000).

177. See *id.* (“Like the requirement of ‘intentional deception,’ ‘actual confusion’ constitutes an extra element.”); *Kindergartners Count, Inc. v. DeMoulin*, 171 F. Supp. 2d 1183, 1192 (D. Kan. 2001) (“Proof of customer confusion or deception and/or proof of a confidential relationship and the breach thereof are extra elements that keep this unfair competition claim from being preempted.”).

178. See *Too, Inc. v. Kohl’s Dep’t Stores, Inc.*, 210 F. Supp. 2d 402, 405 (S.D.N.Y. 2002) (“Accordingly, because Too’s claim for unfair competition is based on an allegation that Windstar copied *and* passed off Too’s works as its own, it is not preempted and the proposed amendment is not futile.”); *Rubin v. Brooks/Cole Publ’g Co.*, 836 F. Supp. 909, 924–25 (D. Mass. 1993) (“Thus, although somewhat factually dissimilar from boilerplate ‘passing off’ claims in which the defendant pretends that the *product* is the plaintiff’s, Rubin’s claim similarly contains an extra element of misrepresentation with regard to the sponsorship or authorization of the reproduction.” (citations omitted)).

179. H.R. Rep. No. 94-1476, at 132 (1976).

180. See *Carson v. Dynegy, Inc.*, 344 F.3d 446, 455–57 (5th Cir. 2003) (stating elements of conversion of physical property under Texas law and noting they are “qualitatively different than those of copyright infringement”).

181. 17 U.S.C. § 106(1) (2012); see also *supra* Part I.B (discussing equivalency requirement).

would not make sense given the nature of the fashion industry. Clothes are very much in the public eye from the moment they appear on the runway to the moment they are hung on racks in stores. This public exposure is essential for designers seeking to get their garments into retail stores.¹⁸² It is also quite easy to reverse engineer the designs of garments once they are released to the public. Furthermore, any contractual claim would not be plausible, since it is highly unlikely that the designer and the manufacturer of the knockoff are parties to a contract. The extra elements accompanying fraud and unfair-competition claims initially seem appealing, and consumer confusion could indeed be a worthy addition to a state law for garment protection, but requiring proof of misrepresentation, passing off, or intentional deception would likely present too high of a barrier. Fashion pirates, with the exception of counterfeiters, often are not trying to pass off their products as those of a designer or intentionally deceive customers; they are merely appropriating someone else's design and free riding on someone else's creativity. However, one seemingly unlikely claim bears closer examination: "hot news" misappropriation.

2. *"Hot News" Misappropriation.* — House Report 1476 explicitly articulates "hot news" misappropriation as a cause of action left to the states.¹⁸³ The "hot news" claim originated in *International News Service v. Associated Press*,¹⁸⁴ which involved news piracy. The Associated Press (AP) accused International News Service (INS) of copying the news from AP bulletins and selling it to its clients.¹⁸⁵ Occasionally, INS was able to disseminate the copied news to its West Coast clients at the same time, or even before, AP delivered it to its own clients.¹⁸⁶ AP could not bring a

182. See Josh Patner, Fashion Week FAQ, Slate (Sept. 13, 2004, 7:01 PM), http://www.slate.com/articles/arts/fashion/2004/09/fashion_week_faq.html (on file with the *Columbia Law Review*) (discussing importance of fashion-week runway shows to "fashion press, retail buyers, and others with influence in the fashion world").

183. See H.R. Rep. No. 94-1476, at 132 ("[S]tate law should have the flexibility to afford a remedy (under traditional principles of equity) against a consistent pattern of unauthorized appropriation by a competitor of the facts (i.e., not the literary expression) constituting 'hot' news . . .").

184. See Lauren M. Gregory, Hot off the Presses: How Traditional Newspaper Journalism Can Help Reinvent the "Hot News" Misappropriation Tort in the Internet Age, 13 Vand. J. Ent. & Tech. L. 577, 587 (2011) ("The *INS* decision marked the birth of the 'hot news' misappropriation tort that inspired vigorous dissent at the time and draws criticism even today.").

185. See *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 232 (1918) ("The only matter that has been argued before us is whether defendant may lawfully be restrained from appropriating news taken from bulletins issued by complainant or any of its members, or from newspapers published by them, for the purpose of selling it to defendant's clients.").

186. See *id.* at 238-39 ("[I]rregularities in telegraphic transmission on different lines, and the normal consumption of time in printing and distributing the newspaper, result in permitting pirated news to be placed in the hands of defendant's readers sometimes

claim for copyright infringement because the news, as factual matter, is not copyrightable.¹⁸⁷ Yet the Supreme Court held that INS's actions were not permissible:

Stripped of all disguises, the process amounts to an unauthorized interference with the normal operation of complainant's legitimate business precisely at the point where the profit is to be reaped, in order to divert a material portion of the profit from those who have earned it to those who have not; with special advantage to defendant in the competition because of the fact that it is not burdened with any part of the expense of gathering the news.¹⁸⁸

The Court declined to modify the rather nebulous injunction granted by the district court, which restrained "any taking or gainfully using of the complainant's news . . . 'until its commercial value as news to the complainant and all of its members has passed away.'"¹⁸⁹ While *INS* is no longer good law, it is widely agreed that "hot news" claims can survive preemption.¹⁹⁰

There are three "extra elements" to a "hot news" claim that enable it to survive preemption: "(i) the time-sensitive value of factual information; (ii) the free-riding by a defendant; and (iii) the threat to the very existence of the product or service provided by the plaintiff."¹⁹¹ Though "hot news" might seem like an unlikely analogy for fashion, this framework could be adapted to a law protecting garment designs.¹⁹² If such a state law were adopted, not only would it avoid preemption under the first prong of the preemption test requiring copyrightable subject matter,¹⁹³ but the law would escape under the second prong, requiring equivalency,¹⁹⁴ as well.

simultaneously with the service of competing Associated Press papers, occasionally even earlier.").

187. See *id.* at 232 (discussing copyrightability, or lack thereof, of news); see also *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) ("The key to resolving the tension lies in understanding why facts are not copyrightable. The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author.").

188. *INS*, 248 U.S. at 240.

189. *Id.* at 245–46.

190. *Barclays Capital Inc. v. Theflyonthewall.com, Inc.*, 650 F.3d 876, 894 (2d Cir. 2011). Indeed, the Second Circuit has "used *INS* as a description of the types of claims—'*INS*-like'—that, Congress has said, are not necessarily preempted by federal copyright law *INS* thus maintains a ghostly presence as a description of a tort theory, not as a precedential establishment of a tort cause of action." *Id.*

191. See *NBA v. Motorola, Inc.*, 105 F.3d 841, 853 (2d Cir. 1997) (noting these three extra elements allow "hot news" claim to survive preemption); see also *Forest Park Pictures v. Universal Television Network, Inc.*, 683 F.3d 424, 430–31 (2d Cir. 2012) (same).

192. For a discussion of how the elements would function in the context of fashion, see *infra* Part III.B, which discusses one potential model for state law protecting garment designs.

193. See *supra* Part I.A (discussing subject-matter requirement of preemption test).

194. See *supra* Part I.B (discussing equivalency requirement of preemption test).

Because garments fail under any iteration of the separability test, garments are useful articles that are outside the realm of copyrightable subject matter. Therefore, a state law that protects garment designs would not run afoul of federal copyright preemption. Additionally, it appears as if it would be possible for a law addressing garment designs to incorporate “extra elements,” thus failing to meet either prong of the preemption test. States are therefore free to craft legislation to protect garment designs without fear of preemption. Part III discusses how such a law could function and why one should be passed in New York.

III. NEW YORK SHOULD MAKE A FASHION STATEMENT

The fashion industry makes an enormous contribution to the economy;¹⁹⁵ “[it] shows the highest revenues of all creative industries, exceeding those of books, movies and music combined,”¹⁹⁶ all of which are eligible for copyright protection under United States law.¹⁹⁷ However, despite these contributions, efforts to protect works of fashion have largely failed.¹⁹⁸ Due to Congress’s inactivity on the subject and the fact that this appears to be an area on which states may legislate,¹⁹⁹ states should take this opportunity to pass laws that provide protection to garments. This Part explores the possibility of New York becoming the first state to implement such a law and discusses how the law could function; it also addresses a few lingering objections.

A. *Why New York?*

Of the four international fashion capitals, only one is in the United States—New York City.²⁰⁰ Fashion is vitally important to New York City; it is a “\$55 billion industry that employs 165,000 people, accounts for 5.5 percent of the city’s workforce and generates nearly \$2 billion annually

195. The global fashion industry is worth \$1.3 trillion and makes up 2.1% of the global gross domestic product, with the North American market worth \$352 billion. Eveline van Keymeulen & Louise Nash, *Fashionably Late*, *Intell. Prop. Mag.*, Dec. 2011–Jan. 2012, at 53, 53, available at <http://www.cov.com/files/Publication/8fc11e54-27e2-4da3-9323-0663dd0a5746/Presentation/PublicationAttachment/45a27275-df92-475b-9e11-11154b0c1061/Fashionably%20Late.pdf> (on file with the *Columbia Law Review*).

196. *Id.*

197. See 17 U.S.C. § 102 (2012) (providing subject matter of copyright).

198. See *supra* note 15 and accompanying text (discussing failed attempts to protect fashion at federal level).

199. See *supra* Part II (discussing copyright preemption as it relates to garment designs).

200. See Shelley Emling, *Big 4 Fashion Weeks Get New Company*, *N.Y. Times* (Oct. 3, 2006), <http://www.nytimes.com/2006/10/03/style/03iht-Rweeks.3015966.html> (on file with the *Columbia Law Review*) (referring to Paris, London, Milan, and New York as “traditional four fashion capitals”).

in tax revenues.”²⁰¹ More than 800 fashion companies are based in New York City, and the twice-yearly New York Fashion Week “generates \$466 million in direct visitor spending, leading to \$782 million in total economic impact per year.”²⁰² New York City is also the home of major fashion periodicals, such as *Vogue*, *W*, and *Harper’s Bazaar*.²⁰³ Parsons The New School for Design, which boasts such alumni as Marc Jacobs, Tom Ford, Donna Karan, and Narciso Rodriguez,²⁰⁴ and the Fashion Institute of Technology, which is responsible for Calvin Klein, Francisco Costa, and Norma Kamali,²⁰⁵ are both based in New York City. As the fashion capital of the United States,²⁰⁶ New York would be an obvious choice for a state law extending protection to fashion designs.

B. *What Would the Law Look Like?*

As a preliminary matter, the fashion designer would be required to show that she designed the garment before the alleged pirate did. In order to do this, the designer could point to the garment’s appearance in a runway show, the fact that it was sold—either in stores or online—under her label, published photographs or sketches of the design or garment, notarized sketches, or any other mechanism demonstrating that her design predated the knockoff. The designer would also need to show that both her original garment and the knockoff were available for sale in the state in question at the same time. The designer would then have to show that her design was misappropriated.

One of the simplest ways to avoid preemption is to ensure that the cause of action contains elements “that are different in kind from copyright infringement”²⁰⁷—or “extra elements.”²⁰⁸ The extra elements in a “hot news” misappropriation claim can serve as a model for a state law

201. Ruth La Ferla, Preserving New York as a Fashion Capital, *N.Y. Times: On the Runway* (Nov. 2, 2010, 5:20 PM), <http://runway.blogs.nytimes.com/2010/11/02/preserving-new-york-as-a-fashion-capital/> (on file with the *Columbia Law Review*).

202. Innovative Design Protection Act Reintroduced, Council of Fashion Designers of Am. (Sept. 12, 2012), <http://cfda.com/the-latest/innovative-design-protection-act-reintroduced> (on file with the *Columbia Law Review*).

203. See Brands/Media Kits, Condé Nast, <http://www.condenast.com/brands> (on file with the *Columbia Law Review*) (last visited Oct. 8, 2014) (displaying brands operated by media company Condé Nast, which is headquartered in New York City); *Harper’s Bazaar*, Hearst, <http://www.hearst.com/magazines/harpers-bazaar> (on file with the *Columbia Law Review*) (last visited Oct. 8, 2014) (noting *Harper’s Bazaar*, “world-renowned arbiter of fashion and good taste,” is headquartered in New York City).

204. Fashion, New Sch., <http://www.newschool.edu/parsons/fashion-school/> (on file with the *Columbia Law Review*) (last visited Oct. 8, 2014).

205. Noted FIT Alumni, Fashion Inst. of Tech., <http://www.fitnyc.edu/5002.asp> (on file with the *Columbia Law Review*) (last visited Oct. 8, 2014).

206. See Emling, *supra* note 200 (discussing world’s fashion capitals).

207. H.R. Rep. No. 94-1476, at 132 (1976).

208. See *supra* Part II.B.1 (discussing extra elements that enable claim to avoid preemption).

protecting works of fashion.²⁰⁹ The relevant extra elements are (1) time sensitivity, (2) free riding by the pirate, and (3) the threat to the existence of the original.²¹⁰

1. *Time Sensitivity*. — The first element, time sensitivity, also applies in the fashion context. Like the facts that make up a news article, garments are not copyrightable subject matter,²¹¹ but garments are (like the news) time sensitive in their own way. In addition to the seasonal approach to fashion and the fact that it is a constantly refreshing medium, knockoffs are particularly problematic because they often appear in stores before the originals. For instance, Forever 21 recently was able to manufacture and ship to its stores a T-shirt resembling a look that acclaimed American fashion designer Alexander Wang introduced on the runway only fifteen days earlier.²¹² Tom Ford, another established American fashion designer, described the futility of designing clothing only to have someone produce a knockoff almost instantaneously: “[A]ll of the fast-fashion companies that do a great job, by the way, knock everything off. So it’s everywhere all over the streets in three months and by the time you get it to the store, what’s the point?”²¹³ Anna Sui, an American designer who has sued Forever 21 for copying twenty-six of her designs, expressed a similar sentiment: “For me, this is not simply about copying The issue is also timing These copies are hitting the market before the original versions do.”²¹⁴

Oscar Wilde once famously quipped that “fashion is merely a form of ugliness so absolutely unbearable that we have to alter it every six

209. See *supra* Part II.B.2 (discussing “hot news” misappropriation claim).

210. *NBA v. Motorola, Inc.*, 105 F.3d 841, 853 (2d Cir. 1997).

211. See *supra* Part II.A (discussing whether garments fall under umbrella of copyrightable subject matter).

212. See Kenzie Bryant, Forever 21 Made an Alex Wang ‘Parental Advisory’ Knock-Off, Racked (Sept. 23, 2013), <http://racked.com/archives/2013/09/23/forever21-already-made-that-alexander-wangs-parental-advisory-knockoff.php> (on file with the *Columbia Law Review*) (depicting Forever 21 T-shirt and Alexander Wang sweatshirt, both with “Parental Advisory” logo). The “Parental Advisory” designs by Alexander Wang walked the runway as part of his Spring 2014 Ready-to-Wear Collection at New York Fashion Week in early September 2013. See Look 15 of Alexander Wang Spring 2014 Ready-to-Wear, Style.com, <http://www.style.com/slideshows/fashion-shows/spring-2014-ready-to-wear/alexander-wang/collection/15> (on file with the *Columbia Law Review*) (last visited Oct. 8, 2014) (depicting model in “Parental Advisory” shirt); Look 16 of Alexander Wang Spring 2014 Ready-to-Wear, Style.com, <http://www.style.com/slideshows/fashion-shows/spring-2014-ready-to-wear/alexander-wang/collection/16> (on file with the *Columbia Law Review*) (last visited Oct. 8, 2014) (same).

213. Bridget Foley, Tom Ford Disses Fashion World’s Cult of Immediacy, Women’s Wear Daily (Sept. 14, 2010), <http://www.wwd.com/fashion-news/fashion-features/tom-ford-disses-fashion-worlds-cult-of-immediacy-3267063> (on file with the *Columbia Law Review*).

214. Eric Wilson, Fashion Industry Grapples with Designer Knockoffs, N.Y. Times (Sept. 4, 2007), <http://www.nytimes.com/2007/09/04/business/worldbusiness/04iht-fashion.1.7373169.html> (on file with the *Columbia Law Review*).

months.”²¹⁵ Given the nature of the fashion industry, garments are essentially perishable items. The first element of the claim would require the designer to make some kind of showing that the value of the article is highly time sensitive. This could involve providing information regarding the average lifespan of such a garment before it becomes outdated. The designer could also show the difference between how long it will take the original and knockoff to be manufactured and shipped to stores. If, as is often the case,²¹⁶ it is likely the knockoff will hit stores first, this evidence could be sufficient to show the knockoff “scoops” the original, thereby damaging its value in the market. Ultimately, given the garment’s short lifespan in a fast-paced industry and the pirates’ ability to get clothes into stores at a rapid speed, the designer should show that her ability to recoup her investment in creating the original is jeopardized.

2. *Free Riding by the Pirate.* — The second element of the claim under a state law would be free riding,²¹⁷ a key concern of the fashion industry; it is not just the copying that is troubling, but also the fact that pirates are able to appropriate a design without the requisite creativity, time, energy, and expense. Narciso Rodriguez, the American designer responsible for Carolyn Bessette-Kennedy’s minimalistic wedding gown,²¹⁸ once maintained that design pirates could make more from copying and mass producing just one of his designs than he could earn from his entire collection.²¹⁹ In fact, Rodriguez was only able to sell forty copies of the Bessette-Kennedy wedding gowns. Copycats sold millions.²²⁰ “Some may say that I benefited from the publicity,” Rodriguez said of this copying, but “publicity with no sales does not pay the bills.”²²¹ This is the same

215. Oscar Wilde, *The Philosophy of Dress*, N.Y. Daily Trib., Apr. 19, 1885, at 9.

216. Manufacturers are increasingly able to get clothes into stores at dizzying speeds. Zara is able to design, manufacture, and ship new items to its stores across the globe in just two weeks; H&M sends new items to stores within eight weeks; and Forever 21 has new items in stores within six weeks. Elizabeth L. Cline, *Overdressed: The Shockingly High Cost of Cheap Fashion* 98–99 (2013); see also supra note 212 and accompanying text (describing Forever 21’s Alexander Wang knockoff, which hit stores just fifteen days after it appeared on runway).

217. A free rider is someone who appropriates the plaintiff’s product without the requisite “costly efforts” to develop it himself, thus allowing him “to produce a directly competitive product for less money because [he] has lower costs.” *NBA v. Motorola, Inc.*, 105 F.3d 841, 852, 854 (2d Cir. 1997).

218. *The Best Dressed Celebrity Brides of All Time*, InStyle, http://www.instyle.com/instyle/package/general/photos/0,,20464370_20403733_20813890,00.html (on file with the *Columbia Law Review*) (last visited Oct. 13, 2014) (depicting Carolyn Bessette-Kennedy’s wedding gown).

219. *Design Law—Are Special Provisions Needed to Protect Unique Industries?*: Hearing Before the Subcomm. on Courts, the Internet & Intellectual Prop. of the H. Comm. on the Judiciary, 110th Cong. 22 (2008) (statement of Narciso Rodriguez, fashion designer).

220. *Id.*

221. *Id.* at 26. And, according to Rodriguez, the bills are high:

concern at issue in *INS*: The pirate will swoop in “precisely at the point where the profit is to be reaped . . . with special advantage to [him] in the competition because of the fact that [he] is not burdened with any part of the expense.”²²²

The analysis for this second element is most similar to copyright’s substantial-similarity analysis for infringement. Here, the designer would need to show that the designs are so similar that the pirate’s burden in creating the garment was substantially reduced. In other words, the designer would have to show that the pirate did not have to put in the creativity, time, energy, and expense involved in creating an original garment because he merely copied her design. Therefore, the pirate obtained an economic benefit at the designer’s expense without bearing any of the burdens.²²³

3. *The Threat to the Existence of the Original.* — The third element of the claim would require the designer to show that the knockoff threatens the existence of the original. In addition to the timing issues,²²⁴ mass-copying can also make the original item less unique. Why spend money

To design and fabricate my 250 piece collection it takes six to twelve months. The fall and spring runway shows cost on average \$800,000 to stage. The fabric another \$800,000, the work room that develops the patterns and garments another \$1,500,000. The travel budget for design and fabric development is \$350,000 and marketing is another \$2,500,000[.] There are so many aspects of a fashion business that make it risky in the best of circumstances, and the pirates are only making it riskier.

Id. at 25.

222. *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 240 (1918).

223. The Second Circuit took a narrower approach to the “free-riding” element in *Barclays Capital Inc. v. Theflyonthewall.com, Inc.*, 650 F.3d 876 (2d Cir. 2011). There, the court found the plaintiffs’ “hot news” claim preempted by federal copyright. *Id.* at 902 (“[T]he Firms’ claim for ‘hot news’ misappropriation fails because it is preempted by the Copyright Act.”). The court noted that the defendant was not free riding because the plaintiffs were attempting to protect something they *created* as opposed to *acquired*. *Id.* at 903 (“[T]he Firms seek only to protect their Recommendations, something they *create* using their expertise and experience rather than *acquire* through efforts akin to reporting.”). Furthermore, the defendant was not selling the information as its own. In actuality, it was the defendant’s accurate attribution to the plaintiffs that gave the information its value. *Id.* In *Barclays*, the court found that the profit was not even being diverted to the defendant. *Id.* at 904 (“[I]t is not at all clear that *that* profit is being in any substantial sense ‘diverted’ to Fly by its publication of Recommendations news. The lost commissions are . . . diverted to whatever broker happens to execute a trade placed by the recipient of news of the Recommendation from Fly.”). Though one could make the “creating” versus “acquiring” distinction with respect to fashion designers, since they “create” their garments as opposed to culling them from other sources, the other two factors the Second Circuit pointed to are certainly relevant in the context of the fashion industry. In the typical case, the pirate is selling the appropriated designs as his own and is not attributing the design to the original designer. Furthermore, the pirate is absolutely the one to whom the profits are diverted.

224. See *supra* notes 212–214 and accompanying text (discussing problem of knockoff hitting market before original).

on the real thing when people might just assume it was mass-produced and purchased for under \$20 at a fast-fashion chain? Knockoffs can thus hurt designers in two ways. First, a low-priced knockoff may lure some buyers to purchase the knockoff in place of the original if the buyer just wants the look and not necessarily the quality or originality.²²⁵ In this way, design piracy tends to hurt emerging and mid-range designers—who may be closer to the fast-fashion price point—the most. In fact, these designers bring the majority of litigation against stores like Forever 21.²²⁶ Second, the knockoff may dissuade a buyer from purchasing the original, out of fear of being perceived as someone who would purchase low-quality, mass-produced items at fast-fashion stores. This has been referred to, somewhat unkindly, as the “snob effect.”²²⁷

The threat to the original garment’s existence could be shown in a few different ways. The first and most obvious way would be to show that the pirate’s ability to undercut the price of the original makes the knockoff a substitute for the original. The designer would show the pirate’s ability to save money by mass-producing and cutting corners in terms of craftsmanship, material quality, and labor costs, and that such working conditions enabled the pirate to sell a knockoff at a lower price that would lure in potential purchasers of the original. The original designer could also make an argument similar to a trademark-tarnishment claim. A trademark is tarnished when it is

linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner’s product. In such situations, the trademark’s reputation and commercial value might be dimin-

225. See Hemphill & Suk, *supra* note 14, at 1175–76 (“Moreover, for a midrange designer . . . , the sales of the copy substitute for and hence reduce sales of the original Sometimes the substitution is made by an aggressive retailer, rather than the final consumer. Either way, the profits of the original designer can be much reduced.” (footnotes omitted)).

226. *Id.* at 1176 (“[Midrange designers] . . . bring most of the lawsuits that attempt to circumvent the lack of design protection by alleging copyright or trade dress violations under existing law, against Forever 21 and other fast-fashion copyists.”).

227. See *id.* (“In addition to replacing sales, the prevalence of cheaper copies also may reduce demand for the original design. This ‘snob’ effect may reflect a consumer’s desire for distinction from lower-status consumers or from other consumers more generally.” (citation omitted)); cf. Simon Doonan, *How Snooki Got Her Gucci: The Dirt on Purses*, N.Y. Observer (Aug. 17, 2010, 9:55 PM), <http://observer.com/2010/08/how-snooki-got-her-gucci-the-dirt-on-purses/> (on file with the *Columbia Law Review*) (describing how fashion houses sent Snooki their competitors’ bags as form of “preemptive product placement” or “unbranding”); Elizabeth Holmes, *Abercrombie and Fitch Offers to Pay “The Situation” to Stop Wearing Its Clothes*, Wall St. J.: Speakeasy (Aug. 16, 2011, 7:31 PM), <http://blogs.wsj.com/speakeasy/2011/08/16/abercrombie-and-fitch-offer-to-pay-the-situation-to-stop-wearing-their-clothes/> (on file with the *Columbia Law Review*) (quoting Abercrombie & Fitch statement offering to pay “The Situation” to stop wearing its clothes as saying, “We understand that the show is for entertainment purposes, but believe this association is contrary to the aspirational nature of our brand, and may be distressing to many of our fans”).

ished because the public will associate the lack of quality or lack of prestige in the defendant's goods with the plaintiff's unrelated goods, or because the defendant's use reduces the trademark's reputation and standing in the eyes of consumers as a wholesome identifier of the owner's products or services.²²⁸

In explaining trademark tarnishment, Judge Posner gave the example of a "striptease joint" that named itself "Tiffany" and explained that, "because of the inveterate tendency of the human mind to proceed by association, every time [consumers] think of the word 'Tiffany' their image of the fancy jewelry store will be tarnished by the association of the word with the strip joint."²²⁹ The designer could argue the existence of the knockoff "tarnishes" the original by diminishing its uniqueness and cachet and altering perceptions of its quality and high-end nature. Therefore, the designer could argue the knockoff serves as a substitute for the original, or it could argue the knockoff tarnishes the original, or both. It may be appropriate for the designer to use consumer surveys or expert opinion to make this point.

Importantly, legislators should ensure the term of protection provided by the law is not too lengthy. Due to the fast-paced nature of the fashion industry, garment designs only stay relevant for a limited time. A maximum term of protection of two years would cover the time necessary to design, manufacture, ship, and sell a garment. During this time, the law would preclude pirates from creating a knockoff.

C. Possible Objections to a State Law

1. *Did Congress Intend to Leave Fashion in the Public Domain?* — The term "public domain" refers to the "universe of inventions and creative works that are not protected by intellectual-property rights and are therefore available for anyone to use without charge," including works whose intellectual-property rights have expired.²³⁰ In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, the Supreme Court struck down a Florida statute under the Supremacy Clause.²³¹ The statute precluded the reverse engineering of boat-hull designs that were in the public domain.²³² The Court stressed the impropriety of allowing states to protect works in the public domain and made clear that such state action "impermissibly contravenes the ultimate goal of public disclosure and use which is the centerpiece of federal patent policy."²³³

228. *Deere & Co. v. MTD Prods.*, 41 F.3d 39, 43 (2d Cir. 1994) (footnote omitted).

229. *Ty Inc. v. Perryman*, 306 F.3d 509, 511 (7th Cir. 2002).

230. *Black's Law Dictionary* 1349 (9th ed. 2009).

231. 489 U.S. 141, 168 (1989).

232. *Id.* at 160 ("In essence, the Florida law prohibits the entire public from engaging in a form of reverse engineering of a product in the public domain.").

233. *Id.* at 156–57.

“It may be unfortunate—it may indeed be unjust—that the law should not thereafter distinguish between ‘originals’ and copies,” the Second Circuit noted of garment designs over seven decades ago, “but until the Copyright Office can be induced to register such designs as copyrightable under the existing statute, they both fall into the public demesne without reserve.”²³⁴ This raises the question of whether Congress intentionally left works of fashion in the public domain. Trademark and trade dress²³⁵ can provide some protection to handbags²³⁶ and shoes.²³⁷ Design patents are also an option for works of fashion,²³⁸ but tend to be cost prohibitive when it comes to patenting an entire collection’s worth of garments.²³⁹ Most importantly, design patents are often not worthwhile for garments since it can take eight to twenty months for the patent to issue.²⁴⁰ By the time the designer actually has the patent in hand, the garments likely will be, at best, on sales racks. Design patents are thus a better option for accessories and staples of a particular designer that will be produced season after season. Given the ability to gain piecemeal protection through the other intellectual-property regimes, it is unlikely that Congress intended for works of fashion to remain in the public domain.

234. *Fashion Originators Guild of Am. v. FTC*, 114 F.2d 80, 84 (2d Cir. 1940).

235. See *supra* note 13 and accompanying text (noting literature on use of existing intellectual-property regimes to protect works of fashion).

236. See *Gucci Am., Inc. v. Guess?, Inc.*, 868 F. Supp. 2d 207, 255 (S.D.N.Y. 2012) (finding handbags produced by Guess infringed and diluted Gucci’s trademarks).

237. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 228 (2d Cir. 2012) (holding Christian Louboutin’s signature red sole had acquired secondary meaning and was thus valid and enforceable trademark).

238. For discussions of the use of design patents in the fashion industry, see, e.g., Ferrill & Tanhehco, *supra* note 13 (suggesting design patents to combat threat of knockoff goods, as well as strategies for their implementation); Scott D. Locke, *Fifth Avenue and the Patent Lawyer: Strategies for Using Design Patents to Increase the Value of Fashion and Luxury Goods Companies*, 5 *J. Marshall Rev. Intell. Prop. L.* 40 (2005) (providing overview of design patents’ benefits, drawbacks, and practical considerations); Erin Geiger Smith, *Fashion Designers Look to Patents to Fight Knockoffs*, *Reuters* (Sept. 12, 2013, 7:32 AM), <http://www.reuters.com/article/2013/09/12/us-usa-fashion-newyork-patents-idUSBRE98B0H420130912> (on file with the *Columbia Law Review*) (noting increase in design patents in fashion industry and selective application of patents based on expected lifespan of design).

239. Acquiring a design patent can cost upward of \$2,000, which can quickly add up considering the number of garments that goes into a runway collection. See *Fashion Law: A Guide for Designers, Fashion Executives and Attorneys* § 2.2.4.7, at 62 (Guillermo C. Jimenez & Barbara Kolsun eds., 2010) (“The legal fees to prepare and file a design patent application are \$1,500 to \$2,000, plus a PTO fee of \$230 Additional communication with the PTO Examiner, if needed, can run \$500 to \$1,000. Paying the final issue fee, including PTO fee, will usually cost around \$800.”).

240. *Id.* § 2.2.4.3, at 61; see also *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 190 (S.D.N.Y. 1934) (noting patent law permits protection of garment designs “but as a practical matter in many instances this fails to give the needed protection, for designs and patterns usually are short-lived and with the conditions and time incidental to obtaining the patent, this protection comes too late, if at all”).

2. *Does Fashion Make Sense as Copyrightable Subject Matter?* — It is also arguable whether it would make sense to consider works of fashion copyrightable subject matter. The owner of a valid copyright has a monopoly over his work for the duration of his life plus seventy years²⁴¹ and can use it to prevent others from infringing upon any of federal copyright's five exclusive rights: reproduction, preparation of derivative works, distribution, performance, and display.²⁴² Given the transient and fast-paced nature of the fashion industry, this degree of protection is excessive. There is simply no reason to protect garment designs for upward of seventy years when the vast majority will be out of commission within a matter of months. While it is conceivable that a book, movie, or song will be sold for decades, this just is not the case for garment designs, and it is difficult to come up with an example of a garment that is produced and sold for more than a season. Just as in *INS*, the purpose of protection should be to allow designers to reap the rewards of their creativity “until its commercial value . . . has passed away”²⁴³—and not a day more. The sheer extent of protection provided by the federal copyright regime makes it seem unlikely that Congress would have believed works of fashion would qualify as copyrightable subject matter.

CONCLUSION

Despite the plethora of literature devoted to intellectual-property protection for the fashion industry,²⁴⁴ the question of state-level legislation has gone largely unexplored, presumably due to assumptions that such laws would be preempted by federal copyright. However, it is possible for a state law that speaks to garment designs to pass both prongs of the copyright-preemption test. Since garment designs resoundingly fail the versions of conceptual separability set out by the courts, garment designs simply do not qualify as copyrightable subject matter. Furthermore, it is possible to craft a law in such a way that it does not impede upon the exclusive rights provided by federal copyright. Thus, a state law that protects garment designs could very well avoid copyright preemption.

Though it is possible that a state law would not successfully deter knockoffs, if multiple states passed such legislation, it could, in the collective, sufficiently dissuade pirates from appropriating the designs of

241. See 17 U.S.C. § 302(a) (2012) (“Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and 70 years after the author’s death.”).

242. See 17 U.S.C. § 106 (describing exclusive rights provided by federal copyright).

243. *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 245 (1918) (internal quotation marks omitted).

244. See *supra* notes 13–14 and accompanying text (noting previous commentary on fashion industry and intellectual-property protection).

others. A state law, or a group of similar state laws, could also compel design pirates to comply with the laws' terms rather than develop different business practices for different states. Though a statute at the federal level would be ideal, a state law could still provide some relief for designers who have been attempting to secure protection for decades.²⁴⁵ Finally, a state law would further the states' purpose as "laboratories of democracy."²⁴⁶ If successful, such a law could convince Congress that it is time to take action and protect the fashion industry from design piracy.

245. See *Fashion Originators' Guild of Am. v. FTC*, 312 U.S. 457, 461, 464 (1941) (holding trade agreement among fashion designers to refuse to sell garments to retailers who also sold knockoffs to be unfair method of competition).

246. See *New State Ice Co. v. Liebmann*, 285 U.S. 262, 311 (1932) (Brandeis, J., dissenting) ("It is one of the happy incidents of the federal system that a single courageous State may, if its citizens choose, serve as a laboratory; and try novel social and economic experiments without risk to the rest of the country.").

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