

THE DEVIL WEARS TRADEMARK: HOW THE FASHION INDUSTRY HAS EXPANDED TRADEMARK DOCTRINE TO ITS DETRIMENT

I. INTRODUCTION

Over the past decade, the uncertainty of fashion's status as protectable intellectual property has generated enormous controversy. It is no wonder: in 2011, apparel sales in the United States amounted to almost two hundred billion dollars;¹ handbag sales alone accounted for eight billion dollars that year and are continuing to balloon at ten percent annually.² This trend is also global. Fashion has become one of the largest and most dynamic industries in the world. Global fashion revenue totals one trillion dollars per year, representing four percent of global GDP.³ Unsurprisingly, then, the question of intellectual property protection for fashion design has commanded attention from designers, litigators, policymakers, and consumers. Nevertheless, growth in the industry's economic importance and in the ease of pirating fashion designs have both outpaced legal change.⁴

American fashion designers have largely failed to achieve protection for their designs through existing copyright and patent law and through lobbying for changes to those or other laws. Instead, as this Note argues, designers have turned their efforts to the courts, where their lawyers have co-opted trademark law as a tool for protecting designs that arguably would not have been entitled to protection under the traditional scope of trademark law or under any other intellectual property scheme in the United States. While much has been written on the expansion of trademark doctrine, little attention has been given to trademark law's increased protection of what this Note terms "quasi-designs" — patterns or shapes that walk the line between logos and designs. Such quasi-designs are nominally trademarkable logos but practically nontrademarkable designs — and perhaps functionally both. By highlighting some of the most influential cases in this arena, this Note exposes and analyzes the language in recent court opinions that signals

¹ *NPD Reports on the U.S. Apparel Market 2011: Results Show Marked Improvement over 2010*, NPD GROUP (Mar. 29, 2012), http://www.npd.com/wps/portal/npd/us/news/press-releases/pr_120329.

² Cotten Timberlake, *Coach Drops as Kors Grabs Handbag Customers in Slowdown: Retail*, BLOOMBERG (Aug. 1, 2012, 12:00 AM), <http://www.bloomberg.com/news/2012-08-01/coach-drops-as-kors-grabs-handbag-customers-in-slowdown-retail.html>.

³ Guillermo C. Jimenez, *Fashion Law: Overview of a New Legal Discipline*, in *FASHION LAW* 3, 6 (Guillermo C. Jimenez & Barbara Kolsun eds., 2010).

⁴ See Michael S. Mireles, Jr., *Towards Recognizing and Reconciling the Multiplicity of Values and Interests in Trademark Law*, 44 *IND. L. REV.* 427, 435–38 (2011) (noting that, while trademark protections have arguably expanded, other legal protections applicable to fashion have contracted).

judicial relaxation of the traditional conceptual scope of trademark law, such that trademarks are no longer strictly limited to logos and may instead be rooted in quasi-designs. Such decisions are effectively creating a loophole in the system whereby designers can receive *permanent* rights over quasi-designs that masquerade as logos.

This Note also argues, however, that the industry's efforts to co-opt trademark law lead largely to negative and even self-defeating results, such as a bias favoring large incumbent brands and the inducement of laziness in design. Specifically, designers have — perhaps predictably — shifted their design focus from innovation in the product itself to the generation of more prominent and elaborate iterations of the logos emblazoned on their products. Such a focus on logos may ultimately harm a brand's image as the market becomes oversaturated with exposure. Furthermore, society receives nothing in return for protecting these rights. Instead of allowing this creeping doctrinal expansion to continue, Congress should simply create *sui generis* legislation for the protection of fashion design, under either copyright or patent law.

This Note proceeds in four parts. Part II discusses why the fashion industry, for both practical and strategic reasons, has turned to trademark law as the means of protecting design. Part III shows, by highlighting and analyzing some of the most impactful trademark cases, how courts have gradually expanded trademark doctrine's reach to include quasi-designs. Part IV presents the largely negative implications of such expansion. Part V concludes with some thoughts on what form *sui generis* legislation for fashion design might take.

II. WHY THE FASHION INDUSTRY HAS RESORTED TO TRADEMARK LAW FOR PROTECTION OF DESIGNS

A. *Lack of Protection from Traditional Copyright and Patent Law Regimes*

U.S. copyright and patent regimes shun protection for fashion design. Though the United States is an outlier in this respect,⁵ its lack of copyright protection for fashion design is historical: U.S. law has long sought to draw a line between works of art, which are copyrightable, and “useful articles,” the utilitarian aspects of which are not copyrightable.⁶ Shirts, dresses, pants, footwear, and bags are all considered “useful articles.” On the other hand, “pictorial, graphic, or sculptural

⁵ Matthew S. Miller, *Piracy in Our Own Backyard: A Comparative Analysis of the Implications of Fashion Copying in the United States for the International Copyright Community*, 2 J. INT'L MEDIA & ENT. L. 133, 156 (2008).

⁶ See 17 U.S.C. § 101 (2012) (defining “useful articles” as “having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”).

works,” wherein the features of the design “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article,” may be protected.⁷ This distinction is termed the doctrine of conceptual separability, which — in jurisdictions that recognize the doctrine — allows for the protection of a design when the design can be conceptually separated from the object in which it is embodied.⁸ Under this doctrine then, a textile print of a dress or a unique flourish on the dress may be copyrightable, but the design of the dress is not. However, the difficulty of proving conceptual separability eliminates it as an effective venue for fashion design protection.⁹

More recently, Justice Breyer “dropped a puzzling clue”¹⁰ about design copyright in his majority opinion in *Kirtsaeng v. John Wiley & Sons, Inc.*,¹¹ hinting at a possible broadening of copyright doctrine to include fashion design. In listing three paradigmatic imported goods protected by copyright, the Court included: “a video game made in Japan, a film made in Germany, or a dress (with a design copyright) made in China.”¹² Scholars have noted that the inclusion of a dress on this list is “striking”¹³ and may portend the beginnings of the adoption of more liberal design copyright for fashion design, but it is still too early to tell.¹⁴ Until the Supreme Court has an opportunity to clarify Justice Breyer’s elusive pronouncement in *Kirtsaeng*, copyright law’s narrow and uncertain application render it a largely inoperative tool for intellectual property protection for fashion.

Neither can the fashion industry rely on patent law for protection. Patents — specifically design patents — protect “new, original, and ornamental design[s] for an article of manufacture,” and if granted, provide fifteen years of protection.¹⁵ Despite this promising language, there are structural and procedural reasons why design patents are not an effective means for protecting fashion and other short-lived new designs.

⁷ *Id.*

⁸ *See, e.g., Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 414–18 (2d Cir. 1985).

⁹ *See* ROBERT C. LIND, COPYRIGHT LAW 40 (3d ed. 2006) (noting the split of authority regarding the test of conceptual separability).

¹⁰ C. Scott Hemphill & Jeannie Suk, Reaction, *What “Design Copyright”?*, 126 HARV. L. REV. F. 164, 164 (2013).

¹¹ 133 S. Ct. 1351 (2013).

¹² *Id.* at 1360.

¹³ Hemphill & Suk, *supra* note 10, at 164.

¹⁴ *See id.* at 165–66.

¹⁵ 35 U.S.C. §§ 171, 173 (2006), amended by Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, sec. 102, § 173, sec. 202, § 171, 126 Stat. 1527, 1532, 1535–36. The term for a design patent was recently extended from fourteen to fifteen years. For an overview of the applicability of intellectual property to fashion designs, see Oliver Herzfeld, *Protecting Fashion Designs*, FORBES (Jan. 3, 2013, 9:14 AM), <http://www.forbes.com/sites/oliverherzfeld/2013/01/03/protecting-fashion-designs>.

First and foremost, a design patent, like any other patent, can only protect an invention that is both novel¹⁶ and nonobvious.¹⁷ Many, if not most, fashion designs would fail the novelty requirement because fashion designs are often derivative of one another¹⁸ or of a designer's previous works, rendering them unpatentable due to anticipation by prior art. Nonobviousness — which requires that nothing came before an invention that would have suggested to the creator how to make her design¹⁹ — is an even more subjective requirement than novelty and likely very difficult to apply in the fashion context. Second, because design patents protect designs, they fail to protect features dictated solely by function.²⁰ This limitation, then, casts doubt upon whether a design patent can ever cover features of clothing that must be present in order for the article to fit the human form.²¹ Third, patents are ineffective at protecting fashion design because of the logistical impracticality of obtaining them. The patent process is lengthy and costly and would often exceed the marketable duration of any individual fashion item.²² Plus, since patenting requires publication of the design, patenting may even aid copyists. Thus, unless the patent involves materials or technologies that are highly innovative and require significant research and development to create — such as those seen in the high-technology athletic fabrics and footwear of Under Armour or Lululemon²³ — the patent is likely not worth pursuing.

B. Failure to Effect Legislative Change

Stakeholders in the fashion industry have launched numerous efforts to gain protection from Congress,²⁴ but Congress has not yielded. Indeed, since 1914, over seventy bills intended either to protect designs through copyright law or to create a design-specific protection system

¹⁶ See 35 U.S.C. § 102 (2006 & Supp. V 2011), amended by Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, sec. 102, § 102(d)(2), 126 Stat. 1527, 1531.

¹⁷ See *id.* § 103.

¹⁸ See Brooke Olaussen, *Design Patents: Fashion's Next Big Thing?*, 4 INTELL. PROP. BRIEF 62, 62 (2012).

¹⁹ See *Graham v. John Deere Co.*, 383 U.S. 1, 11 (1966).

²⁰ See 35 U.S.C. § 171.

²¹ Susanna Monseau, *European Design Rights: A Model for the Protection of All Designers from Piracy*, 48 AM. BUS. L.J. 27, 43-44 (2011).

²² See *id.* at 42; Herzfeld, *supra* note 15. Before issuance, a patent application must be reviewed by the United States Patent and Trademark Office to determine if the product or design is eligible for protection, a process that historically has taken about two years, though new procedures have been put in place to reduce this period. See Monseau, *supra* note 21, at 42; Herzfeld, *supra* note 15.

²³ See Olaussen, *supra* note 18, at 62.

²⁴ See Meaghan McGurrin Ehrhard, Note, *Protecting the Seasonal Arts: Fashion Design, Copyright Law, and the Viability of the Innovative Design Protection & Piracy Prevention Act*, 45 CONN. L. REV. 285, 291 (2012).

have been introduced.²⁵ All have failed.²⁶ Congress has consistently rejected proposed bills to protect industrial designs, and on the whole it has seemed hostile to the idea of increasing protection. For example, Congress explicitly deleted the proposed Title II from the Copyright Act of 1976, a title that would have created “a new limited form of copyright protection for ‘original’ designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself.”²⁷ Similarly telling is the fact that even after the United States acceded to the Berne Convention,²⁸ which required the protection of applied art,²⁹ Congress did not create a law to cover industrial design.³⁰

Congress has refused to pass protective legislation primarily for fear of restraining competition or promoting litigiousness. Congress recognized “that to make such designs eligible for copyright would be to create a ‘new monopoly’ having obvious and significant anticompetitive effects.”³¹ For example, if shapes fell within such protection, the potential anticompetitive effects might include: first, monopolies over certain utilitarian objects where function mandates a certain shape, such as scissors or paper clips; second, monopolies over certain designs where consumers sometimes demand or expect uniformity of shape, such as a stove; and third, monopolies over basic geometric shapes, of which there are only a limited number.³² Furthermore, skeptics of fashion protection legislation point out that such laws might ultimately harm independent designers who do not have enough funds to effectively initiate or defend infringement challenges in court.³³

²⁵ Kevin V. Tu, *Counterfeit Fashion: The Interplay Between Copyright and Trademark Law in Original Fashion Designs and Designer Knockoffs*, 18 TEX. INTELL. PROP. L.J. 419, 429 (2010).

²⁶ *Id.*

²⁷ H.R. REP. NO. 94-1476, at 50 (1976); see also Safia A. Nurbhai, Note, *Style Piracy Revisited*, 10 J.L. & POL'Y 489, 501 (2002). Rejection of the title was based on the “fundamental objection,” *id.*, that the title “would create a new set of exclusive rights, the benefits of which did not necessarily outweigh ‘the disadvantage of removing such designs from free public use.’” *Id.* (quoting H.R. REP. NO. 94-1476, at 50).

²⁸ Berne Convention for the Protection of Literary and Artistic Works, Sep. 9, 1886, S. TREATY DOC. NO. 99-27, 828 U.N.T.S. 221 [hereinafter Berne Convention].

²⁹ See *id.* art. 2(1). However, the Convention notes that “it shall be a matter for legislation in the [signatory] countries . . . to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected.” *Id.* art. 2(7).

³⁰ Monseau, *supra* note 21, at 48.

³¹ *Esquire, Inc. v. Ringer*, 591 F.2d 796, 801 (D.C. Cir. 1978) (footnote omitted) (quoting H.R. REP. NO. 94-1476, at 50).

³² *Id.* at 801 n.15.

³³ See, e.g., Katy Tasker, *The Innovative Design Protection and Piracy Prevention Act: Litigation, Uncertainty, and Economic Harm*, PUB. KNOWLEDGE (July 15, 2011), <http://publicknowledge.org/blog/innovative-design-protection-and-piracy-preve>.

Most recently, Congress considered a new bill called the Innovative Design Protection Act³⁴ (IDPA). The bill was a proposed amendment to the Copyright Act that would have provided for a three-year term of protection for original elements or arrangements of fashion designs that were the result of a designer's "own creative endeavor" and that "provide[d] a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs."³⁵ Like its predecessors, however, the bill failed to pass.³⁶

III. THE EXPANDING REACH OF U.S. TRADEMARK LAW

A. *The Fashion Industry's Increased Reliance on Trademark Law*

This Part explains how the fashion industry has come to rely more on trademark law for protection of its trademarks (and designs), and how such reliance has led to the expansion of trademark doctrine. Part IV of this Note will discuss some of the implications of this expansion.

At first blush, trademark law does not seem like the obvious choice for protecting fashion intellectual property. Though trademark law is often considered part of and taught alongside the broader intellectual property scheme to which patent and copyright law also belong, it is inherently quite different. Both patent and copyright are fundamentally incentive-based systems. The creator invents something from which the rest of society can benefit, and society rewards that inventor with a limited-duration monopoly to monetize the invention. This reward also serves as incentive for an inventor to invent. It is a tradeoff that, at least theoretically, as a whole encourages innovation.

Trademark law is not based on this principle of a tradeoff between society and an inventor. Instead, trademarks originated to protect a product's source-identifier.³⁷ Rights were focused on protecting producers or merchants from illegitimate diversions of their trade rather than on protecting consumers.³⁸ It was not until the 1946 passage of

³⁴ S. 3523, 112th Cong. (2012).

³⁵ *Id.* § 2(a)(2)(B).

³⁶ See S. 3523 (112th): *Innovative Design Protection Act of 2012*, GOVTRACK.US, <https://www.govtrack.us/congress/bills/112/s3523> (last visited Nov. 24, 2013).

³⁷ Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 NOTRE DAME L. REV. 1885, 1890-91 (2011). Trademarks became legitimized through two historical uses: first, merchants (not craftsmen) would affix marks on their goods so that they would be able to identify and retrieve their own goods after shipping, and second, guilds would often require a regulatory production mark to be placed upon certain goods so that defective goods could be traced to their originator and such individuals could be punished. *Id.*; see also Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 814 (1927).

³⁸ See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 97 TRADEMARK REP. 1126, 1126 (2007).

the federal Lanham Act³⁹ that trademark law's purposes expanded beyond source-identification. The Lanham Act defines a trademark as "any word, name, symbol, or device, or any combination thereof" that is used or intended to be used by a person "in commerce . . . to identify and distinguish his or her goods."⁴⁰ The Lanham Act's two primary goals are to protect producers from unfair competition and consumers from deception.⁴¹

Even so, it may still not be clear why trademarks have become the center of attention in infringement disputes between designers — after all, trademarks prohibit copying of source-identifiers (that is, logos such as the red Target bullseye), not designs. However, the fashion industry has long realized that trademark law's nonconformity with the general quid-pro-quo schemes of copyright and patent law can actually work to its advantage.⁴² Recall that a trademark is permanent.⁴³ It can endure indefinitely so long as the registrant continues to use it in commerce.⁴⁴ If a designer can conflate logo and design, then he can conveniently obtain permanent, practically no-strings-attached rights to the design. On top of this prospect, consider the fact that the speed of the fashion cycle is many times faster than the speed of litigation: a design will be in and out of the shops before the litigation has even commenced.⁴⁵ Designs are seasonal, but because a trademark can last forever, it is worth the litigation expense.

Related to trademark is the doctrine of trade dress, which has been another avenue of attack for design litigants. Trade dress is generally understood to be the "total image and overall appearance" of a prod-

³⁹ 15 U.S.C. §§ 1051–1141n (2012).

⁴⁰ *Id.* § 1127.

⁴¹ *Id.* §§ 1058–59; S. REP. NO. 79-1333, at 3 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1274. To establish a prima facie case of trademark infringement, a plaintiff must prove "(1) that it has a protectible ownership interest in the mark; and (2) that the . . . use of the mark is likely to cause consumer confusion" as to its source. *Dep't of Parks & Recreation v. Bazaar Del Mundo Inc.*, 448 F.3d 1118, 1124 (9th Cir. 2006). The Supreme Court has recognized that marks may be classified in five categories of increasingly distinct marks: "(1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

⁴² See Lauren Howard, *An Uningenious Paradox: Intellectual Property Protections for Fashion Designs*, 32 COLUM. J.L. & ARTS 333, 336 (2009) ("Trademark is particularly important to fashion labels, as it protects designers' most important asset: their brand."); Felix Salmon, *Susan Scafidi on Copyrighting Fashion*, UPSTART BUS. J. (Sept. 19, 2007, 12:00 AM), <http://upstart.bizjournals.com/views/blogs/market-movers/2007/09/19/susan-scafidi-on-copyrighting-fashion.html> ("Revenues and profits at the big fashion houses rely heavily on trademark protection — all those little 'CC,' 'GG,' and 'LV' initials decorating handbags and other must-have items.").

⁴³ 15 U.S.C. §§ 1058–1059.

⁴⁴ *Id.* § 1058(a), (b)(1)(A).

⁴⁵ See Interview with Imogen Wiseman, Partner, FJ Cleveland LLP (Jan. 22, 2013) (notes on file with the Harvard Law School Library).

uct,⁴⁶ including “features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.”⁴⁷ Thus, in addition to asserting rights over brand names and insignia, fashion designers can in certain circumstances assert that the actual shape of an article has become, through association in the customer’s mind, a trade dress — take, for example, the glass Coca-Cola bottle. Designers may resort to trade dress to sue the manufacturer or distributor of a knockoff whose design is so similar to an original design that it causes confusion about the origin of the knockoff.

This standard has traditionally been very difficult to meet, but has become easier in the past decade. The Supreme Court in *Wal-Mart Stores, Inc. v. Samara Bros.*⁴⁸ held that to prevail on a trade dress infringement claim, the plaintiff must prove that its trade dress is distinctive, or in other words, show that the trade dress is either “inherently distinctive”⁴⁹ or has acquired distinctiveness through “secondary meaning.”⁵⁰ Where trade dress infringement has been seen as a possibility by courts, it has been in the rare case of high-profile, well-established designs, such as certain Adidas-brand shoes.⁵¹ Therefore, trade dress has traditionally not been a sure route by which designers — especially new designers — may attain protection for their designs.

B. How Trademark Law Has Expanded

The economic benefits of creating a design that heavily incorporates the use of a trademark (termed “brand innovation”⁵² by some scholars) are obvious. A designer may indirectly obtain protection for a design so long as the design incorporates the use of a protectable trademark. As Professor Susan Scafidi notes: “[Y]ou didn’t think that all of those repeated logos were just aesthetic choices, did you?”⁵³

The cases presented in this section do not always represent a court victory for fashion design, but the language of the decisions showcases a pattern of courts’ subtle and increased willingness to expand the ho-

⁴⁶ *Blue Bell Bio-Med. v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989).

⁴⁷ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992) (quoting John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983)) (internal quotation mark omitted).

⁴⁸ 529 U.S. 205 (2000).

⁴⁹ *Id.* at 210.

⁵⁰ *Id.* at 211.

⁵¹ See, e.g., *Adidas-Salomon AG v. Target Corp.*, 228 F. Supp. 2d 1192 (D. Or. 2002).

⁵² See Interview with Noam Shemtov, Senior Lecturer in Intellectual Prop. and Tech. Law, Queen Mary, Univ. of London, Sch. of Law (Jan. 23, 2013) (notes on file with the Harvard Law School Library).

⁵³ Salmon, *supra* note 42 (quoting Susan Scafidi); see also Tu, *supra* note 25, at 432 (“In light of the protection granted to trademarks, a fashion designer that incorporates a registered trademark into a fashion design may obtain indirect protection of the design itself from those who misappropriate the mark for use on counterfeit goods.”).

rizons of trademark doctrine in a way that allows quasi-designs to be protected as trademarks.

1. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.: Beginnings of Protecting Logos that Are Arguably Designs.* — Louis Vuitton is a French high-fashion firm that designs handbags and is well known for its Toile Monogram that consists of entwined “LV” initials set against one of three motifs.⁵⁴ Vuitton registered this design pattern and the individual unique shapes as trademarks with the U.S. Patent and Trademark Office (USPTO).⁵⁵ In October 2002, Vuitton updated this Toile Monogram by printing the entwined “LV” initials in thirty-three bright colors on either a white or black background.⁵⁶ This design — arguably a quasi-design — Vuitton called the Louis Vuitton Monogram Multicolore,⁵⁷ but it was not a registered trademark.⁵⁸ By 2004, Vuitton had sold 70,000 bags and accessories with the Multicolore pattern in the United States and generated over forty million dollars in sales.⁵⁹ In July 2003, Dooney & Bourke, an American fashion firm known for its handbags consisting of the interlocking initials “DB” in a repeating pattern, began manufacturing and selling its “It-Bag” line of bags, which eventually featured the entwined “DB” initials printed in contrasting colors on a variety of colored backgrounds.⁶⁰

Vuitton sued Dooney & Bourke in the U.S. District Court for the Southern District of New York shortly after Dooney & Bourke introduced its “It-Bag” collection, claiming “trademark infringement, unfair competition and false designation, and trademark dilution, under federal and New York state law.”⁶¹ Vuitton specifically claimed trademark infringement because it knew other forms of intellectual property, most notably trade dress, would be inadequate to protect its Multicolore pattern.⁶² In fact, it filed the lawsuit with the hope that the court might consider expanding the scope of trademark protection in a direction that would safeguard design (or, at least, designs that were incorporated into a trademark).⁶³

Vuitton, on the surface, lost. The Second Circuit did not engage with Vuitton on its reasons for filing this lawsuit — that is, to counter the phenomenon of design piracy in the fashion industry. By its language the court seemed opposed to expanding trademark doctrine to

⁵⁴ *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 112 (2d Cir. 2006).

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ *Id.* at 115.

⁵⁹ *Id.* at 112–13.

⁶⁰ *Id.* at 113.

⁶¹ *Id.*

⁶² *See id.* at 115–16.

⁶³ *See id.*

give refuge to fashion.⁶⁴ The court merely remanded the case back to the district court, with instructions for how the district court should conduct the likelihood-of-confusion analysis necessary to evaluate “the precise trademark claimed” by Vuitton.⁶⁵

But the industry scored at least a small victory. A year before the *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*⁶⁶ case, the Second Circuit had dealt with a nearly identical case, where Vuitton had sued Burlington Coat Factory for trademark infringement.⁶⁷ There the Second Circuit approached the case with apparently the same degree of doctrinal rigidity as it did in the later *Dooney & Bourke* case: it chose to focus on the district court’s assessment of consumers’ likelihood of confusion rather than taking the opportunity to analyze the proper scope of trademark doctrine.⁶⁸

However, a deeper analysis reveals that more crucial than the court’s similar focus on the adequacy of likelihood-of-confusion analyses are its dicta in both cases. In neither case did the court pronounce Vuitton’s Multicolore trademark to be invalid. Far from it. In *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*,⁶⁹ the court touted the prominence of Vuitton’s Multicolore design in the marketplace,⁷⁰ almost as if tacitly agreeing that, if challenged, the Multicolore design would hold up as a mark. Then in *Dooney & Bourke*, the court itself made the leap it hinted at in *Burlington Coat Factory*: with colorful and powerful language, it pronounced Vuitton’s Multicolore mark to be a valid trademark:

Notably, plaintiff does not claim a separate trademark in the colors alone. . . .

Instead, plaintiff maintains that the polychromatic display is an “essential part” of its trademarked design, and that other handbag manufacturers are free to create their own brightly-colored handbags so long as they do not do so in a manner confusingly similar to the Vuitton combination of color and defined design. With regard to its own trademark, [Vuitton] asserts that it “cannot dissect the color from the pattern. . . . [T]he strength of the mark here is . . . the synergy between the colors and the [traditional] Louis Vuitton trademarks.”

⁶⁴ See *id.* at 116–18; Ashley E. Hofmeister, Note, *Louis Vuitton Malletier v. Dooney & Bourke, Inc.: Resisting Expansion of Trademark Protection in the Fashion Industry*, 3 J. BUS. & TECH. L. 187, 203–04 (2008).

⁶⁵ *Dooney & Bourke*, 454 F.3d at 119–20.

⁶⁶ 454 F.3d 108 (2d Cir. 2006).

⁶⁷ *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 536 (2d Cir. 2005).

⁶⁸ See *id.* at 539.

⁶⁹ 426 F.3d 532.

⁷⁰ See *id.* at 535.

Vuitton does not seek to protect the overall look of its handbags, that is, its trade dress, but rather the narrower trademark it has established in its colored pattern. . . .

Vuitton's Multicolore mark, consisting of styled shapes and letters — the traditional Toile mark combined with the 33 Murakami colors — is original in the handbag market and inherently distinctive.⁷¹

Despite the court's declining to address directly Vuitton's design piracy concerns, the court's statement (while not binding on future cases) ameliorated those concerns by perpetuating a conception of trademark doctrine that would allow or even encourage broad protection of this type of design pattern. This Multicolore pattern is a noteworthy departure from Vuitton's original mono-color trademark, especially when one considers just how basic such a pattern actually is. By approving of Vuitton's Multicolore mark, the court suggested that patterns as basic as printed designer's initials in various colors on a black or white background may be off-limits in the future to other designers.

2. *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.: Expansion of Trademark Protection to Single Colors.* — A few years after the *Dooney & Bourke* case, the Second Circuit faced a similarly high-profile trademark infringement dispute between two well-known shoe designers, Christian Louboutin and Yves Saint Laurent (YSL).⁷² In this case, the court expanded trademark doctrine by a degree that the *Dooney & Bourke* court stopped short of — the Second Circuit pronounced that a single color on a fashion item *could* constitute a trademark.

In 1992, Louboutin, a French designer, put bright lacquered red on the outsoles of its high heels and in January 2008, obtained a trademark (the "Red Sole Mark"⁷³) from the USPTO for such a red sole.⁷⁴ This trademark would also be classified as a quasi-design. YSL, an American competitor, made several models of shoes following a "monochrome" design concept, meaning that these shoes were one color all over, including the outsole.⁷⁵ The shoes came in all-yellow,

⁷¹ *Dooney & Bourke*, 454 F.3d at 115–16 (second and third alterations in original). Vuitton ultimately lost the case on remand because the district court found that *Dooney & Bourke*'s conduct failed to qualify as willfully deceitful and because Vuitton could not prove actual damages from brand dilution. See *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 500 F. Supp. 2d 276, 282–83 (S.D.N.Y. 2007).

⁷² *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012).

⁷³ *Id.* at 213.

⁷⁴ Brief for Plaintiffs-Counter-Defendants-Appellants and Special Appendix at 3, *Louboutin*, 696 F.3d 206 (No. 11-3303-cv). Louboutin has stated that he chose the color red to inject "energy" into his lines of shoes and because red is "engaging, flirtatious, memorable and the color of passion," as well as "sexy." *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 447 (S.D.N.Y. 2011) (quoting Declaration of Alexis Mourot at 3–4).

⁷⁵ Brief for Defendants-Counter-Claimants-Appellees at 1, *Louboutin*, 696 F.3d 206 (No. 11-3303-cv).

all-green, all-red, all-blue, and all-purple.⁷⁶ YSL offered these monochrome shoes in four shades of matte red: "rouge," "flame," "fragola/rosa," and "lobster."⁷⁷

In the ensuing infringement case, the district court held that Louboutin's Red Sole Mark did not merit protection. It reasoned that, uniquely in the fashion industry, color has aesthetic and expressive purposes.⁷⁸ Because the fashion industry "is dependent on colors,"⁷⁹ the court found that artists' use of the full palette of colors should be unconstrained; otherwise, allowing trademarking of a single color would limit artistic freedom and promote unfair competition.⁸⁰

On appeal, however, the Second Circuit concluded that a single color — more specifically, a quasi-design premised primarily on the placement of a single color — *could* serve as a trademark in the fashion industry.⁸¹ It found that to hold otherwise would have been inconsistent with the Supreme Court's ruling in *Qualitex Co. v. Jacobson Products Co.*,⁸² a case where the gold-green color on dry-cleaning press pads was held as a valid trademark.⁸³ The Second Circuit found that Louboutin's Red Sole Mark had acquired "secondary meaning," but with one modification: the red outsole must contrast with the remainder of the shoe in order for the mark to be valid.⁸⁴ And finally, the court concluded that because YSL's shoes utilized a monochrome design (that is, there was no contrast between the red outsole and the upper part of the shoe), they did not infringe Louboutin's Red Sole Mark as modified.⁸⁵

Comparing the two Louis Vuitton cases with *Louboutin*, it is clear that the Second Circuit has widened its stance on the scope of trademark law. In *Dooney & Bourke*, the court asserted that one of the reasons Vuitton's Multicolore mark was a valid trademark was that Vuitton did "not claim a separate trademark in the colors alone."⁸⁶ Both Vuitton's multicolor logo and Louboutin's red sole were arguably as much *design* choices as ways to help consumers identify the source of a product. Thus, *Louboutin* can be read as allowing designers to protect a design component under trademark law — something they could

⁷⁶ *Id.* at 2.

⁷⁷ *Id.* at 10. Only the all-red shoes were at issue in the case. *Id.*

⁷⁸ See *Louboutin*, 778 F. Supp. 2d at 453–54.

⁷⁹ *Id.* at 454.

⁸⁰ See *id.* The court analogized this case to Picasso's laying claim to the color blue as part of his hypothetically trademarked Blue Period and then objecting to Monet's use of the same color. *Id.* at 451.

⁸¹ *Louboutin*, 696 F.3d at 212.

⁸² 514 U.S. 159 (1995); see *Louboutin*, 696 F.3d at 212.

⁸³ *Qualitex*, 514 U.S. at 166.

⁸⁴ *Louboutin*, 696 F.3d at 228.

⁸⁵ *Id.*

⁸⁶ *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2006).

not have done in copyright law under the doctrine of conceptual separability. The claimed trademark — the red sole — actually embodies the design of the shoe, and this design cannot be separated from the utility of the product, for if the red sole were separated conceptually from the bottom of the shoe, then it would simply be a color in space, which would not qualify as a “design.” This feature of the shoe differs from, for example, a textile print design on a dress, which would still qualify as a design even if it were disembodied from the dress.

Even more remarkable in comparison is the outcome of a case Louboutin had concurrently filed against Zara France for infringement of the same red sole.⁸⁷ The French Court of Cassation (France’s highest court of civil and criminal appeals) actually cancelled Louboutin’s mark for lack of “distinctiveness,” finding that “the reputation of Louboutin’s . . . red sole shoes related . . . to a concept, rather than to the trademark.”⁸⁸ To wit, a U.S. court’s conception of what designs are protectable actually exceeded that of a French court, despite France being generally known for having one of the most robust systems of fashion design protection.⁸⁹

3. Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.: *Ninth Circuit Ignores Precedent to Expand Trademark Protectability*. — In 2011, Levi Strauss sued Abercrombie & Fitch for infringing and diluting the federally registered trademark on Levi Strauss’s “Arcuate” logo design, which appears on the back pockets of its denim jeans.⁹⁰ The Arcuate logo design consists of two connected arches that meet in the center of the pocket.⁹¹ Levi Strauss created blue jeans and has been selling them since the 1870s, and “[s]ales of garments bearing the Arcuate mark have accounted for more than ninety-five percent of Levi Strauss’s revenue over the past thirty years, totaling roughly fifty billion dollars.”⁹² In 2006, Abercrombie added a design to the back pockets of its jeans that, according to Levi Strauss, “incorporate[d] the distinctive arcing elements of the Arcuate trademark.”⁹³ According to the court, Abercrombie’s new design was similar, though not identical, to the Arcuate design: it “consist[ed] of two less-pronounced arch-

⁸⁷ Cour de cassation [Cass.] [supreme court for judicial matters] com., May 30, 2012 (Fr.), <http://www.legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte=JURITEXT00025963595&fastReqId=654839726&fastPos=1>.

⁸⁸ *Supreme Court Invalidates Louboutin’s Red-Sole Trademark*, INT’L L. OFF. (Nov. 12, 2012), <http://www.internationallawoffice.com/newsletters/detail.aspx?g=e7f9ee16-36df-44b1-8108-2e6283f61fa7>.

⁸⁹ See Shelley C. Sackel, *Art Is in the Eye of the Beholder: A Recommendation for Tailoring Design Piracy Legislation to Protect Fashion Design and the Public Domain*, 35 AIPLA Q.J. 473, 484 (2007).

⁹⁰ *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158, 1159 (9th Cir. 2011).

⁹¹ *Id.*

⁹² *Id.*

⁹³ *Id.* (quoting Brief of Appellant at 4, *Levi Strauss*, 633 F.3d 1158 (No. 09-16322)).

es . . . connected by a ‘dipsy doodle,’ which resembles the mathematical sign for infinity,” and the design “sits lower on the [Abercrombie jean] pocket than Levi Strauss’s Arcuate design.”⁹⁴

In analyzing Levi Strauss’s trademark dilution claim, the district court considered whether the two marks were “identical or nearly identical.”⁹⁵ Though in previous trademark dilution cases the Ninth Circuit had approved of such a stringent similarity standard,⁹⁶ here it disapproved, instead relaxing the stringency of the similarity requirement.⁹⁷ Its reasoning was that the cases in which it had used an “identical or nearly identical” standard predated or were otherwise unaffected by the passage of the Trademark Dilution Revision Act of 2006⁹⁸ (TDRA), and that this standard “did not survive Congress’s enactment of the TDRA.”⁹⁹ While the Ninth Circuit could have read the TDRA in a way that would have made its intent more consistent with the “identical or nearly identical” approach, which the court had already set in its own precedent, as well as more consistent with a similarly strict standard embraced by other circuits pre-TDRA,¹⁰⁰ it instead chose to read the statute in a way that departed from and loosened the standard previously applied. The court purported to interpret the statute afresh, looking only to the “plain language” of the Act to conclude that a plaintiff need not show that a challenged mark is “identical, nearly identical, or [even] substantially similar” to the plaintiff’s established trademark in order to obtain relief.¹⁰¹ Instead, all that a plaintiff must show is that the challenged mark is “likely to

⁹⁴ *Id.*

⁹⁵ *Id.* at 1161 (emphasis omitted) (quoting *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, No. C 07-03752 JSW, 2009 WL 1082175, at *7 (N.D. Cal. Apr. 22, 2009) (emphasis added) (internal quotation marks omitted).

⁹⁶ See, e.g., *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 634 (9th Cir. 2008); *Perfumbay.com Inc. v. eBay Inc.*, 506 F.3d 1165, 1180 (9th Cir. 2007); *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 905 (9th Cir. 2002); *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 806 (9th Cir. 2002).

⁹⁷ *Levi Strauss*, 633 F.3d at 1172.

⁹⁸ Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended in scattered sections of 15 U.S.C.). Congress passed the TDRA to overturn the Supreme Court decision in *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003), which had required a showing of actual trademark dilution, rather than a likelihood of dilution. See Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 INTELL. PROP. L. BULL. 187, 187 (2007). The TDRA resolves other issues involving fame, blurring, and tarnishment that arose in cases decided under the original Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (codified as amended in scattered sections of the U.S. Code). For example, marks that are recognized only in limited geographic areas or niche markets do not qualify for dilution protection under the TDRA. Dale M. Cendali & Bonnie L. Schriefer, *The Trademark Dilution Revision Act of 2006: A Welcome — and Needed — Change*, 105 MICH. L. REV. FIRST IMPRESSIONS 109 (2009), <http://www.michiganlawreview.org/articles/the-trademark-dilution-revision-act-of-2006-a-welcome-and-needed-change>.

⁹⁹ *Levi Strauss*, 633 F.3d at 1159.

¹⁰⁰ *Id.* at 1165.

¹⁰¹ *Id.* at 1172; see *id.* at 1171-73.

impair the distinctiveness” of the plaintiff’s established mark.¹⁰² Thus, the Ninth Circuit reversed the district court’s judgment with respect to Levi’s TDRA claims, announcing that a “less-demanding standard could have tipped the balance in favor of Levi Strauss.”¹⁰³

Each of the cases above involves a different aspect of trademark law, not to mention a different sector of the design world, but taken together, they show that trademark doctrine is expanding through the proactive, tenacious, and resourceful litigation strategies of plaintiffs as well as through the apparently growing trend of courts to side with them. Whether these judges realize it or not, they have signaled an increasing willingness to grant protections to quasi-designs — protections that these plaintiffs would not have been able to secure under copyright or patent law, and that give designers certain rights against design copyists. This trend can be detected in courts’ application of trade dress law as well.

C. Protection of Quasi-Designs Through Trade Dress

Even where counterfeiters copy only the essence of a design instead of imitating it entirely, designers may seek redress in trade dress and secondary meaning pursuant to section 43(a) of the Lanham Act.¹⁰⁴

1. *Wal-Mart Stores, Inc. v. Samara Bros.: Supreme Court Extends Trade Dress Protection to Clothing Designs.* — *Wal-Mart Stores, Inc. v. Samara Bros.* was the first case in which the Supreme Court acknowledged that unregistered trade dress could extend to clothing designs.¹⁰⁵ Samara was a designer of children’s clothing, and it sued Wal-Mart — which had requested that its manufacturers produce clothing based on pictures of Samara’s designs — for producing and selling knockoffs.¹⁰⁶ The Court drew a line between “product-packaging trade dress,” which it had formerly deemed to be inherently distinctive (because packaging “normally is taken by the consumer to indicate origin”) and “product-design trade dress,” which would require a showing of secondary meaning in order to be considered an indicator of origin.¹⁰⁷ Recognizing that its ruling would create “some hard cases at the margin,” it advised courts to err on the side of caution and to classify ambiguous trade dress as product design so as to require a showing of secondary meaning.¹⁰⁸ However, in spite of this cautionary language, the Court expanded trade dress doctrine significantly — from covering only product packaging to covering

¹⁰² *Id.* at 1172.

¹⁰³ *Id.* at 1174.

¹⁰⁴ 15 U.S.C. § 1125 (2012).

¹⁰⁵ 529 U.S. 205, 207 (2000).

¹⁰⁶ *Id.* at 207–08.

¹⁰⁷ *Id.* at 215 (emphasis omitted).

¹⁰⁸ *Id.*

product design — thereby bringing fashion design within its ambit of protection.

2. *Adidas-Salomon AG v. Target Corp. and Hermès International v. Steven Stolman, Ltd.: Trade Dress May Protect Aesthetic Design Choices.* — *Adidas-Salomon AG v. Target Corp.*,¹⁰⁹ a trade dress dispute over the design of footwear, demonstrates how a designer may use trade dress to protect aesthetic design choices, so long as he successfully shows that the design has acquired secondary meaning. Adidas claimed its shoes comprised the following design elements that were distinctive and thus source-identifiers: (1) three stripes on the side of the shoe; (2) a rubber “shell toe”; (3) a particularly flat sole; and (4) a portion on the outer back heel section including a design.¹¹⁰ Target, the defendant, sold similar-looking athletic footwear bearing four stripes.¹¹¹ Citing *Wal-Mart Stores*, Adidas argued that this design constituted “product packaging,”¹¹² whereas Target argued it was a “product design.”¹¹³ The court classified the pattern as a “product design” but still found that the pattern had acquired secondary meaning,¹¹⁴ and that Target’s shoes posed a likely risk of confusion for consumers.¹¹⁵

Not long after these apparel- and footwear-design cases, handbag designers also sought protection based on trade dress. Hermès, an international maker of luxury goods, sought redress for trade dress infringement related to the design of its famous \$5000 Birkin bags in *Hermès International v. Steven Stolman, Ltd.*¹¹⁶ According to Hermès’s complaint, Stolman, the defendant, had begun selling a bag called the “Jelly Kelly,” which looked very similar to the Hermès Birkin bag.¹¹⁷ There were differences, however: The Hermès bags were made either of dyed calf leather or Amazonia rubber (an environmentally friendly rubber found only in the Amazon),¹¹⁸ whereas Stolman’s versions, which cost about \$145 each, were made out of cheaper rubber.¹¹⁹ The Jelly Kelly bags were also different from the Birkin bags in that the keyhole cutouts on the flaps of the Jelly Kelly were larger than those of the Birkin, the straps were longer, and the classic locket dangling from the Birkin’s horizontal strap was ab-

¹⁰⁹ 228 F. Supp. 2d. 1192 (D. Or. 2002).

¹¹⁰ *Id.* at 1194.

¹¹¹ *Id.* at 1196.

¹¹² *Id.* at 1207.

¹¹³ *Id.* at 1206.

¹¹⁴ *Id.* at 1207–09.

¹¹⁵ *Id.* at 1211–13.

¹¹⁶ Complaint, *Hermès Int’l v. Steven Stolman, Ltd.*, No. CV 03 3722 (E.D.N.Y. July 30, 2003), 2003 WL 23883672; see *id.* at 2, 4, 2003 WL 23883672, at *2, *4.

¹¹⁷ *Id.* at 8, 2003 WL 23883672, at *8.

¹¹⁸ *Id.* at 5, 2003 WL 23883672, at *5.

¹¹⁹ *Id.* at 8–9, 2003 WL 23883672, at *8–9.

sent.¹²⁰ Hermès claimed that the design of the Birkin bags, “specifically [their] unique closure, lock, key and shape,” was “strongly associated with Hermès.”¹²¹ Despite the Jelly Kelly’s differences in these exact features, Hermès “obtained a permanent injunction against the sale of [Stolman’s] bags, along with an undisclosed settlement.”¹²²

Considering collectively the above cases on trademark and trade dress, it is important to note that all of the disputed marks were marks whose designs overlapped with the marks’ source-identifying functions. The courts’ piecemeal expansion of trademark doctrine to include protection of design, however, may ultimately hurt the industry that spurred such change.

IV. IMPLICATIONS OF TRADEMARK LAW’S EXPANDED PROTECTIVE REACH

Protecting fashion design through trademark introduces a complex weave of normative, economic, and legal considerations. Three key consequences include (1) stifling fashion design innovation, (2) creating an imbalance in protection that privileges incumbent fashion houses, (3) contributing to a decisive lack of clarity in trademark doctrine as applied to fashion, and (4) perpetuating a counterproductive lack of uniformity between the United States’ and other countries’ approaches to protecting intellectual property.

First, trademark law’s increased protection of quasi-designs discourages artistic innovation in design, instead perversely incentivizing “logo-fication.” Designers trying to secure protection for their goods will opt to generate more logos (and more ways to display them) instead of creating new designs. For example, a designer might place an existing logo on a different backdrop or produce iterations of preexisting logos so that the brand remains recognizable. Even Giorgio Armani, who had always been skeptical of using monograms as an exterior decorative element, acceded to the use of an eagle logo for Emporio Armani to deter copyists.¹²³ Thus, logo-fication may result in further proliferation of handbags with prominent identifiers and fewer types of uniquely tailored clothing.¹²⁴

Indeed trademarks, which can last forever, are antithetical to the credo of fashion, which is based on temporality. The faster the old dies, the more quickly it is replaced by the new, and the more revenue there is to be made. As Coco Chanel famously said: “[F]ashion should slip out of

¹²⁰ Ginia Bellafante, *A “Satire” of a Classic Fails to Amuse the August House of Hermès*, N.Y. TIMES, Aug. 12, 2003, at B8.

¹²¹ Complaint, *supra* note 116, at 4, 2003 WL 23883672, at *4.

¹²² Tu, *supra* note 25, at 438.

¹²³ RENATA MOLHO, BEING ARMANI 92 (2007).

¹²⁴ *See id.*

your hands. The very idea of protecting the seasonal arts is childish. One should not bother to protect that which dies the minute it was born.¹²⁵ Protecting quasi-designs is tantamount to artificial protectionism, stripping fashion designers of the incentive to compete continually by overturning the old with the new. It also encourages such designers to focus first on generating recognizable logos as opposed to experimenting with creative designs or ensuring the quality of their products.

Moreover, the doctrinal expansion of trademark effectively awards a permanent monopoly to creators of trademarked quasi-designs. But the recipients of such monopolies, unlike in patent and copyright law, give nothing back to society in return. Patents expire after twenty years, and copyrights expire seventy years after the death of the creator. The protected creations thereafter fall into the public domain. But because trademark rights are permanent, the owners of trademarked quasi-designs will never have to contribute to society's box of creative tools.

Furthermore, and ironically, a designer's logo-centric approach may actually come back to haunt the brand. The more recognizable the logo (and hence, the stronger the protection it receives), the *easier* it is to copy. Status-crazed people in recent years have begun using such logos in the most unlikely places, including in tattoos and on garbage bags, assault rifles, and toilet seats.¹²⁶ Many have begun to mock and protest such rampant and indiscriminate uses of logos.¹²⁷ Louis Vuitton has felt the backlash of its logo-focused approach: at Louis Vuitton's February 2013 fashion show in Paris, the fashion house's most famous logos — the Monogram and Damier canvases — curiously made no appearance.¹²⁸ Notably, the company had reported two consecutive quarters of its slowest revenue growth since 2009.¹²⁹ As a result, the company's chairman and chief executive, Bernard Arnault, indicated that the fashion house would shift its strategy, intending to "open fewer stores, focus on more luxurious materials and reduce the visibility of its monogrammed products."¹³⁰

¹²⁵ Lynsey Blackmon, Comment, *The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion*, 35 PEPP. L. REV. 107, 112 (2007) (quoting Coco Chanel) (internal quotation marks omitted).

¹²⁶ Angela Meiquan Wang, *35 Things That Shouldn't Be Louis Vuitton-Monogrammed*, BUZZFEED (Nov. 9, 2012, 9:24 PM), <http://www.buzzfeed.com/angelameiquan/35-things-that-shouldnt-be-louis-vuitton-monogram-7ofn>.

¹²⁷ See, e.g., *id.* ("The bags are already enough. Please, no more.")

¹²⁸ Suleman Anaya, *Has Logo Fatigue Reached a Tipping Point?*, BUS. FASHION (Mar. 11, 2013), <http://www.businessoffashion.com/2013/03/has-logo-fatigue-reached-a-tipping-point.html> ("[W]hat does it mean when the world's largest luxury brand shifts its focus away from the very trademarks on which its success has been built?")

¹²⁹ *Id.*

¹³⁰ *Id.* ("Of course it would be easier for Louis Vuitton to boost its revenue; all it would take would be to launch ten new products with the monogram product, but down the road it's not a good strategy." (quoting Bernard Arnault) (internal quotation marks omitted)).

Second, trademark's protection of design logos favors incumbent players to the detriment of emergent designers. Whether protecting product designs or brand names from customer confusion or dilution by similar marks, the consistent requirement in all the cases discussed above was that a trademark or design had obtained *significant recognition* of its uniqueness. Thus, trademark protection tends to be stronger for well-known designers with famous brand names. This type of reputational protection provided by trademark law may encourage design decisions that would strengthen protection, such as the prominent use of visible trademarks on merchandise.¹³¹ The focus on the uses of logos serves to reinforce the incumbency of the big fashion houses whose logos are most recognizable.¹³² The more easily recognizable the logo is, the stronger the protection, and thus the harder it is for emerging designers to establish their brands. This bias in favor of incumbent players is tantamount to suppressing competition, which directly subverts one of the key goals of the Lanham Act.

Third, while the cases above may showcase designers' ability, in certain cases, to circumvent the strictures of the current intellectual property regime, court-initiated protection of quasi-designs does not lead to comprehensive, long-term protection upon which designers may rely. Most of the cases discussed in Part III resulted in hand-crafted, one-off decisions that gave little guidance to future courts on how to apply the doctrine and little predictability for future designers and potential copyists on where courts have actually drawn the line. Take, for example, *Louboutin*. Both sides in that case thought they had won¹³³: Louboutin retained the exclusive right to use the color red on the bottom of its shoes whenever the outer portion of the shoe was any color besides red, and YSL's all-red shoes were found not to have infringed Louboutin's trademark. But this holding did not clarify, for example, the soundness of the lower court's application of the "aesthetic functionality" doctrine.¹³⁴ And because of this ambiguity, a fashion house like Tiffany's is unfortunately left in the dark as to whether its

¹³¹ See Salmon, *supra* note 42.

¹³² See Susan Scafidi, *Intellectual Property and Fashion Design*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 115, 121-23 (Peter K. Yu ed., 2007) (describing the interplay of different forms of intellectual property protection for fashion designers).

¹³³ See Hannah Elliott, *Both Sides Claim Victory in YSL v. Louboutin Shoe Case*, FORBES (Sept. 5, 2012, 5:31 PM), <http://www.forbes.com/sites/hannahelliott/2012/09/05/both-sides-claim-victory-in-ysl-v-louboutin-shoe-case>.

¹³⁴ Aesthetic functionality concerns whether the purely aesthetic aspects of a product, such as color, might nonetheless affect utility or cost. Claire Guehenno, *Color War: The Louboutin Decision and Single-Color Marks in the Fashion Industry*, 4 HARV. J. SPORTS & ENT. L. 225, 231 (2013). The color of medicine capsules is an example of aesthetic functionality. See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.10 (1982).

robin's egg-blue design — given that it is a single color — can hold up in court as a valid trademark.

Finally, when considered in an international context, such decisions worsen the current state of international disparity in intellectual property protection regimes. The consequences of America's independent, piecemeal protection of fashion design have become evident as American fashion designs have gained greater global appeal.¹³⁵ As the Council of Fashion Designers of America (CFDA) reported to the United States Trade Representative:

"[F]ashion design has matured to the point where U.S. original creations are increasingly being copied abroad, and we therefore have an interest in ensuring continued reciprocal protection for these original works." . . . "European designers and their trade associations are becoming increasingly dissatisfied because, even though Europe protects U.S. designs, the U.S. does not adequately protect European designs."¹³⁶

For designers whose products enjoy international demand, it will be difficult to protect their designs simultaneously in America's trademark-based regime and in Europe's copyright-based regime. To illustrate: in *Société Yves Saint Laurent Couture S.A. v. Société Louis Dreyfus Retail Management S.A.*,¹³⁷ YSL sued Ralph Lauren under French copyright law in a case concerning Ralph Lauren's \$1000 imitation of a YSL \$15,000 tuxedo dress.¹³⁸ A French court found that Ralph Lauren had copied YSL's dress and fined the American designer \$383,000.¹³⁹ While YSL recovered for Ralph Lauren's sale of the knock-offs in France, it could not have done so for the sale of the same articles in the United States.¹⁴⁰ That case was decided in 1994, before the wave of trademark expansion that occurred in the 2000s in the United States.

If YSL were to bring the same case today in both countries, it would perhaps have filed previously for trademark or trade dress pro-

¹³⁵ Miller, *supra* note 5, at 156.

¹³⁶ *Id.* (emphasis omitted) (quoting Email from Peter Arnold, Exec. Dir., Council of Fashion Designers of Am., to Mark Mowrey, Deputy Assistant U.S. Trade Representative for Eur. and the Mediterranean (Dec. 17, 2004), available at http://www.ustr.gov/archive/assets/World_Regions/Europe_Middle_East/Transatlantic_Dialogue/Public_Comments/asset_upload_file637_7044.pdf). Some have argued that the Berne Convention, to which the United States is a signatory, actually mandates copyright protection for fashion design. *See id.* at 147. The preamble to the Berne Convention provides that signatories are "equally animated by the desire to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works." Berne Convention, *supra* note 28, pmb. To the extent that U.S. courts have offered design protection via trademark expansion, their decisions may be considered ad hoc, partial fulfillment of the United States' treaty commitments.

¹³⁷ Tribunal de Commerce [Trib. Comm.] [commercial court] Paris, May 18, 1994 (Fr.), translated in 1994 EUROPEAN COMMERCIAL CASES [E.C.C.] 512.

¹³⁸ Julie P. Tsai, Comment, *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK L. REV. 447, 464-65 (2005).

¹³⁹ *Id.* at 465.

¹⁴⁰ *Id.*

tection of its tuxedo dress in order to recover for damages in the United States. And assuming that, like Samara, it had its trademark or trade dress approved by the USPTO, YSL would sue for trademark infringement in the United States. Accordingly, then, YSL would be suing for trademark infringement in one country and copyright infringement in another — on the basis of infringement of the *very same article*. In the process of such litigation, YSL might even be compelled to assert statements for one case that may undercut its case in the other country. For example, one might imagine that to obtain copyright or patent protection for a design that is merely an iteration of an earlier, original design, a fashion house might have to argue for a design's originality in order to meet novelty requirements that are typical of most intellectual property protection systems. Yet, in order to receive trademark protection, the designer might have to argue that the second mark bears substantial similarity to the original mark, thereby suggesting that this second mark is not original at all, undermining the argument for patentability.

V. CONCLUSION

All of these factors taken together suggest that *sui generis* legislation from Congress might be the best way both to provide protection for new and incumbent fashion designers and to promote creativity in the industry. If Congress does not affirmatively create legislation to protect design in a more orderly way now, it may later have to fashion defensive legislation to undo court-crafted changes to trademark doctrine that stifle creativity and competition.

The IDPA was a good start. It proposed a reasonably short length of protection: three years. This term of protection is comparable to that of France, where the term of years is left up to the discretion of judges, who usually decide that "protection should last so long as the design is capable of being effectively exploited" (typically from eighteen months to two years in fashion).¹⁴¹ France also applies a looser originality requirement than the IDPA would have — French originality is determined "on an ad hoc basis, looking to any works which may have inspired the design at issue"¹⁴² — potentially justifying its even shorter term of protection.

However, the IDPA's language was likely too vague to have been effective even if it had passed. It would have protected "the appearance

¹⁴¹ Leslie J. Hagin, Note, *A Comparative Analysis of Copyright Laws Applied to Fashion Works: Renewing the Proposal for Folding Fashion Works into the United States Copyright Regime*, 26 TEX. INT'L L.J. 341, 374 (1991) (quoting 2 JEAN VINCENT, GUIDE JURIDIQUE § 37, at 204-205 (1987) (translated by author)).

¹⁴² *Id.*

as a whole” of articles of apparel.¹⁴³ Such a broad definition would likely open the door to the trivial yet costly litigation of which its critics warn. Compare this language to the more descriptive guide provided by the Community Designs Regulation¹⁴⁴ adopted about a decade ago by the European Union to provide a more uniform system for protecting European designs from infringement in other EU member countries. Under the Community Designs Regulation, “design” is defined as “the outward appearance of a product or part of it, resulting from the lines, contours, colours, shape, texture, materials and/or its ornamentation.”¹⁴⁵ A perfectly precise and all-encompassing definition is impossible — fashion would not be fashion if it were so easily captured in words — but a definition can provide guidance to designers and courts.

Still, critics of *sui generis* legislation may argue that the benefits of protection are ultimately outweighed by the cost of increased (and unnecessary) litigation. One way to get around this issue is by modifying the litigation process or limiting the court remedies available for fashion design. In the United Kingdom, the Patents County Court deals on an expedited basis with patents, registered UK or Community designs, trademark disputes, copyright disputes, unregistered designs, and databases.¹⁴⁶ Design-copying cases are decided solely by a sole judge who has the final and only say about whether two designs are similar.¹⁴⁷ This juryless decisionmaking process may seem unfair to some, but overall it has the advantage of expediting litigation of designs that will be out of vogue in a few months anyway, allowing designers to move on with their work rather than maintain protracted court battles.

The piecemeal granting of trademark protection to quasi-designs will stagnate the fashion industry, both artistically and economically. It will aid the nearly permanent removal of artistic tools from the public domain with no corresponding benefit to the public. *Sui generis* legislation, while bound to be imperfect, may be the best way to balance the goals of artistic innovation, idea protection, and fair competition.

¹⁴³ S. 3523, 112th Cong. § 2(a)(2) (2012).

¹⁴⁴ Council Regulation 6/2002, 2002 O.J. (L 3) 1, amended by Council Regulation 1891/2006, 2006 O.J. (L 386) 14.

¹⁴⁵ *What is a Design?*, OFF. FOR HARMONIZATION IN THE INTERNAL MKT. (TRADE MARKS & DESIGNS), <http://oami.europa.eu/ows/rw/pages/RCD/design.en.do> (last visited Nov. 24, 2013).

¹⁴⁶ Alison Rea, *United Kingdom: IP Enforcement for Small and Medium Sized Companies — The Patents County*, MONDAQ, <http://www.mondaq.com/x/218956/Patent/Increased+Regulation+Likely+To+Lead+To+More+Outsourcing+AndOr+Redundancies+In+The+Financial+Services+Sector> (last updated Jan. 31, 2013).

¹⁴⁷ See Interview with Imogen Wiseman, *supra* note 45.

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