# ANNE KEARNS LAW PRESENTS

# COPYRIGHTS IN THE FASHION BUSINESS… IT ALL DEPENDS

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# OUTLINE

- ☐ **COPYRIGHT PROTECTION**
  - Original works of authorship[1]
    - *e.g.,* books, movies, pictures, graphics, sculptures
  - Requirements:
    - Original[2]
      - Minimally creative, and
      - Created independently
    - Fixed in tangible medium[3]
  - Exclusive Rights to exploit work:[4]
    - Copy
    - Distribute
    - Perform
    - Display
    - Make derivative works
  - Registration
    - Not required - protection begins automatically when fixed[5]
    - Required - to bring lawsuit [6]
    - Required - for additional damages (attorney's fees, statutory damages)[7]
  - Notice
    - Not required - but recommended[8]
    - Info for notice: © [year] by [name of owner][9]
      - Can also use the word "Copyright or "Copr." in place of ©
- ☐ **COPYRIGHT DOES NOT PROTECT**
  - Ideas, methods & concepts[10]
  - Single words, titles, short phrases[11]
  - Familiar symbols, typeface, lettering, listing of ingredients or content[12]
  - Blank forms and works consisting of commonly known facts (tape measures)[13]
  - Useful articles - purpose is functional[14]
- ☐ **CLOTHING IS A USEFUL ARTICLE AND NOT COPYRIGHTABLE**
  - Clothing (design) is a useful article[15]

- It is functional – meant to warm and cover body[16]
  - *e.g.,* pants, skirts, dresses, shirts, coats, costumes
- Refers to shape, style, cut, dimensions of garment[17]
- Examples:[18]
  - Neckline & collar
  - Sleeve type
  - Skirt type
  - Trouser cut
  - Seam type
  - Waistband
  - Buttons
  - Pockets
- There are some exceptions – jewelry, costume masks (see below)

☐ **FEATURES OF CLOTHING MAY BE COPYRIGHTABLE UNDER SEPARABILITY TEST**

- Features of clothing are capable of copyright protection if:[19]
  - They can be perceived separately from the clothing, and
  - They could otherwise qualify as a protectable artistic work – such as a two or three dimensional work (like a painting or a sculpture)
- Examples of features that may be protectable if requirements met:
  - Surface designs (*e.g.,* chevrons on cheerleading uniforms)[20]
  - Fabric print:[21]
    - *e.g.,* on clothing, shoes, purses
  - Appliques and embroidery[22]
    - *e.g.,* leaves on sweaters; embroidery on jeans
  - Decorative elements of belt buckles and bands[23]
  - Decorative elements of watches[24]
  - Artistic elements of costumes[25]
  - Color combination[26]
- Some clothing items are not considered useful articles
  - Separability test not used
  - Must still meet requirements of originality
  - Examples:
    - Jewelry[27]
    - Masks (costume)[28]

**ENDNOTES**

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[1] 17 USC §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.

[2] *Feist Publications, Inc. v. Rural Telephone Service Co., Inc*., 499 U.S. 340, 345 (1991) (holding that "[o]riginal, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.") (citation omitted).

[3] 17 USC § 102(a); *see also* 17 USC §101:

> A work is "created" when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.

[4] 17 USC § 106.

[5] 17 USC § 102(a); 17 USC § 408(a).

[6] 17 USC § 411.

[7] 17 USC § 412(2). To be timely, registration must occur either before the infringing activity or within 3 months of publication. *Derek Andrew, Inc. v. Poof Apparel Corp*., 528 F.3d 696, 699 (9th Cir. 2008).

[8] 17 USC § 401(a).

[9] 17 USC § 401(b).

[10] 17 USC § 102(b); 37 C.F.R. 202.1(b).

[11] 37 C.F.R. § 202.1(a).

[12] 37 C.F.R. §§ 202.1(a), (e).

[13] 37 C.F.R. §§ 202.1(c), (d).

[14] 17 USC § 101 (italics added):

> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. *Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned. . . .*
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> 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. An article that is normally a part of a useful article is considered a "useful article."

[15] "As a general rule, items of clothing are not entitled to copyright protection. [Citations]. This is because items of clothing are generally considered useful articles, and useful articles are not entitled to protection under the Copyright Act. [Citation]. . . ." *Express, LLC v. Fetish Grp., Inc.*, 424 F. Supp. 2d 1211, 1224 (C.D. Cal. 2006).

[16] "[I]t is impossible either physically or conceptually to separate a 'dress design,'. . . from the utilitarian aspects of clothing, i.e., to cover, protect, and warm the body." *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 492 (6th Cir. 2015), *cert. granted in part sub nom. Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 136 S. Ct. 1823 (2016), and *aff'd sub nom. Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (hereinafter "*Varsity I*") (citation omitted).

[17] "[A] 'dress design'. . . 'graphically sets forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment. . . .'" *Id.* (citation omitted).

[18] As summarized in *Varsity I*, at 492-93:

> The shapes of the neckline (v-neck, square-neck, crew-neck), sleeves (short, long, puffy), skirt shape (a-line, pencil, midi, maxi), trouser cut (pleated, plain-front, cuffed), or pockets (patch, welt, jetted)—these are the components of a design that are inextricably connected with the utilitarian aspects of clothing: pockets store pencils or pens; pants and skirts cover the legs; shirts cover the torso modestly or less modestly depending on the neckline. The designs of these components of an article of clothing "can[not] be identified separately from, [or be] capable of existing independently of, the utilitarian aspects of the article [of clothing]." [Citation].
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> [T]he creative arrangement of sequins, beads, ribbon, and tulle, which form the bust, waistband of a dress, do not qualify for copyright protection because each of these elements (bust, waistband, and skirt) all serve to clothe the body. [Citation]. And a collection of uniforms, which includes chef hats shaped like vegetables, tuxedo jackets with a "distinctive shawl collar styling with a deep V neckline," and semi-fitted jackets with princess seams and star buttons, does not receive copyright protection. [Citation]. Creative and arguably attractive as these articles may be, they are merely inventive designs used to cover the wearer's body and hair. Thus, the design of these hats and jackets (useful articles) "can[not] be identified separately from," and are not "capable of existing independently of, the utilitarian aspects of" a hat or a jacket. [Citation].

[19] The U.S. Copyright Act states that "the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design

incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 USC §101.

Courts have grappled with whether the feature must be capable of being physically or conceptually separated **while leaving the original article in tact**. *See Pivot Point Int'l Inc. v Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004) (collecting cases discussing different applications of test). In 2017, the U.S. Supreme Court rejected the view that the article must remain in tact after separation and "abandoned the distinction between 'physical' and 'conceptual' separability":

> But the statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one. . . . The statute does not require that we imagine a nonartistic replacement for the removed feature to determine whether that *feature* is capable of an independent existence.
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> Because we reject the view that a useful article must remain after the artistic feature has been imaginatively separated from the article, we necessarily abandon the distinction between "physical" and "conceptual" separability, which some courts and commentators have adopted based on the Copyright Act's legislative history. . . .
>
> The statutory text indicates that separability is a conceptual undertaking. Because separability does not require the underlying useful article to remain, the physical-conceptual distinction is unnecessary.

*Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1013–14 (2017). The Court then clarified the separability test as follows:

> [A] feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.

*Id.* at 1007.

[20] *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. at 1112:

> Applying this test to the surface decorations on the cheerleading uniforms is straightforward. First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium—for example, on a painter's canvas—they would qualify as "two-dimensional ... works of ... art," § 101. And imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the

> uniform itself. Indeed, respondents have applied the designs in this case to other media of expression—different types of clothing—without replicating the uniform. [Citation]. The decorations are therefore separable from the uniforms and eligible for copyright protection.

[21] "The Copyright Act protects fabric designs, but not dress designs." *Varsity I*, at 492 (citing to *Knitwaves, Inc. v. Lollytogs Ltd.,* 71 F.3d 996, 1002 (2d Cir.1995); *Folio Impressions, Inc. v. Byer Cal.,* 937 F.2d 759, 763 (2d Cir.1991)). *See also* Registrability of Costume Designs, 56 FR 56530-02 (1991):

> A two-dimensional design applied to the surface of the clothing may be registered, but this claim to copyright is generally made by the fabric producer rather than the garment or costume designer. Moreover, this claim to copyright is ordinarily made when the two-dimensional design is applied to the textile fabric and before the garment is cut from the fabric.

*See also* Compendium of U.S. Copyright Office Practices, Third Edition ("Compendium"), 924.3(A)(1) Fabric and Textile Designs Embodied in Clothing or Other Useful Articles:

> Although the copyright law does not protect the shape or design of clothing, and although fabric and textiles have useful functions (e.g., providing varying degrees of warmth and protection), designs imprinted in or on fabric are considered conceptually separable from the utilitarian aspects of garments, linens, furniture, or other useful articles. Therefore, a fabric or textile design may be registered if the design contains a sufficient amount of creative expression.

[22] *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996, 999 (2d Cir. 1995) (Designers may obtain valid copyrights for "a multicolored striped sweater with puffy leaf appliques. . . ."); *Sweet People Apparel, Inc. v. Cool-G, Inc.,* 2014 WL 12596316, at *1 (C.D. Cal. Feb. 14, 2014) (copyrights for stitching and embroidery on denim products).

[23] *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993-94 (2d Cir. 1980) (finding that decorative art on belt buckle was a conceptually separable sculptural element, akin to jewelry, and thus, copyrightable).

[24] In *Severin Montres Ltd. v. Yidah Watch Co.,* 997 F. Supp. 1262, 1265 (C.D.Cal.1997) the court held that the features of a Gucci watch were copyrightable: "The rectangular frame of the [watch] which forms a three-dimensional letter "G" and the bracelet and clasp arrangement are the features that combine to give the [watch] its unique appearance. The frame around the face which forms the letter "G" in particular makes the [watch] unique and represents artistic design separable from the utilitarian aspects of the watch."

[25] "Costumes will be treated as useful articles, and will be registrable only upon a finding of separable artistic authorship." Registrability of Costume Designs, 56 FR 56530-02 (1991).

[26] "Color by itself is not subject to copyright protection. [Citation]. Nevertheless, '[a]n original combination or arrangement of colors should be regarded as an artistic creation capable of copyright protection.'" *Boisson v. Banian, Ltd*, 273 F.3d 262, 271 (2d Cir. 2001)

(citation omitted); *see also* Compendium, 313.4(K), Mere Variations of Coloring: "Color is one of the basic building blocks for pictorial, graphic, and sculptural works. The U.S. Copyright Office may register an original combination or arrangement of colors if it results in a pictorial, graphic, or sculptural work that qualifies as an original work of authorship."

[27] "There is no doubt that artistic jewelry is copyrightable." *Ronald Litoff, Ltd. v. Am. Exp. Co.*, 621 F. Supp. 981, 984 (S.D.N.Y. 1985). "Jewelry designs are typically protected under the U.S. copyright law as sculptural works, although in rare cases they may be protected as pictorial works." Compendium, 908 Jewelry; *see also* Compendium, 908.2 Copyrightable Authorship in Jewelry:

> The U.S. Copyright Office may register jewelry designs if they are sufficiently creative or expressive. The Office will not register pieces that, as a whole, do not satisfy this requirement, such as mere variations on a common or standardized design or familiar symbol, designs made up of only commonplace design elements arranged in a common or obvious manner, or any of the mechanical or utilitarian aspects of the jewelry. Common *de minimum* designs include solitaire rings, simple diamond stud earrings, plain bangle bracelets, simple hoop earrings, among other commonly used designs, settings, and gemstone cuts.

[28] "Under the adopted practices, masks will be registrable on the basis of pictorial and/or sculptural authorship." Registrability of Costume Designs, 56 FR 56530-02 (1991).