



Fashion and Garment Law: Intellectual Property Protection

A fashion or garment company introduces new creation in September and a few weeks later a cheaper “knock-off” appears in stores. The fashion or garment company would have to wonder what means are available to them to prevent knock-offs and counterfeiters.

This article will look at intellectual property law, customs law and other available protective means for fashion or garment companies. As the Design Piracy Prohibition Act proposed by the US Congress in 2008 did not pass and is unlikely to pass in the near future, one needs to utilize every available methods within existing legal framework to protect its work product.

COPYRIGHT

Copyright protection is generally not available to a clothing designer for the garment itself, but is available for a print/or design pattern and the two-dimensional sketch. This is because clothing itself is considered useful articles, and copyright will only apply when the article’s expressive design component is separable from its useful function. Since clothing is considered a useful article, a court will generally take the view that a garment’s expressive component cannot be separated either physically or conceptually.

A fashion designer seeking copyright protection from a knock-off designer must convince a judge that either the item of clothing is not functional or that its artistic design is separable from its utilitarian purpose. A court is unlikely to view the garment itself as not being utilitarian. However, courts will give copyright protection to the design pattern itself and/or the two-dimensional sketch, since they are considered pictorial works.

A distinction should be drawn between a garment and fashion accessories such as a piece of jewelry, since jewelry is generally considered to be non-utilitarian, and therefore eligible for copyright protection as pictorial and/or sculptural work.

PATENT

Generally, Patent protection is not available as a means of protection for garment designers.

Why? Garments are usually not eligible to be granted a patent. A patent is granted for a new and useful process, machine, manufacture, or composition of matter and it must advance the prior art in a way that is non-obvious. A design in fashion is generally not considered a process, machine, manufacture or a composition of matters. Occasionally a design patent will be granted to a designer to protect the appearance of a fabric, garment, handbag, eyeglasses, etc. For example, Burberry has a design patent for its trench coat.

Even if courts allow a fashion design to be patented, the amount of time it takes to acquire a patent makes this process impractical for most designers. A United States Patent and Trademark Office application can take years to review and only about half of them are granted a patent and by then the garment would most likely be out-of-season.

In some cases, pursuing a utility patent may make sense for a designer. For example, if they had invented a new fabric such as Goretex® or created a new technology, such as method for dyeing garments.

TRADE-DRESS AND TRADEMARK

Since the Design Piracy Prohibition Act that was proposed in 2008 did not pass, trademark and trade-dress law is the best legal means for a fashion designer to protect their design.

TRADEMARK

A trademark is any word, name, symbol, device, or combination thereof that is used by a merchant used to identify their goods and distinguish them from those manufactured and sold by other merchants. For example, Louis Vuitton's "LV" logo or Chanel's "Double C" logo are trademarks. Trademark protection in the United States is very strong and potentially infinite in length, as long as the mark is being used in commerce to designate the source of the goods.

The key to determining if another designer is infringing on a trademark is the likelihood that ordinary consumers in the marketplace would confuse the original trademark and the allegedly infringing trademark. For example, Adidas won a 305 million dollar judgment against Payless Shoes in 2008 for selling two and four stripe shoes that looked very similar to Adidas's three stripe shoes.

TRADE DRESS

Trade dress falls under the realm of trademark law, and refers to a product's overall appearance and the total image presented to consumers, either of the product itself or its packaging. This can encompass a product's packaging, store, website, etc. To prove that a knock-off has violated trade dress, a designer must prove their trade dress is

- (a) Nonfunctional;
- (b) Distinctive, and
- (c) Likely to be confused by consumers with the knock-off mark.

When evaluating whether trade dress protection is available a court will look at the totality of circumstances, including the context in which the product is displayed, how it is used in advertising, and the likelihood of confusion among consumers.

Signature elements of a brand may be protected under trade dress. For example, Burberry owns a registered trademark for a red, brown, grey, black, and white plaid pattern, which covers handbags and clothing.

HOW DOES A DESIGNER PICK THE RIGHT TRADEMARK/BRAND NAME?

A critical branding strategy should include consulting a qualified attorney before investing time, money, and energy into a marketing campaign.

Ideally a fashion designer will want to select a trademark that is coined, arbitrary, or suggestive and avoid marks that are considered descriptive or generic.

STRONG TRADEMARKS

A Coined Mark is the strongest. It is a made-up word, and the most likely to be accepted for registration with the USPTO. Examples: Kodak, Yahoo,

An Arbitrary Mark is close in strength behind coined mark. The brand name is a real word, but is unrelated to the product. Example: Camel Cigarettes.

A Suggestive Mark is not as strong as a coined or arbitrary mark, but is somewhat distinct from the actual product. However, with a little thought by the consumer, they can make the connection. Example: Coppertone Suntan Lotion

WEAK TRADEMARKS

A Descriptive Mark will offer some protection, but they are often difficult to register and more easily infringed upon. Example: Men's Wearhouse, Computer Magazine.

A Generic Mark will offer no protection and most likely will be rejected by the USPTO.

It is possible to own a trademark forever, but you have to continually use the mark in commerce to distinguish your goods and take active steps to protect your trademark from infringers and copycats. Otherwise, a trademark is deemed to be abandoned or inactive.

Registering your trademark with the federal government's United States Patent and Trademark Office (USPTO) is the first step in protecting your brand.

BENEFITS OF REGISTERING YOUR TRADEMARK WITH THE USPTO

It is easier to enforce your trademark rights by registering your mark with the USPTO and should be done by a qualified attorney who can go beyond searching the USPTO database and conduct a proper due diligence search to see if your mark is being used elsewhere. Some of the benefits of registering your trademark with the USPTO include:

- Provides prima facie evidence that you own the trademark
- Registering your trademark with the USPTO, puts would-be infringers on alert that a particular trademark is taken
- Obtaining registration with the USPTO can be used as a basis for registering your trademark in foreign countries
- Registration may be filed with U.S. Customs and Border Control to prevent importation of infringing foreign goods. (A designer should provide samples to help assist Customs)

PREVENT COUNTERFEITERS, ENFORCE YOUR TRADEMARK and PROTECT YOUR DESIGN

Preventing counterfeiters and enforcing your trademark takes a multi-pronged approach and may require working with your attorney and/or local authorities.

Ebay's VeRO program (Verified Rights Owner Program):

Ebay's VeRO program enables intellectual property rights owners to request the removal of listings that infringe upon copyrights and trademarks. In this process, a notice of claimed infringement (NOCI) is filed, requesting an item be removed from eBay. At that point, eBay immediately removes the item from their site and a black mark is attributed to the seller.

Enforcing Trademark Rights on 3rd Party Sellers:

Under the Lanham Act, a third party, such as a flea market or trade-show, that provides a safe harbor for counterfeit goods may be liable for any damages. By having your attorney send cease and desist letters, a designer can create enough trouble for the third party that they will often stop selling the goods. If necessary, a designer can take the third party seller to court. However, litigation is expensive and can take a long time to be resolved.

Real Property Laws:

In New York, once a landlord is put on notice that a tenant is engaged in illegal activity, such as selling counterfeit goods, a landlord may void the tenant's lease. If the landlord knowingly continues to harbor the counterfeiter, then the landlord may be liable severally and jointly with the occupants carrying out the illegal activity and be held responsible for damages.

Nuisance Abatement Laws:

Nuisance Abatement Laws are laws that deal with zoning issues, quality of life issues, and public nuisances. As long as designers are cooperative with the city's agencies, nuisance abatement laws can be very cost-effective solution to counterfeiters. For example, Mayor Bloomberg in New York City created the Office of Special Enforcement to help target counterfeiters.

Monitoring Manufacturing:

Organizations such as the –International Authentication Association (www.internationalauthenticationassociation.org) provide insights on how to monitor and track the producers of your clothing by using methods such as RFID tags, watermarks, etc. to track your garments.

Search Engine Infringement:

If a potential customer searches for your brand, and a competitor is using your trademark as a key word to advertise their goods, then they may be infringing on your mark by using your trademark in their advertisement. However, a designer should consult their attorney, because this is a grey area of the law, and the competitor maybe using your trademark in a fair manner, such as comparing your products to their products.

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